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**INTELLECTUAL PROPERTY
AND HUMAN RIGHTS**
Enhanced Edition of
Copyright and Human Rights

Paul L.C. Torremans (ed.)



Wolters Kluwer

Law & Business

Intellectual Property and Human Rights

Enhanced Edition of Copyright and Human Rights

KLUWER LAW INTERNATIONAL

Intellectual Property and Human Rights

Enhanced Edition of Copyright and Human Rights

Edited by

Paul L.C. Torremans



Wolters Kluwer

Law & Business

AUSTIN

BOSTON

CHICAGO

NEW YORK

THE NETHERLANDS

Published by:

Kluwer Law International
PO Box 316
2400 AH Alphen aan den Rijn
The Netherlands
Website: www.kluwerlaw.com

Sold and distributed in North, Central and South America by:

Aspen Publishers, Inc.
7201 McKinney Circle
Frederick, MD 21704
United States of America
Email: customer.care@aspenpubl.com

Sold and distributed in all other countries by:

Turpin Distribution Services Ltd.
Stratton Business Park
Pegasus Drive, Biggleswade
Bedfordshire SG18 8TQ
United Kingdom
Email: kluwerlaw@turpin-distribution.com

ISBN 978-90-411-2653-5
(ePDF ISBN 978-90-411-4750-9)

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Information Law Series

VOLUME 18

General Editor

Prof. P. Bernt Hugenholtz
Institute for Information Law
University of Amsterdam

The titles published in this series are listed at the back of this volume.

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Foreword

A couple of years ago I organized a conference on intellectual property and human rights at Canada House in London.¹ The papers dealt essentially with copyright related issues and many of us felt that we were dealing with a niche topic. We were very happy when Kluwer Law International accepted to publish the papers as a book.² Soon afterwards though we become aware that our niche topic started to mushroom and the book started to attract an increasing amount of interest.

What you have in front of you is a much expanded second edition. The majority of the original papers have been updated thoroughly and developed much further. They are now part of a much larger project though. Many papers have been added. And apart from copyright, the interaction between human rights, patents, trade marks and rights in information is now also fully addressed. The second edition is therefore very different from the first one. The project has come to age.

In a first set of papers the complex relationship between human rights and intellectual property as a whole is analyzed. The starting point is that over the last couple of years these two disciplines had to learn to live together. It is therefore interesting to see how the European Court of Human Rights dealt with intellectual property issues and to address the challenges that emerge. Human Rights often have a constitutional dimension. It is therefore interesting to examine whether that also applies, or whether it should also apply, to intellectual property. Maybe there is indeed no conflict. Could these two areas cooperate? If so, how do we deal with the balance between them? Could proportionality assist? And finally, some aspects of intellectual property rights might themselves have human rights status.

1. The support of the Canadian High Commission in London, my then colleagues in the BACS Legal Studies Group and especially Michael Hellyer in launching this project is gratefully acknowledged.

2. Paul Torremans (ed.), *Copyright and Human Rights: Freedom of Expression – Intellectual Property – Privacy*, Volume 14 Information Law Series, Kluwer Law International (2004).

That brings us to the interaction with specific intellectual property rights. First, our attention turns to copyright. Freedom of expression is an issue that arises only to take centre stage. Defences of fair dealing could potentially be used to fine-tune copyright to respect the right to freedom of expression. Looking at it from the other end of the spectrum, human rights could guide or inspire copyright reform. Copyright also affects the human right to education. Here the issues are broader than just freedom of expression.

Secondly, we address issues related to trade marks and similar rights. There are general issues here, but also specific questions such as a right to immoral trade marks. Cultural expressions and geographical indications also give rise to specific issues.

Thirdly, our attention turns to rights in information. Privacy and breach of confidence clearly raise a lot of issues. That applies maybe not only in a context related to private persons, but it could also affect corporations. Freedom of information and the public interest defense clearly also affect this area.

Finally, we address issues in relation to patents for biotechnological material and some of the issues in relation to living materials are shown very sharply in relation to embryo research and stem cells. Ethical and moral issues then play a dominant role.

Human rights and intellectual property is clearly a field in full expansion and development. On behalf of all the contributors I hope that this book can make a substantial contribution to this development. Our thanks also go to Gwen Devries and her team at Kluwer Law International who made this expended and revised edition possible and who made the editing such a pleasant experience.

*Paul Torremans
Moissac, December 2007.*

Part I

The Relationship between
Intellectual Property
and Human Rights

Chapter 1

Intellectual Property and Human Rights: Learning to Live Together

*Daniel J. Gervais**

I. INTRODUCTION

Intellectual property and human rights must learn to live together. Traditionally, there have been, as Paul Torremans points out, two dominant views of this ‘cohabitation’, namely a conflict view, which emphasizes the negative impacts of intellectual property on rights such as freedom of expression or the right to health and security, and a compatibility model, which emphasizes that both sets of rights strive towards the same fundamental equilibrium. This chapter will take the dualist view that both are right, though there is, and should be, much more truth to the second approach in the coming years.

What are the threads that weave intellectual property and human rights together? First, intellectual property rights claim to have roots in natural law, most famously as the Lockean moral desert theory, which held that property rights should be commensurate with ‘the sacrifice actually incurred’.¹ According to this view, property is justifiable as a (just) reward for work done to create new works

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1. Barbara H. Fried, *The Progressive Assault on Laissez Faire: Robert Hale and the First Law and Economics Movement* (Cambridge: Harvard University Press, 1998), 111.

from the existing inventory of ideas and public domain works, or on a significant, industrially useful improvement on the existing stock technological knowledge.

Locke's original theory turned on the labour sacrifice of a particular land owner. He did not advocate property rights in intangibles. Applying his theory to intangibles raises interesting questions. For instance, if one adopts a natural law justificatory theory for intellectual property, then one might ask whether the protection of intangible should be commensurate with the author's or inventor's efforts. If one were to argue for proportionality, a flood of both theoretical and practical questions immediately would race through one's mind: who could set and enforce the criteria to determine the value of a work or a patent? Which *kind* of value (societal, economic, etc.), and according to which set of metrics? How would temporal elements be factored into the equation (i.e., what is the value now and twenty years hence)? What would be the transaction costs of this determination? And the list goes on.

Is the invisible hand the best judge? Few would argue that the *market* value of a particular piece of music or patent (assuming market value is a valid benchmark) is proportional to the efforts, time or money invested. Poets, whose sweat and coffee stains are often the only visible result of a day's work and whose success, if and when it happens, will seem picayune compared to the latest techno or hip-hop hit, might agree. The same criticism could be addressed to many physical goods, whose market value bears little relationship to actual costs.

In spite of those differences between tangible and intangible property, natural law roots are something that intellectual property, and perhaps more acutely copyrights and patents, still share with traditional (Eurocentric) human rights theory.² One might disagree with the assertion that private property rights are human rights – at least in a universal conception. At the opposite end of the spectrum, French polemicists asserted that authors' rights were 'the most sacred, the most legitimate, the most unassailable and . . . the most personal of all properties'.³ That debate, however, is beyond the scope of this chapter.⁴ Additionally, as Professor Torremans

2. Since at least Aristotle's *Nicomachean Ethics*, it has been argued that human rights underpin a moral order whose legitimacy precedes contingent social and historical conditions. According to this view, human rights are 'naturally' universal.

3. Le Chapelier, rapporteur before the Constituent Assembly, quoted in translation in Michel Vivant, 'Authors' Rights, Human Rights?', *Revue internationale du droit d'auteur*, RIDA 174 (1997): 60, 62. One could add Lakanal's amplification (quoted in *idem*): 'Of all properties, the least disputable, the one whose growth can neither undermine republican equality nor offend freedom, is unquestionably that of productions of genius.' The same was said of patents. That authors' rights are a property rights is formally recognized in Art. L.111.1 of the *Code de la propriété intellectuelle* (France). The question whether this is still true in France is occasionally discussed. See M. Vivant, *loc. cit.*, at 81 et seq.

4. As Professor Yu demonstrates in his chapter, the synonymy between the reference to 'material interests' in the UDHR and other instruments (discussed below), on the one hand, and private property, which many often take for granted, on the other, has not in fact been established. That said, in a number of civil law jurisdictions, intellectual property forms part of incorporeal property and is considered as private property in the same way as chattels or land. The two classic divisions of property in those systems are between moveable and immovable and between

notes in his chapter, when applied to informational or ideational objects, the concept of property is imperfect. At the very least, in that context ‘property’ must have a different purpose and meaning,⁵ because statutory intellectual property rights are not only non-excludable and non-rival;⁶ they are also temporary.⁷

Leaving that debate aside, then, and against the backdrop of the traditional linkages based on natural law between intellectual property and human rights, Part II of this chapter will argue that entering the pragmatic realm of trade law, as intellectual property norm-making has done over the past twenty years, might entail abandoning its claim to property and/or human right status. This shift may be observed inter alia by the exclusion of moral rights from trade agreements concerning copyright, and the application of an effects-based test (the three-step test) as a common denominator for allowable exceptions to several intellectual property rights in the TRIPS Agreement.

Responding dialectically to Part II, Part III will focus on copyright’s internal balance as it relates to and mirrors human rights principles and suggests that copyright at least can (re)anchor itself normatively in such principles even if it abandoned traditional natural law-based claims by becoming a trade-related right. As was noted by other contributors to this book, including the editor and Professor Laurence Helfer, copyright can rely on both Article 27 of the Universal Declaration of Human Rights (UDHR)⁸ and Article 15 of the International Covenant on

corporeal and incorporeal (See, e.g., Art. 899 of the Civil Code of Quebec). Art. 458 of the Civil Code of Quebec is an illustration. It reads in part: ‘Intellectual and industrial property rights are private property.’ Art. 909 reads in part as follows: ‘Property that produces fruits and revenues, property appropriated for the service or operation of an enterprise, shares of the capital stock or common shares of a legal person or partnership, the reinvestment of the fruits and revenues, the price for any disposal of capital or its reinvestment, and expropriation or insurance indemnities in replacement of capital, are capital. Capital also includes rights of intellectual or industrial property.’

5. Property confers advantages by ensuring investment and development of resources. The social costs of excludability are acceptable because ‘the losses that people suffer from exclusion are small compared to the gains that they get both from their ability to privatize their labour and from their ability to enter into trade’. In other words, the main propertization is a clear Pareto improvement, but copyright may be different. In classic property theory, for instance, possession is considered key and the law essentially reinforces the physical control that can be exerted by the owner (by fencing, etc.). No such metes and bounds exist in copyright law. This probably explains why property rights in intangibles have been the subject of many a scholarly debate.
6. Non-excludable means that it is impossible to prevent an individual who does not pay for that thing from enjoying the benefits of it. Non-rival goods may be consumed by one consumer without preventing simultaneous consumption by others. Those are the two traditional characteristics of public goods. The increasing recourse to Technological Protection Measures (TPMs) to prevent access to or use of copyright goods is, however, a form of enclosure that attempts to treat information object as excludable property. Tangible patented goods are also obviously excludable, but not the patented information itself, subject to the prohibition of its use to develop a commercial product that would infringe the patent. The level of patent protection in national law may go beyond this prohibition.
7. Except of course for trademarks that remain in commercial use.
8. J.A.L. Sterling, *World Copyright Law* (London: Sweet & Maxwell, 2nd ed., 2003), 43.

Economic, Social and Cultural Rights, as well as regional instruments such as Article 13 of the American Declaration on the Rights and Duties of Man.⁹ Those instruments provide a blueprint for cohabitation, because the human rights principles they embody closely mirror the internal equilibrium of the copyright system, with its limited exclusive rights and exceptions to such rights mainly based on public interest considerations.

Part IV will suggest that the emergence of new normative conflicts between intellectual property and human rights, such as the right to health, but also, in the field of copyright, face-offs with privacy, have fundamentally altered the landscape. There have always been perceived conflicts between copyright and rights such as freedom of expression, but it was also argued in parallel that copyright was *intended* to be an engine of free expression.¹⁰ Freedom of creation is a condition precedent to the existence of freedom of expression. Indeed, as is discussed in Professor Yu's chapter, censorship is at odds with the ability to access and contribute to culture and there is, therefore, a convergence of interests in having copyright as the economic underpinning of a free press and publishing industry. That case may be harder to make with respect to privacy and the right to health. The new environment is thus characterized, on the one hand, by human rights with increased visibility and status, and intellectual property 'reduced to' trade law status, on the other. Intellectual property rights holders ask for this linkage with trade essentially to benefit from the protection of trade sanctions and cross-sectoral trade-offs in trade agreements.¹¹ What they may have underestimated are the 'ontological costs' associated with what, for intellectual property, amounts to an existential shift. Whether trade remedies can compensate for those costs will be discussed at the end of Part IV.

II. INTELLECTUAL PROPERTY AS TRADE LAW

II.A THE ALIGNMENT WITH TRADE

The progressive alignment of trade and intellectual property policy started in the United States in the 1980s through successive amendments to section 301 of the *Trade Act*, which allowed the US Administration to impose trade-based sanctions on countries which, in the view of the United States Trade Representative, did not adequately protect intellectual property rights of United States citizens and companies. There is little doubt that this new weaponry bore fruit. It allowed US

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9. A.R. Chapman, 'Approaching Intellectual Property as a Human Right (Obligations Related to Article 15(1)(c))'. XXXV *Copyright Bulletin* (2001) nos 3, 4–36, at 11.
 10. This was the stated intention of the framers of the Constitution of the United States. See M. Birnhack, 'Copyright Law and Free Speech after *Eldred v. Ashcroft*', S. Cal. L. Rev. 76 (2003): 1275, 1284. See also Patrick Masiyakurima's chapter in this book.
 11. By this I mean that in trade agreement negotiations, concessions on intellectual property can be compensated by concessions in other areas, such as trade in cotton, cars or banking services.

companies to obtain improvements in the protection of their intellectual property in several foreign territories, which agreed to increase protection lest they lose most-favoured nation trading status with the United States.

There ensued a well-documented¹² push by the United States government, supported by the European Commission and the Japanese government, to link intellectual property and trade rules in the World Trade Organization (WTO) as part of the Uruguay Round of Multilateral Trade Negotiations, which ended in Marrakesh in April 1994 with the signing of the Agreement Establishing the WTO, Annex 1C of which is the TRIPS Agreement. While critics opined that intellectual property was not proper subject matter for the WTO, enter the house of trade it did, wholesale.¹³

This has at least two important consequences. First, unlike human rights, trade law is essentially pragmatic and results-based, something illustrated by such fuzzy notions under WTO law of ‘nullification or impairment’ of benefits or the doctrine of ‘reasonable expectations’. Second, trade remedies are generally predicated on a showing of *actual* adverse impact on trade. The protection of intellectual property by trade rules does not seem to mesh with its ideological defence either as a ‘property’ or a human right.

A tort law analogy might be helpful to illuminate the difference. The tort of trespass to land occurs where a person enters or remains upon another’s land without permission and is actionable *per se* without the need to prove damage. Trade law is closer to nuisance, because a showing of damage (actual adverse impact) is required. Not surprisingly, since intellectual property trade law moved its home to the trade neighbourhood critics of intellectual property have tried to show that use of copyright works or patented goods (especially pharmaceuticals) in certain situations would lead to no demonstrable loss of income (i.e., no actual damage) for the rights holders. Logically, they say (if one accepts the premise of trade rules), use should be allowed. Linkage with trade thus reinforces the instrumentalist/consequentialist approach to intellectual property regulation. Intellectual property rights serve a purpose and when they no longer do (as a rule or in a given situation), they should cease to apply.

Rights-holders may need to pick which legal horse they want to cross the intellectual property infringement river: if they choose a trade horse, they must accept pragmatism and the related need to show loss of reasonably available income streams. From that viewpoint, rhetorical reliance on ‘property’ is at odds with a strategy that was otherwise highly successful by copyright and patent lobbies to link intellectual property and trade. Perhaps the most direct and concrete illustration of

12. D. Gervais, *The TRIPS Agreement: Drafting History and Interpretation* (London: Sweet & Maxwell, 2nd ed., 2003); Susan K. Sell, *Private Power, Public Law* (Cambridge University Press, 2003), 96–120; C. May, *A Global Political Economy of Intellectual Property Rights: The New Enclosures?* (Routledge, 2000); P. Drahos & J. Braithwaite, *Information Feudalism: Who Owns the Knowledge Economy?* (New Press, 2003); and A. Koury Menescal, ‘Those behind the TRIPS Agreement: The Influence of the ICC and the AIPPI on International Property Decisions’, *Intell. Prop. Q.* 2 (2005): 155.

13. Jagdish Bhagwati, *In Defense of Globalization* (Oxford, 2004), 182–185.

the impact of trade rules on intellectual property is the omnipresence of the effects-based ‘three-step test’, increasingly viewed as a major normative vector to determine the appropriate scope of intellectual property rights, most notably copyrights, designs and patents in the TRIPS Agreement, as we shall now see.

II.B THE THREE-STEP TEST

The three-step test has become the cornerstone for almost all exceptions to all intellectual property rights at the international level. It is the central test for exceptions to all copyright rights in the TRIPS Agreement (Article 13), to the rights created by the WIPO Copyright Treaty (WCT, Article 10) and the WIPO Performances and Phonograms Treaty (WPPT, Article 16). It is also the basis for exceptions to industrial design protection (Article 26(2)), and patent rights (Article 30) in TRIPS.¹⁴

The test requires that any exception be (1) a special case; (2) not interfere with normal commercial exploitation; and (3) not unreasonably prejudice the legitimate interests of rights holders. It achieves two objectives: first, the test canvasses the areas in which rights holders do *not* need rights to maximize their income; second, it provides a compensation mechanism (the third step) for exceptions that are considered desirable from a public interest perspective but could affect the material interests of rights holders, such as exceptions for private copying. As a result of this rather complete ‘map’ of rights holders’ interests painted by the test, it has been suggested that the test should be reversed in the field of copyright to reveal the optimal scope of exclusive rights, thus greatly simplifying copyright law and aligning it with the economic purpose it embraced by inviting itself to the table of trade.¹⁵

Let us consider briefly each of the three steps. This is only a rather cursory overview and much more detailed commentaries are available elsewhere.¹⁶

II.B.1 ‘Certain Special Cases’

In the 2001 WTO panel decision concerning section 110(5) of the US Copyright Act,¹⁷ the first part of the three-step test, namely the meaning of ‘special’, was interpreted for the first time by an international tribunal. The approach taken was essentially to look at the Oxford dictionary:

The term ‘special’ connotes ‘having an individual or limited application or purpose’, ‘containing details; precise, specific’, ‘exceptional in quality or

14. There is, however, a crucial difference in the case of patent rights: The last (third) step of the test [does] not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.

15. D. Gervais, ‘Towards A New Core International Copyright Norm: The Reverse Three-Step Test’, *Marq. Intell. Prop. L. Rev.* 9 (2005):1.

16. Sam Ricketson & Jane C. Ginsburg, *The Berne Convention and Beyond* (Oxford, 2006), § 13.03 et seq.; and D. Gervais, *loc. cit.*

17. Title 17, United States Code.

degree; unusual; out of the ordinary' or 'distinctive in some way' [here was a footnote referring to the Oxford dictionary] This term means that more is needed than a clear definition in order to meet the standard of the first condition. In addition, an exception or limitation must be limited in its field of application or exceptional in its scope. In other words, an exception or limitation should be narrow in quantitative as well as a qualitative sense.

The approach chosen by the panel is understandable. For valid policy reasons, the WTO Appellate Body has preferred to stick with the ordinary meaning of words, in part to avoid introducing 'unbargained for' concessions in the WTO legal framework. As a result, however, the two steps in the test that can truly be operationalized as normative tools are the 'interference with commercial exploitation' and the 'unreasonable prejudice to the legitimate interests of the author'.

II.B.2 Interference with Normal Commercial Exploitation

What is the meaning of 'exploitation' in the context of this second step of the test? It seems fairly straightforward: use of the work by which the copyright owner tries to extract/maximize the value of her right. 'Normal' is more troublesome. Does it refer to what is simply 'common' (i.e., an empirical standard) or does it refer to a normative standard? The question is relevant in particular for new forms and emerging business models which have not thus far been common or 'normal'. During the last substantive revision of the Berne Convention (Stockholm, 1967), the concept was clearly used to refer to 'all forms of exploiting a work which had, or were likely to acquire, considerable economic or practical importance'. As Paul Goldstein has noted, the purpose of the second step is to 'fortify authors' interests in their accustomed markets against local legislative inroads'. It thus seems that the condition is normative in nature: an exception is not allowed if it covers any form of exploitation which has, or is likely to acquire, considerable importance. In other words, if the exception is used to limit a commercially significant market or, *a fortiori*, to enter into competition with the copyright holder, the exception is prohibited.

The WTO panel in the 110(5) case concluded as follows on this point:

It appears that one way of measuring the normative connotation of normal exploitation is to consider, in addition to those forms of exploitation that currently generate significant or tangible revenue, those forms of exploitation which, with a certain degree of likelihood and plausibility, could acquire considerable economic or practical importance.

The test thus incorporates a dynamic notion of normalcy of commercial exploitation. To be sure, to consider an exception incompatible with the second step because of conflict with a *potential* significant source of revenue requires great caution.

II.B.3 Unreasonable Prejudice to Legitimate Interests of Rights Holders

The third step is perhaps the most difficult. What is an ‘unreasonable prejudice’, and what are ‘legitimate interests’?

Let us start with ‘legitimate’. It can have two meanings: (a) conformable to, sanctioned or authorized by, law or principle; lawful, justifiable; proper; or (b) normal; regular; conformable to a recognized type. To put it differently, are legitimate interests only ‘legal interests’?

The third step is a clear indication of the need to balance the rights of copyright holders and interests (under copyright law, not rights under other laws) of users. An analysis of the Records of the 1967 Stockholm Conference shows that the United Kingdom took the view that legitimate meant simply ‘sanctioned by law’, while other countries seem to take a broader view, meaning ‘justifiable’ in the sense that they are supported by social norms and relevant public policies. The WTO panel concluded that the combination of the notion of ‘prejudice’ with that of ‘interests’ pointed towards a legal-normative approach. In other words, it found that ‘legitimate interests’ are those that are protected by law. The interpretation might have been different if the third step had been formulated as ‘the reproduction not contrary to the legitimate interests of the author’. With the ‘unreasonable prejudice’ element, however, the legitimate interests are almost by definition legal interests.

This leaves open one key question: what does ‘unreasonable prejudice’ mean? Clearly, the word ‘unreasonable’ indicates that some level or degree of prejudice is justified. For example, while a country might exempt the making of a small number of private copies entirely, it may be required to impose a compensation scheme, such as a levy, when the prejudice level becomes unjustified. To buttress this view, the French version of the Berne Convention, which governs in case of a discrepancy, uses the expression ‘*préjudice injustifié*’, which one would translate literally as ‘unjustified prejudice’. The Convention translators opted instead for ‘not unreasonable’. The inclusion of a reasonableness/justifiability criterion would allow legislators to establish a balance between, on the one hand, the rights of authors and other copyright holders and the needs and interests of users, on the other. This seems even clearer when the French term (‘unjustified’) is used. In other words, there must be a public interest justification to limit copyright.

In that vein, the WTO panel concluded that ‘prejudice to the legitimate interests of right holders reaches an unreasonable level if an exception or limitation causes or has the potential to cause an unreasonable loss of income to the copyright owner’. A public interest imperative may lead a government to impose an exception to copyright that may translate into a loss of revenue for copyright holders. It can nonetheless be ‘justified’.

By focusing on economic harm, the panel may have considerably expanded the scope of some exceptions: it is not the fact that a user obtains some value that is determinative, but rather the fact that a rightsholder can show that it stands to lose actual value (revenue) – the ‘prejudice’. Exceptions to copyright are seen through a trade-related effects-based prism.

II.B.4 European 'InfoSoc' Directive

The European Union's Information Society ('InfoSoc') Directive¹⁸ contains two sets of exceptions. The first, and only mandatory, exception is for transient copies 'forming an integral and essential part of a technological process'.¹⁹ Otherwise, the Directive contains an exhaustive list of permitted exceptions (i.e., exceptions that EU Member States may choose to use in their national copyright legislation). These are all purpose-specific exceptions. There is no set of criteria comparable to the US fair use doctrine.

However, the preamble to this Directive, which serves as a guideline for the interpretation of the operative part of the text, refers to permitting 'exceptions or limitations in the public interest for the purpose of education and teaching' and to the need to safeguard a 'fair balance of rights and interests between the different categories of rights holders, as well as between the different categories of rights holders and users' through exceptions and limitations, which 'have to be reassessed in the light of the new electronic environment'. Otherwise, the Directive refers to the three-step test as an overarching test for all permitted exceptions. Article 5(5) reads:

The exceptions and limitations provided for in paragraphs 1, 2, 3 and 4 shall only be applied in certain special cases which do not conflict with a normal exploitation of the work or other subject matter and do not unreasonably prejudice the legitimate interests of the right holder.²⁰

Interestingly, the reference to the test is seen as a 'guiding principle' rather than a means to effectively harmonize exceptions in the national laws of the 25 EU Member States. Indeed, at the level of national laws, the three-step test could be refined by enumerating certain specific cases, or by providing additional guidance on the interpretation of the three steps. It remains a flexible test which could, however, be used by courts in cases where no such specific exception exists, if allowed to do so under domestic law.

II.C EXCLUSION OF MORAL RIGHTS

Article 9 of the TRIPS Agreement incorporates most of the substantive provisions of the Berne Convention (Paris Act, 1971) administered by the World Intellectual Property Organization (WIPO) into TRIPS, though it also states that WTO 'Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6bis of that Convention or of the rights derived

18. Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society. OJ L 167/10, 22 June 2001).

19. *Id.*, Art. 5(1).

20. *Id.*

therefrom'. In other words, the moral right to claim authorship (or to remain anonymous) and the right to 'object to any distortion, mutilation or other modification of, or other derogatory action in relation to [a protected] work, which would be prejudicial to [the author's] honour or reputation' are excluded from TRIPS.

By excluding moral rights the TRIPS Agreement split the copyright coin. One can adhere to a rather simplistic notion of moral rights (as implemented in common law jurisdictions) as a foreign, Continental, Kantian concept imposed on reluctant common law countries. Or one might see moral rights as forming a part of common law copyright – at least with respect to the right to claim authorship and the right to prevent first publication, which may conceptually be linked to a reputation-based right such as the right to oppose a mutilation of a creative work. In either case, it seems fair to conclude that by removing the non-economic component from its normative framework, TRIPS has weakened the intrinsic equilibrium of copyright and, hence, the 'power to convince', rooted in natural law, which copyright had traditionally enjoyed. In other words, copyright is seen as a purely statutory entitlement enforced through trade rules, one set of rights among many others, one designed to allow for limited market control.

Human rights and intellectual property were natural law cousins owing to their shared filiation with equity. Market optimization is not part of that family. Consequently, the policy debate has become not one of fairness to authors but rather of how much money it is fair for those companies (not authors) to make. This may explain part of the resistance of various user groups to copyright rules and their insistence that music or videos are too expensive, and the related, if generally intuitive, perception that copyright works are public goods.

Because copyright claims were transplanted in the soil of trade, natural rights-based views – and with them many of the perceived fairness – of copyright are no longer convincing. For user groups and developing countries implementing TRIPS and TRIPS Plus rules, it has become a numbers game, not one where players can defend a position strictly based on the propertization of creative works.

Nor can ethics guide us in a context of aggressive commercial exploitation: 'because of the breakdown of traditional social structure or matrix of social practices within which ethical questions have either been resolved or lack a motivation'.²¹ In fact, social norms may be moving away from the industry control rhetoric and may give rise to other compensation.²² The social norms do not reflect an understanding of downloading as *malum in se*, as a natural rights justification would suggest, but rather as an (sometimes annoying) *malum prohibitum*, and a prohibition that should be revisited (if not the norm itself then the way it is used and enforced). The lower level of internalization of the rule means that a higher degree of technical control or legal enforcement is required, i.e., exactly what can be observed in the marketplace.

21. M. Alfino, (year, etc.), 'Intellectual Property and Copyright Ethics', <<http://guweb2.gonzaga.edu/faculty/alfino/dossier/Papers/COPYRIGH.htm>> (last accessed 29 November 2007), 10.

22. D. Gervais, 'The Price of Social Norms: Towards A Liability Regime for File-Sharing', *J. Intell. Prop. L.* 12 (2004): 39.

Perhaps some forms of intellectual property that trace their origins to natural law can make claims to human rights status on that basis. It will not be at a greatly detailed level.²³ Yet, quite independently of where one draws the line of what constitutes a human right, the fact that trade rules do not qualify as human rights is beyond cavil. There is a cost to be paid in choosing trade. To use rather loosely a Rawlsian analytical framework, one loses deontological pull. Perhaps this can be tied to the loosening of social norms concerning use of copyright material.

Put differently, the trade link and the pragmatic nature of trade rules, and their enforcement in the GATT/WTO context, have forced copyright holders to find a new exposition of the principles according to which their investment should be protected, in what circumstances and to what extent. Term, scope (or rights and exceptions) and rights management are all on the Holmesian table set by the incorporation of copyright in trade. 'This is the age of the finance minister. . . . The game of nations is now geo-monopoly.'²⁴ Copyright policy is not, or no longer, an exception. Whether that is for the best remains to be seen.

III. COPYRIGHT'S INTERNAL BALANCE IN THE MIRROR OF HUMAN RIGHTS

Especially since it has jettisoned its property/natural law lineage by moving to the trade domain, the ship of copyright policy is anchored more than ever in utilitarian waters. Economic analysis is the sextant that can ensure that it avoids the Charybdis of rent-seeking and the Scylla of free-riding. A unified theory of copyright to navigate those shoals, one that applies to paintings, academic books, Harry Potter, Radiohead and Windows Vista might seem somewhat murky to the purist. But, after all, this is the world of trade law, one in which bananas have been traded for educational services.

The point of this Part is not to challenge the search for a justificatory theory.²⁵ Rather, in seeming contradistinction with Part I, it challenges the assumption that economic analysis must be the only toolbox and suggests that a cogent copyright theory can be based at least in part on a human rights analysis. It may also provide a more solid foundation because 'in generating rights to intellectual property

23. Costas Douzinas, *The End of Human Rights* (2000), at 7.

24. Thomas L. Friedman, quoted in John H. Jackson, *The World Trading System: Law and Policy of International Economic Relations* (MIT Press, 2nd ed., 1997) 4.

25. Indeed, it may very well that a federation of theories is a better outcome, one that recognizes the characteristics of each type of work. That being said, the search for a theory may reveal with greater clarity the policy purpose of copyright and inform courts in (necessarily) case-by-case determinations. For example, a proper theoretical grounding might allow a court better to craft the proper scope of fair dealing or fair use in terms of societal outcomes: if fair use and fair dealing are designed to allow uses that maximize social welfare while not impeding normal commercial exploitation, a limit reminiscent of the omnipresent three-step test, then surely parody and transformative reuses should be allowed.

on utilitarian grounds we are left with something decidedly less than what we typically mean when we say someone has a right'.²⁶

Copyright could be defended on one of two bases as a human right. First, because it is seen as property, and property in turn seen as a human right. This debate, as mentioned in the introduction, is beyond the reach of this chapter, though I mention it briefly below.²⁷ Additionally, there are questions as to whether that human right protection of property extends to *private* property.²⁸ Even if one believes that internationally protected human rights include private property rights, the extent to which policy outcomes may be derived from such a finding is limited. For that reason, the issue is better left aside.

The other human right basis for copyright is fact that, as René Cassin noted, 'Human beings can claim rights by the fact of their creation.'²⁹ The thesis explored in this part is thus that copyright should embrace the challenges posed by its deepening linkages with human rights and affirm its own (credible) justifications in human rights theory based on the creativity of authors and the universal cultural resonance of that role. In doing so, copyright might serve to show that intellectual property and human rights may indeed live together. This part also suggests that human rights principles and analogies are able to provide normative boundaries to the age-old quest for intrinsic equilibrium in copyright policy: the protection of interests resulting from expressed creativity, on the one hand, and the right to enjoy and share the arts and scientific advancement. In Part IV, I will suggest that this analysis can inform the newer, extrinsic equilibria that are emerging in the world of intellectual property, namely the normative balance between intellectual property rights, on the hand, and other rights such as privacy and consumer protection, on the other.

The purpose of this exercise is not to dethrone economic analysis. After all, now that intellectual property has entered the house of trade law, it may not be possible to do so. Yet, in the very spirit of law and economics, it may be useful to question the *monopoly* of economic analysis on the theoretical discourse surrounding the foundations and evolution of copyright policy.

Article 27 UDHR, which saw the light of day 238 years after the *Statute of Anne*, is an interesting mirror for copyright's sleeping beauty, namely a solid justificatory theory beyond the practicalities of trade. Article 27 protects *both* the right to the protection of the moral and material interests resulting from and scientific, literary or artistic production of which he is the author *and* users' right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits. The objective of protection

26. Adam D. Moore, *Intellectual Property & Information Control* (Transaction Publishers, 2001), 104.

27. See notes 43–44 and accompanying text.

28. Many non-Western legal systems recognize collective property in certain intangible creations. See D. Gervais, 'Spiritual but Not Intellectual? The Protection of Sacred Intangible Traditional Knowledge', *Cardozo J. of Int'l & Comp. Law* 11 (2003): 467–495.

29. Quoted in M. Vivant, *loc. cit.* at 86.

embraces at least indirectly the moral desert theory (protection of interests resulting from scientific, literary or artistic production), while the objective of access is expressed teleologically as a tool to allow everyone to enjoy the arts and to share in scientific advancement and its benefits. By giving a purpose to exceptions, human rights may both serve as guidance to courts³⁰ and compensate for the excessively economic focus of trade law, as embodied in particular in the three-step test interpreted by a trade body, namely the WTO Dispute-Settlement Body.³¹ It is interesting to recall François Dessemontet's words: '[T]he Universal Declaration and the UN Covenant [on Economic, Social and Cultural Rights adopted on 16 December 1966] mark the apex of the French vision of literary and artistic property, as opposed to the Anglo-American "mercantilist" view as ensconced in the TRIPS.'³²

Indeed, human rights may compensate for an evolution (of copyright policy) that has not always been well thought through. As Peter Drahos aptly noted, 'The development of intellectual property policy and law has been dominated by an epistemic community comprised largely of technically minded lawyers. In their hands intellectual property has grown into highly differentiated and complex system of rules. The development of these systems has been influenced in important ways by the narrow and often unarticulated professional values of this particular group.'³³

Human rights approaches bring *values* back to the system. The emphasis on culture in human rights instruments, allow one, for example, to acknowledge the limits of economic analysis and theory as a policy-making machine. As Professor Julie Cohen suggests, we need a substantive balance which 'concerns the ways in which copyright's goal of creating economic fixity must accommodate its mission to foster cultural play. Economic analysis can help us to understand some of the considerations relevant to the balance between economic fixity and cultural mobility, but both valuation and incommensurability problems prevent a comprehensive summing of the relevant costs and benefits. Modelling the benefits of artistic and intellectual flux is hard to do'.³⁴ The copyright's 'mission to foster cultural play' may be read against the backdrop of Articles 27(1) UDHR and 15 of the Covenant, which enshrine the right to participate in cultural life. 'Cultural life must be

30. D. Gervais, 'The Role of International Treaties in the Interpretation of Canadian Intellectual Property Statutes', in *The Globalized Rule of Law: Relationships between International and Domestic Law*. ed. O. Fitzgerald (Irwin Law, 2006), 549–572.

31. United States – Section 110(5) of the US Copyright Act, Document WTR/DS/160/R (WTO Dispute Settlement Panel, 2000). See Jane C. Ginsburg, 'Toward Supranational Copyright Law? The WTO Panel Decision and the "Three Step Test" for Copyright Exemptions', *Revue internationale du droit d'auteur* (RIDA)187 (2001): 3.

32. F. Dessemontet, 'Copyright and Human Rights', in *Intellectual Property and Information Law*, Jan J.C. Kabel (Kluwer Law, 1998), 113 at 114.

33. Peter Drahos, 'The Universality of Intellectual Property Rights: Origins and Development', text of presentation at WIPO (November 1998). Available at <www.wipo.int/tk/en/hr/paneldiscussion/papers/pdf/drahos.pdf>, (last accessed 19 April 2008).

34. Julie Cohen, 'Creativity and Culture in Copyright Theory', *U.C. Davis Law Review* 40 (2007): 1151, 1196.

regarded as a benefit to which every member of the community is entitled. Culture must not be viewed as an esoteric activity of a superior social elite.³⁵

Economic analysis is both useful and necessary, and follows quite naturally from the shift to trade, but any complete analysis must be informed by broader, less tangible (and measurable) considerations. From copyright's viewpoint, culture is a two-way street: it provides the essential substratum upon which all creators draw to create, and their creations in turn feed and grow the culture. The phenomenon has taken on an additional layer of complexity with the globalization of Web culture, but a lot of cultural resonance remains local. 'Individual creators begin with situatedness and work through culture to arrive at the unexpected.'³⁶

Copyright and culture need new works to be created, though for different reasons (the former to justify its existence, the latter to grow), and to be created those new works need existing works. Conceptually, this can be framed as a 'freedom to create', which, to a certain extent at least, is the freedom to copy. Whether *copying* constitutes copyright *infringement* is a matter of degree. Professor Dessemontet suggested a list of factors to be taken into account: (a) whether the work copied from fades away in the new work; (b) whether the first work is recognizable and the degree to which it is; and (c) the proportionality of 'newness' (presumably assessed quantitatively but also, and perhaps mostly, qualitatively) to the amount that is borrowed.³⁷

How can one reconcile human rights and natural law, the new and old sources of legitimacy for intellectual property? Is the question whether copyright is an instrument for stimulating creativity or a property-like Lockean protection against the illicit appropriation of the work done and the investment made? Not quite. Let us remember that John Locke did not advocate a particular model for copyright.³⁸ He believed, to summarize his thought in a few words, that nothing in nature permitted the granting of a particular property right to a particular person. According to Locke, divine power imposed moral duties on each individual that could be discerned by reason, and this was what should guide the work of judges. Those duties are, in general, reciprocal: what I owe to others, they owe to me in return. Locke placed these duties in two categories: those dealing with liberty and those giving the right to make claims. One of the four great duties he describes was the duty not to impede others from profiting from what they have created or adapted from the public domain through their own efforts.³⁹ In other words, translated in Pareto-optimal terminology, the 'underlying rationale of Locke's proviso is that if no one's situation is worsened, then no one can complain about another

35. Yoram Dinstejn, 'Cultural Rights', *Israel Yearbook on Human Rights* 9 (1979): 58, 76.

36. Julie Cohen, *loc. cit.*, at 1183.

37. F. Dessemontet, *loc. cit.* at 119–120.

38. Wendy Gordon, 'A Property Right in Self-Expression: Equality and Individualism in the Natural Law of Intellectual Property', *Yale L.J.* 102 (1993): 1533. To return to the source, see *John Locke*, ed. Peter Laslett (Cambridge Univ. Press, 2nd ed., 1967), 269–278 (vol. II, paras 4–15).

39. Wendy Gordon, *loc. cit.*, 1542–1543.

individual appropriating part of the commons'.⁴⁰ That is the premise used to justify copyright: a new work after all is created from the 'public domain' – therefore from ideas and existing works. The rights are derived from intellectual efforts by sovereign moral agents warranting non-interference claims.⁴¹ This is indeed close to the rights flowing from the creative process recognized in international human rights instruments.

Natural law, as described by Locke, thus offers an interesting perspective, one that *can* be reconciled with an exegesis of Article 27 UDHR and Article 15 of the Covenant, and more recent instruments discussed by Professor Torremans, Professor Yu and Professor Helfer in their respective chapters. Human rights can, first and foremost, restore a degree of authorial dignity to copyright. '[H]uman beings have fundamental interests, which should not be sacrificed for public benefit, and . . . society's well-being does not override those interests. Protecting those interests is deemed vital for maintaining individual autonomy, independence, and security.'⁴²

Protection of copyright in human rights framework can also be sourced in the continuum between an author and her creation. That is the basis in French and German doctrine,⁴³ for the moral right. It is essential to note, however, that this unbreakable link does not justify a perpetual *property* right or right to exclude economic use. The fact that works fall into the public domain has consistently formed part of the human rights discourse concerning authors' rights since 1948.⁴⁴ True, it has been critiqued as a Western conception of authorship, rooted in individually authored, well-identified creations. However, I would argue that the relevant human rights instruments do not embody this limited conception and could be extended to cover other forms of creation, thus adapting the extant intellectual framework to collective or traditional creations and inventions.⁴⁵

I am not suggesting staking a vague claim to specific rights on dignity, but refocusing the policy efforts to operationalize the (supposed) value attached to creation in the traditional conceptual edifice of copyright, recognizing that copyright works (arguably with the huge exception of software)⁴⁶ have special status because of their cultural resonance.

40. A.M. Moore, *loc. cit.*, 109.

41. *Id.*, 108.

42. Orit Fischman Afori, 'Human Rights and Copyright: The Introduction of Natural Law Considerations into American Copyright Law', *Fordham Intell. Prop. Media & Entertainment L.J.* 14 (2004): 497, 499.

43. I. Kant, *Metaphysics of Morals, Doctrine of Right*, (Cambridge Univ. Press, 1996), § 31, II; G.W.F. Hegel, *Elements of the Philosophy of Right*, (Cambridge Univ. Press, 1991), §§ 43 and 69.

44. M. Vivant, *loc. cit.*, 91–92.

45. See Silke von Lewinski. *Indigenous Heritage and Intellectual Property*. (Kluwer, 2003); and WIPO *Draft Provisions on Traditional Cultural Expressions/Folklore and Traditional Knowledge*, document. WIPO/GRTKF/INF/1, available at <www.wipo.int/tk/en/consultations/draft_provisions/draft_provisions.html>, (last accessed 19 April 2008).

46. It was decided, first by the courts and then by many legislative bodies, that computer software should be considered literary works, an international consensus now reflected in Art. 10.1 of the

Put differently, the trade-economic approach refocused copyright on the industries that produce and distribute copyright content. From a purely policy-oriented perspective, this ‘de-centering’ of copyright away from creators reduces the moral imperative of users, whose sympathy for large distribution multinationals (assuming for the sake of this discussion that this is a widespread perception of how the music and film industry are structured) is far from infinite. Conversely, copyright perceived as a right vested in and benefiting creators may have a different resonance, as the relative success of examples of ‘pay as much as you feel this is worth’ models tend to show. Industries which were quick to instrumentalize authors in the eighteenth century, with some benefit to creators, have lost much in moving to the trade arena and sidelining creators. Phenomenologically, this was greatly reinforced by the introduction in international treaties and now many national laws of protection of Technological Protection Measures (TPMs), the use and/or circumvention of which is illegal in most cases independently of the underlying copyright. TPMs are rarely used by creators. It is an industrial tool, and its protection is generally viewed as such, thus further diminishing the perceived legitimacy of the copyright system.

Human rights, in providing a teleological framework for exceptions, can also guide courts⁴⁷ in interpreting whether a particular use should be covered by an exception whose interpretation is unclear, and policy makers in designing new exceptions. One might think this impossible owing to the presence of three-step test straitjacket. However, the third step was interpreted as allowing public interest considerations (i.e., what constitutes an allowable ‘justification’ for the exception), and human rights principles might thus inform the determination of the proper scope of exceptions. In that respect, the UDHR in particular would allow exceptions that demonstrably augment access where such access (enjoyment) is not commercially reasonable or possible, and the right to reuse and thereby participate in the cultural life of the community. This seems to justify both consumptive use exceptions where commercial access is undesirable or impracticable, including exceptions such as those contained in the Appendix to the Berne Convention for access in developing countries, and exceptions for transformative uses (such as but not limited to parody), the principal element of the United States fair use doctrine.⁴⁸

TRIPS Agreement. The entry of software in the house of copyright was to have major practical repercussions, but one must acknowledge that the conceptual shock was enormous, since it brought into the copyright family works created without any claim to artistic or aesthetic merit but rather on a purely functional basis. Another conceptual leap caused by the admission en masse of software was that the work being protected (i.e., the code) was not designed to be perceived by anyone. Its role was to make a computer function.

47. As was done, e.g., by French courts. See JDI 1989, 1005 note Edelman; (1989) 143 RIDA 301, note Sirinelli).
48. Except, arguably, between *Sony Corp. of America v. Universal City Studios, Inc.*, 464 U.S. 417 (1984) and *Metro-Goldwyn-Mayer Studios Inc. v. Grokster, Ltd.*, 125 S. Ct. 2764 (2005). Sony was interpreted (wrongly in my view) as deciding broadly that private use was fair use (in fact, it says that some forms of time-shifting copying may be fair use). In *Grokster*, the Supreme Court

The UDHR reference to moral and material interests is also fully consistent with the coin of traditional copyright, with its economic side and its moral side. Copyright and human rights can indeed live together and learn from one another.⁴⁹

IV. INTELLECTUAL PROPERTY AND HUMAN RIGHTS: THE NEW CONFLICTS

A copyright holder who invades users' hard disks to search for unauthorized copies of music may run afoul of privacy laws, as the Sony RootKit case demonstrates.⁵⁰ Yet copies of copyright content available for download will increasingly include codes to identify the purchaser of that copy, a tool to be used in case that copy is later found circulating on the Internet. This information, whether expressed as full name, as a code or in the form of a hash or watermark, is protected by the WCT (WIPO Copyright Treaty 1996) and WPPT (WIPO Performances and Phonograms Treaty 1996), (and national implementations thereof), and cannot be removed or altered knowingly for the purpose of facilitating an infringement.

Patents are rights to prohibit even in the absence of a viable market. Would a refuse to make available a patented product constitute only a potential abuse of patent rights or is it also or instead a violation of human rights? Here, denial of patented pharmaceuticals to patients who cannot afford them, when they, or their government, could afford those products at a generic rate (that is, without patent rent) is confronted with the right to health and security. These are the new kinds of battles that are starting to emerge in our courts and in international discussions, in the WTO and elsewhere.

Copyright can live with human rights, and indeed reinforce its justification in human rights, but only if we can move the discourse away from property-based rhetoric, and treating any unpaid use as piracy. By moving away from property, whether as a human right or as an economic tool, copyright can transcend this debate and find a new, balanced justification based on a human rights framework in which protection and access are seen as *complementary* objectives. The recognition that copyright is not 'ordinary' property led some scholars to argue that copyright was a 'hybrid property right'⁵¹ or a 'transmuted right'.⁵² There is a point where this type of debate may no longer provide a solid foundation for a justificatory theory for

arguably went back to traditional fair use jurisprudence and focused on transformative – instead of purely consumptive – uses.

49. It has also been suggested that copyright could be used as a model for human rights (i.e., the reverse analogical process). See John R. Morss & Mirko Bagaric, 'Human Rights as Copyrights: A Third Way in Human Rights Discourse', *U. Balt. Intell. Prop. J.*, 13 (2005):103.
50. Mark H. Lyon, 'Technical Protection Measures for Digital Audio and Video: Learning from the Failure of Audio Compact Disc Protection', *Santa Clara Computer & High Tech. L.J.* 23 (2007): 643, 650–658.
51. C. Colombet, *Propriété littéraire et artistique et droits voisins.*, (Paris: Dalloz, 6th ed.,1992), § 20.
52. M. Vivant, *loc. cit.*, at 84.

copyright that can withstand the need for detailed policy scrutiny and normative confrontations with other rights. From this perspective, the pragmatism of the three-step-test, infused with the human rights inspired purposive approach to exceptions and limitations, could thus be seen as a significant step forward.

Can the same be said of patents? The battles with AIDS and public health activists advocating flexibility on behalf of developing countries has left scars on pharmaceutical companies, and impressions on public opinion. Their claims are based on the right to health and security, but also to the more controversial right to development.⁵³ Clearly, fighting not only human rights but spokespersons such as *Doctors without Borders* and Nelson Mandela against a backdrop of dying children to defend a 'trade-related' right is a difficult public relations battle, one which should never have been waged. An ethical, human rights approach to public health dictates limits on patent rights when no market is possible. No one is forcing patent holders to produce at or below cost.

At its most basic level, the argument is as follows: when the patent holder cannot reasonably hope to have a significant market in a territory for a product that has life-saving potential, there is no legitimate reason to prevent access to that product if someone (a public or private entity) is willing to produce it at a cost that the country can afford. There are legitimate concerns on the part of patent holders about re-exportation, and those should be adequately addressed. It can be done, as the solution adopted by the World Trade Organization demonstrates.

It must be stressed that the problem of HIV infection and other severe diseases affecting least-developed countries does not lie entirely with patents, far from it. In several African countries where patent protection would be available, antiretroviral drugs are not patented. Many others have until 2016 to adopt pharmaceutical patent protection under WTO rules. Problems often lie elsewhere, such as in the absence of a capacity of production and the lack of distribution networks. The latter can be solved, though with colossal efforts, by setting up distribution mechanisms, local clinics, etc. Concerns about interrupted treatments and the possible emergence of more aggressive viruses must be taken seriously. The former problem required another series of solutions. One could reasonably suggest building public laboratories to produce antiretroviral, anti-malarial or other drugs in each and every country where such products are needed. At the same time, no compulsory license could be issued predominantly for export under TRIPS Article 31 rules. This explains why this prohibition was waived, subject to a number of conditions in the new Article 31bis, which, though it has yet not entered into force, was already effected by a WTO Decision in 2003.

The ripple effect of the clash with human rights is far from over. The World Health Organization, for example, has actively entered the field and broadened the

53. Ruth Okediji, 'The Limits of Development Strategies at the Intersection of Intellectual Property and Human Rights', in *Intellectual Property, Trade and Development*, ed. D. Gervais (Oxford U.P., 2007), 355–384; and Robert J. Gutowski, 'The Marriage of Intellectual Property and International Trade in the TRIPS Agreement: Strange Bedfellows or a Match Made in Heaven?', *Buff. L. Rev.* 47 (1999): 713, 715.

discussion to the entire financing of pharmaceutical research, questioning the predominance of private, profit-driven enterprises. There is indeed an enormous amount of publicly-funded research both in the United States (e.g., the National Institutes of Health) and elsewhere, including in hundreds of universities worldwide. The recalcitrance of the pharmaceutical industry truly to engage may not be an optimal strategy.

Human rights could also have a direct impact on the WTO itself. The WTO Appellate Body found that the WTO Agreement is ‘is not to be read in clinical isolation from public international law’.⁵⁴ This principle was reflected in this and subsequent decision, which relied on the case law of other international tribunals, namely the International Court of Justice, the European Court of Human Rights cases and the Inter-American Court of Human Rights, in interpreting the provisions of the WTO Agreement.⁵⁵ This could of course extend to TRIPS.

Naturally, in fields of industrial activity other than pharmaceuticals affected by patents, effects would differ because the right to health would not be implicated, though there may well be developmental impacts and more diffused calls for technology transfers, deeper disclosure of working methods, and abuse issues where no supply of the domestic market is present.

Independently of the ethical considerations, human rights may play a normative role in re-scoping intellectual property rights. There is significant opposition to this trend. Part of the international pharmaceutical industry believes there is nothing to be gained by engaging deeply on the human rights terrain. The United States Administration seems to agree. Some of those provisions may form part of and thus be multilateralized by the Anti-Counterfeiting Trade Agreement (ACTA) imitative,⁵⁶ a new TRIPS-Plus Treaty that could curtail flexibilities contained in TRIPS and the ‘normative elasticity’ that could be interpreted in accordance with human rights principles by a WTO panel or the Appellate Body. Similar provisions exist in a number of recent free trade agreements concluded by the United States. The question that remains is whether the tension that exists between patents and human rights can be effectively bottled up that way. Trade is indeed king in international relations, and the strategy may well succeed, though at what cost it is hard to say. If successful, the strategy will show that moving intellectual property to the trade realm was the ‘right’ solution to obtain and defend maximum protection. Whether the result is ethically optimal is an entirely different question.

54. *US – Standards for Reformulated and Conventional Gasoline*, WTO doc. WT/DS2/AB/R, para. III. B (Appellate Body, 1996).

55. *Id.*, n. 36; and *Japan – Taxes on Alcoholic Beverages*, document WT/DS8/AB/R, part D, n. 19 Appellate Body, 1996).

56. ‘Ambassador Schwab Announces US Will Seek New Trade Agreement to Fight Fakes’ (Oct. 2007), available at <www.ustr.gov/Document_Library/Press_Releases/2007/October/Ambassador_Schwab_Announces_US_Will_Seek_New_Trade_Agreement_to_Fight_Fakes.html>, (last accessed 19 April 2008). Now supported by the European Union, see <ec.europa.eu/trade/issues/sectoral/intell_property.fs231c07_en.htm> (last accessed 19 April 2008).

V. CONCLUSION

Part II of this chapter explored the noble lineage of intellectual property back to its natural law origins, and how one important group of rightsholders were abandoned when they put all their policy eggs in the trade basket. It did so to obtain multi-lateral concessions that would likely not have been possible absent intersectoral bargaining. It incorporated all existing intellectual property norms into trade rules, and a test, based on economic effects, was used as a filter for almost all exceptions to patent and copyright rights. By doing so, however, intellectual property holders left behind some of the doctrinal armour that could support its normative clashes with human rights. The move to trade also signifies a less persuasive reliance on property rhetoric, independently of whether property is seen as a human right.

Part III suggested that copyright can reclaim its lost heritage, or develop a new one in keeping with its purpose of defending authorial dignity, by embracing the internal balance between protection of interests following from the production of new copyright works and the need to ensure adequate access and reuse of such works, especially in the absence of reasonable market conditions. In fact, the traditional balance between exclusive rights, on the one hand, and limitations and exceptions on the other, mirrors this dual objective of human rights legislation. In spite of occasional conflicts with free expression, for example, copyright and human rights share broadly similar objectives. This may not be true, however, of newer rights such as the protection of TPMs and Rights Management Information, which pull copyright policy further away from creators and may clash with privacy rights.

Part IV explored whether a similarly harmonious solution may exist for extrinsic conflicts, those that do not affect the internal balance of intellectual property (between protection and exceptions) but where exclusive protection clashes with a different set of norms. Courts may be able to address TPM or RMI (Rights Management Information), uses that infringe privacy, though the absence of a single set of privacy norms may lead to a variable geometry of national solutions. Patents on pharmaceuticals seem a harder case. In spite of agreeing to a solution in the WTO to allow compulsory licensing for export under strict conditions, important parts of the pharmaceutical industry are still trying to limit the use of export licenses. The great reluctance of the industry truly to engage has had several effects, including a significant involvement by the World Health Organization. The response of the industry and the United States Government thus far, as illustrated by free trade agreements and recent multilateral efforts outside of WTO and WIPO (World Intellectual Property Organisation), points to additional trade-enforced restrictions on existing flexibilities that would be successful in maintaining maximum protection and limiting access to products to sold by the patent holder, but at a potentially high human and ethical cost. This seems like suboptimal cohabitation.

Copyright can be recast as freedom to express oneself, to create, a (potentially perpetual) right (derived from the act of creation and authorial dignity) to be identified as the author (individual or collective) of a creation, and a limited economic entitlement to benefit materially from such creation. It is balanced against

the freedom to participate in cultural life and rights to access information, to protect one's privacy and other such rights. Thus a human rights framework can provide specific normative guidance in the elaboration and interpretation of copyright rules. This reasoning may be extended, though it has not traditionally been, to patents and other intellectual property rights, which, like copyright, are in search of a normative anchor as a result of moving into the trade realm and abandoning a (not very useful except as rhetorical tool) property status.

Chapter 2

The New Innovation Frontier? Intellectual Property and the European Court of Human Rights

*Laurence R. Helfer**

I. INTRODUCTION

In Europe, human rights law is intellectual property's new frontier. This statement will no doubt surprise many observers of the region's intellectual property system, which has steadily expanded over the last few decades. The mechanisms of that expansion have included a litany of now familiar legal and regulatory tools – the negotiation and ratification of multilateral agreements, the promulgation of European Community (EC) directives, the rulings of the powerful European Court of Justice, and the revision of national laws and administrative regulations. The result of these cumulative and interrelated initiatives is a highly developed intellectual property system that is strongly protective of creators, innovators, and businesses.

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This regional intellectual property regime has developed in relative isolation from Europe's other judicial powerhouse, the European Court of Human Rights (ECHR or Court).¹ The ECHR began its existence modestly as an optional judicial review mechanism for European states that had ratified the Convention for the Protection of Human Rights and Fundamental Freedoms² (European Convention or Convention) and its Protocols. But in the half century since its creation, the ECHR has evolved into something far more momentous – the judicial guardian of a ‘constitutional instrument of European public order’.³ The Court now reviews tens of thousands of complaints each year, and its jurisdiction extends the length and breadth of the continent, encompassing 800 million people in forty-seven nations from Azerbaijan to Iceland and from Portugal to Russia.⁴

One might reasonably ask what an international human rights court and the human rights treaty it interprets has to do with intellectual property. The answer is the right of property, which appears in the European Convention together with more widely recognized civil and political liberties such as the prohibitions of slavery and torture, due process rights, and freedom of expression. Yet the protection of ‘the peaceful enjoyment of . . . possessions’ in Article 1 of Protocol 1 (Article 1)⁵ has long been considered among the weakest rights in the Convention

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1. For a detailed discussion of the ECHR's success and its influence on other international tribunals, see Laurence R. Helfer and Anne-Marie Slaughter, ‘Why States Create International Tribunals: A Response to Professors Posner and Yoo’, *Cal. L. Rev.* 93 (2005): 899, 917–922; Laurence R. Helfer, ‘Adjudicating Copyright Claims Under the TRIPs Agreement: The Case for a European Human Rights Analogy’, *Harv. Int'l L.J.* 39 (1998): 357, 399–410 [hereinafter Helfer, ‘Adjudicating Copyright Claims’]; Laurence R. Helfer & Anne-Marie Slaughter, ‘Toward a Theory of Effective Supranational Adjudication’, *Yale L.J.* 107 (1997): 273, 297–298.
 2. Convention for the Protection of Human Rights and Fundamental Freedoms, 4 November 1950, 213 U.N.T.S. 222 [hereinafter European Convention].
 3. *Loizidou v. Turkey*, App. No. 15318/89, 310 Eur. Ct. H.R. (ser. A) at 27 (1995) (preliminary objections).
 4. See ECHR, Survey of Activities 2006, <www.echr.coe.int/NR/rdonlyres/69564084-9825-430B-9150-A9137DD22737/0/Survey_2006.pdf>.
 5. Art. 1 of Protocol 1 states in its entirety:

Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law.

The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties.

Protocol to the Convention for the Protection of Human Rights and Fundamental Freedoms, Art. 1, 20 March 1952, 213 U.N.T.S. 262, [hereinafter Protocol 1]. Although the drafters of Art. 1 ‘spoke of “right of property” or “right to property” to describe the subject-matter’ protected by this clause, *Marckx v. Belgium*, App. No. 6833/74, 31 Eur. Ct. H.R. (ser. A), para. 63 (1979), the ECHR has consistently described this provision as guaranteeing the right of property. See, e.g., *Hutten-Czapska v. Poland*, App. No. 35014/97, 45 Eur. H.R. Rep. 4 [52], 129 (Grand Chamber 2007) (judgment of 19 June 2006) (holding that government had ‘failed to strike the requisite fair balance between the general interests of the community and the protection of the *right of property*’ (emphasis added)). (Due to a change in 2000, recent volumes of the European Human

system, affording governments broad discretion to regulate private property in the public interest.⁶

Partly for this reason, the ECHR and the European Commission of Human Rights (European Commission or Commission) for decades gave intellectual property issues a wide berth. Intellectual property claimants did not file any complaints alleging violations of property rights until the early 1990s. And when these claimants did allege such violations, the ECHR and the European Commission summarily dismissed their challenges. Applying a restrictive interpretation of Article 1, the two tribunals eschewed searching scrutiny of national courts and administrative agencies and allowed Europe's intellectual property system to evolve largely unfettered by human rights concerns.⁷

This judicial reticence has now decisively ended. Within the last three years, the ECHR has issued a trio of decisions holding that patents, trademarks, copyrights, and other economic interests in intangible knowledge goods are protected by the European Convention's right of property.⁸ The most recent of these rulings – a 2007 judgment of the Grand Chamber in *Anheuser-Busch Inc. v. Portugal* – is especially striking.⁹ The case involved a dispute between two corporations, the well-known American brewer and its longstanding Czech rival, Budějovický Budvar, over the exclusive right to market 'Budweiser' beer in Portugal. The ECHR concluded that both registered trademarks and applications to register such marks fall within the ambit of the treaty's property rights clause. On the particular facts presented, however, the Court found that the Portuguese government had not violated Article 1.¹⁰ Nevertheless, the analysis in *Anheuser-Busch*

Rights Report do not use standard citation formats for cases. For the reader's convenience, the Report's citation is given, along with the more traditional starting page number in brackets afterward.)

6. See Arjen van Rijn, 'Right to the Peaceful Enjoyment of One's Possessions', in *Theory and Practice of the European Convention on Human Rights*, eds Pieter van Dijk et al., 4th ed. (2006) 863, 864: '[T]he right of property has lost a good deal of its inviolability, also in the Member States of the Council of Europe, under the influence of modern social policy (*Sozialstaat*). This fact is reflected in the very far-reaching limitations which Art. 1 allows.'
7. See *infra* Part III (reviewing intellectual property rulings of the ECHR and the European Commission).
8. See *Dima v. Romania*, App. No. 58472/00, para. 87 (admissibility decision) (in French only; unofficial English translation on file with author) (copyrighted works protected by Art. 1); *Melnichuk v. Ukraine*, App. No. 28743/03, para. 8 (admissibility decision) (intellectual property protected by Art. 1); *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 44 Eur. H.R. Rep. 42 [846], 855–856 (Chamber 2007) (judgment of 11 October 2005) (registered trademarks protected by Art. 1).
9. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830] (Grand Chamber 2007).
10. The facts of the *Anheuser-Busch* case are complex. In essence, the ECHR concluded that Portugal had not interfered with the American brewer's application to register the trademark 'Budweiser' because the application had been contested by Budějovický Budvar, the owner of a previously registered geographical indication for 'Budweiser Bier'. For a more detailed analysis of the case, see *infra* Part III.A.

suggests that the ECHR recognizes the broader human rights implications of the region's innovation and creativity policies and that its future rulings may influence intellectual property protection standards in Europe.¹¹

From just this brief description, the Grand Chamber judgment in *Anheuser-Busch Inc. v. Portugal* may strike many observers as misguided in several respects. First, the decision protects the fundamental rights of multinational corporations rather than those of natural persons. For reasons I explain below, the ECHR's adjudication of property rights claims by business entities is indisputably authorized by Article 1's text and the intent of its drafters.¹² Such cases nevertheless sit uneasily with a treaty whose principal objective is to protect the civil and political liberties of individuals. This is particularly true given that serious or systemic violations of those liberties are occurring in many countries.¹³ In addition, with the accession to the Convention of Eastern European states in the 1990s, the ECHR's caseload has exploded. The result is a mountainous backlog of pending complaints.¹⁴ Adding intellectual property disputes to the Court's already vastly overburdened docket will only make it more difficult for the judges to adjudicate other complaints that allege violations of fundamental rights.

A second concern relates to the broader legal and political context in which the ECHR's recent intellectual property rulings are situated. The last several years

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11. Intellectual property owners have heralded *Anheuser-Busch* as a watershed ruling, suggesting that the case may trigger the filing of new complaints alleging violations of Art. 1. See, e.g., Burkhardt Goebel, 'Geographical Indications and Trademarks in Europe', *Trademark Rep.* 95 (2005): 1165, 1179 (describing the 2005 Chamber judgment as 'remarkable and most important' in recognizing trademarks 'as protected fundamental rights'); Arthur Rogers, 'Anheuser-Busch Hails European Court Ruling That Trademark Applications Get Protections', *Int'l Trade Rep.* 24 (2007): 72, 72 (characterizing the 2007 Grand Chamber judgment as a 'landmark' decision).
 12. See Protocol 1, *supra* n. 5, Art. 1 ('Every natural or legal person is entitled to the peaceful enjoyment of his possessions') (emphasis added). See also *infra* notes 23 and 178 and accompanying text (discussing the rationales for protecting the property rights of corporations and other business entities in the European human rights system).
 13. See, e.g., Eur. Parl. Assemb., 'Implementation of Judgments of the European Court of Human Rights: Supplementary Introductory Memorandum' (revised), AS/Jur (2005) 55 rev. (2005): 11–13, available at <http://assembly.coe.int/CommitteeDocs/2005/20051220_Ejdoc55.pdf> (assessing compliance with ECHR judgments involving widespread human rights abuses by the Russian military in Chechnya and massive structural failures of the Russian courts and the criminal justice system); Menno T. Kamminga, 'Is the European Convention on Human Rights Sufficiently Equipped to Cope with Gross and Systematic Violations?', *Neth. Q. Hum. Rts.* 12 (1994): 153, 153–54 (analyzing past cases and suggesting that there will be an increasing number of systemic human rights abuses challenged before the ECHR); Paul Mahoney, 'Speculating on the Future of the Reformed European Court of Human Rights', *Hum. Rts. L.J.* 20 (1999): 1, 4 (predicting that the ECHR will increasingly be confronted with 'serious human rights violations' such as 'minorities in conflict with [a] central government' and cases relating to 'terrorism, violence, and civil strife').
 14. Lucius Cafilisch, 'The Reform of the European Court of Human Rights: Protocol No. 14 and Beyond', *Hum. Rts. L. Rev.* 6 (2006): 403, 404 ('[T]he Court is presently confronted with an accumulated case-load of 82,600 applications, out of which 45,550 were made in 2005, the yearly capacity of absorption of the Court now being at around 28,000 cases.').

have seen an explosion of competing human rights claims relating to intellectual property – in Europe, in the United States, and in numerous international venues. There are two separate catalysts for these developments.

On the one hand, the expansion of intellectual property protection standards raises numerous human rights concerns relating to the right to life, health, food, privacy, freedom of expression, and enjoying the benefits of scientific progress. International experts, government officials, judges, and scholars are responding to these concerns by analyzing the interface between the two legal regimes¹⁵ and, in particular, whether human rights should serve as ‘corrective[s] when [intellectual property] rights are used excessively and contrary to their functions’.¹⁶ On the other hand, litigants, lawmakers, and courts are increasingly invoking fundamental rights – including the right of property – as a justification for *protecting* intellectual

15. See, e.g., U.N. Econ. & Soc. Council [ECOSOC], Comm. on Econ., Soc. & Cultural Rights, *Substantive Issues Arising in the Implementation of the International Covenant on Economic, Social and Cultural Rights: Human Rights and Intellectual Property*, U.N. Doc. E/C.12/2001/15 (14 December 2001) (analyzing conflicts between intellectual property and the International Covenant on Economic, Social, and Cultural Rights); The High Commissioner, *Report of the High Commissioner on the Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights, delivered to the Sub-Comm’n on the Promotion and Protection of Human Rights*, U.N. Doc. E/CN.4/Sub.2/2001/13 (27 June 2001); ECOSOC, Sub-Comm’n on the Promotion and Protection of Human Rights, *The Realization of Economic, Social and Cultural Rights*, at 3, U.N. Doc. E/CN.4/Sub.2/2000/L.20 (11 August 2000) (identifying conflicts between intellectual property and ‘the right of everyone to enjoy the benefits of scientific progress and its applications, the right to health, the right to food, and the right to self-determination’). For more detailed analyses of these developments, see, for example, Christophe Geiger, ‘“Constitutionalising” Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property in the European Union’, *Int’l Rev. Intell. Prop. & Competition L.* 37 (2006): 371, 382, 390–397 [hereinafter Geiger, ‘Constitutionalising Intellectual Property Law’] (analyzing recent intellectual property cases from Belgium, France, Germany, the Netherlands, Switzerland and countries outside of Europe that raise non-trivial freedom of expression issues); Christophe Geiger, ‘Fundamental Rights, a Safeguard for the Coherence of Intellectual Property Law?’, *Int’l Rev. Intell. Prop. & Competition L.* 35 (2004): 268, 277 [hereinafter Geiger, ‘Fundamental Rights Safeguard’] (analyzing ‘decisions in the field of copyright in which the freedom of expression has been invoked to justify a use that is not covered by an exception provided for in [intellectual property] law’); Laurence R. Helfer, ‘Toward a Human Rights Framework for Intellectual Property’, *U.C. Davis L. Rev.* 40 (2007): 971, 1001–1014 [hereinafter Helfer, ‘Human Rights Framework’] (analyzing recent treaty-making initiatives in the United Nations Educational, Scientific and Cultural Organization, the World Health Organization, and the World Intellectual Property Organization concerning the relationship between human rights and intellectual property); Laurence R. Helfer, ‘Regime Shifting: The TRIPs Agreement and New Dynamics of International Intellectual Property Lawmaking’, *Yale J. Int’l L.* 29 (2004): 1, 26–53 (analyzing intellectual property standard setting in the biodiversity, plant genetic resources, public health, and human rights regimes).

16. Geiger, ‘Fundamental Rights Safeguard’, *supra* n. 15, at 278; see also Helfer, ‘Human Rights Framework’, *supra* n. 15, at 1017–1018 (analyzing how international human rights law can be interpreted to impose ‘external limits on intellectual property’).

property and the corporations and individuals that own it.¹⁷ This countervailing trend is reflected in treaties,¹⁸ reports of international expert bodies,¹⁹ and judicial rulings in Europe²⁰ and the United States.²¹

The ECHR's entry into this maelstrom of competing human rights-based claims to restrict or expand intellectual property raises important and difficult questions. For example, does intellectual property deserve to be treated as a fundamental right? And if it does, how does a human rights-inspired conception of intellectual property differ from existing rules that promote innovation and creativity? More concretely, what role, if any, should the ECHR play in shaping innovation and creativity policy in Europe? Should the Court favour the rights of corporate intellectual property owners over the rights of individual users and consumers, or should it strike a distinctive human rights balance among these actors with competing interests?

In this article, I consider one important dimension of these questions in light of the ECHR's recent intellectual property rulings. I provide the first detailed assessment of the European human rights tribunals' Article 1 intellectual property case law.²² And I develop a comprehensive proposal for the ECHR to adjudicate

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17. See, e.g., Michael A. Carrier, 'Cabining Intellectual Property through a Property Paradigm', *Duke L.J* 54 (2004): 1, 1 (stating that '[o]ne of the most revolutionary legal changes in the past generation has been the "proPERTIZATION" of intellectual property'); Kal Raustiala, 'Density and Conflict in International Intellectual Property Law', *U.C. Davis L. Rev.* 40 (2007): 1021, 1032 (stating that 'the embrace of [intellectual property] by human rights advocates and entities . . . is likely to further entrench some dangerous ideas about property: in particular, that property rights as human rights ought to be inviolable and ought to receive extremely solicitous attention from the international community').
 18. See Charter of Fundamental Rights of the European Union Art. 17, 7 December 2000 O.J. (C 364) 1 ('Everyone has the right to own, use, dispose of and bequeath his or her lawfully acquired possessions . . . Intellectual property shall be protected.'), available at <www.europarl.europa.eu/charter/pdf/text_en.pdf>.
 19. See ECOSOC, Comm. on Econ., Soc. and Cultural Rights, General Comment No. 17: The Right of Everyone to Benefit from the Protection of the Moral and Material Interests Resulting from Any Scientific, Literary or Artistic Production of Which He or She Is the Author (Art. 15, Paragraph 1(c) of the Covenant), U.N. Doc. E/C.12/GC/17 (21 November 2005) [hereinafter General Comment], available at <www.ohchr.org/english/bodies/cescr/docs/gc17.doc>.
 20. See, e.g., Joseph Straus, 'Design Protection for Spare Parts Gone in Europe? Proposed Changes to the EC Directive: The Commission's Mandate and Its Doubtful Execution', *Eur. Intell. Prop. Rev.* 27 (2005): 391, 398 (discussing 2000 decision of the Federal Constitutional Court holding that patents constitute property under the German Constitution); Thomas Crampton, 'Apple Gets French Support in Music Compatibility Case', *N.Y. Times*, 29 July 2006, at C9 (discussing a ruling of the French Constitutional Council, the country's highest judicial body, which 'declared major aspects of the so-called iPod law unconstitutional' and 'made frequent reference to the 1789 Declaration on Human Rights and concluded that the law violated the constitutional protections of property').
 21. See, e.g., *Zoltek Corp. v. United States*, 442 F.3d 1345 (Fed. Cir. 2006) (rejecting a claim that the federal government's uncompensated use of a patent amounts to a taking of private property in violation of the U.S. Constitution), *reh'g denied*, 464 F.3d 1335 (Fed Cir. 2006).
 22. The few existing analyses of intellectual property in the European human rights system focus on treaty provisions that restrict intellectual property – such as the right to freedom of expression –

intellectual property disputes under the European Convention's property rights clause.

The article begins in Part II with an overview of the right of property in Article 1 and the decisions interpreting it. Part III develops a tripartite framework to analyze the ECHR's intellectual property case law, including decisions that commentators have not previously identified. I use this framework to link together a series of seemingly disconnected rulings and to expose the many points of intersection between Europe's human rights and intellectual property systems. Part IV analyzes three distinct paradigms that the ECHR may apply in future intellectual property disputes. I label these approaches the rule of law paradigm, the enforcement paradigm, and the intellectual property balancing paradigm. Each paradigm finds support in the Court's case law and its interpretive methodologies. However, the three paradigms have radically different consequences for innovation and creativity policy in Europe. I analyze these consequences and emphasize the systemic effects of overlaying two previously unrelated legal regimes. I argue that the ECHR should follow the rule of law paradigm and restrict its review of Article 1 intellectual property claims to cases of arbitrary government conduct. Part V briefly concludes.

II. EUROPEAN CONVENTION ON HUMAN RIGHTS AND THE RIGHT OF PROPERTY

This part surveys the property rights jurisprudence of the European human rights tribunals, highlighting issues that are relevant to the more detailed analysis of the intellectual property case law that appears in the next Part of the article. Before turning to this survey, however, a brief introduction to the structure of the European human rights system and the ECHR's interpretive methodologies is in order.

The European Convention enshrines a broad catalogue of civil and political liberties. The primary beneficiaries of these liberties are natural persons, although certain rights of corporations also receive protection, including the right of property.²³ In addition, the Convention is principally a charter of negative liberties that

or emphasize the European Convention's influence on the intellectual property laws of a specific country. See P. Bernt Hugenholtz, 'Copyright and Freedom of Expression in Europe', in *Expanding the Boundaries of Intellectual Property: Innovation Policy for the Knowledge Society* eds Rochelle Cooper Dreyfuss et al. (2001), 343; Timothy Pinto, 'The Influence of the European Convention on Intellectual Property Rights', *Eur. Intell. Prop. Rev* 24 (2002): 209. No comprehensive study of the European human rights tribunals' intellectual property jurisprudence under the Convention's property rights clause has ever been attempted.

23. See *generally* Marius Emberland, *The Human Rights of Companies: Exploring the Structure of ECHR Protection* (2006).

constrain the behaviour of state actors. But it also imposes a limited set of positive obligations on European governments.²⁴

When reviewing the actions of national governments, the ECHR gives pride of place to the Convention's text, from which it has distilled a diverse array of bright-line rules and multi-part balancing tests. But other interpretive methodologies have been equally vital forces in shaping European human rights jurisprudence. For example, the Court assesses the functional importance of particular rights in democratic societies, the rationales governments advance for restricting those rights, the arguments for and against deference to domestic decision makers, and the need for the Convention to evolve in response to legal, political, and social trends in Europe.²⁵ As explained below, the Court has applied each of these doctrines and interpretive tools when analyzing the right of property.

II.A ARTICLE 1 OF PROTOCOL 1: PROTECTING PEACEFUL ENJOYMENT OF POSSESSIONS

The protection of 'the peaceful enjoyment of possessions' for 'every natural or legal person' is one of the more controversial and obscure provisions in the European human rights system.²⁶ The right appears not in the Convention's primary text, but in Article 1 of its first Protocol.²⁷ This placement, as well as the absence of any mention of the word 'rights' in Article 1, reflects a disagreement among European governments over the inclusion of a property rights clause in the treaty as well as the scope and extent of protection it provides.²⁸

The Convention's drafters recognized that democratic governments need leeway to adopt or modify economic and social policies implicating private property without, in every instance, compensating adversely affected owners. On the other hand, the drafters also understood that the rule of law in general and the stability and predictability of property rights in particular would be undermined if governments could arbitrarily deprive owners of their possessions.²⁹ In attempting to reconcile these competing perspectives, the European Court and

24. See generally Alastair R. Mowbray, *The Development of Positive Obligations under the European Convention on Human Rights by the European Court of Human Rights* (2004). For a discussion of 'positive obligations' relating to the right of property, see *infra* Part IV B.

25. See Helfer, *Adjudicating Copyright Claims*, *supra* n. 1, at 407.

26. For more detailed analyses of the right of property in the European human rights system, see Ali Rıza Çoban, *Protection of Property Rights within the European Convention on Human Rights* 124–25 (2004); Camilo B. Shutte, *The European Fundamental Right of Property* (2004); Rijn, *supra* n. 6.

27. See Protocol 1, *supra* n. 5, Art. 1.

28. See Çoban, *supra* n. 26, at 124–125 (reviewing Art. 1's drafting history).

29. See *id.* at 127–137; Helen Mountfield, 'Regulatory Expropriations in Europe: The Approach of the European Court of Human Rights', *N.Y.U. Envtl. L.J.* 11 (2002): 136, 146–147.

Commission have created a complex and intricate jurisprudence interpreting the right of property.

II.B THE SUBJECT MATTER AND TEMPORAL SCOPE OF THE RIGHT OF PROPERTY

A preliminary issue the tribunals faced was defining Article 1's subject matter scope. The Court and Commission adopted a capacious interpretation of the word 'possessions', extending it to a broad array of 'concrete proprietary interest[s]' having economic value.³⁰ Whether such interests qualify as possessions does not depend on their status in domestic law.³¹ Rather, Article 1 has an 'autonomous meaning' that authorizes the ECHR to decide 'whether the circumstances of the case, considered as a whole, may be regarded as having conferred on the applicant title to a substantive interest protected by' Article 1.³² Applying this expansive if amorphous standard, the Court has adjudicated restrictions on most economically important types of tangible and intangible property, including land, chattels, licenses, leases, contractual rights, corporate securities, business goodwill and, as described in detail below, intellectual property.³³

Article 1's temporal scope extends to current and future proprietary interests. As the ECHR recently stated, "Possessions" can be either (1) "existing possessions" or (2) assets, including claims, in respect of which the applicant . . . has at least a "legitimate expectation" of obtaining effective enjoyment of a property right.³⁴ The Court has extended the latter line of cases to enforceable debts, lease renewal options, final court judgments, and vested rights to social security and pension benefits.³⁵ By contrast, the mere 'hope of recognition of a property right which it has been impossible to exercise effectively' is not protected, nor is 'a conditional claim which lapses as a result of the non-fulfillment of the condition'.³⁶

30. See *Kopecký v. Slovakia*, App. No. 44912/98, 2004-IX Eur. Ct. H.R. 125, 144 (Grand Chamber).

31. *Kechko v. Ukraine*, App. No. 63134/00, para. 22 (2005).

32. *Öneryıldız v. Turkey*, App. No. 48939/99, 2004-XII Eur. Ct. H.R. 79, 127 (Grand Chamber).

33. See Çoban, *supra* n. 26, at 152–155 (collecting recent decisions); David Anderson, 'Compensation for Interference with Property', 6 Eur. Hum. Rts. L. Rev. 6 (1999): 543, 546 (same).

34. *Kopecký*, 2004-IX Eur. Ct. H.R. at 139–140 (enumeration added).

35. See Çoban, *supra* n. 26, at 152–155 (collecting recent decisions).

36. *Kopecký*, 2004-IX Eur. Ct. H.R. at 140; see also *Gratzinger v. Czech Republic*, App. No. 39794/98, 2002-VII Eur. Ct. H.R. 399, 419–420 (Grand Chamber). The ECHR has often applied these principles to complaints seeking restitution of real or personal property seized by socialist governments in Eastern Europe. The Court has held that former property owners have no 'legitimate expectation' of receiving restitution if they do not have 'a currently enforceable claim that was sufficiently established', for example because they do not meet 'one of the essential statutory conditions' for recovery of previously owned property or because there is 'a dispute as to the correct interpretation and application of domestic law by the national courts'. *Rosival v. Slovakia*, App. No. 17684/02, para. 75 (2007) (admissibility decision) (internal citations omitted).

Future interests must also have a solid basis in domestic law, such as a statute or a judicial ruling that recognizes their existence.³⁷

II.C INTERFERENCES WITH PROPERTY

If the ECHR determines that a possession falls within Article 1's subject matter and temporal scope, it must then consider whether the government has interfered with the possession. The second and third sentences of Article 1 recognize two distinct categories of government interferences – deprivations of property and controls on its use.³⁸

Deprivations are the more invasive of these two categories. They include expropriations, nationalizations, confiscations, and other comprehensive disposessions. The ECHR has avoided finding a deprivation unless the government has effectively extinguished the owner's property right. In contrast, controls on use encompass any lesser restriction on an owner's possessory interests. The ECHR has adopted 'a very broad concept of "control of use"', thereby bringing 'a wide range of regulatory measures within its jurisdiction'.³⁹

II.D ASSESSING THE LEGALITY OF INTERFERENCES

Where a state interferes with a possession, the Court must assess the validity of its actions. For an interference to be compatible with the Convention, it must be 'provided by law' and pursue 'a legitimate aim' in the public interest.⁴⁰ Interferences must also achieve 'a fair balance . . . between the demands of the general interest of the community and the requirements of the protection of the individual's fundamental rights'.⁴¹ Striking this balance requires 'a reasonable relationship of

37. See *Zhigalev v. Russia*, App. No. 54891/00, para. 131 (2006); *Kopecký*, 2004-IX Eur. Ct. H.R. at 144–145.

38. *Hellborg v. Sweden*, App. No. 47473/99, 45 Eur. H.R. Rep. 3 [29], 43 (2007) (judgment of 28 February 2006) (explaining this distinction); see also Çoban, *supra* n. 26, at 174–186. The ECHR has also recognized a third category – interference with the substance of property. This category is reserved for government intrusions which, as a formal matter, 'do not transfer the property to public authorities, nor . . . limit or control the use of the property.' *Id.* at 187. In practice, however, the Court has not applied this concept consistently or coherently. Commentators have also noted that the cases decided under this rubric could easily fit under the first two categories. See *id.* at 189; Anderson, *supra* n. 33, at 551–552. For these reasons, I do not give separate treatment to 'substance of property' claims.

39. Mountfield, *supra* n. 29, at 146; see also Çoban, *supra* n. 26, at 175–185 (analyzing deprivations and comparing them to controls on use).

40. *Jahn v. Germany*, App. No. 46720/99, 42 Eur. H.R. Rep. 49 [1085], 1103–04 (Grand Chamber 2006) (judgment of 30 June 2005).

41. *Kirilova v. Bulgaria*, App. No. 42908/98, para. 106 (2005).

proportionality between the means employed' by the state and the objectives it seeks to achieve.⁴²

Although this proportionality test is highly fact-specific, the ECHR has identified several considerations relevant to assessing whether the government has maintained the fair balance required by Article 1. These factors include the owner's reasonable expectations;⁴³ whether the restriction imposes an inequitable or excessive burden (especially on non-nationals);⁴⁴ the amount of compensation (if any) paid by the government;⁴⁵ the uncertainty created by the regulation;⁴⁶ and the speed and consistency with which the state acts.⁴⁷

In assessing these factors, the ECHR affords governments considerable leeway to regulate private property in the public interest. Because states frequently impose property controls when implementing broader social and economic policies, 'the national authorities' – which have direct knowledge of their society and its needs – 'are in principle better placed than the international judge' to decide whether a regulation is necessary to achieve those policies.⁴⁸ As a result, the ECHR gives significant deference to 'the legislature's judgment as to what is in the public interest unless that judgment is manifestly without reasonable foundation'.⁴⁹ It also stresses the 'wide margin of appreciation' that states enjoy 'with regard both to choosing the means of enforcement and to ascertaining whether the consequences of enforcement are justified in the general interest for the purpose of achieving the object of the law in question'.⁵⁰

42. *L.B. v. Italy*, App. No. 32542/96, para. 23 (2002).

43. *Pine Valley Dev. Ltd. v. Ireland*, App. No. 12742/87, 222 Eur. Ct. H.R. (ser. A) at 23 (1991).

44. The Court has justified this differential treatment on public choice grounds, reasoning that non-nationals lack representation in domestic political processes and thus risk bearing a disproportionate share of the costs of property deprivations. See *Lithgow v. United Kingdom*, App. No. 9006/80, 102 Eur. Ct. H.R. (ser. A) at 49 (1986).

45. See Tom Allen, 'Compensation for Property under the European Convention of Human Rights', *Mich. J. Int'l L.* 28 (2007): 287, 298–300. When the state deprives non-nationals of their property, Art. 1's reference to 'the general principles of international law' mandates the payment of prompt, adequate, and effective compensation. Protocol 1, *supra* n. 5, Art. 1; Anderson, *supra* n. 33, at 548. By contrast, Art. 1 does not require compensation to be paid to nationals. *Lithgow*, 102 Eur. Ct. H.R. (ser. A) at 47–49. In practice, however, the Court has applied an equivalent standard of compensation to both types of takings. As a result, where a state deprives its own citizens of their property, it must normally pay 'an amount reasonably related to its value', and its failure to provide any compensation 'can be considered justifiable under Art. 1 of Protocol No. 1 only in exceptional circumstances'. *Scordino v. Italy*, App. No. 36813/97, 45 Eur. H.R. Rep. 7 [207], 239 (Grand Chamber 2006) (judgment of 30 March 2005).

46. *Hutten-Czapska v. Poland*, App. No. 35014/97, 45 Eur. H.R. Rep. 4 [52], 108 (Grand Chamber 2007) (judgment of 19 June 2006).

47. *Kirilova v. Bulgaria*, App. No. 42908/98, para. 106 (2005); *Broniowski v. Poland*, App. No. 31443/96, 2004-V Eur. Ct. H.R. 1 (Grand Chamber).

48. *Draon v. France*, App. No. 1513/03, 42 Eur. H.R. Rep. 40 [807], 832–33 (2006) (judgment of 6 October 2005) (internal quotations omitted).

49. *Id.*

50. *Scordino*, 45 Eur. H.R. Rep. 7 at 239.

This deference does not, however, amount to a blank check for European governments. To the contrary, as the docket of property rights cases has expanded exponentially over the last decade,⁵¹ the ECHR has pointedly refused to ‘abdicate its power of review’ and has reserved the final authority to ‘determine whether the requisite balance was maintained in a manner consonant with’ the right of property.⁵² As a result of this European judicial supervision, the ECHR has found an increasing number of violations of Article 1 in the last few years.⁵³

III. INTELLECTUAL PROPERTY AND THE EUROPEAN CONVENTION’S RIGHT OF PROPERTY: A TRIPARTITE FRAMEWORK FOR ANALYSIS

In this part, I apply the general principles reviewed above to cases in which intellectual property owners alleged a violation of Article 1 of Protocol 1. The analysis consists of three questions: First, does Article 1 apply to the intellectual property at issue, either because it is an existing possession or because the owner has a legitimate expectation of obtaining a future proprietary interest? If neither type of property exists, the government’s conduct, however egregious, cannot violate Article 1. In contrast, if the ECHR answers this question affirmatively, it must consider a second question: Has the government ‘interfered’ with the possession? The absence of such an interference also requires a ruling for the respondent state. Conversely, the existence of an interference leads to a third and final question: Whether the interference is justified, i.e., has the state upset the fair and proportional balance that Article 1 requires between the interests of the public and the property owner’s rights?

Analyzing the intellectual property jurisprudence of the ECHR and the European Commission using this tripartite framework helps to expose the numerous points of intersection – and of potential conflict – between the European human rights system and the region’s intellectual property laws.

51. Çoban, *supra* n. 26, at 258 (stating that over the last decade ‘both the magnitude and variety of the applications regarding [Art. 1] have escalated significantly and the number of the judgments rose consequently’). Not surprisingly, this expansion followed the accession of Eastern European countries to the Convention in the 1990s. These states have faced significant challenges to reallocating property rights during their transition from socialist to democratic systems of government. See Tom Allen, ‘Restitution and Transitional Justice in the European Court of Human Rights’, *Colum. J. Eur. L.* 13 (2006/2007): 1, 13–29.

52. *Jahn v. Germany*, App. No. 46720/99, 42 Eur. H.R. Rep. 49 [1085], 1105 (Grand Chamber 2006) (judgment of 30 June, 2005); see also *Fedorenko v. Ukraine*, App. No. 25921/02, para. 29 (2006) (asserting that the state’s ‘margin of appreciation . . . goes hand in hand with European supervision’ which authorizes the ECHR to ‘ascertain whether the discretion afforded to the Government was overstepped’).

53. *Kopecký v. Slovakia*, App. No. 44912/98, 2004-IX Eur. Ct. H.R. 125, 155 (Grand Chamber 2004) (Strážnická, J., dissenting) (‘In the Court’s case-law from 2000 onwards, a tendency may be discerned to subject the application of national law to supervisory review by the Court.’); Çoban, *supra* n. 26, at 258 (stating that the ECHR has found ‘more and more violations of [Art. 1] in the last couple of years’ and that it ‘is not as reluctant as it was before to find [a] violation’).

III.A IS INTELLECTUAL PROPERTY PROTECTED BY ARTICLE 1?

In three decisions dating back to 1990, the European Commission has consistently held that patents and copyrights fall within Article 1's subject matter scope.⁵⁴ The Court did not directly address this issue until 2005,⁵⁵ when it issued a trilogy of decisions applying Article 1 to intellectual property disputes.⁵⁶ *Anheuser-Busch Inc. v. Portugal* is the most well-known of these three rulings. In that judgment, analyzed in detail below, a seven-member Chamber of the ECHR concluded that 'intellectual property as such incontestably enjoys the protection of Article 1 of Protocol No. 1'.⁵⁷

The case was reargued before a Grand Chamber of the ECHR in 2006. Review by this panel of seventeen judges is reserved for disputes which involve 'a serious question affecting the interpretation or application of the Convention or the protocols thereto, or a serious issue of general importance'.⁵⁸ In a judgment issued in early 2007, the Grand Chamber unanimously agreed with the Chamber's conclusion, holding that Article 1 'is applicable to intellectual property as such'.⁵⁹ The Grand Chamber's statement is more measured than the language used by the Chamber. Nevertheless, its holding is an unequivocal endorsement of the view that the right of property protects the financial interests of intellectual property owners in their inventions, creations, and signs.

The ECHR's only justification for this conclusion is found in a brief quotation from the European Commission's first intellectual property decision, in which the Commission stated that under Dutch law the holder of a patent is referred to as the proprietor of a patent and that patents are deemed, subject to the provisions of the Patent Act, to be personal property which is transferable and assignable. The Commission finds that a patent accordingly falls within the scope of the term 'possessions' in Article 1 of Protocol No. 1.⁶⁰

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54. See *Lenzing AG v. United Kingdom*, App. No. 38817/97, 94-A Eur. Comm'n H.R. Dec. & Rep. 136 (1998) (patent); *Aral v. Turkey*, App. No. 24563/94 (1998) (admissibility decision) (copyright); *Smith Kline & French Lab. Ltd. v. Netherlands*, App. No. 12633/87, 66 Eur. Comm'n H.R. Dec. & Rep. 70, 79 (1990) (admissibility decision) (patent).
 55. In a 1995 ruling, *British Am. Tobacco Co. Ltd. v. Netherlands*, App. No. 19589/92, 331 Eur. Ct. H.R. (ser. A) (1995), the Court avoided deciding whether patent applications are possessions – an issue I discuss in greater detail below. See *infra* Part III.A.2.
 56. See *supra* n. 8.
 57. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 44 Eur. H.R. Rep. 42 [836], 856 (Chamber 2007) (judgment of 11 October 2005). I discuss the complex facts and procedural history of the case below. See *infra* Part III.A.2.a.
 58. European Convention, *supra* n. 2, Art. 43.
 59. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830], 849 (Grand Chamber 2007). Both the concurring and dissenting judges agreed that Art. 1 applies 'to intellectual property in general and to a duly registered trade mark'. *Id.* at 853 (Steiner and Hajiyev, JJ., concurring), 855 (Caflisch and Cabral Barreto, JJ., dissenting).
 60. *Smith Kline & French Lab. Ltd. v. Netherlands*, App. No. 12633/87, 66 Eur. Comm'n H.R. Dec. & Rep. 70, 79 (1990) (admissibility decision).

The Commission's reasoning in this passage is sparse. But it suggests that the European tribunals place significant weight on the exclusivity of the exploitation and transfer rights that national laws confer on intellectual property owners.⁶¹ Inasmuch as these exclusive rights are standard features of national and international intellectual property systems, it is safe to predict that the ECHR will treat other forms of industrial and artistic property – such as new plant varieties, integrated circuits, performers' rights, trade secrets, and the like – as 'possessions' protected by Article 1. In addition, because Article 1 applies to fixed claims to future revenue and compensation,⁶² the Court will likely extend Article 1 to intellectual property rights that are subject to a statutory or compulsory license (i.e., a license that authorizes users to exploit protected works provided that they remunerate rights holders).⁶³ These logical extensions of prior Article 1 case law suggest that there are no obvious jurisdictional limits on the ECHR's power to review a wide array of intellectual property disputes under the rubric of the right of property.

Outside of these broad jurisdictional parameters, however, the scope of Article 1 is much less certain. This is particularly true where Article 1 intersects with intellectual property subject matter and ownership rules; for example, where ownership is contested or where it is unclear whether an inventor, creator, or business has satisfied the requirements for protection under domestic law. I analyze these unresolved issues below. I begin with literary and artistic works that are protected from the moment of their creation or fixation. I then discuss industrial property whose eligibility for protection is determined by a registration procedure.

III.B LITERARY AND ARTISTIC WORKS

Consider first an easy case – literary and artistic works whose ownership and eligibility for protection in domestic law are undisputed. The creators of such works possess exclusive exploitation and assignment rights that fit comfortably within European jurisprudence protecting various forms of intellectual property under Article 1. In these cases of undisputed ownership and eligibility, the ECHR will simply defer to the national copyright or neighboring rights laws and conclude that Article 1 is applicable. Yet such deference may not always yield easy answers, particularly when domestic law provides limited guidance concerning a creator's proprietary interests.

61. See Laurent Sermet, *The European Convention on Human Rights and Property Rights* (1998), 13 ('patents have two characteristics – exclusiveness and transferability – which are also hallmarks of property').

62. See *supra* Part II.B.

63. Compulsory licenses fit easily within the concept of Art. 1 'assets', even where the amount of compensation is determined ex post by a government agency or royalty tribunal. See *Broniowski v. Poland*, App. No. 31443/96, 2004-V Eur. Ct. H.R. 1, 54 (Grand Chamber) (applying Art. 1 to a right 'to obtain . . . compensatory property' notwithstanding the fact that the 'right was created in a somewhat inchoate form, as its materialisation was to be effected by an administrative decision allocating State property to' the applicant).

III.B.1 Dima v. Romania

Dima v. Romania,⁶⁴ a 2005 admissibility decision previously unmentioned by commentators, highlights these complexities. The case concerned a graphic artist, Victor Dima, who created the design for a new national emblem and seal shortly after the fall of Romania's communist regime in 1989. Dima developed a preliminary drawing of the state symbols in response to a public competition. A government commission selected his prototype over several other submissions and directed him to work with two history and heraldry experts to revise the design.⁶⁵

The Romanian Parliament later adopted the revised design as the state emblem and seal, listing Dima as the 'graphic designer' in a statute published in the country's Official Journal.⁶⁶ Inexplicably, however, the Parliament never paid Dima for his work. In addition to seeking to recover the compensation owed to him, Dima responded by asserting his rights as the graphic designer of the state emblem and seal.

He turned first to Romania's administrative agencies. The Patent and Trademark Office refused to register the design, relying on a provision of Romania's industrial design statute that excludes from protection designs 'whose purpose and appearance are contrary to morality or public policy'.⁶⁷ Dima had better luck with the Copyright Agency, whose director informed him in a series of letters that he was the author of the graphic design and enjoyed all of the rights in domestic copyright law. On the strength of these assertions, Dima filed three copyright infringement actions in the Romanian courts against two private businesses and a state-owned enterprise responsible for minting Romanian coins – all of which had reproduced and distributed the design for profit.⁶⁸

The courts dismissed all three suits, holding that Dima did not own a copyright in the design of the state symbols. The decisive rulings were issued by the Romanian Supreme Court of Justice. The court acknowledged that Dima had personally created the design. But it held that the Parliament, which had commissioned the

64. *Dima v. Romania*, App. No. 58472/00 (2005) (admissibility decision).

65. The ECHR does not indicate whether Dima prepared his initial design for the competition, although that is the most plausible interpretation of the facts. See *id.* at paras 3–4.

66. *Id.* at para. 6 ('*auteur des maquettes graphiques*', in French).

67. The Patent and Trademark Office also based its refusal on an unpublished internal rule which provided that industrial drawings and models representing the emblem of a state were excluded from copyright protection (*droit d'auteur*). *Id.* at para. 9. The ECHR did not explain why an industrial property office believed itself competent to interpret an issue of copyright law. However, settled grounds for rejecting the registration of state symbols *as trademarks* appear in Art. 6ter of the Paris Convention, which prohibits the registration and use of 'armorial bearings, flags, and other State emblems' as such marks or as elements thereof 'without authorization by the competent authorities'. *Id.* at para. 27 (citing Paris Convention for the Protection of Industrial Property, Art. 6ter, 20 Mar. 1883, 828 U.N.T.S. 305). Although the Patent and Trademark Office did not rely upon this provision in denying Dima's registration, Romania cited it in opposing his complaint to the ECHR. See *id.* at paras 7, 18.

68. See *Dima*, App. No. 58472/00. at paras 11–26.

revision of the design, was the ‘author’ of the works.⁶⁹ Alternatively, the Supreme Court concluded that ‘symbols of the State could not be the subject of copyright’, neither under the 1956 copyright statute in effect at the time Dima created the design (which did not mention state symbols) nor under a revised 1996 statute (which expressly excluded such symbols from copyright protection).⁷⁰ Finally, the Supreme Court rejected Dima’s argument that the lower courts had retroactively applied the 1996 statute to his design, since even under the earlier law Dima was not the author of ‘works of intellectual creation’.⁷¹

Dima challenged these rulings before the ECHR, alleging that the Romanian courts had deprived him of a possession in violation of Article 1.⁷² He invoked the subject matter and authorship rules of the 1956 copyright statute, which protected ‘all works of intellectual creation in the literary, artistic and scientific domain, whatever the contents and form of expression’, including ‘works of graphic art’.⁷³ The statute further provided that the ‘author’ of such works ‘shall be the person who has created’ them and that the copyright ‘arise[s] the moment the work takes . . . concrete form’.⁷⁴ Dima asserted that, as a result of these statutory provisions, his copyright in the graphic design arose at the moment he created it or, at the latest, when he was listed as the graphic designer in the Official Journal.⁷⁵

The ECHR began its analysis by stating that Article 1 protects copyrighted works. But this conclusion did not resolve whether Dima had ‘a “possession” or at least a “legitimate expectation” to acquire a “possession”’ as the author of the graphic models he created.⁷⁶ To assess that issue, the Court first turned to the subject matter rules of European copyright laws. It observed that ‘the majority of national legal systems, including that of Romania, provide that copyright arises upon the creation of an artistic work. Some jurisdictions require, in addition . . . that

69. The Supreme Court emphasized the collective process of the models’ creation and the decisive role played by the Parliament in selecting the final models. See *id.* at para. 14.

70. According to the ECHR, the 1996 statute was adopted to ‘modernize the field of copyright’ after the fall of the socialist regime in 1989. See *id.* at paras 61–62.

71. *Id.* at para. 13.

72. Dima’s complaint to the ECHR also raised two other claims: (1) the government’s failure to compensate him for his work, and (2) various procedural objections to the domestic infringement proceedings. As to the first claim, the ECHR ruled that Dima had failed to exhaust domestic remedies, thus precluding the Court from reviewing his allegations on the merits. *Id.* at paras 78–81. As to the second claim, the ECHR rejected all of Dima’s objections save one – a challenge to a report produced by an expert witness for one of the defendants. As to that issue, it declared Dima’s complaint admissible. *Id.* at paras 66–67. In November 2006, the ECHR concluded that Romania had violated the European Convention’s right to a fair hearing when the Romanian Supreme Court dismissed his appeal without addressing Dima’s challenge to the expert’s report. The Court awarded Dima EUR 2,000 in damages. See *Affaire Dima c. Roumanie*, App. No. 58472/00 (2006); see also Press Release, Registrar, European Court of Human Rights, Chamber Judgments Concerning Azerbaijan, Bulgaria, Croatia, Italy, Lithuania, Romania and Russia (16 November 2006) (summarizing the ECHR’s judgment in English).

73. Decree No. 321 Relating to Copyright, 18 June 1956, Art. 9 (Rom.) (copy on file with author).

74. *Id.* Art. 2.

75. See *Dima v. Romania*, App. No. 58472/00, para. 38 (2005) (admissibility decision).

76. *Id.* at para. 87.

the work have a concrete form of expression.⁷⁷ These general principles, viewed in the abstract, appeared to support a ruling in Dima's favour.

Yet the Court also recognized that these principles did not answer all unsettled questions concerning the scope of national copyright law. In cases where the 'existence or extent' of copyright is uncertain, the ECHR stated, it is the task of domestic courts to resolve any ambiguities.⁷⁸ Only once those ambiguities have been resolved can the Court determine the extent of the applicant's property right and whether the state had violated that right.

The key question, therefore, was whether Romanian courts had decided that a graphic design of a state emblem could be protected by copyright prior to the adoption of the 1996 statute that expressly denied such protection. On this issue, the facts did not favour Dima. Although he was listed as the graphic designer in the official gazette and the subject matter provisions of the 1956 copyright law were ambiguous, he could not point to 'a judgment in his favour, nor could he rely on any favourable case law concerning the ability to copyright models of the State emblem and seal'.⁷⁹ In addition, the Supreme Court of Justice ultimately rejected Dima's proposed interpretation of the 1956 statute (and, implicitly, that of the Copyright Agency, although the ECHR failed to mention this fact). In light of this rejection, Dima could not claim to have any 'legitimate expectation' of acquiring a possession, since such an expectation cannot arise where there is 'a dispute as to the interpretation and application of national law, and . . . the applicant's submissions [are] subsequently rejected by the national courts'.⁸⁰

The ECHR concluded by reaffirming its 'limited power' to review allegations of legal or factual errors committed by national courts when interpreting domestic law. Applying this deferential standard, it found 'no appearance of arbitrariness' in the Supreme Court's ruling. There was thus 'no basis on which the [ECHR] could reach a different conclusion on the question of whether [Dima] . . . did or did not have a copyright' in the design he created.⁸¹

III.B.2 Implications of *Dima* for the Protection of Literary and Artistic Works

Dima v. Romania raises several important issues regarding the application of Article 1 to literary and artistic works. Perhaps most significantly, the ECHR refused to second-guess the Romanian courts' interpretation of domestic copyright law in a case whose facts were sympathetic to the creator. Instead, it deferred to the authority of national courts of last resort to resolve contested legal issues that divide lower courts and administrative agencies. Yet the Court also signaled that its deference to these domestic decision-makers would not be unlimited.

77. *Id.* at para. 88.

78. *Id.* at para. 89.

79. *Id.* at para. 91.

80. *Id.* at para. 92.

81. *Id.* at para. 93.

A close parsing of the judgment suggests several issues which may engender more searching scrutiny by the ECHR in future cases.

First, the ECHR in *Dima* did not address moral rights, a branch of copyright law that enables creators to control the attribution and integrity of their works. Inasmuch as moral rights protect the personal link between the creator and his or her intellectual creations, some commentators have argued that they have a stronger claim to protection as human rights than do copyright's economic exploitation privileges.⁸² Scholars are divided over whether Article 1 extends to moral rights.⁸³ The Court did not resolve this debate, inasmuch as *Dima*'s challenge focused solely on his economic rights in the graphic designs. However, creators may raise moral rights claims in future cases, for example, where the state misattributes authorship or distorts or damages a protected work.⁸⁴ In such cases, the Court will need to consider whether national decision-makers deserve less deference if they restrict moral rights.

Second, the ECHR refused to conflate subject matter standards from different branches of intellectual property law. In contesting *Dima*'s allegations before the ECHR, the government argued against the *copyrightability* of state symbols by citing to a *trademark* provision of the Paris Convention and Romania's *industrial design* statute,⁸⁵ both of which exclude such symbols as protectable subject matter.⁸⁶ The ECHR studiously avoided any mention of industrial property, however, restricting its analysis to copyright law. Had the Romanian courts relied solely on industrial property principles to reject *Dima*'s copyright infringements claims, the case's outcome before the ECHR might have been quite different. A broader implication of this approach is that the ECHR will interpret Article 1 in a manner that is appropriately sensitive to the distinct subject matter and protection standards of different fields of intellectual property law.

82. See Orit Fischman Afori, 'Human Rights and Copyright: The Introduction of Natural Law Considerations into American Copyright Law', *Fordham Intell. Prop. Media & Ent. L.J.* 14 (2004): 497, 524 (stating that 'the center of copyright as a human right lies in the moral rights arena'). But see General Comment, *supra* n. 19, paras 30–34, 44–46 (emphasizing importance of economic exploitation rights for creators and innovators and their interdependence with moral rights).

83. Compare Çoban, *supra* n. 26, at 149–150 (suggesting that Art. 1 covers only the economic value of a possession), with Geiger, *Constitutionalising Intellectual Property Law*, *supra* n. 15, at 383 and n. 54 (suggesting that Art. 1 also protects moral rights).

84. Plausible illustrations of such claims include disputes over the government's removal or destruction of sculptures, murals, or other works of visual art. from public buildings or parks. Cf. Rebecca Stuart, Comment, 'A Work of Heart: A Proposal for a Revision of the Visual Artists Rights Act of 1990 to Bring the United States Closer to International Standards', *Santa Clara L. Rev.* 47 (2007): 645, 659–676 (reviewing cases decided under US moral rights statute in which creators challenged the government's removal, destruction, or mutilation of works of visual art, and comparing US law to the protection of moral rights in international agreements and in other countries).

85. See *Dima v. Romania*, App. No. 58472/00, para. 80 (2005) (admissibility decision). *Dima* challenged the government's reliance on these authorities.

86. See *supra* n. 67 and accompanying text (discussing these two provisions).

Third, the ECHR signaled in *Dima* a concern with the retroactive application of domestic intellectual property laws. The ECHR recognized that copyright protection exists from the moment an author creates a work. Had the Romanian Supreme Court rejected Dima's authorship claim based solely on the subsequently enacted 1996 statute, the ECHR's recognition of this rule would have supported a finding that the retroactive application of the new law interfered with an existing possession. On the facts presented, however, Dima did not have a reasonable basis for claiming copyright protection even before the new statute took effect. There was no final judgment, nor any favourable precedent that recognized the copyrightability of design models for state symbols. This raises the possibility that the ECHR may find in favour of authors and rights holders who rely on these legal authorities before a change in the applicable law.

Fourth, the ECHR did not dismiss Dima's complaint solely on the ground that he did not own a possession protected by Article 1. Although the Court emphasized that issue, it also considered whether the Romanian courts had acted arbitrarily, indicating that the Court was also implicitly addressing the second issue identified above – whether the government had 'interfered' with a possession.⁸⁷ Had Dima not been the owner of such a possession, no amount of arbitrariness by the Romanian courts could have justified the ECHR in finding a violation of Article 1. The Court's willingness to consider the issue of arbitrariness suggests that in close cases it may assume *arguendo* that the complainant has an existing possession or a legitimate expectation in order to correct egregious errors of national courts in domestic intellectual property disputes.

III.C INDUSTRIAL PROPERTY

A different set of ambiguities arises with respect to the ECHR's treatment of industrial property. As mentioned above, the Grand Chamber's judgment in *Anheuser-Busch Inc. v. Portugal* definitively resolved the question of whether registered industrial property rights are existing possessions protected by Article 1. The Court also concluded that applications to register trademarks are similarly protected, overruling the Chamber's conclusion that such applications are neither existing possessions nor legitimate expectations. This extension of Article 1 to trademark applications raises several important issues. I discuss those issues below, but first provide an overview of the case and the reasoning of the Chamber and the Grand Chamber.

III.C.1 *Anheuser-Busch Inc. v. Portugal*

The ECHR's judgment in *Anheuser-Busch* is one small skirmish in a longstanding litigation war between the American brewer of 'Budweiser' beer and a rival Czech company, Budějovický Budvar (Budějovický), which also distributes beer under

87. See *supra* Part II.C.

the ‘Budweiser Bier’, ‘Budweiser Budvar’, and similar brand names. Over the last quarter of a century, nearly fifty disputes between the two competitors have raged across Europe in industrial property offices, domestic courts, and regional tribunals.⁸⁸ These disputes raise difficult questions concerning the relationship between trademarks and geographical indications (GIs)⁸⁹ and between national and international intellectual property laws.

The Portuguese legal system confronted these issues in 1981 when Anheuser-Busch applied to the National Institute for Industrial Property to register ‘Budweiser’ as a trademark. Budějovický opposed the registration, citing its 1968 Portuguese registration of an appellation of origin⁹⁰ for ‘Budweiser Bier’.⁹¹ The industrial property office refrained from acting on Anheuser-Busch’s application while the parties attempted to negotiate a licensing agreement. Eight years later, in 1989, after protracted negotiations proved unsuccessful, Anheuser-Busch asked the Portuguese courts to cancel Budějovický’s registration. An additional six years elapsed before a lower court ruled in favour of the American Bier company in 1995, cancelling the registration on the ground that ‘Budweiser Bier’ was not a valid appellation of origin.⁹²

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88. See ‘European Rights Court Rejects Budweiser Bid for Protection against Rival Czech Brand’, *Pat. Trademark & Copyright J.* 70 (2005): 668; Jeremy Reed, *ECJ Protects Simple Geographical Indications for Their Bud-dy*, 27 *Eur. Intell. Prop. Rev.* 25 (2005); Budweiser Budvar, *Disputes Concerning Registered Trademarks*, <www.budvar.cz/en/web/Znacka-Budvar/Znamka-Budvar.html> (last visited 14 November 2007).
89. The World Intellectual Property Organization (WIPO) defines a GI as a ‘sign used on goods that have a specific geographical origin and possess qualities or a reputation that are due to that place of origin’. World Intellectual Property Organization, *About Geographical Indications*, <www.wipo.int/about-ip/en/about_geographical_ind.html#P16_1100> (last visited 14 November 2007). The TRIPs Agreement has a similar definition. *Agreement on Trade-Related Aspects of Intellectual Property Rights*, Art. 22.1, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments – Results of the Uruguay Round, 33 I.L.M. 1125 (1994) [hereinafter TRIPs].
90. The Lisbon Agreement defines an appellation of origin as ‘the geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors’. *Lisbon Agreement for the Protection of Appellations of Origin and Their International Registration*, Art. 2(1), 31 October 1958, last amended 28 September 1979, 923 U.N.T.S. 205. For a discussion of the relationship between GIs and appellations of origin, see Felix Addor & Alexandra Grazioli, ‘Geographical Indications beyond Wines and Spirits: A Roadmap for a Better Protection for Geographical Indications in the WTO/TRIPs Agreement’, *J. World Intell. Prop.* 5 (2002): 865, 867–869.
91. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 *Eur. H.R. Rep.* 36 [830], 833–834 (Grand Chamber 2007). The 1968 registration was filed pursuant to the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration, which was opened for signature on 31 October 1958. *Id.*
92. *Id.* at 834. The Lisbon Court of First Instance held that, under the terms of the Lisbon Agreement, appellations of origin were ‘reserved to the geographical name of a country, region, or locality, which served to designate a product originating therein . . . “Budweiser” did not come within this category’. *Id.* For a more detailed explanation of this issue, see *infra* n. 95 and accompanying text.

In the wake of this ruling, the industrial property office promptly registered Anheuser-Busch's trademark.⁹³ It was now the Czech brewer's turn to petition the Portuguese courts, invoking a 1986 bilateral treaty between Czechoslovakia and Portugal that provided reciprocal protection for each country's indications of source and appellations of origin. Budějovický argued that the bilateral agreement required Portugal to register 'Budweiser Bie' as a Czech GI. But the lower court held that only 'ČeskoBudějovický Budvar' – a Czech phrase indicating a beer from České Budějovice, a town in the Bohemia region of the Czech Republic where the brewer is based – was an appellation of origin.⁹⁴ The German name of that town – 'Budweis' or 'Budweiss' – and the German translation of the phrase designating beer from that town – 'Budweiser Bier' – were not.⁹⁵

An intermediate appellate court reversed this decision and ordered the cancellation of Anheuser-Busch's trademark. The Supreme Court of Portugal affirmed. It interpreted the 1986 bilateral treaty to protect each signatory's national products in translation as well as in their original language.⁹⁶ The German translation of ČeskoBudějovický Budvar – 'Budweiser Bier' – was therefore eligible for protection as a GI under the 1986 treaty. Moreover, the refusal to register the American company's mark in reliance on that treaty did not violate the trademark priority rules in the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs).⁹⁷

93. *Id.* Budějovický had filed an opposition to the application to register the Anheuser-Busch mark with the industrial property office. Notwithstanding this opposition, the office issued a certificate of registration to the American brewer in June 1995. See *id.*

94. *Id.* at 834–835.

95. The translation from Czech to German is not serendipitous. Until the middle of the last century, a large German-speaking population resided in the Bohemia region of the Czech Republic (formerly Czechoslovakia and, before 1918, a province of the Austro-Hungarian Empire). According to the Budweiser Budvar website, '[s]ince the 14th century the official name of [České Budějovice] was Budweis. Only in 1918 was the name changed into the Czech name of České Budějovice. However, the indication Budweis is today the official translation of the name of the city into many foreign languages.' Budweiser Budvar, Information about Trademarks, <www.budvar.cz/en/web/Znacka-Budvar/Znamka-Budvar.html> (last visited 14 November 2007).

96. Anheuser-Busch disputed that the appellation of origin 'ČeskoBudejovicky Budvar' corresponds to the German expression 'Budweiser', with the result that, even if the bilateral treaty applied to translations, it did not support the registration of 'Budweiser Bier' as a geographical indication. The Supreme Court of Portugal rejected this argument. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 44 Eur. H.R. Rep 42 [846], 848–49 (Chamber 2007) (judgment of 11 October 2005).

97. TRIPs, *supra* n. 89, Art. 24. Anheuser-Busch claimed a right of priority for its 'Budweiser' mark application under Art. 24(5) of TRIPs, which addresses a subset of the conflicts between geographical indications and trademarks. Art. 24(5) gives priority to trademarks that have been applied for or registered in good faith before the entry into force of TRIPs or before the geographical indication is protected in its country of origin. The Supreme Court rejected the American company's claim of priority under this provision. *Anheuser-Busch*, 44 Eur. H.R. Rep. 42 at 848–49 (Chamber). For a more detailed discussion of the court's decision, see Antonio Corte-Real, *The Budweiser Case in Portugal*, 24 Eur. Intell. Prop. Rev. 43 (2002).

With the Portuguese litigation at an end, Anheuser-Busch filed a complaint with the ECHR. The beer manufacturer alleged that Portugal had violated Article 1 by invoking the 1986 bilateral treaty to deny registration of its 'Budweiser' trademark that the company had applied to register in 1981, six years prior to the treaty's entry into force.⁹⁸

In their respective judgments, both the Chamber and the Grand Chamber began by surveying industrial property treaties, EU directives, and domestic laws. These sources treat registration as the key to obtaining protection of a trademark. But they also confer 'certain rights' on trademark applications, such as fixing the beginning of the mark's period of validity and exclusivity. In addition, 'in some countries, an application to register a mark . . . may be the subject of an assignment, security assignment or licence and (provided the mark is subsequently registered) create an entitlement to compensation in the event of fraudulent use by a third party'.⁹⁹ These rights notwithstanding, most European states also authorize interested parties to oppose trademark applications and to bring actions to revoke or invalidate a mark within a set time period after its registration.¹⁰⁰ The key issue facing the ECHR was whether, in light of this palimpsest of legal rules, Article 1 protects not only registered marks but trademark applications as well.

The Chamber Judgment. By a five-to-two vote, the Chamber ruled that Article 1 was inapplicable to the dispute before it.¹⁰¹ The majority offered two justifications for this conclusion. The first rationale was limited to the case's complex procedural history. Among the twists and turns of twenty years of litigation, two events stood out: First, that the American company's right to use its mark in Portugal "was already contested by Budějovický Budvar when [Anheuser-Busch first] filed its application" in 1981; and second, that the 1986 bilateral treaty had been in force for more than two years when the company first challenged Budějovický's GI registration in 1989.¹⁰² As a result of these events, Anheuser-Busch could not be sure of being the owner of the trademark in question until after final registration and then only on condition that no objection was raised by a third party. In other words, the applicant company had a conditional right, which was extinguished retrospectively for failure to satisfy the condition, namely that it did not infringe third-party rights.¹⁰³

98. *Anheuser-Busch*, 44 Eur. H.R. Rep. 42 at 853–56 (Chamber). The 1986 bilateral agreement entered into force for Portugal on 7 March 1987. *Id.* at 848.

99. *Id.* at 852; *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830], 840–41 (Grand Chamber 2007). The Portuguese courts had held that 'the mere filing of an application for registration conferred on the applicant a "legal expectation" that warranted the protection of the law'. *Anheuser-Busch*, 44 Eur. H.R. Rep. 42 at 852 (Chamber). This expectation was later codified in a provision of the Portuguese Code of Industrial Property – enacted after the conclusion of the domestic litigation between Anheuser-Busch and Budějovický – that provided 'provisional protection' to trademark applicants and authorized them to bring infringement actions on the basis of that protection. *Id.*

100. See *Anheuser-Busch*, 44 Eur. H.R. Rep. 42 at 854–55 (Chamber); *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 843 (Grand Chamber).

101. *Anheuser-Busch*, 44 Eur. H.R. Rep. 42 at 858 (Chamber).

102. *Id.* at 857.

103. *Id.* at 858.

This narrow, fact-specific rationale was sufficient to support the Court's conclusion that Article 1 was inapplicable. The Chamber went further, however, holding that Article 1 applies only 'after final registration of the mark, in accordance with the rules in force in the State concerned'.¹⁰⁴ Prior to that time, while an application to register is pending, the applicant has 'a hope of acquiring' a possession. But it does not have a 'legally protected legitimate expectation' of a future proprietary interest.¹⁰⁵

This second, categorical construction of Article 1 easily disposed of Anheuser-Busch's principal argument – that the Portuguese Supreme Court had expropriated its property when it invoked the 1986 bilateral treaty to reject the company's previously filed application to register 'Budweiser'. Under the majority's second, broader holding, the court's adherence to the later-in-time treaty was simply 'irrelevant, since, when that Agreement entered into force . . . the applicant did not have a "possession"'.¹⁰⁶

In contrast to the judges in the majority, the two dissenting judges believed that Anheuser-Busch had a legitimate expectation protected by Article 1.¹⁰⁷ That expectation was based on the Portuguese Code of Industrial Property, which conferred three rights on trademark applicants: (1) a right of priority over subsequent applications; (2) a right to compensation for illegal uses of the mark by third parties; and (3) a right to have their 'application[s] examined in accordance with the rules' in force when they file an application.¹⁰⁸ The Portuguese courts had interfered with these rights by refusing to register the 'Budweiser' mark in reliance on the 1986 bilateral agreement.¹⁰⁹ The refusal resulted in a 'total inability to exploit the mark commercially' in Portugal without the payment of compensation. For this reason, the interference did not strike a fair balance between the company's property rights and the general interest.¹¹⁰

The Grand Chamber Judgment. Anheuser-Busch petitioned for a review of the Chamber's ruling before the Grand Chamber. The ECHR granted the company's request, received additional arguments from the parties, and issued a revised judgment in January 2007. By a fifteen-to-two vote, the ECHR held that Portugal had not violated Article 1. Unlike the Chamber judgment, however, the Grand Chamber advanced one step further in the analytical framework outlined above.¹¹¹ Specifically, the majority held that property rights in the European Convention apply to trademark applications as well as to registered marks.¹¹²

To reach this result, the Grand Chamber reviewed the 'bundle of financial rights and interests that arise upon an application' to register a mark. These rights

104. *Id.*

105. *Id.*

106. *Id.*

107. *Id.* at 858–860 (Costa & Cabral Barreto, JJ., dissenting).

108. *Id.* at 859.

109. *Id.*

110. *Id.* at 859–860.

111. See *supra* Part III (introductory paragraph).

112. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830], 850 (Grand Chamber 2007).

and interests enable applicants to enter into transactions (such as assignments or licensing agreements) that may have ‘substantial financial value’.¹¹³ The majority categorically rejected Portugal’s claim that these transactions have only ‘negligible or symbolic value’, citing the numerous rights that domestic law grants to trademark applicants. The economic value of trademark applications was especially likely in the case of Anheuser-Busch’s ‘Budweiser’ mark, which the ECHR recognized as enjoying ‘international renown’.¹¹⁴

The Court next turned to the Chamber’s conclusion that trademark applicants possess only conditional rights prior to registration, a status that precludes their protection under Article 1. The majority acknowledged the conditional status of the rights that attach to trademark applications. But it reasoned that when it filed its application for registration, the applicant company was entitled to expect that it would be examined under the applicable legislation if it satisfied the other relevant substantive and procedural conditions. The applicant company therefore owned a set of proprietary rights . . . that were recognized under Portuguese law, even though they could be revoked under certain conditions.¹¹⁵

The Court thus held that Article 1 was ‘applicable in the instant case’, a conclusion that made it ‘unnecessary . . . to examine whether the applicant company could claim to have had a “legitimate expectation”’.¹¹⁶

III.C.2 **The Significance of Anheuser-Busch’s Extension of Article 1 to Trademark Applications**

Before analyzing the next stage in the Grand Chamber’s analysis, it is worth pausing to consider the significance of the Court’s decision to overrule the Chamber and apply the Convention’s property rights clause to Anheuser-Busch’s application to register the ‘Budweiser’ mark. In particular, the Grand Chamber’s judgment raises at least three issues that will affect the future relationship between the European human rights system and national and regional intellectual property laws.

The first issue concerns the European-wide influence of the Court’s ruling. As a formal matter, ECHR judgments only bind the parties to the dispute. They do not have binding precedential effect for future controversies involving other complainants or respondent states. In practice, however, many ECHR rulings have trans-jurisdictional consequences. These effects are especially pronounced when the

113. *Id.*

114. *Id.*

115. *Id.*

116. *Id.* The majority’s holding logically implies that trademark applications are ‘existing possessions’, the only other temporal category of property rights protected by Art. 1. See *supra* Part II.B. It is uncertain, however, whether the Grand Chamber placed trademark applications in this category, since it stated only that such applications ‘[give] rise to interests of a proprietary nature’. *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 850 (Grand Chamber). In contrast to the majority, the concurrence and dissent analyzed trademark applications under the rubric of ‘legitimate expectations’. *Id.* at 853 (Steiner & Hajiyev, JJ., concurring), 856 (Caflisch & Cabral Barreto, JJ., dissenting).

Court departs from its normal practice of resolving cases on narrow, fact-specific grounds and includes general statements of principle in its judgments.¹¹⁷

A close reading suggests that *Anheuser-Busch* is just such a case. Although the Grand Chamber refers to facts specific to the dispute between the two brewers, such as the claim that ‘Budweiser’ is a well-known mark, several aspects of the decision suggest that the judges intend the case to apply more broadly. These include the Court’s canvassing of international, regional, and national trademark treaties and statutes; its discussion of the economic value of trademark applications in a market economy; and the phrasing of its holding – that ‘the applicant company’s legal position as an applicant for the registration of a trade mark came within Article 1’.¹¹⁸ The Court’s inclusion of these general principles strongly suggests that its analysis of Article 1 applies to applications to register trademarks in all forty-seven European Convention Member States.

A second unsettled issue concerns the consequences of the Grand Chamber’s analysis for applications to register other forms of intellectual property, such as patents, industrial designs, plant varieties and integrated circuits. The Court’s twin focus on (1) the priority, exploitation, and transfer rights that international, regional, and national laws grant to trademark applicants; and (2) the practical economic value that such applications possess, suggests that the ECHR will examine these same two factors to decide whether to extend Article 1 to applications to register other forms of intellectual property.

The Court’s judgment does not expressly delineate the relationship between the two factors. Its analysis strongly suggests, however, that the legal recognition of these exclusive rights creates a presumption of economic value, even if the applicant did not itself assign, license, or otherwise derive financial benefit from the application.¹¹⁹ Thus, to the extent that patent and industrial design, and similar laws, confer such rights upon applications to register, those applications will fall within Article 1’s ambit.¹²⁰ By contrast, if the relevant legal rules do not confer such rights, applicants will need to prove that they in fact engage in

117. See Robert Harmsen, ‘The European Convention on Human Rights after Enlargement’, *Int’l J. Hum. Rts.* 5 (2001): 18, 32–33 (discussing ECHR’s common practice of issuing narrow, fact-specific rulings rather than broad statements of principle). The most recent past President of the ECHR has urged the Court to abandon this practice. See Luzius Wildhaber, ‘A Constitutional Future for the European Court of Human Rights’, *Hum. Rts. L.J.* 23 (2002): 161, 162–163.

118. *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 850 (Grand Chamber) (emphasis added).

119. The fact that the ECHR did not reference *Anheuser-Busch*’s attempt to license its trademark application to Budějovický Budvar in its analysis of the scope of Art. 1 supports this view. See *id.* at 834 and 849.

120. See, e.g., European Patent Convention, 5 October 1973, 1065 U.N.T.S. 199, Art. 67 (defining the rights conferred by a European patent application after publication) and Arts 71–73 (describing a European patent application as ‘an object of property’ and enumerating rights of applicants including transfer, assignment, and licensing); Council Regulation (EC) No. 6/2002, Community Designs, 2002 O.J. (L 3) 1, 5, available at <http://oami.europa.eu/en/design/pdf/reg2002_6.pdf, art. 12> (term of protection exists from the date of filing of an application to register a Community design) and Art. 34 (describing an ‘application for a registered Community design as an object of property’).

‘legal transactions, such as a sale or license agreement for consideration’.¹²¹ Such evidence demonstrates that applications to register these other forms of intellectual property are ‘capable of possessing . . . substantial financial value’ even in the absence of formal legal protection.¹²²

A third consequence of the Grand Chamber’s decision relates to the ECHR’s jurisdiction to review the refusal of domestic industrial property offices and domestic courts to register trademarks on grounds such as consumer confusion or lack of distinctiveness.¹²³ These issues lurked in the background of the *Anheuser-Busch* case. The parties disputed whether the Portuguese courts had rejected the American brewer’s 1981 application to register ‘Budweiser’ not only because it conflicted with the 1986 bilateral agreement, but also because it was confusingly similar to the Czech brewer’s appellation of origin.¹²⁴ Neither the Chamber nor the Grand Chamber addressed this issue. But its importance to the parties – and to future ECHR intellectual property disputes – is easy to explain.

Consumer confusion has long been accepted as a valid basis for refusing to register trademarks. Had such confusion in fact been the basis for the refusal to register ‘Budweiser’, Anheuser-Busch could not have argued that Portugal had interfered with its statutory right of priority by enforcing the subsequently adopted bilateral treaty. Rather, the American brewer could only have complained that the domestic courts had misjudged the reputation and consumer associations of the two companies’ brands in the Portuguese beer market.

It is here that the consequences of the different approaches adopted by the Chamber and Grand Chamber are illustrated most starkly. By deciding that Article 1 is not implicated until after a trademark registration is final, the Chamber adopted a bright-line rule that categorically precluded the ECHR from reviewing national court and administrative agency decisions that refuse to register trademarks. By extending Article 1 to trademark applications (and, as I argue above, to applications for other registered rights) and holding that Anheuser-Busch was ‘entitled to expect that [its application] would be examined under the applicable legislation’,¹²⁵ the Grand Chamber expanded the ECHR’s jurisdiction to review the denial of registrations on any ground recognized in national and regional intellectual property laws. As I explain below, the ECHR’s review of complaints challenging refusals to register is likely to be quite limited.¹²⁶ It nevertheless creates an

121. *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 850 (Grand Chamber).

122. *Id.*

123. See Council Directive (EC) 89/104, Arts 3–4, 1989 O.J. (L 40) 1 (setting forth mandatory and permissive grounds for denying registration of a trademark).

124. Compare Anheuser-Busch’s claim that during the domestic litigation, ‘there had never been any question of a risk of confusion with the Czech company’s products’, *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 44 Eur. H.R. Rep. 42 [846], 854 (Chamber 2007) (judgment of 11 October 2005) with Portugal’s response that the Supreme Court considered both the risk of confusion and the 1986 bilateral agreement in refusing to register the American company’s trademark, *id.* at 855.

125. *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 850 (Grand Chamber).

126. See *infra* notes 188, 191–192 and accompanying text.

additional layer of European human rights scrutiny over domestic intellectual property registration systems.

III.D HAS THE STATE INTERFERED WITH A POSSESSION?

After concluding that a particular form of intellectual property qualifies as an ‘existing possession’ or a ‘legitimate expectation’ protected by Article 1, the ECHR and the European Commission must next consider the second question identified above – whether the state has ‘interfered’ with such a possession or expectation. The tribunals have identified two distinct types of interferences: (1) government restrictions on the exercise of intellectual property rights; and (2) interferences that result from domestic intellectual property litigation between private parties.¹²⁷

127. The ECHR and the European Commission have also indirectly considered the interference issue in two other categories of Art. 1 cases. In the first category, the tribunals decline to review a claim under Art. 1 if they have already examined it under another provision of the Convention. See *British Am. Tobacco Co. Ltd. v. Netherlands*, App. No. 19589/92, 331 Eur. Ct. H.R. (ser. A) at 29 (1995) (refusing to consider Art. 1 claim challenging denial of patent application where claim was “in substance identical to that already examined and rejected in the context of” complainant’s Art. 6 challenge to the independence and impartiality of the Appeals Division of the Dutch Patent Office); *Dimitrievski v. The Former Yugoslav Republic of Macedonia*, App. No. 26602/02, para. 7 (2006) (admissibility decision) (refusing to examine alleged violation of right of property where the complaint under Art. 1 ‘relate[d] solely to the outcome of the proceedings’ and was ‘in fact a restatement of the complaints under Article 6’).

A second category of indirect interference has arisen in challenges to the authority of the European Patent Office (EPO) to review patent applications and register patents. Inventors file applications directly with the EPO, whose examiners decide whether the applications meet the eligibility requirements of the European Patent Convention (EPC). If the EPO grants the application, the patent is automatically protected in all states that have ratified the EPC. National industrial property offices and national courts may not deny a patent that the EPO has granted nor grant a patent that the EPO has denied. In four cases, inventors whose patent applications were rejected challenged the state’s delegation of decision-making authority to the EPO. In each case, the European Commission rejected the challenge. The Commission highlighted the numerous benefits of the EPO’s centralized review and registration system and emphasized the EPC’s ‘procedural safeguards’, including an appeals procedure staffed by independent legal and technical experts. In light of these ‘equivalent protections’ for the rights of patent applicants, the states’ delegation of authority to the EPO to review patent applications and register patents did not interfere with a possession in a manner proscribed by Art. 1. *Lenzing AG v. Germany*, App. No. 39025/97, para. 20 (1998) (admissibility decision); *Lenzing AG v. United Kingdom*, App. No. 38817/97, 94 Eur. Comm’n H.R. Dec. & Rep. 136, 144 (1998) (admissibility decision); *Heinz v. Contracting States* also Parties to the European Patent Convention, App. No. 21090/92, 76 Eur. Comm’n H.R. Dec. & Rep. 125 (1994) (admissibility decision); *Reber v. Germany*, App. No. 27410/95, 22 Eur. H.R. Rep. 98 (1996) (admissibility decision). The ECHR has never addressed this issue, although it recently cited the Commission’s case law with approval. See *Bosphorus Hava Yollari Turizm ve Ticaret Anonim Şirketi v. Ireland*, App. No. 45036/98, 42 Eur. H.R. Rep. 1 [1], 32, 45 (Grand Chamber 2006) (judgment of 30 June 2005) (analyzing the delegation of authority by the European Convention’s Member States to the European Union).

III.D.1 **Restrictions on the Exercise of Intellectual Property Rights**

As explained above, government ‘interferences’ with property rights take two principal forms – use controls and deprivations.¹²⁸ The ECHR and the European Commission have considered state interferences with intellectual property on only two occasions. In both instances, the tribunals concluded that the government had restricted the exercise of intellectual property rights – that is, had controlled their use – but had not completely deprived rights holders of their possessions.

The most recent analysis of use controls appears in the dissenting opinion to the *Anheuser-Busch* Chamber judgment. According to the two dissenting judges, the Portuguese Supreme Court’s ‘refusal to register’ the Budweiser trademark in Portugal ‘indisputably amount[ed] to [an] interference with the applicant company’s right of property’. The dissenting judges rejected the American brewer’s claim that the refusal to register was an expropriation of its trademark. The state had not deprived Anheuser-Busch of its ownership interest but instead had prevented the company from ‘exploit[ing] the mark commercially’ in the country.¹²⁹

Fifteen years earlier, the Commission considered whether a compulsory license issued by the Dutch Patent Office amounted to an interference within the meaning of Article 1.¹³⁰ The government argued that such licenses were not interferences because ‘patents are granted subject to the provisions of the Patent Act, which expressly limits the scope of the patent owners’ rights by providing for the grant of compulsory licences’.¹³¹ The Commission disagreed. It reasoned that ‘a patent initially confers on its owner the sole right of exploitation. The subsequent grant of rights to others under the patent is not an inevitable or automatic consequence.’ The Patent Office’s decision to grant a compulsory license thus ‘constituted a control of the use of property’.¹³²

III.D.2 **Interferences Resulting from Litigation between Private Parties**

A second category of interference cases arises from domestic litigation between private parties. It is axiomatic that only states parties to the European Convention

128. See *supra* Part II.C.

129. *Anheuser-Busch*, 44 Eur. H.R. Rep. 42 at 859 (Chamber) (Costa & Cabral Barreto, JJ., dissenting). The two judges who dissented from the Grand Chamber’s judgment did not discuss whether Portugal’s refusal to give priority to the Budweiser trademark was a control of a possession or a more substantial deprivation of property. They merely concluded that, by applying the 1986 bilateral agreement retroactively, ‘the Portuguese authorities have objectively caused damage to the applicant company’. *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 857 (Grand Chamber) (Caflisch & Cabral Barreto, JJ., dissenting).

130. *Smith Kline & French Lab. Ltd. v. Netherlands*, App. No. 12633/87, 66 Eur. Comm’n H.R. Dec. & Rep. 70, 79 (1990).

131. *Id.*

132. *Id.* The Commission’s conclusion raises the question of whether such a control is justified. I address this issue below. See *infra* Part III.C.

can violate the rights and freedoms it protects. The ECHR thus has ‘no jurisdiction to consider applications directed against private individuals or businesses’.¹³³ When those individuals or businesses turn to national courts to resolve their property disputes, however, the decisions of those courts trigger the application of Article 1.

The ECHR and the European Commission have thus recognized that domestic judicial rulings are a form of state action.¹³⁴ At the same time, they have been wary of treating those rulings as ‘interferences’ with property. The tribunals have considered the interference issue in three types of intellectual property disputes involving private parties: (1) cases in which national courts adjudicate contract disputes involving the licensing or transfer of intellectual property; (2) cases in which national courts reject complaints alleging intellectual property infringement; and (3) cases in which national courts resolve competing claims of intellectual property ownership. I analyze these three categories of disputes below, highlighting the ways in which the Grand Chamber in *Anheuser-Busch Inc. v. Portugal* expanded Member States’ obligations relating to domestic litigation between private parties.

III.D.2.a Adjudication of Intellectual Property Contracts

Aral v. Turkey,¹³⁵ a previously unnoticed admissibility decision, reveals the tribunals’ treatment of the first type of dispute – private contract claims involving the licensing or transfer of intellectual property rights. In *Aral*, the Commission dismissed a complaint filed by three artists who alleged that Turkey had violated Article 1 when its courts enforced a contract that governed the rights to cartoon characters that the artists had created.¹³⁶ The Commission held that the case concerns a commercial dispute between private parties. The State’s intervention in the case only occurred through its courts . . . [T]here is no interference with the right to peaceful enjoyment of possessions when, pursuant to the domestic law and a contract regulating the relationship between the parties, a judge orders one party to that contract to surrender a possession to another, unless it arbitrarily and unjustly deprives that person of property in favour of another.¹³⁷

After briefly reviewing the domestic court decisions, which had interpreted the contract and Turkish intellectual property law to divide ownership of the

133. *Reynbakh v. Russia*, App. No. 23405/03, para. 18 (2005). Only one decision applies this principle to intellectual property. See *Mihăilescu v. Romania*, App. No. 47748/99, paras 22–28 (2003) (admissibility decision) (dismissing Art. 1 claim by patent owner who was unable to enforce a domestic court damage award against a state enterprise which had been privatized and later declared bankrupt).

134. See *S.Ö. v. Turkey*, App. No. 31138/96, para. 20 (1999) (admissibility decision) (stating that a transfer of property ownership was ‘enforced by a court order and thus by an act of a State organ’).

135. App. No. 24563/94 (1998) (admissibility decision).

136. *Id.* at paras 7–17, 21.

137. *Id.* at para. 38.

cartoons between the parties,¹³⁸ the Commission found no evidence that ‘the courts acted in an arbitrary and unreasonable manner. Accordingly, there is no shortcoming attributable to the State’.¹³⁹

III.D.2.b *Rejection of Domestic Infringement Claims*

Melnychuk v. Ukraine exemplifies the ECHR’s analysis of the second category of private disputes – cases in which an intellectual property owner challenges a national court’s dismissal of its infringement claims against a third party.¹⁴⁰ *Melnychuk* involved a dispute between a writer and a newspaper that published disparaging reviews of his books. The writer asked the newspaper to publish his reply to the reviews. When the newspaper refused, the author filed a complaint with the Ukrainian courts seeking ‘compensation for pecuniary and non-pecuniary damage caused by the publication’ of the critical book reviews. He also claimed that the newspaper had violated his copyright, although he did not explain the basis for the alleged infringement.¹⁴¹ The trial court dismissed Melnychuk’s complaint in its entirety. As to the copyright claim, the court stated simply that his allegations were ‘unsubstantiated’.¹⁴²

After exhausting all domestic appeals, Melnychuk filed a complaint with the ECHR. His complaint included a claim that ‘the newspaper articles about his books violated his copyright’.¹⁴³ The Court rejected the claim, stating that ‘the fact that the State, through its judicial system, provided a forum for the determination of the applicant’s rights and obligations does not automatically engage its responsibility under Article 1 of Protocol No. 1’. Rather, the state’s responsibility in such cases is only triggered in ‘exceptional circumstances’ for ‘losses caused by arbitrary determinations’. Melnychuk’s complaint did not meet this high threshold. To the contrary, ‘the national courts proceeded in accordance with domestic law, giving full reasons for their decisions. Thus, their assessment was not flawed by arbitrariness or manifest unreasonableness.’¹⁴⁴

The European tribunal’s limited scrutiny of national court rulings in *Melnychuk* and *Aral* indicates that challenges to garden variety infringement and breach of contract actions will rarely succeed. The ECHR did not simply dismiss Melnychuk’s weak copyright claims out of hand, but instead emphasized the exceptionally narrow scope of review in such cases. This suggests that the Court will defer to domestic judges’ resolution of infringement and breach of contract disputes even where an

138. *Id.* at para. 39. The Turkish court held that the magazine publisher owned cartoons which had been ‘published or which were unpublished but held in the archives of the magazines’. But it also held that the artists ‘could continue to draw the same characters . . . in association with other subjects and stories [and] in other magazines or newspapers’. *Id.*

139. *Id.* at para. 40.

140. See *Melnychuk v. Ukraine*, App. No. 28743/03 (2005) (admissibility decision).

141. *Id.* at para. 7.

142. *Id.* at para. 9.

143. *Id.* at para. 30.

144. *Id.* at para. 31.

applicant's claims have greater merit. Such an approach is consistent with the European Convention's core objective – preventing governments and public officials from violating civil and political liberties. As stated above, the treaty has no 'horizontal effect' between non-state actors.¹⁴⁵ The ECHR will thus only rarely find fault with 'the determination of [property] rights in disputes between private persons'.¹⁴⁶

III.D.2.c Resolution of Competing Ownership Claims

A third category of Article 1 interference cases arises when national courts resolve competing claims of intellectual property ownership. This issue arose in *Anheuser-Busch*, a case in which the Portuguese courts confronted 'the conflicting arguments of two private parties concerning the right to use the name "Budweiser" as a trade mark or [as an] appellation of origin'.¹⁴⁷ As explained above, the courts ruled in favour of the Czech owner of the appellation on the basis of a 1986 bilateral agreement between the two countries. The American brewer challenged that ruling before the ECHR, alleging that Portugal had violated the right of priority attaching to its previously filed 1981 application to register Budweiser as a trademark.¹⁴⁸

After concluding that trademark applications were protected by Article 1, the Grand Chamber considered whether the Portuguese courts had interfered with Anheuser-Busch's application to register Budweiser. In analyzing this issue, the ECHR struggled to knit together two previously unrelated strands of case law.

One line of decisions concerned 'the retrospective application of legislation whose effect is to deprive someone of a pre-existing asset'.¹⁴⁹ The retroactivity of such domestic laws 'may constitute [an] interference that is liable to upset the fair balance that has to be maintained between the demands of the general interest on the one hand and the protection of the right to peaceful enjoyment of possessions on the other'.¹⁵⁰ Previously, the ECHR had applied this principle to interactions between the government and private parties.¹⁵¹ But in the year prior to the Grand Chamber's judgment, the Court extended the principle 'to cases in which the dispute is between private individuals and the State is not itself a party to the

145. This contrasts with many provisions of EC law, which have both a 'vertical effect (between the State and the individual), [and] a horizontal effect (between individuals)'. *Bosphorus Hava Yollari Turizm ve Ticaret Anonim Şirketi v. Ireland*, App. No. 45036/98, 42 Eur. H.R. Rep. 1 [1], 28 (Grand Chamber 2006) (judgment of 30 June 2005) (internal quotations omitted). It bears noting, however, that some national court decisions have given horizontal effect to certain provisions of the European Convention. See Geiger, *Constitutionalising Intellectual Property Law*, *supra* n. 15, at 384.

146. *Voyager Ltd. v. Turkey*, App. No. 35045/97, para. 104 (2001) (admissibility decision).

147. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830], 852 (Grand Chamber 2007).

148. See *supra* Part III.A.2.a.

149. *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 851 (Grand Chamber).

150. *Id.* at 852.

151. See *Kopecký v. Slovakia*, App. No. 44912/98, 2004-IX Eur. Ct. H.R. 125, 142–143 (Grand Chamber 2004) (reviewing case law).

proceedings'.¹⁵² These decisions provided support for Anheuser-Busch's claim that Portugal had violated Article 1 by applying the 1986 bilateral treaty retroactively to its 1981 trademark application.

The American brewer's complaint also intersected with a second strand of ECHR jurisprudence – cases challenging the interpretation or application of domestic law by national courts. When confronted with such challenges, the Court has consistently held that it cannot review errors of fact or law that domestic judges have allegedly committed. Rather, its jurisdiction is limited to ensuring that national court rulings 'are not flawed by arbitrariness or otherwise manifestly unreasonable' and that their interpretations of domestic law do not violate the Convention.¹⁵³ To the extent that Anheuser-Busch's arguments were premised on the Portuguese courts' misinterpretation of the bilateral treaty and the Code of Industrial Property, the ECHR had solid jurisprudential grounds for rejecting its complaint.

The Grand Chamber reconciled these two lines of case law by emphasizing that the retroactive application of the 1986 bilateral treaty was itself an unsettled issue. Unlike prior decisions in which 'the retrospective effect of the legislation [was] indisputable . . . [and] intentional', the application of the bilateral treaty to pending trademark applications presented 'difficult questions of interpretation of domestic law'.¹⁵⁴ The complexities of the case were compounded by the fact that, at the time of the treaty's entry into force, the appellation of origin was still registered and the parties were attempting to negotiate a license agreement. Given these unique circumstances, the ECHR concluded that the Portuguese Supreme Court's rejection of Anheuser-Busch's claim of priority and its interpretation of the bilateral treaty were neither arbitrary nor manifestly unreasonable.¹⁵⁵ As a result, the Supreme Court's ruling did not 'interfere' with the application to register Budweiser as a trademark and thus did not violate Article 1.

The ECHR's narrow, fact-specific disposition of the case gives broad deference to national courts to interpret intellectual property statutes and treaties incorporated into domestic law. But the Grand Chamber did not limit its analysis to resolving the dispute between parties. In addition to affirming the difficulty of reconciling retroactive property restrictions with the Convention, the Court made the following general statement:

[E]ven in cases involving litigation between individuals and companies, the obligations of the State under Art. 1 of Protocol No. 1 entail the taking of measures necessary to protect the right of property. In particular, the State is under an obligation to afford the parties to the dispute judicial procedures which offer the necessary procedural guarantees and therefore enable the

152. *Anheuser-Busch*, 45 Eur. H.R. Rep. 36 at 851 (Grand Chamber) (citing *Lecarpentier v. France*, App. No. 67847/01, paras 48, 51, 52 (2006); *Cabourdin v. France*, App. No. 60796/00, paras 28–30 (2006)).

153. *Id.* at 851.

154. *Id.* at 852.

155. *See id.*

domestic courts and tribunals to adjudicate effectively and fairly in the light of the applicable law.¹⁵⁶

The Grand Chamber did not elaborate upon these seemingly basic due process requirements. As I explain below, however, the Court's statement has important implications for its future review of intellectual property disputes under Article 1. In particular, the ECHR may interpret these due process guarantees as requiring Member States to provide statutory, administrative, and judicial mechanisms to enable intellectual property owners to prevent private parties from infringing their protected works.¹⁵⁷

III.E HAS THE STATE ADEQUATELY JUSTIFIED ITS INTERFERENCE WITH A POSSESSION?

If the ECHR concludes that a possession exists and that the state has interfered with that possession, it must then consider a third and final issue – whether the state has adequately justified that interference. The standard for assessing such justifications is well-settled. Every interference must be specified by law, pursue a legitimate aim, and achieve a fair and proportional balance between the rights of the property owner and the public interest.¹⁵⁸ The European tribunals use this multi-part standard to assess the social policies and values that underlie state regulations of property.¹⁵⁹

III.E.1 Dependent Patent Compulsory Licenses

The ECHR has never applied this standard to intellectual property, and the European Commission has done so only once. In *Smith Kline & French Laboratories*, discussed above, the Commission upheld the grant of a compulsory license to the owner of a dependent patent to use a previously registered invention.¹⁶⁰ After the company that owned the dominant patent refused to negotiate a license, the dependent patent owner asked the Dutch Patent Office to award a compulsory license. The Office issued the license, which the Dutch courts upheld on appeal.¹⁶¹

The dominant patent owner then filed a complaint with the European Commission, alleging that the compulsory license violated its exclusive exploitation rights. The Commission agreed that the license interfered with a possession, but it held that the interference was justifiable and thus did not violate Article 1.

156. *Id.* at 851.

157. See *infra* Part IV.B.

158. See *supra* Part II.D.

159. See Çoban, *supra* n. 26, at 195–210.

160. See *supra* Part III.B.1.

161. *Smith Kline & French Lab. Ltd. v. Netherlands*, App. No. 12633/87, 66 Eur. Comm'n H.R. Dec. & Rep. 70, 72–73 (1990) (admissibility decision).

The Commission first found that the compulsory license was provided by law – the Dutch Patent Act – and pursued the legitimate aim of ‘encouraging technological and economic development’. The Commission then emphasized that ‘many’ European Convention Member States restrict a patentee’s exclusive rights to enable ‘other persons to make use of a particular patented product or process . . . for the purpose of preventing the long term hampering of technological progress and economic activity’.¹⁶² As to the crucial issue of proportionality, the Commission emphasized the social benefits of granting compulsory licenses to dependent patent owners as well as the protections such licenses afford to dominant patent owners:

[T]he Commission notes that the provision only comes into effect where such license is necessary for the working of a patent of the same or later date and the license should be limited to what is required for the working of the patent. Further, the owner of the dominant patent is entitled to royalties in respect of each compulsory license granted under the legislation and receives reciprocal rights under the dependent patent . . . [T]he Commission finds that the framework imposed by the legislation is intended to prevent the abuse of monopoly situations and encourage development and that this method of pursuing that aim falls within the margin of appreciation accorded to the Contracting State. The Commission accordingly finds that the control of use in the circumstances of this case did not fail to strike a fair balance between the interests of the applicant company and the general interest . . .¹⁶³

This short paragraph reveals a fairly sophisticated understanding of patent policy, especially for a human rights tribunal’s foray into substantive intellectual property law.¹⁶⁴ It also appears to afford considerable leeway to national decision-makers to restrict exclusive rights as a means of furthering intellectual property’s underlying social functions. As I explain in the next section, however, several factors limit the precedential value of the Commission’s analysis for future Article 1 disputes over the validity of exceptions and limitations to intellectual property rights.

III.E.2 Other Exceptions and Limitations to Exclusive Rights

First, the Commission’s holding is narrow and fact-specific. The scope of a dependent patent compulsory license is carefully limited to the justifications for granting it. In addition, dominant patent owners receive considerable benefits in exchange for the diminution of their exclusive rights, including remuneration and a cross-license to exploit the dependent invention. Where these benefits are absent – such as for exceptions to exclusive rights whose substantive contours are more capacious and do not require remuneration – the ECHR may be less willing to defer

162. *Id.* at 80.

163. *Id.*

164. The Commission’s decision in *Smith Kline* was its first analysis of an intellectual property dispute under Art. 1. See *supra* Part III.B.1 and n. 54.

to national decision-makers in striking a balance between private property and the public interest. In this respect, it is noteworthy that the two dissenting judges in *Anheuser-Busch* believed that Portugal had violated Article 1's proportionality requirement by failing to compensate the American company for the refusal to register its trademark application.¹⁶⁵

Second, the Commission upholds a limitation on patents that unambiguously protects both the rights of other intellectual property owners and the public interest in technological progress. The European Convention repeatedly refers to rights of others as a justification for limiting civil and political liberties.¹⁶⁶ The Commission's reasoning therefore suggests that other exceptions to intellectual property rights, such as private copying, parody, and noncommercial uses, are more likely to be upheld if the ECHR interprets them as safeguards for protecting the human rights of users and consumers – an issue that the Court has yet to address.

The subsequent history of *Smith Kline & French Laboratories* provides a third basis for giving limited precedential weight to the Commission's analysis. Although the Commission rejected the dominant patent owner's Article 1 claim, it was more troubled by the assertion that the Dutch Patent Office was not an independent or impartial tribunal.¹⁶⁷ After the Commission decided to review this claim on the merits, the patent owner and the Dutch government entered into settlement negotiations. The chief component of the state's settlement offer was a pending revision of Dutch patent law which vested the civil courts, rather than the Patent Office, with 'the decision making-power for the grant or refusal of a compulsory license'.¹⁶⁸ The amendment also restricted the compulsory licenses for dependent patent owners to 'cases where the dependent, competing patent involves substantial technical progress in the field'.¹⁶⁹

The Commission, which reviewed all proposed settlements to determine whether they manifest 'respect for [h]uman [r]ights', approved the parties' agreement.¹⁷⁰ This suggests that its rejection of the company's Article 1 claim was in

165. See *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 44 Eur. H.R. Rep. 42 [846], 858–859 (Chamber 2007) (judgment of 11 October 2005) (Costa & Cabral Barreto, JJ., dissenting).

166. See European Convention, *supra* n. 2, Arts 8(2), 9(2), 10(2), 11(2) (all recognizing 'the rights and freedoms of others' as a legitimate basis for restricting rights).

167. *Smith Kline & French Lab. Ltd. v. Netherlands*, App. No. 12633/87, 66 Eur. Comm'n H.R. Dec. & Rep. 70, 78 (1990) (admissibility decision).

168. *Smith Kline & French Lab. v. Netherlands*, App. No. 12633/87, 11 (1991) (Commission Report). This revision was later enacted. See Patents Act of the Kingdom 1995, Art. 57.4, September 1995, No. 51 (Dutch Patent Act of 1995), available at <www.wipo.int/clea/docs_new/en/nl/nl020en.html#JD_NL020_57_4> (authorizing dependent patent compulsory licenses only where 'the patent for which the license is requested represents a considerable advance'). This clause implements a provision of TRIPs which requires the dependent patent to contain 'a considerable technical advance of considerable economic significance' in relation to the dominant patent. *Id.* at n. 4 (paraphrasing TRIPs, *supra* n. 89, Art. 31(l)(i)).

169. *Smith Kline*, App. No. 12633/87, para. 3.

170. *Id.* After the Commission's abolition in 1998, the ECHR performs this settlement review function and applies the identical legal standard. See European Convention, *supra* n. 2, Art. 38(1)(b).

fact a close question. It also suggests that the Commission was untroubled by the state's decision to narrow the statutory exceptions to a patent owner's exclusive rights without considering the social policies underlying such a change in the law. The Commission's approval of the settlement thus leaves unresolved precisely how much discretion national decision-makers enjoy restricting intellectual property in the public interest.

IV. FORECASTING THE FUTURE: THREE PARADIGMS FOR ECHR ADJUDICATION OF INTELLECTUAL PROPERTY DISPUTES

The preceding sections of this article developed a tripartite framework to analyze the ECHR's intellectual property case law under Article 1. Such a framework has three benefits. First, it provides an organizing principle to explain the relationships among a group of diverse judicial rulings, including several decisions that commentators have not previously analyzed. Second, it exposes the numerous points of intersection between European human rights law and international and domestic intellectual property law. And third, it provides an informed basis for predicting how ECHR intellectual property jurisprudence will develop in the future.

This Part forecasts the evolution of the ECHR's intellectual property case law in greater depth. It does so by developing and analyzing three paradigms that the ECHR may apply when deciding future disputes relating to intellectual property. I label these approaches the rule of law paradigm, the enforcement paradigm, and the intellectual property balancing paradigm.

These three paradigms, illustrated below with contemporary examples, provide competing visions of how to conceptualize intellectual property's place in the European human rights system. Each paradigm finds support in the Court's case law and in the interpretive methodologies that ECHR judges use to further the European Convention's objectives and values.¹⁷¹ However, the three paradigms have radically different consequences for the region's innovation and creativity policies. I analyze these consequences below, emphasizing the sometimes problematic effects of overlaying two previously distinct legal regimes.

IV.A THE RULE OF LAW PARADIGM

Many legal scholars and philosophers recognize the importance of protecting property as a fundamental right, although they differ on the appropriate justification for and scope of that protection.¹⁷² As noted above, the decision to include a

171. See *supra* notes 23–25 and accompanying text (analyzing the ECHR's interpretive methodologies).

172. See generally Jeremy Waldron, *The Right to Private Property* (1990). For a comprehensive review of the literature, see Çoban, *supra* n. 26, at 35–77.

right of property in the European Convention was contested and controversial.¹⁷³ The drafters did not endorse any single philosophical or theoretical rationale for property rights. But the history and text of Article 1 reflects a consensus on the basic proposition that protection of private property is essential to preserving the rule of law.

The rule of law is a concept that suffuses the entire European Convention.¹⁷⁴ But it is expressed with particular forcefulness in Article 1, which provides that deprivations of property must be ‘subject to the conditions provided for by law’ and requires controls on the use of property to be based on ‘such laws as [the state] deems necessary’.¹⁷⁵ The ECHR has interpreted this dual reference to law as establishing Article 1’s ‘first and most important requirement’ – that ‘any interference by a public authority with the peaceful enjoyment of possessions should be lawful . . . [T]he principle of lawfulness presupposes that the applicable provisions of domestic law are sufficiently accessible, precise and foreseeable in their application.’¹⁷⁶ By compelling states to regulate property pursuant to previously established rules with these characteristics, the Court prevents arbitrary and excessive exercises of government power.¹⁷⁷ The desire to uphold the rule of law also explains and justifies Article 1’s application to corporations, since arbitrary deprivations of property do not affect only natural persons.¹⁷⁸

Under a rule of law paradigm, therefore, the ECHR would treat intellectual property no differently than any other type of real, personal, or intangible property protected by Article 1. The Court would not consider the public good qualities of intellectual property rights, nor would it concern itself with the social and cultural policies which justify the state’s protection of those rights. Instead, it would find fault only with arbitrary government conduct, such as *ultra vires* actions, failure to follow previously established rules and procedures, or laws that contravene the rule of law principles described above.¹⁷⁹ The Court’s scrutiny of national decision-makers would thus be minimal and unobtrusive. It would allow governments unfettered discretion to fashion their domestic innovation and creativity policies as they see fit, provided that they adhere to previously established rules embodying those policies.

173. See *supra* Part II.A.

174. See Emberland, *supra* n. 23, at 44.

175. Protocol 1, *supra* n. 5, Art. 1.

176. *Edwards v. Malta*, App. No. 17647/04, para. 60 (2006). See also *Zlinsat, Spol. S R.O. v. Bulgaria*, App. No. 57785/00, para. 98 (2006) (‘The requirement of lawfulness . . . means not only compliance with the relevant provisions of domestic law, but also compatibility with the rule of law.’).

177. Emberland, *supra* n. 23, at 46 (‘When the Court invokes the rule of law as an interpretive argument, it emphasizes its capacity to prevent governmental arbitrariness and the excessive wielding of public power.’).

178. See *id.* at 44 (‘The rule of law also helps explain why corporate persons enjoy ECHR protection’).

179. See Çoban, *supra* n. 26, at 196–197 (reviewing case law).

Does the ECHR believe that intellectual property complaints should be analyzed under the rule of law paradigm? The Grand Chamber intimated as much in *Anheuser-Busch* when it emphasized that it could not ‘take the place of the national courts, its role being rather to ensure that the decisions of those courts are *not flawed by arbitrariness or otherwise manifestly unreasonable*’.¹⁸⁰ Similarly, in *Melnychuk*, the Court held that providing intellectual property owners with a judicial forum to adjudicate domestic infringement claims did not ‘automatically engage [the state’s] responsibility’ under Article 1. Only ‘in exceptional circumstances’ could the state ‘be held responsible for losses caused by arbitrary determinations’.¹⁸¹ These quotations suggest that the ECHR will avoid using Article 1 as a vehicle to review the micro-foundations of domestic intellectual property laws.

Other than these general statements, however, neither the Court nor the Commission has considered how the rule of law paradigm applies to intellectual property. But the tribunals have frequently addressed arbitrary government conduct in other property rights contexts. For example, the ECHR has found fault with a domestic law that authorized an executive branch official to obtain a court order quashing a final, executed judgment that restored nationalized real property to its former owner.¹⁸² It has disapproved of a statute conferring unbounded discretion on a prosecutor to suspend a contract to privatize real property.¹⁸³ It has criticized the withdrawal of a banking license without prior notice or a procedure for subsequent administrative or judicial review.¹⁸⁴ It has condemned a state’s arbitrary use of supervisory review to quash final judgments ordering it to pay disability pension benefits.¹⁸⁵ And it has found a violation of Article 1 when the eviction and continuing dispossession of a lessee was ‘manifestly in breach’ of domestic law.¹⁸⁶

Extrapolating from these cases, it is possible to predict how the ECHR would apply the rule of law paradigm to intellectual property disputes. Government agencies that themselves infringe intellectual property rights arguably provide the strongest case for finding a violation of Article 1 using this approach. A ministry that installs copyrighted software on all of its desktop computers without obtaining a license from the software’s owner provides a ready example. Equally problematic from a rule of law perspective would be a state-owned enterprise’s failure to pay royalties to an inventor whose patented product or process it had previously licensed.¹⁸⁷

180. *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830], 851 (Grand Chamber 2007) (emphasis added).

181. *Melnychuk v. Ukraine*, App. No. 28743/03, para. 28 (2005) (admissibility decision).

182. See *Brumărescu v. Romania*, App. No. 28342/95, 1999-VII Eur. Ct. H.R. 201.

183. *Zlinsat, Spol. S R.O. v. Bulgaria*, App. No. 57785/00, para. 23 (2006).

184. See *Capital Bank AD v. Bulgaria*, App. No. 49429/99, 44 Eur. H.R. Rep. 48 [952], 984–85 (2007) (judgment of 24 November 2005).

185. *Chebotarev v. Russia*, App. No. 23795/02, para. 6 (2006).

186. *Iatridis v. Greece*, App. No. 31107/96, 30 Eur. H.R. Rep. 97, 116 (Grand Chamber 2000) (judgment of 25 March 1999).

187. Cf. *Mihăilescu v. Romania*, App. No. 47748/99, paras 22–28 (2003) (admissibility decision) (holding that inability to execute a judgment against a state-owned enterprise that had

Other instances of arbitrary government conduct may involve the judiciary. A domestic court that refuses to consider a trademark applicant's plausible arguments in favour of registration illustrates one possible scenario.¹⁸⁸ Another involves domestic infringement proceedings that are inexplicably or inexcusably prolonged, such that the right holder is effectively precluded from preventing unauthorized exploitation by third parties.¹⁸⁹ In both instances, the state has failed to provide the minimal procedural guarantees to which property owners are entitled under the ECHR's conception of the rule of law.¹⁹⁰

The above examples must be distinguished from court decisions that invalidate a previously registered patent or trademark. It is an inherent feature of patent and trademark systems that third parties may challenge the validity and scope of inventions and marks after administrative agencies have registered them. In fact, roughly half of all patents whose validity is later tested in litigation are found to be invalid.¹⁹¹ In this sense, registered rights are always conditional. Although it is therefore accurate to state that if a patent or trademark 'is found invalid, the property right will have evaporated',¹⁹² the dissolution of that property right raises no Article 1 concerns.

Domestic laws that authorize governments to exploit patented inventions and copyrighted works without rights holders' consent present a closer question.¹⁹³ On the surface, these statutes appear to authorize wholesale infringements similar to the software infringement and patent royalty examples described above. In fact, however, such laws allow governments to use private knowledge goods for the

unilaterally reduced royalties paid to a patent owner did not violate Art. 1 because the state only owned a minority stake in the enterprise and thus was not a state actor).

188. Cf. *Hiro Balani v. Spain*, App. No. 18064/91, 303 Eur. Ct. H.R. 23 (ser. A) at 30 (1995) (finding a violation of the right to a fair hearing where the Supreme Court failed to consider a trademark owner's argument that its mark had priority over the trade name of a competitor that had successfully applied to cancel the mark).
189. See *Stele v. Slovenia*, App. No. 6549/02, para. 13 (2006) (friendly settlement) (approving the settlement of a complaint alleging a violation of Art. 1 by a domestic court for failing to issue a judgment in a patent infringement action for nearly eleven years).
190. See, e.g., *Capital Bank AD v. Bulgaria*, App. No. 49429/99, 44 Eur. H.R. Rep. 48 [952], 984 (2007) (judgment of 24 November 2005) (stating that although Art. 1 'contains no explicit procedural requirements', its provisions nevertheless imply that 'any interference with the peaceful enjoyment of possessions must be accompanied by procedural guarantees affording to the individual or entity concerned a reasonable opportunity of presenting their case to the responsible authorities for the purpose of effectively challenging the measures interfering with the rights guaranteed by this provision'.).
191. Mark A. Lemley & Carl Shapiro, 'Probabilistic Patents', *J. Econ. Persp.*, Spring 2005, at 76.
192. *Id.* at 75.
193. For summaries of such government use exemptions relating to copyright, see, for example, 2 Melville B. Nimmer & Paul E. Geller, *International Copyright Law and Practice*, GER § 8(2)(d)(iii) (2005) (Germany); *id.* ITA § 8(2)(b)(iii) (Italy); *id.* POL § 8(2)(c) (Poland); *id.* SWE § 8(2)(d)(iii) (Sweden); *id.* UK § 8(2)(c) (United Kingdom); LiLan Ren, 'Note, A Comparison of 28 U.S.C. § 1498(a) and Foreign Statutes and an Analysis of § 1498(a)'s Compliance with TRIPS', 41 *Hous. L. Rev.* 41 (2005): 1659, 1664–1669 (analyzing foreign statutes authorizing government use of patented inventions).

public's benefit under previously specified conditions and for particular purposes.¹⁹⁴ Because intellectual property rights are state-created monopolies, the ECHR should reject rights holders' challenges to the application of these laws, provided that they are publicly available and drafted with sufficient prevision to enable rights holders to predict when the government may use their protected works.¹⁹⁵ By contrast, the ECHR should find a violation of Article 1 where the state fails to comply with the conditions specified in these statutes, for example by refusing to pay the required compensation or by exceeding the scope of the privilege.

In summary, the rule of law paradigm has several virtues. It enables the ECHR to police arbitrary excesses of state power and unambiguous violations of national law without interfering with domestic intellectual property systems. Application of the Court's authority in such cases is fully consistent with the objectives of the European Convention and the shared intent of Article 1's drafters. These disputes thus merit a place on the Court's overloaded docket, whether the complaints are filed by individuals or by corporations. In addition, any violations that the ECHR finds in such cases would not exacerbate the adverse human rights consequences of overly capacious intellectual property protection standards.¹⁹⁶ On the contrary, a state would be free to either expand or reduce such standards without fear of violating Article 1, provided that the government did not itself infringe protected works and provided that the laws were precise, accessible, and foreseeable.

IV.B THE ENFORCEMENT PARADIGM

There is solid support for the rule of law paradigm in recent ECHR jurisprudence. But the cases also contain a broader vision for the Court's adjudication of intellectual property disputes. Embedded in the Grand Chamber's *Anheuser-Busch* ruling are the seeds of an enforcement paradigm, in which the ECHR interprets Article 1 to require states to provide statutory, administrative, and judicial mechanisms that allow intellectual property owners to prevent private parties from infringing their protected works.

Whereas the rule of law paradigm targets arbitrary government interferences with possessions, the enforcement paradigm emphasizes the state's 'positive obligations' to protect private property.¹⁹⁷ Positive obligations require public authorities to take affirmative steps to ensure that rights holders can effectively exercise

194. See Ren, *supra* n. 193, at 1666, 1669 (reviewing European laws that provide for government use of patented inventions for purposes of, inter alia, national defense and producing or supplying drugs and medications).

195. Cf. *De Graffenried v. United States*, 29 Fed. Cl. 384, 387 (1993) (stating that a patent owner's rights 'do not include the right to exclude the government from using his or her patented invention' because 'the statutory framework that defines a patent owner's rights gives the government the authority to use all patented inventions').

196. See *supra* notes 15–16 and accompanying text.

197. See *Sovtransavto Holding v. Ukraine*, App. No. 48553/99, 38 Eur. H.R. Rep. 44 [911], 938 (2004). See also *Broniowski v. Poland*, 2004-V Eur. Ct. H.R. 1, 56 (Grand Chamber).

their rights. It is the state's wrongful omission, not its wrongful action, that triggers its responsibility under international law.¹⁹⁸

As applied to Article 1, positive obligations include 'provid[ing] a legal system so that property rights can be enforced'.¹⁹⁹ For example, the Court has required states to provide police assistance to landlords seeking to recover possession of leasehold property after the termination of a tenancy.²⁰⁰ States must also 'afford judicial procedures which offer the necessary procedural guarantees and therefore enable . . . domestic courts and tribunals to adjudicate effectively and fairly any [property] disputes between private persons'.²⁰¹ The Grand Chamber in *Anheuser-Busch* quoted this language almost verbatim, although it did not acknowledge that it was implicitly referencing the Court's positive obligations case law.²⁰²

The ECHR's application of positive obligations to private intellectual property disputes is likely to generate a fresh set of complaints challenging the adequacy of domestic enforcement procedures. These complaints will require the Court to articulate with greater precision which mechanisms states must provide to enable rights holders to prevent and punish infringements by third parties. In determining Article 1's implicit affirmative requirements, the ECHR may draw inspiration from the domestic enforcement provisions of the TRIPs Agreement.²⁰³

TRIPs requires countries to establish 'fair and equitable' procedures that 'permit effective action against any act of infringement of intellectual property rights', including procedures to prevent and deter infringements.²⁰⁴ The treaty also contains detailed rules for civil and administrative remedies, provisional measures, border enforcement, and criminal penalties.²⁰⁵ Tempering these obligations,

198. See Mowbray, *supra* n. 24. See also Clare Ovey & Robin White, Jacobs and White, *The European Convention on Human Rights* (4th edn, 2006), 51–52.

199. Çoban, *supra* n. 26, at 164.

200. See *Immobiliare Saffi v. Italy*, App. No. 22774/93, 1999-V Eur. Ct. H.R. 73, 90–92 (Grand Chamber).

201. *Sovtransavto Holding*, 38 Eur. H.R. Rep. 44 at 916 ('positive obligations may entail certain measures necessary to protect the right of property even in cases involving litigation between individuals or companies') (internal citation omitted).

202. See *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830], 851 (Grand Chamber 2007) ('[T]he State is under an obligation to afford the parties to the dispute judicial procedures which offer the necessary procedural guarantees and therefore enable the domestic courts and tribunals to adjudicate effectively and fairly in the light of the applicable law.').

203. As a formal matter, TRIPs protects only foreign intellectual property owners, whereas Art. 1 protects the owners of all possessions regardless of nationality. As a political and practical matter, however, states rarely protect foreign intellectual property owners without extending equivalent protections to domestic creators, innovators, and businesses. See Helfer, *Adjudicating Copyright Claims*, *supra* n. 1, at 367 & n. 38. As a result, the formal differences in scope between the two treaties are unlikely to deter the ECHR from consulting TRIPs when fashioning Art. 1 positive obligations.

204. TRIPs, *supra* n. 89, Arts 41(2), 41(1).

205. *Id.* Arts 42–51, 61. These provisions have resulted in substantial changes to domestic enforcement procedures in many countries. See Jerome H. Reichman, 'Enforcing the Enforcement Procedures of the TRIPs Agreement', *Va. J. Int'l L.* 37 (1997): 335.

TRIPs acknowledges that intellectual property enforcement measures may vary from country to country depending upon the resources available for law enforcement in general.²⁰⁶

Several factors suggest that the ECHR may refer to TRIPs when defining the positive obligation to protect intellectual property. First, TRIPs binds thirty-nine of the forty-seven European Convention members.²⁰⁷ The Court has held that the Convention ‘must be applied in accordance with the principles of international law’, including treaties to which the respondent state is a party.²⁰⁸ For these thirty-nine countries, consulting TRIPs to interpret Article 1 would help harmonize the states’ treaty obligations.²⁰⁹ Second, the ECHR has held that the Convention must be interpreted in light of regional and international trends in law and social policy.²¹⁰ Thus, even for countries that are not World Trade Organization (WTO) members, the ECHR may consult TRIPs to elucidate the domestic enforcement mechanisms that Article 1 requires.

To be sure, the Court is unlikely to incorporate every nuance of TRIPs into Article 1, especially in cases involving countries that are not WTO members. Rather, the ECHR would use the treaty as a rough benchmark to aid it in fashioning minimum enforcement standards that respect ‘the fair balance that has to be struck between the general interest of the community and the interests of the individual’ and that do not ‘impose an impossible or disproportionate burden on the authorities’.²¹¹

Aware of the helpful analogies that TRIPs provides, rights holders are likely to invoke the treaty in three types of Article 1 enforcement cases. First, rights holders may contest the remedies awarded in individual infringement proceedings, even

206. TRIPs, *supra* n. 89, Art. 41(5). For a detailed analysis of how WTO dispute settlement panels might draw on ECHR jurisprudence to interpret TRIPs’ enforcement obligations, see Helfer, *Adjudicating Copyright Claims*, *supra* n. 1, at 416–420.

207. See World Trade Organization, ‘Understanding the WTO: The Organization – Members and Observers’, <www.wto.org/english/thewto_e/whatis_e/tif_e/org6_e.htm> (last visited 14 November 2007); Council of Europe, Member States of the Convention for the Protection of Human Rights and Fundamental Freedoms, <<http://conventions.coe.int/Treaty/Commun/ChercheSig.asp?NT=005&CM=8&DF=2/23/2007&CL=ENG>> (last visited 14 November 2007). The eight European Convention members who have not yet ratified the WTO Agreement are Andorra, Azerbaijan, Bosnia and Herzegovina, Montenegro, the Russian Federation, San Marino, Serbia and Ukraine. *Id.*

208. *Guichard v. France*, App. No. 56838/00, 2003-X Eur. Ct. H.R. 419, 431 (admissibility decision). See also *Paradis v. Germany*, App. No. 4783/03 (2004) (judgment of 15 May 2003) (admissibility decision).

209. The case for using TRIPs as a benchmark is strengthened by the fact that both treaties require states to use practical effective enforcement mechanisms to protect intellectual property rights. Compare TRIPs, *supra* n. 89, Art. 41(1) (TRIPs enforcement provisions aim ‘to permit effective action against any act of infringement of intellectual property rights’), with *Artico v. Italy*, App. No. 6694/74, para. 33 (1980) (holding that ‘the Convention is intended to guarantee . . . rights that are practical and effective’).

210. See Alastair Mowbray, ‘The Creativity of the European Court of Human Rights’, *Hum. Rts. L. Rev.* 5 (2005): 57, 60–71.

211. *Özgür Gündem v. Turkey*, App. No. 23144/93, 2000-III Eur. Ct. H.R. 1, 21.

where a domestic legal system in the aggregate satisfies the Convention's rule of law requirements. These challenges are unlikely to succeed. Disputes over issues such as the amount of damages, the denial of injunctive relief, or the failure to impound infringing articles are precisely the sort of case-specific applications of domestic law with which the ECHR rarely finds fault.²¹² In addition, nothing in TRIPs limits the discretion of national courts to tailor remedies to the facts and circumstances of individual disputes.²¹³ Only in extraordinary cases, such as where national courts refuse to award a remedy mandated by domestic law, might the ECHR plausibly intervene.

A second category of cases concerns a state's failure to provide one of the enforcement measures that TRIPs requires.²¹⁴ In the late 1990s, for example, the United States successfully challenged the lack of *ex parte* civil remedies in Denmark and Sweden.²¹⁵ Most European countries now authorize *ex parte* orders.²¹⁶ Some intellectual property owners claim, however, that the procedures for obtaining these orders are 'unnecessarily complicated' and 'costly' in some jurisdictions. These claims could be refashioned as arguments that the states concerned have failed to provide the effective enforcement measures required by Article 1.

The third and most serious non-enforcement claim concerns the wholesale failure to prevent private infringements of intellectual property. Cases of this nature target pervasive, systemic defects in civil, administrative, or criminal procedures which prevent intellectual property owners from enforcing their rights. Such system-wide enforcement deficiencies exist principally (although by no means exclusively) in Eastern Europe.²¹⁷ Piracy and counterfeiting in the Ukraine, Russia, and Turkey are especially flagrant.²¹⁸

212. See *supra* Part III.B.2.b.

213. Cf. *eBay Inc. v. MercExchange, L.L.C.*, 126 S.Ct. 1837 (2006) (emphasizing the discretionary nature of injunctive relief in patent infringement cases).

214. See 'Int'l Intell. Prop. Alliance, Copyright Enforcement under the TRIPs Agreement' 5 (2004) (summarizing in chart form the TRIPs deficiencies found in national copyright laws and enforcement practices), available at <www.iipa.com/rbi/2004_Oct19_TRIPS.pdf>.

215. See Notification of Mutually Agreed Solution, *Denmark – Measures Affecting the Enforcement of Intellectual Property Rights*, WT/DS83/2 (13 June 2001); Notification of Mutually Agreed Solution, *Sweden – Measures Affecting the Enforcement of Intellectual Property Rights*, WT/DS86/2 (11 December 1998).

216. See Int'l Intell. Prop. Alliance, *supra* n. 214, at 3.

217. See Ed Bates, 'Supervision of the Execution of Judgments Delivered by the European Court of Human Rights: The Challenges Facing the Committee of Ministers', in *European Court of Human Rights: Remedies and Execution of Judgments*, eds Theodora Christou & Juan Pablo Raymond (2005), 49, 84–96 [hereinafter ECHR Remedies] (describing systemic and structural problems, including lack of resources, infrastructure, and slow or corrupt domestic judicial processes, leading to widespread violations of the European Convention in Turkey and in several Eastern European countries).

218. According to a recent report, the deficiencies include the 'lack of an effective and deterrent criminal enforcement system . . . ; the lack of effective plant inspection [for optical media production and distribution] . . . ; the lack of civil *ex parte* search procedures; an extremely porous border; delays in criminal prosecutions and adjudications; and infrequent destruction of seized pirate goods'. Office of US Trade Representative, *Special 301 Report* 32 (2005),

The ECHR recently established a ‘pilot judgment procedure’ that is well suited to redressing widespread piracy of intellectual property rights. Under this new class action mechanism, the Court adjudicates a single case that represents a large number of similar human rights claims, and it uses the case to develop systemic reforms for the entire class. The ECHR first applied the procedure in a 2004 decision affecting nearly 80,000 real property claimants in Poland.²¹⁹ It later approved a settlement of the dispute, but only after the state had enacted legislation to prevent future Article 1 violations and provide remedies to all affected property owners.²²⁰ The case publicized the Court’s determination to scrutinize systemic problems that affect large numbers of similarly-situated property owners.²²¹

Intellectual property rights holders could invoke the pilot judgment procedure if they are unable, after reasonable diligence, to protect their works within a respondent state’s territory. If rights holders prove that piracy in the jurisdiction is pervasive, the ECHR could require the government to adopt system-wide reforms. Depending on the nature and scope of the violations, such measures could include enacting domestic legislation, streamlining judicial procedures, or allocating additional resources to criminal or administrative enforcement actions. Here too the ECHR may turn to TRIPs’ enforcement provisions for guidance in fashioning appropriate systemic remedies, although the Court should also be mindful of the statement that nothing in the agreement ‘creates any obligation with respect to the distribution of resources as between enforcement of intellectual property rights and the enforcement of law in general’.²²²

Should the ECHR endorse the enforcement paradigm described above? The arguments in favour of its doing so are equivocal. On the one hand, once a government has recognized exclusive rights in knowledge goods, the owners of Article 1 possessions can reasonably expect that government to provide the means to prevent and punish infringements by third parties. This expectation is bolstered

available at <www.ustr.gov/assets/Document_Library/Reports_Publications/2005/2005_Special_301/asset_upload_file195_7636.pdf>; see also *id.* at 24 (highlighting the need for Ukraine to ‘deter . . . optical media piracy through adequate enforcement’), 33 (highlighting ‘concerns over patent protection, copyright piracy, trademark counterfeiting, and IPR enforcement problems’ in Turkey). Not coincidentally, both Russia and Ukraine have yet to be admitted to the WTO, in part because of their poor record of enforcing intellectual property rights. See Gary G. Yerkey, ‘Russia Needs to Do “Much More” before U.S. Will Sign off on WTO Accession Agreement’, *WTO Rep.* 6 (BNA) No. 184 (22 September 2006).

219. *Broniowski v. Poland*, App. No. 31443/96, 2004-V Eur. Ct. H.R. 1, 76 (Grand Chamber). The Art. 1 violations in this case concerned the state’s failure to meet its positive obligations and its interference with property rights. *Id.* at 57.

220. *Broniowski v. Poland*, App. No. 31443/96, 43 Eur. H.R. Rep. 1 [1], 19–20 (Grand Chamber 2006) (judgment of 28 September 2005) (friendly settlement).

221. See Philip Leach, ‘Beyond the Bug River – A New Dawn for Redress before the European Court of Human Rights’, *Eur. Hum. Rts. L. Rev.* 10 (2005): 148. The Court has since issued a pilot judgment involving an even larger number of property claimants. See *Hutten-Czapska v. Poland*, App. No. 35014/97, 45 Eur. H.R. Rep. 4 [52] (Grand Chamber 2007) (judgment of 19 June 2006) (holding that domestic legislation which prevented 100,000 landlords from raising rents to cover property maintenance for between 600,000 and 900,000 tenants violated Art. 1).

222. TRIPs, *supra* n. 89, Art. 41(5).

where the state is a WTO member and has accepted the obligation to conform its domestic laws to TRIPs. In addition, once a state has incorporated intellectual property enforcement mechanisms into its domestic legal system, rights holders can reasonably expect it to devote sufficient resources to make those mechanisms practical and effective.

Yet the enforcement paradigm also raises troubling issues. The first relates to the different judicial access rules of the WTO and the ECHR. In the WTO dispute settlement system, only states can file complaints alleging violations of TRIPs. This limitation on WTO standing acts as a key political filter that limits the number and type of TRIPs controversies²²³ and colors how disputes are resolved.²²⁴

The enforcement paradigm bypasses this political filter by allowing private parties to litigate breaches of TRIPs' enforcement provisions in the guise of violations of Article 1's positive obligations. As the years of ceaseless judicial battles between Anheuser-Busch and Budějovický Budvar illustrate, many businesses have the incentive and the means to litigate in every available forum. The ECHR's adoption of the enforcement paradigm would thus presage an increase in litigation of intellectual property enforcement disputes framed as human rights complaints, including cases that, under the current system, would not have been litigated or would have been resolved through politically palatable settlements. It is highly questionable whether these cases warrant a place on the Court's already overcrowded docket.

A second concern of the enforcement paradigm relates to the dissimilar remedies that the WTO and the ECHR award. Although both tribunals recommend responses for states that have violated their treaty commitments, the ECHR's remedial powers are more expansive. Its recent judgments have included

223. See Alan O. Sykes, 'Public Versus Private Enforcement of International Economic Law: Standing and Remedy', 34 *J. Legal Stud.* 34 (2005): 631 (analyzing 'political filters' that allow states to limit WTO litigation to disputes that produce joint welfare gains). In the intellectual property context, governments litigate only a subset of TRIPs disputes that rights holders bring to their attention. In some cases, a state may decline to file a complaint because it fears a WTO countersuit. In others, it may refuse to do so because the probability of success is low or because victory will only marginally benefit domestic industries. In still others, geo-strategic factors unrelated to trade or intellectual property may lead governments to refrain from litigating. In each instance, the 'decision whether to challenge a practice of a member may be made only by another member government, not by the private party who is directly aggrieved by that practice'. Judith H. Bello, 'Some Practical Observations about WTO Settlement of Intellectual Property Disputes', *Va. J. Int'l L.* 37 (1997): 357, 358.

224. When governments do file TRIPs complaints, they often prefer a politically palatable settlement or an ambiguous panel decision to a definitive WTO Appellate Body ruling. Such compromises allow both sides to claim victory and resolve the litigation in ways that both states are willing to accept. See Notification of a Mutually Satisfactory Temporary Arrangement, *United States – Section 110(5) of the US Copyright Act*, WT/DS160/23 (26 June 2003) (notifying WTO of lump-sum payment by United States to the EC to settle TRIPs copyright dispute in which the EC prevailed); see also Eva Gutierrez, 'Geographical Indicators: A Unique European Perspective on Intellectual Property', 29 *Hastings Int'l & Comp. L. Rev.* 29 (2005): 29, 48–49 (stating that both the United States and the EC claimed victory and did not appeal a WTO panel decision partially invalidating EC protection of GIs).

recommendations to reopen closed court proceedings, revise domestic statutes, and award restitution in kind.²²⁵ In addition, the ECHR awards ‘just satisfaction’ to ‘injured parties’.²²⁶ Damage awards are usually less than EUR 10,000, and the Court has discretion to award no monetary relief. In property rights cases, however, pecuniary damage awards ‘can assume gigantic proportions’, the largest on record being nearly (US dollars) USD 31 million.²²⁷ Governments have promptly paid these sums in all but a handful of cases.²²⁸

The ECHR’s award of these remedies when states violate Article 1’s positive obligations could impose significant constraints on national legal systems. If countries do not adopt the remedies that the Court recommends, injured rights holders could file complaints with the Court seeking compensation. In addition, under the new pilot judgment procedure described above, the ECHR could recommend systemic reforms benefiting all similarly situated rights holders. In counterfeiting and piracy cases, for example, the Court may award large monetary awards to an entire class of rights holders if states do not improve their judicial procedures.²²⁹ These concerns suggest, on balance, that the ECHR should avoid interpreting Article 1 to enable intellectual property owners to challenge the adequacy of domestic enforcement mechanisms.

IV.C THE INTELLECTUAL PROPERTY BALANCING PARADIGM

If the merits of the enforcement paradigm are at best ambiguous, the Court’s adoption of an intellectual property balancing paradigm would have indisputably negative consequences for innovation and creativity law and policy. Such deleterious effects would result from the ECHR’s inevitably ad hoc interventions at the upper and lower boundaries of intellectual property protection standards. Under the balancing paradigm, the ECHR would interpret the European Convention to impose both a floor and a ceiling on domestic intellectual property rights. The Court would police the lower limit of protection by reviewing whether the government’s diminution of exclusive rights or expansion of exceptions and limitations

225. See Leach, *supra* n. 221, at 149–151 (describing evolution of ECHR’s approach to remedies).

226. European Convention, *supra* n. 2, Art. 41.

227. Marius Emberland, ‘Compensating Companies for Non-pecuniary Damage: *Comingersoll S.A. v. Portugal* and the Ambivalent Expansion of the ECHR Scope’, *Brit. Y.B. Int’l L.* 74 (2003): 409, 412; see also Çoban, *supra* n. 26, at 228. In addition, the ECHR has ‘awarded monetary compensation for moral injury in almost all of the property cases where it found [a] violation of’ Art. 1. *Id.* at 230. Moral damage suffered by corporations includes harm to business reputation, uncertainty in future planning, disruption in management, and inconvenience to directors and officers. Emberland, *supra* n. 23, at 132.

228. Bates, *supra* n. 217, at 74 (‘[I]n the vast majority of instances settlement is made, at the latest, within six months of the date due for payment expired.’).

229. See *Hutten-Czapska v. Poland*, App. No. 35014/97, 45 Eur. H.R. Rep. 4 [52], 139 (Grand Chamber 2007) (judgment of 19 June 2006) (Zupančič, J., concurring in part and dissenting in part) (stating that judgment finding a violation of Art. 1 in a pilot judgment case ‘bind[s] the state to indemnify all similarly situated rights holders’).

satisfies Article 1's fair and proportional balance standard.²³⁰ And it would police the upper boundary by assessing whether expansions of exclusive rights or restrictions on exceptions and limitations violate other European Convention provisions, such as freedom of expression and the right of privacy.²³¹

The intellectual property balancing paradigm finds some support in recent European human rights jurisprudence. With respect to Article 1, the Court in both *Anheuser-Busch* and *Dima* suggested that retroactive laws that deprive intellectual property owners of an existing asset may violate Article 1. This concern extends not only to interactions between the state and rights holders, but also to disputes between private parties.²³²

With respect to other human rights, the ECHR recently decided a string of cases challenging the Austrian Copyright Act's ban on public dissemination of '[p]ortraits of persons' that cause injury to 'the legitimate interests of the persons portrayed'.²³³ In each case, the Court held that injunctions prohibiting newspapers from publishing photographs of politicians or individuals involved in matters of public interest violated the right to freedom of expression.²³⁴ In reaching this result, the ECHR stated that freedom of expression 'protects not only the substance of ideas and information but also the form in which they are conveyed'.²³⁵ The Court also conducted a detailed and fact-intensive balancing analysis, weighing the interests of the individuals whose images were disseminated against the media's interest in conveying information to the public.²³⁶

Several predictions follow from these two lines of decisions. The first concerns retroactive restrictions of property rights. When governments revise intellectual property protection standards, they generally apply the revisions to works

230. See *supra* Part II.D.

231. European Convention, *supra* n. 2, Art. 10(1) ('Everyone has the right to freedom of expression. This right shall include freedom to . . . receive and impart information and ideas without interference by public authority and regardless of frontiers. '); *id.* Art. 8(1) ('Everyone has the right to respect for his private and family life, his home and his correspondence.').

232. See *Anheuser-Busch Inc. v. Portugal*, App. No. 73049/01, 45 Eur. H.R. Rep. 36 [830] (Grand Chamber 2007); *Dima v. Romania*, App. No. 58472/00, paras 87–92 (2005) (admissibility decision).

233. Urheberrechtsgesetz – UrhG. Bundesgesetz über das Urheberrecht an Werken der Literatur und der Kunst und über verwandte Schutzrechte [UrhG] [Federal Law on Copyright in Works of Literature and Art. and on Related Rights] Bürgerliches Gesetzbuch [BGB1] No. 111/1936, § 78 (1) (Austria) ('Portraits of persons may not be exhibited or otherwise distributed in a manner which would make them available to the public if legitimate interests of the person portrayed, or, should he have died without authorizing or ordering the publication of the portrait, of a close relative would be prejudiced.').

234. See, e.g., *Österreichischer Rundfunk v. Austria*, App. No. 35841/02, paras 72–73 (2006); *Verlagsgruppe News GmbH v. Austria* (No. 2), App. No. 10520/02, para. 29 (2006); *Krone Verlags GmbH & Co KG v. Austria*, App. No. 34315/96, 36 Eur. H.R. Rep. 57 [1059], 1066 (2003) (judgment of 26 February 2002); *News Verlags GmbH & CoKG v. Austria*, 2000-I Eur. Ct. H.R. 157, 174–175.

235. *Verlagsgruppe News GmbH*, App. No. 10520/02, para. 29.

236. See *News Verlags GmbH*, 2000-I Eur. Ct. H.R. at 175–77; *Österreichischer Rundfunk*, App. No. 35841/02 paras 62–73; *Verlagsgruppe News GmbH*, App. No. 10520/02 paras 34–44.

already in existence as well as to those yet to be created.²³⁷ Where such modifications reduce the level of protection, they may upset rights holders' reasonable expectations and investments made in reliance on the prior legal regime.²³⁸ Although expansions of exclusive rights have received the lion's share of attention in recent years,²³⁹ contractions are more widespread than is commonly believed.

Consider a few examples of diminutions of intellectual property protection standards that apply to pre-existing works. Belgium recently introduced a new research exemption and a compulsory license for public health uses of biotechnology patents.²⁴⁰ The United Kingdom eliminated perpetual protection for unpublished copyrighted works in 1989.²⁴¹ Germany and Belgium amended their copyright statutes to implement a 2001 EC Directive on the harmonization of copyright.²⁴² The new laws authorize users 'to demand from the right holder any support required for the exercise of certain legitimate uses. This means that if a technical measure hinders a user in a use permitted by law, the user can ask a judge to enforce his limitation.'²⁴³

237. Nothing in Art. 1 or ECHR case law prohibits governments from limiting diminutions of intellectual property protection standards to inventions, creations, and signs that have yet to be created. In practice, however, states rarely limit protection in this way.

238. See Rochelle Cooper Dreyfuss, *Patents and Human Rights: Where Is the Paradox?*, Molengrafica Series, at 9 n. 43 (2006) (unpublished), available at <http://papers.ssrn.com/sol3/papers.cfm?abstract_id=929498> (arguing against protecting patents as human rights but stating that 'there is a grey area where investments made in reliance on a particular scheme of patent protection are frustrated by a change in regime; whether the change amounts to a taking of property is arguably a hard question').

239. See *id.* at 9–12.

240. See Geertrui Van Overwalle, 'The Implementation of the Biotechnology Directive in Belgium and Its After-Effects', *Int'l Rev. Intell. Prop. & Comp. L.* 37 (2006): 889, 905–918 (describing the scope of the exemption and compulsory license in Belgium).

241. See R. Anthony Reese, 'The New Property', *Tex. L. Rev.* 85 (2007): 585, 608 The law provides a fifty-year transition period, so that works unpublished in that year date will be protected until the end of 2039.

242. Council Directive 2001/29/EC, *pmb.*, 2001 O.J. (L 167) 10, 11. The Act of 22 May 2005 amended Belgium's copyright legislation to implement the directive. See I Melville B. Nimmer & Paul E. Geller, *International Copyright Law and Practice*, BEL § 1 (Belgium). The Amendment of 10 September 2003 implemented the directive in Germany. See Nimmer & Geller, *supra* n. 193, GER § 1 (Germany).

243. Christophe Geiger, 'Copyright and Free Access to Information: For a Fair Balance of Interests in a Globalised World', *Eur. Intell. Prop. Rev.* 28 (2006): 366, 370 & n. 44.

Not all European countries have successfully limited intellectual property protection standards. In France, for example, a draft law implementing the EC Directive initially included a provision requiring Apple Computer to license its FairPlay digital rights management for use in devices that compete with its highly successful iPod. The Constitutional Council declared the provision to violate the right of property in the French Constitution. Crampton, *supra* n. 20, at C9; Charles Jade, 'Parts of French "iPod Law" Ruled Unconstitutional', *Ars Technica*, 29 July 2006, <<http://arstechnica.com/news.ars/post/20060729-7380.html>>. French courts are widely known for their strong support for authors' rights; see Hugenholtz, *supra* n. 22, at 357. A similar law in a different jurisdiction might well survive a constitutional challenge, paving the way for rights holders to file a complaint with the ECHR.

As applied to pre-existing works, each of these statutory revisions interferes with an existing possession and thus raises the retroactivity concerns identified by the Grand Chamber in *Anheuser-Busch*. If rights holders challenge these laws as violating Article 1, the ECHR would need to address the third and most difficult issue in the tripartite framework developed above – whether the laws strike a fair and proportional balance between the rights of intellectual property owners and the broader public interest.²⁴⁴

This inquiry raises questions whose answers have important systemic consequences. For example, what is the relationship between the fair and proportional balance standard and the ‘three-step test’ that TRIPs uses to regulate exceptions and limitations in national copyright, patent, and trademark laws?²⁴⁵ If the Article 1 standard is more *lenient* than the three-step test, rights holders whose complaints are rejected by the ECHR could petition their governments to challenge the exceptions as a violation of TRIPs, taking what is, in effect, an appeal from the ECHR to the WTO. If the Article 1 standard is more *restrictive* than the three-step test, rights holders will have an incentive to challenge exceptions and limitations before the ECHR, bypassing the WTO dispute settlement system’s political filters²⁴⁶ and adding more cases to the Court’s docket. Even if Article 1 and the three-step test impose *equivalent* restrictions, their substantive standards will undoubtedly differ. This will create complexity and uncertainty for both rights holders and users and increase opportunities for protracted, duplicative litigation and forum shopping.

These problems will only be compounded if the ECHR invokes other individual liberties to establish an upper human rights boundary on intellectual property protection standards. Although a detailed treatment of these issues is beyond the scope of this article, recent national court rulings and the writings of commentators suggest the kinds of cases that the ECHR may soon face.²⁴⁷ As one scholar has predicted:

[F]reedom of expression arguments are likely to succeed against copyright claims aimed at preventing political discourse, curtailing journalistic or artistic freedoms, suppressing publication of government-produced information or impeding other forms of ‘public speech’. In practice, this might imply that the [ECHR] would be willing to find violations of Article 10 [protecting the right to freedom of expression] if national courts fail to interpret broadly or ‘stretch’

244. See *supra* Part II.D & III.C.

245. For example, Art. 13 of TRIPs confines exceptions and limitations to copyright to ‘certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder’. TRIPs, *supra* n. 89, Art. 13. See also *id.* Art. 17 (trademark), Art. 30 (patent).

246. See Sykes, *supra* n. 223 (discussing how the restriction of judicial access to states functions as a political filter on WTO dispute settlement).

247. See Geiger, *Constitutionalising Intellectual Property Law*, *supra* n. 15, at 394–396 (discussing court decisions from Austria, the Netherlands and Germany in which freedom of expression and the public’s right to information prevailed over claims for protection by copyright and trademark owners).

existing copyright limitations to permit quotation, news reporting, artistic use or reutilization of government information. The Court might also be willing to find national copyright laws in direct contravention of Article 10 if they fail to provide exceptions for uses such as parody.²⁴⁸

There are several reasons to be concerned about the ECHR imposing upper and lower limits on intellectual property protection standards. First, the rights and freedoms in the European Convention, even when viewed collectively, do not provide a coherent blueprint for the Court to undertake such a sensitive and policy-laden function. Unlike the Universal Declaration of Human Rights²⁴⁹ and the International Covenant on Economic, Social and Cultural Rights,²⁵⁰ the Convention does not contain a single provision that expressly balances the rights of authors and inventors²⁵¹ against the public's right to benefit from the scientific and cultural advances that knowledge goods can engender.²⁵² In the absence of such a provision, the ECHR's interventions at the upper and lower boundaries of protection will inevitably be ad hoc. They also create a risk of both underprotection and overprotection, depending on the vagaries of which cases are filed, in what order, and how the Court extends its jurisprudence over time.²⁵³

Second, and more fundamentally, the European Convention does not provide a mechanism to address the utilitarian and social welfare arguments that are central to intellectual property law and policy.²⁵⁴ If the ECHR adopts the balancing paradigm, the disputes it reviews will be framed not in utilitarian terms but as clashes pitting one group of rights holders (intellectual property owners) against another

248. Hugenholtz, *supra* n. 22, at 362.

249. Universal Declaration of Human Rights, G.A. Res. 217A, at 71, U.N. GAOR, 3d Sess., 1st plen. mtg., U.N. Doc. A/810 (10 December 1948) [hereinafter UDHR].

250. International Covenant on Economic, Social and Cultural Rights, Arts 15(1)(b), 15(1)(c), 16 December 1966, 993 U.N.T.S. 3 [hereinafter ICESCR].

251. UDHR, *supra* n. 249, Art. 27(2) ('Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he [or she] is the author. '); ICESCR, *supra* n. 250, Art. 15(1)(c) (recognizing the same right in nearly identical language).

252. ICESCR Art. 15 recognizes 'the right of everyone' to 'enjoy the benefits of scientific progress and its applications', and obligates states to take steps 'necessary for the conservation, the development and the diffusion of science and culture'. ICESCR, *supra* n. 250, Arts 15(1)(b), 15(2). Similarly, the UDHR protects the right of everyone 'freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits'. UDHR, *supra* n. 249, Art. 27(1).

253. The above statement does not imply that the authors' rights provisions of the ICESCR and UDHR provide a fully coherent framework for a human rights-inspired conception of intellectual property. To the contrary, such a framework remains to be specified through, for example, additional general comments of the ICESCR Committee, the decisions of national courts, and the writing of commentators.

254. See Dreyfuss, *supra* n. 238, at 13–18 (critiquing human rights approaches to intellectual property as ignoring utilitarian concerns). But see Geiger, *Constitutionalising Intellectual Property Law*, *supra* n. 15, at 388 (arguing that human rights 'are effective tools to guarantee a balanced development and understanding of IP rights and a remedy for the overprotective tendencies of lobby-driven legislation').

(such as consumers or the media). The Court will respond to these competing claims by weighing one right against the other. Much has been written about the problematic nature of constitutional balancing methodologies.²⁵⁵ These concerns are even more compelling when rights claims are infused with the myriad contestations of economic and social policy that intellectual property disputes inevitably engender.

A third and final reason to eschew the intellectual property balancing paradigm concerns the multiplier and feedback effects of ECHR rulings. Formally, the Court's judgments are only binding as a matter of international law and only upon the parties to each dispute.²⁵⁶ But the influence of European human rights jurisprudence is far more sweeping in practice. In some countries, national courts give direct effect to ECHR judgments, a method of compliance that leaves little room for legislative compromises that preserve competing national values.²⁵⁷ In addition, legislators and courts across Europe – including the European Court of Justice²⁵⁸ – consult ECHR case law when drafting or interpreting statutes and constitutions.²⁵⁹ These consultations extend the Court's influence and further constrain the discretion of domestic decision-makers to set national intellectual property policies.²⁶⁰ As a result, even if the ECHR intervenes in intellectual property issues only rarely, its rulings will likely have extensive regional effects.

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255. See, e.g., T. Alexander Aleinikoff, 'Constitutional Law in the Age of Balancing', Yale L.J. 96 (1987): 943, 972–983 (critiquing case-by-case or ad hoc balancing standards in constitutional adjudication). The difficulties with balancing tests include determining which factors a court should weigh against each other and whether those factors can be measured on the same scale. More generally, balancing 'expands judicial discretion [and] frees it substantially from the need to justify and persuade. . . . [I]t gives a view of judicial review that is intuitional, if not incomprehensible.' Louis Henkin, 'Infallibility under Law: Constitutional Balancing', Colum. L. Rev. 78 (1978): 1022, 1047–1049.
256. *European Convention*, *supra* n. 2, Art. 46(1) ('The High Contracting Parties undertake to abide by the final judgment of the Court in a case to which they are parties').
257. See, e.g., Council of Europe, Committee of Ministers, Judgments by the European Court of Human Rights, ResDH(2006)27E (7 June 2006), available at <<https://wcd.coe.int/ViewDoc.jsp?id=1008059&Site=CM&BackColorInternet=9999CC&BackColorIntranet=FFBB55&BackColorLogged=FFAC75>> (quoting the government of Greece's statement that 'the Convention and the Court's case law enjoy direct effect in Greek law', and citing a 2005 Court of Cassation decision that 'recognised and stressed the supra-statutory force of Art. 1 of Protocol No. 1 to the Convention'); Frank Hoffmeister, 'Germany: Status of European Convention on Human Rights in Domestic Law', Int'l J. Const. L. 4 (2006): 722, 726–728 (reviewing the legal status of the European Convention in Member States).
258. See, e.g., *Regione Autonoma Friuli-Venezia Giulia v. Ministero delle Politiche Agricole e Forestali*, 2005 E.C.R. I-3785, para. 125 (referencing the 'case-law of the European Court of Human Rights' as establishing the standard for assessing whether government controls on the use of property are compatible with European Community law); *Laserdisken ApS v. Kulturministeriet*, 2006 E.C.R. I-08089, para. 65 (stating that 'intellectual property rights . . . form part of the right to property').
259. See Tom Barkuysen & Michel L. van Emmerik, 'A Comparative View on the Execution of Judgments of the European Court of Human Rights' in *ECHR Remedies*, 1, 15, 19, *supra* n. 217.
260. See *id.* at 12 (describing Dutch legislative proposals that were modified to comply with Art. 1 and stating that 'in recent years the right to property, contained in Article 1 . . . seems to have been discovered in legal practice' and 'is gaining more attention in the legislative process').

V. CONCLUSION

This article provides the first comprehensive analysis of the intellectual property jurisprudence of the European Court and Commission of Human Rights under the property rights clause of the European Convention on Human Rights. It organizes the tribunals' decisions interpreting Article 1 of Protocol 1 into a tripartite framework that exposes the many points of intersection – and of potential conflict – between human rights and intellectual property. It also provides a vision of how the ECHR's intellectual property jurisprudence may evolve in the future by developing three paradigms that the Court may follow, each of which has very different consequences for innovation and creativity policies in Europe.

The article concludes that the rule of law paradigm, which targets arbitrary government conduct, presents the strongest justification for the ECHR to find in favour of intellectual property owners. Such a minimalist approach serves the core European Convention values of promoting predictability, certainty, and adherence to the rule of law. And it does so without unduly constraining the discretion of national legislators and judges to tailor domestic intellectual property rules to local circumstances.

A more equivocal case can be made for the enforcement paradigm, which requires national governments to provide the minimal administrative, judicial, and criminal procedures necessary for intellectual property owners to challenge infringements of their protected works. Finding Article 1 violations where a state fails to adopt such procedures provides an alternative enforcement mechanism for rights holders to prevent widespread intellectual property piracy. It does so, however, by circumventing the political filter that prevents private parties from litigating intellectual property complaints in the WTO dispute settlement system.

The intellectual property balancing paradigm presents the least persuasive case for ECHR intervention. Under this approach, the Court determines the legality of diminutions of intellectual property by applying Article 1's fair and proportional balance standard. It assesses the legality of expansions of intellectual property under other European Convention provisions, such as freedom of expression and the right of privacy. Adoption of the balancing paradigm would create several interrelated problems, including greater complexity and uncertainty and increased opportunities for forum shopping. The paradigm would also transform the ECHR into an arbiter of intellectual property law and policy in Europe, a role that the Court is jurisprudentially and institutionally ill-suited to play.

Finally, this article highlights the broader theoretical and doctrinal controversies over the intersection of human rights, property rights, and intellectual property. The boundaries between these three areas of law are increasingly overlapping, leading to contestations among rights holders, governments, consumers, and nongovernmental organizations. These contestations are playing out in multiple venues, including domestic courts, international tribunals, national legislatures, and intergovernmental organizations. As these controversies become more contentious and more pervasive, government officials, scholars, and policymakers in Europe and elsewhere would benefit from the cautionary lessons that the ECHR's intellectual property jurisprudence offers.

Chapter 3

Challenges to the Development of a Human-Rights Framework for Intellectual Property

*Peter K. Yu**

I. INTRODUCTION

Since the establishment of the World Trade Organization (WTO) and the entering into effect of the Agreement on Trade-Related Aspects of Intellectual Property Rights¹ (TRIPS Agreement), government officials, international bureaucrats, inter-governmental and nongovernmental organizations, courts, and scholars have focused considerable attention on the interplay of intellectual property and human rights. In recent years, scholars have begun to advocate the development of ‘a comprehensive and coherent “human rights framework” for intellectual property law and policy’.²

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1. Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C (1994) 33 ILM 1197.
2. L.R. Helfer, ‘Toward a Human Rights Framework for Intellectual Property’, *U.C. Davis Law Review* 40 (2007): 977–1020; P.K. Yu, ‘Reconceptualizing Intellectual Property Interests in a Human Rights Framework’, *U.C. Davis Law Review* 40 (2007): 1039–1149.

As I pointed out elsewhere, such a framework would not only be socially beneficial, but would also enable countries to develop a balanced intellectual property system that takes into consideration their international human rights obligations.³

To help better understand the interplay of intellectual property and human rights, and how such a framework can be developed, the Committee on Economic, Social and Cultural Rights (CESCR) recently provided an authoritative interpretation of Article 15(1)(c) of the International Covenant on Economic, Social and Cultural Rights (ICESCR)⁴ in General Comment No. 17.⁵ At the outset, the Committee distinguished the right to the protection of interests in intellectual creations ‘from most legal entitlements recognized in intellectual property systems’.⁶ As the Committee elaborated:

Human rights are fundamental as they are inherent to the human person as such, whereas intellectual property rights are first and foremost means by which States seek to provide incentives for inventiveness and creativity, encourage the dissemination of creative and innovative productions, as well as the development of cultural identities, and preserve the integrity of scientific, literary and artistic productions for the benefit of society as a whole.

In contrast to human rights, intellectual property rights are generally of a temporary nature, and can be revoked, licensed or assigned to someone else. While under most intellectual property systems, intellectual property rights, often with the exception of moral rights, may be allocated, limited in time and scope, traded, amended and even forfeited, human rights are timeless expressions of fundamental entitlements of the human person. Whereas the human right to benefit from the protection of the moral and material interests resulting from one’s scientific, literary and artistic productions safeguards the personal link between authors and their creations and between peoples, communities, or other groups and their collective cultural heritage, as well as their basic material interests which are necessary to enable authors to enjoy an adequate standard of living, intellectual property regimes primarily protect business and corporate interests and investments. Moreover, the scope of protection of the moral and material interests of the author provided for by article 15, paragraph 1 (c), does not necessarily coincide with what is referred to as intellectual property rights under national legislation or international agreements.⁷

To highlight the distinction and avoid confusion between the right protected in Article 15(1)(c) and the so-called intellectual property rights – a catch-all term that is used to describe copyrights, patents, trademarks, trade secrets, and other existing

3. Yu, n. 2 above, at 1123.

4. International Covenant on Economic, Social and Cultural Rights, Art. 15(1)(c), 16 December 1966, 993 UNTS 3.

5. Committee on Economic, Social and Cultural Rights, General Comment No. 17: The Right of Everyone to Benefit from the Protection of the Moral and Material Interests Resulting from Any Scientific, Literary or Artistic Production of Which He Is the Author (Art. 15(1)(c)), para. 35, 12 January 2006, U.N. Doc. E/C.12/GC/17.

6. *Ibid.*, para. 1.

7. *Ibid.*, para. 2.

and newly-created related rights – this chapter uses throughout the term ‘the right to the protection of moral and material interests in intellectual creations’ – or, its shorter form, ‘the right to the protection of interests in intellectual creations’. Although these terms seem long and clumsy, they are superior to their shorthand counterparts, as those titles tend to ‘obscure the real meaning of the obligations that these rights impose’.⁸

While the development of a human rights framework for intellectual property is important, sceptics have expressed concern over the danger of an ‘arranged marriage’ between intellectual property and human rights. Their scepticism is not new. During the drafting of Article 27(2) of the Universal Declaration of Human Rights (UDHR)⁹ and Article 15(1)(c) of the ICESCR, delegates already expressed their concern about including in human rights instruments the protection of interests in intellectual creations. Some delegates found the protection redundant with that offered by the right to private property and other rights in the instruments. Meanwhile, others considered such protection right only secondary to such fundamental human rights as prohibition on genocide, slavery, and torture; the right to life; or the right to freedom of thought, expression, association, and religion. Even today, commentators remain concerned that the continuous proclamation of new human rights will undermine both the fundamental nature of human rights and the integrity of the process of recognizing those rights.¹⁰

Although these concerns are understandable, it may be too late to deny the protection of human rights-based interests in intellectual creations. In the UDHR, the ICESCR, and many other international or regional instruments, for example, the right to the protection of interests in intellectual creations is explicitly recognized as a human right.¹¹ This chapter therefore does not seek to reopen this debate, which has been widely explored and documented elsewhere.¹² Rather, it examines three new challenges that may confront the development of this framework, especially from the pro-development perspective:

- (1) the ‘human rights ratchet’ of intellectual property protection;
- (2) the undesirable capture of the human rights forum by intellectual property rights-holders; and

8. M. Sepúlveda, *The Nature of the Obligations under the International Covenant on Economic, Social and Cultural Rights* (Antwerp: Intersentia, 2003), 8.

9. Universal Declaration of Human Rights, G.A. Res. 217A, Art. 27(2), U.N. GAOR, 3rd Sess., 1st plen. mtg., 10 December 1948, U.N. Doc. A/810.

10. P. Alston, ‘Conjuring up New Human Rights: A Proposal for Quality Control’, *American Journal of International Law* 78 (1984): 607–621.

11. See, for example, Additional Protocol to the American Convention on Human Rights in the Area of Economic, Social and Cultural Rights (Protocol of San Salvador), Art. 14(1)(c), opened for signature 17 November 1988, O.A.S.T.S. No. 69, (1989) 28 ILM 161; ICESCR, n. 4 above, Art. 15(1)(c); Organization of American States, American Declaration of the Rights and Duties of Man, Art. 13, 2 May 1948, OEA/Ser. L./V./II.23, doc. 21 rev. 6 (1948); UDHR, n. 9 above, Art. 27(2).

12. J. Morsink, *The Universal Declaration of Human Rights: Origins, Drafting, and Intent* (Philadelphia: University of Pennsylvania Press, 1999), 217–222; M. Green, Drafting History of the Article 15(1)(c) of the International Covenant, para. 45, 9 October 2000, U.N. Doc. E/C.12/2000/15; Yu, n. 2 above, at 1047–1075.

- (3) the framework's potential bias against non-Western cultures and traditional communities.¹³

To be certain, there are additional challenges. From the standpoint of intellectual property rights-holders, there is also a growing concern that the development of a human rights framework for intellectual property will undermine the balance of existing intellectual property systems. Just as public interest advocates are concerned about the *upward* ratchet of intellectual property rights through their association with human rights, rights-holders are equally concerned about the *downward* ratchet of intellectual property rights, due to the fact that those attributes or forms of intellectual property rights that do not have human rights basis are likely to be deemed less important through a human rights lens. Notwithstanding this important concern, this chapter focuses primarily on the pro-development concerns raised by the development of human rights framework for intellectual property. It seeks to explain why this framework will benefit not only individual authors and inventors, but also less developed countries and traditional communities.

II. THE 'HUMAN RIGHTS' RATCHET

As intellectual property rights become increasingly globalized, there is a growing concern about the 'one-way ratchet' of intellectual property protection. As critics have claimed, the growing protection of intellectual property not only jeopardizes access to information, knowledge, and essential medicines throughout the world, but it also has heightened the economic plight and cultural deterioration of less developed countries and indigenous communities. To these critics, it would be highly undesirable to elevate the status of all attributes or forms of intellectual property rights to that of human rights regardless of whether these attributes or forms have any human rights basis.

As Kal Raustiala recently noted, 'the embrace of [intellectual property] by human rights advocates and entities . . . is likely to further entrench some dangerous ideas about property: in particular, that property rights as human rights ought to be inviolable and ought to receive extremely solicitous attention from the international community'.¹⁴ An emphasis of the human rights attributes in intellectual property rights is also likely to further strengthen intellectual property rights, especially in civil law countries where judges are more likely to uphold rights that are considered human rights. As a result, the development of a human rights framework for intellectual property would result in the undesirable 'human rights' ratchet of intellectual property protection. Such development would exacerbate the already severe imbalance in the existing intellectual property system. It might also

13. This chapter uses the term 'traditional communities', rather than 'indigenous communities', because the former captures a larger group of people who benefit from the protection of folklore and traditional knowledge, innovations and practices. Yu, n. 2 above, at 1047 n. 18.

14. K. Raustiala, 'Density and Conflict in International Intellectual Property Law', *U.C. Davis Law Review* 40 (2007): 1032.

hamper the growing efforts to use the human rights forum to set maximum limits of intellectual property protection, thereby enriching the public domain and promoting access to information, knowledge, and essential medicines.

While I am sympathetic to these concerns, the existing international instruments have recognized only certain attributes of existing intellectual property rights as human rights.¹⁵ Because only *some* attributes of intellectual property rights can be considered human rights, international human rights treaties do not protect the remaining non-human-rights attributes of intellectual property rights or those forms of intellectual property rights that have no human rights basis. Thus, in a human rights framework for intellectual property, the human rights attributes of intellectual property rights will receive its well-deserved recognition as human rights. However, the status of those attributes or forms of intellectual property rights that have no human rights basis will not be elevated to that of human rights. As the CESCR reminded governments in its Statement on Intellectual Property Rights and Human Rights, they have a duty to take into consideration their human rights obligations in the implementation of intellectual property policies and agreements and to subordinate these policies and agreements to human rights protection in the event of a conflict between the two.¹⁶

Moreover, although states have obligations to fully realize the right to the protection of interests in intellectual creations, their ability to fulfil these obligations is often limited by the resources available to them and the competing demands of the core minimum obligations of *other* human rights. Indeed, the right to the protection of interests in intellectual creations has been heavily circumscribed by the right to cultural participation and development, the right to the benefits of scientific progress, the right to food, the right to health, the right to education, the right to self-determination, as well as many other human rights. For example, some commentators have suggested that the right to the benefits of scientific progress ‘carries the inference that the right involved should promote socially beneficial applications and safeguard people from harmful applications of science that violate their human rights’.¹⁷ Depending on the jurisdiction, such a right can be translated into *ordre public* exceptions that are similar to those found in Article 27(2) of the TRIPS Agreement¹⁸ and Article 53(a) of the European Patent Convention.¹⁹

In fact, Article 5(1) of the ICESCR states that ‘nothing in the present Covenant may be interpreted as implying for any State, group or person any right to engage in

15. Yu, n. 2 above, at 1079–1092.

16. Intellectual Property Rights and Human Rights, Sub-Commission on Human Rights Res. 2000/7, para. 3, 17 August 2000, U.N. Doc. E/CN.4/Sub.2/RES/2000/7.

17. R.P. Claude, ‘Scientists’ Rights and the Human Right to the Benefits of Science’, in *Core Obligations: Building a Framework for Economic, Social and Cultural Rights*, eds A. Chapman & S. Russell (Antwerp: Intersentia, 2002), 255.

18. TRIPS Agreement, n. 1 above, Art. 27(2).

19. Convention on the Grant of European Patents, Art. 53(a), 5 October 1973, as amended by Decision of the Administration Council of the European Patent Organization of 21 December 1978, (1974) 13 ILM 268.

any activity or to perform any act aimed at the destruction of any of the rights or freedoms recognized herein, or at their limitation to a greater extent than is provided for in the present Covenant'.²⁰ Thus, the ICESCR presumes that states would not be able to expand their protection of interests in intellectual creations at the expense of both existing protection and the core minimum obligations of other human rights.²¹ As General Comment No. 17 stated:

As in the case of all other rights contained in the Covenant, there is a strong presumption that retrogressive measures taken in relation to the right to the protection of the moral and material interests of authors are not permissible. If any deliberately retrogressive measures are taken, the State party has the burden of proving that they have been introduced after careful consideration of all alternatives and that they are duly justified in the light of the totality of the rights recognized in the Covenant.²²

Notwithstanding these limitations, there remains a strong possibility that the status of all intellectual property rights, regardless of their bases, will be elevated to that of human rights in rhetoric even if that status will not be elevated in practice. Indeed, intellectual property rights-holders have widely used the rhetoric of private property to support their lobbying efforts and litigation,²³ despite the many limitations, safeguards, and obligations in the property system, such as adverse possessions, easements, servitudes, irrevocable licenses, fire and building codes, zoning ordinances, the rule against perpetuities, and the eminent domain, waste, nuisance, and public trust doctrines.²⁴ The property gloss over intellectual property rights has also confused policymakers, judges, jurors, and commentators, even though there are significant differences between the attributes of real property and those of intellectual property.²⁵ Using this line of reasoning, it is, therefore, understandable

20. ICESCR, n. 4 above, Art. 5(1).

21. General Comment No. 17, n. 5 above, para. 35.

22. *Ibid.*, para. 27.

23. On the use of the private property rhetoric to expand intellectual property protection, see T.W. Bell, 'Authors' Welfare: Copyright as a Statutory Mechanism for Redistributing Rights', *Brooklyn Law Review* 69 (2003): 273–277; N.W. Netanel, 'Impose a Noncommercial Use Levy to Allow Free Peer-to-Peer File Sharing', *Harvard Journal of Law and Technology* 17 (2003): 22; S.E. Sterk, 'Intellectualizing Property: The Tenuous Connections between Land and Copyright', *Washington University Law Quarterly*, 83 (2005): 420; R.M. Stallman, 'Did You Say "Intellectual Property"? It's a Seductive Mirage', <www.fsf.org/licensing/essays/not-ipr.xhtml>, 12 July 2007.

24. W.W. Fisher III, *Promises to Keep: Technology, Law, and the Future of Entertainment* (Stanford: Stanford University Press, 2004), 140–143; J. Boyle, 'Foreword: The Opposite of Property?', *Law and Contemporary Problems* 66, no. 1–2 (2003): 32; M.A. Carrier, 'Cabining Intellectual Property through a Property Paradigm', *Duke Law Journal* 54 (2004): 52–144; J. Lipton, 'Information Property: Rights and Responsibilities', *Florida Law Review* 56 (2004): 165–189; P.K. Yu, 'Intellectual Property and the Information Ecosystem', *Michigan State Law Review*, (2005): 6.

25. On differences between attributes of real property and those of intellectual property, see M.A. Lemley, 'Property, Intellectual Property, and Free Riding', *Texas Law Review* 83

why some public interest advocates have been concerned about the ‘marriage’ of intellectual property and human rights.

While their concerns are valid and important, the best response to alleviate these concerns is not to dissociate intellectual property rights from human rights or to cover up the fact that some attributes of intellectual property rights are, indeed, protected in international or regional human rights instruments. Rather, it is important to clearly delineate which attributes of intellectual property rights would qualify as human rights and which attributes or forms of those rights should be subordinated to human rights obligations due to their lack of any human right basis. In doing so, a human rights framework will highlight the moral and material interests of individual authors and inventors while exposing the danger of increased expansion of those attributes or forms of intellectual property rights that have no human rights basis at all.

Consider, for example, the growing expansion of corporate intellectual property rights. None of these rights would qualify as human rights, because they do not have any human rights basis. As Maria Green noted with respect to the ICESCR, ‘[t]he drafters do not seem to have been thinking in terms of the corporation-held patent, or the situation where the creator is simply an employee of the entity that holds the patent or the copyright.’²⁶ As pointed out in the beginning of this chapter, the CESCR also emphasized the importance of not equating intellectual property rights with the human right recognized in Article 15(1)(c).²⁷ In distinguishing between the two, General Comment No. 17 pointed out that, while human rights – including the right to the protection of interests in intellectual creations – focus on individuals, groups of individuals, and communities, ‘intellectual property regimes primarily protect business and corporate interests and investments’.²⁸ Because corporate entities remain outside the protection of human rights instruments, ‘their entitlements . . . are not protected at the level of human rights’.²⁹

The two strongest claims corporate rights-holders could make are as follows: first, because their intellectual property interests were initially derived from the human-rights-based interests of individual authors or inventors, damage to corporate interests would jeopardize these individual interests by reducing the opportunities the individuals have and the remuneration they will receive; and second, because corporate rights-holders are seeking protection on behalf of individual shareholders of the human-rights-based property interests in their investments, corporate intellectual property rights need to be strongly protected.

These claims are rather weak. However, even if they are to be accepted, there will be at least two counter-responses. First, the reduction of opportunities and remuneration might not reach the level of a human-rights violation. As the drafting

(2005): 1031–1075; Sterk, n. 23 above. On the controversy over the term ‘intellectual property’, see Yu, n. 24 above, at 11–16.

26. Green, n. 12 above, para. 45.

27. General Comment No. 17, n. 5 above, para. 3.

28. *Ibid.*, para. 2.

29. *Ibid.*, para. 7.

history of the UDHR has shown, the right to the protection of interests in intellectual creations was not designed to protect the unqualified property-based interests in intellectual creations, but rather to protect the narrow interest of just remuneration for intellectual labour.³⁰ Thus, it is important to distinguish between full and just remuneration, as the right holder may not receive the full value of the use of his or her protected content.³¹

Second, the core minimum obligation focuses mainly on protecting the ‘basic material interests which are necessary to enable authors to enjoy an adequate standard of living’.³² Even if one subscribes to the view that property rights are the best means to protect these basic interests, there remains a need to define the amount of property rights needed to protect these basic interests. Article 28 of the American Declaration of the Rights and Duties of Man, for example, states that ‘every person has a right to own such private property as meets the essential needs of decent living and helps to maintain the dignity of the individual and of the home’.³³ As Chilean delegate Hernan Santa Cruz observed during the UDHR drafting process, ‘[o]wnership of anything more than [what is required under this language] might not be considered a basic right’.³⁴ In other words, the right to the protection of interests of intellectual creations only require the protection of sufficient intellectual property-based interests; it does not cover those additional interests that are generally not required to meet the essential needs of decent living or to maintain human dignity.

To be certain, countries are free to extend through national legislation ‘human-rights’-like protection to corporations or other collective entities. As Craig Scott pointed out, ‘[w]ithin the European regional human-rights system, powerful companies no less than wealthy individuals may bring, and have indeed brought, claims of violation of their “human” rights before the European Court of Human Rights [ECHR]’.³⁵ Although litigants ‘have had very limited success invoking Article 1 of Protocol No. 1 due to the European Court’s relatively “social conception of both the state and the function of property”’,³⁶ their likelihood of success has been greatly enhanced by the recent judgement of *Anheuser-Busch, Inc. v. Portugal*, in which the Grand Chamber of the ECHR

30. Yu, n. 2 above, at 1087–1088.

31. C. Krause, ‘The Right to Property’, in *Economic, Social and Cultural Rights: A Textbook*, eds A. Eide, C. Krause & A. Rosas, 2nd rev. ed., (Boston: Martinus Nijhoff Publishers, 2001), 201.

32. General Comment No. 17, n. 5 above, para. 2.

33. American Declaration, n. 11 above, Art. 23.

34. Morsink, n. 12 above, at 145.

35. C. Scott, ‘Multinational Enterprises and Emergent Jurisprudence on Violations of Economic, Social and Cultural Rights’, in *Economic, Social and Cultural Rights: A Textbook*, eds A. Eide, C. Krause & A. Rosas, 2nd rev. ed. (Boston: Martinus Nijhoff Publishers, 2001), 564, n. 3.

36. *Ibid.* As Uma Suthersanen pointed out, ‘The property provision under the [European Convention on Human Rights] is qualified in that deprivation or third-party use of property is expressly allowed for “public interest” or “general interest” reasons.’ U. Suthersanen, ‘Towards an International Public Interest Rule? Human Rights and International Copyright Law’, in *Copyright and Free Speech: Comparative and International Analyses*, eds J. Griffiths & U. Suthersanen (Oxford: Oxford University Press, 2005), 107.

held that Article 1 protects both registered marks and trademark applications of a multinational corporation.³⁷

Thus, to ensure that corporate intellectual property rights will not be ratcheted up through their association with human rights, it is important to distinguish between corporate actors that have standing to bring human-rights claims and those that actually claim that their ‘human’ rights have been violated. While it is acceptable, and socially beneficial at times, to allow corporate actors to bring human-rights claims on behalf of individuals whose rights have been violated, it is disturbing that these actors can actually claim that their ‘human’ rights have been violated. As Jack Donnelly put it emphatically, ‘[c]ollectives of all sorts have many and varied rights. But these are not – cannot be – human rights, unless we substantially recast the concept’.³⁸

Second, General Comment No. 17 clearly distinguished between fundamental, inalienable, and universal human rights and temporary, assignable, revocable, and forfeitable intellectual property rights. In making this distinction, the comment seems to suggest that human-rights instruments do not cover the protection of transferable interests;³⁹ instead, it focuses on what Cassin described as the right that would survive ‘even after such a work or discovery has become the common property of mankind’.⁴⁰ Thus, the recognition of the human-rights attributes of intellectual property rights may challenge the structure of the traditional intellectual property system. In the copyright context, for example, such recognition will encourage the development of an author-centred regime, rather than one that is publisher-centred. Many publishers, therefore, are likely to find unappealing the human-rights framework for intellectual property.

Indeed, the recognition of the human-rights attributes of intellectual property rights may further strengthen the control of the work by individual authors and inventors, thus curtailing corporate control of intellectual creations as recognized by the ICESCR. The right to the protection of moral interests in the intellectual creations, for example, already exceeds the standards of protection offered under US intellectual property laws. As Laurence Helfer put it:

A human rights framework for authors’ rights is . . . both more protective and less protective than the approach endorsed by copyright and neighboring

37. *Anheuser-Busch, Inc. v. Portugal*, [2007] ECHR 73049/01 (Grand Chamber). On the increasing role of the European Court of Human Rights in innovation and creativity policies in Europe, see L.R. Helfer, ‘The New Innovation Frontier? Intellectual Property and the European Court of Human Rights’, *Harvard International Law Journal* 49 (2008) (forthcoming), available at <<http://ssrn.com/abstract=976485>>. On the emerging fundamental rights discourse on intellectual property in Europe, see C. Geiger, ‘“Constitutionalizing” Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property in the European Union’, *International Review of Intellectual Property and Competition Law* 37 (2006): 371–406.

38. J. Donnelly, *Universal Human Rights in Theory & Practice*, 2nd ed., (Ithaca: Cornell University Press, 2003), 25.

39. General Comment No. 17, n. 5 above, para. 2.

40. ‘Cassin Draft’, Art. 43, reprinted in M.A. Glendon, *A World Made New: Eleanor Roosevelt and the Universal Declaration of Human Rights* (New York: Random House, 2001), 275–280 (emphasis added).

rights regimes. It is more protective in that rights within the core zone of autonomy [that is protected by the human rights instruments] are subject to a far more stringent limitations test than the one applicable contained in intellectual property treaties and national laws. It is also less protective, however, in that a state need not recognize any authors' rights lying outside of this zone or, if it does recognize such additional rights, it must give appropriate weight to other social, economic, and cultural rights and to the public's interest in access to knowledge.⁴¹

When the United States pushed for the TRIPS Agreement, it paid special attention to ensure that 'Members shall not have rights or obligations under this Agreement in respect of the rights conferred under Article 6*bis* of that Convention or of the rights derived therefrom'.⁴² In doing so, it successfully avoided being subjected to the mandatory dispute resolution process on disputes over inadequate protection of moral rights, even though it continues to bear moral rights obligations under the virtually unenforceable Berne Convention.

While the strong protection of moral interests in intellectual creations may surprise corporate rights-holders, it may also limit access to protected materials and frustrate projects that facilitate greater unauthorized recoding or reuse of existing creative works. Indeed, General Comment No. 17 included a more stringent test than the three-step test laid out in the Berne Convention, the TRIPS Agreement, and the WIPO Internet Treaties.⁴³ Article 13 of the TRIPS Agreement, for example, outlined the three-step test by stating that the WTO Member States 'shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder'.⁴⁴ Likewise, Article 30 permits Member States to provide limited exceptions to the exclusive rights conferred by a patent, provided that such exceptions do not unreasonably conflict with a normal exploitation of the patent and do not unreasonably prejudice the legitimate interests of the patent owner, taking account of the legitimate interests of third parties.⁴⁵

Compared to these two provisions, General Comment No. 17 provided a much more stringent test. As the Committee stated, the limitations 'must be determined by law in a manner compatible with the nature of these rights, must pursue a legitimate aim, and must be strictly necessary for the promotion of the general welfare in a democratic society, in accordance with Article 4 of the Covenant'.⁴⁶ In addition, they must be proportionate and compatible with other provisions and must offer a least restrictive means to achieve the goals.⁴⁷ Under certain circumstances, 'the imposition of limitations may . . . require compensatory measures,

41. Helfer, n. 2 above, at 997.

42. TRIPS Agreement, n. 1 above, Art. 9(1).

43. Helfer, n. 2 above, at 995.

44. TRIPS Agreement, n. 1 above, Art. 13.

45. *Ibid.*, Art. 30.

46. General Comment No. 17, n. 5 above, para. 22.

47. *Ibid.*, para. 23.

such as payment of adequate compensation for the use of scientific, literary or artistic productions in the public interest'.⁴⁸

III. INSTITUTIONAL CAPTURE

The second challenge concerns the undesirable capture of the human-rights forum by intellectual property rights-holders. Because rights-holders and their supporting developed countries are rich, powerful, and organized, their greater resources and stronger organization and negotiation skills may enable them to capture the human-rights forum to the detriment of less developed countries, traditional communities, and the disadvantaged. Such institutional capture would make the human-rights forum less appealing for voicing concerns and grievances in the intellectual property area and for mobilizing resistance to increased intellectual property protection.

Indeed, it is not infrequent to hear that some governments of small countries have to give up participation in international fora due to their lack of resources. As Gregory Shaffer recounted: 'One London-based environmental NGO, the Foundation for International Environmental Law and Development [,] . . . negotiated a deal with a developing country, Sierra Leone, to represent it before the [WTO Committee on Trade and Environment]'.⁴⁹ Likewise, John McGinnis and Mark Movsesian pointed out that 'some developing nations lack the resources . . . to send delegates to these fora and thus have resorted to using nongovernmental organizations (NGOs) to represent their interests'.⁵⁰

Rights-holders can generally capture the human-rights forum in two ways. First, they can lobby their governments to aggressively protect their interests. Indeed, because intellectual property remains one of the key export items for many developed countries, the governments of these countries are likely to find a coincidence of their interests with those of the rights-holders. A case in point is the aggressive push for the establishment of the TRIPS Agreement by the United States and the European Communities. As Susan Sell described:

In the TRIPS case, private actors pursued their interests through multiple channels and struck bargains with multiple actors: domestic interindustry counterparts, domestic governments, foreign governments, foreign private sector counterparts, domestic and foreign industry associations, and international

48. *Ibid.*, para. 24.

49. G.C. Shaffer, 'The World Trade Organization under Challenge: Democracy and the Law and Politics of the WTO's Treatment of Trade and Environment Matters', *Harvard Environmental Law Review* 25 (2001): 62–63; V.T. Thamilmaran, 'Cultural Rights in International Law', in *Cultural Rights in a Global World*, eds A. Goonasekera, C. Hamelink & V. Iyer (Singapore: Eastern Universities Press, 2003), 153; A.R. Chapman & S. Russell, 'Introduction', in Chapman and Russell, n. 17 above, at 11.

50. J.O. McGinnis & M.L. Movsesian, 'The World Trade Constitution', *Harvard Law Review* 114 (2000): 57, n. 256.

organizations. They vigorously pursued their IP objectives at all possible levels and in multiple venues, successfully redefining intellectual property as a trade issue.⁵¹

Second, rights-holders can influence developments in the human-rights forum through direct participation, indirect participation (via financial support or the establishment of front organizations), or even collaboration efforts. As two commentators related concerns over the establishment of public-private partnerships in the public-health area:

In relation to the UN, fears arise that inadequately monitored relations with the commercial sector may subordinate the values and reorient the mission of its organs, detract from their abilities to establish norms and standards free of commercial considerations, weaken their capacity to promote and monitor international regulations, displace organizational priorities, and induce self-censorship, among other things. Interaction, it is argued, may result in these outcomes, not just because the sectors pursue opposing underlying interests, but because the UN, having very limited resources, may face institutional capture by its more powerful partners.⁵²

Today, ‘the movement towards human rights accountability of corporate actors has [remained] . . . an uphill battle’.⁵³ Thus, it is understandable why many commentators and activists are concerned that intellectual property rights-holders might be able to capture the human-rights forum, thus taking away from less developed countries an important venue to voice their concerns and grievances in the intellectual property area. Such institutional capture also would make it difficult for them to have access to a forum ‘to generate the political groundwork necessary for new rounds of intellectual property lawmaking in the WTO and WIPO’.⁵⁴

There are several responses, however. First, to the extent that the rights-holders, transnational corporations, and other hostile players are exploring strategies to create tactical advantages in the human-rights forum, such political manoeuvring and strategic behaviours have already been taking place. Although rights-holders and transnational corporations continue to prefer such fora as the WTO and WIPO, they have paid more attention to other fora, such as the human-rights forum. Although they ‘insist on the sufficiency of their own efforts, that is, self-implementation of human-rights standards, and [remain] strongly resistant to establishment of enforcement or even accountability and transparency procedures’,⁵⁵ they also try hard to

51. S.K. Sell, *Private Power, Public Law: The Globalization of Intellectual Property Rights* (Cambridge: Cambridge University Press, 2003), 8.

52. K. Buse & A. Waxman, ‘Public – Private Health Partnerships: A Strategy for WHO’ *Bulletin of the World Health Organization* 79 (2001): 750.

53. Scott, n. 35 above, at 563.

54. L.R. Helfer, ‘Regime Shifting: The TRIPS Agreement and New Dynamics of International Intellectual Property Lawmaking’, *Yale Journal of International Law* 29 (2004): 59.

55. R. Falk, ‘Interpreting the Interaction of Global Markets and Human Rights’, in *Globalization and Human Rights*, ed. A. Brysk (Berkeley: University of California Press, 2002), 65–66.

persuade others of approaches that would be beneficial to their interests while at the same time seeking to reduce the impact of human-rights instruments on their business activities.

Their actions are understandable, because governments have duties to regulate activities of private actors as part of their international human-rights obligations. As General Comment No. 17 stated, 'While only States parties to the Covenant are held accountable for compliance with its provisions, they are nevertheless urged to consider regulating the responsibility resting on the private business sector, private research institutions and other non-State actors to respect the rights recognized in' Article 15(1)(c) of the ICESCR.⁵⁶ For example, States can be found to violate the Covenant by either action (such as when they 'entic[e transnational corporations] to invest by providing conditions which violate human rights, including tax-free havens and prohibition of trade union activities')⁵⁷ or inaction (such as when they 'fail to have the regulatory structures in place which prevent or mitigate the harms in question').⁵⁸ As Professor Donnelly noted, 'a State that does no active harm itself is not enough. The State must also include protecting individuals against abuses by other individuals and private groups'.⁵⁹

Second, even if the rights-holders are trying to capture the forum, it is unclear if they will succeed. The human-rights forum is more robust than one would expect, and institutional capture of a robust forum has not been easy. At present, the forum provides significant safeguards to protect the poor, the marginalized, and the less powerful. Thus far, non-governmental organizations and less developed countries are well represented in the human-rights forum. They also have been more active than transnational corporations and their supporting developed countries, which often find alien the human-rights language and the forum structure. Moreover, the discussion of human-rights norms may even help less developed countries make a convincing case to their developed counterparts of the need for recalibration of interests in the existing intellectual property regime. As Professor Helfer pointed out:

By invoking norms that have received the imprimatur of intergovernmental organizations in which numerous states are members, governments can more credibly argue that a rebalancing of intellectual property standards is part of a rational effort to harmonize two competing regimes of internationally recognized 'rights', instead of a self-interested attempt to distort trade rules or to free ride on foreign creators or inventors.⁶⁰

Third, it may not necessarily be bad to include corporations and other rights-holders in the forum. The human-rights forum includes many different issues,

56. General Comment No. 17, n. 5 above, para. 55.

57. A. Eide, 'Obstacles and Goals to Be Pursued', in Eide, Krause and Rosas, n. 31 above, at 559.

58. Scott, n. 35 above, at 568.

59. Donnelly, n. 38 above, at 37.

60. L.R. Helfer, 'Human Rights and Intellectual Property: Conflict or Coexistence?', *Minnesota Intellectual Property Review* 5 (2003): 58.

which range from the right to health to the right to food to the right to education. Today, the development of intellectual property laws and policies is no longer just about intellectual creations; it has, indeed, affected many areas that are related to other human rights, including agriculture, health, the environment, education, culture, free speech, privacy, and democracy. The inclusion of intellectual property rights-holders in the human-rights forum, therefore, would create an opportunity to educate them on the adverse impact of an unbalanced intellectual property system. It would also broaden their horizon by encouraging them to develop a holistic perspective of issues concerning many different human rights – a perspective that is quite different from the one that narrowly focuses on profit maximization.

Fourth, even though states remain the central players in the human-rights system, that system has been changing. As a result, there is a growing and conscious effort to directly engage private actors, in particular transnational corporations.⁶¹ In the 1999 World Economic Forum, UN Secretary-General Kofi Annan challenged business leaders to join an international initiative called the Global Compact.⁶² This initiative brought hundreds of companies together with UN agencies, labour, and civil society to support universal principles in the areas of human rights, labour, the environment, and anti-corruption.⁶³ The following year, the Organisation for Economic Co-operation and Development adopted the Revised OECD Guidelines for Multinational Enterprises in its annual ministerial meeting in Paris.⁶⁴ In August 2003, the UN Sub-Commission on the Promotion and Protection of Human Rights established the Norms on the Responsibilities of Transnational Corporations and Other Businesses, which states:

Within their respective spheres of activity and influence, transnational corporations and other business enterprises have the obligation to promote, secure the fulfilment of, respect, ensure respect of and protect human rights recognized in international as well as national law, including the rights and interests of indigenous peoples and other vulnerable groups.⁶⁵

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61. P. Alston, 'Ships Passing in the Night: The Current State of the Human Rights and Development Debate Seen through the Lens of the Millennium Development Goals', *Human Rights Quarterly* 27 (2005): 767–770. On the relationship between human rights obligations and private actors, see A. Brysk, *Human Rights and Private Wrongs: Constructing Global Civil Society* (New York: Routledge, 2005); A. Clapham, *Human Rights in the Private Sphere* (Oxford: Clarendon Press, 1993); M. Emberland, *The Human Rights of Companies: Exploring the Structure of ECHR Protection* (Oxford: OUP, 2006); S.R. Ratner, 'Corporations and Human Rights: A Theory of Legal Responsibility', *Yale Law Journal*, 111 (2001): 443–545.
 62. U.N. Global Compact, 'What Is the Global Compact?', <www.globalcompact.org/AboutTheGC/index.html>, 12 July 2007.
 63. *Ibid.*, 'The Ten Principles', <www.globalcompact.org/AboutTheGC/TheTenPrinciples/index.html>, 12 July 2007.
 64. Organisation for Economic Co-operation and Development, *The OECD Guidelines for Multinational Enterprises: Revision 2000* (Paris: Organisation for Economic Co-operation and Development, 2000).
 65. Economic and Social Council, Sub-Commission on the Promotion and Protection of Human Rights, Norms on the Responsibilities of Transnational Corporations and Other Business Enterprises with Regard to Human Rights, 13 August 2003, U.N. Doc. E/CN.4/Sub.2/2003/12/Rev.2.

While these developments remain in their early stages and their effectiveness has been questioned,⁶⁶ it is very likely that this trend will continue and expand as the world becomes increasingly globalized and as transnational corporations become more important in the present state-centred system. Indeed, as the Sub-Commission recognized, 'new international human rights issues and concerns are continually emerging and that transnational corporations and other business enterprises often are involved in these issues and concerns, such that further standard-setting and implementation are required at this time and in the future'.⁶⁷

Finally, despite the foregoing challenges, there are tremendous benefits to advancing a dialogue with intellectual property rights-holders in the human-rights forum. For example, the language used in this dialogue may eventually find its way to other intellectual property-related fora, such as the WTO or WIPO.⁶⁸ Indeed, as Professor Helfer pointed out, the new intellectual property-related lawmaking initiatives completed or currently underway in the United Nations Educational, Scientific and Cultural Organization (UNESCO), the World Health Organization, and WIPO have already utilized approaches that 'are closely aligned with the human rights framework for intellectual property reflected in the CESCR Committee's recent interpretive statements'.⁶⁹ The drafters of the agreements not only cited to or drew support from international human-rights instruments,⁷⁰ but also carried with them the usual scepticism among human-rights advocates that strong intellectual property protection has only limited benefits for less developed countries.⁷¹

The language and the dialogue may also help countries in their negotiation of future intellectual property treaties. For example, the CESCR's recommendations

66. On the Global Compact and corporate social responsibilities, see 'Symposium, Holding Multinational Corporations Responsible under International Law', *Hastings International and Comparative Law Review* 24 (2001): 285–506; 'Symposium, The U.N. Global Compact: Responsibility for Human Rights, Labor Relations, and the Environment in Developing Nations', *Cornell International Law Journal* 34 (2001): 481–554.

67. Responsibilities of Transnational Corporations, n. 65 above, pmb., recital 12.

68. P.K. Yu, 'Currents and Crosscurrents in the International Intellectual Property Regime', *Loyola of Los Angeles Law Review* 38 (2004): 428–429.

69. Helfer, n. 2 above, at 1001.

70. For example, the preamble to the Convention on the Protection and Promotion of the Diversity of Cultural Expressions states that the instrument 'celebrat[es] the importance of cultural diversity for the full realization of human rights and fundamental freedoms proclaimed in the Universal Declaration of Human Rights and other universally recognized instruments'. Convention on the Protection and Promotion of the Diversity of Cultural Expressions, pmb., recital 5, 20 October 2005. Art. 2(1) of the Convention lists the principle of respect for human rights and fundamental freedoms among one of its guiding principles. Article 2(1) states further:

Cultural diversity can be protected and promoted only if human rights and fundamental freedoms, such as freedom of expression, information and communication, as well as the ability of individuals to choose cultural expressions, are guaranteed. No one may invoke the provisions of this Convention in order to infringe human rights and fundamental freedoms as enshrined in the Universal Declaration of Human Rights or guaranteed by international law, or to limit the scope thereof (*ibid.*, Art. 2(1)).

71. Helfer, n. 2 above, at 980.

in General Comment No. 17 ‘provide a template for countries whose governments already oppose expansive intellectual property protection standards to implement more human rights-friendly standards in their national laws’.⁷² In the shadow of these templates, countries may be able to improve their negotiation positions and demand more access to protected materials. Those recommendations also may influence the jurisprudence of WTO dispute settlement panels, which are likely to confront arguments that the TRIPs Agreement should be interpreted in a manner that avoids conflicts with nonbinding norms and harmonizes the objectives of the international intellectual property and international human rights regimes.⁷³

Indeed, countries have been relocating to more sympathetic fora to create tactical advantages for themselves.⁷⁴ As a result, intellectual property issues have been explored and discussed in many different regimes, thus forming what I have coined the ‘international intellectual property regime complex’.⁷⁵ This regime complex includes not only the traditional international intellectual property regime, but also those other international regimes or fora in which intellectual property issues play a growing role or with which formal or informal linkages have been established.

In addition, there have been increasing activities in the WTO and WIPO exploring the relationship between intellectual property and human rights. For example, in November 1998, WIPO conducted a panel discussion on ‘Intellectual Property and Human Rights’.⁷⁶ The WTO, in particular the TRIPs Council, has also paid closer attention to the lack of access to patented pharmaceuticals in light of HIV/AIDS, tuberculosis, and malaria pandemics in Africa and other less developed countries.⁷⁷ Such attention eventually resulted in the adoption of the Doha Declaration on the TRIPs Agreement and Public Health⁷⁸ and a recent protocol to

72. *Ibid.*, at 1000.

73. *Ibid.*

74. *Ibid.*, at 974–975; Helfer, n. 54 above, at 59; Raustiala, n. 14 above, at 1027.

75. P.K. Yu, ‘International Enclosure, the Regime Complex, and Intellectual Property Schizophrenia’, *Michigan State Law Review*, 2007: 1 et seq. The term ‘regime complex’ was derived from K. Raustiala and D.G. Victor, ‘The Regime Complex for Plant Genetic Resources’, *International Organization*, 58 (2004): 279. David Leebron has also used the term ‘conglomerate regime’. D.W. Leebron, ‘Linkages’, *American Journal of International Law* 96 (2002): 18.

76. World Intellectual Property Organization, Panel Discussion on Intellectual Property and Human Rights Geneva, 9 November 1998, <www.wipo.int/tk/en/hr/paneldiscussion/papers/index.html>, 12 July 2007.

77. On TRIPs developments in relation to access to medicines, see P. Roffe, G. Tansey & D. Vivas Eugui (eds), *Negotiating Health: Intellectual Property and Access to Medicines*, (London: Earthscan, 2006); F.M. Abbott, ‘The WTO Medicines Decision: World Pharmaceutical Trade and the Protection of Public Health’, *American Journal of International Law* 99 (2005): 317–358; P.K. Yu, ‘The International Enclosure Movement’ *Indiana Law Journal* 82 (2007): 827–907.

78. World Trade Organisation, Declaration on the TRIPs Agreement and Public Health of 14 November 2001, para. 7, WT/MIN(01)/DEC/2, (2002) 41 ILM 755. The Doha Declaration delayed until 1 January 2016, the formal introduction of patent protection for pharmaceuticals and of the protection of undisclosed regulatory data.

formally amend the TRIPS Agreement by adding a new Article 31*bis*.⁷⁹ Had these alternative activities not raised concerns and provided the needed counterbalancing language, the Doha Declaration that sparked off a number of changes to the international intellectual property system might not have been adopted.⁸⁰

IV. CULTURAL BIAS

The final challenge concerns the framework's potential bias against non-Western cultures and traditional communities. In recent years, policy makers and commentators have discussed how the human-rights instruments have failed to protect the interests of non-Western countries and indigenous communities. As they noted, many of the rights included in the UDHR and the ICESCR articulate and reinforce values that have prior existence in the West and, therefore, have limited applicability in countries in the non-Western world.⁸¹ The climax of this cultural relativist movement came when Asian countries adopted the Bangkok Declaration at the Asian preparatory regional conference before the World Conference on Human Rights in 1993.⁸² Although the Bangkok Declaration did not articulate the oft-discussed 'Asian values', it states explicitly that, 'while human rights are universal in nature, they must be considered in the context of a dynamic and evolving process of international norm-setting, bearing in mind the significance of national and regional particularities and various historical, cultural and religious backgrounds'.⁸³

This plea for cultural sensitivity is not new. Indeed, when the UDHR was being drafted, the American Anthropological Association sent a long memorandum to the Human Rights Commission, expressing their concern, or even fear, that the

79. Council for Trade-Related Aspects of Intellectual Property Rights, Implementation of paragraph 11 of the General Council Decision of 30 August 2003 on the Implementation of paragraph 6 of the Doha Declaration on the TRIPS Agreement and Public Health: Proposal for a Decision on an Amendment to the TRIPS Agreement, IP/C/41, 6 December 2005. If adopted, Article 31*bis* would allow those WTO Member States that had insufficient or no manufacturing capacity to import generic versions of on-patent pharmaceuticals.

80. Yu, n. 68 above, at 414–415.

81. On the tension between human rights and non-Western cultures, see A.A. An-Naim (ed.), *Human Rights in Cross-Cultural Perspectives: A Quest for Consensus* (Philadelphia: University of Pennsylvania Press, 1992), and other sources cited *infra*. note 83.

82. World Conference on Human Rights, Regional Meeting for Asia, 29 March–2 April 1993, Report of the Regional Meeting for Asia of the World Conference on Human Rights, 7 April 1993, U.N. Doc. A/Conf.157/PC/59.

83. *Ibid.*, para. 8. On Asian values and the Bangkok Declaration, see D.A. Bell, *East Meets West: Human Rights and Democracy in East Asia* (Princeton: Princeton University Press, 2000); W.T. de Bary and W. Tu (eds), *Confucianism and Human Rights* (New York: Columbia University Press, 1998); W.T. de Bary, *Asian Values and Human Rights: A Confucian Communitarian Perspective* (Cambridge, MA: Harvard University Press, 1998); J.R. Bauer & D.A. Bell (eds), *The East Asian Challenge for Human Rights* (Cambridge: Cambridge University Press, 1999); M.C. Davis (ed.), *Human Rights and Chinese Values: Legal, Philosophical, and Political Perspectives* (New York: Oxford University Press, 1995); M.C. Davis, 'Constitutionalism and Political Culture: The Debate over Human Rights and Asian Values', *Harvard Human*

Declaration would become an ethnocentric document. As the Association's executive board put it in the now infamous 1947 memorandum, '[T]he primary task confronting those who would draw up a Declaration on the Rights of Man is . . . , in essence, to resolve the following problem: How can the proposed Declaration be applicable to all human beings, and not be a statement of rights conceived only in terms of the values prevalent in the countries of Western Europe and America?'⁸⁴

Notwithstanding these cultural concerns, the human rights instruments do not seem to dictate a certain level or modality of protection, as far as the right to the protection of interests in intellectual creations is concerned.⁸⁵ In fact, the drafting history strongly suggests that the drafters were determined to create a universal document and reluctant to introduce language that was tailored toward a particular form of political or economic system.⁸⁶ It was, therefore, no surprise that John Humphrey, the director of the Division on Human Rights at the United Nations who was heavily involved in drafting the UDHR, recalled in his memoirs that Chinese delegate Peng-chun Chang 'suggested that [he] put [his] other duties aside for six months and study Chinese philosophy . . . [implying] that Western influences might be too great'.⁸⁷

Indeed, commentators have underscored the diverse cultural and religious backgrounds of governmental representatives participating in the drafting. Based on one commentator's calculation, 'thirty-seven of the member nations stood in the Judeo-Christian tradition, eleven in the Islamic, six in the Marxist, and four in the Buddhist tradition'.⁸⁸ Moreover, "'[w]estern" states . . . made up only about a third of the votes for the Universal Declaration',⁸⁹ and the Soviet and

Rights Journal 11 (1998): 109–147; K. Engle, 'Culture and Human Rights: The Asian Values Debate in Context', *New York University Journal of International Law and Politics* 32 (2000): 291–333; R. Peerenboom, 'Beyond Universalism and Relativism: The Evolving Debates about "Values in Asia"', *Indiana International and Comparative Law Review* 14 (2003): 1–85; S.S.C. Tay, 'Human Rights, Culture, and the Singapore Example', *McGill Law Journal* 41 (1996): 743–780.

84. American Anthropological Association, 'Statement on Human Rights' *American Anthropologist* 49 (1947): 539–543.

85. Yu, n. 2 above, at 1083–1092.

86. Morsink, n. 12 above, at 149.

87. J.P. Humphrey, *Human Rights and the United Nations: A Great Adventure* (Dobbs Ferry: Transnational Publishers, 1983), 29. Some commentators, however, disagreed with Dr. Humphrey's assessment. Glen Johnson, for example, noted, 'Those members of the [Human Rights] Commission who represented non-European countries were, themselves, largely educated in the European tradition, either in Europe or the United States or in the institutions established in their own countries by representatives of European colonial powers.' M.G. Johnson, 'A Magna Carta for Mankind: Writing the Universal Declaration of Human Rights', in M.G. Johnson & J. Symonides, *The Universal Declaration of Human Rights: A History of Its Creation and Implementation, 1948–1998* (Paris: UNESCO, 1998), 46–47.

88. Morsink, n. 12 above, at 21.

89. Donnelly, n. 38 above, at 22 n. 1; J.W. Nickel, *Making Sense of Human Rights: Philosophical Reflections on the Universal Declaration of Human Rights* (Berkeley: University of California Press, 1987), 67.

Latin American countries dominated the discussion in economic, social, and cultural rights. A diverse array of governments, intergovernmental and nongovernmental organizations, and private entities also participated widely in the drafting process.⁹⁰ Even when countries, in particular those from the Eastern bloc, abstained from voting for the final adoption of Article 27 of the UDHR and Article 15 of the ICESCR, they were able to influence the outcome by joining the discussions, submitting comments, drafts, and amendments, and participating in some of the preliminary voting.⁹¹ Thus, as Lebanese delegate Charles Malik recounted, ‘The genesis of each article, and each part of each article, [in the UDHR] was a dynamic process in which many minds, interests, backgrounds, legal systems and ideological persuasions played their respective determining roles’.⁹²

In the end, the documents and their drafting processes were not marred by the delegates’ differences, but united by their commonalities. As Mary Ann Glendon pointed out, what was crucial for the principal framers of the UDHR ‘was the similarity among all human beings. Their starting point was the simple fact of the common humanity shared by every man, woman, and child on earth, a fact that, for them, put linguistic, racial, religious, and other differences into their proper perspective’.⁹³ Thus, it is no surprise that General Comment No. 3 stated that the ICESCR is neutral ‘in terms of political and economic systems . . . and its principles cannot accurately be described as being predicated exclusively upon the need for, or the desirability of a socialist or a capitalist system, or a mixed, centrally planned, or *laissez-faire* economy, or upon any other particular approach’.⁹⁴

While the drafting history provides important evidence to dispel complaints about the fact that the right to the protection of interests in intellectual creations has ignored interests in non-Western countries, the concerns about its inability to accommodate the needs and interests of traditional communities require a different response. After all, indigenous groups are not what the drafters of the International Bill of Rights had in mind when they drafted the documents. As General Comment No. 17 noted, the words ‘everyone’, ‘he’, and ‘author’ ‘indicate that the drafters of that article seemed to have believed authors of scientific, literary or artistic productions to be natural persons, without at that time realizing that they could also be groups of individuals’.⁹⁵

The double use of the definite article in ‘the right freely to participate in the cultural life of the community’, as compared to ‘a right “to participate in the cultural life of his or her community”’, also betrayed the framers’ intentions.⁹⁶ As Johannes Morsink observed, ‘Article 27 seems to assume that “the community” one participates in and with which one identifies culturally is the dominant

90. Morsink, n. 12 above, at 9.

91. *Ibid.*, at 21.

92. Glendon, n. 40 above, at 225.

93. *Ibid.*, at 232.

94. Committee on Economic, Social and Cultural Rights, General Comment No. 3: The Nature of States Parties Obligations (Art. 2, para. 1), para. 8, UN Doc. E/1991/23, 14 December 1990.

95. General Comment No. 17, n. 5 above, para. 7.

96. Morsink, n. 12 above, at 269.

one of the nation state. There is no hint here of multiculturalism or pluralism.⁹⁷ In fact, Morsink has shown convincingly why historical memories, political circumstances, concerns of the colonial powers, and the lack of political organization had caused the UDHR drafters to omit a provision on the right to protect minorities.⁹⁸

To make things more complicated, many commentators have pointed out accurately that the existing intellectual property regime has ignored the interests of those performing intellectual labour outside the Western model, such as ‘custodians of tribal culture and medical knowledge, collectives practicing traditional artistic and musical forms, or peasant cultivators of valuable seed varieties’.⁹⁹ By emphasizing individual authorship and scientific achievement over collective intellectual contributions, the drafters of the UDHR and the ICESCR seemed to have subscribed to the traditional Western worldview of intellectual property protection.

Nevertheless, the fact that the drafters might not have foreseen the extension of Article 27 of the UDHR and Article 15(1)(c) of the ICESCR to traditional communities or other groups of individuals does not mean that the documents cannot be interpreted to incorporate collective rights. To begin with, human-rights instruments contain considerable language that allows one to explore collective rights. Although Article 27 of the ICCPR, as compared to a provision in the UDHR or the ICESCR, is the only article in the International Bill of Rights that specifically addresses the cultural rights of minorities,¹⁰⁰ references to cultural participation and development appear in many international and human-rights instruments, including the UN Charter, the UNESCO Constitution, the Declaration of the Principles of International Cultural Co-operation, the Convention on the Rights of the Child, the Convention on the Elimination of All Forms of Discrimination against Women, and the International Convention on the Elimination of All Forms of Racial Discrimination.¹⁰¹

In addition, the International Bill of Rights has undertaken a collective approach to specific rights, including ‘self-determination, economic, social and cultural development, communal ownership of property, disposal of wealth and natural resources, and intellectual property rights’.¹⁰² As Donald Kommers pointed out in his comparison of the German and US Constitutions, there can

97. *Ibid.*

98. *Ibid.*, at 269–280.

99. Bellagio Declaration, reprinted in J. Boyle, *Shamans, Software and Spleens: Law and the Construction of the Information Society* (Cambridge, MA: Harvard University Press, 1996), 193.

100. Art. 27 of the ICCPR provides: ‘In those States in which ethnic, religious or linguistic minorities exist, persons belonging to such minorities shall not be denied the right, in community with the other members of their group, to enjoy their own culture, to profess and practise their own religion, or to use their own language.’ International Covenant on Civil and Political Rights, Art. 27, 16 December 1966, (1976) 999 UNTS 171.

101. S.A. Hansen, ‘The Right to Take Part in Cultural Life: Toward Defining Minimum Core Obligations Related to Article 15(1)(a) of the International Covenant on Economic, Social and Cultural Rights’, in Chapman and Russell, n. 17 above, at 282.

102. *Ibid.*, at 288.

be two visions of personhood: 'One vision is partial to the city perceived as a private realm in which the individual is alone, isolated, and in competition with his fellows, while the other vision is partial to the city perceived as a public realm where individual and community are bound together in some degree of reciprocity'.¹⁰³ Drawing on this distinction, Professor Glendon suggested that the drafters of the UDHR might have embraced the latter vision:

In the spirit of [this] vision, the Declaration's 'Everyone' is an individual who is constituted, in important ways, by and through relationships with others. 'Everyone' is envisioned as uniquely valuable in himself (there are three separate references to the free development of one's personality), but 'Everyone' is expected to act toward others 'in a spirit of brotherhood'. 'Everyone' is depicted as situated in a variety of specifically named, real-life relationships of mutual dependency: families, communities, religious groups, workplaces, associations, societies, cultures, nations, and an emerging international order. Though its main body is devoted to basic individual freedoms, the Declaration begins with an exhortation to act in 'a spirit of brotherhood' and ends with community, order, and society.¹⁰⁴

Moreover, human rights continue to evolve and expand,¹⁰⁵ and there has been a growing trend to extend human rights to groups, despite the original intentions of the framers of the UDHR and the ICESCR. As General Comment No. 17 stated:

Human rights are fundamental, inalienable and universal entitlements belonging to individuals and, under certain circumstances, groups of individuals and communities. . . . Although the wording of Article 15, paragraph 1(c), generally refers to the individual creator ('everyone', 'he', 'author'), the right to benefit from the protection of the moral and material interests resulting from one's scientific, literary or artistic productions can, under certain circumstances, also be enjoyed by groups of individuals or by communities.¹⁰⁶

The CESCR's interpretative comment is strongly supported by international law. As the International Court of Justice declared in the *Namibia Advisory Opinion*, '[a]n international instrument has to be interpreted and applied within the framework of the entire legal system prevailing *at the time of the interpretation*'.¹⁰⁷ The Vienna Convention on the Law of Treaties also requires subsequent agreement and practice to be taken into account in treaty interpretation.¹⁰⁸

103. D.P. Kommers, 'German Constitutionalism: A Prolegomenon', *Emory Law Journal* 40 (1991): 867.

104. Glendon, n. 40 above, at 227.

105. Sepúlveda, n. 8 above, at 81–84; Chapman and Russell, n. 49 above, at 13.

106. General Comment No. 17, n. 5 above, paras 1, 8 (emphasis added).

107. Legal Consequences for States of the Continued Presence of South Africa in Namibia (South West Africa), Advisory Opinion, 1971 ICJ 31, para. 53 (June 21) (emphasis added).

108. Vienna Convention on the Law of Treaties, Art. 31(3), entered into force 27 January 1980, (1969) 8 ILM 679.

In the context of cultural rights, this comment also makes a lot of sense. As Asbjørn Eide aptly observed, ‘the basic source of identity for human beings is often found in the cultural traditions into which he or she is born and brought up. The preservation of that identity can be of crucial importance to well-being and self-respect’.¹⁰⁹ Thus, it is no surprise that General Comment No. 17 stated that ‘States parties in which ethnic, religious or linguistic minorities exist are under an obligation to protect the moral and material interests of authors belonging to these minorities through special measures to preserve the distinctive character of minority cultures’.¹¹⁰ As the Draft Declaration on the Rights of Indigenous Peoples recognized:

Indigenous peoples are entitled to the recognition of the full ownership, control and protection of their cultural and intellectual property. They have the right to special measures to control, develop and protect their sciences, technologies and cultural manifestations, including human and other genetic resources, seeds, medicines, knowledge of the properties of fauna and flora, oral tradition, literatures, designs and visual and performing arts.¹¹¹

Finally, compared to civil and political rights, economic, social, and cultural rights present the lease tension between Western and non-Western cultures and between traditional and non-traditional ones. Indeed, during the UDHR drafting process, many Western countries, in particular Britain and the United States, were reluctant to recognize economic, social, and cultural rights as human rights. It is no accident that those rights were left out of the initial discussions of the now-abandoned Covenant on Human Rights. In fact, ‘[w]ithin some societies in the West, cultural traditions persist based on a strong faith in full economic liberalism and a severely constrained role for the state in matters of welfare’.¹¹² The drafting history also showed that Britain and the United States remained reluctant to embrace those rights because they seemed foreign to them. As Professor Glendon noted, ‘The [relativist] label “Western” obscures the fact that the Declaration’s acceptance in non-Western settings was facilitated by the very features that made it seem “foreign” to a large part of the West: Britain and the United States’.¹¹³

In sum, as far as the right to the protection of interests in intellectual creations is concerned, the human-rights regime is not as biased against non-Western countries and traditional communities as the critics have claimed. As indigenous rights strengthen, the use of the human-rights regime may even help reduce the existing bias against those performing intellectual labour outside the Western model.

109. A. Eide, ‘Cultural Rights as Individual Human Rights’, in Eide, Krause & Rosas, n. 31 above, at 291.

110. General Comment No. 17, n. 5 above, para. 33.

111. Economic and Social Council, Sub-Commission on Prevention of Discrimination and Protection of Minorities, Draft United Nations Declaration on the Rights of Indigenous Peoples, Art. 29, 26 August 1994, U.N. Doc. E/CN.4/Sub.2/1993/29.

112. A. Eide, ‘Economic Social and Cultural Rights as Human Rights’, in Eide, Krause & Rosas, n. 31 above, at 11.

113. Glendon, n. 40 above, at 227.

Nevertheless, there remains a considerable challenge concerning whether less developed countries and indigenous communities would be able to consider the right to the protection of interests in intellectual creations as important as such other human rights as the right to food, the right to health, the right to education, the right to cultural participation and development, the right to the benefits of scientific progress, and the right to self-determination (notwithstanding the universal, indivisible, interdependent, and interrelated nature of human rights). There is also continuous tension between human-rights protection and economic development.¹¹⁴

In addition, there is a growing concern that the development of a human-rights framework for intellectual property will lead to the creation of the notorious one-size-fits-all templates that have been used to transplant intellectual property laws from developed to less developed countries. Fortunately, the ECHR has advanced a deferential approach that respects a considerable ‘margin of appreciation’.¹¹⁵ As Professor Helfer noted:

[T]he ECHR gives significant deference to ‘the legislature’s judgment as to what is in the public interest unless that judgment is manifestly without reasonable foundation’. It also stresses the ‘wide margin of appreciation’ that states enjoy ‘with regard both to choosing the means of enforcement and to ascertaining whether the consequences of enforcement are justified in the general interest for the purpose of achieving the object of the law in question.’¹¹⁶

If this approach is incorporated into the framework, countries are likely to be able to develop a balanced intellectual property system that takes into consideration their international human-rights obligations while at the same time maintaining the policy space needed for the development of a system that appreciates their local needs, national interests, technological capabilities, institutional capacities, and public health conditions.¹¹⁷

V. CONCLUSION

With the continuous expansion of intellectual property rights, there is a growing need to develop a human-rights framework for intellectual property. However,

114. On the tension between human rights and economic development, see Donnelly, n. 38 above, at 109–110, 194–203; P.K. Yu, ‘Ten Common Questions about Intellectual Property and Human Rights’, *Georgia State University Law Review* (forthcoming) 23 (2007), available at <<http://ssrn.com/abstract=979193>>. On how to recalibrate the concept of intellectual property in light of the development concept, see M. Chon, ‘Intellectual Property and the Development Divide’, *Cardozo Law Review* 27 (2006): 2821–2912.

115. On the margin of appreciation doctrine embraced by the ECHR, see Laurence R. Helfer, ‘Adjudicating Copyright Claims under the TRIPs Agreement: The Case for a European Human Rights Analogy’, *Harvard International Law Journal* 39 (1998): 404–405.

116. Helfer, n. 37 above.

117. On the enclosure of the policy space less developed countries have in designing intellectual property systems that fit their needs, interests, and goals, see Yu, n. 77 above.

considerable conceptual and practical challenges remain. If policy makers are to ensure that these challenges will not ultimately undermine the development of the framework, they need to anticipate the challenges while at the same time advancing a constructive dialogue at the intersection of intellectual property and human rights. The successful development of this framework not only will offer individuals the well-deserved protection of their moral and material interests in intellectual creations, but also will allow states to harness the intellectual property system to protect human dignity and respect as well as to promote the full realization of other important human rights.

Chapter 4

The Constitutional Dimension of Intellectual Property

*Christophe Geiger**

I. INTRODUCTION

There is no longer any doubt: intellectual production is certainly the field of economic activity marked by the most significant evolution in the last few years. Indeed, it is undeniable that this new sector of activity will progressively take the place of traditional enterprises based on agriculture and the industrial revolution as a factor of development. The nations that are poor with respect to natural resources, as is the case for a majority of the European countries, will be forced to innovate in order to survive. This is especially true if they want to maintain an advanced level of social protection for their populations, since manpower in other parts of the world is much less expensive.¹ High hopes are therefore undoubtedly

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1. See on this issue M. Vivant & P. Sirinelli, 'De l'irrésistible ascension de l'immatériel', *RLDI* 3 (2005).

built on what economists call the knowledge economy,² and it is not surprising that the European Council in Lisbon has made this one of its priorities for the immediate future.

Intellectual property law, as it happens, will play an increasing role in the future, as it has the difficult task of regulating this rapidly expanding field, in which decision makers see at least an important factor of development, if not the guarantee that the competitiveness of the European economy will survive. For example, cultural industries have become an important field of influence and are therefore now at the centre of a philosophical and cultural debate confronting in particular the United States and the old continent. The famous question of the ‘cultural exception’, today renamed ‘cultural diversity’, is subject to a struggle on the international level,³ the stakes of which extend from the control of the entertainment economy to the preservation of the very cultural identity and particularities of entire nations.⁴

It may seem astonishing that, at the same time, the more intellectual property rights have been at the centre of economic activity, the more their legitimacy has been contested by the public at large and by a great number of other circles: consumers are claiming their right to private copy;⁵ researchers and libraries, the freedom to access research results;⁶ the open source community has radically opposed

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2. See for example OECD, *Innovation in the Knowledge Economy, Implications for Education and Learning* (Paris: OECD Publishing, Centre for Educational Research and Innovation, 2004). See particularly D. Foray, *The Economics of Knowledge* (Cambridge, MA: MIT Press, 2004).
 3. On this question see S. Regourd, *De l'exception à la diversité culturelle, Collection Problèmes politiques et sociaux* (Paris: La Documentation française, 2004). On the connections between cultural diversity and copyright, see A. Dietz, ‘Cultural Diversity and Copyright’, in *Mélanges Victor Nabhan, Hors série des Cahiers de propriété intellectuelle* (Québec: Les Éditions Yvon Blais Inc., 2004), 109, as well as, focusing on human rights, C. B. Graber, ‘Traditional Cultural Expressions in a Matrix of Copyright, Cultural Diversity and Human Rights’, in *New Directions in Copyright Law*, vol. 5, ed. F. Macmillan (Cheltenham (UK)/Northampton, MA: Edward Elgar, 2007), 45.
 4. On 20 October 2005, the General Conference of the UNESCO adopted with a sizable majority the Convention on the Protection and Promotion of the Diversity of Cultural Expressions, commonly called the ‘Convention on Cultural Diversity’ (only two countries voted against: the US and Israel). The consequences of this Convention, which does not provide for any dispute settlement body are, however, not very clear, particularly regarding its connections to the agreements of the WTO. While Art. 20(1) stipulates that the parties take into account the provisions of the Convention when they interpret and apply other treaties and when they enter into other international obligations – which is certainly encouraging – Art. 20 para. 2 specifies that ‘nothing in this Convention shall be interpreted as modifying rights and obligations of the Parties under any other treaties to which they are parties’. Concerning this text and its deficits see S. Regourd, ‘Le projet de Convention de l’Unesco sur la diversité culturelle: Vers une victoire à la Pyrrhus’, *Légipresse* 226 (2005): 115.
 5. See on this issue C. Geiger, ‘Right to Copy v. Three-Step Test: The Future of the Private Copy Exception in the Digital Environment’, *Computer Law Review international* (CRi) 1 (2005): 7 and, by the same author, ‘The Private Copy Exception, an Area of Freedom (Temporarily) Preserved in the Digital Environment’, *IIC* 37 (2006): 74.
 6. In the field of research, several experts of high reputation, like Nobel laureate Joseph Stiglitz, plead for new models that are not based on exclusive rights (open content or open source). Big European research institutions such as the Max Planck Society also favour these new models

software patentability;⁷ patents on pharmaceuticals are increasingly said to hinder access to medicine in the poorest areas of the world;⁸ strong apprehensions have been expressed concerning the development of a 'patent on life' (through the patenting of genetic material);⁹ and the 'privatization', through intellectual property (IP) rights, of the traditional resources of indigenous groups by large Western corporations.¹⁰ This phenomenon has been aggravated by the fact that intellectual property rights are increasingly becoming perceived as a tool for industrialized countries to dominate developing countries.¹¹ Consequently, a large movement has been formed, contesting a law considered to privilege only the wealthiest countries.¹² More than ever, intellectual property is going through a crisis of legitimacy; the issue of this crisis is still uncertain, as dissatisfaction is growing vis-à-vis a system perceived as incapable of guaranteeing an equitable balance of the interests involved. In what follows we will attempt to show that a constitutionalization of intellectual property law can offer a remedy for the overprotective tendencies of intellectual property and can help this field of law recover its legitimacy (I). Such a constitutionalization could indeed allow us to identify certain solutions for the interpretation and the adaptation of these laws in the future (II).

(see for example the 'Berlin Declaration on Open Access to Knowledge in the Sciences and Humanities' of 22 October 2003. On this declaration, see R.M. Hilty, 'Five Lessons about Copyright in the Information Society: Reaction of the Scientific Community to Over-Protection and What Policy Makers Should Learn', *Journal of the Copyright Society of the USA* 53 (2006): 127. On this issue, see also from a German perspective G. Hansen, 'Zugang zu wissenschaftlicher Information – alternative urheberrechtliche Ansätze', *GRUR Int.* (2005): 378.

7. On this issue, see e.g., R.M. Hilty & C. Geiger, 'Patenting Software? A Judicial and Socio-Economic Analysis', *IIC* 36 (2005): 615.
8. On this issue see e.g., P. Rott, 'TRIPS-Abkommen, Menschenrechte, Sozialpolitik und Entwicklungsländer', *GRUR Int* (2003): 103. See also the resolutions of the United Nations Commission on Human Rights in 'Access to Medication in the Context of Pandemics such as HIV/AIDS, Tuberculosis and Malaria', which urge states to adopt legislation or other measures in accordance with applicable international law to safeguard access to medication from any limitation by third parties (Comm. on Hum Rts. Res. 2001/33 of 23 April 2001; Res. 2002/32 of 22 April 2002; Res. 2003/29 of 22 April 2003). From a human rights perspective, see recently on this topic H. Hestermeyer, *Human Rights and the WTO. The Case of Patents and Access to Medicines* (Oxford/New York: Oxford University Press, 2007).
9. See on this issue e.g., S. MacDonagh, *Patenting Life? Stop!* (Dublin: Dominican Publications, 2003).
10. See e.g., United Nations Development Programme, *Human Development Report 1999*, no. 68 (New York: Oxford University Press, 1999). For an analysis of the relationship between the notion of traditional knowledge and the international protection of human rights, see H. M. Haugen, 'Traditional Knowledge and Human Rights', *Journal of World Intellectual Property* 8 (2005): 663; L.R. Helfer, 'Human Rights and Intellectual Property: Conflict or Coexistence?', 5 *Minn. Intell. Prop. Rev.* 5 (2003): 52 et seq.
11. See on this issue e.g., P. Drahos, 'Developing Countries and International Intellectual Property Standard-Setting', *Journal of World Intellectual Property* 5 (2002): 789.
12. See e.g., on this issue in the field of copyright, H. Sun, 'Copyright Law under Siege: An Inquiry into the Legitimacy of Copyright Protection in the Context of the Global Digital Divide', *IIC* 36 (2005): 192; U. Suthersanen, 'Education, IPRs and Fundamental Freedoms – The Right to Knowledge', paper presented at the ARHC Conference on Copyright, Corporate Power and Human Rights, London, 27 January 2006; C. Geiger, 'Copyright and Free Access to Information. For a Fair Balance of Interests in a Globalised World', *EIPR* (2006): 366.

II. CONSTITUTIONALIZING IP LAW: A WAY TO SECURE A JUST BALANCE OF THE INVOLVED INTERESTS

II.A THE GUARANTEE OF A JUST BALANCE OF INTERESTS: THE CRUCIAL ISSUE

Even if the demand for a fair balance of interests within intellectual property has only been made for a relatively short time, the idea is not completely new. Already in the thirteenth century, the theologian and philosopher Thomas Aquinas held the opinion that ‘positive right’ (*ius positivum*) could be regarded only as fair and legitimate as long as it aimed for general well-being. Thus, he also regarded private property as fair, though only because it served the interests of the public.¹³ Where this is no longer the case, property must be limited; otherwise, it will lose its legitimacy.¹⁴ One already recognizes in these ideas the premises of a theory developed in the nineteenth century by two famous German scholars, Josef Kohler and Otto von Gierke, called ‘the social function of private law’, which refers on the one hand to the necessity for a fair reconciliation of the interests of a particular person with those of the other individuals, and with those of society on the other hand.¹⁵ We know that to these authors, these principles also applied to copyright, which they regarded as ‘a socially rooted right’.¹⁶

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13. See also in this sense J. Cornides, ‘Human Rights and Intellectual Property, Conflict or Convergence?’, *Journal of World Intellectual Property* 7 (2004): 143, who after a close analysis of natural law theories concerning property states: ‘The most important conclusion to be drawn... is that property is not an end in itself. Obviously, it must be used in a way that contributes to the realisation of the higher objectives of human society.’
 14. On the ideas of Thomas Aquinas see G. Decker, ‘Urheberrecht und Naturrecht – Grundfragen zum UrhG 1965’, in *Urheberrechtliche Probleme der Gegenwart, Festschrift für E. Reichardt*, eds A. Scheuermann & A. Strittmatter (Baden-Baden: Nomos, 1990), 13 et seq. See also J.-J. Rousseau, *Constitutional Project for Corsica*, 1765 (reprinted by Kessinger Publishing, Whitefish, MT, 2004): ‘It is sufficient to explain my idea, which is not to destroy private property absolutely, since that is impossible, but to confine it within the narrowest possible limits... and keep it ever subordinate to the public good.’
 15. O. von Gierke, *Die soziale Aufgabe des Privatrechts* (Berlin: 1889; republished by Klosterman, Frankfurt 1943); J. Kohler, *Das Autorrecht, eine zivilrechtliche Abhandlung* (Jena: Verlag von G. Fischer, 1880), 41: ‘Property is not the bastion of egotism but rather the vehicle for social exchange.’ On the social function of private rights, see also L. Josserand, *De l’esprit des droits et de leur relativité* (Paris: Dalloz, 1939), 10 et seq.
 16. These authors were the originators of the theory of the so-called social bounds of copyright. See J. Kohler, *supra* n. 15, at 40. The first use of this term is attributed to Julius Kopsch (J. Kopsch, ‘Zur Frage der gesetzlichen Lizenz’, *ArchFunkR* (1928): 201). On the theory of the social bounds of intellectual property, see also more recently F. Leinemann, *Die Sozialbindung des Geistigen Eigentums* (Baden-Baden: Nomos, 1998), and for copyright, see E. Pahud, *Die Sozialbindung des Urheberrechts* (Berne: Stämpfli Verlag, 2000); C. Geiger, ‘Droit d’auteur et droit du public à l’information, approche de droit comparé’ 98 et seq. (Paris: Litec, 2004); A. Rocha de Souza, ‘A função social dos direitos autorais: uma interpretação civil-constitucional dos limites da proteção jurídica: Brasil: 1888–2005’, (Campos dos Goytacazes, Ed. Faculdade de Direito de Campos, 2006). On the social function of the general right to property see recently R. Libchaber, ‘La propriété, droit fondamental’, in *Libertés et droits fondamentaux*, eds R. Cabrillac, M.-A. Frison-Roche & T. Revet, 12th ed. (Paris: Dalloz, 2006), 659, according to

The perceptions of the philosophy of law go in the same direction; according to du Pasquier, it is

the task of the law to secure the peaceful living together of the human group and to harmonize the different activities of the members of society. In a word: the law offers the basis of social order, which can be achieved only by a just balance of the different interests.¹⁷

Thus, one thing is certain: The law – in our case intellectual property law – does not exist as an end in itself but only has legitimacy as long as it fulfils a certain function. Hence, it is not surprising that the discussion about the legal nature of intellectual property (is it property or a monopoly?) has not supplied useful answers to the question of the concrete design of the law.¹⁸ One may think of the continuing debate over the term ‘intellectual property’, which so far has not been able to provide any information about the contents of the IP right, its duration and its restrictions. It has, strictly speaking, a purely symbolic character.¹⁹ For example, you may hold the opinion that copyright is a property right; nevertheless, it is generally recognized that it concerns property *of a special kind*.²⁰ This debate is not getting us anywhere, because the question of the legal nature of intellectual property acts on the assumption of a postulate, which already gets in the way of a critical analysis: intellectual property *is*, we must only define its nature. A very good example of this postulate can be found in the wording of the Charter of Fundamental Rights of the European Union, which simply (in fact much too simply!) states in Article 17(2): ‘intellectual property shall be protected’.²¹ Intellectual

whom the right to property has changed from an individualistic right – i.e., assigned only for the egotistic purposes of the proprietor – to a sort of social function: the property is no longer restricted to the aspect of personal development, which it permits, but it is also considered from the perspective of the interests of society.

17. C. du Pasquier, *Introduction à la théorie générale et à la philosophie du Droit*, 4th ed. (Neuchâtel/Paris: Delachaux et Nestlé, 1967), 19.
18. See also in this sense M. Vivant, ‘Le contenu du droit d’auteur’, in *Le droit d’auteur aujourd’hui*, ed. I. de Lamberterie, (Paris: Éditions du CNRS, 1991), 78, who considers that there is an element which is not emphasized enough, namely that all properties are monopolies.
19. See recently A. Ohly, ‘Geistiges Eigentum?’, *JZ* (2003): 548, according to whom the reference to natural property is an ‘argument with an intuitive persuasiveness which has often been used in the fight for a reinforcement of the protection of intellectual efforts. The reference to intellectual property has thus always had a function of judicial politics’.
20. See also in this sense M. Vivant, ‘Authors’ Rights, Human Rights?’, *RIDA* 174 (1997): 115, n. 41. On the flexible understanding of intellectual property in the constitutional sense, see also *infra* II.B.
21. The Treaty of Lisbon amending the Treaty on European Union and the Treaty establishing the European Community, signed at Lisbon the 13 December 2007 (OJEU 17 December 2007, 2007/C 306/01) gives the charter of Fundamental Rights a legally binding force and integrates this text in the primary legislation of the European Union (Art. 6(1)). On Art. 17(2) of the Charter, see C. Geiger, ‘Copyright’s Fundamental Rights Dimension at EU Level’, in *Research Handbook on the Future of EU Copyright*, ed. E. Derclaye, (Cheltenham, UK/Northampton, MA, Edward Elgar, 2008 (forthcoming)).

property stands as an end in itself.²² We have seen, however, that the question of the legitimacy of a right must be based on whether the right fulfils its assigned function. To determine this, one must examine *why* there is intellectual property and which interests it protects. So we should not ask about the legal nature of the right, but search for the justification of the right, even if both aspects may be linked with one another.

Having said that, it becomes evident that today we no longer know why we have intellectual property and why its scope should be increasingly extended. This really became obvious during the debate on the proposal for a directive on ‘software patentability’. While economists were pointing out that an extension of the patent to software could harm innovation, the IT industry was underlining the need to have patents to compete with American companies and to build ‘patent thickets’ for defensive purposes.²³ Other examples could be given, like the extension of the duration of copyright in the United States to the life of the author plus seventy years, just because Europe has such a duration and American interests should be preserved in kind.²⁴ The foundations of intellectual property, and by consequence its legitimacy, are in a serious crisis. We will try to demonstrate this by taking an

22. Furthermore, the protection is not even linked to the creator. All the other articles of the Charter start with ‘Everyone has the right to . . .’, but not Art. 17(2). That means that investors could also claim protection under this Art., which would be the sign of a real paradigm shift in intellectual property, as the investment becomes the reason to protect (see *infra* IB). For criticism see also A. Dietz, ‘Constitutional and Quasi-Constitutional Clauses for Justification of Authors’ Rights (Copyright) – From Past to Future’, in *Exploring the Sources of Copyright – Proceedings of the ALAI Congress 2005* (Paris: AFPIDA, 2007), 55; also published in German: 2006 GRUR Int. 7) and J. Drexler, ‘Constitutional Protection of Authors’ Moral Rights in the European Union – Between Privacy, Property and the Regulation of the Economy’, in *Human Rights and Private Law, Privacy as Autonomy*, ed. Katja S. Ziegler (Oxford/Portland, OR: Hart Publishing, 2007), 159 et seq. On the other hand, the special mention of intellectual property alongside the general property right could also be interpreted as a mark of its specificity. IP would then be mentioned because of its difference from the right to property in general. The problem is furthermore that Art. 17(2), unlike Art. 17(1), which states that ‘the use of property may be regulated by law in so far as necessary for the general interest’, contains no limitations. Even if we agree with one author that ‘this cannot be interpreted to imply a more absolute nature of intellectual property possessions’ (T. Milly, ‘Intellectual Property and Fundamental Rights: Do They Interoperate?’, in *Intellectual Property beyond Rights*, ed. N. Bruun (Helsinki: WSOY, 2005), 207, it would have been much better to underline the limited character of IP explicitly to prevent any abusive interpretations.

23. On this issue see R. M. Hilty & C. Geiger, *supra* n. 7.

24. Copyright Term Extension Act of 27 October 1998 (Pub. L. at 105–298). This extension encountered resistance on a large scale within American doctrine, which considered this long delay as being contrary to the constitutional clause about copyright which only allows authors to be granted an exclusive right in their works for a limited period of time. A complaint of unconstitutionality was lodged before the Supreme Court, and was rejected by the renowned decision of 15 January 2003 (*Eldred v. Ashcroft*, 537 U.S. 186, 123 S. Ct. 769 (2003), rehearing denied, 123 S. Ct. 1505 (Mem. 2003)). See e.g., W.J. Gordon, ‘Do We Have a Right to Speak with Another’s Language? *Eldred* and the Duration of Copyright’, in *Copyright and Human Rights*, ed. P.L.C. Torremans (The Hague/London/New York: Kluwer Law International, 2004), 109 et seq.

example from the field we know best: copyright law. But some of the conclusions we will draw below could easily be extended to other areas of IP law.²⁵

II.B THE CRISIS OF THE CLASSICAL FOUNDATIONS OF IP LAW: THE COPYRIGHT EXAMPLE

As we have already mentioned, if one aims for a readjustment of the interests within the IP system, it is essential to ask oneself why a right exists, and thus to delve further into the question of the foundations of intellectual property. Only in this way can it be determined whether the law is properly conceived and which background the regulation has, above and beyond the question of which interests should be protected. Questioning the justification of a rule also makes it possible to evaluate critically whether the rule achieves its objective. If this is not the case, then it must be corrected. A return to the basis of the subject is all the more necessary, as in the past this argument was very often carried out using catch words; a systematic analysis was omitted (depending on which objective was to be reached, copyright was referred to as the ‘holiest of all property rights’,²⁶ or as the ‘milder evil for the society’²⁷). Furthermore, the concrete design of the law in recent years was characterized more by the protection of private interests (legislators being put under pressure by strong lobby groups) than by systematic reasoning.²⁸

There is a traditional differentiation in copyright between the justifications of ‘natural law’ and ‘utilitarian’ justifications.²⁹ According to the natural-law

25. As long as the IP right involved the aim of rewarding creativity (or innovation), which means that e.g., trademarks would deserve a differentiated analysis, as they have other main functions. The same is true for geographical indications, where the innovation aspect is more or less absent.

26. See the famous words of Le Chapelier, reporter of the French decree on copyright of 1791: ‘The most sacred, the most legitimate, the most inattackable and the most personal of all properties, is the work which is the fruit of a writer’s thoughts’ (*Le Moniteur universel*, 15 January 1791, at 116 et seq.).

27. See e.g., Lord Macaulay’s Speech before the House of Commons (*Hansard*, Vol. 56, 5 February 1841, at 346 et seq.): ‘For the sake of the good, we must submit to the evil. But the evil ought not to last a day longer than is necessary for the purpose of securing the good.’; ‘It is desirable that we should have a supply of good books; we cannot have such a supply unless men of letters are liberally remunerated and the least objectionable way of remunerating them is by way of copyright.’ The words of Le Chapelier and Macaulay were often quoted out of their context and instrumentalized to push certain interests.

28. An important number of scholars have underlined this tendency. See e.g., H. Laddie, ‘Copyright: Over-strength, Over-regulated, Over-rated?’, *EIPR* (1996): 259; P. M. Gerhart, ‘Why Lawmaking for Global Intellectual Property is Unbalanced’, *EIPR* (2000): 310; P. Gyertyánfy, ‘Expansion des Urheberrechts – und kein Ende?’, *GRUR Int.* (2002): 557; A. Quaadvlieg, ‘Copyright’s Orbit Round Private, Commercial and Economic Law – The Copyright System and the Place of the User’, *IIC* 29 (1998): 435; R.M. Hilty, *supra* n. 6, at 109 et seq.

29. For a recent detailed analysis of the justifications of copyright see also C. Geiger, *supra* n. 16, at 22 et seq.; S. Dusollier, *Droit d’auteur et protection des œuvres dans l’univers numérique*. (Brussels:

approach, the law concretizes pre-existing rights of the author, which he is by nature entitled to. It is the property in one's own person that is extended to the fruits of one's work and the personal rights, which protect the work as an illustration of the personality of the author. In contrast to this, according to the utilitarian approach, the right does not exist from the beginning, but is granted by society with a view to certain goals and serves as a cultural or economic policy instrument. The author is to be motivated to create new works by the prospect of a reward in the form of a right, which he can make use of to receive remuneration. Copyright presents itself as a means of amortization of the investments the author must make to create the work and as a remuneration of his efforts. This already shows the deficits of the economic analysis: a remuneration results only in the case of exploitation of the work, thus when the work has already been created. In the creation phase, the author is dependent on the financial support of others and therefore has to put himself in a position of dependence on an exploiter or on the state.

It must be stressed, however, that it is of substantial importance whether copyright is used as a cultural or an economic policy instrument, even if this distinction is often ignored in the literature.³⁰ In the first case, the main emphasis is on the aspect of the 'intellectual' enrichment of society, whereas in the second, it is on 'material' or 'economic' enrichment. In the first case, a diversity of opinions and the democratic dialogue with as many different works as possible is to be enabled, while in the second case, the exploitation of a work, meaning the monetary realization of profits, is at the centre of attention. Of course, both aspects are often very closely linked. Nevertheless, the distinction can be relevant, because cultural policy goals can require an emphasis on non-monetary incentives (for example, a '*droit moral*'), if they have a larger incentive function for the author than just the prospect of profit. That will be especially the case if there is a very small market for the work ('*avant-garde*' art, science and so forth).

The classical principles of natural law and utilitarianism do not withstand a critical analysis.³¹ As far as the justification of the IP right based on the personality of the author is concerned, its disadvantage consists in the fact that it is based on natural law. Natural law is difficult to outline; historians of law have shown that Aristotle's conception of natural law differs much from that of the Middle Ages, which again has very little in common with that of the French Revolution.³² Today natural law would again look different. Because of its vagueness, natural law very easily provides the possibility for misuse and manipulation in favour of the opinion

Larcier, 2005), 216 et seq. See also e.g., G. Davies, *Copyright and the Public Interest*, 2nd ed. (London, Sweet and Maxwell 2002), 9 et seq.; A. Strowel, *Droit d'auteur et Copyright, Divergences et convergences* (Brussels/Paris: Bruylant & LGDJ, 1993), 174 et seq.; F. Fechner, *Geistiges Eigentum und Verfassung* (Tübingen: Mohr Siebeck, 1999) 121 et seq.

30. On the reasons for such a distinction, see also in more detail C. Geiger, *supra* n. 16, at 27 et seq.

31. For a detailed critical analysis of copyright's classical justifications see C. Geiger, *supra* n. 16, at 27 et seq.; See also G. Davies, *supra* n. 29, 243 et seq.

32. P. Gaudrat, *Droit des auteurs, Droits moraux. Théorie générale du droit moral*, Juris-Classeur P.L.A., Fasc. 1210, 2001, at 8 et seq.

which one would like to uphold.³³ This can be best illustrated by the debate on intellectual property during the nineteenth century. While some authors³⁴ with reference to natural law wanted to protect the ‘holiest, most legitimate, most unassailable and most personal of all property rights’,³⁵ others argued that it was contrary to the laws of nature to grant property in an intangible asset.³⁶

Another weakness of the concept of natural law is the fact that it offers only insufficient justification for protecting works with purely technical character that do not reflect the personality of their creator (computer programs, databases, works with a low level of creativity – the ‘small change of copyright’). These works are often not created by particular authors working independently of each other, but within a team and according to certain predefined guidelines with little scope left for an author’s creativity. Some ‘*droit d’auteur*’ countries such as France even have the construction of the ‘*œuvre collective*’, according to which the rights of the work are, under certain conditions, transferred to the exploiter.³⁷ Regarding computer programs, this has already become a legally binding rule.³⁸ For all these cases, the rationale of natural law does not satisfy.

Turning to the utilitarian foundations, their weaknesses lie in the fact that they reduce creative activity to a strictly economic process. Numerous studies have shown, however, that the creator of a work often does not act out of monetary reasons but with completely different motives (idealism, ability, self-fulfilment, desire for acknowledgment and so forth).³⁹ Evidence of this is the fact that numerous works were created before there was even any copyright protection at all.⁴⁰ Within certain domains like science, the fame and prestige connected with a work

33. See also in this sense M. Vivant, *supra* n. 18, at 83.

34. See e.g., Lamartine’s pleadings for an eternal copyright, cited in: A. Strowel, *supra* n. 29, at 597. On this issue see also A. Götz von Olenhusen, “‘Ewiges geistiges Eigentum’ und ‘Sozialbindung’ des Urheberrechts in der Rechtsentwicklung und Diskussion im 19. Jahrhundert in Frankreich und Deutschland”, in *Festschrift für Georg Roeber zum 10. Dezember 1981* (Freiburg: Hochschulverlag, 1982), 88.

35. This sentence comes from Le Chapelier, reporter of the first French Copyright Act (*supra* n. 26). But the sentence was later always cited out of its context, as Le Chapelier only referred to unpublished texts (see in this sense J.C. Ginsburg, ‘A Tale of Two Copyrights: Literary Property in Revolutionary France and America’, RIDA 147 (1991): 158.

36. See e.g., A.-C. Renouard, *Traité des droits d’auteurs, dans la littérature, les sciences et les beaux arts*, vol. 1, (Paris: Jules Renouard et Cie, 1838, 454. See also earlier Thomas Jefferson, writing in his famous letter to Isaac McPherson of 13 August 1813 (quoted in J. Cornides *supra* n. 13, at 150: ‘Inventions cannot, in nature, be subject of property.’).

37. Articles L. 113-2 and L. 113-5 of the French Intellectual Property Code (CPI).

38. See Art. 3 of the Directive on the legal protection of computer programs of 14 May 1991 (OJEC L 122, 17 May 1991, at 42); s. 69b of the German Copyright Act; Art. L. 113-9 of the French CPI.

39. See e.g., A. Strowel, *supra* n. 29, 221 et seq. and G. Davies, *supra* n. 29, at 249 et seq., with further references. See also A. Peukert, ‘Die psychologische Dimension des droit moral’, in *Die psychologische Dimension des Urheberrechts*, ed. M. Rehinder (Baden-Baden: Nomos, 2003), 129 et seq.

40. See G. Boytha, ‘The Justification of the Protection of Authors’ Rights as Reflected in Their Historical Development’, RIDA 151 (1992); 53 et seq.

represent a much larger motivating factor than the prospect of remuneration (which is usually very small anyway).⁴¹ Besides that, the remuneration – as mentioned above – benefits the author very late, that is, after the creation of the work. He must perform in advance and in the work phase is dependant on other earnings for a living. That is why a large number of works are financed indirectly by the state in the form of research jobs, scholarships and other support. If the state does not take over this financing, then it is an exploiter, or producer, who makes the creation of the work financially possible. He invests in a work and wants to see his investment amortized. Thus, copyright is much more of an incentive for the exploiter than for the creator.⁴² Hence, it is not surprising that, with the increasing economic significance of the cultural industry, protection has shifted from the author to the exploiter and that (national and international) legislatures have therefore tried to build up the law in such a way that it would offer comprehensive protection for the exploiter.

It is, then, not surprising that copyright has evolved more and more into an investment-protection mechanism. It must be noted that copyright has gradually become an industrial right and the *investment has become the reason for protection*.⁴³ The copyright, which was originally intended to promote the interests of the public, presents itself increasingly as a protection of the interests of some few private entities. The bond between the author and society has loosened, and copyright has come to be seen by the public as a weapon in the hands of large companies.⁴⁴ The social dimension of the law is progressively disappearing in favour of a strictly individualistic, even egotistic conception. This means that the balance between the different interests within the system is threatening to tip in favour of the investors. It could even be argued that the continental term ‘author’s right’ is no longer appropriate, since it suggests that the system of

41. M. Stojanovic, ‘The Raison d’être of Copyright’, RIDA 102 (1979):128.

42. See in this sense e.g., A. Plant, *The New Commerce in Ideas and Intellectual Property* (London: The Athlone Press, 1953), 13.

43. See also in this sense e.g., M. Vivant, ‘Propriété intellectuelle et nouvelles technologies, À la recherche d’un nouveau paradigme’, in *Université de tous les savoirs*, vol. 5: *Qu’est ce que les technologies?*, (Paris: Odile Jacob, 2001), 201 et seq. This conclusion can equally be reached for patent law, where the protection of creativity and innovation seems to become subordinate to the protection of investment. As B. Remiche, ‘Marchandisation et brevet’, in *Propriété intellectuelle et mondialisation*, ed. M. Vivant (Paris: Dalloz, 2004), 127, correctly emphasizes, we have been witnessing for several years a change in the centre of interest of the law ‘turning from the inventor’s person to the investing company’. This mutation can already be considered worrying since the perception of investment does not contain any human or ethical dimension. Compensation of the investment is not systematically a synonym for progress, and as Prof. Remiche recalls, ‘to accent the investment – or even to make the nearly single element out of it – means to incite the research and the investment only there where they are the most cost-effective and profitable! (at 128). The public interest cannot be reduced to economic interest; the social justification for intellectual property is larger and should take into account certain fundamental values (see *infra* IC).

44. J.C. Ginsburg, ‘How Copyright Got a Bad Name for Itself’, *Columbia Journal of Law & the Arts* 26 (2002): 61.

protection benefits above all the author.⁴⁵ In reality, only a small number of authors (the commercially most successful) benefit from copyright protection. The fact that an increasing number of authors no longer identify with the applicable system of protection can be seen in the increasing success of alternative models like the ‘open source’ and ‘open content’ movements, even if these are, technically speaking, also based on copyright.⁴⁶

It is thus becoming urgent to give IP law a new legitimacy and to ensure the reconciliation of interests by searching for a new foundation for the system. In our opinion, fundamental rights and human rights can offer a suitable basis for a balanced system.⁴⁷

II.C FUNDAMENTAL RIGHTS AS A NEW FOUNDATION FOR IP LAW

The reason why fundamental rights and human rights are an ideal basis from which to start is that they offer a synthesis of the bases of natural law and utilitarianism and represent the values from which intellectual property developed.⁴⁸ The best example is offered by Article 27 of the Universal Declaration of Human Rights (UDHR) of 1948:⁴⁹ According to Article 27(1) everyone has ‘the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits’, while according to

45. See in this sense A. Strowel, *supra* n. 29, at 276; A. Dietz, ‘Transformation of Authors’ Rights, Change of Paradigm’, RIDA 138 (1988): 26.

46. See on this issue S. Dusollier, ‘Les licences Creative Commons: les outils du maître à l’assaut de la maison du maître’, *Propr. intell.* 18 (2006): 10 et seq. On the bad image of copyright, see Y. Gendreau, ‘The Image of Copyright’, *EIPR* (2006): 209.

47. See in this sense P. Drahos, ‘The Universality of Intellectual Property Rights: Origins and Development’, in *Intellectual Property and Human Rights* (Geneva: WIPO Publications, 1999), 33; (also published under the title ‘Intellectual Property and Human Rights’, *IPQ* (1999): 349). See also A.E.L. Brown, ‘Socially responsible intellectual property: A solution?’, *SCRIPT-ed* Vol. 2, Issue 4, December 2005, at 527; F. Fechner, *supra* n. 29, 135 et seq.; and the excellent article by A. Dietz, *supra* n. 22.

48. See P. Drahos, *supra* n. 47, at 33; J. Cornides, *supra* n. 13, at 138; P. Torremans, ‘Copyright as a Human Right’, in *Copyright and Human Rights*, ed. P. Torremans (The Hague/London/New York: Kluwer Law International, 2004), 9 et seq., reproduced in French: ‘Le droit d’auteur en tant que droit de l’homme’, *Propr. intell.* 23 (2007): 173, all underlining the instrumental dimension of human rights regarding intellectual property; A. Chapman, ‘Approaching Intellectual Property as a Human Right (obligations related to Art. 15(1)(c))’, *Copyright Bulletin* 35 (2001): 14: ‘A human-rights approach takes the implicit balance between the rights of inventors and creators and the interest of the wider society within intellectual property paradigms and make it more explicit and exacting. A human-rights orientation is predicated on the centrality of protecting and nurturing human dignity and the common good. *By extension, the right of the creator or the author are conditional on contributing to the common good and welfare of society*’ (emphasis added). See also R. D. Anderson & H. Wager, ‘Human Rights, Development, and the WTO: The Cases of Intellectual Property and Competition Policy’, *Journal of International Economic Law* 9, no. 3 (2006): 721 et seq., underlining that human rights and utilitarian rationales are not mutually exclusive, but are complementary grounds for the protection of IPRs.

49. G.A. res. 217A (III), UN Doc. A/810 at 71 (1948).

Article 27(2), everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author. Article 15(1) of the International Covenant on Economic, Social and Cultural Rights (ICESCR) of 19 December 1966⁵⁰ adopted almost verbatim the wording of the UDHR.⁵¹ The European Convention on Human Rights (ECHR)⁵² also codifies the principle of the freedom of expression and communication in Article 10(1), while Article 10(2) provides restrictions in the protection of rights of others, which includes the rights of creators. Even if intellectual property is not explicitly named, there is no longer any doubt (and recent case law of the European Court of Human Rights has clearly stated)⁵³ that the exploitation right is furthermore protected by Article 1 of Protocol 1 of the Convention, which protects property.⁵⁴ Concerning moral rights, even if there is no case law on them yet, legal scholars are of the opinion that these can be protected by Article 8 of the Convention on the protection of privacy,⁵⁵ or even by Article 10(1) protecting freedom of expression.⁵⁶ In sum, the classical foundations for IP

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50. G.A. res. 2200A (XXI); UN Doc. A/6316, 999 UNTS 171. On this article, see J. Schneider, *Menschenrechtlicher Schutz geistigen Eigentums, Reichweite und Grenzen des Schutzes geistigen Eigentums gemäß Artikel 15 Absatz 1 lit. c) des Internationalen Paktes über wirtschaftliche, soziale und kulturelle Rechte* (Stuttgart/Munich: Boorberg, 2006).
 51. It is important to emphasize that neither the UDHR nor the ICESCR determine that the material and immaterial interests of the creators should be protected by way of a *property right*. That means that within the scope of these conventions, other means of protection can certainly be envisaged by the legislators. These two texts thus leave countries a great room to manoeuvre, while at the same time guaranteeing creators a just remuneration for their work, which makes these judicial instruments particularly modern and flexible means to embed the matter (see also in this sense T. Milly, *supra* n. 22, 197).
 52. ETS No. 005 (vol. I).
 53. See e.g., European Court of Human Rights, 11 October 2005, *Anheuser Busch Inc. v. Portugal* (Appl. No. 73049/01; for a short comment see F. Sudre, 2006 JCP G 190), confirmed by the Grand Chamber of the ECHR, 11 January 2007, *Journal of Intellectual Property Law & Practice* 4 (2007): 197, comment by B. Goebel: 'Intellectual property as such undeniably attracts the protection of Art. 1 of Protocol No. 1' (trademark case). See also, for the case of a patent, the decision of the former European Commission of Human Rights *Smith Kline and French Laboratories Ltd. v. The Netherlands* (Appl. No. 12633/87), 4 October 1990, 66 D.R. 70 (1990). In the field of copyright, the ECHR, 4th Section, 29 January 2008, *Basan v. Moldava*, Appl. No. 19247103, No. 34.
 54. See e.g., A.R. Coban, *Protection of Property Rights within the European Convention on Human Rights* (Aldershot: Ashgate, 2004), 149; M. Carss-Frisk, 'The Right to Property, A Guide to the Implementation of Article 1 of Protocol No. 1 to the European Convention on Human Rights', in *Human Rights Handbooks*, No. 4, (Strasbourg: Council of Europe, 2001), 6. According to J. Drexler (*supra* n. 22), this article could even protect moral rights in a 'property-based' approach to these rights. In any case, according to this author, moral rights would be protected by Art. 17(2) of the Charter of Fundamental Rights of the European Union.
 55. P.B. Hugenholtz, 'Copyright and Freedom of Expression in Europe', in *Expanding the Boundaries of Intellectual Property*, eds R.C. Dreyfuss, D.L. Zimmerman & H. First (Oxford University Press, 2001), 346, and, more prudently, J. Drexler, *supra* n. 22.
 56. P. Leuprecht, 'Droit d'auteur et droits de l'homme au plan européen', in *Droits d'auteur et droits de l'homme* (Paris: INPI, 1990), 66.

rights can also be found in these texts,⁵⁷ but here they are placed in a stable balance: On the one hand, the foundation of natural law by acknowledging an exploitation right and a *'droit moral'* for the creator; and on the other hand, the utilitarian foundation, because this acknowledgment has the promotion of intellectual variety and the spreading of culture and science throughout society as a goal.⁵⁸

It is often emphasized that the UDHR does not have a binding effect, since it is only a recommendation of the United Nations General Assembly. Nevertheless, many authors consider that the declaration exerts a binding effect as customary international law.⁵⁹ In some decisions in France, the UDHR has even been applied directly in copyright disputes.⁶⁰ Also, the lack of a binding effect of the declaration is irrelevant in those countries that ratified UN pacts because, as international-law treaties, they are binding on the states that joined them (which does not include the US!). The same applies in Europe to the European Convention on Human Rights. Meanwhile, in many countries, the application of the Convention is even recognized in private-law disputes,⁶¹ so that without doubt a human-rights reasoning has

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57. On the sources of human rights in general, see J.J. Shestack, 'The Philosophical Foundations of Human Rights', in *Human Rights: Concept and Standards*, ed. J. Symonides (Aldershot: Ashgate/UNESCO, 2000), 31.
58. See in this sense O. Fischman Afori, 'Human Rights and Copyright: The Introduction of Natural Law Considerations into American Copyright Law', *Fordham Intell. Prop. Media & Ent. L.J.* 14 (2004): 500; P. Torremans, *supra* n. 48, at 7. See also A. Dietz, *supra* n. 22. He drafts an extremely interesting, balanced proposition of a constitutional clause on copyright protection, which could be included in the national constitutions of the different European countries. It can only be noted that the clause proposed, aiming to be complete, becomes quite complicated. Furthermore, the clause contains the principle of the exclusive right, which hinders a certain flexibility in the protection of the author's interests because it has to take imperatively the form of an exclusive right, other forms being only exceptionally allowed. One could thus maybe prefer Art. 27 of the UDHR, which is less complicated and leaves more flexibility to legislators concerning the effective possibilities of protecting the author.
59. See e.g., M.-C. Dock, 'Les conventions internationales sur le droit d'auteur et la Déclaration universelle des droits de l'homme', in *Droits d'auteur et droits de l'homme* (Paris: INPI, 1990), 90; D. Bécourt, 'Copyright and Human Rights', 32 *Copyright Bulletin* 32 (1998):14; P. Torremans, *supra* n. 48, at 6; I. Telec, 'The Human Rights Dimension of Authors' Rights and Neighbouring Rights from the Czech Constitutional Perspective', in *Festschrift für A. Dietz*, eds P. Ganeva, C. Heath & G. Schrickler (Munich: Beck, 2001), 76.
60. See e.g., Paris District Court, 29 April 1959, 28 RIDA 133 (1960); Paris District Court, 23 November 1988, 139 RIDA 205 (1989); Paris Court of Appeal, 1 February 1989, 142 RIDA 301 (1989), comment by P. Sirinelli.
61. See A. Clapham, 'The "Drittwirkung" of the Convention', in *The European System for the Protection of Human Rights*, eds J.St.R. Macdonald, F. Matscher & H. Petzold (Dordrecht/Boston/London: Martinus Nijhoff Publishers, 1993), 201; E. A. Alkema, 'The Third-Party Applicability or "Drittwirkung" of the European Convention on Human Rights', in *Protecting Human Rights: The European Dimension, Studies in Honour of G.J. Wiarda*, eds F. Matscher & H. Petzold, (Cologne: Carl Heymanns, 1988), 33 et seq.; V. Coussirat-Coustère, 'Convention européenne des droits de l'homme et droit interne: primauté et effet direct', in *La Convention européenne des droits de l'homme*, eds L.-E. Pettiti, E. Decaux & P.-H. Imbert, 2nd ed. (Paris: Economica 1999), 14. This evolution should be welcomed. Indeed, the fact that countries place increasing emphasis on their economic well-being has led to a certain transfer of power from the state to the industry.

entered into the private-law discourse⁶² (there are many cases in which national judges have applied the ECHR horizontally, that is in conflicts between two private persons. We will come back to some of these cases below).⁶³ These values are also included in national constitutions, though. All provide equally for protection of property and personality on the one hand, and protection of the freedom of expression, of information and of art. and science on the other hand.⁶⁴

III. CONSEQUENCES OF ‘CONSTITUTIONALIZING’ IP LAW

Opponents to any fundamental-rights discourse within IP law often argue that these rights are vague and do not allow any conclusions to be drawn concerning the scope of IP rights – that the fundamental-rights reasoning within IP is a merely theoretical exercise that does not have any practical impact. In our opinion, the contrary is true and we will hereafter try to demonstrate that a constitutionalizing of IP law would have numerous practical consequences.⁶⁵ In particular, fundamental rights would serve not only as a guideline for the application of IP law, but also for a reorganization of IP law in the future.

This cannot occur without consequences for positive law: As the misuse of power can now also emanate from economic actors, individual freedoms must from now on not only be protected vis-à-vis the state, but also vis-à-vis private persons. In this sense, see also T. Milly, *supra* n. 22, at 193.

62. According to F. Dessemontet, ‘there will be in the future a tendency to emphasise the direct applicability of all fundamental provisions of the new European legal order to come, allowing therefore private individuals to complain about the behaviour of other private entities which could appear to be in violation of human rights. Why then should the Universal Declaration of Human Rights not benefit from the direct applicability of the European Convention on Human Rights?’ (F. Dessemontet, ‘Copyright and Human Rights’, in *Intellectual Property and Information Law*, eds J.J.C. Kabel & G.J.H.M. Mom (The Hague: Kluwer Law International, 1998), 116). In fact, according to the ECJ, the UDHR and the ICESCR are also part of the European framework concerning fundamental rights and have to be taken into account (see *infra* n. 75).

63. See *infra* II.A.

64. Nevertheless, the introduction of a balanced constitutional clause, modelled on the Universal Declaration, could permit the matter to be framed in a more readable way. For such a clause see also A. Dietz, *supra* n. 22. Of course, some countries in Europe already mention copyright at the constitutional level (see e.g., Art. 42(2) of the Portuguese Constitution; Chapter 2, s. 19 of the Swedish Constitution; Art. 43(1) of the Slovakian Constitution; Art. 60 of the Slovenian Constitution; Art. 34 of the Czech Charta on Fundamental Rights; Art. 44(1) of the Russian Constitution). However, as was rightly stated by A. Dietz, *supra* n. 22, none of these clauses is really drafted in a satisfying manner. In favour of a formal recognition of the authors’ rights at the constitutional level (especially in the ECHR), see also A. Zollinger, *Droit d’auteur et droits de l’Homme*, PhD Thesis, University of Poitiers, 2006, at 181 et seq. See also H. Porsdam ‘On European Narratives of Human Rights and Their possible Implications for Copyright’, in *New Directions in copyright Law. Vol. 6*, ed F. Macmillan (Edward Elgar, Cheltenham (UK)/ Northampton, MA (USA) 2007), 335 et seq.

65. See in this sense P. Torremans, *supra* n. 48, at 19, and J. Drexler, *supra* n. 22, stating that ‘constitutional considerations matter. They are crucial for building a legal system in a situation in which there is a growing feeling that something is wrong with existing copyright’.

III.A FUNDAMENTAL RIGHTS AS GUIDELINES FOR THE APPLICATION OF IP LAW

We will first show how fundamental rights provide a balanced framework for IP law.⁶⁶ We will then illustrate the positive effect that the application of fundamental rights by various European national courts in IP-law disputes has had,⁶⁷ by serving as a shield from some of the overprotective tendencies of IP and securing the coherence which the law (or its understanding) lately seems to have lost.⁶⁸

There are several advantages involved in recognizing fundamental rights as a foundation for the IP system:

- Fundamental rights are included in the national constitutions and bind the legislature. They rank high in the hierarchy of norms. The reference to natural law is no longer necessary because the basis of natural-law values were codified in fundamental rights.⁶⁹ They form the roots of positive law and have to be considered by the lawmakers.⁷⁰ Fundamental rights therefore offer possibilities for a balanced development of intellectual property.
- The legislature has to consider all fundamental rights equally. There is no hierarchical relationship between them. There is a basic tension between property and freedom, which the legislature must bring into a balanced relationship.⁷¹ The property right and the personality right⁷² must therefore always be confronted by different fundamental rights like the freedom of

66. See also in this sense L.R. Helfer, 'Towards A Human Rights Framework for Intellectual Property', *U.C. Davis Law Review* 40 (2007): 971. On the relationship of intellectual property and human rights, see P. K. Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework', *U.C. Davis Law Review* 40 (2007):1039; N. Bronzo, *Propriété intellectuelle et droits fondamentaux* (Paris: L'Harmattan, 2007).

67. On the consequences see also A.E.L. Brown, 'Guarding the Guards: The Practical Impact of Human Rights on Protection of Innovation and Creativity', paper presented at the 20th BILETA Conference, April 2005, Queen's University of Belfast, and by the same author: 'Human Rights: In the Real World', *JIPPL* (2006): 603.

68. See also C. Geiger, 'Fundamental Rights, a Safeguard for the Coherence of Intellectual Property Law?', *IIC* 35 (2004): 268.

69. F. Fechner, *supra* n. 29, at 135.

70. See T. Milly, *supra* n. 22, 187 et seq., underlining that fundamental rights 'provide the basic set of the most fundamental norms and principles to which all areas of law are connected. They thus play a particular role in the pursuit of coherence. Accordingly, private law and fundamental rights should be seen in a dialogical relationship: rather than eliminating choice, autonomy and experimentalism, such a dialogue enables the realisation of certain basic values'.

71. See also in this sense D. Vaver, 'Intellectual Property: The State of the Art', *Law Quarterly Review (LQR)* 116 (2000): 636; S. Ricketson, 'Intellectual Property and Human Rights', in *Commercial Law and Human Rights*, eds S. Bottomley & D. Kinley (Burlington: Ashgate, 2001), 192; J. Cornides, *supra* n. 13, at 167.

72. The link between the moral right and the personality right is very clear in Germany, where moral rights are described as 'authors' personality rights' (*Urheberpersönlichkeitsrechte*). See on this issue J. Drexler, *supra* n. 22. On the constitutional protection of copyright from a German perspective, see also H. Schack, *Urheber- und Urhebervertragsrecht*, 3rd ed. (Tübingen: Mohr Siebeck, 2005), 37 et seq.

expression, the freedom of information, the right of privacy or the right to human dignity,⁷³ and a proportional balance between these rights must be found.⁷⁴ By the way, not only national, but also the European legislature, is bound by them. The rights of the ECHR are considered as general principles of European Union law and have a higher status in the European hierarchy of norms than directives.⁷⁵ Indirectly,⁷⁶ the Convention can thus be considered as the highest binding source of law within the Community concerning fundamental rights, so that both primary and secondary EC law must comply

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73. This last fundamental right, which is to be found in the preamble of the UDHR and of the Covenant, as well as in Art. 1 of the EU Charter on fundamental rights, is very important to act as a limit for the existence of patent law in certain areas, like patents on genetic material. See on this subject the very interesting paper of G. van Overwalle, 'Human Rights' Limitations in Patent Law', presented at the CIER conference on the Human Rights Paradox in Intellectual Property, University of Utrecht, 3–4 July 2006 (to be published in the Molengrafica Series). See also in this sense recital 38 of the Directive of 6 July 1998 on the legal protection of biotechnological inventions (Official Journal L 213, 30 July 1998, at 13): 'Whereas the operative part of this Directive should also include an illustrative list of inventions excluded from patentability so as to provide national courts and patent offices with a general guide to interpreting the reference to *ordre public* and morality; whereas this list obviously cannot presume to be exhaustive; whereas processes, the use of *which offend against human dignity*... are obviously also excluded from patentability'. See also the General Comment No. 17 (2005) of the United Nations Committee on Economic, Social and Cultural Rights to Art. 15(1)(c) of the Covenant (E/C.12/GC/17, 12 January 2006), stating that 'the States parties should prevent the use of scientific and technical progress for purposes contrary to human rights and dignity, including the rights to life, health and privacy, e.g., by excluding inventions from patentability whenever their commercialization would jeopardize the full realization of these rights' (para. 35). See note generally on the issue, *Biotechnologies and International Human Rights*, ed. F. Francioni (Oxford, Hart Publishing, 2007).
74. See also P. Torremans, *supra* n. 48, at 17; M. Grünberger, 'A Constitutional Duty to Protect the Rights of Performers? Goldstein versus California and Bob Dylan – Two Different Stories', IIC 37 (2006): 277 More sceptical, R.L. Ostergard, 'Intellectual Property: A Universal Human Right?', *Human Rights Quarterly* 21 (1999): 156, arguing that to recognize IPRs as human rights is problematic because other human rights, like those relating to physical well-being, must take priority over the guarantee of IPRs as universal human rights. In our opinion, to recognize IPRs as human rights does not mean to give priority to these rights over those relating to physical well-being. On the contrary, it might even require that the latter prevail, because fundamental rights are always to be analyzed in their interaction with other fundamental rights. Art. 27(2) UDHR, for example, should always be contemplated with regard to Art. 27(1).
75. ECJ, case 4/73, ECR 1974, 491; See also Art. 6(2) EU. However, the standard of fundamental rights protection within the EU is much broader than the ECHR, as the ECJ has declared that when constructing the Community standard of fundamental rights protection, it draws inspiration 'from guidelines supplied by international treaties for the protection of human rights on which the Member States have collaborated or of which they are signatories' (see e.g., joined cases C-20/00 and C-64/00, *Booker Aquaculture Ltd, Hydro Seafood GSP Ltd and the Scottish Ministers*, ECR 2003, I-7411 at para. 65. See also the cases 4/73, ECR 1974, 491 and 44/79, ECR 1979, 3727.) This means that the UDHR and the ICESCR are also part of the European framework concerning fundamental rights and have to be taken into account.
76. However, this will change in the future, because the new version of Art. 6(2) EU resulting from the Treaty of Lisbon envisages that "the Union shall accede to the ECHR".

with it.⁷⁷ Directives should therefore always be interpreted ‘in the light’ of the European Convention.⁷⁸ Furthermore, there have been more and more references to fundamental-rights values in the recitals of the latest directives on intellectual property, which also must be considered when interpreting the directives.⁷⁹ However, the nature of fundamental rights as objective principles implies that the obligation to interpret EU law in a manner compliant with fundamental rights is not restricted to directives, but extends to the whole *acquis communautaire*, including the articles of the EC Treaty.⁸⁰

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77. See H. Scheer, ‘The Interaction between the ECHR and EC Law, A Case Study in the Field of EC Competition Law’, *ZEuS* (2004): 690. As a result, in a subordination of EC law to the ECHR, the EC institutions should be considered bound by the ECHR. See also the modified version of Art. 6(2) EU; Art. 51(1) charter of Fundamental Rights of the European Union. In a decision of 27 June 2006, the ECJ referred directly to the Charter of Fundamental Rights when testing the validity of a directive (ECJ, 27 June 1996, *Parliament v. Council*, C-540/03, para. 38; for a comment see A. Bailleux, ‘La Cour de Justice et les droits de l’homme: à propos de l’arrêt Parlement c. Conseil du 27 juin 2006’, *J.T.* (2006): 589). It is therefore possible to conclude that a directive must now also comply with the Charter to be valid.
78. In the case that a directive violates a fundamental right of the ECHR, Member States can bring an action before the ECJ and challenge the conformity of the text to the ECHR: action of annulment according to Art. 230(2) of the EC Treaty (the ECJ has ‘jurisdiction in actions brought by a Member State, the European Parliament, the Council or the Commission on grounds of lack of competence, infringement of an essential procedural requirement, infringement of this Treaty or of any rule of law relating to its application, or misuse of powers’) (emphasis added). Unfortunately, the delay for the action is only two months (Art. 230(5) EC Treaty). Moreover, a natural or legal person can only initiate proceedings against a directive if it is of direct and individual concern (Art. 230(4) EC). That is seldom the case, for example when national legislators have absolutely no margin of discretion in implementing the directive. But after the directive has been implemented, the individual can claim that the implementation law violates his fundamental rights before a national court. If the court considers that the law could violate a fundamental right as embodied in the ECHR, it can refer the matter to the ECJ according to Art. 234 EC. That way, the ECJ can test the validity of a directive, even when the two months are over. On remedies before the ECJ, see P. Craig & G. de Búrca, *EU Law. Texts, Cases and Materials*, 3rd ed. (Oxford University Press, 2003), 482 et seq.
79. See Recital 3 of the Directive of the European Parliament and of the Council on the harmonization of certain aspects of copyright and related rights in the information society of 22 May 2001 (OJEC L 167, 22 June 2001, at 10); Recitals 2 and 32 of the Directive of the European Parliament and of the Council on the enforcement of intellectual property rights from 29 April 2004 (OJEC L 157, 30 April 2004, at 45); Recital 16 of the Directive 98/44/EC of the European Parliament and of the Council of 6 July 1998 on the legal protection of biotechnological inventions (OJEC L 123, 30 July 1998, at 13). Recital 12 of the Amended proposal for a Directive of the European Parliament and of the Council on criminal measures aimed at ensuring the enforcement of intellectual property rights of 26 April 2006, COM (2006) 168 final.
80. See e.g., the decision of the ECJ (case C-260/89, ECR 1991, I-2925) in which the court interprets the freedom to provide services in the light of the general principle of freedom of expression as embodied in Art. 10 of the ECHR. For the use of fundamental rights as mandatory requirements that justify barriers to the fundamental freedoms, see also cases C-368/95, ECR 1997 I-3689 and C-60/00, ECR 2000, I-6297). The arrival at the ECJ, as a result of the enlargement of the European Union of 1 May 2004, of a certain number of judges who have been part of either the European Court of Human Rights or a Constitutional Court could increase the influence of fundamental rights on the jurisprudence of the Court of Luxembourg (in this sense see Y. Laurin, ‘L’Europe à vingt-cinq et la Cour de justice de Luxembourg’, 2006 D. 313).

National legislatures have also, when implementing the directives, to take into account the European standards of fundamental rights,⁸¹ as well as the provisions of their national constitutions, when the directives leave some margin of appreciation.⁸² Fundamental rights therefore constitute a good framework for the development of IP protection. They are effective tools to guarantee a balanced development and understanding of IP rights and a remedy for the overprotective tendencies of lobby-driven legislation.⁸³

- Fundamental rights and human rights represent ethical values, which enjoy widespread consent and acknowledgment under international law.⁸⁴ In the context of globalization, they offer a ‘human’ legal framework for the advancement of intellectual property, which so far has been regarded exclusively from an economic point of view.⁸⁵ Whereas, for instance, the different legal systems show various cultural differences despite their convergences, the moral and cultural values of the UDHR are undisputed and could represent the basis of a worldwide harmonization.⁸⁶ It would be worth considering including a reference to the UDHR in the TRIPS Agreement, so that the Declaration could serve as a guideline for its interpretation.⁸⁷ This

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81. P. Craig & G. de Búrca, *supra* n. 78, 337 et seq. See clearly in this sense clearly the decision of the ECJ, 29 January 2008, *Promusicae v. Telefonica de Espana SAU*, Case C-275/06. No. 70. stating that Community law requires that, when transporting directives, the Member States take care to rely on an interpretation of them which allows a fair balance to be struck between the various fundamental rights protected by the Community legal order. Further, when implementing the measures transposing those directives, the authorities and courts of the Member States must not only interpret their national law in a manner consistent with those directives but also make sure that they do not rely on an interpretation of them which would be in conflict with those fundamental rights or with the other general principles of Community law, such as the principle of proportionality.
82. See e.g., the decision of the German Constitutional Court, 12 May 1989, 1989 EuGRZ 339, 340: ‘The directive... leaves... a considerable margin of appreciation. The national legislature, when implementing the directive, is bound by the guidelines of the German Basic Law’. This has also been clarified recently in Germany by the German Constitutional Court in the context of a framework decision of 18 July 2005, 2005 NJW 2289.
83. See in this sense M. Grünberger, *supra* n. 74, at 302, stating that if a fundamental rights analysis of IP-Law ‘at first sight appears to be another twist to fortify the stronghold of right holders’, it ‘may well turn out to be the critics Trojan horse in the industry’s citadel’.
84. According to M. Cassin, the UDHR has a very strong moral, political and practical impact (R. Cassin, ‘L’intégration, parmi les droits fondamentaux de l’homme, des droits des créateurs des œuvres de l’esprit’, in: *Mélanges Marcel Plaisant* at 231 (Paris: Sirey, 1960)).
85. In this sense also P. Drahos, *supra* n. 47, at 34; A. Chapman, *supra* n. 48, 14 et seq.; A. Kéréver, ‘Authors’ Rights are Human Rights’, *Copyright Bulletin* 32 (1998): 23; P. Torremans, *supra* n. 48, at 16.
86. See also in this sense D. Beldiman, ‘Fundamental Rights, Author’s Right and Copyright – Commonalities or Divergences?’, *Columbia Journal of Law & the Arts* 29 (2005): 60.
87. See Resolution 2000/7 of the UN Sub-Commission on Human Rights, 17 August 2000, on ‘Intellectual Property Rights and Human Rights’ (E/CN.4/SUB.2/RES/2000/7), where the ‘Human Rights Commission requests the World Trade Organisation, in general, and the Council on TRIPS during its ongoing review of the TRIPS Agreement, in particular, to take fully into account the existing State obligations under international human rights instruments’. (emphasis added) See also in this sense Resolution 2001/21 of the UN Sub-Commission on Human Rights,

could prevent a systematic interpretation in favour of the right owners.⁸⁸ Furthermore, it would guarantee that economic reasoning is carried out with ethical considerations.⁸⁹ Such a correction could be incorporated into the Agreement without substantial changes and could even draw a consensus on an international level.⁹⁰

- If legislation does not represent these values, the judges have to interpret the laws in the light of fundamental rights. In exceptional cases, they can even intervene without legal basis within IP law and correct certain excesses. Thus in numerous decisions of European courts, the rights laid out in the ECHR have already been used in copyright disputes to limit the rights of the author (in these cases, fundamental rights act as ‘external’ limits of intellectual property).

We must admit, it is obviously not the ideal solution to fall back on rules from outside intellectual property. It would be preferable for these problems to be solved

16 August 2001 (E/CN.4/SUB.2/RES/2001/21). Unfortunately, these resolutions have no binding character for the Member States, but their political significance is not to be neglected. Furthermore, it is not excluded that these soft law principles evolve into customary international law (see e.g., C.M. Chinkin, ‘The Challenge of Soft Law: Development and Change in International Law’ *International & Comparative Law Quarterly* 38 (1989): 856 et seq. However, the interpretation of TRIPS in the light of the UDHR could already result from the General Rule of interpretation of treaties to be found in Art. 31 of the Vienna Convention on the Law of Treaties of 23 May 1969, entered into force on 27 January 1980 (United Nations, Treaty Series, vol. 1155, 331). According to Art. 31.3(c), for the interpretation of a treaty, ‘any relevant rules of international law applicable in the relations between the parties’ should be taken into account. Giving the numerous ethical questions involved, it is hard to deny that the UDHR can be such a relevant rule in the context of the TRIPS Agreement.

88. However, it has been suggested that the primacy of international human rights acts over trade liberalization rules already require that these rules have to be interpreted in the light of the UDHR (see e.g., the article of G. Marceau, Counsellor for the Legal Affairs Division of the WTO Secretariat: ‘WTO Dispute Settlement and Human Rights’, *European Journal of International Law* 13 (2002): 753 et seq., and from the same author: ‘The WTO Dispute Settlement and Human Rights’, in *International Trade and Human Rights: Foundations and Conceptual Issues*, *World Trade Forum*, Vol. 5, eds F.M. Abbott, C. Breining-Kaufmann & T. Cottier (Ann Arbor: University of Michigan Press, 2005), Chapter 10; R. Howse & M. Mutua, *Protecting Human Rights in a Global Economy: Challenges for the World Trade Organization* (Montreal: Rights & Democracy, International Centre for Human Rights and Democratic Development, 2000). See also Resolution 2000/7 of the UN Sub-Commission, *supra* n. 87.
89. See A. Chapman, *supra* n. 48, at 15. See also A. Kur, ‘A New Framework for Intellectual Property Law – Horizontal Issues’, 35 2004 IIC at 14, underlining the need to take ethical issues more into account.
90. Favouring a link of the TRIPS Agreement to the human-rights treaties, see also L.R. Helfer, *supra* n. 10, at 61. This author maintains that allowing greater opportunities for airing a human-rights perspective on intellectual property issues will strengthen the legitimacy of the WTO and promote the integration of an increasingly dense thicket of legal rules governing the same broad subject matter. See also R.D. Anderson & H. Wager, *supra* n. 48, 707 et seq., underlining the complementarities of international trade law with human rights concerns: ‘It remains that efficiently functioning markets, backed up by appropriate laws and institutions, are central to any realistic programme for development and hence to the fulfilment of human rights’ (at 715).

by IP legislation.⁹¹ But the difficulty here results from the fact that national legislatures are bound by an entire bundle of European or international regulation, leaving them a rather small margin of freedom. In addition, there is often a certain lack of political courage among legislators, as the question is sensitive and controversial. We realize that instead of taking any initiatives, the national legislative bodies prefer to remain quite passive.

Due to this lack of legislative development, the national jurisprudence of several European countries has tried to find some solutions that will permit an equitable readjustment. The judicial instruments to achieve this goal have been various, reaching from competition law (and the granting of certain compulsory licences as in the *Magill* decision of the ECJ)⁹² to media law, the theory of abuse of right or the application of fundamental rights.⁹³ Some cases have entailed some very interesting decisions.⁹⁴ They mainly concern the conflict between an intellectual property right (especially copyright, but also trademark rights)⁹⁵ and freedom of expression⁹⁶ or the

91. See in this sense e.g., A. Lucas, 'Droit d'auteur, liberté d'expression' et droit du public à l'information', 2005 A&M 21.

92. ECJ, 6 April 1995, *Radio Telefis Eireann and others v. Commission and Magill TV Guide*, C-241/91 P and C-242/91 P (ECR 1995, I-743). It is clear that competition law can also be an effective judicial means to 'counter' certain abuses of intellectual property rights (see particularly C. Geiger, *supra* n. 16, at 306 et seq.; U. Bath, 'Access to Information v. Intellectual Property Rights', 2002 EIPR 138). Paradoxically, its application to intellectual property law, while it is still contested by certain purists, is however less contested than the application of fundamental rights.

93. On the judges' recourse to extrinsic exceptions, see C. Geiger, *supra* n. 16, at 382 et seq.

94. For a presentation and analysis of those cases, see C. Geiger, "'Constitutionalising" Intellectual Property Law?', *The Influence of Fundamental Rights on Intellectual Property in Europe*, 37 IIC 389 (2006). See also A.E.L. Brown, *supra* n. 67.

95. To our knowledge, there are very few decisions on patents, which is surprising, as ethical questions play an important role in that field. However, see the decision of the ECJ *Netherlands v. Council and Parliament* (case C-377/98, ECR 2001, I-7079), where the Court assesses whether Directive 98/44/EC on the legal protection of biotechnological inventions (OJ EPO 1999, 101) limits the right to human dignity or the right to self-determination. After calling to mind that 'it is for the Court of Justice, in its review of the compatibility of acts of the institutions with the general principles of Community law, to ensure that the fundamental right to human dignity and integrity is observed' (para. 70), the Court analyzed the different provisions of the Directive and found no limitation of these fundamental rights. For a very critical analysis of this decision see T. Milly, *supra* n. 22, at 208 and D. Beyleved & R. Bwonsword, 'Is Patent Law Part of the EC Legal Order? A Critical Commentary of the Interpretation of Art. 6(1) of Directive 98/44/EC in Case C-377/98', 2002 IPQ 97.

96. On the conflict of copyright with freedom of expression in Europe see e.g., P. B. Hugenholtz, 'Copyright and Freedom of Expression in Europe', in *Expanding the Boundaries of Intellectual Property*, eds R.C. Dreyfuss, D.L. Zimmerman & H. First (Oxford University Press, 2001), 343; A. Strowel & F. Tulkens (eds), *Droit d'auteur et liberté d'expression*, (Brussels: Larcier, 2006), and by the same authors: 'Freedom of Expression and Copyright under Civil Law: Of Balance, Adaptation, and Access', in *Copyright and Free Speech*, eds J. Griffiths & U. Suthersanen (Oxford University Press, 2005), 287; F. MacMillan Patfield, 'Towards a Reconciliation of Free Speech and Copyright', in *The Yearbook of Media and Entertainment Law 1996*, ed. E. Barendt (Oxford University Press, 1996), 199; D. Voorhoof, 'Freedom of Expression, Parody, Copyright and Trademarks', in *Adjuncts and Alternatives to Copyright*, eds J.C. Ginsburg & J.M. Besek

public's right to information.⁹⁷ From this case law, it appears that fundamental rights, far from being a danger for the rights of intellectual property, seem quite to the contrary to be the very instruments to guarantee a certain flexibility in IP law.⁹⁸ Of course, it is not to deny that fundamental rights, because of their very broad and hardly precise wording, can sometimes be asserted in an abusive way. As it already has been said, using rules outside IP legislation to solve internal problems can be considered quite unsatisfying as well. However, such an external effect would be reduced substantially if fundamental rights were recognized as a foundation for the IP system, because then a judge only would have to determine whether the application of the law is consistent with the fundamental-rights objective of the regulation. Thus, the conflict would be 'internalized' and one would interpret the relevant regulations in light of the basic principles of IP law and its protected interests. This way one could prevent the investors from arguing in the name of the creators or the users in order to promote their own interests.⁹⁹

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- (ALAI, 2001; New York, Kernochan Center for Law Media and the Arts, 2002), 636; M.D. Birnhack, 'Acknowledging the Conflict between Copyright Law and the Freedom of Expression under the Human Rights Act', 2003 Ent. L.R. 24; H. Cohen Jehoram, 'Copyright and Freedom of Expression, Abuse of Rights and Standard Chicanery: American and Dutch Approaches', 2004 EIPR 275; M. Elst, 'Copyright, Freedom of Speech, and Cultural Policy in the Russian Federation' (Leiden/Boston: Martinus Nijhoff Publishers, 2005); P. Akester, 'The Political Challenge – Copyright and Free Speech Restrictions in the Digital Age', 2006 I.P.Q. 16; J. Rosen, 'Copyright and Freedom of Expression in Sweden – Private Law in a Constitutional Context, in *Copyright Law: A Handbook of Contemporary Research*, ed. P. Torremans (Cheltenham, UK/Northampton, MA: Edward Elgar, 2007, 355).
97. On the conflict of copyright with freedom of information or the public's right to information, see e.g., C. Geiger, *supra* n. 16, and by the same author: 'Author's Right, Copyright and the Public's Right to Information, A Complex Relationship, in *New Directions in Copyright Law*, Vol. 5, ed. F. Macmillan, *supra* n. 3, at 24. The next part of this article draws on this paper; J. Griffiths, 'Copyright Law and the Public's Right to Receive Information: Recent Developments in an Isolated Community', in *The Yearbook of Copyright and Media Law 2001/2*, eds E. Barendt & A. Firth (Oxford University Press, 2002), 29; M. Löffler, 'Das Grundrecht auf Informationsfreiheit als Schranke des Urheberrechts' 1980 NJW 201; P.B. Hugenholtz, 'Auteursrecht contra informatievrijheid in Europa', in *Van ontvanger naar zender*, eds A.W. Hins & A.J. Nieuwenhuis (Amsterdam: Otto Cramwinckel, 2003) 157; T. Hoeren, 'Access Right as a Postmodern Symbol of Copyright Deconstruction?', in: J.C. Ginsburg & J.M. Besek (eds), *supra* n. 96, 361 et seq.
98. See on this issue C. Geiger, 'Flexibilising Copyright. Remedies to the Privatisation of Information by Copyright', 38 IIC 178 (2008). We thus cannot agree with A.E.L. Brown, *supra* 67, when she concludes: 'It cannot be said, so far, that a human rights based approach to interpretation of IP is having any significant effect.' Even if the cases in which human rights have been used as external limits to intellectual property rights are still rare, which is rather a good sign, the interpretation of intellectual property 'in the light' of these rights has often had a considerable impact on the solutions elaborated by the judges.
99. In the context of the UDHR and the ICESCR, it has been argued, e.g., that the requirement of human creativity 'indicates that persons other than the initial creator of the subject matter may be outside the scope of protection guaranteed by these Articles' (T. Milly, *supra* n. 22, at 196); see also in this sense S. Ricketson, *supra* n. 71, at 192 and the General Comment No. 17 (2005) of the United Nations Committee on Economic, Social and Cultural Rights to Art. 15(1)(c) of the Covenant (*supra* n. 73), stating that the 'the Committee considers that only the "author",

However, creating this kind of new foundation for the system would also imply different consequences for the concrete design of the law.

III.B FUNDAMENTAL RIGHTS AS GUIDELINES FOR REORGANIZING IP LAW

A new foundation would lead to a reorganization of the law and set the course for the arrangement of a fair and balanced IP system.¹⁰⁰

- For one thing, decisions that on principle favour the right-holder, like the principle of the restrictive interpretation of exceptions, would not be justified under a system based on fundamental rights.¹⁰¹ In addition, the so-called ‘three-step test’ (included in Directive 2001/29/EC on the harmonization of certain aspects of copyright and related rights in the information society (Article 5(5), but also in the Berne Convention, the TRIPS Agreement¹⁰² and the WIPO Treaties) would have to be understood in light of the fundamental rights and not in the sense of a preliminary decision for the author and inventor (or the right-holder). Rather, the test could offer greater flexibility for limitations to IP rights and their adaptation to changed social and technical circumstances. This requires, however, a new reading of the three-step test,¹⁰³ namely one that begins with the last step, which requires a balance of the concerned interests and fundamental rights positions with

namely the creator, whether man or woman, individual or group of individuals, of scientific, literary or artistic productions, such as, inter alia, writers and artists, can be beneficiary of the protection of Art. 15(1)(c). . . . The drafters of this article seemed to have believed authors of scientific, literary or artistic productions to be natural persons’ (para. 7). See on this comment H. M. HAUGEN, ‘General Comment No. 17 on ‘Authors’ Rights’’, 10 *The Journal of World Intellectual Property* 53 (2007).

100. See also in this sense H.L. MacQueen, ‘Towards Utopia or Irreconcilable Tensions? Thoughts on Intellectual Property, Human Rights and Competition Law’, 4 *SCRIPT-ed* vol. 2, 500 (December 2005), at, stating that human rights ‘play a dynamic role in political debate about the content and effects of IPRs – and it is in that dimension, I suggest, that we should look to achieve their fullest effects’.
101. See also in this sense T. Milly, *supra* n. 22, at 208. See in this sense Supreme Court of Canada, 4 March 2004, *CHH Canadian Ltd. v. Law Society of Upper Canada*, 2004 SCC 13, 35 IIC 705 (2004): ‘The fair dealing exception, like other exceptions in the Copyright Act, is a user’s right. In order to maintain the proper balance between the rights of a copyright owner and user’s interests, it must not be interpreted restrictively’ (para. 48). For a comment on this important decision, see C.P. Spurgeon, ‘Chronique du Canada’, 207 *RIDA* 209 et seq. (2006).
102. The TRIPS Agreement contains such a test for the limitations of copyright, but also for limitations of trademark and patent rights (Arts 13, 17 and 30 TRIPS). For a horizontal approach to the three-step test, see M. Senftleben, ‘Towards a Horizontal Standard for Limiting Intellectual Property Rights? – WTO Panel Reports Shed Light on the Three-Step Test in Copyright Law and Related Tests in Patent and Trademark Law’, 37 IIC 407 (2006). See also on this topic, C. Geiger, ‘From Berne to National Law, via the Copyright Directive: The Dangerous Mutations of the Three-Step Test’, 2007 *EIPR* 486.
103. For such a new interpretation of the test, see C. Geiger, *supra* n. 5, at 12, and by the same author: ‘The Three-Step Test, A Threat to a Balanced Copyright Law?’, 37 IIC 683 (2006).

consideration of the principle of proportionality.¹⁰⁴ The second step would serve as a corrective, in order to prevent heavy losses for the right-holder. This means it would be necessary to reduce the term of normal exploitation to the core of the exclusive right, as has rightly been suggested by some scholars.¹⁰⁵ Otherwise, in practice almost every use could fall under this notion and other interests could not be considered.¹⁰⁶ In this understanding, the test would have to be applied from the bottom up. Another solution would be to read the test as setting out a number of factors that must be taken into consideration by the judge, following the model of the US doctrine of fair use. The second step would then be only one of the criteria among others to be applied, one of the parameters to be taken into account in the analysis of the application of a limit.¹⁰⁷

- A certain number of creations could be excluded from protection because of their importance for society by a positive definition of the public domain.¹⁰⁸

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104. See also in this sense M. Senftleben, *supra* n. 102. See further the WTO Panel Reports of 17 March 2000 (WTO Document WT/DS114/R) and 15 March 2005 (WTO Document WT/DS174/R), interpreting the test in the field of trademark and patent law. According to the Panel, the term ‘legitimate interests’ has to be defined as ‘a normative claim calling for protection of interests that are “justifiable” in the sense that they are supported by relevant public policies or *other social norms*’ (WTO Panel Patents, para. 7.69; WTO Panel Trademarks, para. 7.663; emphasis added). Without a doubt, fundamental rights would be an example of such social norms.
105. M. Senftleben, *Copyright, Limitations and the Three-Step Test*, (The Hague: Kluwer, 2004), 193. See also S. Dusollier, ‘L’encadrement des exceptions au droit d’auteur par le test des trois étapes’, 2005 I.R.D.I. 220, who refers to the normal exploitation as ‘the principal avenues of the exploitation of a work, those that provide for the author the major source of income’. In copyright, that could for example be the editing/publishing and selling of a book, meaning the exploitation of the work on the principal market.
106. Interestingly, the WTO Panel report in the patent case (*supra* n. 104), unlike the Panel decision of 15 June 2000 in the field of copyright (WTO Document WT/DS160/R), also accepted a normative understanding of the terms ‘normal exploitation’: it must be essential to the achievement of the goals of patent policy (para. 7.58). Therefore, policy considerations could be taken into account at the second step and the concept of normal exploitation would not only be understood in purely economic terms. Taking account of normative aspects also in the field of copyright, see also J.C. Ginsburg, ‘Toward Supranational Copyright Law? The WTO Panel Decision and the “Three-Step Test” for Copyright Exceptions’, 187 RIDA at 23 (2001).
107. For such a reading see K.J. Koelman, ‘Fixing the Three-Step Test’, 2006 EIPR, 407. See also C. Geiger, ‘The Role of the Three-Step Test in the Adaptation of Copyright Law to the Information Society’, *e-Copyright Bulletin* January-March 2007.
108. The notion and the content of the public domain is still not really clarified in legal literature. On this issue, see e.g., J. Litman, ‘The Public Domain’, *Emory Law Journal* 39 (1990): 965; J. Boyle (ed.), ‘The Public Domain’, 66 *Law & Contemp. Probs.* Nos. 1–2 (2003); and more recently, D. Borges Barbosa, ‘Domínio Público e Patrimônio Cultural’, in: *Direito da Propriedade Intelectual – Estudos em Homenagem ao Pe. Bruno Jorge Hammes* (Juruá: Curitiba, 2005), 117; P.B. Hugenholtz & L. Guibault (eds), *The Public Domain of Information* (The Hague: Kluwer Law International, 2006); S. Dusollier, ‘Le domaine public, garant de l’intérêt public en propriété intellectuelle ?’, in *L’intérêt général et l’accès à l’information en propriété intellectuelle*, eds M. Buydens & S. Dusollier (Brussels: Bruylant, 2008, forthcoming); S. Dusollier & V.-L. Benabou, ‘Draw Me a Public Domain’, in *Copyright Law: A Handbook of Contemporary Research*, ed. P. Torremans (Cheltenham, UK/Northampton, MA: Edward

Such exclusions, already known within patent law,¹⁰⁹ could clarify the existing regulation by identifying certain subjects the protection of which is socially or economically undesirable.¹¹⁰ Of course, the list of excluded creations should be non-exhaustive to permit the law to adapt to technical and social evolution.¹¹¹ One could conceivably go one step further and limit the scope of the exclusive nature of the right for creations of considerable social, cultural or economic importance. This kind of reasoning is already admitted in Europe by courts and legal scholars when applying principles of competition law to intellectual property.¹¹² For some creations, the scope of

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- Elgar, 2007, 161). Unlike in the environmental sector, the preservation of informational resources has not been legally secured so far.
109. See for example Arts 52.2 and 53 of the European Patent Convention of 5 October 1973 (EPC); see also the possibility of Member States to exclude some subjects from patentability (Arts 27.2 and 3 of the TRIPS Agreement).
110. In the field of copyright, this could for example lead to the explicit exclusion of essential public information. See also in this sense V.-L. Benabou, 'L'étendue du droit d'auteur/Der Schutzzumfang des Urheberrechts', in *Impulse für eine europäische Harmonisierung des Urheberrechts*, eds R.M. Hilty & C. Geiger (Berlin/Heidelberg/New York: Springer, 2007), 117 et seq. On the problem of the privatization of information through database rights from a human-rights perspective, see S. Corbett, 'A Human Rights Perspective on the Database Debate', 2006 EIPR 83 et seq; E. Derclaye, 'Database *Sui Generis* Right: The Need to Take the Public's Right to Information and Freedom of Expression into Account', in *New Directions in Copyright Law*, vol. 5, ed. F. Macmillan, *supra* n. 3, at 3. In many countries, some creations like official documents and official texts are explicitly excluded from copyright protection. This possibility is left open by the Berne Convention (see Art. 2.4).
111. Compare for example the open wording of Art. 53(a) of the EPC: 'European patents shall not be granted in respect of inventions the publication or exploitation of which would be contrary to "*ordre public*" or morality, provided that the exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation in some or all of the Contracting States.' This clause should allow patent offices (and judges when reviewing their decisions) to include a fundamental-rights reasoning when granting a patent. However, it is to be doubted whether the narrow reading of this article by the EPO is compatible with fundamental-rights obligations so far (see in this sense P. Drahos, 'Biotechnology Patents, Markets and Morality', 1999 EIPR 448, proposing that the EPO constitute a special Ethics Board with plural membership to hear matters in which Art. 53 is being argued, decisions the appeal of which should lie to the European Court of Human Rights). In any case, the EPO Board of Appeal has clearly admitted in its Interlocutory Decision of 5 August 1998 (T 0377/95-3.3.4) that the European Convention on Human Rights should serve to interpret the patent provisions of the EPC. The court stated that 'the overall acceptance of the ECHR as guidance is shown by the fact that all member states to the EPC adhere to the ECHR' (para. 36).
112. See the decision of the ECJ, 29 April 2004, *IMS Health*, 35 IIC 564 (2004), comment by B. Conde Gallego & D. Riziotis. Numerous articles have been written on the application of the essential facilities doctrine to intellectual property; see e.g., J. Drexler, 'IMS Health and Trinko – Antitrust Placebo for Consumers Instead of Sound Economics in Refusal-to-Deal Cases', 35 IIC 788 (2004); G. McCurdy, 'Intellectual Property and Competition: Does the Essential Facilities Doctrine Shed Any New Light?', 2003 EIPR 472; A. Narciso, 'IMS Health or the Question Whether Intellectual Property Still Deserves a Specific Approach in a Free Market Economy', 4 IPQ 445 (2003); B. Conde-Gallego, 'Die Anwendung des kartellrechtlichen Missbrauchsverbots auf "unerlässliche" Immaterialgüterrechte im Lichte der IMS Health – und Standard-Spundfass-Urteile', 2006 GRUR Int. 16.

protection is restricted because they represent an ‘essential facility’. Fundamental-rights reasoning would help to extend this notion to other creations on moral and ethical grounds. A similar approach can be found in the European Television without Frontiers Directive of 30 June 1997,¹¹³ which restricts the exclusivity of a right with regard to certain events of major importance for society.¹¹⁴ The rationale behind this text was to guarantee fundamental rights such as freedom of expression and the public’s right to information.¹¹⁵ Its Article 3a(1) holds that

each Member State may take measures in accordance with Community law to ensure that broadcasters under its jurisdiction do not broadcast on an exclusive basis events which are regarded by that Member State as being of major importance for society in such a way as to deprive a substantial proportion of the public in that Member State of the possibility of following such events via live coverage or deferred coverage on free television.¹¹⁶

Even though the Directive primarily referred to sporting events, it also covers other events of great importance.¹¹⁷ This is how Article 3 has been perceived by certain national legislatures when transposing this Directive. Some of them have thus included several cultural events capable of being protected by copyright on the list of events the access to which cannot be restricted by systems of cryptography or other technical means of protection.¹¹⁸

113. Directive 97/36/EC of the European Parliament and of the Council of 30 June 1997 amending Council Directive 89/552/EEC of 3 October 1989 on the coordination of certain provisions laid down by law, regulation or administrative action in Member States concerning the pursuit of television broadcasting activities (OJEC L 202/60, 30 July 1997, at 60).

114. P.B. Hugenholtz, ‘Copyright, Contract and Code – What Will Remain of the Public Domain?’, 26 *Brooklin J. Int’l. L.* 89 (2000): ‘If legislatures were to contemplate legal measures to cure the negative effects of the wide-scale application of trusted systems, and to safeguard the public domain, comparable legislation outside the field of broadcasting law might be considered, for example, a right of access to (socially, culturally or economically) “important” scientific source material, works of art, etc.’

115. According to e.g., Recital 18 of the Directive, ‘It is essential that Member States should be able to take measures to protect the right to information and to ensure wide access by the public to television coverage of national or non-national events of major importance for society’.

116. See also in this sense Art. 9 of the Convention of the Council of Europe on transfrontier television of 5 May 1989 that prescribed to signatory states that they ‘examine and, where necessary, take legal measures . . . to avoid the right of the public to information being undermined due to the exercise . . . of exclusive rights’. Of course, the production of these events (or of information in general) sometimes requires substantial investments. It is then a question of public policy: If in a democratic society the access to information and to certain works is rated as an essential tool for citizens to participate in the public debate, the access costs should be kept very low (or even sometimes free of charge), like access to education. The production costs should then be partly covered by public funding, if the loss of income due to the reduction of the exclusivity could reduce the incentive for producing it.

117. See on this issue C. Geiger, *supra* n. 16, at 386 et seq.

118. For example, Austria and Italy included on the list some events related to national cultural and as well as other events. See N. Helberger, *Controlling Access to Content, Regulating*

- Limitations to intellectual property rights, which are based on fundamental rights and thereby represent basic democratic values within IP law, are *rights* of the users (and not mere interests to be taken into account), which are of equal value as the exclusive right.¹¹⁹ The consequence of this is that they should be considered mandatory (which means the user's exercise of statutory limitations cannot be restricted by contract)¹²⁰ and should prevail over technical measures. The national legislatures could introduce into their acts a prohibition of technical devices that prevent a use privileged by law, or at least grant the user judicial means to 'enforce' his exceptions (this would lead to the creation of a 'subjective right' to the exception). The so-called Info Soc Directive¹²¹ would not stand in the way of such a solution.¹²²
- Different rules should apply to different works: A work in which no elements of the personality of the creator can be found, cannot enjoy the same protection as those with such elements because the justification of personality

Conditional Access in Digital Broadcasting, (The Hague: Kluwer Law International, 2005), 96 et seq.

119. See for a more detailed analysis C. Geiger, 'Die Schranken des Urheberrechts im Lichte der Grundrechte – Zur Rechtsnatur der Beschränkungen des Urheberrechts', in *Interessenausgleich im Urheberrecht*, eds R.M. Hilty & A. Peukert (Baden-Baden: Nomos, 2004), 143; C. Geiger, 'De la nature juridique des limites au droit d'auteur', 2004 *Propr. intell.* 882. See also Supreme Court of Canada, 4 March 2004, *supra* n. 101. In the context of patent law and TRIPS, see D. Vaver & S. Basheer, 'Popping Patented Pills: Europe and a Decade's Dose of TRIPS', 2006 *EIPR* 282. In this sense, see also L.R. Helfer *supra* n. 10, at 58, stating that a human-rights approach to intellectual property grants users a status conceptually equal to owners and producers.
120. The Belgian law states this imperative character of copyright exceptions explicitly (see Art. 23 *bis* of the Belgian act of 30 June 1994, inserted by an Act of 31 August 1998, which implemented the Database Directive in Belgian law). The mandatory character of the exceptions was maintained in the new Belgian Act of 22 May 2005 (M.B., 27 May 2005, 24997; on this Act see M.-C. Janssens, 'Implementation of the 2001 Copyright Directive in Belgium', 37 *IIC* 50 (2006)), except for the works made available to the public on agreed contractual terms (Art. 7). In France, the imperative nature of copyright exceptions could be deduced from the wording of Art. L 122-5 of the Intellectual Property Code, as it specifies that 'the author cannot prohibit' the uses there stated. A recent decision of the Paris District Court of 10 January 2006, 13 RLDI 24 (2006), even held explicitly that the private copy exception was '*d'ordre public*', meaning mandatory, and therefore that a technical measure should not hinder the making of a copy of a CD. But the French Supreme Court has since then taken a different position (28 February 2006, 2006 D. 784).
121. OJEC L 167, 22 June 2001, at 10.
122. According to Art. 6(4), Member States shall take 'appropriate measures' to ensure the functioning of certain limitations. But the Directive does not say what these measures could consist of. It seems to us that one can hardly perceive it as an 'appropriate measure' if a user has to enforce the benefit of an exception before a court or an arbitration board, as the required efforts will deter most users. It could therefore be helpful to analyze the Directive in the light of Art. 10 of the ECHR. See also in this sense P. Akester, *supra* n. 96, at 33, according to whom the European Court of Human Rights could possibly declare national laws implementing Art. 6 in contravention with Art. 10 ECHR, at least if it is not assured that the beneficiaries of exceptions listed in Art. 6(4) are able to benefit from them.

protection is lacking. That means the extent of protection of creations with a low level of creativity (the so-called ‘small change’ of IP-protected works) must be smaller than that of classical works (a short term of protection, no ‘*droit moral*’, the employer can be the holder of the rights, registration, and so on).¹²³ Creativity or innovation must clearly be differentiated from investment. This would lead to the establishment of a graduated IP system.¹²⁴ It could also possibly lead to an outsourcing of the works with a low level of creativity from the classical IP regimes and to the establishment of a uniform *sui generis* right¹²⁵ (as has been proposed recently for computer programs).¹²⁶ Where IP protection primarily aims at protecting an investment, the fundamental-rights justification is very weak and the balance should be drawn in a completely different manner than when creativity is the main goal for protection. Admitting a fundamental-rights justification could then lead to a complete reshaping of existing IP laws, entailing rather broad protection when the creative input is high and rather narrow protection when the input is low. Such reshaping would surely help IP laws to regain their legitimacy, because as things stand now the public hardly understands why a salad basket, a telephone book, a trivial computer program or some isolated genetic material should deserve the strong protection offered by intellectual property as we know it.

- The IP right has to be developed in such a way that the rights in existence do not prevent the creation of new works.¹²⁷ On the one hand, there is no

123. See also in this spirit P. Torremans, *supra* n. 48, at 19: ‘The higher the level of creativity and the more important the input of the creator is, the stronger the Human Rights claim of copyright will be. Not all works and not all situations will give copyright the same strength in its claim to Human Rights status and in its balancing exercise with other Human Rights’; O. Fischman Afori, *supra* n. 58, at 524. See also in this sense M. Vivant, *supra* n. 20, at 94 et seq.: ‘It is thus far from being incongruous to say, at one and the same time, that authors’ rights could be considered human rights and that this classification could remain a purely formal one in certain borderline cases (e.g., nuts and bolts and computer software).’

124. This would result in a system of different degrees of protection: 1. A creative work would be covered by normal protection; 2. Creations whose creative added value is inferior to external obligations that have to be observed by the creator (works with little margin of creative freedom because of technical, market or genre standards) would only benefit from weaker protection; 3. Non-creative results, which would not be protected by IP law. Such a graduated system has been suggested already by legal doctrine; see e.g., M. Buydens, *La protection de la quasi-cr ation* (Brussels: Larcier, 1993) 779 et seq.

125. For such an idea see also J.H. Reichman, ‘Legal Hybrids between the Patent and Copyright Paradigms’, in *Information Law towards the 21st Century*, eds W.F. Korthals Altes, E.J. Dommering, P.B. Hugenholtz & J.C. Kabel (Deventer: Kluwer, 1992) 325 et seq. The author identifies a number of legal hybrids that form a third intellectual property paradigm and that should therefore not be protected by copyright or patent law, but by a distinct *sui generis* right.

126. R.M. Hilty & C. Geiger, *supra* n. 7. For such a proposal see also P.M. Samuelson, R. Davis, M.D. Kypor & J.H. Reichman, ‘A Manifesto Concerning the Legal Protection of Computer Programs’, 94 Colum. L. Rev. 2308 (1994).

127. See also in this sense T. Milly, *supra* n. 22, at 219, n. 55, arguing that the original author should not necessarily be able to control derivative works.

reason to put the creator who has already created a work in a better position than the creator who would still like to create one.¹²⁸ Rather, the creation of new material has to be privileged if we take intellectual property seriously as an instrument of cultural and technical progress and attach a high value to its social component. Therefore the right has to be restricted if certain basic values (like the freedom of expression or information, privacy or the right to human dignity) are to be held higher than the rights of the creator. The compromise solution of the statutory licence can help in these cases. One could, for example, consider converting the exclusive right into a remuneration right, with royalties paid every time the use of an existing creation makes it possible to create a new work.¹²⁹ In this way, problems like those of the *Magill* case could be prevented right from the beginning.¹³⁰ The exclusive right would therefore be limited to protection against piracy, and the exploitation rights could not be used to prevent the creation of new materials.¹³¹ This might also reduce the number of cases in which

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128. For such a reasoning, see also C. Geiger, 'Copyright and the Freedom to Create – A Fragile Balance', 38 IIC 707 (2007).
129. Patent law already provides a mechanism for this purpose: to prevent the holder of a patent (who is in a dominant position in view of a patent of improvement) from using his right to impede the exploitation of this improvement, the creator can sue for the issue of a compulsory licence based on reasons of dependency (s. 24(2) German Patent Act) or '*licence de dépendance*' (Art. L. 613–615 CPI). Such compulsory licences are also provided by the TRIPS Agreement (Art. 31) and the members of the WTO have wide discretion regarding the reasons that may give rise to the grant of such a licence. See also in this sense Art. 12 of Directive 98/44, dated 6 July 1998, on the legal protection of biotechnological inventions (OJEC L 213, 30 July 1998, at 13), which also provides for compulsory licences in cases of dependency. This situation is similar to the possibility (in theory) of obtaining compulsory licences through antitrust law or via the theory of abuse of rights. The main disadvantage in all these cases is the fact that the licence has to be ordered by a judge, a fact that favours those economic actors who have the resources to afford the associated legal costs of sometimes very long proceedings. In the meantime, innovation is blocked. Therefore, it seems that legal regulations for non-voluntary licences based on a right to remuneration should be preferred. In this sense in the field of software see R.M. Hilty & C. Geiger, *supra* n. 7, at 641 et seq.
130. *Supra* n. 92. In this case, the right-holders were using their copyright to prevent the creation of a new TV guide.
131. For a detailed discussion of such a solution, see C. Geiger, *supra* n. 16, at 323–332. This would also be compatible with the three-step test (on this test see *supra*), provided that the second step related to the normal exploitation of the work is interpreted very restrictively. For such interpretation, see C. Geiger, *supra* n. 5, at 12. To avoid the radical implications of the statutory licence and in regard of the current broad interpretation of the concept of normal exploitation, the option of the mandatory collective administration of the exclusive right in these cases of productive use could be followed (for a discussion of this option see C. Geiger, *supra* n. 16, at 333 et seq.). As has been asserted, the implementation of this solution would not be hindered by the three-step test, because provisions prescribing such administration should not be regarded as exemptions to the exclusive rights (see S. von Lewinsky, 'Mandatory Collective Administration of Exclusive Rights – A Case Study on Its Compatibility with International and EC Copyright Law', *e-Copyright Bulletin*, January-March 2004, 1; K.J. Koelman, 'The Levitation of Copyright: An Economic View of Digital Home Copying, Levies and DRM', in *Intellectual Property Law 2004*, eds F.W. Grosheide & J.J. Brinkhof (Antwerpen/Oxford:

IP rights are abused to hinder the expression of certain opinions. The idea of such an ‘exception for creative uses’ can be found in a bill in the United States concerning orphan works. According to this bill, when an author creates a derived work starting from an orphan work (that is, whose right-holders cannot be found after a reasonable search), the right-holder to the first work who subsequently reappears will not be able to prevent the exploitation of the derived work post hoc, but can only demand fair compensation.¹³²

Of course, adversaries of such a reshaping of the scope of IP rights would invoke the constitutional protection of property to oppose such a suggestion immediately. However, the qualification of copyright as property in the constitutional sense does not under any circumstances prevent a balanced arrangement of the law.¹³³ On the contrary, the ‘social function’ of property (as laid down for example in Article 14(2) of the German Constitution) orders this reconciliation of interests.¹³⁴ The German Constitutional Court stated that very clearly at the beginning of the 1970s in its *school book* decision on copyright, holding that although the protection of property rights

implies that the economic exploitation of the work in principle rests with the author, the constitutional protection of property rights does not extend to all such exploitations. It is a matter for the legislature to determine the limits of copyright by imposing appropriate criteria, taking into

Intersentia, 2005), 436 et seq.; C. Geiger, ‘The Role of the Three-Step Test in the Adaptation of Copyright Law to the Information Society’, *e-Copyright Bulletin*, January-March 2007).

132. Section 514, Orphan Works Act of 2006, 109th Congress, 2nd Session, H.R. 5439, introduced to the House of Representatives on 22 May 2006. See also the specific provision on orphan works in the Canadian copyright law (Copyright Act, R.S.C., ch. C-42, Sec. 77 (1985) (Can.), permitting anyone who wants to make a copyright use of a work and cannot locate the copyright owner to petition the Canadian Copyright Board for a licence. See also on this point the study conducted by the IViR (Institute for Information Law) of the University of Amsterdam, *The Recasting of Copyright & Related Rights for the Knowledge Economy*, 185 et seq. (Amsterdam, November 2006), which recommends the implementation in the countries of the EU of a system permitting a public authority to grant a compulsory licence to the user of an orphan work. The study also envisages the creation of an exception for the use of such a work, which would have to provide for a payment to the right-holder if he or she should reappear (at 188). See also the article of one of the authors of this study, S. van Gompel, ‘Unlocking the Potential of Pre-existing Content: How to Address the Issue of Orphan Works in Europe?’, 38 IIC 2007, 669 (2007). On the issue of orphan works from a German perspective see also G. Spindler & J. Heckmann, ‘Retrodigitalisierung verwaister Printpublikationen, Die Nutzungsmöglichkeiten von ‘orphan works’ de lege late inferenda 2008 CIRUR Int 271.
133. See also in this sense J. Griffiths, ‘Copyright Law after *Ashdown* – Time to Deal Fairly with the Public’, 2002 IPQ 240 (at 263): ‘The right to property is undoubtedly recognised internationally as a human right. However, states are typically accorded a wide margin of appreciation in regulating the right to property in order to advance the common good.’
134. Admitting that intellectual property falls under the constitutional notion of property should then not be feared, on the contrary. See in this sense also P. Drahos, *supra* n. 47, at 34: ‘Viewing intellectual property through the prism of human rights discourse will encourage us to think about ways in which the property mechanism might be reshaped to include interests and needs that it currently does not.’

account the nature and social function of copyright and ensuring that the author participates fairly in the exploitation of his work.¹³⁵

The second paragraph of Article 1 of Protocol 1 of the ECHR also leaves a large margin for the states to regulate property.¹³⁶ On the one hand, the constitutional right to property orders the fundamental allocation of the economic value to the creator, but it does not require that this value always be assigned to him by means of an exclusive right.¹³⁷ Sometimes a legal remuneration right (in the form of a statutory licence) can even be economically more favourable for the creator. This was emphasized by the German Federal Supreme Court explicitly in the field of copyright in its *Electronic Press Review* decision.¹³⁸ On the other hand, the legislature has a considerable scope of discretion.¹³⁹ It could therefore come to the conclusion that the creation of a new work has to be rated as being more important and introduce a remuneration right in the form of a statutory licence. In our opinion, the protection of property prevents only a general transformation of the exclusive right into a mere levy.

- The IP system must benefit the creators of works in a better way. They must participate more effectively in the exploitation of their works. How this can finally be reached is secondary. One could, of course, imagine a better contract law¹⁴⁰ (with some imperative rules, like the copyright contract

135. German Constitutional Court, 7 July 1971, 1972 GRUR 481, 3 IIC 394 (1972), with comment by W. Rumphorst. On the relationship of intellectual property and Art. 14 of the German Basic law (protection of property), see B. Grzeszick, 'Geistiges Eigentum und Art. 14 GG', 5 ZUM 344 (2007). See also on this issue C. Geiger, 'Die Schranken des Urheberrechts als Instrumente der Innovationsförderung – Freie Gedanken Zur Ausschließlichkeit im Urheberrecht', 2008 GRUR Int. (forthcoming).

136. According to Art. 1.2 of Protocol 1 ECHR, 'the preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties'. In his judgment in *Sporrong and Lönnroth v. Sweden* (23 September 1982, HRLJ 1982, 268 (284)), the European Court of Human Rights held that 'the Court must determine whether a *fair balance* was struck between the demands of the general interests of the community and the requirements of the protection of the individual's fundamental rights. . . . The search for this balance is inherent in the whole of the Convention and is also reflected in the structure of Art. 1 of Protocol 1' (para. 69). For example, in the *Smith Kline* case (*supra* n. 53), the European Commission on Human Rights stated that the grant under Dutch law of a compulsory licence in a patented drug was not a violation of Art. 1 of Protocol 1. It considered that the compulsory licence was lawful and pursued a legitimate aim of encouraging technological and economic development.

137. This is all the more the case in the context of the UDHR and the ICESCR which, as we have already pointed out, do not determine that the creators' material and immaterial interests should necessarily be protected by a right of intellectual *property*.

138. German Federal Court, 11 July 2002, 2002 GRUR 963. The Federal Supreme court of Switzerland came recently to the same conclusion in a very interesting decision of 26 June 2007 Grur. Int. 1046.

139. See also in this sense J. Cornides, *supra* n. 13, at 141; P. Torremans, *supra* n. 48, at 8. Much more restrictive in the German context, see H. Schack, *supra* n. 72, at 41.

140. See e.g., R.M. Hilty, *supra* n. 6, at 137.

rules of some European countries), but also an increase of statutory licences if these offer financially more favourable solutions for the creators than the exclusive right. This latter course has so far remained relatively unexplored and still requires closer investigation.¹⁴¹

IV. CONCLUSION

An investigation of the basis of intellectual property shows that the classical justifications have been displaced in favour of protection of investment and that the balance within the system is threatening to break in favour of the exploiters of IP rights. This conclusion is not new, this ‘paradigm shift’ already having been stressed by the literature in the 1980s;¹⁴² but no real conclusions were drawn at the time. Assuming, however, that the foundations of the system have changed, the same solutions cannot apply and the whole subject must be considered again. In order to ensure a fair balance of interests, a re-founding of the system is necessary; in this chapter, we have tried to show that fundamental rights can offer a suitable basis for a balanced system. The search for a new foundation is already urgent, because an unbalanced system is at risk of collapsing at any time. We have already quoted Thomas Aquinas, who said that positive law can only be regarded as legitimate as long as it aims for general societal well-being and ensures an appropriate balance between different interests. If this is no longer the case, then the system loses its legitimacy. The American writer Henry David Thoreau showed in the nineteenth century which attitude individual humans should have if they are confronted with a law which is illegitimate. In his work ‘On the Duty of Civil Disobedience’, published in 1849, he maintains that everyone has the right to disobey an ‘unfair’ law. He writes: ‘I think we should be men first, and subjects afterwards. It is not desirable to cultivate a respect for the law, so much as for the right’,¹⁴³ and for justice. The massive rejection of intellectual property in the public opinion unfortunately seems to prove him right. It is therefore urgently necessary to bring intellectual property closer to the people again, to humanize the subject by binding it to the basic values of our juridical system: fundamental rights and human rights.

141. Such ideas have recently been formulated for the field of copyright. See C. Geiger, *supra* n. 16, at 318 et seq.; R.M. Hilty, ‘Verbotsrecht vs. Vergütungsanspruch: Suche nach den Konsequenzen der tripolaren Interessenlage im Urheberrecht’, in *Festschrift für Gerhard Schricker*, eds A. Ohly, T. Bodewig, T. Dreier, H.-P. Götting, M. Haedicke & M. Lehmann (Munich: Beck, 2005) 348 et seq. In the context of the levy for private copying, see also K. Gaita & A.F. Christie, ‘Principle or Compromise? Understanding the Original Thinking behind Statutory License and Levy Schemes for Private Copying’, 2004 I.P.Q. 426; A. Dietz, ‘Continuation of the Levy System for Private Copying Also in the Digital Era in Germany’, *Auteurs et Médias* (2003): 348 et seq.

142. See e.g., A. Dietz, *supra* n. 45, at 22.

143. Henry David Thoreau, *On the Duty of Civil Disobedience* (1849, republished by Applewood Books, Bedford MA, 2000).

Chapter 5

Intellectual Property Rights and Human Rights: Coinciding and Cooperating

*Estelle Derclaye**

I. INTRODUCTION

The discourse on the interface between intellectual property rights (IPR) and human rights is relatively recent. The debate was sparked at the end of the 1990s with the adoption of resolutions by several international bodies¹ and since then, the literature on the topic has grown. The debate has centered on whether IPR and human rights coexist or are in conflict.² The ‘conflict approach’

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1. See e.g., Panel discussion, Geneva, 9 November 1998, *Intellectual Property and Human Rights*, WIPO, Geneva, Publication, No. 762(E) 1999; UN Sub-Commission on the Promotion and Protection of Human Rights, Resolution 2000/7, *Intellectual Property and Human Rights*, UN Doc. E/CN.4/Sub.2/RES/2000/7, 17 August 2000; *Intellectual Property and Human Rights*, Statement by the Committee on Economic Social and Cultural Rights: follow-up to the day of general discussion on Art. 15(1)(c), E/C.12/2001/15, 26 November 2001; World Trade Organization, *Protection of Intellectual Property under the TRIPS Agreement*, E/C.12/2000/18, 27 November 2002. For a complete list of the documents, see J. Cornides, ‘Human Rights and Intellectual Property: Conflict or Convergence?’ [2004] *Journal of World Intellectual Property* 135 and related fn. and H. Haugen ‘Patent Rights and Human Rights: Exploring Their Relationships’, [2007] vol. 10, No. 2, *Journal of World Intellectual Property*, 97.
2. L. Helfer, ‘Human Rights and Intellectual Property: Conflict or Coexistence?’ [2003] 5 *Minnesota Intellectual Property Review* 47, 48–49; Cornides, above fn. 1. Although some

sees human rights and IPR as fundamentally conflictual rights, so that the first must necessarily ‘win’ over the second.³ The ‘coexistence approach’ sees both rights trying to answer the same question, that is, where to strike the right balance between giving an incentive to create and innovate whilst insuring the public has sufficient access to such creations and inventions, although disagreeing over where to strike that balance.⁴ The majority of commentators have accepted or assumed that the two were in conflict and focused on the resolution of these conflicts. Moreover, some of this literature and the documents issued by the UN institutions remain at the general and/or political, even demagogic level.

However, in order to determine the precise nature of the relationship between human rights and IPR in depth, one has to revert to the fundamentals of IPR and therefore their justifications and aims and then examine how the legislature has transcribed these aims. This analysis reveals two important findings. First, there is no intrinsic conflict between IPR and human rights (at least no more than between other human rights themselves, if any). This is because IPR are themselves human rights and for this reason, they share the same goals as other human rights (sections II–IV). To this end, the article gives concrete examples and lists the areas where such absence of conflict exists (section IV). However, in some (rare) cases, ‘real conflicts’ indeed occur because an excess of IPR protection results either from the legislation or from its interpretation by judges, or both. What needs to be done in these situations is to curtail IPR which do not respect other human rights and find specific tests so that courts can rectify the excess and the right balance can be achieved (if this cannot be solved internally, within the intellectual property laws themselves, by legislatures). Second, human rights and IPR do not ‘simply’ coexist but in fact most of them coincide from the outset, that is, they have the same goal (for example, the protection of privacy, of property or freedom of speech) and as a result, in most cases, because of this similarity or identity of goals, they even ‘cooperate’ (section IV). The article focuses on EU law and the four main IPR namely, copyright, patents, trademarks and designs.

II. INTUITIONS

It is not difficult to imagine how the world would be without human rights. The two world wars have amply shown what the result is. The last of the two triggered a universal awareness⁵ of abuses by the world nations of human rights and their

have asserted that ‘because of the overlapping human rights attributes, these two sets of rights both coexist and conflict with each other’. See P. Yu, ‘Reconceptualising Intellectual Property Interests in a Human Rights Framework’ [2007] 40(3) *U.C. Davis Law Review* 1039, 1078.

3. Human rights treaty bodies have embraced this approach. For the documents, see above fn. 1.
4. Helfer, above fn. 2, at 48–49. The WTO embraced the coexistence approach. See World Trade Organization, *Protection of Intellectual Property Rights under the TRIPS Agreement*, above fn. 1, para. 9.
5. Such national awareness existed before as many constitutions recognized human rights. Think only of the *Declaration of the Rights of the Man and of the Citizen*, approved by the National Assembly of France, 26 August 1789, available at <www.hrcr.org/docs/frenchdec.html> (last accessed 22 April 2008).

commitment to avoid them at international and regional level by the signing of the Universal Declaration of Human Rights (UDHR) (1948), the International Covenant on Civil and Political Rights (ICCPR) (1966), the International Covenant on Economic, Social and Cultural Rights (ICESCR) (1966)⁶ and the European Convention of Human Rights (ECHR) (1950).

But what would the world be without IPR? It is not difficult to imagine as some countries have lived in such a situation until very recently. To take but one example, how was the situation in the USSR and its other dependent republics and countries before the perestroika and the fall of the Berlin wall? With a planned economy and markets controlled by the state, trademarks did not exist, or rather there was only one (the state's). Authors and artists were constrained in their creations because of political reasons. As to innovation, it took place and at an excellent level, but it was financed solely by the state and corresponded to, mostly, defense or broader political ends (nuclear energy, rockets, satellites, submarines and so on). Other aims were barely considered. But we do not even have to look at ex-communist countries to illustrate how a world without IPR looks like, a simple trip back in time in Western Europe before the advent of copyright and patent laws similarly does the trick where authors and inventors depended on private patrons⁷ or sovereigns. It is not a surprise that IPR came with revolutions. Hence, the link between and even inclusion of IPR within human rights. IPR are intrinsically linked to a free market economy and a democratic society.⁸ With copyright, authors finally obtained the right to earn money by themselves (through publication of their works independently) rather than writing for the patron or sovereign only and being paid by him or her, restricting therefore his or her ability to criticize power. These times were also those where perpetual monopolies on inventions or even simply some common (not innovative) businesses were granted by the monarch to the very few he trusted. Intellectual property laws have abolished this state of play and allow everyone who creates or invents something to obtain a copyright or patent for it. Trademark law also allows a free market economy as no right can subsist in descriptive and generic terms, thereby avoiding monopolies. Even if copyright and patents give exclusive rights which may sometimes confer a monopoly, the latter are always limited in time and scope, keeping competition alive. Micro-economists tell us that such competitive state brings dynamic efficiency and with it, constant

6. International Covenant on Civil and Political Rights, adopted 16 December 1966, 999 UNTS 171 (entered into force 23 March 1976), GA Res 2200 (XXI), 21 UN GAOR, Supp (No. 16) at 52, UN Doc A/6316 (1966) and International Covenant on Economic, Social and Cultural Rights, adopted 16 December 1966, 993 UNTS 3 (entered into force 3 January 1976), GA Res 2200 (XXI), 21 UN GAOR Supp (No. 16) at 49, UN Doc A/6316 (1966).

7. This spans from (at least) Roman times until the eighteenth century. A good example is the dependence of the poet Horatius on Maecenas's generosity, cited by Cornides, above fn. 1, at 143.

8. See e.g., N. Netanel, 'Copyright and a Democratic Civil Society' [1996] 106 *Yale Law Journal* 283, arguing this in respect of copyright.

innovation.⁹ They also tell us that competitive markets and the innovation that ensues leads to social welfare. So even if IPR were not human rights, they would still be conducive of human well-being. And what do human rights try to achieve? Human well-being. Q.E.D.:¹⁰ there is no conflict between human rights and IPR. To that end, they both set rules so that human beings respect other human beings.

III. PHILOSOPHICAL UNDERPINNINGS

An analysis of the justifications for intellectual property protection confirms this intuitive supposition. A full-blown review of the several justifications for IPR is not repeated here as it has been many times explained in detail elsewhere.¹¹ In short, IPR, copyright, patents and designs can be justified in three different ways. First, according to the naturalist justification,¹² IPR are natural rights. Therefore, the author or inventor has both economic and moral property rights in his or her creation or invention as they are the fruits of his or her own labour. Although this justification is philosophical and therefore is not very detailed, it still acknowledges the fact that such rights must have some limits.¹³ Second, according to the utilitarian justification, IPR are necessary in society because they contribute to the general well-being. In order to achieve this goal, property rights are given to authors and inventors as an incentive to create and innovate but some aspects must remain in the public domain to preserve future creations and innovations. The underlying idea, which can also be found in the US Constitution, is that patent and copyright are not ends in themselves but only tools to another greater end: progress.¹⁴ The utilitarian justification has been further elaborated by the

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9. See e.g., N. Mankiw, *Principles of Economics*, 3rd ed. (Mason, OH: Thomson/South-Western, 2002); D. Begg et al., *Economics*, 8th ed. (London: McGraw Hill, 2005), Chapters 8 & 9; F. Scherer & D. Ross, *Industrial Market Structure and Economic Performance*, 3rd ed. (Boston MA: Houghton Mifflin, 1990), Chapters 1 & 2.
 10. *Quod erat demonstrandum*, Latin for 'which was to be demonstrated'.
 11. See e.g. Cornides, above fn. 1. For copyright in particular, see e.g., E. Derclaye, *The Legal Protection of Databases: A Comparative Analysis* (Cheltenham: Edward Elgar, 2008), Ch. 1, s. 1 and authors cited.
 12. The naturalist justification of IPR is inspired by Locke's Second Treatise on Civil Government of 1690.
 13. There are inbuilt limitations in the Lockean theory of IPR which ensure that owners do not harm others. One is that 'enough and as good' should remain in the commons. See M. Birnhack, 'Copyrighting Speech: A Trans-Atlantic View', in *Copyright and Human Rights: Freedom of Expression – Intellectual Property – Privacy*, P. Torremans (ed.) (The Hague: Kluwer Law International, 2004), 37, at 50.
 14. Copyright and Patent clause, Art. 1, s. 1, clause 8 of the US Constitution which gives Congress the power 'to promote the Progress of Science and useful Arts by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries'. See also Cornides, above fn. 1, at 159.

economics of law literature and more precise limits to IPR have been defined.¹⁵ These are called ‘economics of intellectual property’ and are often classified as a sub-category of the utilitarian argument. The economics of intellectual property have detailed the limits to IPR. Finally, the most recent justification is by way of human rights. In a way, it may be said to be encompassed in the naturalist justification if human rights are deemed to be natural rights. This justification also implies limits although they are generally only sketched out in the international, regional and national legal instruments and start to emerge from the case law. In addition, as this justification classifies IPR as a human right, it reinforces IPR’s welfare goal and at the same time, reveals that the human rights and utilitarian justifications have the same goal. Furthermore, as human rights all have equal rank,¹⁶ they must all be balanced with one another and therefore all have intrinsic limits. IPR are no exception. A quick word should be said of trademarks. Their primary function is to guarantee the origin of products, i.e. that the same branded goods or services come from the same source, and therefore prevent confusion of consumers. Nowadays, an additional advertising function has been recognized to trademarks so that the trademark itself has value as such, as a ‘lifestyle concept’.¹⁷ Trademarks are therefore different from patents and copyrights as they are not granted to incentivize innovation but to prevent confusion and protect the trademark owner’s goodwill. Nevertheless, they have limits as well (such as the prohibition of protection of descriptive and misleading signs, limitation of infringement to use in trade and to use of a similar sign on similar goods or services) and thereby prevent monopolies.

From the above, it is clear that all these justifications and especially the economic and human-rights ones share the same underlying theme: there must be limits to IPR. For instance, the two last justifications entail that quotation, criticism and use for private and educational purposes should be possible. This shows that whatever the argument used to justify IPR, the specific IPR protection in question will by definition (intrinsically or internally) respect human rights. All IPR have internal, inherent limits from the outset that respect human rights. So there should not be any conflicts.¹⁸ Perhaps, this finding (that IPR have limits) and the related

15. For the economics of IPR generally, see R. Posner, *Economic Analysis of Law*, 4th ed. (Boston/Toronto/London: Little, Brown & Co. 1992); R. Cooter & T. Ulen, *Law and Economics*, 2nd ed. (Harper Collins Publishers, 1997). For copyright, see e.g., W. Landes & R. Posner, ‘An Economic Analysis of Copyright Law’ [1989] 18 *Journal of Legal Studies* 325. For trademarks, see e.g., W. Landes & R. Posner, ‘Trademark Law: An Economic Perspective’ [1987] 30 *Journal of Law and Economics* 265. For patents, see e.g., F. Machlup, ‘An Economic Review of the Patent System’, Study of the Committee on Patents, Trade Marks and Copyright Committee on the Judiciary, US Senate, 85th Congress, Study n. 15 (Washington, DC: 1958).

16. See e.g., A. Chapman, ‘The Human Rights Implications of Intellectual Property Protection’ [2002] 5 *Journal of International Economic Law* 861, at 863.

17. Cornides, above fn. 1, at 145.

18. The yardstick Cornides, above fn. 1, at 159, proposes to use is that patents and copyright aim to promote progress and development Accordingly, ‘it may be assumed that, if legislation on intellectual property corresponds to this purpose, there can be no true conflict between intellectual property and policy objectives, such as development, public health, or the fight against hunger’.

set of rules boil down to the general jurisprudential or philosophical saying that no right should ever be absolute or ‘my freedom ends where yours begins’. And this is also the case for human rights (for example, Articles 8 and 10 ECHR and 1 First Additional Protocol to the ECHR have limitations in their second paragraphs). Q.E.D. (Qued erat demonstratum), once more. Most if not all the literature has so far not seen this point.¹⁹ Of course, a social problem and its solution in the law cannot be so easily equated with a mathematical equation and its solution. On the contrary, the law is full of nuances. This is why obviously this article does not stop here.

IV. THE MYTH DESTROYED: THERE IS NO CONFLICT BETWEEN IPR AND HUMAN RIGHTS

Before looking at the areas identified by authors as areas of so called ‘conflict’, a few clarifications must be made. First of all, it is clear that rights on inventions and creations are human rights. This derives from Article 27(2) of the UDHR and Article 15(1)(c) of the ICESCR.²⁰ Although the UDHR is not

19. For instance, Chapman above fn. 16, at 867 who seems to imply that intellectual property laws’ main or sole goal is to maximize economic benefits. See also L. Helfer, ‘Toward a Human Rights Framework for Intellectual Property’, [2007] 40 *U.C. Davis Law Review* 971, 1018: ‘A third human rights framework for intellectual property proceeds from a very different premise. It first specifies the minimum outcomes – in terms of health, poverty, education, and so forth – that human rights law requires of states. The framework next works backwards to identify different mechanisms available to states to achieve those outcomes. Intellectual property plays only a secondary role in this version of the framework. *Where intellectual property laws help to achieve human rights outcomes, governments should embrace it. Where it hinders those outcomes, its rules should be modified (but not necessarily restricted, as I indicate below). But the focus remains on the minimum levels of human well-being that states must provide, using either appropriate intellectual property rules or other means.*’ (emphasis added). When he says this, he respectfully fails to more clearly state that human rights and IPR have the same goal. In fact, as IPR are a type of human right obviously, their goal is the same as all human rights, human welfare. C. Geiger, ‘“Constitutionalising” Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property in the European Union’ [2006] 37 *International Review of Intellectual Property & Competition Law* 371, 379–381 does not see this either. For him, natural law is vague and the utilitarian justification reduces ‘creative activity to a strictly economic process’ whereas many studies have shown that creators often do not act out of monetary purposes. This is why the human-rights justification for IPR seems to be ‘the solution’ for this author in order to re-establish the long-gone equilibrium (see *ibid.*, ‘Fundamental Rights, a Safeguard for the Coherence of Intellectual Property Law?’ [2004] 35 *International Review of Intellectual Property & Competition Law* 268, ‘the balance in IPR has long ceased to be harmonious’), although he admits that the balance is better made internally than externally by using human rights ([2006], at 389). Even if it can be said that in some countries (mainly the author’s rights or civil law systems), ‘copyright has become an industrial right where investment has become the reason for protection’ (*ibid.*, at 381), this was the case from the beginning in copyright systems (common law countries). In addition, if some authors do not create for money, many still do live out of their intellectual efforts (authors and performers of music, writers, other artists, most if not all patentees).

20. Art. 27 provides: ‘(1) Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits.

(strictly) binding, the ICESCR is.²¹ The remainder of the chapter will therefore focus on the ICESCR and the ECHR. When the ECHR has also provided for the same right as the ICESCR, the focus will be on the ECHR. Second, not only creations but also inventions are classified as human rights.²² It appears equally from the latter two articles. What is the content of Article 15 ICESCR? It

recognizes a number of distinct rights: everyone's cultural rights, everyone's right to benefit from scientific and technological development and everyone's right to benefit from individual contributions they make. In other words, it provides a framework within which the development of science and culture is undertaken for the greater good of society while recognizing the need to provide specific incentives to authors for this to happen.²³

Neither the UDHR nor the ICESCR dictate the level or modality of protection for material interests in intellectual productions.²⁴ Hence, property rights are not mandated to protect intellectual endeavours. As a result, states have some latitude as to which legal form may be given to such inventions and creations. In addition, Article 17 UDHR's flexible drafting²⁵ allows states to modulate their level of intellectual property protection (strong or less strong).

At European level, however, the European Court of Human Rights has recently clarified that IPR (at least copyright, trademarks, patents and even

(2) Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author'. Art. 15(1) provides: 'The States Parties to the present Covenant recognize the right of everyone: (a) To take part in cultural life; (b) To enjoy the benefits of scientific progress and its applications; (c) To benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.' See also *The right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he or she is the author*, General Comment No. 17, UN ESCOR, Comm. on Econ., Soc. & Cult. Rts., 35th Sess., UN Doc. E/C.12/GC/17 (2006), para. 1 provides that the right to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which she or he is an author is a human right.

21. Many authors recognize that the UDHR has a binding effect as customary international law. See e.g., Chapman, above fn. 16, at 863. Be that as it may, even if it does not, it has great moral value and the ICESCR binds states in any case so that determining the legal effect of the UDHR is not so important here. Note that the ICCPR, above fn. 6, is also binding.
22. S. Ricketson, 'Intellectual Property and Human Rights', in *Commercial Law and Human Rights*, S. Bottomley & D. Kinley (eds) (Dartmouth: Ashgate, 2002), 189–191. Even though Art. 27(2) of the UDHR and Art. 15(1)(c) of the ICESCR use the term 'authors' only and not inventors, it uses the term 'scientific production' so that it is deemed to also encompass inventors and designers.
23. P. Cullet, 'Human Rights and Intellectual Property Protection in the TRIPS Era' [2007] 29(2) *Human Rights Quarterly* 403, at 408.
24. Yu, above fn. 2, at 1092.
25. It provides: '(1) Everyone has the right to own property alone as well as in association with others. (2) No one shall be arbitrarily deprived of his property'.

applications for the latter two rights) are property rights falling under Article 1 of the First Additional Protocol to the ECHR.²⁶

Even international agreements on IPR integrate human rights notions, which can be said to come from the utilitarian justification and perhaps as well from the human-rights justification for IPR. Article 7 of the TRIPS Agreement provides that IPR must ‘contribute to the promotion of technological innovation . . . and in a manner conducive to social and economic welfare, and to balance of rights and obligations’.²⁷ Human rights other than IPR are also, at least implicitly, recognized in Article 8(1) of the TRIPS which provides that: ‘Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement.’²⁸ The literature has derived from Article 8 that TRIPS must be applied in light of human rights laws. In other words, when implementing TRIPS, states must respect their human-rights obligations.²⁹

As stated in the introduction, most commentators believe that IPR conflict with human rights. It should first be noted that that no conflicts have been identified at the level of treaty obligations.³⁰ Thus countries which have adhered to both human rights and intellectual property treaties do not have conflicting international obligations. It is now useful to summarize these alleged conflicts by listing the different types of IPR and of human rights (section IV.1), then analyze these relationships in more detail in order to disprove the presumption that they are in conflict (section IV.B). Finally, areas where *excessive* IPR protection leads to ‘real conflicts’ can be identified and remedies, discussed (also within section IV.B).

26. See *Anheuser-Busch Inc. v. Portugal*, No. 73049/01, ECtHR, 11 January 2007, available at <<http://cmiskp.echr.coe.int/tkp197/search.asp?sessionId=7172327&skin=hudoc-en>>, (last accessed 22 April 2008). (conflict between two trademarks). The Court held that Art. 1 of the First Additional Protocol applies to intellectual property (para. 72). It also cited previous case law that ruled in this direction: *Smith Kline and French Laboratories Ltd v. The Netherlands*, No. 12633/87, Decision of 4 October 1990, Decisions and Reports (DR) 66, 70 (in relation to a patent); *Melnychuk v. Ukraine* (Dec.), No. 28743/03, ECHR 2005-IX (in relation to copyright). According to the court, not only trademarks but also an application for a trademark is a possession because Anheuser-Busch owned a set of rights recognized under Portuguese law that could only be revoked under certain conditions (para. 78).

27. An earlier proof of these inbuilt limits is found in the Copyright and Patent Clause of the US Constitution. See above fn. 14.

28. As the wording (‘may’) suggests, though, it is not an obligation on Members.

29. See S. Edwardson, ‘Reconciling TRIPS and the Right to Food’, in *Human Rights and International Trade*, T. Cottier, J. Pauwelyn & E. Bürgi Bonanomi (eds) (Oxford: Oxford University Press, 2005), 383–390, at 386, 390.

30. Haugen, above fn. 1, at least between TRIPS and ICESCR as regards patents.

IV.A LISTING THE 'CONFLICTS'

Copyright, patents and trademarks may 'conflict' with the following human rights: right to freedom of expression,³¹ which contains the public's right to information (Articles 19 UDHR, 19(2) ICESCR, 10 ECHR), right to education (Articles 26 UDHR, 13 ICESCR, 2, First Additional Protocol to the ECHR), right to privacy (Article 8 ECHR), right to health (Articles 25(1) UDHR, 12 ICESCR), right to food (Articles 25 UDHR and 11 ICESCR), right to life (Article 2 ECHR), right to liberty and security (Article 5 ECHR), right not to be discriminated against (Articles 14 ECHR and 1 of the 12th Additional Protocol to the ECHR), right to share in scientific advancement and its benefits (Article 15 ICESCR) and right to development (Articles 11 ICESCR or 1 of the Declaration on the Right to Development (1986)).³² Not every IPR 'conflicts' with every human right. The following 'conflicts' can be identified:

- Copyright and related rights (including rights over data (in Europe, the *sui generis* right)) versus right to freedom of speech, right to privacy, right to health, right to education;
- Patents and related rights (including the plant breeder's right) versus right to life, right to liberty and security,³³ right to share in scientific advancement and its benefits, right to health, right to food, right to development; and
- Trademarks versus right to freedom of speech, right to privacy, right not to be discriminated against.

IV.B LEGAL ANALYSIS OF THE 'CONFLICTS'

The aim here is not to make detailed developments on each of the potential conflictual areas. One or if not more articles would be needed to address each 'conflict'. This book's contributions do this in many ways. The aim is to show through analysis of the legal provisions that in the vast majority of the cases, there are no conflicts and when they are, they are the result of unbalanced IPR legislation, often itself an unfortunate consequence of heavy lobbying on the part of IPR holders. In that case, it is submitted that courts must interpret IPR restrictively to restore their intrinsic balance and in any case, they need to do so, in order for their respective countries to fulfil their international or even national obligations concerning human rights.

31. The terms 'freedom of speech' and 'freedom of expression' will be used interchangeably.

32. See below, s. IV.D.1.

33. As identified by Ricketson, above fn. 22, at 208 but not further explained (simply mentioning possible patents on gene sequences and other life forms).

IV.B.1 Copyright and Related Rights

IV.B.1.a Copyright and the Right to Freedom of Expression

The first most obvious area of conflict on which a vast literature already exists is the so-called ‘conflict’ between copyright and related rights and freedom of expression.³⁴ Because of the inbuilt limits of the idea/expression dichotomy, originality requirement, exceptions and term,³⁵ there is enough room for individuals to express themselves freely by taking the ideas or non-original expressions or even the protected expressions of one’s work (by exercising an exception or if the work has fallen in the public domain). There cannot therefore be conflicts between copyright and freedom of expression.³⁶ It comes as no surprise that the European Court of Human Rights (ECHR) has never heard a case on the matter. The US Supreme Court has most exactly and recently again confirmed this absence of conflict and the intuitive and historical point made earlier (see section II). In *Eldred v. Ashcroft*,³⁷ the Court held that ‘[t]he Copyright Clause and First Amendment were adopted close in time’. This proximity indicates that, in the Framers’ view, copyright’s limited monopolies are compatible with free speech principles. Indeed, copyright’s purpose is to promote the creation and publication of free expression. As Harper & Row observed: ‘[T]he Framers intended copyright itself to be the engine of free expression. By establishing a marketable right to the use of one’s expression, copyright supplies the economic incentive to create and disseminate ideas.’³⁸ The court then listed the idea/expression dichotomy, the fair use privilege, other exceptions to rights and the term to show that the copyright act respects free speech.

However, because of the nature of some works, which need to be communicated in their entirety for the user to achieve the purpose behind an exception to copyright (for example, reporting current events), there can be a ‘real conflict’ between freedom of expression and copyright. To take but a few important cases,

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34. See e.g., *Copyright and Freedom of Speech*, Proceedings of the ALAI Congress, Barcelona, 19–20 June 2006, not yet published; J. Griffiths & U. Suthersanen (eds) *Copyright and Free Speech, Comparative and International Analyses*, (Oxford: Oxford University Press, 2005); *Copyright and Human Rights: Freedom of Expression – Intellectual Property – Privacy*, above fn. 13; C. Geiger, *Droit d’auteur et droit du public à l’information, Approche de droit comparé* (Paris: Litec, 2004); P.B. Hugenholtz, ‘Copyright and Freedom of Expression in Europe’, in *Expanding the Boundaries of Intellectual Property*, eds R. Dreyfuss, D. Zimmerman & H. First (Oxford: Oxford University Press, 2001), 346.
 35. See the international instruments on these limits, the idea/expression dichotomy (Art. 9(2) TRIPS), originality requirement (e.g., Art. 2(5), 14bis(1) Berne Convention), exceptions (Arts 9, 10, 10bis Berne Convention and 13 TRIPS), term (Art. 7 Berne Convention) and corresponding national and regional instruments.
 36. Most adamantly stated by A. Strowel & F. Tulken, ‘Freedom of Expression and Copyright under Civil Law: of Balance, Adaptation, and Access’ in *Copyright and Free Speech, Comparative and International Analyses*, above fn. 34, 287.
 37. 537 US 186 (2003).
 38. *Ibid.*, at 219, citing *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 US 539, at 558.

which dealt with the reproduction of ‘visual’ works (painting³⁹ and film footage)⁴⁰ in their entirety, courts have preferred copyright over freedom of speech, although it was not mandated by Article 10(2) of the ECHR. The Court of Appeal of England and Wales ruled, like the US Supreme Court, that it will be rare when freedom of speech will be needed as an external safeguard, but nevertheless left the door open and accepted that there may be some cases where it will need to apply.⁴¹ A prime example is that of *Hyde Park Residence v. Yelland*,⁴² where a photograph or film is necessary rather than its description in words for example, to report current events.⁴³

Another ‘real conflict’ may occur between free speech and the European *sui generis* right for databases or ‘database right’.⁴⁴ As a result of heavy lobbying by database producers, many aspects of the right are unbalanced and freedom of speech and the public’s right to information relatively restricted. A demonstration has been made and remedies proposed, elsewhere.⁴⁵ Some have even argued that the database right should not be a human right because of its intrinsically economic character, and therefore other human rights should take precedence over database producers’ claims in case of a clash.⁴⁶ Concurrently, the same imbalance occurred in 2001 in the Copyright Directive with some of the exceptions and with the imperfect mechanism allowing users to benefit from them when a work is

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39. District Court, 3rd ch., 23 February 1999 [2000] 184 RIDA 384, overruled by Court of Appeals, 4th ch. A, 30 May 2001 [2002] 191 RIDA 294, confirmed by Supreme Court, 1st civil ch., 13 November 2003 [2004] 35 IIC 716 (*Utrillo*). A television channel had briefly shown a few of Utrillo’s paintings to inform the public about a new exhibit.
40. *Hyde Park Residence v. Yelland* [2001] Ch 143 (CA).
41. *Ashdown v. Telegraph Group Ltd* [2001] EWCA Civ 1142; [2001] 3 WLR 1368.
42. Above, fn. 40. In that case, the Court of Appeal could have decided differently and allow the reproduction but the outcome of this particular decision can perhaps be understood because the circumstances of the publication (through theft of the film) weighed too much against the defendant.
43. T. Pinto, ‘The Influence of The European Convention on Human Rights on Intellectual Property Rights’ [2002] EIPR 209, at 218.
44. Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases, OJ L77/20, 27 March 1996.
45. E. Derclaye, ‘Database *sui generis* Right: The Need to Take the Public’s Right to Information and Freedom of Expression into Account’, in *New Directions in Copyright Law*, vol. 5, ed. F. Macmillan (Cheltenham: Edward Elgar, 2007), 3–23; Derclaye, above fn. 11.
46. Indeed, no moral rights attach to a database protected solely by the *sui generis* right. Ricketson, above fn. 22, 201. However, *sui generis* right databases were protected by copyright in the United Kingdom before the Database Directive came into force because of the lower criterion of originality. As copyright protected those databases, it was not an issue whether database producers could not benefit from their human right in their creations. Arguably, the sole protection of material interests should not prevent the classification of a right into a human right. In addition, when a legal entity obtains the IPR, this should not prevent the classification as a human right. A legal entity will always derive its IPR from the actual human beings who created or invented the work or invention. Comp. Ricketson, above fn. 22, 207–208, speaking of patents and P. Yu above fn. 2, 1129 (corporate entities could make the claim that because their intellectual property rights derive from human beings, the damage done to their rights would jeopardize opportunities that the human beings receive through them for their creations).

technologically protected (Article 6(4) of the said Directive). For discussions and remedies, the reader is referred to the abundant literature, although not much has been said yet in detail on the interface between technological protection measures (TPMs), anti-circumvention provisions and freedom of speech.⁴⁷

Another area of ‘conflict’ between copyright and freedom of speech may be the non-protection by some copyright laws of immoral works (e.g., pornographic, fascist, racist, sexist).⁴⁸ However, again this is only an apparent conflict because the absence of copyright protection does not prevent the person from creating such works in the first place. The only consequence is the absence of a right to prevent their reproduction.

IV.B.1.b *Copyright and the Right to Privacy*

An apparent conflict exists between the right of the photographer or film maker on their work and the right to privacy of the person photographed or filmed.⁴⁹ This conflict does not exist because it is specifically acknowledged in Article 8(2) ECHR. It can also be said that under Article 1 of the First Additional Protocol, state may ‘expropriate’⁵⁰ copyright holders in the general interest, here being the interest of individuals having their right to privacy respected.⁵¹ Additionally, it can

47. For bibliographies, see S. Dusollier, *Droit d’auteur et protection des oeuvres dans l’univers numérique, Droits et exceptions à la lumière des dispositifs de verrouillage des œuvres* (Bruxelles: Larcier, 2005) and Derclaye, above fn. 11. See, however, ALAI Annual Congress 2006, above fn. 34.

48. This stems from Art. 17 of the Berne Convention, which allows Members to deny copyright protection to works on reason of public policy or morality. It provides: ‘[T]he provisions of this Convention cannot in any way affect the right of the Government of each country of the Union to permit, to control or to prohibit, by legislation or regulation, the circulation, presentation, or exhibition of any work or production in regard to which the competent authority may find it necessary to exercise that right’. See S. Ricketson, *The Berne Convention for the Protection of Literary and Artistic Works* (London: Kluwer & QMW, 1987), para. 9.72; S. Ricketson & J. Ginsburg, *International Copyright and Neighbouring Rights, The Berne Convention and Beyond*, 2nd ed. (Oxford: Oxford University Press, 2006), vol. 1, 841, n. 13.88.

49. L. Gimeno, ‘Case Comment, Spain: Copyright and Privacy, *B v. AM*’ [1996] *European Intellectual Property Review* D360-361 (photograph); D. Van Engelen, ‘Case Comment, Netherlands: Copyright – Freedom of Speech versus Invasion of Privacy, *M v. Bios Amsterdam BV*’ [1997] *Entertainment Law Review* E91-92 (photograph); W. Roos, ‘Case Comment, Netherlands: Copyright: Right to Privacy and Portrait Right, *Van Hesteren v. Ordelmans*’ [1998] *Entertainment Law Review* N146-147 (film). All these courts converge in holding that if the copyright owner publishes the photograph or communicates the film to the public without the consent of the person photographed or filmed, this person’s right to privacy is breached. Note that this arguably applies to all works (a French case has recognized it in the case of literary works as well; see E. Dreyer, ‘Case Comment, France: Copyright – Moral Rights versus Invasion of Privacy, *Perbet v. Bauzon*’ [1997] *Entertainment Law Review* E83-84 (autobiography)).

50. It may not go as far as expropriation as the copyright holder retains the right to keep a copy of their work, but it may amount to interference with the peaceful enjoyment of possessions as they cannot exploit their work.

51. The margin of appreciation of states is wide. See *James v. United Kingdom*, Judgment of 21 February 1986, Series A, No. 98, [1986] 8 EHRR 123, para. 46. C. Ovey & R. White, *Jacobs*

be said that even if such conflict may be said to exist, it is minimal because the artist's freedom to create is not endangered. He or she can find other subjects for his or her work. For instance, section 85(1) of the UK Copyright Act makes it clear that the person who commissions the taking of a photograph or film for private or domestic purposes has the right not to have the latter reproduced or shown publicly.⁵² A few exceptions to this right are provided in section 85(2), which correspond to some exceptions to copyright infringement (for instance if the work is incidentally included in another work). They restore the prevalence of freedom of speech (through the use of private images in a subsequent copyright work) when the breach on the right to privacy can be deemed minimal.

Sometimes, when copyright and private interests go hand in hand, they can however be said to 'conflict' with freedom of speech and that brings us back to the discussion above (section IV.B.1.a). It is neither against the right to privacy nor the right to property, as freedom of speech (Article 10.1 ECHR) and/or the public interest (Article 1.2 First Additional Protocol) may prevail. Some national copyright laws even have an implicit inherent limit which allows such disclosure (for example, the public interest defense in, section 171 of the UK Copyright Act). Again, there is only an apparent conflict between copyright and the right to privacy.

A 'new' type of 'conflict' has emerged recently, that between the use by copyright holders of technical protection measures (TPMs) to control access and use of their work and the right of users to their privacy.⁵³ Some TPMs can indeed monitor what people privately read, listen to or view. Arguably, however, this has always been the case as rental shops and libraries also record what work has been rented or lent. However, it has never been an issue in the analogue world. The digital world has not changed this state of fact that much, at least at first sight.⁵⁴ But even if it did, this would be an apparent conflict again because of the limits in Articles 8, 10 ECHR and 1 First Additional Protocol.

and White, The European Convention on Human Rights, 4th ed. (Oxford: Oxford University Press, 2006), 362, note that 'it is difficult to find a case in which the Court has not recognised the policy preferences of a State as providing legitimate goal'. But there must be a proportionality between the means employed and the aim sought to be realized. See *James v. United Kingdom*, above, para. 50.

52. H. MacQueen, 'My Tongue Is Mine Ain': Copyright, the Spoken Word and Privacy' [2005] 68 *Modern Law Review* 349, at 355. See also other national laws, such as s. 35(5) of Australia's Federal Copyright Act 1968, as amended and s. 45c of Norway's Intellectual Property Act 1961 (*lov om opphavsrett til åndsverk m.v.* 12 May 1961 nr. 2, as amended) cited by L. Bygrave 'The Technologisation of Copyright: Implications for Privacy and Related Interests' [2002] *European Intellectual Property Review* 51 at fn 5.
53. For details, see Working Document on Data Protection Issues related to Intellectual Property Rights, 18 January 2005, document xxx/05/EN, WP 104, issued by the Art. 29 Data Protection Working party instituted by Directive 95/46/EC of the European Parliament and the Council of 24 October 1995, OJ L281/31, 23 November 1995.
54. It has been argued that such use can also endanger free speech as people may be less inclined to express non-conformist opinions because they are aware their use is being monitored by copyright holders. Bygrave, above fn. 52, at 53.

IV.B.1.c *Copyright and the Right to Health*

It is not copyright but the database right that may once more impact on the right to health. Because the *sui generis* right's internal limits are too narrow, the right to health may be often impeded,⁵⁵ leading to a real conflict.

IV.B.1.d *Copyright and the Right to Education*

There is no conflict between copyright and the right to education, at least as provided in Article 2 of the First Additional Protocol to the ECHR.⁵⁶ Firstly, the right to education arguably does not extend to include an obligation on states to provide for any type of education at their own expense.⁵⁷ It is a right to access educational institutions and to obtain official recognition for the studies pursued.⁵⁸ However, the right to education seems 'to require States to maintain certain standards in education',⁵⁹ and might be extended in the future.⁶⁰ Article 13 ICESCR has been interpreted to require specific obligations from states. It includes availability, which means that teaching materials must be available. It also includes economic accessibility, i.e., education must be affordable to all.⁶¹ However, there is no conflict between copyright and the right to education again because of copyright's intrinsic limits. The idea/expression dichotomy, the term and the exception for research and teaching⁶² allows states to respect the right to education. A problem may only occur if the teaching exception does not exist in the state in question (and it may happen as the Copyright Directive's exception is not mandatory) and no other available source exists (the copyright gives the author a monopoly). Whilst this will be rare, it cannot be completely ruled out. In this case, there may be a real conflict and courts can use the right to education and/or competition law to force the right holder to license its copyright material. Finally, the database *sui generis* right arguably also clashes with the right to education, as its limits are not broad enough to accommodate the right (the exception for teaching purposes is optional and too restrictive).⁶³

55. Ricketson, above fn. 22, at 201–202.

56. It provides: 'No person shall be denied the right to education. In the exercise of any functions which it assumes in relation to education and to teaching, the State shall respect the right of parents to ensure such education and teaching in conformity with their own religions and philosophical convictions.'

57. Ovey & White, above fn. 51, at 378.

58. *Belgian linguistic Case No. 2*, Judgment of 23 July 1968, Series A, No. 6 [1979–1980] 1 EHRR 252, para. 4.

59. Ovey & White, above fn. 51, at 380–381.

60. Ovey & White, above fn. 51, at 387.

61. See General Comment No. 13, *The Right to Education*, 8 December 1999, Committee on Economic, Social and Cultural Rights, UN Doc. E/C.12/1999/10.

62. See Art. 5(3)(a) of the Copyright Directive (Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society, OJ L167/10, 22 June 2001).

63. For a discussion, see Derclaye, above fn. 11. Art. 9 of the Database Directive reads 'Member States may stipulate that lawful users of a database which is made available to the public in

IV.B.2 Patents and Related Rights

IV.B.2.a Patents and the Right to Health

Are patents and the right to health really in conflict? First, the content of the right to health should be elucidated. The content of patent rights is assumed. The right to health stems from Article 25 UDHR which provides that '[e]veryone has the right to a standard of living adequate for the health and well-being of himself and his family, including food, clothing, housing and medical care and necessary social services'. The right is further elaborated in Article 12(1) ICESCR, which provides for the 'right of everyone to the enjoyment of the highest attainable standard of physical and mental health'. The basic elements of the right are availability, accessibility, acceptability and quality.⁶⁴ This notion of highest attainable standard presupposes that the right is only progressively realized.⁶⁵ 'The right also entails a duty to undertake measures to promote public health, prevent disease, and to eliminate other external causes of morbidity and mortality, reduce health inequalities and improve the underlying conditions of health.'⁶⁶ Thus violations of the right to health will include repeal of legislation or failure to adopt legislation that enables human beings to enjoy the right, or adoption of legislation which is manifestly incompatible with the right.⁶⁷

The argument for the conflict is that patent protection limits the enjoyment of the right to health because of the high cost of patented medicines.⁶⁸ As with copyright, patent laws have intrinsic limits, which normally allow them to respect human rights. They are namely: Excluded subject matter (for example, methods of treatments, discoveries, scientific theories, presentations of information),⁶⁹ protection requirements (novelty, non-obviousness and industrial application),⁷⁰ exceptions (private use, experimental purposes, farmer's privilege)⁷¹ and term.⁷²

whatever manner may, without the authorization of its maker, extract or re-utilize a substantial part of its contents: . . . (b) in the case of extraction for the purposes of illustration for teaching or scientific research, as long as the source is indicated and to the extent justified by the non-commercial purpose to be achieved'. Re-utilization, which is necessary to teach, is not allowed without the permission of the right holder.

64. This comes from the Committee on Economic, Social and Cultural Rights, General Comment No 14: *The right to the highest attainable standard of health* (Art. 12 of the Covenant), Twenty-Second Session, 25 April-12 May 2000, E/C. 12/2000/4. See also Chapman, above fn. 16, at 875.

65. S. Musungu, 'The Right to Health, Intellectual Property and Competition Principles, Commentary on F. Abott', in *Human Rights and International Trade*, above fn. 29, at 301, 302–303. All rights in the ICESCR are to be achieved gradually, although the UN Committee on Economic, Social and Cultural Rights has identified core obligations, 'minimum essential levels which all states must immediately implement'. Helfer, above fn. 19, at 990.

66. Musungu, above fn. 65, at 303.

67. *Ibid.*

68. *Ibid.*, at 307.

69. Arts 27 TRIPS and 52 of the European Patent Convention (EPC).

70. Arts 27 TRIPS and 52, 54, 56 and 57 EPC.

71. Arts 30 TRIPS 48 et seq. and 60 UK Patent Act.

72. Arts 33 TRIPS and 63 EPC.

There are two counter-arguments to the assertion that there is a conflict between patents and the right to health. First, at the philosophical or justification level, the nature of the necessary incentive for development and progress demands some exclusivity. Otherwise, inventors would not innovate. In relation to the right to health, pharmaceutical companies would not develop new drugs. As patents may grant a monopoly over a specific drug for a while, the price will generally be high, as a result of this monopoly. But even if the price may be high for a period of time (short-term), it does go down eventually with the expiry of the patent or sometimes even earlier if ‘similar’ inventions are invented ‘around’ the patent (lower prices in the long-term). This is the price to pay for innovation. If patent laws did not exist, prices would be cheaper but there would be fewer drugs as there would be less or no development of new drugs.⁷³ Patents are therefore a necessary restriction on competition to enhance competition.⁷⁴ This proves that if patents and the right to health do not cooperate, at least they coincide. Patents in the long run help improve the standard of health. In addition, as some have rightly stated, the price of drugs is not exclusively owed to patent protection but may also be dictated by unrelated factors ‘such as the level of import duties, taxes, and local market approval costs’.⁷⁵ There is another reason why there is no conflict between patents and the right to health. Because the research and development (R&D) that lead to patents will only be undertaken privately if the patent holder can recoup its investment, such private research will not be undertaken for some types of rare diseases or diseases that occur in countries where the population cannot afford treatment.⁷⁶ Thus ‘IPR are a necessary, but not the only, tool to serve the objective of public health’.⁷⁷ Political decisions have to be made to collect money to develop cures for rare diseases, so that the state or more generally public bodies (for example, research centres, universities) effectively conduct research on such diseases.

However, if a patent law is over-protective (and some may be if they do not provide compulsory licenses in certain cases), then courts may use the right to health and/or competition rules to solve the conflict.⁷⁸

73. Cornides, above fn. 1, at 159 (‘Even if there were benefits in the short term (e.g., the price for new medicines would fall sharply, there would be less innovation in the medium or long term; hardly any new treatment would be developed by privately owned companies, and the development of new treatments would then depend upon public funding’). See also in the same vein, H. Haugen, above fn. 1, at 100.

74. See M. Lehmann, ‘The Theory of Property Rights and the Protection of Intellectual and Industrial Property’ [1985] *International Review of Intellectual Property & Competition Law* 525 and *ibid.*, ‘Property and Intellectual Property – Property Rights as Restrictions on Competition in Furtherance of Competition’ [1989] *International Review of Intellectual Property & Competition Law* 1.

75. Helfer, above fn. 19, at 1019, citing The High Commissioner, Report of the High Commissioner on the Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights, 10–15, 27–58, UN Doc. E/CN.4/Sub.2/2001/13 (27 June 2001), 43.

76. There is an exception for charities. But their work depends on private funding and the voluntary nature of the donations does not solve the problem of every disease on earth.

77. Cornides, above fn. 1, at 164.

78. Art. 8(2) TRIPS already provides the possibility for Members to use competition law to prohibit abuses of IPR.

IV.B.2.b Patents and the Right to Life

Some have noted that patent laws may be found to conflict with the right to life (Article 2 ECHR) when ‘licenses are not granted on reasonable terms for life-saving drugs’.⁷⁹ It may be added that patents may also conflict with the right not to be subject to torture or to inhuman or degrading treatment (Article 3 ECHR). However, this conflict has not been further discussed in the literature. The right to life imposes a duty on the state to take steps to avoid the loss of life.⁸⁰ But does the high cost of a drug and the consequence of its unavailability to certain persons for that reason amount to unlawful killing by the patentee or the state? There has not been any case on this issue and it may be argued that courts might not go as far. Certainly, even if the price remains high as a result of a compulsory licence, there is arguably no conflict.

IV.B.2.c Patents and the Right to Food

Similarly to the right to health, there is only an apparent conflict between patents and the right to food. The latter is set forth in Articles 25 UDHR and 11 ICESCR. Its content is similar to the right to health. The food must be available and accessible.⁸¹ This means that first, states must not enact rules prohibiting the supply of food to people who would otherwise not have access to adequate food. Second, they are obliged to protect individuals from violation of the right by third parties. Third, they must facilitate opportunities by which the right can be enjoyed. Fourth, the right is progressive. States must not delay the realization of the right.⁸² In order to facilitate the cultivation of crops, ‘farmers must be able to save, exchange and replant seeds’.⁸³ Thus a law preventing this would encroach on the right to food.

First, as stated in section IV.B.2.a above, patent legislation’s goal is to promote scientific progress and development. Thus it can be said that patents are partly responsible for the growth in productivity in agriculture because this growth is mainly due to new plant varieties and agricultural techniques. Without IPR, many of these innovations might not have happened.⁸⁴ Thus, it is submitted that the two rights cooperate or if not, at least coincide. In any case, there is no conflict as the natural limits of patent law prevent such conflict from occurring (see above section 3.2.2.1.). Specifically in relation to the right to food, the farmer’s privilege in respect of the right given to the breeder of new plant varieties (that exists in most nations’ laws as allowed by Article 27(2) TRIPS and mandated by the

79. Pinto, above fn. 43, at 219.

80. Ovey & White, above fn. 51, at 56.

81. See General Comment No. 12 of the Committee on Economic, Social and Cultural Rights discussed by C. Breining-Kaufmann, ‘The Right to Food and Trade in Agriculture’, in *Human Rights and International Trade*, above fn. 29, at 341, 362–365.

82. *Ibid.*

83. Edwardson, above fn. 29, at. 383, 387.

84. Cornides, above fn. 1, at 164.

UPOV Convention⁸⁵ which allows farmers to reuse and exchange the seeds albeit not to sell them)⁸⁶ ensures that farmers can replant protected species of seeds without having to purchase new ones.⁸⁷ Therefore, there are no adverse consequences on the right to food. As rightly expressed by S. Edwardson: ‘Plant variety protection can be implemented in a way that *coincides*, rather than conflicts, with a state’s obligation to realize and safeguard the right to food’ (emphasis added).⁸⁸

IV.B.3 Trademarks

IV.B.3.a Trademarks and the Right to Freedom of Expression

As for copyright and patent, because of the internal limits within trademark laws (the distinctiveness requirement, the fact that there is only infringement if an identical or similar sign is used in the course of trade in connection with identical or similar goods) within Article 1(2) of the First Additional Protocol and within freedom of expression (Article 10 ECHR), there is only an apparent conflict between trademarks and freedom of speech.⁸⁹ Similarly, no conflict occurs when a trademark is refused registration for reasons of morality or public policy. Again, this falls squarely within Article 10(2) ECHR.⁹⁰

Trademark owners may also prevail when freedom of speech is abused, through, e.g., the defamatory use of the trademark (that is, when the mark is not used in the course of trade).⁹¹ Such cases do not raise conflicts as defamatory use is

85. Union for the Protection of New Varieties of Plants Convention of 1961, last revised in 1991.

86. Edwardson, above fn. 29, at 388.

87. Cornides, above fn. 1, at 165. Breining-Kaufmann, above fn. 81, at 355 notes that IPR can favour the development of mono-agricultural practices to the detriment of agro-biodiversity. Thus there is a potential problem with the right to food. She then notes that Art. 27(2) of TRIPSTRIPS’ exception for the protection of *ordre public* or morality includes the protection of human, animal or plant life or health. We find it difficult to conceive that IPR may favour mono-agricultural practices as they encourage innovation and consequently, almost by definition, a growing number of new techniques and plant varieties. Only if the patentee has a monopoly could there be a problem in this respect.

88. Edwardson, above fn. 29, at 383.

89. See Ricketson, above fn. 22, at 210 (traditional trademarks raise few human rights concerns). It has also been argued that freedom of speech could be used to counter the fact that there is no principle of international exhaustion in the EEA and therefore be used ‘by a parallel importer in order to prevent a trademark owner objecting to an import from outside the EEA’. See Pinto, above fn. 43, at 218–219 citing K. Garnett, ‘A Classic Clash between Competing Rights – Parallel Imports: Is the Human Rights Convention a Solution’, once available at <www.5newsquare.co.uk/humanrts.htm>. However, because of the state’s margin of appreciation included in Art. 10(2) ECHR, judges would probably find that such a principle does not breach freedom of speech. Pinto, above fn. 43, at 219.

90. For a recent example, see *Basic Trade Mark SA’s Trade Mark Application* [2005] RPC 25 (refusal to register application for the sign JESUS for among others clothing held not to breach Art. 10 ECHR).

91. For examples of national decisions in Europe, see E. Baud, ‘The Damage Done’ [2005] 176 *Trade Mark World* 29; Geiger 2004, above fn. 19. Note that in the UK, actions against

clearly an abuse of freedom of expression falling into Article 10(2) ECHR. In addition, this does not strictly concern trademark law but civil liability in general.⁹²

Real conflicts can, however exist, especially in relation to famous trademarks.⁹³ Member States can provide, and generally have provided,⁹⁴ more protection for famous trademarks – the so-called protection against dilution of the trademark (Article 5.2 of the Trade Mark Directive)⁹⁵ – but also for any trademark (Article 5.5 of the same).⁹⁶ Thus in these cases, competitors and the public may not be able to use the trademark even though the use does not create (a risk of) confusion or deception (when goods are not similar) but only dilution. So far, however, this seems to have happened only when the detriment to the repute consists in disparagement or is very close to defamation. Accordingly, the more negative the association and the stronger the disparagement, the more likely the trademark owners will prevail.⁹⁷ European case law seems to indicate that this occurs when the trademark is depicted together with images clearly associated with death.⁹⁸ This seems to be a logical test based on Article 10(2) ECHR and there is no real conflict. In some cases, courts have even made freedom of expression prevail as the association with death is in fact a characteristic of the trademarked product (cigarettes).⁹⁹ This may be contrasted with the use of images of death and

defamation or malicious falsehood are typically used as complements or alternatives to trademark infringement.

92. Geiger 2004, above fn. 19, at 280.

93. Ricketson, above fn. 22, at 210.

94. See e.g., s. 10(3) of the UK Trade Mark Act 1994.

95. ‘Any Member State may also provide that the proprietor shall be entitled to prevent all third parties not having his consent from using in the course of trade any sign which is identical with, or similar to the trade mark, in relation to goods or services which are not similar to those for which the trade mark is registered, where the latter has a reputation in the Member State and where use of that sign without due cause, takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.’

96. Para. 5 allows states to provide for protection even beyond Art. 5(2) i.e., when the sign is used other than for distinguishing goods or services and the use of the sign without due cause takes unfair advantage of, or is detrimental to, the distinctive character or the repute of the trademark.

97. Baud, above fn. 91, at 33.

98. *Ibid.*, who reviews decisions in France, Germany and the UK.

99. For instance, in Germany, the Federal Supreme Court held that the use of the sign MORDORO in the context of a campaign against smoking was not sufficient to constitute defamation of the trademark MARLBORO (BGA [1984] *GRUR* 684, cited by Baud, above fn. 91. NB: ‘Mord’ means ‘murder’ in German). In a case involving similar facts, the French Supreme Court found that ‘the use of an almost dying camel laying on the ground and smoking a cigarette which projects smoke in the form of a skull head’ was not disparagement (Paris Court of First Instance, 28 March 2003 affirmed by the Court of Appeal on 14 January 2005, [2005] III *PIBD* no. 806, 242, overruled by the Supreme Court, 19 October 2006 [2007] *International Review of Intellectual Property & Competition Law* 357). For a comment, see C. Geiger, ‘Trade Marks and Freedom of Expression – The Proportionality of Criticism’ [2007] *International Review of Intellectual Property & Competition Law* 317. The means used by CNMRT were appropriate because of the campaign’s humorous approach and the public health objective. The case law relating to freedom of expression in the context of journalism applied to trademark law would mean that so long as organizations act in good faith and do not communicate false information, there is no breach of trademark law.

businesses which very rarely cause death.¹⁰⁰ A real conflict could nevertheless occur if imagery milder than death is used. In this case, trademark law would be going too far as it would prevent almost any fair criticism of any (famous or not) mark.

IV.B.3.b Trademarks and the Right to Privacy

Is there a conflict between the right to privacy and trademark law if a person wants to register the name or likeness of someone as a trademark?¹⁰¹ As with copyright (see section IV.B.1.b), this is only an apparent conflict as Article 8(2) and/or 1(2) First Additional Protocol's limits allow an encroachment of the right to privacy on trademark law in this case.

IV.B.3.c Trademarks and the Right to Non-discrimination

A real conflict seems to occur, however, in relation to the prohibition in the UK, which is supported by the UK courts and the ECJ,¹⁰² for famous persons to register their own name as a trademark. This prohibition may be a breach of the celebrity's human right not to be discriminated against (Article 14 ECHR).¹⁰³ Arguably, such famous persons are discriminated on the basis of their personal status (this including social standing). Fiddes does not see any reason why there should be a difference of treatment between famous and ordinary persons.¹⁰⁴ The registry would argue that 'the use of his own name by a famous person would be seen by consumers as a description of the subject matter of the products to which it is applied'.¹⁰⁵ But that is the only reason that seems to be found.

IV.B.4 Designs

As designs cumulate aspects of patents, trademarks and copyright, most of the comments made above would equally apply to design rights. Therefore, only

100. See e.g., Paris Court of First Instance, 9 July 2004 [2004] 795, III *PIBD* 591; [2004] *Communication Commerce Electronique* comm. 110 (*Areva v. Greenpeace*). In this case, Areva, a French nuclear energy company, won against the use of death imagery by Greenpeace. This decision has nevertheless been recently overruled by the Court of Cassation (8 April 2008, available at <http://www.legalis.net>) so that freedom of speech seems to be prevailing even in cases where the trademark owner's business rarely causes death. Note however, that it may depend on the type of defendant who uses the trademark as the court notes specifically that here the defendant acted in conformity with its goals, namely the general interest and public health.

101. As suggested by Pinto, above fn. 43, at 218.

102. A. Fiddes, 'Human Rights and Trade Mark Rights' [2006] 1, 5 *Journal of Intellectual Property Law and Practice*, 349.

103. *Ibid.*, 351.

104. *Ibid.*, at 352.

105. *Ibid.*

apparent conflicts could exist with the right to privacy (if someone wished the register the name or likeness of a person as a design) and the right to freedom of speech (as design right's inbuilt limits prevent the protection of ideas and methods, require novelty and individual character, provide for exceptions and a limited duration).¹⁰⁶ So far designs have not been influenced by the ECHR.¹⁰⁷

IV.B.5 Conclusion

The above analysis has shown that in the vast majority of cases, because of IPR's inherent limits, there are no real but only apparent conflicts between IPR and other human rights. This explains the non-existent or scarce case law by the European Court and Commission on human rights. As for the national European case law, as has been seen, it mainly dealt with apparent conflicts, although some cases involved real conflicts.

The following quote from J. Sachs of the Constitutional Court of South Africa in a case involving the use of a trademark usefully summarizes what I call 'apparent conflicts' between any IPR and another human right:

What is in issue is not the limitation of a right, but the balancing of competing rights. . . . [I]t would appear, once all the relevant facts are established, it should make no difference in principle whether the case is seen as a property rights limitation on free speech, or a free speech limitation on property rights. At the end of the day, this will be an area where nuanced and proportionate balancing in a context-specific and fact-sensitive character will be decisive, and not formal classification based on bright lines.¹⁰⁸

Thus in cases of apparent conflicts, the 'conflict' is normally already resolved internally (within the intellectual property laws).

It is only when the legislature annihilates or severely restricts the natural limits of an IPR that there can be a real conflict (what the literature has called conflict).¹⁰⁹ So, if legislators do not go overboard, judges should not have to revert to the human rights as there should be no conflict. On the other hand, if the intellectual property

106. See EC Directive 98/71/EC of 13 October 1998 on the legal protection of designs, OJ L289/28, 28 October 1998 and EC Regulation 6/2002 of 12 December 2001 on Community designs, OJ L3/1, 05 January 2002.

107. Pinto, above fn. 43, at 219, also noting that '[n]otwithstanding that designs can involve artistic and/or commercial expression, design law will probably always fall within a state's margin of appreciation for restricting that expression'.

108. Per J. Sachs, Constitutional Court of South Africa, 27 May 2005, *Laugh It Off Promotions CC v. South African Breweries Int. (Finance) B.V. t/a Sabmark Int.*, case CCT 42/04 [2005] 36 *International Review of Intellectual Property & Competition Law* 868, para. 83.

109. Ricketson above fn. 22, at 197–198, believes that the conception that IPR's limits are generally well crafted is too 'generalised and idealistic to be a true reflection of current reality' because of the current expanding trends, i.e., mainly globalization of IPR, growing 'proprietaryism' on the part of IPR holders and the linking of IPR with trade law (WTO). This is debatable but my view is that on the contrary, balanced IPR are generally the norm as is reflected in the different national and regional intellectual property laws and international agreements.

law in question is too protective, that is, when the IPR has been subverted or distorted, and its aims diverted so that it grants excessive protection, then judges can use human rights (and/or other laws such as competition law) as an external limit to curtail the overly broad intellectual property right. How must this balance be made? Clearly, when one right is abused to the detriment of the other (for example, when the use of freedom of expression is defamatory or when copyright prevents the communication of an entire work (perhaps only if the work is of such importance for the public to be adequately informed)¹¹⁰ for the purposes of reporting current events), the latter should simply prevail. Otherwise, when the conflict is more subtle, fine-tuning is necessary. It is not my aim to elaborate a test here but some principles should be kept in mind when such test is crafted and applied. As has been rightly put, ‘the best balance is achieved when it is remembered that IPRs were originally created in order to secure societal purposes. . . . [T]he type and level of protection afforded by any IPR regime must, to the greatest possible extent, facilitate scientific progress’.¹¹¹ Also, one has to remember that IPR are exceptions to the principle of freedom to copy and should therefore be interpreted restrictively at least in these types of conflicts.¹¹²

A final point should be made to emphasize the absence of conflict between human rights and IPR and in fact the overall beneficial effect of IPR for society. If the discourse of radical human-rights lawyers was followed, so that intellectual property protection should be abolished or severely diminished, such lawyers would in fact shoot themselves in the foot if not in the heart. Without IPR, or if IPR protection is lessened, other human rights would suffer considerably. The most striking example is possibly the right to health, as, without IPR protection, extremely few if any new drugs would be developed.

V. THE TRUTH REVEALED: IPR AND HUMAN RIGHTS COINCIDE OR EVEN COOPERATE

This section reveals the so far rarely and sometimes not yet analyzed areas where IPR and other human rights in fact work hand in hand. The analysis reveals that there is a coincidence and sometimes even more, a cooperation, between most IPR and most other human rights.

110. For instance, if there is only one person that has photographed or filmed the assassination of a famous person (or their last moments, as in *Hyde Park v. Yelland*). Contrast this with the information of the public about a new exhibit (like in the *Utrillo* case, above fn. 39). In this case, it may be said that showing only parts of the paintings adequately informs the public. Arguably, Art. 5(3)(c) of the Copyright Directive caters for this as it does not restrict the use of the work to a substantial part. Accordingly, a substantial part of the work or the *entire* work can be used for the purposes of reporting current events.

111. Cornides, above fn. 1, at 167.

112. See D. Voorhoof, ‘Freedom of Expression, Parody, Copyright and Trade Marks’, in *ALAI Congress 2001, Adjuncts and Alternatives to Copyright*, eds J. Ginsburg & J. Besek (New York: Kernochan Center for Law, Media and the Arts, 2002), 639.

V.A COPYRIGHT

V.A.1 Copyright and the Right to the Respect of One's Property

At least two areas of cooperation can be identified between copyright law and the right to the respect of one's property (other than the particular copyright itself). Articles 27(2) UDHR and 15(1)(c) ICESCR provide for the protection of material and moral interests of authors. This means that authors must be recognized moral rights in their works. If the state wants to expropriate the owner of a building and destroy it, the owners of the house and of the copyright in the architectural work, if they are not the same person, have the same interest in having the house kept intact. In Europe, whether such destruction is allowed will depend on whether paragraph 2 of Article 1 of the First Additional Protocol to the ECHR applies.¹¹³ Probably, since the state's margin of appreciation is wide, the building would be lawfully destroyed. However, the case law requires that compensation be paid for deprivation of property, which is the case in the above example (destruction).¹¹⁴ As there is no case law on this particular issue, two questions remain unanswered. Does destruction of the building really amount to destruction of the copyright (as the architect can keep his plans and/or make photographs or films of the building before its destruction)? If the answer to this first question is positive, is this double possibility for the architect sufficient compensation?

A second area where copyright, and for that matter most if not all other intellectual property rights, does not conflict but coincides with the right to the respect of one's property is through the principle of exhaustion. Once the person has acquired the tangible medium on which the IPR applies, the owner of the tangible medium can dispose of it (transfer¹¹⁵ or destroy it) as she or he pleases.¹¹⁶ So there is coincidence in the sense that neither the state nor the IPR holder may after the first transfer by the IPR holder, or with his consent, to the first owner of the medium embodying the IPR, interfere with the enjoyment of the product. A related area of coincidence between IPR and the right to the respect of one's property is the right for the acquirer to repair the IP-protected good which is generally included in intellectual property laws.

113. Art. 1 provides: '1. Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law. 2. The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties'.

114. See e.g., *Holy Monasteries v. Greece*, Judgement of 9 December 1994, Series A, No. 301-A [1995] 20 EHRR 1, para. 71.

115. That means to sell, give, privately lend, but not rent or publicly lend the product.

116. 'The right to property does include the right to dispose of one's property.' Ovey & White, above fn. 51, at 347, citing *Marckx v. Belgium*, Judgment of 13 June 1979, Series A, No. 31 [1979–1980] 2 EHRR 330, para. 63.

There are however, two exceptions to these areas of coincidence. There will be a real conflict in certain countries where the moral right of integrity gives to the author a (quasi) absolute right to object to the destruction of its work because in those countries, it is (almost) always seen as an attack on the honour or reputation of the author.¹¹⁷ The specific national law therefore favours copyright over property. The second is the right for the patentee to object to reconstruction of the product beyond repair.¹¹⁸ But this second exception is arguably an apparent conflict.

V.A.2 Copyright and the Right to Privacy

As some have noted, copyright and privacy rights have in fact some common origins, namely the doctrines on personality rights.¹¹⁹ There is no clearer proof that they sometimes coincide. In fact, as has been rightly stated, '[b]oth attempt essentially to control the flow of information so as to safeguard certain values and interests'.¹²⁰ It is no surprise therefore that they in some respects also cooperate. The moral right of divulgation or, if it is not recognized (like in the United Kingdom, for instance) the economic issuing right, implies that the author can choose to keep his writings private if he or she so wishes. In other words, an author has the right to keep his or her creations secret until he or she divulges them for the first time. A recent example is the dispute between HRH the Prince of Wales and a newspaper which reproduced parts of his private journals.¹²¹ In the United Kingdom, copyright can even palliate the absence of a 'proper' right to privacy.¹²² If the spoken words are recorded and are private conversations, and if they attract copyright (if they are sufficiently original), the author can prevent their reproduction and communication to the public on the basis of his or her copyright in his or her literary work even if he or she could not base an action in breach of confidence (that is, if the conditions of this action are not fulfilled, which often happens).¹²³

117. See e.g., France. For case law, see M. Salokannel, A. Strowel & E. Derclaye, *Final Report of the study contract concerning moral rights in the context of the exploitation of works through digital technology*, April 2000, available at <http://ec.europa.eu/internal_market/copyright/docs/studies/etd1999b53000e28_en.pdf>.

118. On this, see E. Derclaye, 'Blocking Repair and Recycle through End User Licence Agreements and Technological Protection Measures', in *Intellectual Property Law: Repairs, Interconnections and Consumer Welfare*, eds A. Kamperman Sanders & C. Heath (Kluwer Law International, forthcoming, 2008). For the United Kingdom, see *Solar Thomson Engineering Co. Ltd v. Barton* [1977] RPC 537; *United Wire v. Screen Repair Services (Scotland) Ltd* [2001] RPC 439.

119. Bygrave, above fn. 52.

120. *Ibid.*, 51.

121. *HRH Prince of Wales v. Associated Newspapers Ltd* [2006] EWCA Civ. 1776.

122. As a result of the Human Rights Act 1998, the UK has implemented the ECHR in its national law but it has not in that implementation recognized a right to privacy. On this issue, see T. Aplin's contribution in this book.

123. MacQueen, above fn. 52, at 355. In another case, breach of confidence helped claimants who could not win under copyright law (*Creation Records Ltd and Others v. News Group Newspapers Ltd* [1997] EMLR 444, a static scene did not fall into any category of copyrightable subject matter).

The United Kingdom could, if it so wished and as the Berne Convention allows it to do so, grant ‘more effective protection to individual privacy’ by ‘remov[ing] the requirement of recording, and adopt the position that all unscripted speech amounting to an original work ha[s] copyright from the moment it was uttered’.¹²⁴

The moral right to retract, in countries where it exists (for example, in France, Germany, Greece), may also be seen as working hand in hand with the right to privacy, as it allows the author to recall a work or copies of a work where it no longer corresponds with his or her beliefs.¹²⁵

Another example is the exception for private use of a copyright work. This prevents copyright holders from entering the users’ private sphere.¹²⁶ ‘At the same time, privacy rights in the form of data protection law help copyright by placing limits on the processing of personal information that might subsequently be exploited in breach of copyright.’¹²⁷

V.A.3 Copyright and the Right to Education

The right to education includes the safeguard of pluralism as ‘the State shall respect the right of parents to ensure such education and teaching in conformity with their own religions and philosophical convictions’.¹²⁸ As has been seen above in sections II and III, copyright also allows this pluralism as it is linked to freedom of expression. If copyright did not exist, authors would only be funded publicly, thereby drastically reducing pluralism (as their works may have to fit in the State’s or private patron’s tastes). This shows one more area of coincidence or cooperation.

V.A.4 Copyright and the Right to Freedom of Thought, Conscience and Religion

A similar area of coincidence or even cooperation is found between copyright and the right to freedom of thought, conscience and religion. As copyright is closely linked with freedom of expression and the latter allows a broad and varied expression of beliefs through writings and other copyright works, the three rights form an inseparable trio.

124. MacQueen, above fn. 52, at 367.

125. On this right see e.g., Salokannel, Strowel & Derclaye, above fn. 117.

126. Bygrave, above fn. 52, at 51.

127. *Ibid.*

128. At least in Europe, see Art. 2 of the First Additional Protocol to the ECHR. See Ovey & White, above fn. 51, at 381.

V.B PATENTS

V.B.1 Patents and the Right to Freedom of Speech

There is coincidence and even cooperation between patent law and the right to freedom of speech.¹²⁹ It is a mandatory requirement for patentees to disclose their invention. This is done through the publication of the patent application by the respective patent office(s). This condition is the price to pay to obtain a patent and the disclosure function of patent law is linked to the utilitarian goal of patent laws. In order to provide an incentive to innovate, a patent may be gained but in order not to hinder further invention, the invention must be disclosed to the public. Freedom of speech and the right of the public to receive information is therefore specifically furthered by patent law.

V.B.2 Patents and the Right to Health

As seen above in section IV.B.2.a, the two rights may be said to coincide.

V.B.3 Patents and the Right to Food

Similarly, as seen above in section IV.B.2.c, the two rights may be said to coincide.

V.C TRADEMARKS

As seen above in section IV.B.3.a, the inherent limits of trademark laws generally preserve freedom of speech. In a similar vein, the Comparative Advertising Directive coincides with the right to freedom of speech.¹³⁰

V.D IPR IN GENERAL

V.D.1 IPR and the Right to Development

The right to development has been recognized in the 1986 Declaration on the Right to Development but it is not binding.¹³¹ As IPR encourage development, they

129. Pinto, above fn. 43, at 219, noted that since commercial information contained in a patent must be disclosed to the world, it is unlikely that freedom of speech will influence patent law.

130. For a recent case applying Art. 10 ECHR to comparative advertising, see *Red Dot Technologies Ltd v. Apollo Fire Detectors Ltd* [2007] EWHC 1166 (Ch).

131. Available at <www.unhchr.ch/html/menu3/b/74.htm>, (last accessed 22 April 2008). Whose Art. 1 provides that '1. The right to development is an inalienable human right by virtue of which every human person and all peoples are entitled to participate in, contribute to, and enjoy economic, social, cultural and political development, in which all human rights and fundamental freedoms can be fully realized. 2. The human right to development also implies

cannot be blamed to be a restriction to development, provided they are adequately crafted. Both too strong and too weak IPR impact negatively on development.¹³² This is yet another area of cooperation.

V.D.2 IPR and the Right to a Safe and Clean Environment

At present, there is no enforceable human right to a safe and clean environment at international or EU level. If there was one however, it could be said that intellectual property coincides or even cooperates with such right. This might be said to be linked to the primary aim of intellectual property, scientific progress and with it, human welfare. First, the principle of exhaustion present in all IPR does not prevent recycling.¹³³ Second, Article 27(2) TRIPS allows states to prevent the patenting of inventions which seriously prejudice the environment and the EPC case law clearly prohibits such patenting (on the basis of the morality clause).¹³⁴

VI. CONCLUSION

This chapter has shown that not only there are no conflicts between IPR and other human rights but they generally coincide or even cooperate. The reason is intellectual property's philosophical underpinnings as reflected in the legislation, which carry with them an intrinsic element of balance in order to achieve social welfare. Not only the intellectual property laws but also the human-rights instruments embody the limits of IPR and other human rights and thus enable courts to achieve the fine balancing when the rights come in apparent conflict. However, an IPR may be overly broad, and in this case, a real conflict may occur with another human right. If the IPR is abused, the other human right should prevail. Otherwise, when the conflict is more subtle, fine-tuning will be necessary. Several principles can be used to resolve such conflicts as stated above in section IV.B.5. But more importantly, this chapter has, hopefully, shown that most IPR work hand in hand with other human rights, as they have the same or similar goals. Thus contrary to what the main trend in the literature and official documents emanating from different treaty bodies would like us to believe, IPR and human rights are not enemies but friends (even brothers, as IPR are themselves human rights). Nonetheless, legislators and courts should exercise vigilance when respectively crafting intellectual property statutes and subsequently judging disputes involving them to ensure that

the full realization of the right of peoples to self-determination, which includes, subject to the relevant provisions of both International Covenants on Human Rights, the exercise of their inalienable right to full sovereignty over all their natural wealth and resources.'

132. Cornides, above fn. 1, at 159.

133. Note that even though there is no 'proper' right to a clean and safe environment, environmental laws exist and thus indirectly ensure that such a right is respected. For a discussion, see Derclaye, above fn. 118.

134. For a discussion, see E. Derclaye, 'Intellectual Property Rights and Global Warming', [2008] *Marquette Intellectual Property Review*, (forthcoming).

IPR's limits are not or have not been erased or lessened to the detriment of other human rights. In this case, proper tests should be devised to rectify the balance. The debate on the interface between human rights and IPR is therefore not completely moot but less acute as it may at first seem.¹³⁵

135. With particular reference to Professor Helfer's three possibilities at the end of his 2007 article (above fn. 19, at 1015–1020), I do not think that human rights will, or indeed can, be used to expand IPR, at least not in Europe, because of the limits that the ECHR already sets. Human rights are currently already used 'to impose external limits on intellectual property'. It is done in the case of 'real conflicts' i.e., 'when intellectual property rights are used excessively and contrary to their functions'. As to the third possibility ('achieving human rights ends through intellectual property means'), as shown in sections II and III, it is what IPR always have tended to achieve right from the start. Therefore, I do not believe 'it is too early to predict which of these three versions of the human rights framework for intellectual property, or others yet to be identified, will emerge as dominant'. The third possibility has always been there and this article has attempted to clarify and enlighten this. The second is happening more and should continue and the first should normally not happen at least in Europe.

Chapter 6

Proportionality and Balancing within the Objectives for Intellectual Property Protection

*Dr Henning Grosse Ruse-Khan**

I. INTRODUCTION

The principle of proportionality is a concept with different connotations; it has distinct functions and is employed in various environments.¹ For example, it can be applied for the protection of human rights and fundamental freedoms to constrain the ways a state can exercise its power over its citizens. In this ‘classic’ case, the interference with a fundamental right affected must be proportional in relation to the legitimate public policy interests realized by the state measure.² It can further serve as a general mechanism for the balance of interests; as a standard for judicial review; a tool to determine the scope of legal norms or as a limit on the power of

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1. For an overview on these distinct contexts of application of proportionality, see M. Andenas, S. Zleptnig, ‘Proportionality and Balancing in WTO Law: A Comparative Perspective’, 20 CRIA (1/2007), at 2–3.
2. This can be further refined by requiring the state to pursue *suitable or appropriate* objectives, which it must implement in a way which *necessary* (that is, is least onerous to the citizen) and further *not disproportionate or excessive* in relation to the citizen’s interests affected.

judges.³ The role as a balancing tool can relate to state versus private interest – but can equally concern the weighting between any other type of (competing) individual or public interests.

It is this search for equilibrium between distinct values and objectives which will be at stake in this chapter: I plan to analyze the role of a proportional *balancing of interests* within intellectual property protection as part of international economic regulation. In this context, my scrutiny concentrates on the Agreement on Trade Related Intellectual Property Rights (TRIPS). This is not only because it has – being a key element of the law of the WTO – an obvious link to the regulation of global trade and to international economic law. TRIPS, more than other international agreements on intellectual property protection, contains several provisions which allow or even call for a balance of interests. Nevertheless, TRIPS tends to be perceived by various (mainly developing) countries, civil society groups and NGOs focussing on non-trade interests such as public health, the environment or human rights as overall biased towards particular trading interests of (industrialized) countries and their industries. This raises the question whether the balancing provisions under TRIPS – in particular in comparison to other regulatory systems of international economic law – are either not effective in itself, are not applied in an effective manner or, of course, whether the perception is incorrect.

The analysis in front of the reader here should be understood as part of broader comparative research on balancing of diverging interests within international economic regulation. In this regard, this chapter marks the starting point with a focus on Article 7 TRIPS as a tool for a (proportional) balancing of interests within International Intellectual Property (IP) Law and its implementation in domestic IP rules. Further research will build on the findings and in a next step look more closely at Article 8 TRIPS: The scope for proportionality under these two key provisions of TRIPS is then juxtaposed against Article XX GATT and Article XIV GATS as the main operative provisions on international regulation on trade in goods and services which allow for weighing trade and non-trade interest.

The current focus on Article 7 in this chapter is motivated by the following considerations: Article 7 – together with Preamble which will equally be analyzed – provides evidence of the objectives of TRIPS. Under the principles of interpretation of public international law relevant for all WTO law, a treaties' objective is, next to the ordinary meaning and its context, a key source for determining the meaning of individual treaty provisions.⁴ Article 7 TRIPS therefore is crucial for interpreting broad and open legal concepts within TRIPS treaty language which are likely to have significant influence for the ability of WTO Member States to balance different interests addressed in or affected by IP protection. In so far, this analysis aims to lay down the basis for interpreting individual provisions containing such concepts such as 'normal exploitation', 'legitimate interests',

3. See M. Andenas, S. Zleptnig, as n. 1 above, at 2–3.

4. Compare Art. 31(1) of the Vienna Convention on the Law of Treaties (VCLT) and the detailed discussion in sec. III.B.4 below.

and (un)reasonableness in Articles 13, 17, 26(2) and 30 TRIPS or ‘necessity’ and ‘*ordre public*’ in Article 27(3) TRIPS.

As the next future step, a comparative analysis of Article 8 TRIPS is warranted: Entitled ‘Principles’, Article 8 TRIPS is the only horizontal provision within TRIPS which addresses public interests affected by IP protection and their relation to interests and rights protected under individual TRIPS rules. Especially the negotiation history⁵ of Article 8 and to a lesser extent its current wording show similarities as well as important differences with Article XX GATT and Article XIV GATS which employ the same function in the other two main areas of global trade rules in the WTO. This calls for an examination of the scope and substance of Article 8 TRIPS and contrasting the results against the regulatory potential for a balance of interests in the area of goods and services. One should then question the justifications for the significant differences in this regard between protecting intellectual property on the one hand and liberalizing trade in goods and services on the other.

Even further research on this topic could then build on the findings relating to Articles 7 and 8 TRIPS in order to determine the need, options and scope for a proportional weighing of different interests under individual provisions within TRIPS. It could initially centre on TRIPS and follow the ‘classic’ division of Intellectual Property protection regimes by looking at evidence for a balance of interests in TRIPS provisions on:

- the scope of protected subject matter and the conditions for protection;
- the exclusive rights (or other form of protection) granted
- exceptions from these exclusive rights; and
- the enforcement of intellectual property rights.

Again, the potential for proportionality under TRIPS rules could be juxtaposed against the principle’s equivalent sphere of operation in the context of trade liberalization for goods and services in the WTO. In the long run, this comparative analysis should be extended to cover other areas of global regulation both in the fields of intellectual property protection as well as market access and substantive standards for goods and services, investment protection and regulation of financial markets. The results of this research could then lead to further insights on how various subfields of economic regulation deal with distinct (and often contravening) societal values and interests.⁶ In this way, it is hoped to provide a contribution towards a better understanding of the role and respective relationship of individual fields of international economic law in their wider context.

5. ICTSD/UNCTAD, Resource Book on TRIPS and Development: An authoritative and practical guide to the TRIPS Agreement (Geneva, 2005), Part 1, Ch. 6 (2.2.2) – available online at <www.iprsonline.org/unctadictsd/ResourceBookIndex.htm>, (last accessed 10 November 2007).

6. For a comparative analysis of the role of proportionality in WTO and EC law, see M. Andenas, S. Zleptnig, as n. 1 above, at 2–3.

II. THE NEED FOR PROPORTIONALITY IN THE CONTEXT OF INTERNATIONAL ECONOMIC REGULATION

In order to point out the need for an effective balancing system, this review of the TRIPS objectives shall first be placed in the relevant global regulatory context: Common denominator in all fields of economic rule-making mentioned in section I. above is their significant potential impact on domestic regulation of (non-trade and non-economic) societal interests for the sake of a harmonized global economy. While this certainly has its advantages for those able to utilize the system for their own benefit⁷ and, at least in the area of classic trade liberalization, allows countries to rely on their ‘comparative advantage’;⁸ by the same token it can be detrimental for interests not sufficiently addressed and recognized within this increasingly comprehensive regulatory regime. This in itself may already provide for sufficient justification to incorporate balancing mechanisms such as proportionality tests in order to ensure a due recognition of these (non-trade or non-economic) interests.⁹

One can further describe this common denominator by the metaphor of extending international rules ‘*behind the border*’¹⁰ of the nation state to affect various societal values, interests and lifestyles well beyond the traditional way of economic regulation: Above all, this term has been used to paraphrase key developments in the transformation of the former GATT system mainly concerned with trade in goods towards the creation of the WTO with its comprehensive body of rules. Instead of increasing market access (for foreign goods) by simply standardizing and reducing the tariffs to be paid at the national border,¹¹ economic regulation in the last decades has moved beyond this and increasingly imposes obligations on national governments to adopt substantive rules in various areas traditionally not affected by international economic rule-making.¹² For example, freer trade in goods has

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7. E.g. by reducing transaction costs in international commerce, providing security and foreseeability on a global level as well as reducing various types of barriers to enter national markets.
 8. A general explanation of the theory of comparative advantage, its origins in Adam Smith’s and David Ricardo’s work, its main argument for specialization and (free) international trade and its current implications can be found in P. Van der Bossche, *The Law and Policy of the World Trade Organization* (Cambridge, 2005) at 19–24; For an Economist’s perspective see S. Brakman, H. Garretsen, C. Van Marrewijk & A. Van Witteloostuijn, *Nations and Firms in the Global Economy* (Cambridge, 2006) at 63–95.
 9. See further hypotheses below at the end of this section.
 10. See generally C. Arup, *The New World Trade Organization Agreements* (Cambridge, 2000), at 5–13; TRIPS itself is often perceived as a prominent illustration of this trend to impose obligations in areas which were traditionally regarded in the purview of domestic regulation – also referred to as ‘positive integration’: see B. Hoekman & M. Kostecki, *The Political Economy of the World Trading System* (Oxford, 2001) at 283 as well as the further discussion on the role of TRIPS in this context below.
 11. As it has been the ‘classic’ way of trade liberalization during the first six Rounds of Negotiations under the GATT 1947 – see a detailed history in A. Loewenfeld, *International Economic Law* (Oxford 2003), at 46–55; Matsushita, Schoenbaum, Mavroidis, *The World Trade Organization* (Oxford 2003), at 4–5; C. Arup, as n. 4 above, at 45.
 12. See Matsushita, Schoenbaum, Mavroidis, as n. 11 above, at 595–596. While the initial rationale (during the Tokyo Round) was to counter the protectionists trade policies adopted by various

been realized by extending regulation and harmonization from reducing tariff barriers to eliminating so called *non-tariff barriers*¹³ and turning attention towards so far untouched areas by considering them as ‘*trade related*’.¹⁴ Under these two concepts basically any field of domestic norm-setting may be subsumed, provided it has a potential impact on trade: It therefore includes not only government procurement and subsidies policies;¹⁵ but also extends to (non-harmonized) domestic technical standards and safety regulations; diverging opinions on what constitutes a threat to plant, animal or human health and national measures adopted in their protection and further environmental, consumer protection as well as labour standards and workers’ rights.¹⁶ The overreaching and dominant notion is to perceive the world from a trade perspective and to aim for regulating all kinds of human activities as soon as they have a significant impact on free trade and economic globalization. As *C Arup* puts it: This tendency is sure to subject many more matters – at the core of economics, politics, cultures and law – to the influence of trade norms and processes.¹⁷ The key areas of trade rules concerning goods and services within the WTO however do provide for some regulatory tools to recognize interests not motivated by trade liberalization.¹⁸ Since there is – from the outset – no directly equivalent rule in TRIPS,¹⁹ giving effect to these interests via an *interpretation* of key provisions may be even more relevant.

The last decades of international intellectual property regulation in general and the TRIPS Agreement in particular are – to a large extent – based on the very same trade-perspective and should be analyzed in this context.²⁰ One can find various examples for this increasing tendency to reach behind the border: To some extent, the continuous move from mere obligations to provide national treatment for foreign right holders towards more and more guaranteed minimum rights can be compared with the trend from reducing tariffs towards the regulation of non-tariff

key trading nations in the 1970s, this was extended to a much broader and deeper agenda for trade liberalization during Uruguay Round of Negotiations covering not only ‘new areas’ such as services, investment and intellectual property but also binding all Members of the newly established World Trade Organization to the so far voluntary codes on non-tariff barriers, subsidies and trade remedies; see A. Loewenfeld, as n. 11 above, at 54–67.

13. See M. Trebilcock & R. Howse, *The Regulation of International Trade* (3rd Edn, London 2005), at 24.
14. Compare C. Arup, as n. 10 above, at 11.
15. M. Trebilcock & R. Howse, as n. 13 above, at 24.
16. Compare on the societal issues Matsushita, Schoenbaum, Mavroidis, as n. 5 above, at 599–607.
17. C. Arup, as n. 10 above, at 5.
18. See Art. XX GATT and Art. XIV GATS in particular.
19. This appears to be so especially in the case of Art. 8 TRIPS as it requires ‘measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development’ to be ‘*consistent with the provisions of this Agreement*’ (emphasis added); on this issue see in particular C. Correa, *Trade Related Aspects of Intellectual Property Rights* (Oxford, 2007), 103–115; ICTSD/UNCTAD, as n. 5 above, at Part 1, Ch. 6 (2.2, 3.2, 4. and 7.).
20. If this is so, it is reasonable to demand also in the area of (*trade-related*) protection of intellectual property for equivalent systems and regulatory tools for weighing distinct or competing interests – see the further discussion below.

barriers.²¹ However, even with an increasing amount of substantive minimum standards – especially in relation to copyright and neighbouring rights under the Berne and Rome Conventions – the international IP regimes did not necessarily have an extensive impact on domestic policies: First of all, countries tended towards a rather lax implementation of the international agreements, whenever domestic interests seemed to be at stake.²² While the key international regimes provided, in theory, for a system of resolving disputes in front of the International Court of Justice (ICJ), this option had never been exercised.²³ Countries with a lax implementation record thus did not have to fear enforcement actions from other contracting states. Secondly, the (more or less unlimited)²⁴ option to foresee exceptions and limitations to the exclusive rights mandated by the international regime allowed to give due regard to various interests on the national implementation level. This however, has changed since the TRIPS Agreement catapulted a provision imposing three conditions on possible exceptions to the reproduction right in copyright law to become the general template for limiting the ability of domestic policy makers to give effect to societal values and interests.²⁵

Furthermore, TRIPS itself can be seen as evidence for the tendency for ‘positive integration’ and reaching ‘behind the border’.²⁶ As its name indicates, it addresses *trade related* aspects of intellectual property rights and thereby transports intellectual property protection into the realms of world trade law where it is now perceived mainly from a trade perspective.²⁷ This perspective on IP regulation

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21. Here the various revisions of the Berne Convention on the Protection of Literary and Artistic Works serve as prominent evidence (on the revisions of the Berne Convention see S. Ricketson & J. Ginsburg, *International Copyright and Neighbouring Rights*, Vol. I (2nd edn, Oxford, 2006), at 84–134. One however must contend that trade liberalization under GATT has – next to reducing tariffs also always consisted of an obligation to provide national treatment as well as most favourite nation treatment, compare Arts I and III GATT 1947.
 22. For tailoring the level of IP protection to serve domestic industry interests see N. Kumar, ‘Intellectual Property Rights, Technology and Economic Development: Experiences of Asian Countries’, Study Paper 1b to the Report of the Commission on Intellectual Property Rights (CIPR), *Integrating Intellectual Property and Development Policy* (London, 2002) – online available at <www.iprcommission.org> (last accessed 24 October 2007).
 23. T. Cottier, ‘The Prospects for Intellectual Property in GATT’, CMLR 1991, at 393.
 24. For the limited harmonization in the area of patent law and the resulting freedom to provide for exceptions in national laws, see Straus, ‘Implications of the TRIPS Agreement in the Field of Patent Law’ in Beier & Schriker, *From GATT to TRIPS – IIC Studies* Vol. 18 (New York, 1996) at 170–175.
 25. On the so called ‘three step test’ with its origins in Art. 9(2) of the Berne Convention and which can be found in Art. 13 TRIPS as well as – in modified forms – in Arts 17, 26(2) and 30 TRIPS see M. Senftleben, ‘Towards a Horizontal Standard for Limiting Intellectual Property Rights?’ IIC (4/2006), at 407–438.
 26. See B. Hoekman & M. Kostecki, as n. 10 above, at 283, further C. Correa, as n. 19 above, at 10: From the former GATT perspective with its focus on trade in (physical) goods, the mere fact that rules on IP protection became part of trade law implicated a significant extension of the scope of trade regulation and its interference with domestic policies.
 27. See also A. Kur, ‘A New Framework for Intellectual Property Rights – Horizontal Issues’, 35 IIC (1/2004) 4–7; C. Arup, as n. 10 above, at 11–13 and especially Ullrich, Technology protection According to TRIPS, in Beier & Schriker, *From GATT to TRIPS – IIC Studies* Vol. 18 (New York, 1996) 357 et seq.

is based on the insight that more and more (high-tech) products and services are traded globally which require significant investment in their initial development, but are easy to copy or imitate. The lack of harmonized and adequate protection for these products or services in export markets prevented right holders to access these markets: The fear of imitation or copying and thus effectively served as barriers to trade.²⁸ This focus on the interests of right holders and their home countries with a comparative advantage in innovation has not always been the prevailing view in trade theory and practice.²⁹ Interestingly, from a traditional ‘GATT perspective’,³⁰ intellectual property rights have rather been viewed as (legitimate) barriers to trade: Due to their territorial nature they allow the title holder to prevent imports of goods containing the protected subject matter (or the provision of services building on it), in this way erect artificial barriers between countries and thereby prevent free trade.³¹

From the perspective of the main proponents of the new intellectual property-trade connection, TRIPS needed to ensure a reliable, globally harmonized, and high standard of protection – preferably for all subject matter where innovation is costly and imitation is cheap and (relatively) easy to perform. In order to achieve this, it had to overcome the perceived ‘shortcomings’ of international intellectual property protection described above. This necessitated a significantly curtailment of the freedom to tailor IP protection – in economic terms – to suit the domestic comparative advantage³² and further to address non-economic domestic interests and societal values without interference from trade rules. It so led to IP regulation under TRIPS reaching well beyond what had been known so far.³³ In summary, the following factors indicate the new ‘behind the border’ effect of TRIPS:³⁴

- a significant strengthening of the substantive protection of intellectual property rights – especially patents and trademarks where previously almost no harmonized level of minimum rights existed on the international level;³⁵

28. Compare Matsushita, Schoenbaum, Mavroidis, as n. 11 above, at 396–397; M. Trebilcock & R. Howse, as n. 13 above, at 397–400.

29. For a compact analysis of global IP protection based on the trade theory of comparative advantage see M. Trebilcock & R. Howse, as n. 13 above, at 400–40: Depending on whether a country has – in any given field – a comparative advantage in innovation or imitation, overall welfare gains will be the highest if the domestic IP policies is tailored to this advantage; see also the discussion on the need for balancing tools to respond to the domestic economic and welfare interests in s. III.B.2 below.

30. Expression of this perception is Art. XX(d) GATT which allows GATT contracting parties to justify inconsistencies with other GATT provisions (and thereby to restrict free trade) if necessary to secure compliance with laws protecting patents, trademarks and copyrights; see also P. Katzenberger & A. Kur, TRIPS and Intellectual Property, in Beier & Schricker, *From GATT to TRIPS – IIC Studies* Vol. 18 (New York, 1996) at 5.

31. Compare C. Correa, as n. 19 above, at 2–3; Ullrich, as n. 27 above, at 376.

32. Compare M. Trebilcock & R. Howse, as n. 13 above, at 400–401 and the brief explanations in n. 29.

33. See J. Watal, *Intellectual Property Rights in the WTO and Developing Countries* (The Hague, 2001) at 1–7; L. Bently & B. Sherman, *Intellectual Property* (2 edn, Oxford, 2004), at 5–8.

34. For another list of issues exemplifying the increase of IP protection and its relevance in today’s economy see D. Vaver, ‘Intellectual property: The State of the Art’, 116 LQR (10/2000), at 624–627.

35. See Arts 10–11, 15–21, 27–34 TRIPS.

- an introduction of new subject matter such as test data and integrated circuits protection;³⁶
- from the perspective of most developing countries, an extension of patents to cover pharmaceutical and agrochemical products and key areas of biotechnology;³⁷
- potentially limiting the ability of national lawmakers to recognize and give effect to (non-trade) interests and societal values by introducing a set of conditions applicable to domestic exceptions to all key intellectual property rights;³⁸
- a list of detailed provisions on the enforcement of intellectual property rights;³⁹ and
- making TRIPS implementation subject to the new WTO dispute settlement mechanism and thereby ensuring not only the means to test the TRIPS compliance of domestic legislation, but also to retaliate by suspending obligations under WTO law in cases of non-compliance.⁴⁰

One can conclude that IP protection under TRIPS provides various examples of international economic regulation extending into areas so far left untouched to the domestic policy maker. This tendency in TRIPS fits well into the overall trend to ‘reach behind the border’ in other areas of WTO law. It is the context against which I plan to assess the options for a balance and proportional weighing of interests within the TRIPS Agreement and compare them with its equivalents under GATT and GATS. In this chapter, my focus will be on Article 7 TRIPS as a main balancing tool available to national policy makers. Further work will then look in more detail at the provisions on the individual intellectual property rights, especially those regulating the use of exceptions. At this point, one might offer two hypotheses which then should be tested against the normative content of the balancing mechanisms in current international economic regulation:

- (1) The increased impact of trade rules on a wide range of domestic policies calls for strong regulatory tools which allow the recognition, and if

36. See Arts 35–38 and Art. 39(3) TRIPS especially the latter protection of test data can have significant implications for the ability to introduce generic versions of (formerly) patented medication and thus has wide-ranging implications for access to drugs.

37. See Arts 27(1) and (3) TRIPS which mandates patent protection for all area of technology, including micro-organisms and microbiological processes.

38. While the exact scope of these limitations certainly depends on the interpretation adopted (*see below*), the ambiguity of the conditions and the resulting insecurity over the legality of domestic exceptions has arguably had a strong deterring effect on countries to enact exceptions in the first place.

39. See Arts 41–61 TRIPS: In order to respond to the perception of ineffective IP protection in a lot of export markets especially in the copyright field – where a lot of developing countries and others where already member of the international convention with the highest level of protection (the revised Berne Convention) – these provisions were setting new standards in effective IP *enforcement* as the level of protection offered by national law was often not enforced in a lot of countries.

40. See Art. 64 TRIPS, Arts XXII, XXIII GATT and the provisions of the WTO Dispute Settlement Understanding (DSU).

necessary, the *giving of preference*, to distinct or competing interests in a transparent and rationale process of balancing. The more intense (reaching ‘behind the border’, impacting on other areas of domestic policies) international regulation becomes; the stronger is the need for including a comprehensive and flexible regime which takes into account all interests affected. Its inclusion in trade law is even more important since the forums in which a trade perspective prevails often have stronger and more effective mechanisms of regulation, monitoring of implementation and for ensuring effective enforcement than forums where competing interests are in focus.⁴¹

- (2) The need for proportionality exists as much in the area of international IP law as it does in other fields of international economic law with a similar potential impact on non-economic or non-trade interests. The mechanisms for balancing should therefore allow an *equivalent level* of recognition and enforcement of these interests.

III. TRIPS OBJECTIVES AS NORMATIVE INPUT FOR THE BALANCING EXERCISE

The TRIPS Agreement includes several provisions which are designed for, or at least allow a balancing of interests. While they seldom refer directly to the principle of proportionality, contain an explicit proportionality test or require measures to be ‘proportional’, a number of norms include broad and undefined legal concepts such as reasonableness, legitimate interests, or necessity.⁴² A key question then is how to conduct a proper balancing exercise under these concepts.

41. On the WTO Dispute Settlement Understanding compare P. Van Der Bossche, as n. 8 above, at 173, 284–289, 299–304; This call should not be understood as positioning in the debate about coherence or fragmentation in public international law (see ‘Fragmentation of International Law: Difficulties Arising From the Diversification and Expansion of International Law’, International Law Commission (U.N. Doc A/CN.4/L.682), 13 April 2006; M. Koskienniemi & P. Leino, ‘Fragmentation of International Law?’ 15 LJIL (2002) 553–579; G Teubner & A. Fischer-Lescano, Regime-Kollisionen: Zur Fragmentierung des Weltrechts (Frankfurt 2006) – an English version is available as ‘Regime Collisions: The Vain Search for Legal Unity in the Fragmentation of Global Law’ at <www.jura.uni-frankfurt.de/ifawz1/teubner/dokumente/regimecollisions.pdf> (visited 12 November 2007). My argument for fair balancing within the systems which have a significant impact on ‘outside’ interests is not an implicit call for addressing all affected societal values from a trade or economic perspective. This may not solve the problem since the forum in which these values then are discussed is set up to deal with the regulation of global trade and (still) mainly occupied by trade experts and economists (instead of doctors, health officials, environmentalists, human rights advocates, unionists and other stake holders). My approach here should rather be seen as a pragmatic response oriented at current political realities in international rule-making. It focuses on how the existing system should be applied or modified to properly balance the interests at stake and to ensure that in the currently dominant trade forums matters are looked at also from a cultural, human rights, bio-diverse, public health, workers, etc perspective.

42. See Arts 3(2), 8(1) and (2), 13, 17, 26(2), 27(2), 30, 31, 34, 39(2), 62, 63 and 73 TRIPS, which rely on such concepts as well as Arts 46 and 47 TRIPS which both explicitly require proportionality.

With Article 3.2 of the WTO Dispute Settlement Understanding (DSU) in mind, such ambiguous terms shall be clarified ‘in accordance with customary rules of interpretation of public international law’. It is established WTO jurisprudence⁴³ that this provision calls in particular for the application of Articles 31 and 32 of the Vienna Convention on the Law of Treaties (VCLT) – even though the VCLT is not treaty law for all WTO Members.⁴⁴ The main rule of treaty interpretation in Article 31(1) VCLT requires an interpreter to analyze the relevant treaty provisions ‘in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in their context and in the light of its object and purpose’.⁴⁵ Thus, next to a determination of their ordinary meaning, a proper context analysis and in particular due regard to the TRIPS objectives will have significant impact on the interpretation of the concepts exemplified above.⁴⁶

For this reason, the focus of this chapter on proportionality and balancing is a scrutiny of the objectives of TRIPS. It begins by looking at the preamble and then moves on to discuss in more detail Article 7 TRIPS. After identifying the two poles in between which IP regulation must be balanced, the chapter attempts to answer the question on the WTO Members’ ability to engage in a domestically tailored balance of interests. It then examines the traditional role of the (TRIPS) objectives in (WTO) treaty interpretation. A central issue here is whether the Doha Declarations have effectively strengthened the role of Article 7 TRIPS in the interpretative process. Before concluding with some general remarks which again refer to the global (economic) context, the main WTO dispute which has examined the role of TRIPS’ objectives is re-evaluated on the basis of the consequences of Doha.

III.A THE PREAMBLE OF TRIPS

Next to Article 7 which is explicitly entitled with the term ‘Objectives’, the preamble of the TRIPS Agreement is generally perceived as an integral part of the

43. *United States – Standards for Reformulated and Conventional Gasoline* (WT/DS2/AB/R), Appellate Body Report (29 April 1996), 3 at 16; *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products* (WT/DS50/AB/R), Appellate Body Report (19 December 1997), para. 46; *United States – Countervailing Duties on Certain Corrosion-Resistant Carbon Steel Flat Products from Germany* (WT/DS213/AB/R) Appellate Body Report (28 November 2002), paras 61–62.

44. Several WTO Members, notably the USA, have not ratified the Vienna Convention.

45. For a detailed analysis on the interpretative role of a treaty’s object and purpose in the context of the WTO see sec. B.4 below.

46. The importance of the objectives of TRIPS for interpreting its provisions has been stressed also by para. 5(a) of the Doha Declaration on the TRIPS Agreement and Public Health (WT/MIN(01)/DEC/2), 20 November 2001. For a more detailed discussion of its role for TRIPS interpretation and balancing of interests, see the analysis of Art. 7 below.

On the importance of the Preamble (in that case the Preamble to the WTO Agreement) for determining the intentions of the WTO Members see *United States – Import Prohibition of Certain Shrimp and Shrimp Products* (WT/DS58/AB/R), Appellate Body Report (12 October 1998), at para. 153. On the role of the context compare *United States – Countervailing Duties on Certain Corrosion-Resistant Carbon Steel Flat Products from Germany*, as n. 43 above, at paras 65, 69 and 104.

agreement which indicates its underlying principles, objectives and purpose.⁴⁷ According to the Article 31(2) VCLT, a preamble also forms part of the context of a treaty. The TRIPS preamble thus can play an interpretive role both as relevant context for other TRIPS provisions as well as an indication of the objective and purpose of TRIPS. In its here relevant parts, the Preamble states:

Members,

Desiring to reduce distortions and impediments to international trade, and taking into account the need to promote *effective and adequate protection* of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade;

Recognizing, to this end, the need for new rules and disciplines concerning:

[. . .]

(b) the provision of *adequate* standards and principles concerning the availability, scope and use of trade-related intellectual property rights;

(c) the provision of *effective and appropriate* means for the enforcement of trade-related intellectual property rights, taking into account differences in national legal systems;

[. . .]

Recognizing the *underlying public policy objectives of national systems for the protection of intellectual property, including developmental and technological objectives*;

Recognizing also the special needs of the least-developed country Members in respect of *maximum flexibility in the domestic implementation* of laws and regulations in order to enable them to create a sound and viable technological base;⁴⁸

At its core, the relevant sections of the preamble refer to the need for adequate and appropriate – but equally effective protection of intellectual property; and ask us to keep in mind the underlying public policy objectives for IP protection. Three related observations can be drawn from this summation that – taken together – reflect a series of individual equilibriums addressed in the various (other) paragraphs of the preamble:⁴⁹ First, the terms ‘adequate’ and ‘appropriate’ imply an assessment on the basis of an individual situation and tailored to the specific circumstances of the case at hand. This has been argued as recognition of the need for policy space in the domestic implementation of IP protection – in accordance with national policy objectives and for the premise that ‘one size does not fit

47. Compare *Canada – Patent Protection of Pharmaceutical Products* (WT/DS114/R), Panel Report (17 March 2000), para. 7.26; D. Gervais, *The TRIPS Agreement – Drafting History and Analysis* (2nd edn, London, 2003), para. 2.08; C. Correa, as n. 19 above, at 1.

48. Preamble of the TRIPS Agreement – certain paragraphs omitted and emphasis added.

49. On the distinct sets of complementary interests to be balanced see D. Gervais, as n. 4 above, at 2.10.

all'.⁵⁰ It further follows from the unequivocal call for maximum flexibility available to least developed WTO Members in the preamble.⁵¹ While not explicitly mandating a balance of interests or proportional treatment, the recognition of policy space certainly *allows* this to take place – in line with the specific economic, technological and developmental needs of the society.

Secondly, the protection of intellectual property shall be *effective*. While this hardly can be said to establish an absolute and uniform or common standard of protection (which then could be enforced globally); it nevertheless emphasizes the need for the domestic protection of IP which is efficient, is successful or has an effect⁵² – both on the substantive-as well as the enforcement level. One could be tempted to view this as a clear statement in favour of strong IP rights which must be made available and enforceable for the right holders of IP protected subject matter. However, the effectiveness, success or efficiency so required is no end in itself but should relate to the underlying policy objectives (of national systems) for the protection of intellectual property.⁵³ Among other provisions,⁵⁴ this follows from the third observation I wish to highlight from the preamble:

Members, Recognizing the *underlying public policy objectives of national systems for the protection of intellectual property, including developmental and technological objectives*

IP protection under TRIPS thus needs to be *effective in achieving its goals* – the *raison d'entré* for its existence.⁵⁵ According to the quotation from the preamble above, these underlying policy objectives in turn can include (but are not limited to) developmental and technological objectives. Again, the reference to national systems indicates flexibility for the domestic legislator to choose and balance the interests which it wishes to pursue via a system for the protection of intellectual

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50. 'Global Economic Prospects and the Developing Countries, 2002', World Bank (Washington DC, 2001), at 129; on the historical evidence for tailoring national IP policy and regulation to the domestic economic, technological and development needs of a country see further Commission on Intellectual Property Rights (CIPR), as n. 22 above, at 18–20; and especially the two related background papers Z. Khan, Study Paper 1a: Intellectual Property and Economic Development: Lessons from American and European History; and N. Kumar, as n. 22 above; For an economic justification on this point see M. Trebilcock & R. Howse, as n. 13 above, at 397–401.
51. See C. Correa (as n. 19 above, at 13) who however stresses several limitations of this maximum flexibility appeal. While this may be true in face of the often extremely burdensome substantive standards in TRIPS, it nevertheless fits within the general idea of policy space in implementing those standards and stresses this to the utmost extent in the case of LDCs.
52. See *Chambers Dictionary* (Edinburgh 1993), 535.
53. See ICTSD/UNCTAD, as n. 5 above, Part 1, sec. 1; C. Correa, as n. 19 above, at 101.
54. These are in particular Art. 7 (Objectives). Its role in the balancing exercise is discussed in detail below in sec. B.
55. For a further discussion of the purpose and objective of TRIPS, see the analysis of Art. 7 below. The need to consider the objective of IP protection follows not only from the term *effective* itself which has no real meaning if not considered in relation to a specific goal or success to achieve. It is also confirmed by Art. 31(1) VCLT as calls for the effectiveness criteria (like any other term or provision of a treaty) to be understood 'in light of its objective and purpose'.

property. Primarily it will be the broad and undefined legal concepts such as reasonableness, legitimate interests, or necessity where such a balancing of interests can be given effect. As indicated above, the rules of treaty interpretation applicable in the WTO allow to refer to the preamble for this purpose under the notion of giving due regard to the treaty's context and, of course, its objectives.⁵⁶

In conclusion, the preamble of TRIPS calls for a regime of IP protection which can be tailored to the domestic needs and gives effect to the underlying policy objectives. It thereby offers several parameters which open gates for a balancing exercise or a proportional recognition of different interests.⁵⁷ Together with the ordinary meaning of a TRIPS provision, these parameters must be taken into account in the interpretative process by virtue of Article 31(1) VCLT.⁵⁸

III.B THE OBJECTIVES UNDER ARTICLE 7 TRIPS

Even more than the preamble, Article 7 TRIPS will be an important source for determining the objectives of the TRIPS Agreement and thereby influencing the understanding of those broad and undefined legal concepts which are the primary tool for a balance of interests. Article 7 states:

Objectives

The protection and enforcement of intellectual property rights should contribute to the *promotion of technological innovation* and to the *transfer and dissemination of technology*, to the *mutual advantage of producers and users* of technological knowledge and in a manner *conducive to social and economic welfare*, and to a *balance of rights and obligations*.⁵⁹

III.B.1 Balance of Interests

The text indicates that Article 7 comprises, next to the overarching goal of facilitating social and economic welfare, three sets of (competing) interests which need to be properly balanced in order to achieve that overarching aim: First and foremost, Article 7 represents a compromise between the objectives to *promote* (new) innovation on the one hand and to *transfer and disseminate* the resulting knowledge and technology on the other.⁶⁰ This is further confirmed by the call for

56. See also ICTSD/UNCTAD, as n. 5 above, Part 1, sec. 1.

57. Compare *D. Gervais*, as n. 47 above, at 2.10.

58. Next to the Preamble of TRIPS, also the preamble to the WTO Agreement expressing the objective to promote sustainable development (in context of expansion of production and use of natural resources) as well as recognition of different levels of development (in relation to actions to protect the environment) may be relevant for proportional recognition of competing interests.

59. Art. 7 of the TRIPS Agreement (emphasis added).

60. See C. Correa, as n. 19 above, at 91–92 who notes that Art. 7 has been written in particular with technology-related IPRs in mind; but argues that since the balance of rights and obligations is an overriding principle in IP law (compare the Preamble of the WIPO Copyright Treaty, WCT) and

mutual supportiveness of IP protection for both producers (which receive an incentive to innovate via IP rights) and users (which (later) should be enabled to access and utilize these innovations). Thirdly, the need to weigh different positions is directly addressed by the phrase that IP rights should contribute to ‘a balance of rights and obligations’. While this is broad enough to accommodate both rights and obligations from the perspective of all potential stakeholders in IP regulation,⁶¹ the balancing will often occur primarily between the two poles of promoting new innovation and transferring as well as disseminating the results to the wider public. One could even attempt to link balancing between these two poles to economic theories on the justification and scope of IP protection: Depending on whether its comparative advantage lies more in innovation or more in imitation, a country is – from the perspective of trade theory – best advised to choose a level of IP protection individually tailored to its strengths in innovation and imitation.⁶² Article 7 arguably supports this by focussing on innovations and producers on the one hand as well as on the transfer and dissemination of these innovations and user on the other.⁶³

In essence, Article 7 therefore encourages WTO Member States to build their IP systems in equilibrium between the two key interests at stake:⁶⁴ Providing an incentive for the creation of new innovations through rewards (usually via negative monopolies ensuring artificial exclusivity and market-lead).⁶⁵ But equally securing the transfer and diffusion of innovations to the public (via disclosure mechanisms, the idea expression dichotomy in copyright, and exceptions to exclusive rights).⁶⁶ The proportional balance of these two interests should be determined in accordance with the overall aim of promoting progress in science, arts and technology and acting ‘conducive to social and economic welfare’ in a society. This reference to (social and economic) welfare in Article 7 again seems to hint to economic theory on the justification for intellectual property rights which puts these welfare concerns at the centre for rationalizing IP protection instead of relying on normative assumptions of natural rights which are argued to be expropriated unless strong protection is available.⁶⁷ Against this clear textual evidence of the purpose and objectives of the TRIPS Agreement statements which assert the ‘main objective of the TRIPS Agreement to strengthen and harmonize intellectual

also in general WTO law (see Art. 3.5 DSU and the Preamble WTO Agreement), Art. 7 is of key relevance for all IP rights.

61. One here can think of, e.g., rights and obligations of IP owners, original creators and inventors, investors, competitors, (commercial) IP users, (private) IP consumers, specific interest groups such as researchers, libraries, new market entrants, state authorities, etc or those related to general societal interests.

62. M. Trebilcock & R. Howse, as n. 13 above, at 400–401.

63. Also arguing for the – albeit limited to Art. 7 and provisions like Arts 30 and 31 TRIPS – incorporation of economic theory in the TRIPS objectives: *Straus*, as n. 24 above, at 170.

64. D. Gervais, as n. 47 above, at 2.76.

65. See for example Arts 11, 14, 16, 6(1) and 28 TRIPS.

66. See for example Arts 29, 9(2), 13, 17, 26(2), 30 and 31 TRIPS.

67. See M. Trebilcock & R. Howse, as n. 13 above, at 398–399.

property protection throughout the world' seem rather to represent certain trading interests than the textual reality embodied in the provisions of TRIPS.⁶⁸

III.B.2 WTO Members Discretion to Exercise Balancing

This balancing exercise must by its nature respond to the individual circumstances at hand and thus include some discretion for Member States as to allow for tailored responses to the developmental, technological and economic needs of a society.⁶⁹ Interpreting TRIPS in light of this may be difficult in cases of clear-cut provisions with a straightforward ordinary meaning.⁷⁰ Against this background it is even more important to allow for a balance of interests whenever the interpretation of broader and vague legal concepts is at stake. A central question here will often be to what extent this weighing process has already been performed by the negotiators while drafting TRIPS provisions or is to be conducted on the implementation level by the individual WTO Member States.⁷¹ While this will depend to some extent on the interpretation of the individual provision at hand, important general observations can be made: Firstly, the language of Article 7 ('The protection and enforcement of intellectual property *should* contribute')⁷² suggests that the desired effects are not achieved automatically and do not follow as such from protecting and enforcing IP rights.⁷³ Neither are these effects necessarily inherent and fully realized in all the individual TRIPS provisions. Had this been the case, Article 7 would be redundant which in turn contradicts a general principle of treaty interpretation according to which words are in a treaty for a meaning and one must give effect to all terms of the treaty.⁷⁴

Instead, national legislators should consider the objectives and interests mentioned in Article 7 and choose a proper balance when implementing TRIPS. Further, the very objective mentioned in Article 7, to advance social and economic welfare, necessitates at least a certain amount of flexibility and policy space to give due regard to the domestic needs of the society. This follows

68. See European Court of Justice, 'Advisory Opinion on TRIPS Jurisdiction', reprinted in 27 IIC (1996), at 503; referred to in *Straus*, as n. 24 above, at 161.

69. Against this background one can hardly argue that 'TRIPS negotiating parties had taken societal interests into consideration when agreeing on the balance of interests which were enshrined in the TRIPS Agreement. Consequently, *individual WTO Members could not now rebalance these interests unilaterally*' (Arguments forwarded by the EC in *Canada – Patent Protection of Pharmaceutical Products*, as n. 47 above, at para. 4.30).

70. For the Panel and Appellate Body jurisprudence on interpreting WTO law, see sec. 4 below.

71. This issue has been discussed in particular in relation to Art. 30 TRIPS: see *Canada – Patent Protection of Pharmaceutical Products*, as n. 5 above, at 7.26 and C. Correa, as n. 19 above, at 101–102. For a more detailed discussion of the *Canada – Patents* report see sec. 6. below.

72. Art. 7 TRIPS, emphasis added.

73. ICTSD/UNCTAD, as n. 5 above, at Part 1 sec. 6.

74. Principle of effectiveness or *effet utile*: see *United States – Standards for Reformulated and Conventional Gasoline*, as n. 43 above, at 21; *Japan – Taxes on Alcoholic Beverages* (WT/DS8/AB/R); Appellate Body report (4 October 1996) at 96(106); and ICTSD/UNCTAD, as n. 5 above, at Part 1 sec. 6.

not only from economic theory on intellectual property protection.⁷⁵ Also historical evidence from the IP policies of industrialized countries in the nineteenth and early twentieth century as well as more recent experience of far-eastern countries such as Korea, India and China clearly indicates that in order to facilitate technological development and economic welfare, IP policies must be tailored to circumstances at hand and respond to domestic problems at stake.⁷⁶ If TRIPS provisions would not allow any significant policy space on the domestic level, the central objective not only of TRIPS but also of the WTO itself⁷⁷ could not be properly implemented.

III.B.3 Legitimate Expectations of Interested Trading Partners in the WTO

A counterargument here might be that allowance for balancing of interests on the domestic level might lead to legal uncertainty and/or frustrate legitimate expectations of private parties or other WTO Members to benefit from a certain standard of IP protection which they might argue was reasonably foreseeable from TRIPS norms. However, this reasoning does not stand up to a detailed scrutiny: For once, legal certainty and foreseeability in trade and commerce is primarily to be dealt with on the municipal level for the benefit of private entities which have a valid interest to know the law in order to adopt (business) strategies and decisions accordingly. Since TRIPS does not grant directly enforceable rights to private entities, they do not have a valid claim in relying on the substance of a particular TRIPS provision.⁷⁸ This was recently confirmed by an Indian High Court in a case involving a Swiss Pharmaceutical Company which tried to challenge a certain provision of the Indian Patent Act as violating TRIPS. The Court upheld the argument that neither could private companies challenge a law as being TRIPS non-compliant nor could an Indian court decide whether the Indian patent law is

75. See the explanations in sec. 2. above as well as M. Trebilcock & R. Howse, as n. 13 above, at 397–401.

76. See M. Trebilcock & R. Howse, as n. 13 above, at 397, 400–401 and *Commission on Intellectual Property Rights (CIPR)*, as n. 22 above, 18–20, and especially the two related background papers by Z. Khan and N. Kumar, both as n. 50 above.

77. See the WTO preamble which states: ‘The Parties to this Agreement, Recognizing that their relations in the field of trade and economic endeavour should be conducted with a view to *raising standards of living*, ensuring full employment and a large and steadily growing volume of real income and effective demand, and expanding the production of and trade in goods and services, while allowing for the optimal use of the world’s resources in accordance with the *objective of sustainable development*, seeking both to protect and preserve the environment and to enhance the means for doing so in a manner *consistent with their respective needs and concerns at different levels of economic development*’ (emphasis added).

78. For International IP law, this follows mainly from the principle of territoriality: The rights available to private entities always flow from the domestic, national IP statutes of the country where IP protection is sought and not from international obligations to provide such rights in the national law (compare Art. 5(2) of the revised Berne Convention on the Protection of Literary and Artistic Works).

TRIPS compliant or not.⁷⁹ In the WTO, the appropriate forum for claims of inconsistencies with TRIPS is the System of Dispute Settlement as mainly regulated in Articles XXII, XXIII GATT and the Dispute Settlement Understanding (DSU).

The more complicated issue is whether WTO Member States may claim that (extensive) balancing of interests in the TRIPS implementation process frustrates its own legitimate expectations for their domestic industries to benefit from a certain standard of IP protection. A country may for example argue that patent protection regulated under Articles 27 and 28 TRIPS obliges other WTO Members to grant certain exclusive rights for pharmaceutical products and thereby includes legitimate expectations that its domestic Pharma Industry will be able to (freely) exploit its patented drugs in markets abroad. It may then consider national measures which rely on a broad reading of the provision on exceptions in Article 30 TRIPS in order to balance the interests of right holders against those of patients for easy and cheap access to essential medicines as frustrating these expectations.

In the WTO law on trade in goods, such types of claims (stemming from the GATT origins of the WTO) are accepted as ‘*non violation complaints*’ and regulated under Articles XXIII:1(b)-(c) GATT 1994: A WTO Member may initiate dispute settlement proceedings if it feels that another Member’s measure nullifies or impairs benefits accruing to it under the GATT – regardless whether the measure violates GATT provisions. The idea behind these non violation complaints under the GATT is to ensure that legitimate market access expectations based on tariff concessions are not upset by (non tariff) measures later introduced by the Contracting Parties.⁸⁰ In the Uruguay Round Negotiations, the extension of this type of complaints to the TRIPS Agreement had been controversial and as a compromise a five-year moratorium had been agreed to in Article 64(2) TRIPS.⁸¹ As the differences over the applicability of non violation complaints in the TRIPS context persist in negotiations of the TRIPS Council, Members have continued to extend the moratorium so that currently these types of complaints cannot be invoked in the TRIPS context.⁸² Against this background, the Appellate Body has explicitly

79. See *Novartis AG vs. Union of India*, Madras High Court Judgment of 6 August 2007 (W.P. Nos 24759 and 24760 of 2006).

80. Compare *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products* as n. 43 above, at para. 41: “‘Non-violation’ complaints are rooted in the GATT’s origins as an agreement intended to protect the reciprocal tariff concessions negotiated among the contracting parties under Article II. In the absence of substantive legal rules in many areas relating to international trade, the “non-violation” provision of Article XXIII:1(b) was aimed at preventing contracting parties from using non-tariff barriers or other policy measures to negate the benefits of negotiated tariff concessions.”

For a comprehensive analysis of the concept of non violation complaints and its applicability in the TRIPS context see UNCTAD/ICTSD, as n. 5 above, at Part Five, Sec. 32 (3.2) and *WTO Secretariat*, Non Violation and Situation Complaints, (IP/C/W/349/Rev. 1), 24 November 2004.

81. Countries disagreed on the overall applicability of non violation complaints and their implications for obligations under TRIPS; see UNCTAD/ICTSD, as n. 5 above, at Part Five, Sec. 32(3.2).

82. see para. 45 of the Hong Kong Ministerial Declaration in the end of 2005: *Ministerial Conference*, Ministerial Declaration on Doha Work Programme, (WT/MIN(05)/DEC), 22

rejected interpreting TRIPS on the basis of a WTO Members' legitimate expectations unless these expectations find a sufficient expression in the text of the TRIPS Agreement.⁸³

A proper and tailored balancing of interests on the level of domestic implementation thus is not in general curtailed by arguments for legal certainty and legitimate expectations. The latter can be invoked only if it is based on interpretation in accordance with the VCLT – in particular the ordinary meaning or the context of a provision. Then however, these arguments must be weighed against the TRIPS objective in favour of a balanced and proportional system of IP protection. One may therefore conclude that the weighting advocated by Article 7 TRIPS is to be conducted by the WTO Members when implementing TRIPS obligations. Of course, the WTO dispute settlement process ensures another Member's right to request an independent review of the compliance of this implementation with the TRIPS obligations – as they are to be understood under accepted principles of interpretation applicable in WTO law. It is the role of the TRIPS objectives within these interpretative principles which I shall turn to now.

III.B.4 The Role of 'Object and Purpose' in WTO Treaty Interpretation

We have seen that the purpose and objective of TRIPS as articulated in the preamble and Article 7 call for a balanced system of intellectual property protection and that in general this weighing of the different interests at stake should be performed at and tailored towards the domestic level, unless the ordinary meaning or context of individual TRIPS provisions do not allow this. The question remains – both on a general, abstract level as well as in relation to individual TRIPS provisions: how much weight, in comparison to the role of 'ordinary meaning' and 'context', should be attached to these objectives in the process of interpretation? In the jurisprudence of WTO treaty interpretation it is well established that

- an answer regarding individual terms of an agreement necessitates, as a '*single combined operation*' a comprehensive analysis of its ordinary meaning and context as well as both the provisions' and the treaties' object and purpose;⁸⁴ and

December 2005: Again the TRIPS Council is requested to continue to examine the matter and make recommendations to the next Ministerial Conference.

83. *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, as n. 43 above, at 45 and 48.
84. See the order of Art. 31(1) VCLT and its application in the jurisprudence of the Appellate Body: *Japan – Taxes on Alcoholic Beverages*, as n. 74 above, 97 (at 105); *European Communities – Measures Concerning Meat and Meat Products (Hormones)* (WT/DS26/AB/R), Appellate Body Report (16 January 1998) at 181; *India – Patent Protection for Pharmaceutical and Agricultural Chemical Products*, as n. 43 above, at 45; *United States – Import Prohibition of Certain Shrimp and Shrimp Products*, as n. 46 above, at 114; *United States – Final Countervailing Duty Determination with respect to certain Softwood Lumber from Canada* (WT/DS257/AB/R), Appellate Body Report (19 January 2004), at 58–59; but note that this is merely

- provisions incorporating broad and open legal concepts (such as reasonableness, necessity, normality and legitimacy in Articles 3, 8, 13, 17, 27, 30 TRIPS) will lend themselves much more for an interpretation which needs to draw from their context, from an evaluation of the specific objective (if any), as well as a determination of its meaning ‘in light of’ the general purpose of TRIPS.⁸⁵

Above this, some general observations can be made on the importance of the objectives as set forth in the Preamble and Article 7 TRIPS which in turn may have a particular impact on the interpretation of the broad concepts mentioned above.⁸⁶ One may begin looking a bit closer at the general approach to interpretation taken by the Appellate Body in WTO dispute settlement: In line with the intention of the drafters of the VCLT⁸⁷ the Appellate Body made clear that

Article 31 of the Vienna Convention provides that the words of the treaty form the foundation of the interpretative process: interpretation must be based above all upon the text of the treaty.⁸⁸

The Appellate Body confirmed this so called ‘textual approach to interpretation’⁸⁹ in various occasions – for example by stressing the ‘fundamental rule of treaty interpretations requires a treaty interpreter to read and interpret the words actually used by the agreement [. . .]’.⁹⁰ On its face, this approach seems to allow little

a logical order of analysis and implies no ranking between the individual elements mentioned in Art. 31(1) VCLT: The International Law Commission (ILC), in its commentary on the said provisions of the VCLT stressed: ‘The article, when read as a whole, cannot properly be regarded as laying down a legal hierarchy of norms for the interpretation of treaties.’ Instead, the drafters of the Vienna Convention called for treaty interpretation as ‘a single combined operation’ See *Yearbook of the International Law Commission*, The International Law Commission’s Commentary on Arts 27 to 29 of its Final Draft Articles on the Law of Treaties, Vol.II (1966), 219–220; further I. Sinclair, *The Vienna Convention on the Law of Treaties* (2nd edn, Manchester, 1984), 117–119.

85. *Canada – Patent Protection of Pharmaceutical Products*, as n. 47 above, at 7.26; Compare also the commentary of the ILC (*Yearbook of the International Law Commission*, as n. 78 above, at 221) citing the Advisory Opinion of the International Court of Justice on the *Competence of the General Assembly for the Admission of a State to the United Nations*: ‘If the relevant words in their natural and ordinary meaning make sense in their context, that is the end of the matter.’
86. As indicated in sec. I., a detailed assessment of key TRIPS provisions embodying such concepts in light of the purposes identified here and in comparison with the scope for balancing in other areas of international economic cannot – for reasons of space and time – be included in this chapter and thus will be subject to further research.
87. As expressed in the ILC Commentary on the respective VCLT provisions where the Commission stresses that ‘starting point of interpretation is the elucidation of the meaning of the text, not an investigation *ab initio* into the intentions of the parties’. – see *Yearbook of the International Law Commission*, as n. 84 above, at 220, 221.
88. *Japan – Taxes on Alcoholic Beverages*, as n. 74 above, 97 (at 105).
89. So described by the ILC (*Yearbook of the International Law Commission*, as n. 78 above, at 220); compare also C. D. Ehlermann, ‘Six Years on the Bench of the “World Trade Court”’ 36 *JWT* (4/2002), 605–639.
90. *European Communities – Measures Concerning Meat and Meat Products (Hormones)*, as n. 84 above, at 181.

room for giving due regard, in the interpretative process, to the purpose and objective of any of the WTO agreements.

However, a closer look may reveal an understanding of this textual approach which is (1) in line with the intended equality amongst the three elements mentioned in Article 31(1) VCLT;⁹¹ and (2) finds support in the case law of the Appellate Body: *R Howse* has pointed out that emphasis on the exact words of a treaty does nothing more than taking those words as the necessary *starting point* for an interpretative exercise that also includes teleological dimensions and merely rejects tendencies to assume objectives without having engaged in careful study of the treaties' text.⁹² This observation corresponds with the Appellate Body's findings in the *US – Shrimp* dispute:

A treaty interpreter must begin with, and focus upon, the text of the particular provision to be interpreted. It is *the words constituting that provision*, read in their context, that the object and purpose of the state parties to the treaty must first be sought. Where the meaning imparted by the text itself is equivocal or inconclusive, or where confirmation of the correctness of the reading of the text itself is desired, light from the *object and purpose of the treaty as a whole* may usefully be sought.⁹³

It follows that the Appellate Body (1) wishes to confirm the logical order of interpretation which should always begin with the text as such and a determination of its ordinary meaning;⁹⁴ (2) above this, views the treaty text as the Archimedean Point for determining a treaties' objectives;⁹⁵ and (3) denounces any attempts to assert (*ab initio*) a treaty purpose not supported by the treaties' text.⁹⁶ This certainly leaves room for teleological considerations – as long as they are text-based. However the Appellate Body seems to suggest that, in the first instance, *the purpose must be sought in the concrete provision at stake*: Only if that text is vague or inconclusive (as to its particular objective), one can move on to consult the objectives of the treaty as a whole.⁹⁷

91. The ILC emphasized that ordinary meaning, context, object and purpose 'are all of obligatory character' and by their very nature not inferior to another, see *Yearbook of the International Law Commission*, as n. 84 above, at 220.

92. See *R. Howse*, *Adjudicative Legitimacy and Treaty Interpretation in International Trade Law*, in *J. Weiler* (Ed), *The WTO, the EC and the NAFTA* (Oxford, 2000).

93. *United States – Import Prohibition of Certain Shrimp and Shrimp Products*, as n. 46 above, at 114 (emphasis added).

94. As already briefly indicated above (see n. 84 and *Yearbook of the International Law Commission*, as n. 84 above, at 220).

95. Thereby countering accusations of 'overreaching' and 'judicial activism' which claim that the Appellate Body has not acted consistent with Art. 3.2 DSU which prohibits the quasi-judicial organs of the WTO to 'add or diminish the rights and obligations provided in the covered agreements'.

96. Compare also A. Qureshi, 'Interpreting World Trade Organization Agreements for the Development Objective', 37 *JWT* (5/2003), at 866.

97. This has been criticized as unduly establishing a hierarchy (similar to the Arts 31–32 VCLT relation) between the objective as following from the treaty provision at stake and the overall

Applying these standards to our scenario, the objectives expressed in the preamble and in particular in Article 7 TRIPS clearly are derived from the text of the Agreement and not speculative. They therefore are text based and can be relied upon in the interpretation of TRIPS. Furthermore, especially the broader and more open concepts in several of the TRIPS provisions – for example ‘normal exploitation’ and ‘unreasonable prejudice (of) the legitimate interests’ in Article 13 TRIPS – could be still be available for an interpretation on the basis of the general objectives in Article 7 TRIPS. Nevertheless, the Appellate Body’s hierarchy of individual-trumping over general objectives may seriously curtail the number of instances in which the balance of interests advocated by Article 7 TRIPS will be able to guide the understanding of individual TRIPS provisions.

While this hierarchy amongst (potentially) different objectives may actually still be in line with the International Law Commissions argument against a legal hierarchy between ordinary meaning, context and purpose in Article 31(1) VCLT, it is inconsistent with the actual wording of that provision: ‘A treaty shall be interpreted in good faith in accordance with the ordinary meaning to be given to the terms of the treaty in *their* context and in the light of *its* object and purpose’⁹⁸ ‘Their’ on the one hand clearly refers to the context of the terms (plural); ‘its’ on the other hand surely refers to the treaty (singular) – and not to the terms of the treaty which are to be interpreted: ‘Ordinary meaning’ and ‘context’ thus relate to the individual terms at stake while ‘object and purpose’ relate to the treaty as a whole.⁹⁹ While this understanding of Article 31(1) VCLT may not necessarily prohibit recognition of an evident purpose of the individual provision interpreted, it nevertheless clearly establishes the overarching importance of the general objectives of the treaty.¹⁰⁰ On this basis, the TRIPS objectives, clearly expressed in the text of Article 7 and the preamble, will preserve their interpretative role on an equal standing next to the ordinary meaning and context of the TRIPS provision at stake.

III.B.5 **The Doha Declarations: Increasing the Relative Importance of TRIPS Objectives?**

The interpretative importance of proportionality and balancing under Article 7 TRIPS may be further amplified by two acts of WTO Members, both adopted by consensus of all WTO Members at the fourth Ministerial Conference in

purpose of the treaty; see D. Shanker, ‘The Vienna Convention on the Law of Treaties, the Dispute Settlement of the WTO and the Doha Declaration on the TRIPS Agreement’, 36 *JWT* (4/2002), at 725–726.

98. Art. 31(1) VCLT – emphasis added.

99. Compare also *Yearbook of the International Law Commission*, as n. 78 above, at 220 and 221, which seems to support this reading as the Commission always relates purpose to the treaty and not to its individual provisions.

100. Therefore, in so far as the jurisprudence of the WTO Appellate Body aims to establish a *general* hierarchy which gives precedence to the purpose of the individual terms at stake, this has to be rejected as inconsistent with the wording of Art. 31(1) VCLT.

Doha (Qatar). First, the Doha Declaration on TRIPS and Public Health, in its relevant parts, states:

4. We agree that the TRIPS Agreement does not and should not prevent Members from taking measures to protect public health. Accordingly, while reiterating our commitment to the TRIPS Agreement, we affirm that the Agreement can and should be *interpreted and implemented* in a manner supportive of WTO Members' right to protect public health and, in particular, to promote access to medicines for all.

In this connection, we reaffirm the right of WTO Members to use, to the full, the provisions in the TRIPS Agreement, which provide flexibility for this purpose.

5. Accordingly and in the light of paragraph 4 above, while maintaining our commitments in the TRIPS Agreement, we recognize that these flexibilities include:

(a) In applying the customary rules of interpretation of public international law, each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles.¹⁰¹

Secondly, the Ministerial Declaration adopted in Doha that kicked-off the so called 'Doha Development Round' of trade negotiations within the WTO contains two paragraphs which refer to the interpretation of TRIPS: Paragraph 17 refers to the Declaration on TRIPS and Public Health and states:

We stress the importance we attach to *implementation and interpretation* of the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS Agreement) in a manner supportive of public health, by promoting both access to existing medicines and research and development into new medicines and, in this connection, are adopting a separate Declaration.¹⁰²

Paragraph 19 then contains the mandate for further negotiations on key areas of concern related to the TRIPS Agreement and intellectual property.¹⁰³ As to the implementation of this mandate, the WTO Members stressed:

In undertaking this work, the TRIPS Council shall be *guided by the objectives and principles set out in Articles 7 and 8 of the TRIPS Agreement* and shall take fully into account the development dimension.¹⁰⁴

101. *Ministerial Conference*, Doha Declaration on the TRIPS Agreement and Public Health (WT/MIN(01)/DEC/2), 20 November 2001 (emphasis added).

102. *Ministerial Conference*, Ministerial Declaration (WT/MIN(01)/DEC/1) 20 November 2001, at para. 17 (emphasis added).

103. This mandate includes an instruction of the TRIPS Council 'in pursuing its work programme including under the review of Article 27.3(b), the review of the implementation of the TRIPS Agreement under Article 71.1 and the work foreseen pursuant to paragraph 12 of this Declaration, to examine, *inter alia*, the relationship between the TRIPS Agreement and the Convention on Biological Diversity, the protection of traditional knowledge and folklore, and other relevant new developments raised by Members pursuant to Article 71.1' – see *Ministerial Conference*, as n. 102 above, at para. 19.

104. *Ministerial Conference*, as n. 102 above, at para. 19 (emphasis added).

Against this background, the question has been raised whether Articles 7 and 8 TRIPS now have a (formally) ‘higher legal status’ for the ongoing negotiations as well as the implementation and interpretation of TRIPS.¹⁰⁵ Regarding the substance of the Declarations, it has been suggested that the importance accorded to Articles 7 and 8 TRIPS may lead a WTO dispute settlement panel to ‘take a longer look at how these provisions should be interpreted in the context of the Agreement as a whole, especially with respect to the need for “balance”’.¹⁰⁶ In order to engage in a comprehensive analysis of the Declarations’ impact on Article 7 and on the idea of interpreting TRIPS with a balancing perspective, one needs to distinguish between the formal status of the Declarations and their substance. The main focus here will be on the Doha Declaration on TRIPS and Public Health since it refers to the interpretation and application of the existing body of WTO law – while the general Doha Declaration deals with negotiations on changing that body of law.

III.B.5.a Formal Legal Status of the Doha Declarations

As to form, the legal status of Ministerial Declarations in the WTO seems ambiguous.¹⁰⁷ When attempting to qualify the ones adopted at the Doha Ministerial Conference under the rules of Decision-making in the WTO,¹⁰⁸ several options exist: Even though some key sections of the Doha Declaration on TRIPS and Public Health fulfil an interpretative function, the prevailing opinion¹⁰⁹ is that they do not amount to so called ‘authoritative interpretations’¹¹⁰ under Article IX:2 of the WTO Agreement¹¹¹ which are generally considered binding upon WTO Members.¹¹² This is backed by the fact that no reference to the authority of Article IX:2 can be found in the Declaration and, more importantly, that the

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105. D. Gervais, as n. 47 above, at para. 2.80; compare also ICTSD/UNCTAD, as n. 5 above, Part 1, Ch. 6 (6.2.1).
106. D. Gervais, as n. 47 above, at para. 2.80; C. Correa speaks about a confirmation of the interpretative value of Art. 7 TRIPS for each provision of TRIPS, see C. Correa, as n. 19 above, at 103.
107. See S. Charnovitz, ‘The Legal Status of the Doha Declarations’, 5 JIEL (2/2002), 211.
108. These are in particular provisions in Arts IV, IX, X and XII of the Agreement establishing the WTO (WTO Agreement) – see H. Grosse Ruse-Khan, ‘The Role of Chairman’s Statements in the WTO’, 41 JWT (3/2007), at 494.
109. See F. Abbot, ‘The Doha Declaration on the TRIPS Agreement and Public Health: Lighting a Dark Corner at the WTO’, 5 JIEL (3/2002) 492; S. Charnovitz, as n. 107 above, at 210; UNCTAD, as n. 5 above, Part 1, Ch. 6 (6.2.1) – for classifying the Doha Declaration on TRIPS and Public Health under Art. IX:2 WTO Agreement, D. Shanker, as n. 97 above, at 763.
110. The term ‘authoritative interpretation’ stems from Art. 3.9 of the DSU. It allows discriminating interpretations under Art. IX:2 from those adopted by a Panel or the Appellate Body which legally are only binding on the Parties to a dispute in respect to the case at hand.
111. This rule provides the Ministerial Conference and General Council with the exclusive authority to adopt interpretations of the WTO Agreements by a three-fourth majority of the Members.
112. See *United States – Tax Treatment for ‘Foreign Sales Corporations’* (WT/DS108/AB/R), Appellate Body Report (24 February 2000), para. 112, 113; C.D. Ehlermann & L. Ehring, ‘Decision-Making in the World Trade Organization’, 8 JIEL (1/2005), at 58; J. Jackson, ‘The World Trading System: Law and Policy of International Economic Relations’ (2nd edn, Cambridge (MA), 1997), 123–124.

procedure required under Article IX:2 has not been adhered to.¹¹³ Instead, most aspects speak for classifying both Declarations as ‘decisions’ under Article IV:1 and Article IX:1 of the WTO Agreement: They have been carefully negotiated and include reciprocal trade off’s from all sides; they have finally been adopted by consensus of all WTO Members and are stated in form of an agreement.¹¹⁴

While this qualification as such yet does not provide a general answer on the extent (if any) to which the Declarations have legally binding character,¹¹⁵ the *formal status in the interpretation process* follows from another provision: In particular the Doha Declaration on TRIPS and Public Health can be considered as an ‘subsequent agreement between the parties regarding the interpretation of the treaty or the application of its provisions’ under Article 31(3)(a) VCLT.¹¹⁶ The relevant language in paragraph 4 and 5 of the Doha Declaration on TRIPS and Public Health constitutes a consensual agreement of all WTO Members on the interpretation of TRIPS in general¹¹⁷ and the application of its provisions in the public health context in particular.¹¹⁸ So far, it has been considered as a ‘substantive equivalent of an interpretation of the TRIPS Agreement and, from a functional standpoint, indistinguishable from an authoritative interpretation under Article IX:2 of the WTO Agreement’.¹¹⁹ However, a word of caution should conclude this formal analysis. The *interpretative function* of the respective sections of the Doha Declaration may be equivalent to an authoritative interpretation. But the *legal weight* in the interpretation process is certainly distinct: An authoritative interpretation under Article XI:2 is *lex specialis* to Articles 31, 32 of the Vienna Convention. Since it amounts to an interpretation which is – as the Appellate Body puts it – ‘generally binding’, its legal relevance in the process of interpretation cannot be re-evaluated by applying the rules in the Vienna Convention.¹²⁰ Doing

113. Art. XI:2 requires that the Ministerial Conference, in the case of an interpretation of a Multilateral Trade Agreement in Annex 1 (as it is the case with TRIPS), shall exercise its authority on the basis of a recommendation by the Council overseeing the functioning of the WTO Agreement in question – in this case the TRIPS Council. The Doha Declaration however was not based on a recommendation from the TRIPS Council.

114. The records of the proceedings can be found at Ministerial Conference, ‘Summary records of the Ninth Meeting of Ministerial Conference on 14 November 2001’, (WT/MIN(01)/SR/9) 10 January 2002; compare also F. Abbot, as n. 109 above; at 491, S. Charnovitz, as n. 107 above, at 210; ICTSD/UNCTAD, as n. 5 above, Part 1, Ch. 6 (6.2.1).

115. Rejected by A. Sykes in *TRIPS, Pharmaceuticals, Developing Countries, and the Doha Solution*, J.M. Ohlin Law and Economics Working Paper No. 140 (February 2002), at 9 – online accessible at <www.law.uchicago.edu/Lawecon/index.html> (visited 06/11/2007).

116. Confirmed by F. Abbot, as n. 109 above, at 491–492; ICTSD/UNCTAD, as n. 5 above, Part 1, Ch. 6 (6.2.1). This however does not apply to para. 19 of the Doha Ministerial Declaration as it concerns the role of TRIPS objectives in the *ongoing negotiations* (which may lead to amendments of existing TRIPS provisions or new ones).

117. See para. 5(a) of the Declaration: ‘In applying the customary rules of interpretation of public international law, each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles.’

118. See para. 4 and 5(b)–(d) of the Declaration.

119. F. Abbot, as n. 109 above, at 491–492.

120. Compare also C.D. Ehlermann/L. Ehling, as n. 112 above, at 59.

so would effectively lead to the possibility for the organs of the dispute settlement system to overrule a decision taken by the WTO legislator under Article IX:2.¹²¹ As an agreement under Article 31(3)(a) VCLT however, the Doha Declaration on TRIPS and Public Health is (only) one element (of potentially many) to be ‘taken into account, together with the context’ in the process of interpretation.¹²²

III.B.5.b *The Substance of the Declaration on TRIPS and Public Health*

Having its formal status as additional and self-standing element in the interpretative process under the Vienna Convention in mind, we can now evaluate the *substance* of the Declaration on TRIPS and Public Health. Of particular importance for the concept of balancing on the domestic level is the second sentence of paragraph four (‘we reaffirm the right of WTO Members to use, to the full, the provisions in the TRIPS Agreement, which provide flexibility for this purpose’) and paragraph 5a (‘Accordingly and in the light of paragraph 4 above, while maintaining our commitments in TRIPS Agreement, we recognize that these flexibilities include: In applying the customary rules of interpretation of public international law, each provision of the TRIPS Agreement shall be read in the light of the object and purpose of the Agreement as expressed, in particular, in its objectives and principles.’). Taken together, one of the TRIPS flexibilities is the right of individual WTO Members to interpret TRIPS in light of its purpose, as particularly expressed in its Article 7 (and 8). This allows the following deductions:

- (1) It confirms the notion that a balance of interests as the main objective under Article 7 is to be conducted at the *domestic level* of implementing TRIPS.¹²³ Within the limits of the ordinary meaning and (other) context, Members are free to implement TRIPS in light of its central purpose of providing a balance – tailored to the domestic circumstances – between encouraging new innovations and transferring/disseminating the results for the benefit of the society.¹²⁴ By the same token, it provides evidence against the view that Article 7 is merely a declaratory expression of the balancing already performed in the drafting of TRIPS.
- (2) It backs the view that the *overall objectives* of TRIPS are decisive – not the ones which may relate to the interpreted provision in particular.¹²⁵
- (3) Within those overall objectives, the Declaration places specific emphasis on the ones expressed in Articles 7 and 8 TRIPS. It has been argued that

121. By giving legal weight to other elements recognized under the Vienna Convention rules a Panel or the Appellate Body could arrive at a distinct result as when relying exclusively on the authoritative interpretation as the sole source of guidance, compare H. Grosse Ruse-Khan, as n. 108 above, at 515–516.

122. See the wording of Art. 31(3) VCLT.

123. See above at 2.

124. See above at 1. and 2.

125. See above at 4.

‘this may have the effect of elevating those provisions above the preamble of TRIPS for interpretative purposes’.¹²⁶ In any event, it places specific emphasis on Article 7 and thus on the key objective of a balanced level of protection advocated therein.

- (4) An interpretation in light of TRIPS’ purpose is obligatory for each provision of the Agreement – not only selected ones. It may nevertheless be of particular importance for those which contain broad and open legal concepts and/or which relate to exceptions of exclusive rights.¹²⁷
- (5) Finally and from a broader perspective on the overall interpretative process, the fact that of the three central elements of interpretation¹²⁸ the Declaration only focuses on the object and purpose (as expressed in Articles 7 and 8 TRIPS) could be understood as placing more emphasis on-or even giving the latter priority over the ordinary meaning and context in the process of interpretation. Recalling that the text is the starting point for treaty interpretation¹²⁹ which should be a single combined operation and include all relevant elements in a holistic manner,¹³⁰ this extra weight on the TRIPS objectives however should not lead to results which are contrary to the ordinary meaning or context of the provision at stake. Such a reading would raise questions as to the extent the Doha Declaration can authorize Members to depart from the accepted principles of treaty interpretation in public international law, as advocated in Article 3.2 of the WTO Dispute Settlement Understanding.¹³¹ Instead, the extra emphasis placed on the treaties’ object and purpose will be of central importance where the ordinary meaning and context of the TRIPS provision at hand *allows* for an interpretation focussing on the objective of a balanced system of IP protection: That is, whenever the interpretation of broad and open legal concepts such as necessity, reasonableness and legitimacy is at stake.¹³²

126. ICTSD/UNCTAD, as n. 5 above, Part 1, Ch. 6 (6.2.1): The latter effect is deemed relevant since the preamble ‘might be understood to place a somewhat greater weight on the interests of intellectual property owners than on public interests’. This however is not necessarily the case – compare the interpretation of the preamble and its role for proportionality and balancing above.

127. See C. Correa, as n. 19 above, at 103; compare also D. Gervais, as n. 47 above, at 2.80 (p. 120).

128. Ordinary meaning, context and object and purpose, see Art. 31(1) VCLT.

129. *United States – Import Prohibition of Certain Shrimp and Shrimp Products*, as n. 46 above, at 114; *Yearbook of the International Law Commission*, as n. 84 above, at 220; compare also R. Howse, as n. 92 above.

130. *Yearbook of the International Law Commission*, as n. 84 above, at 219–220; I. Sinclair, as n. 84 above, at 117–119.

131. Arguably, the Doha Declaration not being an authoritative interpretation under Art. IX:2 or an amendment to existing WTO rights and obligations under Art. X of the WTO Agreement, cannot have the character of adding to or diminishing existing obligations – in this case following from Art. 3.2 DSU.

132. Compare also sec. 1. and 2. above. This result is confirmed by C. Correa, as n. 19 above, at 103.

III.B.5.c *Conclusions: Double Counting and Single Most Important Element*

In conclusion on the role of the Doha Declaration on TRIPS and Public Health for the interpretation of TRIPS provisions, one may emphasize the following points: Formally, the Doha Declaration is an agreement on the interpretation of TRIPS within the meaning of Article 31(3)(a) VCLT and thus an additional element relevant in the interpretative process. This amounts to a ‘double counting’ of the object and purpose of TRIPS in relation to ordinary meaning and other context: Once in application of Article 31(1) and another time under Article 31(3) – there being considered an equivalent to the treaties’ context. As to its substance, the Declaration places emphasis on Articles 7 and 8 TRIPS as tools for an interpretation and implementation of TRIPS tailored to the domestic needs for a balance between incentives for new innovations and their transfer and dissemination to the public. Overall, while the concrete interpretative result will certainly depend on the individual TRIPS provision, especially for broad and open legal concepts, the balancing objective advocated by Article 7 TRIPS is the single most important element in the process of interpretation in WTO law.

Against these conclusions the findings of the Panel in *Canada – Patents* dispute as they regard Article 7 TRIPS cannot be upheld. The following section will, in summarizing the main points of this chapters’ analysis on Article 7 TRIPS, critically address some of these findings as they concern the general role of Article 7 in the interpretation of the TRIPS Agreement.¹³³

III.B.6 *Re-evaluating Canada – Patents*

The dispute *Canada – Patents*¹³⁴ initiated by the European Communities (EC) against Canada concerned the TRIPS consistency of two provisions in the Canadian Patent Act which allowed certain exceptions to the exclusive rights of the Patent holder. These exceptions concerned pharmaceutical patents and authorized the making and use of the patented invention (1) in order to carry out tests necessary to obtain marketing approval for generic versions of the patented drugs (bolar exception); and (2) in order to manufacture and stockpile generic versions for a period of six months before the end of the patent term so that generic copies would be readily available as soon as the patent term of the original drug expired (stockpiling exception). The EC challenged the compliance of these two exceptions with Article 27(1) 2nd sentence and Article 30 TRIPS. With regard to the objectives of TRIPS, the main issue was to what extent they influence the

133. It is, however, beyond the scope of this chapter to assess the main question, regarding Art. 30 TRIPS, at issue in that Panel Report (in this vein, compare M. Senftleben, as n. 25 above). The interpretation of provisions such as Art. 30, 26(2), 17 and 13 TRIPS, in light of the objectives analyzed here and in comparison to the scope for domestic policies in other areas of international economic lawmaking, will be addressed in follow on research publications.

134. *Canada – Patent Protection of Pharmaceutical Products*, as n. 47 above.

interpretation of the relevant terms in Articles 27 and 30. The following excerpts from the Panel report nicely summarizes the Arguments of Canada, the EC, as well as the legal reasoning of the Panel:

7.24 In the view of Canada, the italicized text of Article 7 above declares that one of the key goals of the TRIPS Agreement was a *balance* between the intellectual property rights created by the Agreement and other important socio-economic policies of WTO Member governments. Article 8 elaborates the socio-economic policies in question, with particular attention to health and nutritional policies. With respect to patent rights, Canada argued, *these purposes call for a liberal interpretation of the three conditions stated in Article 30 of the Agreement*, so that governments would have the necessary flexibility to adjust patent rights to maintain the desired balance with other important national policies.

7.25 The EC did not dispute the stated goal of achieving a balance within the intellectual property rights system between important national policies. But, in the view of the EC, *Articles 7 and 8 are statements that describe the balancing of goals that had already taken place in negotiating the final texts of the TRIPS Agreement*. According to the EC, to view Article 30 as an authorization for governments to ‘renegotiate’ the overall balance of the Agreement would involve a double counting of such socio-economic policies. In particular, the EC pointed to the last phrase of Article 8.1 requiring that government measures to protect important socio-economic policies be consistent with the obligations of the TRIPS Agreement. The EC also referred to the provisions of first consideration of the Preamble and Article 1.1 as demonstrating that the basic purpose of the TRIPS Agreement was to lay down minimum requirements for the protection and enforcement of intellectual property rights.

7.26 In the Panel’s view, Article 30’s very existence amounts to a recognition that the definition of patent rights contained in Article 28 would need certain adjustments. On the other hand, *the three limiting conditions attached to Article 30 testify strongly that the negotiators of the Agreement did not intend Article 30 to bring about what would be equivalent to a renegotiation of the basic balance of the Agreement*. Obviously, the exact scope of Article 30’s authority will depend on the specific meaning given to its limiting conditions. The words of those conditions must be examined with particular care on this point. *Both the goals and the limitations stated in Articles 7 and 8.1 must obviously be borne in mind when doing so as well as those of other provisions of the TRIPS Agreement which indicate its object and purposes.*¹³⁵

Assessing this passage and in particular the Panel’s reasoning highlighted in italics against the main conclusions of the analysis the object and purpose of TRIPS after

135. *Canada – Patent Protection of Pharmaceutical Products*, as n. 47 above, at 7.24–7.26 (emphasis added).

Doha, one certainly cannot agree with the position of the EC and further needs to criticize several points made by the Panel: As already indicated above, Article 7 cannot be viewed as merely declaratory of a balance inserted into the individual norms of TRIPS. Apart from the wording of Article 7 as well as the principle of effectiveness, the very objective of balancing itself and the promotion of socio-economic welfare requires this to be tailored towards domestic needs and thus to be performed on the domestic implementation level.¹³⁶ It is on this stage only where a proportional balance between protection of new innovations and their transfer and dissemination to the public can be performed effectively.¹³⁷ Within the process of treaty interpretation, established principles – as codified in the Vienna Convention Articles 31 and 32 – place the object and purpose of a treaty as elements of interpretation on equal footing next to ordinary meaning and context of the provisions at stake. In this regard, the Arguments of the EC are in complete denial of Article 31(1) VCLT.

These principles of interpretation equally stand against the reasoning of the Panel in paragraph 7.26: While it is correct that the limiting conditions in Article 30 (as well as those in Articles 13, 17, 26(2) TRIPS) certainly have to be borne in mind when exercising the balance Article 7 calls for, they in turn have to be interpreted in light of the object and purpose of TRIPS. Here we may recall that starting point is the text of the treaty provision and its ordinary meaning.¹³⁸ If, giving due regard to the provisions context, that meaning leads to an evident result and leaves few (if any) room for different understandings, the impact of the treaty's objectives is likely to be marginal.¹³⁹ If however – as in case of Article 30¹⁴⁰ – the interpretation of broad and open terms and concepts is at stake, the role of Article 7 will be much greater: One should keep in mind that paragraph 4 and 5 (a) of the Doha Declaration constitute a subsequent agreement of all WTO Members on the interpretation of TRIPS which effectively leads to a double counting of the TRIPS objectives in process of interpretation: Whenever the ordinary meaning and context allows, the objective of a proportional balance of interests will be the single most important factor in the interpretation and implementation of TRIPS.¹⁴¹ As this is certainly the case for several key terms in Article 30 TRIPS, these conditions as such cannot be relied upon to limit the role of Article 7 *a priori*.

136. See s. 2. above.

137. This is further supported by historic evidence as well as economic theory on intellectual property protection – see s. 1 above.

138. Compare sec. 4. above. See in particular *United States – Import Prohibition of Certain Shrimp and Shrimp Products*, as n. 46 above, at 114; *Japan – Taxes on Alcoholic Beverages*, as n. 74 above, 97 (at 105); *Yearbook of the International Law Commission*, as n. 84 above, at 220.

139. It nevertheless should be considered since para. 5 (a) of the Doha Declaration on TRIPS and Public Health requires the objectives to be taken into account for every provision of TRIPS; see s. 5. above.

140. 'Unreasonable conflict', 'normal exploitation', 'legitimate interests of the patent owner' and 'legitimate interests of third parties'.

141. Compare s. 5. above.

These insights also contradict another key passage in the Panel Report which deals with the relation between terms in individual provisions and Article 7 TRIPS and which has been criticized in some writings:¹⁴²

Article 27 prohibits only *discrimination* as to the place of invention, the field of technology, and whether products are imported or produced locally. Article 27 does not prohibit *bona fide exceptions* to deal with problems that may exist only in certain product areas. Moreover, *to the extent the prohibition of discrimination does limit the ability to target certain products in dealing with certain of the important national policies referred to in Articles 7 and 8.1, that fact may well constitute a deliberate limitation rather than a frustration of purpose.* It is quite plausible, as the EC argued, that the TRIPS Agreement would want to require governments to apply exceptions in a non-discriminatory manner, in order to ensure that governments do not succumb to domestic pressures to limit exceptions to areas where right holders tend to be foreign producers.

Again, the specific terms of Article 27 TRIPS – the prohibition of certain types of discrimination – cannot be utilized to limit the impact of the general objectives in Article 7 a priori. Instead, while a careful assessment of the ordinary meaning of ‘without discrimination’ may certainly amount to a limited option for giving effect to a balance of interests, it is the terms of Article 27 which in turn must be interpreted in light of the object and purpose of TRIPS. In this case, ‘without discrimination’ is sufficiently open and broad to allow for various understandings.¹⁴³ One must therefore choose an interpretation which gives due regard to the increased importance attached to Article 7 after Doha and at the same time prevents an *abusive* reliance on public policy objectives to further protectionist interests not recognized under Article 7 TRIPS.¹⁴⁴

This analysis of the Panel Report indicates that the interpretation of TRIPS in accordance with all elements recognized under Article 31 VCLT and giving due regard to the extra emphasis placed on the objectives of Article 7 TRIPS is still to be realized in WTO jurisprudence. It seems that so far there is a definite need for a more detailed, concrete elaboration of the content and implications of the objectives under Article 7 TRIPS and their impact on the meaning of individual TRIPS provisions.¹⁴⁵ In this chapter, I have tried to outline the overarching purpose of TRIPS to balance intellectual property protection between the two poles of promoting innovation on the one hand and transferring and disseminating these

142. See ICTSD/UNCTAD, as n. 5 above, Part 1, Ch. 6 (4.); D. Shanker, as n. 97 above, at 742.

143. This follows not only from the terms itself but especially in comparison to the established interpretations on very similar terms in the chapeau of Art. XX GATT which is perceived mainly as a safeguard against the abusive reliance on GATT exceptions; see *United States – Standards for Reformulated and Conventional Gasoline*, as n. 43 above, at 22 and *P. Van der Bossche*, as n. 8 above, at 616–617.

144. Compare the established interpretation of the discrimination clause in Art. XX GATT; see *P. Van der Bossche*, as n. 8 above, at 616–617.

145. See also C. Correa, as n. 19 above, at 102.

innovations on the other. In order to actually be ‘conducive to social and economic welfare’,¹⁴⁶ this balancing must be performed on the domestic implementation level and tailored to domestic needs – without however contradicting the ordinary meaning and context of the TRIPS provisions implemented.

IV. CONCLUDING REMARKS: THE CASE FOR A BALANCE OF INTEREST IN ITS WIDER CONTEXT

To conclude this analysis, one can bring two further reasons for a proportional balancing as a guiding principle in the interpretation of TRIPS: First, international obligations to protect human rights have been relied upon to provide additional normative justifications for a balance of interest: The WTO and its Member States are bound by the UN Charter to comply with fundamental principles of human rights as enshrined in the Universal Declaration of Human Rights and the two international Covenants.¹⁴⁷ Such compliance can be achieved by strengthening the balancing mechanisms within TRIPS which then give effect to public interests protected by international human rights law and place them at the heart of the objectives of intellectual property protection.¹⁴⁸ As long as the interests to be balanced fall within the paradigm of Article 7 TRIPS, the method of interpretation proposed in this chapter should give sufficient effect to the human rights considerations at stake. If this is not the case, one could consider giving effect to these ‘additional’ interests by integrating them into the interpretation process via Article 30(3)(c) VCLT: This rule of treaty interpretation calls for the recognition of ‘any relevant rules of international law applicable in the relations between the parties’. Even though the exact scope of this norm in general and in the context of WTO law in particular is not clear and warrants further analysis,¹⁴⁹ good arguments can be forwarded for its application in relation to well accepted rules of customary or conventional international (human rights) law. Especially regarding the Universal Declaration of Human Rights,¹⁵⁰ this should certainly be the case.

Secondly, the observations on the extension of various fields of international economic regulation into areas so far left untouched to the domestic policy maker

146. Art. 7 TRIPS.

147. C. Correa, as n. 19 above, at 100.

148. UN Sub-commission on the Promotion and Protection of Human Rights, ‘The Impact of the Agreement on Trade related Aspects of Intellectual Property protection on Human Rights’, (E/CN.4/Sub.2/2001), 13 June 2001, at para. 16–28; see also C. Geiger, *Constitutionalising Intellectual Property Law*, 37 IIC (4/2006) at 382–389 – as well as the contribution of C. Geiger in this book.

149. See I. Sinclair, as n. 84 above, at 138–140, *European Communities – Measures Affecting the Approval and Marketing of Biotech Products* (WT/DS293/R) Panel Report (29 September 2006) at 7.52, 7.65–7.68, 7.72–7.75. In a more general way the Appellate Body has stressed that WTO law should not be ‘read in clinical isolation from public international law; see *United States – Standards for Reformulated and Conventional Gasoline*, as n. 43 above, at 16.

150. Adopted and proclaimed by the United Nations General Assembly resolution 217 A (III) of 10 December 1948 – available at <www.un.org/Overview/rights.html> (visited 19 May 2007).

(reaching behind the border)¹⁵¹ merit an increased emphasis on balancing mechanisms within these systems. As stated in the hypothesis above: the more 'intense' and far-reaching international regulation becomes; the stronger is the need for the inclusion of a comprehensive and flexible regime which takes into account all interests affected. Within International IP law, as far as the domestic interests affected by global rule-making from a trade perspective fall within the reach of the balancing advocated by Article 7 or the preamble of TRIPS, the method of interpretation proposed here may offer a proportional solution. If this is not the case, one should assess in detail options of giving effect to these interests via any relevant rules of international law recognized under Article 31(3)(c) VCLT.¹⁵²

One must however always keep in mind that this *merely opens a door* for integrating the interests and concerns at stake into the overall process of treaty interpretation. It certainly does not guarantee that these interests will prevail. This is the less likely the more detailed provisions giving effect to the trade interests are: Those provisions demand to be recognized under the notion of textual interpretation starting with the ordinary meaning of the treaty terms. Non trade interests which are either neglected, merely recognized as (limited) exceptions to the rule, or have to be imported from other regulatory systems to become part of the recognized context for interpretation cannot compete effectively with detailed 'codifications' of trade interests. In the end, this observation provides evidence of the disadvantages which non-trade and non-economic interests are likely to face when competing with trade and economic interests in a regulatory framework dominated by trade rules and applied in a trade forum.

The question then is whether the incorporation of non-trade values into the global trading system, for example by an interpretation focussing on the balancing objectives of TRIPS or by a broad understanding of norms such as Article XX GATT or Article XIV GATS, can really solve this problem. On the one hand, such an internalization of these non-trade interests should, if properly implemented, lead to a more balanced international system of economic regulation and support coherence between distinct areas of public international law. On top of this, a more detailed 'codification' of these interests within the body of trade law would certainly enhance their importance in a balancing exercise and may offer (optional) guidance in their implementation on the domestic level. In the field of intellectual property, especially for developing countries a more detailed codification of interests in favour of the *transfer and dissemination* of innovations¹⁵³ could be not only helpful in guiding implementation, but may also operate as safeguard against

151. See s. II. above.

152. In this regard, one may look at the arguments put forward by the EC and various environmental NGOs of the effect on human health of imported Genetically Modified Organisms (GMOs), via international regulations such as the Cartagena Protocol on Bio-Safety; see *European Communities – Measures Affecting the Approval and Marketing of Biotech Products*, as n. 149 above.

153. One may recall that this objective represents one of the two poles between which the balancing under Art. 7 TRIPS should be performed, see s. II.B.1. above.

bilateral pressures to adopt more stringent IP protection.¹⁵⁴ On the other hand, the internalization of non-trade interests within the body of global trade rules bears the danger of subjecting the former to the latter. The regulatory, administrative and judicial forum would still be a trade focussed forum – unless of course over time the relevant actors were to take non-trade interests as serious as trade interests.

154. This safeguarding function however implies a binding character of provisions promoting non-trade interests ('ceiling rules') which might imply an amendment of Art. 1(1) 2nd Sentence TRIPS. It further raises issues of how these ceiling rules could be enforced in the WTO dispute settlement context which is primarily driven by national *trading* interests.

Chapter 7

Copyright (and Other Intellectual Property Rights) as a Human Right

*Paul L.C. Torremans**

I. INTRODUCTION

When the Canada House conference in which the first edition of this collection of essays was rooted was set up and subsequently when the topics and the essential components of a book treating the issue of copyright, and other intellectual property rights, and human rights were discussed it seemed obvious to think of the issue as one involving copyright and intellectual property rights in general on the one hand and human rights on the other hand. The first impression was inevitably one of two elements being involved and of the task ahead being the study of the interaction between these two elements.

That interaction between copyright and intellectual property rights on the one hand and human rights on the other hand is in truth not a new phenomenon. This essay will demonstrate that the roots of this interaction go back a long time and are of a fundamental nature, but at least in the UK it gave the impression of being something new. No doubt this was a consequence of the introduction of a formal Bill of Rights in the form of the Human Rights Act 1998, which provided a sharp

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focus on human rights in the English legal system. It is true though in a broader international context that copyright and intellectual property rights on the one hand and human rights on the other hand for quite a while seemed to develop in virtual isolation.¹ Each discipline seemed to stand on its own and had very little interest in the development of the other, let alone in the development of any interaction. It is in this respect sufficient to have a look at the vast majority of copyright and intellectual property rights standard texts. No reference to human rights is found² and similarly most standard texts on human rights law do not seem to refer to copyright and intellectual property rights either. In other words, the interaction between the two areas of law may well not be a new phenomenon, but it is one the study of which has only attracted attention in earnest in recent years.³

Two approaches to this interaction can be distinguished.⁴ The first approach is based on the conflict model and sees copyright and intellectual property rights as in fundamental conflict with human rights. The proponents of this approach argue that strong intellectual property rights are bound to undermine human rights and in particular economic, social and cultural aspects of human rights. This leads to an incompatibility that can only be resolved through the recognition of the primacy of human rights whenever a conflict arises. This solution imposes itself in the view of its proponents because in normative terms human rights are fundamental and of higher importance than intellectual property rights.⁵ It is submitted that this approach focuses, maybe unduly so, primarily on the practical effects of certain forms of intellectual property rights in specific situations. In doing so it does not address the broader picture, involving the function and nature of the elements

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1. Helfer, 'Human Rights and Intellectual Property: Conflict or Coexistence?', (2003) *Minnesota Intellectual Property Review* (forthcoming), *Loyola-LA Public Research Paper No. 2003-27*; *Princeton Law & Public Affairs Working Paper No. 03-15*, 3.
 2. Hugenholtz, 'Copyright and Freedom of Expression in Europe', in R. Cooper Dreyfuss, D. Leenheer Zimmerman and H. First, *Expanding the Boundaries of Intellectual Property: Innovation Policy for the Knowledge Society*, Oxford University Press (2001), 343-363, at 350.
 3. See e.g., the expansion of the treatment in the second edition of J.A.L. Sterling, *World Copyright Law*, Sweet & Maxwell (2003) in comparison to the first edition of the book (1999). See also G. Schricker (ed.), *Urheberrecht: Kommentar*, Verlag C.H. Beck (2nd ed., 1999), § 97, Nos 19-25, 1500-1504 to which Hugenholtz, 'Copyright and Freedom of Expression in Europe', in R. Cooper Dreyfuss, D. Leenheer Zimmerman and H. First, *Expanding the Boundaries of Intellectual Property: Innovation Policy for the Knowledge Society*, Oxford University Press (2001), 343-363 refers as an example at 351 and Vivant, 'Le droit d'auteur, un droit de l'homme?', 174 RIDA (1997) 60.
 4. Helfer, 'Human Rights and Intellectual Property: Conflict or Coexistence?', (2003) *Minnesota Intellectual Property Review* (forthcoming), *Loyola-LA Public Research Paper No. 2003-27*; *Princeton Law & Public Affairs Working Paper No. 03-15*, 1-2.
 5. See e.g., United Nations, Economic and Social Council, Commission on Human Rights, Sub-Commission on the Promotion and Protection of Human Rights, Resolution 2000/7 on Intellectual Property Rights and Human Rights, E/CN.4/Sub/2/2000/L.20, preamble § 11 and Robert Howse and Makau Mutua, *Protecting Human Rights in a Global Economy: Challenges for the World Trade Organisation*, International Centre for Human Rights and Democratic Development, Policy Paper, (2000), at 6.

involved in the interaction. The second approach comes to the interaction between intellectual property rights and human rights from this broader perspective. Looking at it from that perspective, both intellectual property rights and human rights deal with the same fundamental equilibrium. On the one hand there is a need to define the scope of the private exclusive right that is given to authors as an incentive to create and as recognition of their creative contribution to society broadly enough to enable it to play its incentive and recognition function in an appropriate and effective way, whilst on the other hand there is the broader interest of society that the public must be able to have adequate access to the fruits of authors' efforts. Both intellectual property law and human rights law try to get the private-public rights balance right and as such there is no conflict. Both areas of law may however not define that balance in exactly the same way in all cases. There is therefore a compatibility between them, rather than a consensus.⁶

The other essays in this collection will deal in detail with the various aspects of the interaction between intellectual property rights and human rights. In this essay I would like to examine whether or not it might be too restrictive to see intellectual property rights and human rights solely as two sets of distinct rights between which there is an interaction along the lines of any of the two approaches or models set out in the previous paragraph. Maybe we are overlooking the fact that one way or another intellectual property rights and more specifically copyright may be considered as a Human Right. We will therefore have to examine whether or not copyright (or any other intellectual property right) can indeed be considered as a Human Right, both at international and at national level. Additionally we will need to examine whether any conclusion on this point necessarily applies to the whole of copyright or only to certain aspects of copyright and whether it applies to all aspects in the same way. And we will need to examine whether other intellectual property rights are different in this respect. Whatever the outcome of such an analysis may be and wherever it may lead us, we will inevitably have to come back to the issue of the interaction between copyright (and other intellectual property rights) and human rights. The question will have to be answered whether our findings can be reconciled with the idea of interaction as defined above. And if the interaction idea involves a balancing of interests we will have to determine where and how balancing is to take place. The question whether the balancing of interests can maybe also take place inside a broadly conceived human rights portfolio will arise unavoidably. But let us now first turn to the question whether there are indications in international legal instruments that allow us to define copyright as a Human Right.

6. See e.g., United Nations, Economic and Social Council, Commission on Human Rights, Sub-Commission on the Promotion and Protection of Human Rights, 52nd session, Item 4 of the Provisional Agenda, Economic, Social and Cultural Rights – The Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights, Report of the High Commissioner, E/CN.4/Sub/2/2001/13, at 5.

II. THE HUMAN RIGHTS APPROACH TO COPYRIGHT IN INTERNATIONAL INSTRUMENTS

Let us for a moment leave behind legal concepts and consider the factual starting point. Broadly speaking we are essentially concerned here with creative works, creations of the mind and elements of cultural heritage which are of particular value to society. Society finds it is therefore in its best interest to offer some form of protection to the creators of these works. Interests in material goods are protected by means of physical possession of the goods, which then gains legal recognition in the form of a property right. Whoever produces the goods and has them in his or her possession will be given a property rights in the goods. Similarly protection for creative works is offered along the property route. As these works are immaterial in nature,⁷ the factual element of physical possession is not available here and cannot form the basis of the property right. That (intellectual) property right is therefore created as a legal fiction, but it serves the same purpose. It is important to note though that the way society and the legal system on its behalf deal with creative works is to turn them into property rights. Behind any property stands an owner and it is important to note also at the outset that the legal fiction that is copyright as a property right refers in this respect to the creator or author behind the work in the absence of the concept of a person having the physical goods in his or her possession in relation to immaterial property. This is important to keep in mind in a human rights context. Apart from the obvious references to copyright as such, the debate will also need to deal with the human rights aspects of property rights and personality rights.⁸

The importance of the act of creation and the link with the creator in relation to rights that may flow from it has also been emphasized by René Cassin, one of the architects of the current human rights framework. In his view the ability and the desire to develop intellectual and creative activities from which copyright works may result is potentially found in all human beings. As such it deserves therefore respect and protection in the same way as all other basic faculties that are common to all men. This would mean that creators can claim rights by the very fact of their creation. This is a broad statement and it is by no clear that such rights are by definition human rights and that they must cover all creations and necessarily take the format of an exclusive right in such creations.⁹ Further analysis is therefore warranted.

7. They are indeed to be distinguished from their material support of carrier.

8. See Chapman, 'Approaching Intellectual Property as a Human Right (obligations related to Article 15(1)(c))', XXXV (2001) Copyright Bulletin, No. 3, 4–36, at 5.

9. Cassin, 'L'intégration, parmi les droits fondamentaux de l'homme, des droits des créateurs des oeuvres de l'esprit', in *Mélanges Marcel Plaisant: Etudes sur la propriété industrielle, littéraire et artistique*, Sirey (1959), at 229 and Vivant, 'Le droit d'auteur, un droit de l'homme?', 174 RIDA (1997) 60, at 87.

II.A

THE UNIVERSAL DECLARATION OF HUMAN RIGHTS

The first key provision in an international instrument that identifies copyright as a Human Right is found in Article 27 of the Universal Declaration of Human Rights.¹⁰ According to Article 27 everyone has first of all ‘the right to the protection of the moral and material interests resulting from and scientific, literary or artistic production of which he is the author’. But it is equally important to note another element of the same article where it is stated in its first paragraph that ‘everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits’.

This first paragraph of Article 27 clearly has historical roots. The Universal Declaration of Human Rights was drafted less than three years after the end of the Second World War, and science and technology as well as copyright based propaganda had been abused for atrocious purposes by those who lost the war. Such an abuse had to be prevented for the future and it was felt that the best way forward was to recognize that everyone had a share in the benefits and that at the same time those who made valuable contributions were entitled to protection. That process was of a human rights nature, as the series of rights and claims made in Article 27 are considered to be universal and vested in each person by virtue of their common humanity. It should in this context also be remembered that the human rights that were articulated in the Universal Declaration of Human Rights are held to exist independently of implementation or even recognition in the customs or legal systems of individual countries. They are after all such important norms that they create prima facie obligations to take measures to protect and uphold these rights. This obligation particularly applies to governments, as they are supposed to act in the common interest of humanity.¹¹ And ‘[b]ecause a human right is a universal entitlement, its implementation should be measured particularly by the degree to which it benefits those who hitherto have been the most disadvantaged and vulnerable’.¹² It should not simply serve one group in society that already occupies a privileged position. The benefit that is produced for ‘everyone’ should also go beyond the ability to draw some benefit from the applications of intellectual property, i, the better goods and services that are made available as a result. Enjoyment of the arts and especially participation in the cultural life of society are clearly broader concepts that go further and involve elements of sharing at all levels and stages.

That brings us back to paragraph two of Article 27. This is not inasmuch a tool to implement paragraph one as a complimentary provision that sets up a right to the protection of moral as well as material interests. The protection of moral and

10. See J.A.L. Sterling, *World Copyright Law*, Sweet & Maxwell (2nd ed., 2003), 43.

11. See J.W. Nickel, *Making Sense of Human Rights: Philosophical Reflections on the Universal Declaration of Human Rights*, University of California Press (1987), 3.

12. Chapman, ‘A Human Rights Perspective on Intellectual Property, Scientific Progress, and Access to the Benefits of Science’, WIPO Panel Discussion on Intellectual Property and Human Rights (8 November 1998), at 2, available at <www.wipo.org>, (last accessed 23 April 2008).

material rights of authors and creator is clearly exactly what is covered by the area of law known as copyright and this second paragraph of Article 27 of the Universal Declaration of Human Rights must therefore be seen as elevating copyright to the status of a Human Right, or maybe it is more appropriate to say that the article recognizes the human rights status of copyright. The roots of this second paragraph of Article 27 go back to two influential elements. In the first place there was the original suggestion made by the French delegation which had a double focus. On the one hand the emphasis was placed on the moral rights of the author, which centred around his or her ability to control alterations made to the work and to be able to stop misuses of the work or creation. On the other hand there was the recognition of the right of the author or creator to receive a form of remuneration for his or her creative activity and contribution.¹³ Secondly, the Mexican and Cuban members of the drafting committee argued that it made sense to establish a parallelism between the provisions of the Universal Declaration of Human Rights and the American Declaration on the Rights and Duties of Man that had at that stage been adopted very recently.¹⁴ Article 13 of the latter dealt with intellectual property rights by stating:

[E]very person has the right to take part in the cultural life of the community, to enjoy the arts, and to participate in the benefits that result from intellectual progress, especially scientific discoveries. He likewise has the right to the protection of his moral and material interests as regards his inventions or any literary, scientific or artistic works of which he is the author.¹⁵

Despite these rather clear and explicit roots, it is not necessarily clear what motivated those who voted in favour of the adoption of the second paragraph of Article 27 of the Universal Declaration of Human Rights. What we know is that the initial strong criticism that intellectual property was not properly speaking a Human Right or that it already attracted sufficient protection under the regime of protection afforded to property rights in general was eventually defeated by a coalition of those who primarily voted in favour because they felt that the moral rights deserved and needed protection and met the human rights standard and those who felt the ongoing internationalization of copyright needed a boost and that this could be a tool in this respect.¹⁶

This is of course not the strongest basis for a strong argument that copyright is beyond doubt a Human Right and in theory things are not helped a great deal either by the fact that as a United Nations General Assembly action the Universal

13. See J. Morsink, *The Universal Declaration of Human Rights: Origins, Drafting and Intent*, University of Pennsylvania Press (1999), at 220.

14. Chapman, 'Approaching Intellectual Property as a Human Right (obligations related to Article 15(1)(c))', XXXV (2001) Copyright Bulletin, No. 3, 4–36, at 11.

15. American Declaration of the Rights and Duties of Man, Approved by the ninth International Conference of American States, Bogota, Colombia, 30 March to 2 May 1948, Final Act of the Ninth Conference, 38–45.

16. J. Morsink, *The Universal Declaration of Human Rights: Origins, Drafting and Intent*, University of Pennsylvania Press (1999), at 221.

Declaration of Human Rights is merely aspirational or advisory in nature. But where initially Member States were not obliged to implement it on this basis, it has now gradually acquired the status of customary international law and of the single most authoritative source of human rights norms. That has in turn greatly enhanced the standing of copyright as a Human Right, even if the economic, social and cultural rights, of which copyright is one, are still seen as weaker provisions than those dealing with basic civil and political rights.¹⁷ The exact ramifications of Article 27 of the Universal Declaration of Human Rights are also not always clear,¹⁸ but what is clear that copyright as a Human Right requires there to be a balance between the concepts expressed in Article 27(1) and those expressed in Article 27(2) as they are linked in the drafting of the provision.¹⁹ Nevertheless, national courts have used it to protect the interests of authors on a couple of occasions.²⁰ For example, in a judgment dated 29 April 1959 the Court of Appeal in Paris granted Charlie Chaplin, a British national, the rights of a Frenchman in France in relation to his moral rights on the basis of an assimilation based on Article 27(2) of the Universal Declaration when he wished to object to the unauthorized addition of a sound track to one of his movies.²¹ Similarly, Article 27(2) played a prominent role in the granting of the status of author and with it moral rights in the first judgment in the John Huston – Asphalt Jungle saga where colour rather than sound was added to the movie.²² Whilst both cases deal primarily with moral rights, the concept of authorship also has economic rights aspects and it is clear that Article 27 covers both economic and moral rights and therefore the whole of copyright.

II.B THE INTERNATIONAL COVENANT ON ECONOMIC, SOCIAL AND CULTURAL RIGHTS

This Covenant is to be seen as a follow up action on the Universal Declaration of Human Rights. Important though is the fact that this follow up action took the form

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17. Chapman, 'A Human Rights Perspective on Intellectual Property, Scientific Progress, and Access to the Benefits of Science', WIPO Panel Discussion on Intellectual Property and Human Rights (8 November 1998), at 7, available at <www.wipo.org>, (last accessed 23 April 2008).
 18. Cassin, 'L'intégration, parmi les droits fondamentaux de l'homme, des droits des créateurs des oeuvres de l'esprit', in *Mélanges Marcel Plaisant: Etudes sur la propriété industrielle, littéraire et artistique*, Sirey (1959), at 225.
 19. See Villalba, 'Volviendo a justificar el derecho de autor – Revalidating Copyright', paper delivered at the ALAI 2007 conference in Punta del Este, to be published in the proceedings of that conference, at paragraph 8.
 20. See Dessemontet, 'Copyright and Human Rights', in J. Kabel and G. Mom, *Intellectual Property and Information Law: Essays in Honour of Herman Cohen Jehoram*, Kluwer Law International (1998), Volume 6, Information Law Series, 113–120.
 21. *Société Roy Export Company Establishment et Charlie Chaplin c/. Société Les Films Roger Richebé*, 28 (1960) RIDA 133 and [1960] *Journal du Droit International* 128, annotated by Goldman.
 22. *Tribunal de Grande Instance de Paris*, judgment dated 23 November 1988, 139 (1989) RIDA 205, annotated by Sirinelli and (1989) *Journal du Droit International* 1005, annotated by Edelman.

of a Treaty and that as such it can impose legally binding obligations to implement its provisions on States that became contracting parties to it. Article 15 of the Covenant is very clear in this respect and imposes a number of responsibilities and steps to be taken on Contracting States in the following way:

- (2) The steps to be taken by the States Parties to the present Covenant to achieve the full realization of this right shall include those necessary for the conservation, development and the diffusion of science and culture. (3) The States Parties to the present Covenant undertake to respect the freedom indispensable for scientific research and creative activity. (4) The States Parties to the Present Covenant recognize the benefits to be derived from the encouragement and development of international contacts and cooperation in the scientific and cultural fields.

These obligations apply to the substantive rights granted in paragraph one of Article 15 of the Covenant and which are very much based on Article 27 of the Universal Declaration of Human Rights. As such they comprise the rights of everyone (a) to take part in cultural life; (b) to enjoy the benefits of scientific progress and its applications and, most importantly for our current purposes; and (c) to benefit from the protection of the moral and the material interests resulting from any scientific, literary or artistic production of which he is the author. However, this provision no doubt gains in importance in the light of the absence in the Covenant of a provision dealing with property, which at the time of the Universal Declaration was still seen as clearly the stronger and more obvious Human Right which could also cover most of the intellectual property issues.

If we look in a bit more detail at the substantive provision contained in Article 15.1(c) of the Covenant the clear starting point is that an obligation is imposed upon the Contracting Parties to protect the moral and material interests of authors and creators.²³ In essence there is therefore an obligation to implement copyright as a Human Right and to put in place an appropriate regime of protection for the interests of authors and creators.²⁴ But a lot of freedom is left to Contracting States in relation to the exact legal format of that protection. The human rights framework in which copyright is placed does however put in place a number of imperative guidelines:

- Copyright must be consistent with the understanding of human dignity in the various human rights instruments and the norms defined therein.
- Copyrights related to science must promote scientific progress and access to its benefits.
- Copyright regimes must respect the freedom indispensable for scientific research and creative activity.

23. Chapman, 'A Human Rights Perspective on Intellectual Property, Scientific Progress, and Access to the Benefits of Science', WIPO Panel Discussion on Intellectual Property and Human Rights (8 November 1998), at 15, available at <www.wipo.org>, (last accessed 23 April 2008).

24. See also A. Bertrand, *Le droit d'auteur et les droits voisins*, Dalloz (2nd ed., 1999), at 81.

- Copyright regimes must encourage the development of international contacts and cooperation in the scientific and cultural fields.²⁵

In looking at this framework it should not be forgotten that its genesis was troubled and cumbersome. Various proposals were made to include intellectual property rights in the Covenant, all of them attracted severe criticism and some were rejected. However, whenever a draft Covenant without an intellectual property rights clause in it was submitted for further discussion a new proposal to include intellectual property rights was tabled and in the end the incorporation into the International Covenant on Economic, Social and Cultural Rights of an intellectual property clause was approved by a vote of thirty-nine to nine, with twenty-four Member States abstaining.²⁶ The Covenant then came into force several years later on 3 January 1976.²⁷

It is of course interesting to look back at these instruments that enshrine copyright as a Human Right and the way in which they came into being, especially as the copyright community all too often simply ignores this aspect of copyright. However, one should not look at this simply as a historical accident. One should also try to identify its implications for copyright and the conclusions that should be drawn from it. The first thing to note is that copyright has a relatively weak claim to human rights status, as its inclusion in the international human rights instruments proved to be highly controversial. And in the end the copyright and intellectual property components of the various articles were only included because they were seen as tools to give effect to and to protect other stronger human rights. The second conclusion flows from this first one. The various elements in the Articles dealing with copyright and intellectual property are interrelated, which means for example that the rights of authors and creators must be understood as essential preconditions for cultural freedom and for the participation and access to the benefits of scientific progress. The fact that the rights of authors and creators can also stand in their own right is instead an ancillary point. The third point takes this interaction one step further. Copyright and intellectual property rights are not simply preconditions. Not only do they need to exist to facilitate cultural participation and access to the benefits of scientific progress, they should also make sure that the other components of the relevant articles in the international human rights instruments are respected and promoted. In this sense the rights of authors and creators should not only enable, but also facilitate rather than constrain cultural participation and access to scientific progress. A fourth implication of all

25. Chapman, 'A Human Rights Perspective on Intellectual Property, Scientific Progress, and Access to the Benefits of Science', WIPO Panel Discussion on Intellectual Property and Human Rights (8 November 1998), at 13, available at <www.wipo.org>, (last accessed 23 April 2008).

26. M. Green, 'Background Paper on the Drafting History of Article 15(1)(c) of the International Covenant on Economic, Social and Cultural Rights', submitted for the Day of General Discussion on Article 15(1) of the Covenant, 9 October 2000, E/C.12/2000/15, at 8–12.

27. The International Covenant on Economic, Social and Cultural Rights, 993 U.N.T.S. 3, G.A. Res. 2200 (XXI), 21 U.N. GAOR Supp. (No.16), 49, U.N. Doc. A/6316 (1966), was adopted on 16 December 1966.

this is that the international human rights instruments deal with copyright and intellectual property rights as such.²⁸ They do not delineate the scope and the limits of copyright. The determination of the substance of copyright is an issue that is left to the legislature.²⁹

Perhaps it is worth adding at this stage that one can only talk in terms of a Human Right when the pre-normative state of a claim has been turned into a normative state that is recognized by the social group concerned. Additionally the norm must fit the existing normative order in a coherent way, it must be considered to represent a basic freedom, that is, an essential social condition for the better development of the individual, and finally it must be perceived as being of universal reach.³⁰ Broadly speaking copyright seems to meet these requirements and its inclusion in the international human rights instruments seems justifiable on that basis, but it remains to be seen how all these elements really fit together in practice in relation to copyright.

The common theme that seems to emerge and an understanding of which seems to be essential to understand how copyright operates as a Human Right is that of the balancing of rights and interests. Two kinds of balancing act appear to be necessary. The first one relates to the balance that is inherent to copyright itself and that involves both the private interests of authors and creators and the wider public interests of society as a whole.³¹ We will now briefly look at other intellectual property rights and we will then turn our attention to this particular balancing act. But on top of that one has to acknowledge that copyright as a Human Right is just one element in the international human rights instruments. Surely copyright as a Human Right will also have to be seen in relation with other human rights. Here again a balancing of rights, albeit of a different nature, will be unavoidable, and we will deal with this at a later stage.

III. OTHER INTELLECTUAL PROPERTY RIGHTS

Article 27 of the Universal Declaration of Human Rights gives one a right to the protection of the moral and material interests also from the scientific production of which he is the author. Similarly, Article 15 of the International Covenant refers to science on top of culture. There is of course no reason to exclude scientific works from the scope of copyright, especially as Article 2(1) of the Berne Convention 1886 specifically includes scientific works in the scope of copyright. It is nevertheless arguable that the wording of the human rights instruments is broader and goes beyond the field of copyright. From an intellectual property perspective the field covered traditionally by patent law could also be involved. The link is much

28. Chapman, 'Approaching Intellectual Property as a Human Right (obligations related to Article 15(1)(c))', XXXV (2001) Copyright Bulletin, No. 3, 4–36, at 13.

29. See H. Schack, *Urheber- und Urhebervertragsrecht*, Mohr Siebeck (1997), at 40.

30. Vivant, 'Le droit d'auteur, un droit de l'homme?', 174 RIDA (1997) 60, at 73.

31. See J.A.L. Sterling, *World Copyright Law*, Sweet & Maxwell (1998), 40.

weaker though and apart from a broad statement that the interests of an inventor should be protected there is very little guidance to be derived from these provisions for the exact scope and content of patent law. Trade marks, as the third major intellectual property right, seem to be entirely unaffected.

More interesting in this respect is the link to human rights through the property provisions in the European Convention. It should in this respect be kept in mind that property was also seen as a key element in the Universal Declaration of Human Rights, but that it had shrunk away when the International Covenant came along. Article 1 of the first Protocol to the European Convention of Human Rights is the key provision on this point. Its role in relation to intellectual property rights was examined carefully by the Grand Chamber of the European Court of Human Rights in *Anheuser-Busch v. Portugal*.³² Anheuser-Busch had applied to register its 'Budweiser' trade mark in Portugal. This was opposed by their rivals Budejovicky Budvar, who relied on a bilateral treaty between Portugal and the Czech Republic protecting geographical indications. The Portuguese Supreme Court eventually ruled in favour of Budejovicky Budvar. Anheuser-Busch argued that they had acquired a property right through their application and that the retrospective application of the bilateral treaty interfered with their property right in a way that is prohibited by Article 1 of the first Protocol.

For our current purposes it is important to note that the European Court of Human Rights accepts that property or the concept of 'possession' in Article 1 of the first protocol is no limited to material property and can also include immaterial property such as intellectual property rights. In relation to patents the Court referred to its judgment in *British-American Tobacco Company v. Netherlands*.³³ In relation to copyright reference was made to the judgment in *Melnitchouk v. Ukraine*³⁴ and the Court then applied the same logic to trade marks in the case at issue.³⁵ Slightly more controversial was the issue whether a mere application for an intellectual property right could also come within the scope of Article 1 of the first protocol. The Court argues that economic interests flow from the mere application, despite the fact that it is at best provisional and that a successful opposition can annul any interest. But under Portuguese law, a mere application makes licences and transfers of rights possible, as well as infringement proceedings. Despite the fact that it remains precarious and dependent on the eventual success of the registration this is in the view of the Court sufficient to bring the mere application also within the scope of Article 1 of the first protocol.³⁶

The next step was then to examine whether the actions of the Portuguese State, effectively the judgment of the Portuguese Supreme Court, amounted to the kind of

32. *Anheuser-Busch v. Portugal*, Case 73049/01, judgment of 11 January 2007, European Court of Human Rights.

33. *British-American Tobacco Company v. Netherlands*, judgment of 20 November 1995, A Series No. 331.

34. *Melnitchouk v. Ukraine*, Case 28743/03, judgment of 5 July 2005, CEDH 2005-IX.

35. *Anheuser-Busch v. Portugal*, Case 73049/01, judgment of 11 January 2007, European Court of Human Rights, at paragraph 72.

36. *Ibid*; at paragraph 78.

interference with property that Article 1 of the first protocol rules out. The Court came to the conclusion that it did not, as the judgment of the Supreme Court was based in law and had nothing arbitrary or manifestly unreasonable in it. There was therefore no interference with the property right in the sense required by Article 1 of the first protocol.³⁷ As a result, Anheuser-Busch was unsuccessful in the end.

Interesting as the case may be on its facts, it adds little to the debate for our current purposes. On the positive side we learn that intellectual property is also for human rights purposes a form of property and that as such the human rights instruments will grant it some form of protection. That also seems to apply to applications to register intellectual property rights. On the negative side, we learn little, if anything at all, about the scope of form these intellectual property rights themselves should take. The influence on the shape of substantive patent or trade mark law seems negligible. Nothing is also said about the interaction with other aspects of human rights law.

IV. BALANCING PRIVATE AND PUBLIC INTERESTS

IV.A THE NEED FOR A BALANCING ACT

As Audrey Chapman put it:

To be consistent with the full provisions of Article 15 [of the International Covenant on Economic, Social and Cultural Rights], the type and level of protection afforded under any intellectual property regime must facilitate and promote cultural participation and scientific progress and do so in a manner that will broadly benefit members of society both on an individual and collective level.³⁸

The emphasis here is on the broad public interest of society, but any level of intellectual property protection will also give rights to the individual right holder. The private interest of the author, creator and eventually of the copyright holder is an inevitable component of the equation. Somehow a balance will need to be struck between these interests, as stronger individual rights inevitably impinge on the interests of society as a whole and vice versa.³⁹ This balance between public and private interests is not an external element for copyright or indeed any other intellectual property right. On the contrary it has been internalized by copyright and it is part of its fundamental nature.⁴⁰ Copyright is therefore familiar with this

37. *Ibid.*, at paragraph 87.

38. Chapman, 'Approaching Intellectual Property as a Human Right (obligations related to Article 15(1)(c))', XXXV (2001) Copyright Bulletin, No. 3, 4–36, at 14.

39. See H. Schack, *Urheber- und Urhebervertragsrecht*, Mohr Siebeck (1997), at 41.

40. Compare in this respect the wording of Article 1, Paragraph 8, Section 8 of the Constitution of the United States of America in which Congress is vested with the power 'To promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries'.

balance of interests.⁴¹ On the one hand there is the need to protect the individual interest of the author in order to encourage further creation that results in the author being given a certain amount of exclusivity in relation to the exploitation and use of his or her work and on the other hand there is the public interest of society as a whole to have access to culture and to copyright works as a tool for progress and improvement.

The need for a balance that takes us away from granting a kind of unrestricted monopoly property right is also inherent in the wording of Article 15 of the International Covenant on Economic, Social and Cultural Rights where it requires States to make sure that everyone will be able 'to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author'. Enjoying a benefit from such protection is clearly not the same as enjoying an unrestricted monopoly property right. In practice copyright insures the balance in many ways, for example by means of limitations and exceptions to copyright infringement rules. This is an example of an attempt to strike the balance by drafting the rule in such a way that its effect in all practical cases is to achieve a proper balance between the various interests. On top of that there are also external correction mechanisms that interfere whenever the rule would not achieve the balance in a particular, that is, peculiar, set of circumstances. What we are dealing with them bears close resemblance to the abuse of rights scenario. The use of competition principles in relation to copyright can serve as a good example to clarify the concept of balancing interests in copyright.

IV.B COMPETITION PRINCIPLES AS AN EXAMPLE

IV.B.1 Principles and Justification

It would indeed be a serious error to see copyright (and other intellectual property rights), as essentially a private monopoly right, and competition law, as defender of the public interest against inappropriate behaviour, as irreconcilable opponents that fight for supremacy. Instead one should start by looking at the way in which intellectual property rights and in particular copyright fit into our modern society and how their existence can be justified.⁴² Why are these intangible property rights such as copyright created? Economists argue that if everyone would be allowed to use the results of innovative and creative activity freely, the problem of the

41. United Nations, Economic and Social Council, Commission on Human Rights, Sub-Commission on the Promotion and Protection of Human Rights, 52nd session, Item 4 of the Provisional Agenda, Economic, Social and Cultural Rights – The Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights, Report of the High Commissioner, E/CN.4/Sub/2/2001/13, at 5.

42. See in general P. Torremans, *Holyoak and Torremans Intellectual Property Law*, OUP (5th ed., 2008), 10-24.

‘free riders’⁴³ would arise.⁴⁴ No one would invest in creation or innovation, except in a couple of cases where no other solution would be available,⁴⁵ as it would give them a competitive disadvantage.⁴⁶ All competitors would just wait until someone else made the investment, as they would be able to use the results as well without investing money in creation and innovation and without taking the risks that the investment would not result in the creative or innovative breakthrough it aimed at.⁴⁷ The cost of the distribution of the knowledge is, on top of that, insignificant.⁴⁸ As a result the economy would not function adequately because we see creation and innovation as an essential element in a competitive free market economy. In this line of argument creation and innovation are required for economic growth and prosperity.⁴⁹ In this starting point one recognizes very clearly elements of public interest, that is, as the needs of society. Property rights should be created if goods and services are to be produced and used as efficiently as possible in such an economy. The perspective that they will be able to have a property right in the results of their investment will stimulate individuals and enterprises to invest in further cultural and artistic creation as well as in research and development.⁵⁰ These property rights should be granted to someone who will economically maximize profits.⁵¹ It is assumed that the creator or inventor will have been motivated by the desire to maximize profits, either by exploiting the creation or invention himself or by having it exploited by a third party, so the rights are granted to them.⁵²

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43. See R. Benko, *Protecting Intellectual Property Rights: Issues and Controversies*, American Enterprise Institute for Public Policy Research (AEI Studies 453) (1987), at 17.
 44. Inappropriability, the lack of the opportunity to become the proprietor of the results of innovative and creative activity, causes an under-allocation of resources to research activity, innovation and creation: see K. Arrow, ‘Economic Welfare and the Allocation of Resources for Invention’ in National Bureau for Economic Research, *The Rate and Direction of Inventive Activity: Economic and Social Factors*, Princeton University Press (1962), at 609–625.
 45. E.g., a case where the existing technology is completely incapable of providing any form of solution to a new technical problem that has arisen.
 46. See Ullrich, ‘The Importance of Industrial Property Law and Other Legal Measures in the Promotion of Technological Innovation’, (1989) *Industrial Property* 102, at 103.
 47. One could advance the counter-argument that inventions and creations will give the innovator an amount of lead time and that the fact that it will take imitators some time to catch up would allow the innovator to recuperate his investment during the interim period. In many cases this amount of lead time will, however, only be a short period, too short to recuperate the investment and make a profit. See also Mansfield, Schwartz and Wagner, ‘Imitation Costs and Patents: An Empirical Study’, (1981) *Ec J* 907, at 915 et seq.
 48. See R. Benko, *Protecting Intellectual Property Rights: Issues and Controversies*, American Enterprise Institute for Public Policy Research (AEI Studies 453) (1987), at 17.
 49. See R. Benko, *Protecting Intellectual Property Rights: Issues and Controversies*, American Enterprise Institute for Public Policy Research (AEI Studies 453) (1987), Ch. 4 at 15, and US Council for International Business, *A New MTN: Priorities for Intellectual Property*, (1985), at 3.
 50. Lunn, ‘The Roles of Property Rights and Market Power in Appropriating Innovative Output’, (1985) *Journal of Legal Studies* 423, at 425.
 51. Lehmann, ‘Property and Intellectual Property – Property Rights as Restrictions on Competition in Furtherance of Competition’, (1989) *IIC* 1, at 11.
 52. For an economic-philosophical approach see also Mackaay, ‘Economic and Philosophical Aspects of Intellectual Property Rights’, in M. Van Hoecke (ed.), *The Socio-Economic Role of Intellectual Property Rights*, Story-Scientia (1991), 1–30.

But how does such a legally created monopolistic exclusive property right fit in with the free market ideal of perfect competition? At first sight every form of a monopoly might seem incompatible with free competition, but we have already demonstrated that some form of property right is required to enhance economic development as competition can only play its role as market regulator if the products of human labour are protected by property rights.⁵³ In this respect the exclusive monopolistic character of the property rights is coupled with the fact that these rights are transferable. These rights are marketable; they can, for example, be sold as an individual item. It is also necessary to distinguish between various levels of economic activity as far as economic development and competition are concerned. The market mechanism is more sophisticated than the competition/monopoly dichotomy. Competitive restrictions at one level may be necessary to promote competition at another level. Three levels can be distinguished: production, consumption and innovation. Property rights in goods enhance competition on the production level, but this form of ownership restricts competition on the consumption level. One has to acquire the ownership of the goods before one is allowed to consume them and goods owned by other economic players are not directly available for one's consumption. In turn, intellectual property imposes competitive restrictions at the production level. Only the owner of the copyright in a literary work may for example produce additional copies of that work and exploit it in any other way. These restrictions benefit competition on the creation level. The availability of property rights on each level guarantees the development of competition on the next level. Property rights are a prerequisite for the normal functioning of the market mechanism.⁵⁴ Copyright and the restrictions on copying and communication to the public which it imposes are needed to enhance further creation of copyright work, which is clearly what is required and desirable from a public interest point of view. This is the only way in which copyright can in the words of the American Constitution play its public interest role 'to promote science and the useful arts'.⁵⁵

Not only does this go a long way in demonstrating that the copyright system right from its inception is influenced heavily by public interest imperatives and that the balance which it tries to achieve between the interest of the right holders and of the users-public is based on public interest considerations. Competition law is also used as a tool to regulate the use that is made of copyright in a later stage. Excesses that can not be reconciled with the justification for the existence of copyright, that is, that do not serve to achieve the public interest aims of copyright, will come to be seen as breaches of competition law. Yet again the public interest is involved, this time in regulating the use of the exclusivity

53. Lehmann, 'Property and Intellectual Property – Property Rights as Restrictions on Competition in Furtherance of Competition', (1989) IIC 1, at 12.

54. Lehmann, 'The Theory of Property Rights and the Protection of Intellectual and Industrial Property', (1985) IIC 525, at 539.

55. US Constitution, Article 1, s. 8, clause 8.

granted by copyright.⁵⁶ The *Magill*⁵⁷ and *IMS*⁵⁸ cases are good examples in this area.

IV.B.2 Magill and IMS Health

Magill was concerned with the copyright in TV listings. The broadcasters that owned the copyright refused to grant a licence to Magill, that needed it to be able to produce a comprehensive weekly TV listings magazine for the Irish market. The case shows clearly that there is nothing wrong with the copyright as such. The problem is clearly situated at the level of the use that is made of the copyright. Here again the starting point is that it is up to the right holder to decide which use to make of the right and that as such a refusal to licence does not amount to a breach of competition law. But the Court of Justice argued that a refusal might in exceptional circumstances constitute an abuse.⁵⁹ These exceptional circumstances involved the following in this case. The broadcasters' main activity is broadcasting; the TV guides market is only a secondary market for them. By refusing to provide the basic programme listing information, of which they were the only source, the broadcasters prevented the appearance of new products which they did not offer and for which there was a consumer demand. The refusal could not be justified by virtue of their normal activities. And, by denying access to the basic information which was required to make the new product, the broadcasters were effectively reserving the secondary market for weekly TV guides to themselves.

In essence, the use of copyright to block the appearance of a new product for which the copyright information is essential and to reserve a secondary market to oneself is an abuse and cannot be said to be necessary to fulfil the essential function (reward and encouragement of the author) of copyright. Here again one clearly sees the public interest input. Competition law is used to make sure that copyright is used according to its proper intention, that is, in the public interest. Any abuse of the right against the public interest, even if it would further enhance the exclusive monopoly style property right of the copyright owner by giving it full and unfettered control over the work and its use, will constitute a breach of competition law.⁶⁰

56. See P. Torremans, *Holyoak and Torremans Intellectual Property Law*, OUP (5th ed., 2008), 297-312.

57. Joined Cases C-241/91 P and C-242/91 P *Radio Telefis Eireann and Independent Television Publications Ltd v. EC Commission* [1995] ECR I-743, [1995] All ER (EC) 4161.

58. Case C-481/01 *IMS Health v. NDC Health*, pending, the Advocate General delivered his opinion on 2 October 2003, available at <<http://curia.eu.int>>, (last accessed 23 April 2008). Order of the President of the Court of Justice of 11 April 2002 in Case C-481/01 P(R); Order of the President of the Court of First Instance of 10 August 2001 in Case T-184/01 R and Order of the President of the Court of First Instance of 26 October 2001 in Case T-184/01 R both available at <<http://curia.eu.int>>, (last accessed 23 April 2008).

59. Joined Cases C-241/91 P and C-242/91 P *Radio Telefis Eireann and Independent Television Publications Ltd v. EC Commission* [1995] ECR I-743, [1995] All ER (EC) 4161, at paras 54 and 57.

60. P. Torremans, *Holyoak and Torremans Intellectual Property Law*, OUP (5th ed., 2008), 297-312.

*IMS Health*⁶¹ is the current complex follow up case. IMS Health had developed a brick structure to facilitate the collection of marketing data on the German pharmaceutical market. It owned the copyright in that brick structure and refused to grant a licence to its potential competitors. In comparison with *Magill* a number of complicating factors arise. First of all it is not entirely clear whether there is a secondary market involved at all, as IMS Health and its competitors both wished to operate on the primary market for the collection of pharmaceutical data in Germany and secondly it is also not clear whether in the circumstances the emergence of a new product would be blocked, as the competitors were only interested in copying IMS's block structure without necessarily providing the user with a different product as a result of such use. The main point in *IMS Health* is however not as much the question whether the requirements of reserving a secondary market to oneself and of blocking the emergence of a new product can be defined in a more flexible way, but rather the question whether these two requirements need to be met cumulatively or whether meeting one of them is sufficient to trigger the operation of competition law. The definitional problems really come down to defining the boundaries of the public interest on this point and the question whether the requirements apply in a cumulative manner defines when the threshold for an intervention by competition law in defence of public interest concerns is met. This latter case shows clearly that striking the balance is not a straightforward or easy task and that the facts of any new situation may require further fine-tuning of the balance.

As *Magill* and *IMS Health* show clearly, society has a strong interest to have access to information and this interest can be impeded by the private interest of the right holder to enhance its exclusive monopoly style property right by giving it full and unfettered control over the work and its use. But it is not just passive access for society as a whole that is required. Each individual member of society also must have a right of access and a right to borrow (ideas and some expression) in order to exercise its fundamental freedom to create in order in turn to be able to exercise his or her Human Right to benefit from copyright in his or her creative effort. Copyright therefore simply cannot prohibit any and all borrowings.⁶² This is another element that is to be taken into account in the fine-tuning of the balance.

IV.B.3 Not only Economic Considerations Count

Be that as it may, what is clear is that copyright has a number of built in mechanisms to balance the private and public interests.⁶³ Further complications arise

61. Case C-481/01 *IMS Health v. NDC Health*, pending, the Advocate General delivered his opinion on 2 October 2003, available at <<http://curia.eu.int>>, (last accessed 23 April 2008). Order of the President of the Court of Justice of 11 April 2002 in Case C-481/01 P(R); Order of the President of the Court of First Instance of 10 August 2001 in Case T-184/01 R and Order of the President of the Court of First Instance of 26 October 2001 in Case T-184/01 R both available at <<http://curia.eu.int>>, (last accessed 23 April 2008).

62. Dessemontet, 'Copyright and Human Rights', in J. Kabel and G. Mom, *Intellectual Property and Information Law: Essays in Honour of Herman Cohen Jehoram*, Kluwer Law International (1998), Volume 6, Information Law Series, 113–120.

63. United Nations, Economic and Social Council, Commission on Human Rights, Sub-Commission on the Promotion and Protection of Human Rights, 52nd session, Item 4 of the Provisional

though as up to now we have almost exclusively looked at economic interests at either side. This is however not the only interest involved.⁶⁴ From a human rights perspective the author or creator assumes also a lot of importance. This manifests itself in the work produced by these authors or creators being acknowledged as having an intrinsic value as an expression of human dignity and creativity.⁶⁵ In terms of copyright law this is reflected by the balance between economic and moral rights, with the latter being a recognition of the fundamental link between the work and the author or creator. Moral rights survive as rights of the author or creator even when the latter transfers the economic rights in the work, thereby preserving the fundamental link.⁶⁶ The moral rights of paternity – that being the right to be identified as author of the work – and integrity, that is, the right to object to the distortion or mutilation of the work that could affect the author's reputation,⁶⁷ operate as fundamental minimal rights that do not normally stand in the way of the normal exploitation of the work and the economic rights in it, but that allow the author to object to clearly abusive use of the work that would deny or distort his or her contribution as an expression of his or her human dignity and creativity.⁶⁸ This way a fair balance with the economic rights is provided, but this is also clearly another important aspect of the overall balancing act that is required if copyright is to operate properly as a Human Right. '[T]he question essentially is [and remains] where to strike the right balance'.⁶⁹

V. COPYRIGHT'S RELATIONSHIP WITH OTHER HUMAN RIGHTS

We already suggested above that a second part of the balancing act relates to the relationship between copyright and other human rights. Already intuitively one

Agenda, Economic, Social and Cultural Rights – The Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights, Report of the High Commissioner, E/CN.4/Sub/2/2001/13, at 5.

64. See Chapman, 'A Human Rights Perspective on Intellectual Property, Scientific Progress, and Access to the Benefits of Science', WIPO Panel Discussion on Intellectual Property and Human Rights (8 November 1998), at 2, available at <www.wipo.org>, (last accessed 23 April 2008).
65. Chapman, 'Approaching Intellectual Property as a Human Right (obligations related to Article 15(1)(c))', XXXV (2001) Copyright Bulletin, No. 3, 4–36, at 14.
66. See P. Torremans, *Holyoak and Torremans Intellectual Property Law*, OUP (5th ed., 2008), Ch. 4, 218–226.
67. As enshrined in Article 6bis of the Berne Convention.
68. See P. Torremans, *Holyoak and Torremans Intellectual Property Law*, Butterworths (3rd ed., 2001), Ch. 13, 220–228 and Torremans, 'Moral Rights in the Digital Age', in I.A. Stamatoudi and P. Torremans (eds), *Copyright in the New Digital Environment*, Sweet & Maxwell (2000), Perspectives on Intellectual Property Series, 97–114.
69. United Nations, Economic and Social Council, Commission on Human Rights, Sub-Commission on the Promotion and Protection of Human Rights, 52nd session, Item 4 of the Provisional Agenda, Economic, Social and Cultural Rights – The Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights, Report of the High Commissioner, E/CN.4/Sub/2/2001/13, at 5.

assumes that human rights must have equal value when compared to one another and that one cannot simply overrule the other. This must add yet another factor to consider when one works out the balance between public and private interests. The way we have looked at that balance up to now reflects very much the content of Article 27 of the Universal Declaration of Human Rights and Article 15 of the International Covenant on Economic, Social and Cultural Rights in both of which elements referring to the public as well as the private interest are brought together. But one needs to add to that that the balance between these interests must be struck with the primary objective of promoting and protecting human rights. That must be the overall aim of the international human rights instruments of which the clause considering copyright as a human rights forms part.⁷⁰

Article 5(1) of the International Covenant on Economic, Social and Cultural Rights backs this up from a legal point of view by stating that

[n]othing in the present Covenant may be interpreted as implying for any State, group or person any right to engage in any activity or to perform any act aimed at the destruction of any of the rights or freedoms recognized herein, or at their limitation to a greater extent than is provided for in the present Covenant.

Copyright and its balance between public and private interests must therefore put in place a regime that is consistent with the realization of all other human rights.⁷¹ The right of freedom of information and of access to information⁷² provides a good example of another fundamental Human Right that needs to be respected, but the implementation of which alongside the implementation of copyright as an exclusive right in some of that information might create problems in a number of circumstances and will therefore call for a careful balancing of all the rights and interest.⁷³ The aim must be to respect both rights to the optimal or maximum extent possible. Maybe the suggestion of the German Constitutional Court that the freedom of access to information can still be guaranteed in those cases where whoever seeks access does not get that access for free but against the payment of a fee in respect of the copyright in the information can serve as an example here. Access is guaranteed, but it is not entirely free access and on the other hand copyright is respected by means of the remuneration whilst giving up the right to refuse to grant a licence as a part of the exclusive right in the work.⁷⁴

The same kind of balance between various human rights is also found in a slightly different context when attention is turned to National Constitutions and the way in which they protect Copyright as a Human Right. Some of them such as the

70. *Ibid.*

71. Chapman, 'Approaching Intellectual Property as a Human Right (obligations related to Article 15(1)(c))', XXXV (2001) *Copyright Bulletin*, No. 3, 4–36, at 14.

72. As found for example in Article 19 of the Universal Declaration of Human Rights.

73. A. Bertrand, *Le droit d'auteur et les droits voisins*, Dalloz (2nd ed., 1999), at 81.

74. H. Schack, *Urheber- und Urhebervertragsrecht*, Mohr Siebeck (1997), at 42.

Swedish⁷⁵ and the Portuguese⁷⁶ Constitutions have a direct copyright clause, but most of them protect copyright as a Human Right by bringing aspects of it under other constitutional provisions covering other fundamental rights. The German Constitution is an example in point. The German Constitutional Court has intervened in copyright cases on many occasions despite the fact that the German Constitution does not have a copyright clause. Instead, there is a consensus in Germany that parts of copyright are covered by the property clause in the Constitution. Especially the economic rights part of copyright can be considered as immaterial property and is hence entitled to protection under the right of fundamental respect for property.⁷⁷ Moral rights on the other hand refer to the author and show a strong overlap with personality rights.⁷⁸ The latter are also specifically protected by the German Constitution.⁷⁹ These separate aspects of fundamental rights protection then have to be put together to come to an overall protection for copyright as a fundamental Human Right. This clearly does not simply amount to an adding up exercise.⁸⁰ The individual components may overlap and they protect different interest which may enter into conflict with one another when pushed to extreme heights of protection. Here too a balancing of these different fundamental rights will be required.

Exactly how this balancing works out and exactly where the balance lies depends also from case to case. The higher the level of creativity and the more important the input of the creator is, the stronger the human rights claim of copyright will be. Not all works and not all situations will give copyright the same strength in its claim to human rights status and in its balancing exercise with other human rights.⁸¹

VI. CONCLUSION

This essay set out to demonstrate that copyright really has a claim to human rights status. We have shown that there clearly is a basis for such a claim in the international human rights instruments,⁸² but it has also become clear that the

75. Chapter 2, § 19 of the Swedish Constitution of 1 January 1975.

76. Article 42 of the Portuguese Constitution of 2 April 1976.

77. H. Schack, *Urheber- und Urhebervertragsrecht*, Mohr Siebeck (1997), at 40–43.

78. See G. Schricker (ed.), *Urheberrecht: Kommentar*, Verlag C.H. Beck (2nd ed., 1999), Vor §§ 12 ff., Nos 1–13, 243–247; A. Lucas and H.J. Lucas, *Traité de la propriété littéraire et artistique*, Litec (2nd ed., 2001), at 303, § 367; Poullaud & Dulkan, ‘Droit moral et droits de la personnalité’, (1994) *Jurisclasseur Périodique G*, I, p. 3780 and *Anne Bragance c/ Michel de Grèce*, Court of Appeal Paris, judgment dated 1 February 1989, (1989) RIDA, Issue 4, 301, annotated by Sirinelli.

79. H. Schack, *Urheber- und Urhebervertragsrecht*, Mohr Siebeck (1997), at 39–40.

80. See G. Schricker (ed.), *Urheberrecht: Kommentar*, Verlag C.H. Beck (2nd ed., 1999), Vor §§ 12 ff., Nos 14–17, 247–249.

81. See Vivant, ‘Le droit d’auteur, un droit de l’homme?’, 174 RIDA (1997) 60, at 103 and 105.

82. Such a claim is confirmed in several jurisdictions, see e.g., Ethevery, ‘Derecho de autor-libertad de creacion-libertad de expression’, paper delivered at the ALAI 2007 conference in Punta del Este, to be published in the proceedings of that conference.

provisions in these instruments that could be said to be the copyright clauses do not define the substance of copyright in any detail. Instead one is left with a series of conclusions and implications for copyright and its substance as a result of its human rights status. The most important points are the balance that needs to be achieved between private and public interests and the equilibrium that needs to be achieved with other human rights.

This balancing of rights can be seen as inherently internal to copyright as a Human Right. The analogy – example of the operation of competition principles in relation to copyright that was set out above demonstrates this clearly. Instead it can also be seen in most instances as the impact of other human rights on copyright. It is with that impact or interaction in each specific case that the other contributions in this collection will deal in considerable detail.

Other intellectual property rights such as patents and trade marks are also covered by the international human rights instruments, be it only as a form of property for example under Article 1 of the first protocol to the European Convention on Human Rights. Apart from that, their position and that of intellectual property in general as a human right is far less developed. Copyright clearly stands out in this respect.

Part II

Copyright and Human Rights

Chapter 8

Copyright and Freedom of Expression in Canada

*Ysolde Gendreau**

I. INTRODUCTION

The year 2002 marked an important date in the history of Canadian constitutional law: the twentieth anniversary of the Canadian Charter of Human Rights and Freedoms. Adopted at the same time as the Canadian constitution was ‘repatriated’ from the UK parliament, the charter includes section 2(b) that guarantees freedom of expression: ‘Everyone has the following fundamental freedoms: [. . .] (b) Freedom of thought, belief, opinion and expression, including freedom of the press and other media of communication’. The relationship between copyright law and freedom of expression is an obvious one and it increasingly attracts much scholarly attention. This has indeed been the case in the neighbouring country, the US, but not in Canada. Yet, one could have expected that the richness of the discussions in that country would have been quickly borrowed in Canada in order to have a headstart on the analysis when the charter became a reality. That it did not happen is perhaps another manifestation of the traditional

* Professor, Faculty of Law, Université de Montréal. This text also been the basis of two talks given in July 2002 under the auspices of the Intellectual Property Research Institute of Australia in Melbourne and Sydney. The author wishes to thank Ms Caroline Ouellet (LL.M., U.Montreal) for her help in the research that this text required.

reluctance on the part of some Canadian copyright jurists to a *rapprochement* with US law.¹

Independently of a concern over the importation of foreign understandings, one may wonder why there has been no real homegrown analysis of the impact of the charter on copyright law in Canada. Perhaps one reason could be that the charter is very much a public law instrument. The charter has beyond doubt impacted much on several public law areas, such as constitutional law, criminal law, procedure or administrative law, and perhaps less so on private law matters, matters that include copyright law. Such a lesser impact on copyright could further be explained by the hypothesis that copyright law already incorporates freedom of expression values through its own mechanisms. There would then be less need for an open confrontation between the two sets of rules. The first part of this paper will thus examine the situation from the perspective of these private law mechanisms, that is, seek to understand how the Copyright Act internalizes freedom of expression. In the second half, one will attempt to appreciate how the charter, a public law instrument, has been affecting the relationship between copyright and freedom of expression.

II. FREEDOM OF EXPRESSION WITHIN THE COPYRIGHT ACT

Today, copyright law and freedom of expression are generally perceived as conflicting sets of values. Yet, one should not forget that the first modern copyright statutes could be perceived as elements of a certain triumph of the authors' freedom of expression over the control exerted by the stationers, in England, or through the privilege holders, in pre-Revolution France. The idea that copyright protection can act as a vehicle for freedom of expression took on an importance of its own and can be said to have reached its high point with Article 27(2) of the Universal Declaration on Human Rights:

Everyone has the right to protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

This statement is echoed in Article 15(1)(c) of the United Nations Covenant on Economic, Social and Cultural Rights:

The States Parties to the present Covenant recognize the right of everyone: [. . .] (c) To benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

In this light, copyright has become a human right equal to freedom of expression.

1. A recent example of this attitude can be found in the Federal Court of Appeal decision in *CCH Canadian Ltd v. Law Society of Upper Canada*, (2002) 18 C.P.R. (4th) 161, where the Court was obviously suspicious of the analysis of the originality concept by the US Supreme Court decision in *Feist Publications, Inc. v. Rural Telephone Service Company, Inc.*, 498 US 808 (1991).

However, if copyright can be regarded as a human right, a more contemporary understanding of that particular human right can lead one to see it as a human right for the ‘happy few’, that is, for a small group within society, authors who are thus protected, that is pitted against the rest of society at large, those to whom their works are destined. It is because of this antagonism that the copyright system can be so often challenged by free speech partisans. Yet if authors are indeed protected, one can readily observe that their protection is already in itself limited by rules whose existence owes much to concerns about the freedom of expression of third parties. It is thus possible to read the Copyright Act with ‘freedom of expression glasses’ with particular attention to the rules governing the identity of the protected work (1), ownership (2), term (3), and all the prerogatives comprised within copyright (4).

II.A IDENTITY OF THE PROTECTED WORK

Several rules operate together so as to ensure that some works—or products of intellectual activity – do not come within the scope of copyright protection. When this happens, the works or products belong to the public domain and anyone may use them free of copyright considerations.

The first of such rules, of course, is the distinction that is made between ideas and facts, on the one hand, and works or expression, on the other hand. It is a fundamental precept of copyright that has precisely evolved in order to foster the possibility for all to voice their opinions on a shared commons of ideas and facts. Closely related to that premise is the requirement of originality: not only must the work be a ‘work’ as opposed to an idea or a fact, it must also be endowed with the quality of originality. However originality is defined in a country,² it should not be forgotten that the very existence of a criterion that is meant to determine if a work is protected or not entails that some works will not meet the requirement and thus will not be protected. Part of the concern over the *sui generis* right for databases, as devised in the European directive on these productions,³ stems from the fact that it is precisely aimed at the creation of a scheme of protection for objects that would escape copyright protection.

In copyright countries, two other factors circumscribe the protection of works. The first one is the requirement of fixation: a work must be fixed in a tangible medium in order to be protected.⁴ Again, depending on how stringently one defines this notion, a greater or lesser number of works will pass the test. The current interpretation of fixation, however, makes for a very broad criterion that

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2. It is expected that the forthcoming decision of the Supreme Court of Canada in *CCH Canadian Ltd v. Law Society of Upper Canada* (see *ibid.* for the appeal decision) will settle the matter in Canadian law.
 3. Directive 96/9/EC of the European Parliament and of the Council on the legal protection of databases, 11 March 1996, *O.J.* No. L 77/20, 27 March 1996.
 4. On this issue in general, see Y.Gendreau, ‘Le critère de fixation en droit d’auteur’, (1994) 159 R.I.D.A.111.

encompasses virtually anything that is found on some medium,⁵ though it still has not come to terms with problem areas such as oral works.⁶ Copyright countries whose legislations are directly inspired by UK statutes, that is, essentially Commonwealth countries, face another hurdle: the strict division of works according to specific categories. Should it not belong to any of the defined literary, dramatic, musical, or artistic groups, a 'work' cannot be considered protected by copyright.⁷ When a work can fit in a category, the identification of that category may have an impact on the exercise of copyright in that work.⁸

All in all, it is important to remember that not all products of creativity in the literary and artistic domain obtain protection under the Copyright Act. While the preoccupation with categories in Commonwealth countries can hardly be said to stem directly from a need to ensure that some works are not protected, the other conditions can be perceived as reflections of such a policy.

II.B OWNERSHIP

It is perhaps less conventional to think of copyright ownership rules as concepts that incorporate freedom of expression values. Yet, this is particularly true in countries that distinguish ownership from authorship and wherever a legal definition of authorship is provided that differs from the traditional understanding of the author as the human creator of a work. The reason why such a link exists is that the award of ownership to someone other than the natural author determines who decides how the work is to be used. An author who is deprived of copyright ownership is being silenced in favour of someone whose judgement as to the exploitation of the work is favoured.

Canadian copyright law is rich in examples. In addition to a standard provision that grants copyright ownership in an employee's work to the employer,⁹ there is an exception to that rule in favour of employed journalists who may want to exploit their works in a context other than a newspaper, magazine, or other periodical.¹⁰

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5. This situation results from the definition of fixation in the US Copyright Act: 'A work is fixed in a tangible medium of expression when its embodiment in a copy or phonorecord . . . is *sufficiently permanent or stable to permit it to be perceived, reproduced, or otherwise communicated for a period of more than transitory duration*' 17 U.S.C. § 101 (emphasis added). See *MAI Systems Corporation v. Peak Computers Inc.*, 991 F.2d 511 (1993). The current concern over 'temporary or permanent' reproductions, as well as 'transient or incidental' ones, as found in the 2001 European directive on the information society can be traced back to this interpretation.
 6. See D. Brennan & A. Christie, 'Spoken Words and Copyright Subsistence in Anglo-American Law', (2001) 1 P.Q. 309.
 7. See *Creation Records Ltd. v. News Group Newspapers Ltd.*, (1997) E.M.L.R. 444, where the set-up for a photograph for an album jacket could not be classified under any heading.
 8. For instance, the general classification of cinematographic works as 'films' in the UK, as opposed to 'dramatic works', leads to different rules with respect to ownership, term, rights and exceptions.
 9. Copyright Act, s. 13(3).
 10. *Ibid.*

The Canadian statute, unlike the British Copyright Designs and Patents Act 1988, still retains the rule that awards copyright ownership to the person who commissions engravings, photographs, and portraits.¹¹ An examination of the case law that has spawned from this rule reveals how important are the privacy concerns of the commissioning parties in those instances.¹²

The most obvious situation is perhaps that of Crown copyright. Like the UK, Canada has a provision that grants to the Crown the copyright in material that is either prepared for it or published under its authority.¹³ Section 12 of the act thus allows for a continuing interrogation on the status of court judgments and statutory materials, for instance: to what extent can the State intervene to allow or, more importantly, prevent the dissemination of these texts? A prime example of the control over expression that copyright ownership rule can play can be found in a relatively recent attempt to expand the scope of Crown copyright. In 1997, a bill entitled 'An Act to Amend the Criminal Code and the Copyright Act (profit from authorship respecting a crime)' was introduced in Parliament.¹⁴ Its purpose was to deprive convicted criminals, who had prepared or collaborated in the creation of a work 'substantially based on the indictable offence or the circumstances of its commission', of the copyright in that work. The copyright would vest in the Crown for the entire duration that would exist for that person's work. The aim was thus to prevent the convicted person from telling his story again and, at the same time, from profiteering from crime. One can well imagine that ownership of the copyright by the Crown would mean that the work would not be published.

This latter example offers a clear case of state censorship where one person's freedom of expression is thwarted by 'nobler' ideals. Yet, the other cases of employees' works and commissioned works can also be regarded as instances of 'private' censorship that exist for business or privacy reasons.

II.C TERM OF PROTECTION

In contrast to ownership rules, term of protection is one of the classic examples of the trade-off between copyright protection and freedom of expression. At the end of a set period of time, works are no longer protected and anyone may use them as the basis of their own expression. People get used to the expectation that the works will become free of all copyright control at the end of a well-known length of time. The familiarization is shared by all and any change to the accepted rule can ignite emotionally charged debates, particularly when the term of protection is increased. Maybe because of the very real need for harmonization of term of protection, the

11. Copyright Act, s. 13(2).

12. See, in general, Y. Gendreau, 'Copyright Ownership of Photographs in Anglo-American Law', (1993) 15 E.I.P.R. 207.

13. Copyright Act, s.12.

14. Bill C-220, 36th Parl., 1st Session, 46 Eliz. II, 1997 (passed by the House of Commons: 1 October 1997).

change from 'life plus fifty' to 'life plus seventy' in 1993 in the European Union did not provoke the same furor as in 1998 in the US. The European countries were used to the 'life plus fifty' rule for quite some time: it had been introduced in the Berlin 1908 revision of the Berne Convention and become compulsory with the 1948 revision in Brussels. In contrast, US law provided for a set term of twenty-eight years upon publication renewable for another similar period until the coming into force of the Copyright Act 1976. It was only at that time that the 'life plus fifty' rule was introduced. Less than twenty-five years later, that term was extended, partly in reaction to the European move, to 'life plus seventy'. In a much shorter period of time, then, than in countries that have belonged to the Berne Union for a long time, the US term of protection changed from 'twenty-eight plus twenty-eight' to 'life plus seventy'. It is hardly surprising, in such circumstances, that the debate on the relationship between copyright and freedom of expression, as expressed through the issue of the term of protection, took on such intensity.¹⁵

Special terms of protection for particular instances reflect similar policy considerations on a smaller scale. The Phase II amendments to the Canadian Copyright Act in 1997 changed the term for posthumous publications. Whereas it used to provide for a protection of fifty years from publication, the act now has a series of rules that should gradually bring those cases in line with general rule on the term of protection.¹⁶ At the other end of the spectrum is the issue of Crown copyright, which has a term of fifty years from publication.¹⁷ One of the consequences of this rule is that a Crown copyright work that is never published never has the opportunity to fall in the public domain. When one considers the potential scope for the application of this provision, it becomes clear that Crown copyright can be exercised to silence some authors whose opinions would be judged undesirable by public authorities.

II.D COPYRIGHT PREROGATIVES

Just as not all creations are protected by copyright for eternity, not all acts that are done in relation to a work come within the scope of the copyright prerogatives. Of course, limitations on the exercise of copyright prerogatives are usually conceived in light of economic rights; but, especially in copyright countries, limitations also exist with respect to moral rights with the avowed aim to give greater freedom to third parties.

15. The *Eldred* case has marked the judicial highpoint of this debate: *Eldred v. Ashcroft*, 123 S.Ct. 769 (2003).

16. Copyright Act, s. 7. In light of the looming end of a first transitional period, pressure has been brought on the government to postpone the expiration of the protection period. It has led to the introduction of a bill to that effect which breeds similar reactions, but on a much smaller scale of course, as the 'life plus seventy' debate in the US. See 'An act to establish the Library and Archives of Canada, to amend the Copyright Act and to amend certain Acts in consequence', Bill C-36, 37th Parl., 2nd Session, 51–52 Eliz. II, 2002–2003 (1st reading: 8 May 2003).

17. *Copyright Act*, s. 12.

Exceptions to economic rights are not the only method through which the freedom of expression of others can be seen to thwart the copyright owner's rights. The very definition of the rights themselves can provide inherent containment. For instance, the performing right is always a shortened form of the 'right of public performance'. A recent Canadian example of definitional harness came with the Supreme Court decision in *Théberge v. Galerie d'art du Petit Champlain* where the right of reproduction was at stake.¹⁸ The issue was the lamination onto blank canvases of posters and greeting cards based on the plaintiff's paintings. The majority of the Court found that no reproduction took place in the process because the colours were transferred from one medium to the other and the 'originals' were left blank: no multiplication of copies took place. Since no reproduction occurred, the copyright owner could not rely on the corresponding right to seek redress for what he perceived had been an encroachment of his rights. For the dissenting judges, however, the defendant's activities did constitute reproductions because, over time, new manifestations of the work were made. The definition of the right can thus determine in a very concrete manner the extent to which third parties may include a work in their own expression.

The most direct reflection of freedom of expression concerns in the field of copyright rights is to be found, of course, in the exceptions to these rights. In a Commonwealth country like Canada, the prime example will be the fair dealing exception with its specified purposes of 'research or private study', 'criticism or review', and 'newsreporting'.¹⁹ There are also two specific exceptions that can be said to bear directly on the furtherance of free speech: one is to allow the report of a public lecture for the purposes of news reporting or news summary and the other is to allow the report of an address of a political nature given at a public meeting for similar purposes.²⁰ Both can be regarded, like many of the other exceptions, as specific applications of a general fair dealing principle just like, for instance, the exceptions concerning the public performance of music by religious, educational, fraternal, or charitable organizations in furtherance of their religious, educational or charitable objects.²¹

Compulsory licenses constitute another form of limitation on a copyright owner's rights. Indeed, their use can come in handy when it is judged impractical to request individual consent for the use of a work; but this latter form of approach is already a rationale for collective management without the element of coercion. When one goes beyond the efficiency considerations to set up a system of compulsory license, it is because the legislator wants to deny the copyright owner the possibility to refuse his consent to the use of the work. Those who want to use the work may not do so for free, but at least they need not worry about the copyright owner's whims.

18. *Théberge v. Galerie d'art du Petit Champlain*, (2002) 17 C.P.R. (4th) 161 (S.C.C.).

19. *Copyright Act*, ss. 29–29.2.

20. *Copyright Act*, s. 32.2(1)(c) & (e).

21. *Copyright Act*, s. 32.2(3).

The author's whims were very much at the forefront of the preoccupations of the Canadian legislator when moral rights, initially introduced in 1931, were revamped in the Phase I amendments of 1987. As in all copyright countries, the moral rights that are recognized are subject to important qualifications: the right to paternity can only be asserted 'when reasonable in the circumstances';²² likewise, the right of integrity is only infringed when the use of the work prejudices 'the honour or reputation of the author'.²³ These limits, which are actually part of the definition of these rights, are designed to prevent authors from exercising their rights to the fullest because 'unhindered' moral rights are perceived as instruments that can impede the free flow of works. The right of integrity, in particular, can act as a real break on the re-utilization of a protected work by third parties.

Freedom of expression concerns are perhaps most openly articulated through the exceptions to copyright. Yet one can see that they inherently shape many of the copyright rules to some extent. Nowadays, this kind of harnessing from within is perceived as insufficient, probably because it is not upfront enough. In this kind of context, a text like the Charter of Human Rights and Freedoms has the potential to be an instrument that makes freedom of expression interests more obvious in the interpretation of the Copyright Act.

III. THE CANADIAN CHARTER AND THE COPYRIGHT ACT

The question to be put is the following: to what extent does the charter change the balance that is already struck by the Copyright Act? The short answer is: not much. Copyright legislation has been around for nearly three centuries; the charter is a much more recent phenomenon and has not yet really managed to make its mark on copyright law.

One should not forget that it is not the first time that a public law rule is likely to come in conflict with copyright law. There is a fairly long history of run-ins with the regulation of obscene works.²⁴ The first Canadian Copyright Act after Confederation in 1867 excluded from protection any 'immoral, licentious, irreligious, treasonable or seditious book or any other . . . work'.²⁵ This prohibition lasted till the coming into force, in 1924, of the Copyright act that forms the basis of today's legislation. Nevertheless, the obscenity of some works has been questioned in some post-1924 court decisions. In *Pasickniack v. Dojacek*, the trial judge found a book on the interpretation of dreams obscene and thus denied it protection; on appeal, the court reversed the decision on its facts and thus accepted that the

22. *Copyright Act*, s. 14.1(1).

23. *Copyright Act*, s. 28.2(1).

24. On this topic in general, see R. G. Howell, 'Copyright and Obscenity: Should Copyright Regulate Content?', (1994) 8 I.P.J. 139.

25. *The Copyright Act, 1868*, S.C. 1868, c. 54, s. 3.

work was protected since it was not obscene.²⁶ Nearly sixty years later and five years after the adoption of the charter, another defendant raised the obscene nature of videotapes he had copied without authorization to deny accusations of infringement. The court recognized that the prohibition on the protection of obscene works had disappeared from the act; yet it found that the plaintiff could only be entitled to an injunction and to damages or other monetary compensation because the sale of the tapes was an illegal activity.²⁷ A similar defence was raised in criminal proceedings the following year to deflect the accusations, but to no avail in those circumstances.²⁸ The court did refer to the charter in that case: the 'supremacy of God', to which it alludes in its opening provision, cannot be thwarted by a freedom of expression that manifests itself through grossly immoral pornographic material that is contrary to the standards of tolerant Canadians.

While they confirm that public law rules may interfere with the application of the Copyright Act, these examples do not really lead to a fundamental challenge of the underpinnings of the statute. With the charter provision on freedom of expression, however, a potential conflict has indeed emerged over time. Two particular problem areas have become apparent in judicial proceedings: Crown copyright material (A) and fair dealing (B).

III.A CROWN COPYRIGHT MATERIAL

The advent of the charter has not led to a questioning of the existence of Crown copyright per se. In particular, one could have expected or even welcomed a debate on the relevance of Crown copyright over statutory and judicial materials where the notion of freedom of expression could shed new light on state control over these texts that are so essential to the working of a democratic justice system.²⁹ The discussion that has come the closest to this issue is one that pertains to the access to court judgments. Otherwise, one must mention a fundamental, and rather early, case on a government publication.

In *Wilson & Lafleur Ltée v. SOQUIJ*,³⁰ a private publisher of law reports was at odds with a government agency, SOQUIJ, that both collects and publishes court judgments. As far as the collecting of judgments is concerned, SOQUIJ operates in a state monopoly environment for it is the only entity which is entrusted by law to operate an activity that allows it to obtain all judgments rendered by courts in Quebec. With such 'raw materials', SOQUIJ publishes various series of law reports. A person who wishes to obtain the judgments as they were issued by

26. *Pasickniack v. Dojacek*, (1928) 2 D.L.R. 545.

27. *Aldrich v. One Stop Video Ltd.*, (1987) 17 C.P.R.(3d) 27.

28. *R. v. Ghnaim*, (1988) 28 C.P.R. (3rd) 463.

29. On this debate, see J.A.L. Sterling, 'Crown Copyright in the United Kingdom and Other Commonwealth Countries' (1996) 10 I.P.J. 157; J. Frémont, 'Normative State Information, Democracy and Crown Copyright', (1996) 11 I.P.J. 19.

30. (1998) R.J.Q. 2489.

the courts may ask for a copy and pay a charge of Canadian dollars CAD 2.00 per page. This fee applies to published as well as unpublished judgments. The publishing arm of SOQUIJ, however, gets the judgments at cost. Wilson & Lafleur claimed that the situation was discriminatory and prevented it from doing business on the same grounds as SOQUIJ the publisher. In particular, it claimed that it wanted access at cost to judgments that are being left aside by SOQUIJ and that therefore its products would not be competing with those of SOQUIJ.

The freedom of expression argument was used in the following manner. Wilson & Lafleur considers itself a member of the legal press and includes freedom of the press within freedom of expression. The high costs charged by SOQUIJ prevent it from running its business on an equal footing with what is admittedly the largest legal publisher of the province. Therefore, these costs constitute a hindrance to its freedom of expression. The Superior Court of Quebec did not respond favourably to this line of argument. It found that Wilson & Lafleur's expression was not being restrained, but rather that the publisher merely suffered economic harm. Access to judgments was not being denied since it could obtain them like any other person. SOQUIJ's pricing policy does not restrain the right to information, the freedom to gather judgments, access to courts, the freedom to talk about the functioning of the justice system, and so forth. In short, freedom of expression was being trumped up as an excuse for claims of unfair competition. It is nevertheless worth noting that it was used in a context where the subject matter that was being fought over was Crown copyright material.

More to the point – and actually the earliest case on the conflict between copyright and freedom of expression – is the Federal Court of Appeal decision in *R. v. James Lorimer & Co. Ltd.*³¹ The object of contention was a one-volume abridgement of a seven-volume report titled *Canada's Oil Monopoly* that had been prepared by the Director of Investigation and Research under the then Combines Investigation Act (the former Competition Act). According to the Copyright Act, such a text was subject to Crown copyright.³² The defendant raised three separate defences to the infringement action: fair dealing for the purposes of review; public interest; freedom of expression according to the charter.

All three defences were rejected. The Court did not find that this was a situation where the defence of fair dealing was applicable because the use of the original work was not minimal.³³ Likewise, the common law defence of public interest could not come into play because enough free copies of the report were available throughout the country; people could thus easily have access to the ideas put forth in the report.³⁴ The innovative aspect of the decision lies in the

31. (1984) 77 C.P.R. (2d) 262.

32. Copyright Act, s. 12.

33. It is often said that it is very difficult to rely on the fair dealing defence successfully. So far, there seems to be only one reported case where the defendant won on the basis of that defence: *Allen v. Toronto Star Newspapers Ltd.*, (1997) 78 C.P.R. (3d) 115.

34. Unlike UK copyright law (*Copyright, Designs and Patents Act 1988*, s. 171(3)), the public interest defence in Canada has no statutory connection. On this defence in general, see G. Davies, *Copyright and the Public Interest*, 2nd ed., London, Sweet & Maxwell, 2002, 63 et seq.

recognition that the Charter of Human Rights and Freedoms could form a defence to copyright infringement. Moreover, this seems to be the case independently of the other defences that could be available. Despite this openness towards this new type of argument in copyright litigation, the court nevertheless concludes that the charter was of no avail to the defendant in that particular instance because the abridgement contained so little of its own thoughts, beliefs, opinions, and expression. The defendant's activity had been more akin to an act of appropriation than to one of self-expression. The freedom of expression that was to be protected by the charter to the benefit of the defendant had to be *Lorimer's* expression and the mere abridgement of another's work could not warrant reliance on the charter.

The *Lorimer* decision has proved to be a lucid forerunner of the later decisions on copyright and freedom of expression according to the Canadian charter. Without stating so openly, it set the stage for the conflict between contents and form or, to put it in standard copyright parlance, between idea and expression. The charter is probably more designed to protect contents (idea) rather than form (expression); since copyright does not protect ideas, it is likely that the spheres of protection do not really clash. A second observation is that the charter argument, though independent, was made together with arguments based on the public interest defence and on the fair dealing exception. Although the public interest argument is much more difficult to put forward in Canada than in the UK, fair dealing has been the mainstay of the confrontation between copyright law and freedom of expression.

III.B FAIR DEALING

One should not expect here a plethora of decisions that finely dissect the relationship between copyright and freedom of expression. Of the five cases that refer to it, only one provides substantial reasoning. Moreover, the relatively cursory dismissal of the charter argument in the *Lorimer* case, an appeal decision, can only have had the effect of curbing what initial enthusiasm there could have been in the early years. Direct references to the charter have however been made in cases that all arose during labour disputes. They essentially revolved around corporate logos or trademarks that had been 'distorted' by the employees' unions at times of labour unrest. That a charter argument has been made in that context is maybe a reflection of the greater familiarity of labour law lawyers with this legal instrument. Only one case in this group of five is not labour-related: it dealt with a porn version of the most popular television soap opera in Quebec where the defendant tried unsuccessfully to rely on the exception of fair dealing for the purpose of criticism.³⁵ In its analysis of the exception, the Quebec Court of Appeal declared that one needed to draw a distinction between humorous imitation for criticism or comment and appropriation for commercial opportunism, having regard to 'copyright protection as well as freedom of expression'. The reference to freedom of expression is here

35. *Productions Avanti Ciné-Vidéo Inc. v. Favreau*, (1999) 1 C.P.R. (4th) 129 (Que. C.A.).

very general and even independent of the charter itself. Yet, its mere mention may be regarded as a reflection that the inroads into legal reasoning that have been made in the other cases may be starting to produce a more general effect on the analysis of fair dealing beyond the narrower context of labour disputes.³⁶

Soon after the *Lorimer* decision came two other attempts to invoke the charter protection of freedom of expression as defences to alleged infringement by the workers' union through the modification of company logos. In both instances, the argument was cursorily dismissed, though the courts paid lip service to the possibility that it could be relevant. 'While there may be situations where the guarantee of freedom of expression in para.2(b) of the Canadian Charter of Rights and Freedoms may properly limit the protection otherwise given to the owners of copyright, I do not believe this represents such a situation'.³⁷ Similarly, the charter was found inapplicable in a case where an injunction was sought to prevent the use of the parodied logo of a roast chicken restaurant chain. The court considered that the grant of the injunction would not prevent the union from informing the public about its position in the labour dispute; thus, the freedom of expression was not violated by the exercise of copyright in the logo.³⁸

Together with the *Lorimer* case, these two decisions seemed to indicate a general unwillingness to explore the reasoning required by this line of argument, an argument which forces all parties to rethink the concepts of infringement and the role that defences that are extraneous to the Copyright Act can play. Although unmentioned, one can again perceive the tension between contents and form where copyright protection and the charter might be operating on two different fields. The decisions make no reference to the fair dealing defence. Yet, they are regularly cited when the next case is discussed, most probably because of the similarity in the fact patterns.³⁹

The *Michelin*⁴⁰ case, about a parody of the Bibendum man, is indeed the most explicit decision on the conflict between copyright protection and freedom of expression as guaranteed by the charter. Thirteen years after the *Lorimer* decision, it bravely renews with an analysis that combines the freedom of expression defence with a pleading of fair dealing. Once again, the fair dealing exception is set aside: the court refuses to consider that parody can come within the notion of criticism and insists on the technical identification requirements of the statute. The analysis

36. The *Avanti* decision is but two years after the more fundamental *Michelin* case. See, *infra.*, the text accompanying n. 40.

37. *Canadian Tire Corporation Ltd. v. Retail Clerk Union, Local 518 of United Food & Commercial Workers Union*, (1985) 7 C.P.R. (3rd) 415, at 420.

38. *Rôtisseries St-Hubert Ltée v. Le Syndicat des Travailleurs(euses) de la Rôtisserie St-Hubert de Drummondville (C.S.N.)*, (1986) 17 C.P.R. (3rd) 461, at 476.

39. See D. Vaver, *Copyright Law*, Toronto, Irwin Law, 2000, 193, fn. 109; J. S. Mc Keown, *Fox on Canadian Law of Copyright and Industrial Designs*, 3rd ed., Toronto, Carswell, 2000, 585, fn. 118. One should also appreciate that the fair dealing defence has been almost ignored by litigants until the 1990s.

40. *Cie Générale des Établissements Michelin – Michelin & Cie v. C.A.W. Canada*, (1996) 71 C.P.R. (3rd) 348.

of the charter argument is handled separately as the Court wonders if the parodies are protected by the charter provision on freedom of expression. Its answer is both specific to the case and general; and the outcome is, once again, favourable to the copyright owner.

The first step in the reasoning is a property argument. The Court considers that one cannot use another's private property right (copyright protected material) to express one's self. If one does use such property, then he must demonstrate a use that is compatible with the function of that good. That function of copyright calls into question a second consideration, that is, the general purpose of copyright protection. Framed in a charter perspective, it leads to an interrogation as to the nature of copyright law along the following lines: is the object or effect of the Copyright Act to restrict freedom of expression? The answer to that question is negative because the rights that are granted by the act are justified in a free and democratic society (language that directly refers to the first article of the charter). The objectives sought by a statute like the Copyright Act are important enough to justify the suppression of a fundamental right and the means that are used to implement these objectives are in themselves reasonable and justified.

In comparison with the earlier case law, the *Michelin* decision is more explicit and articulates its reasoning according to a more usual charter language. It also avoids the contents/form discourse that underlay the conflicts as they were presented. However, the conclusion it draws with respect to the general appreciation of the Copyright Act in light of the charter seems to put a break on any further analysis of the relationship between the two sets of rights. If copyright law as a whole can withstand the pressure of the freedom of expression value that is enshrined in the charter, how can a single notion within copyright law itself, however fundamental it is, fare better? One can only expect that copyright litigants and courts will pay lip service to the charter, just as happened in the *Avanti* decision two years later.⁴¹

Indeed, the last case in this Canadian survey is already a reflection that the charter argument does not lead anywhere in a copyright analysis; it may however become more useful in 'peripheral' reasoning. During interlocutory injunction proceedings over alleged copyright infringement by a union whose web site had similar interface, logos, addresses, etc. as the plaintiff's own, a fair dealing defence was raised and met with the same result as *Michelin*.⁴² The charter right to freedom of expression was also pleaded by the union, but in a different manner than what had been done previously. The union argued that its right to freedom of expression was being limited by its inability to appropriate or get at the plaintiff's intellectual property rights. The argument was rejected in relation to copyright, but accepted with respect to passing off: the common law was not to be interpreted in a way that unreasonably infringes a person's freedom of expression. Consequently, the injunction sought by the plaintiff was not granted because, furthermore, the balance of convenience favoured the union.

41. *Production Avanti Ciné-Vidéo Inc. v. Favreau*, *supra.*, n. 35.

42. *British Columbia Automobile Association v. Office and Professional Employees' International Union, Local 378*, (2001) 10 C.P.R. (4th) 423.

IV. CONCLUSION

At the end of this exercise, it feels like being back to square one. Although there have been some attempts to come to grips with a fundamental right like freedom of expression, Canadian copyright law remains unaffected. Is this Canadian experience unique? At this point, it might be worth looking at recent developments in this area in the UK, a country that shares with Canada both constitutional and copyright roots. Moreover, despite some differences, there are interesting similarities in the way copyright law is confronted with freedom of expression in both countries. The European Convention on Human Rights was signed in 1950, but implemented in the UK only through the Human Rights Act 1998 which came into force in 2000. The Human Rights Act thus incorporates the right to freedom of expression in a statute separate from the Copyright Act and, like its Canadian counterpart, allows for this right to be overridden by other concerns.⁴³ However, that separate statute does not have in UK law the constitutional stature of the Canadian Charter of Human Rights and Freedoms. Another difference in this debate is that the public interest defence in the UK has some statutory basis in the Copyright, Designs and Patents Act 1988.⁴⁴ It is relevant in the present context because many cases that are brought to court and that pit copyright against freedom of expression combine arguments based on both fair dealing and public interest. Lastly, the UK cases often refer to breach of confidence or breach of fiduciary duty, as well as to passing off, something to which the Canadian fact patterns did not lend themselves easily.

Before the coming into force of the Human Rights Act, allusions have been made to the protection of the freedom of expression guaranteed by the European Convention on Human Rights in some major cases of copyright infringement. In both the *Spycatcher*⁴⁵ and the *Blake*⁴⁶ decisions, defences that were somewhat related to freedom of expression were of no serious avail. The situation changed, however, with the Human Rights Act since that statute had become very clearly

43. On this issue in UK law in general, see J. Griffiths, 'Copyright Law and Censorship – The Impact of the Human Rights Act 1998' in E. M. Barendt & A. Firth (eds), *The Yearbook of Copyright and Media Law 1999*, Oxford, OUP, 1999, 3; T. Pinto, 'The Influence of the European Convention on Human Rights on Intellectual Property Rights', (2002) E.I.P.R. 209; M. D. Birnhack, 'Acknowledging the Conflict between Copyright Law and Freedom of Expression under the Human Rights Act', (2003) Entertainment L. Rev. 24; C. Ryan, 'Human Rights and Intellectual Property', (2001) E.I.P.R. 521; J. Griffiths, 'Copyright in English Literature: Denying the Public Domain', (2000) E.I.P.R. 150. From a more general European perspective, see H. Cohen Jehoram, 'Freedom of Expression in Copyright Law', (1984) E.I.P.R.3; C. Caron, 'La Convention européenne des droits de l'homme et la communication des œuvres au public: une menace pour le droit d'auteur?' (1999) Com.com.électr. No. 1, 9; F. Dessemontet, 'Copyright and Human Rights' in J. J. C. Kabel & G. J. H. M. Mom (eds), *Intellectual Property and Information Law-Essays in Honour of Herman Cohen Jehoram*, The Hague, Kluwer, 1998, 113; P. B. Hugenholtz, 'Copyright and Freedom of Expression in Europe' in R. C. Dreyfuss, H. First & D. L. Zimmerman (eds), *Innovation Policy in an Information Age*, Oxford, OUP, 2000, 1.

44. See, *supra.*, n. 34.

45. *Attorney General v. Guardian Newspapers Ltd*, (1990) 1 A.C. 109.

46. *Attorney General v. Blake*, (1998) 1 Ch. 439.

part of the law of the land. So far, the high point of judicial analysis on the relationship between the freedom of expression of the Human Rights Act and copyright law has been the appeal decision in the *Ashdown* case.⁴⁷ In this case about the publication of the verbatim transcript of private meetings between high profile politicians, both the fair dealing and the public interest defences even rejected. The Court then examined the impact of the Human Rights Act on copyright law. It found that the Copyright Act already restricts rights in a necessary fashion in light of freedom of expression concerns and that conflicts will occur only in rare cases. It seems to tie freedom of expression to the public interest defence, but recognizes that it may stand alone as a factor to consider, especially when an injunction is sought. Similar general observations are made, but with an even less interventionist approach, in a subsequent case where an interim injunction was sought to restrain the publication of some confidential documents.⁴⁸ There, the fair dealing defence is immediately rejected and the consideration of the public interest defence leads to the conclusion that the end result would favour the plaintiff. The Court is also of the opinion that courts have already been taking into account freedom of expression interests well before the Human Rights Act and that this act does not change the emphasis that is to be put on that principle in the interpretation of the law.

From the foregoing, one cannot say that, in Canada as well as in the UK, the official recognition of freedom of expression has revolutionized copyright law. There is no enthusiastic embracing that has led to the revisiting of the statutes. Because of a very weak public interest defence in Canada, recourse to freedom of expression analysis is less extensive in that country than in the UK. Yet, despite the possibilities to reason in the context of special doctrines within copyright law, the courts in both countries have not hesitated to comment on the overall scheme of the copyright statutes. Given the kind of language that can be found in the latest decisions, one suspects that the high point in this debate has already been reached and that freedom of expression arguments will be relegated to last ditch marginal pleadings.

This attitude is quite different from what continues to happen in the US where references to free speech arguments continue to be made regularly.⁴⁹ How can one explain such a phenomenon? The reason may lie in the history of the relationship between copyright law and freedom of expression. The first US copyright statute dates from 1790 while the First Amendment to the Constitution, which protects free speech, came the following year. Not only have both concepts evolved along each other from their very beginnings, but both share a constitutional legitimacy which has no equivalent in Canadian and, *a fortiori*, in UK copyright law. It should take a very long time before Canadian law evolves to such a point as to close the gap between such differences.

47. *Ashdown v. Telegraph Group Ltd.*, (2001) 4 All E.R.618. See L. Joseph, 'Human Rights Versus Copyright: the Paddy Ashdown Case', (2002) Entertainment L. Rev. 72.

48. *Imutran Ltd. v. Uncaged Campaigns Ltd.*, (2001) All E.R.(D) 08.

49. See, for instance, the case about *The Wind Done Gone*, the novel based on Margaret Mitchell's *Gone With the Wind*: *Suntrust Bank v. Houghton Mifflin Co.*, 268 F. 3d 1257 (11th Cir. 2001).

Chapter 9

The Free Speech Benefits of Fair Dealing Defences

*Patrick Masiyakurima**

I. INTRODUCTION

Fair dealing defences generally respond to market failure in copyright transactions,¹ and they reconcile copyright protection with other public interests including freedom of expression by excusing unauthorized exploitation of copyright works for the purposes of criticism, review or news reporting,² research for a non-commercial purpose and private study.³ Generally, fair dealing defences may apply if a defendant's unauthorized exploitation of an infringed work falls within one or more of the recognized statutory purposes, is fair and in some instances if there is sufficient acknowledgment of the original work.⁴ Given that most cases

* University of Aberdeen. An earlier version of this article was published in P.L.C. Torremans (ed.) *Copyright and Human Rights* (Kluwer Law International, 2004). All web site references were active on 20 November 2007 and all statutes were obtained from <www.wipo.int/clea/en/index.jsp>, (last accessed 23 April 2008).

1. W. Gordon 'Fair Use as Market Failure: A Structural and Economic Analysis of the *Betamax* Case and its Predecessors' (1982) 82 *Columbia LR* 1600.
2. S. 30 of the Copyright, Designs and Patents Act, 1988 Ch. 48 (CDPA).
3. S. 29 CDPA.
4. E.g., s. 30(2) CDPA; *Pro Sieben Media AG v. Carlton UK TV Ltd* (1999) FSR 160.

relying on fair dealing defences hinge on determinations of ‘fairness’: a nebulous concept that is a matter of impression,⁵ the effectiveness of fair dealing defences is often vitiated by the uncertainties plaguing the interpretation of ‘fairness’. Apart from the evanescence of ‘fairness’, the limitations of fair dealing defences can also be traced to the hegemony of economic and privacy considerations in copyright law.

This chapter discusses the interaction of fair dealing defences and freedom of expression in the United Kingdom. Although the essay primarily focuses on United Kingdom copyright law, it relies on cases and materials from other jurisdictions for the sake of comparison. Several factors necessitate revisiting the relationship between fair dealing defences and freedom of expression. First, important recent judicial developments⁶ and the deleterious impact of the Information Society Directive⁷ on United Kingdom copyright exceptions require a re-examination of the effectiveness of fair dealing defences in the UK. Second, the *Gowers Review of Intellectual Property*⁸ proposed some fundamental reforms in this area. Third, now that the euphoria surrounding the enactment of the Human Rights Act and its impact on various laws has abated significantly, it is appropriate to reconsider the impact of this act on freedom of expression issues in copyright law. Apart from these developments, fair dealing defences are a prominent device for regulating the copyright monopoly given the uncertainties of the idea/expression dichotomy,⁹ the doctrinal uncertainties of the public interest defence¹⁰ and the generally low requirement of originality in UK copyright law.¹¹ A purposive interpretation of fair dealing defences may neutralize these shortcomings.

The relationship between copyright law and freedom of expression is well documented.¹² The pivot of most of the debates on copyright law and freedom of expression revolves around the dichotomy between copyright law’s role as an ‘engine of free speech’¹³ and its anti-dissemination effects.¹⁴ Although the

5. *Hubbard and Anor v. Vosper and Anor* (1972) 2 QB 84 (Lord Denning MR).
6. *Fraser-Woodward Ltd v. BBC* (2005) EMLR 22; *IPC Media Ltd v. News Group Newspapers Ltd* (2005) EWHC 317 and *HRH Prince of Wales v. Associated Newspapers Ltd* (2007) 3 WLR 222.
7. ‘Directive on the harmonisation of certain aspects of copyright and related rights in the information society’ OJ L 167, 22/06/2001 0010–0019.
8. <www.hm-treasury.gov.uk/media/6/E/pbr06_gowers_report_755.pdf>, (last accessed 23 April 2008).
9. E.g., *Designers Guild v. Russell Williams* (2001) FSR 113 (HL); M Spence and T Endicott, ‘Vagueness in the Scope of Copyright’ (2005) 121 *LQR* 657 but cf. *Baigent and Leigh v. Random House* (2007) EWCA Civ 247.
10. *Hyde Park Residence Ltd v. Yelland* (2001) Ch. 143 (CA) but cf. *Ashdown v. Telegraph Group Ltd* (2002) Ch. 149 (CA).
11. E.g., *Sawkins v. Hyperion Records Ltd* (2005) RPC 32 (CA).
12. E.g., J. Griffiths and U. Suthersanen (ed.) *Copyright and Free Speech: International and Comparative Perspectives* (OUP, Oxford, 2005), P Torremans (ed.), *Copyright and Human Rights* (Kluwer Law International 2004), NW Netanel, Locating Copyright within the First Amendment Skein (2001) 54 *Stanford LR* 1 and MB Nimmer, ‘Does Copyright Abridge The First Amendment Guarantees of Free Speech And Press?’ (1970) 17 *UCLA L Rev* 1180.
13. *Harper & Row, Publishers Inc. v. Nation Enterprises Inc.* 471 US 539 (1985).
14. N.W. Netanel, ‘Copyright and a Democratic Civil Society’ (1996) 106 *Yale LJ* 283.

rationales underpinning freedom of expression are far from being uncontroversial,¹⁵ this chapter generally adopts conventional justifications for freedom of expression namely, its importance in facilitating the democratic process, promoting discovery of truth and enhancing opportunities for self-actualization.¹⁶ Apart from these rationales, the chapter will also rely on an author's expressive autonomy to explain some of the decisions in this area. In terms of structure, the first part of the chapter discusses the interaction between fair dealing defences and freedom of expression and the second part considers some of the proposals for reform in this area. The term 'author' is used throughout the chapter to denote various 'creators' of copyright materials while the term 'work' is an umbrella term for various types of copyright subject matter.

II. INCENTIVES FOR CREATING SOCIALLY USEFUL EXPRESSIONS

Copyright protection may promote freedom of expression by stimulating the incentives for creating socially useful expressions. This argument is intensified by the growth in importance of ownership of valuable information and it stems from an assumption that creativity is harmed by an absence of limited statutory monopolies in nonexclusive goods.¹⁷ This philosophy is one of the cardinal justifications for intellectual property protection and it had great purchase in *Harper & Row, Publishers Inc. v. Nation Enterprises Inc.*,¹⁸ a fair use case where Justice O'Connor referred to copyright protection as an 'engine' of freedom of expression. The *quid pro quo* for the incentives granted to copyright owners is the establishment of various devices for promoting access to copyright works. For instance, copyright's limited duration may promote eventual access to unpublished works¹⁹ but its benefits are neutered by steady increases of the copyright term in many jurisdictions.²⁰ Similarly, the idea/expression dichotomy permits unauthorized exploitation of the ideas in copyright works, but its benefits are largely chimerical mainly because the distinction between ideas and expressions of ideas is unsustainable in some copyright genres.²¹ Additionally, although a low test of originality may minimize unfair competition it suffocates derivative uses of copyright works. The

15. E.g., O.M. Fiss, *The Irony of Free Speech* (Harvard UP, 1998); W. Sadurski and T. Campbell (ed.) *Freedom of Communication* (Aldershot: Dartmouth, 1994); C.R. Sunstein, *Democracy and the Problem of Free Speech* (Free Press, New York 1994).

16. E Barendt, *Freedom of Speech* 2nd ed. (OUP 2007).

17. W.M. Landes and R.A. Posner, 'An Economic Analysis of Copyright Law' (1989) 18 J of Leg Stud 325.

18. 471 US 539 (1985).

19. S Ricketson 'The Copyright Term' (1992) IIC 753, 754.

20. E.g., Term Directive 93/98 EEC; Copyright Term Extension Act, S 505 PL 105–298 11 Stat 2827 (US); *Eldred v. Ashcroft* 537 US 186 (2003).

21. P. Masiyakurima, 'The Futility of the Idea/Expression Dichotomy in UK Copyright Law' (2007) 38 IIC 548.

public interest defence suffers a similar fate. Its importance in copyright law is confined to 'rare circumstances'²² and some judges would not even recognize it as a principle of copyright law.²³ Similarly, although the test for substantial infringement may promote unauthorized access to copyright works, its utility is minimized by a desire to prevent misappropriation of copyright works.²⁴ It may, therefore, be posited that interpreting copyright exceptions including fair dealing defences restrictively reflects the importance of preserving the incentives required for creativity. The discussion in this section will reveal that although a restrictive interpretation of fair dealing defences may promote the incentives necessary for creating the ingredients of freedom of expression, an unbridled fixation with safeguarding incentives may harm access to vital information.

Generally, the narrow statutory purposes of UK fair dealing defences are designed in part to safeguard the economic benefits flowing from copyright ownership while promoting access to information necessary for freedom of expression. For instance, excluding commercial research from the ambit of fair dealing for the purpose of research and private study may be viewed as an instance of shielding the economic benefits of copyright protection from free riding while allowing private research for the purpose of self-actualization. In the same vein, excluding photographs from fair dealing for the purpose of reporting news is designed to protect the commercial value of news photographs. Arguably, using a substantial part of a photograph in a news report fundamentally robs the photograph of its newsworthiness. However, excluding photographs from fair dealing for the purpose of reporting news may dilute the vividness and accuracy of the information presented to the public.²⁵ Jacob identified the importance of news photographs in *Hyde Park v. Yelland*²⁶ when he stated that photographs may leave an indelible impression on users which words alone cannot make. Prohibiting dealings in photographs also reduces potential avenues for addressing the shortcomings of applying the idea/expression dichotomy to graphic works. Similar considerations apply to the treatment of unpublished works in fair dealing cases. Some commentators advocate strong copyright protection at the pre-publication stage owing to the need to preserve the economic advantages of copyright protection.²⁷ Nevertheless, 'reporting news' is interpreted purposively²⁸ because apart from its public benefits, it may not interfere significantly with the economic benefits of copyright ownership. Fair dealing for the purpose of criticism or review is also interpreted purposively because it may not conflict significantly with the incentives for creativity

22. *Ashdown v. Telegraph Group Ltd* (2002) Ch. 149.

23. *Hyde Park Residence Ltd v. Yelland* (2001) Ch. 143 (CA) (Aldous LJ).

24. M. Spence and T. Endicott, 'Vagueness in the Scope of Copyright' (2005) 121 LQR 657.

25. M.B. Nimmer 'Does Copyright Abridge the First Amendment Guarantees of Free Speech and Press?' (1970) 17 UCLA LR 1180.

26. (1999) RPC 655 (HC).

27. 'The Stage of Publication as a Fair Use Factor: *Harper & Row, Inc v. National Enterprises*' (1984) St John's LR 598.

28. E.g., *Pro Sieben Media AG v. Carlton UK TV Ltd* (1998) FSR 43, 50; *Newspaper Licensing Authority v. Marks & Spencer* (1999) RPC 536, 545 and *PCR Limited v. Dow Jones Telerate Ltd* (1998) FSR 170.

and may promote creation of derivative expressions. Despite its attractiveness, this fair dealing purpose constricts supplies of factual information because it does not excuse mere presentation of information without comment.²⁹

Judicial determination of ‘fairness’ is largely predicated on safeguarding copyright incentives. In *Hubbard v. Vosper*,³⁰ Lord Denning MR stated that ‘fairness’ is a matter of impression. The chief consequence of this position is that ‘fairness’ is a nebulous concept which allows judges to decide cases on their individual merits and preserve the economic benefits of copyright ownership. Various cases support this position. For instance, in *Ashdown v. Telegraph Group Ltd*³¹ and *Harper & Row v. Nation Enterprises*,³² the courts prohibited a defendant from profiting from its unauthorized reproduction of an unpublished work. Using the quantity and quality of what is taken from an infringed work³³ as a benchmark for assessing ‘fairness’ is also a vital instrument for safeguarding the incentives for creativity because it diminishes the opportunities for free-riding. This point was developed at first instance in *Newspaper Licensing Authority v. Marks & Spencer*³⁴ where it was suggested that a defendant who copies too much must obtain a licence from the copyright owner. Additionally, although freedom of expression may require copying of an entire work,³⁵ there is some force in the observation of the Supreme Court of Canada in *Regina v. James Lorimer & Co Ltd*,³⁶ when it stated that slavish copying adds little to the *corpus* of cultural expressions. A desire to minimize encroachments into a copyright owner’s incentives also explains the importance of commercial competition between the original and the infringing work to a fairness inquiry. For example, in *Associated Newspapers Group plc v. News Group Ltd*,³⁷ a court enjoined the defendant’s competing uses of the Duchess of Windsor’s letters on the basis that they harmed the plaintiff’s pecuniary interests. Similar considerations applied to the minute in *Ashdown v. Telegraph Group Ltd*,³⁸ the broadcasts in *TCN Channel Nine Pty Ltd v. Network Ten Pty Ltd*,³⁹ and the unpublished memoirs in the *Harper & Row* case.⁴⁰ In these cases, a defendant’s unauthorized use of the original work eroded the market for the original expressions. The importance of the defendant’s motives to a fairness inquiry⁴¹ is partly designed to

29. *Associated Newspapers Group plc v. News Group Ltd and Others* (1986) RPC 515.

30. (1972) 2 QB 84.

31. (2001) 4 All ER 666 (CA).

32. 471 US 539 (1985).

33. *Hubbard v. Vosper* (1972) 2 QB 84 and *Associated Newspapers Group plc v. News Group Ltd and Others* (1986) RPC 515, 517.

34. (1999) RPC 536 (HC).

35. (2001) 3 WLR 1368, 1381.

36. (1984) 1 FC 1065.

37. (1986) RPC 515, 518.

38. (2001) 4 All ER 666 (CA).

39. (2002) 118 FCR 417 also *Moorhouse v. University of New South Wales* (1975) RPC 454 and *Television New Zealand Ltd v. Newsmonitor Services Ltd* (1994) 2 NZLR 91, 108.

40. 471 US 539 (1985) also *Princeton University Press v. Michigan Document Services Inc.* 99 F 3d 1381 (6th Cir 1996).

41. *Associated Newspapers Group Plc v. News Group Newspapers Ltd* (1986) RPC 515, 518 but *cf. Hyde Park v. Yelland* (2001) 3 WLR 1172 (CA).

exclude dealings that are principally motivated by a desire to profit from the original expressions. A case based on preserving the incentives for creating some of the ingredients of freedom of expression can therefore be made in defence of the current application of fair dealing defences in the UK. In their article on the vagueness of the idea/expression dichotomy, Spence and Endicott suggested that the uncertainties plaguing some copyright exceptions may be explained on the basis that they promote voluntary transactions.⁴² This position assumes some significance given that successful fair dealing defences permit unauthorized and uncompensated uses of copyright works. However, despite the attractiveness of the importance of perceiving fair dealing defences as vehicles for promoting creativity is redolent with significant drawbacks.

The principal objection to a theory of copyright protection based on incentives is that the task of determining the incentives suitable for inducing creativity is Sisyphean and it necessitates blanket protection of categories of copyright works irrespective of their aesthetic merit. Moreover, the low test of originality in most common law jurisdictions ensures that not all copyright works add significant value to the body of available information. Even if appropriate incentives can be identified, they may be disproportional to the creative effort expended on a particular copyright work. This problem is exacerbated by the incremental nature of creativity in some literary and artistic genres. Moreover, the assumption that every author creates because of the pecuniary advantages of copyright protection is contestable. As Sir Arnold Plant observed in his vanguard article on the economics of copyright protection, 'part of the literature is written without thought of direct remuneration at all'.⁴³ The position that authors create copyright works for various purposes including the possibility of receiving some financial advantages from their creativity is generally unassailable. Even if there are symbiotic links between creativity and incentives it does not follow that copyright protection is always the right incentive. Several competing incentives including public recognition exist. The idea that copyright is an 'engine of free speech' therefore rests on untested assumptions.⁴⁴

The incentive argument is firmly rooted in harnessing the public benefits flowing from authors' creative endeavours but meaningful access to copyright expressions is generally proscribed by gradual commodification of information. For instance, the Copyright Directive's anti-circumvention provisions may render fair dealing defences otiose by proscribing access to works stored digitally.⁴⁵ Moreover, the directive's requirements of fair compensation⁴⁶ for certain dealings in copyright works flies in the face of the lowest common denominator of most copyright exceptions, namely, unauthorized and uncompensated exploitation of

42. 'Vagueness in the Scope of Copyright' (2005) 121 LQR 657.

43. A. Plant, 'The Economic Aspects of Copyright in Books' (1934) *Economica* 167, 168.

44. S. Breyer 'The Uneasy Case for Copyright: A Study of Copyright in Books, Photocopies, and Computer Programs' (1970) 84 Harv LR 281.

45. S. Dusollier, 'Exceptions and Technological Measures in the European Copyright Directive of 2001 – An Empty Promise' (2003) 34 IIC 62, 69.

46. See Arts 2(a) and (b) of the Directive.

another's copyright works. Apart from the deleterious consequences of the Copyright Directive and given that there is no litmus test for measuring 'fairness', the endemic uncertainties engulfing the requirement of fairness may chill legitimate copyright uses. As Hettinger⁴⁷ opined, the economic arguments for intellectual property protection are paradoxical largely because incentives are given to various creators to induce the creation of socially useful expressions but the public is restrained from using the resulting expressions freely. The interpretation and application of fair dealing provisions in the UK generally support Hettinger's observation and the argument that copyright has strong internal safety valves for enhancing access to cultural materials is a veneer for disguising the extent of the monopolies awarded to copyright owners.

The economics of copyright may harm freedom of expression in two distinct ways. First, given that publishing decisions are usually based on the likely profitability of a copyright work, important but financially unattractive works may not be published. In *Malcolm v. Oxford University Press*,⁴⁸ an unconventional philosophy text was rejected by the publisher because its financial viability could not be guaranteed. True, the author litigated and arranged for the work's publication but the work's dissemination was not supported by the financial and marketing muscle of a prestigious international publisher. Second, upon publication, the extensive monopolies granted to copyright owners may constrict access to vital information through high prices.⁴⁹ Owing to the relative inferiority of commercial speech⁵⁰ and the horizontal nature of the freedom of expression issues in copyright law, judges may not discern the dangers posed by publishers to the public interest.⁵¹ Ignoring the potency of 'horizontal' conflicts of rights in copyright law is generally unsustainable mainly because the state 'intervenes' in copyright law through judicial decision making and providing the legislative framework for copyright protection. Concentrated media ownership may also harm competition thereby resulting in high prices for various cultural expressions. In the context of fair dealing defences, courts may sacrifice users' freedom of expression on the altar of economic expediency. For example, the commercial importance of the *aide memoir* in *Ashdown v. Telegraph Group Ltd* trumped the importance of the minute to the prevailing political debates. Copyright law may, therefore, hinder widespread dissemination of information.

Where access to a work is possible, copyright's extensive rights may hinder derivative uses of vital expressions. True, one of the rights flowing from copyright protection is the right of reproduction⁵² but a fastidious insistence on protecting this right hinders derivative uses of copyright works. Given that creativity is generally incremental, users should be allowed to transform existing works and extend

47. E.C. Hettinger, 'Justifying Intellectual Property' (1989) 18 *Philosophy & Public Affairs* 31.

48. (1994) EMLR 17.

49. NW Netanel 'Copyright and a Democratic Civil Society' (1996) 106 *Yale LJ* 283, 292.

50. E. Barendt, *Freedom of Speech* 2nd ed. (OUP 2007).

51. R. Abel *Speech and Respect* (Sweet & Maxwell 1994) 48–58.

52. H.C. Jehoram (ed.), *Copies in Copyright* (Kluwer Law International: 2002).

existing genres. A core weakness observed by both the British Academy's review of copyright law⁵³ and the *Gowers' Review of Intellectual Property* related to UK fair dealing defences' failure to promote derivative uses of copyright works. Parodies, for instance, may require substantial exploitation of the original work if they are to be effective.⁵⁴ Prohibiting parodists from quoting generously from copyright works circumscribes literary and cultural criticism and impedes the avenues for disseminating important expressions. Equally, requiring parodists and biographers to obtain permission from copyright owners may engender accusations of collusion between copyright owners and parodists or biographers if the subsequent work is generally sympathetic to its subject. On that basis, 'the quantity and quality' basis of assessing the fairness of unauthorized uses of copyright works is paradoxical because it suggests that the more substantial the part taken for free speech purposes, the less likely it is for the dealing to be fair. The right approach to this problem was adopted in *Campbell v. Acuff-Rose*,⁵⁵ where the US Supreme Court permitted derivative uses of a popular song, and *SunTrust Bank v. Houghton Mifflin*,⁵⁶ where a critical parody of *Gone with the Wind* was held to be fair.

Criticizing copyright works aids the democratic process and discovery of the truth by facilitating the ventilation of divergent political or cultural ideas. These benefits are extended to users of varying abilities and persuasions because courts disregard the quality or appropriateness of the user's criticism.⁵⁷ On that basis, a Canadian case which suggested that comprehensive and effective criticism diminishes the prospects of successfully relying on fair dealing was wrongly decided.⁵⁸ The absence of special provisions for parodies also ignores the effectiveness of this genre as a weapon of cultural criticism. All these weaknesses are dwarfed into insignificance by the implementation of Article 5 3(d) of the Copyright Directive confining the application of the 'criticism or review' exception to works that have been 'lawfully made available to the public'. Granted that important political or cultural information may be gleaned from unauthorized exploitation of unpublished materials, Article 5 3(d) may censor the disclosure of this information. This shortcoming reveals the European Union's obsession with creating an enabling economic environment for intellectual property ownership irrespective of the harm caused to other public interests.

Evaluating the quantity and quality of what has been taken from the infringed work overlooks the possibility that copying a substantial part of a copyright work may facilitate dissemination of authentic information. An avid reliance on this factor also renders quotation of brief notes or communiqués virtually impossible. Even if the original expressions are capable of different presentation, alternative

53. British Academy, 'Copyright and research in the humanities and social sciences: A British Academy Review' <www.britac.ac.uk/reports/copyright/report.pdf>.

54. M. Spence 'Intellectual Property and the Problem of Parody' (1998) 114 LQR 594, 610.

55. *Campbell v. Acuff-Rose Music Inc.* 510 US 569 (1994).

56. 252 F 3d 1165 (11th Cir 2001).

57. *Pro Sieben Media AG v. Carlton UK Television Ltd* (1999) 1 WLR 605 (CA).

58. *Cie Générale des Établissements Michelin v. CAW-Canada* (1996) 71 CPR (3d) 348 (Fed Ct).

arrangements may dilute the poignancy or accuracy of the ideas conveyed by the original work.⁵⁹ These anomalies are exacerbated by inadequate public access to unpublished original works which may allow dishonest authors to dispute the meaning attached to their expressions.⁶⁰ Similarly, although rejecting fair dealing defences based on the availability of alternative means for expressing the words in a copyright work preserves the pecuniary advantages of copyright protection, this position ignores the importance of allowing users to choose the expressions they need for various free speech purposes. Where publication is in the public interest and accuracy is of cardinal importance, courts must give users 'reasonable latitude' in the size or quality of the selections copied for public consumption.⁶¹ Although the idea/expression dichotomy may obviate this problem by allowing users to appropriate ideas from copyright works, it is notoriously difficult to implement and its perceived benefits are largely inconsequential. Additionally, ideas and expressions of ideas may be inseparable in some informational or graphic works and it may be inefficient to express the ideas in the original work differently. Moreover, significant departures from original expressions may be actionable infringements.⁶² In *Designers Guild v. Russell William Ltd*,⁶³ the claimant's claim succeeded despite some appreciable differences between the designs in question. A purposive interpretation of fair dealing defences may, therefore, minimize the inefficiencies of the idea/expression dichotomy by permitting unauthorized exploitation of ideas and expressions of ideas from copyright works.

Courts generally prevent misappropriation of information by routinely holding that dealings with unpublished works are unfair,⁶⁴ by emphasizing the commercial nature of an infringing use and by considering the amount or quality of expressions taken from the original work. Although unfair competition issues were absent in *Hyde Park v. Yelland*, Mance LJ opined that fair dealing defences do not generally excuse misappropriation of another's copyright works. Expansive use of copyright to prevent misappropriation of a competitor's valuable expressions is problematic mainly because misappropriation is a fluid concept which may prohibit both innocent and infringing copying. Additionally, reliance on copyright law as a misappropriation tool may impede freedom of expression by potentially outlawing the benefits of imitating popular expressions⁶⁵ or allowing copyright owners to censor current or important information until it is commercially convenient for them to publish it.⁶⁶ More fundamentally, preventing misappropriation of copyright works assumes a degree of nihilism in the creative process. Given that creativity is generally incremental,⁶⁷ allowing one author to reap where he has

59. *Hyde Park v. Yelland* (1999) RPC 655 (HC), 662.

60. PN Leval, 'Toward a Fair Use Standard' (1990) 103 Harv LR 1105, 1114.

61. *Campbell v. Mirror Group Newspapers Ltd* (2003) 2 EMLR 39 (CA) 57.

62. *PCR v. Dow Jones Telerate* (1998) FSR 170.

63. (2001) FSR 113 (HL).

64. E.g., *Hyde Park Residence Ltd v. Yelland* (2000) WLR 215, 239 (Mance LJ).

65. R.C. Denicola 'Freedom to Copy' (1999) 108 Yale LJ 1661, 1680.

66. P. Goldstein, 'Copyright and the First Amendment' (1970) 70 Columbia LR 983.

67. Z. Chafee, 'Reflections on the Law of Copyright' (1945) 45 Columbia LR 503.

sown gives that author some economic value he is not responsible for creating. In any event, the nature of fair dealing defences and other copyright exceptions is that they generally interfere with the financial rewards accruing to authors because copiers do not pay royalties.⁶⁸ Although some judges recognize the importance of other public interests in copyright disputes,⁶⁹ relying on misappropriation may harm competition in the copyright sector and set financial barriers to access to information. Where a defendant profits from unauthorized access to copyright works, courts must realize that profits generated from disseminating information to the public may maintain a viable and free press.

III. SELF-ACTUALIZATION

The harmonization of copyright law in common law and civilian jurisdictions⁷⁰ notwithstanding, utilitarianism pervades most copyright doctrines in Anglo-American jurisdictions. Nevertheless, other bases for copyright protection vie for prominence.⁷¹ For instance, copyright may be viewed as a vehicle for protecting an author's personality as encapsulated in her work.⁷² There is an identifiable confluence between self-actualization and protecting an author's personality. For example, the very nature of creativity may be a manifestation of self-actualization. Despite their weaknesses in some common law jurisdictions, moral rights are the chief instrument for superintending authors' self-actualization. For example, a copyright owner's pecuniary interests may be subordinated to the moral rights preserving the work's attribution, integrity and authenticity.⁷³ This function of copyright law may assume great significance to budding authors who may have limited avenues for disseminating and controlling their expressions. Unlike utilitarian justifications for copyright protection, 'personality' rights are principally concerned with safeguarding the interests of authors. However, extensive moral rights provisions may encumber derivative uses of copyright works thereby minimizing the avenues for disseminating important information.⁷⁴ Additionally, the self-actualization basis of moral rights protection ignores the incremental and collaborative nature of creativity.⁷⁵ Moreover, it may be argued that those who encounter the ideas in copyright works must be allowed to promote their personality interests through using or adapting common expressions.

68. P.N. Leval, 'Toward a Fair Use Standard' (1990) 103 Harv LR 1105, 1125.

69. *BBC v. BSKYB* (1992) Ch. 141, 158; *Pro Sieben Media AG v. Carlton UK Television Ltd* (1999) FSR 610.

70. J.C. Ginsburg, 'A Tale of Two Copyrights: Literary Property in Revolutionary France and America' in B. Sherman and A. Strowel (eds), *Of Authors and Origins* (OUP, 1994).

71. J. Hughes, 'The Philosophy of Intellectual Property' (1988) 77 Georgetown LJ 287.

72. A. Dietz, 'The Artist's Right of Integrity under Copyright Law – a Comparative Approach' (1994) 25 IIC 177.

73. P. Masiyakurima 'The Trouble with Moral Rights' (2005) 68 Modern LR 411.

74. P. Goldstein 'Adaptation Rights and Moral Rights in the United Kingdom, the United States and the Federal Republic of Germany' (1983) 14 IIC 43.

75. M. Woodmansee and P. Jaszi (ed.) *The Construction of Authorship* (Duke, 1994).

Additionally and irrespective of its classification, the right of publication also allows authors to disseminate works that truly capture their personality, and to determine the recipients of their speech. Apart from preserving the financial benefits of first publication, the right of publication also has some several ancillary public benefits including facilitating creativity and dissemination of carefully calibrated expressions. These advantages can be traced to *Pope v. Curl*⁷⁶ and they received great prominence in *Harper & Row v. Nation Enterprises*⁷⁷ where Justice O'Connor wrote of 'the obvious benefit to author and public alike of assuring authors the leisure to develop their ideas free from fear of expropriation'.⁷⁸ Courts are, therefore, reluctant to sanction dealings in unpublished works partly because unauthorized publication compels authors to speak when they are not ready to so. Presumably, the failure of fair dealing defences in *Ashdown v. Telegraph Group Ltd*⁷⁹ reflected the possibility that Lord Ashdown needed time and space to finalize his diaries. Although promoting authors' self-actualization has several free-speech advantages, it also has its drawbacks.

The temporary censorship arising from the right of publication may be explainable on the basis that the information would be disclosed in due course. This argument may be misplaced, however. Some works may never be published. Even if authors are minded to publish their works, publishers may decide not to publish thereby proscribing circulation of important information. In *Malcolm v. Oxford University Press*,⁸⁰ a publisher reneged on its undertaking to publish a novel text. Although the work was eventually published, its dissemination did not benefit from the economies of scale arising from publication by a large and international publisher. Delayed publication may also rob the information of its relevance to current events. It took Sir Edward Heath many years to publish his memoirs⁸¹ by which time his totemic dislike of Lady Thatcher had diminished in importance. The right of publication may also introduce an unwelcome measure of censorship into copyright law because authors may refuse to publish their works. Overprotecting the right of publication therefore elicits some opprobrium because it assumes that it is only authors who must engage in self-actualization.

The dangers arising from minimizing access to unpublished works were intensified by provisions of the Copyright Directive confining the application of fair dealing for criticism or review to published works. True, the directive did not depart meaningfully from judicial practice in this area, but its ambit is wider than the discretionary rules applied in *Hubbard v. Vosper* and other cases. The drawbacks of proscribing access to unpublished works are most felt in biographies and historical texts which often require verbatim extracts of previously unknown information. The provisions of the Copyright Directive are not supported by the

76. 2 Atk 342.

77. 471 US 539 (1985).

78. *Harper & Row, Publishers Inc. v. Nation Enterprises* 471 US 539 (1985), 555.

79. (2001) 4 All ER 666 (CA).

80. (1994) EMLR 17.

81. *Times Newspapers Ltd v. George Weidenfeld & Nicholson Ltd* (2002) FSR 29.

experiences of other copyright jurisdictions. Following the decisions in *Salinger v. Random House*⁸² and *New Era Publications International v. Carol Publishing*,⁸³ the US Congress⁸⁴ amended section 107 of the Copyright Act and explicitly allowed fair use of unpublished works. Although the public interest defence may allow exploitation of some unpublished works, its utility is diminished by the enervating doubts surrounding its provenance and scope.

Various copyright exceptions including fair dealing defences may allow users to interact with cultural expressions thereby enhancing their self-actualization. For example, fair dealing for the purpose of non-commercial research or private study⁸⁵ provides the ingredients for cultivation of knowledge, self-development and informed individual participation in a community's affairs. However, a major limitation of the research or private study exception is that it circumscribes the exploitation of valuable political and cultural information by excluding dealings with sound recordings, films and broadcasts.⁸⁶ These repositories of cultural information may yield some ingredients necessary for self-actualization. Fair dealing defences may allow users to exploit copyright works for the purpose of criticizing or reviewing the specific works, their primary ideas or their social and moral implications.⁸⁷ Apart from aiding the democratic process by facilitating dissemination of ideas, criticism also enhances self-actualization by providing users with opportunities for confronting the ideas that shape them. For example, in *Hubbard v. Vosper*,⁸⁸ the defendant's unauthorized exploitation of the plaintiff's copyright works was principally motivated by a desire to break free from the clutches of the Church of Scientology. Similarly, in *Pro Sieben Media AG v. Carlton UK Television Ltd*, a defendant was allowed to criticize the incidence and banality of 'cheque book journalism'. Additionally, Channel 4 was allowed to criticize Stanley Kubrick's *A Clockwork Orange*. Arguably, the last two examples did not involve self-actualization by the individual defendants. Instead, the media organizations concerned acted as conduits for disseminating information necessary for self-actualization. Although users may not change the information in the original work, they achieve self-actualization by utilizing canonical expressions of ideas in making their various choices. A user may also achieve self-actualization by adapting or transforming the ideas in copyright works.

82. 811 F 2d 90 (2d Cir 1987).

83. 904 F 2d 152 (2d Cir 1990).

84. Fair Use and Unpublished Works. Joint Hearing on S. 2370 and H.R. 4263, Bills To Amend Section 107 of Title 17, United States Code . . . before the Subcommittee on Patents, Copyrights, and Trademarks of the Senate Committee on the Judiciary and the Subcommittee on Courts, Intellectual Property, and the Administration of Justice of the House Committee on the Judiciary.

85. S. 29 CDPA.

86. See, Copyright Act (Canada) 1985 (c. 42), s. 27(2)(a) and Copyright Act (Australia) s. 40.

87. S. 30(1) CDPA1988; *Hubbard v. Vosper* (1972) 2 WLR 389, 394; *Time Warner Entertainments Co v. Channel Four Television plc* (1994) EMLR 1, 15.

88. (1972) 2 WLR 389.

A major shortcoming of fair dealing for research is that dealings on behalf of third parties are prohibited⁸⁹ despite their importance in advancing education, dealings on behalf of third parties are prohibited. Arguably, this approach is excusable because defendants who wish to resell copied works to third parties can obtain a licence from copyright owners.⁹⁰ However, obtaining a license may be costly owing to the market power of large collecting societies. The ineffectiveness of the research exception is compounded by the exclusion of commercial research from the statutory exceptions. Arguably, a commercial researcher should obtain a license from the copyright owner but there is no bright line between commercial and non-commercial research. As the Royal Society observed, 'non-commercial research is intrinsically difficult to define, and many research ventures or collaborations only become commercial subsequently. We believe that the limitation of fair dealing to non commercial purposes gives rise to uncertainty, is not useful and is complex to operate'.⁹¹ This is another instance of the superimposition of economic considerations over other public interests.

IV. EXPRESSIVE AUTONOMY⁹²

Fair dealing defences may promote authors' expressive autonomy. The term autonomy generally refers to self-determination, and it is closely allied with self-actualization. Nevertheless, there are subtle differences between expressive autonomy and self-actualization. Expressive autonomy considers the decision making processes involved when speaking to others and may include aspects of the right to privacy and the right not to speak. Conversely, self-actualization is primarily concerned with self-development. Generally, fair dealing defences may promote three expressive autonomy interests. First, interpreting fair dealing defences restrictively may promote an author's expressive autonomy by controlling unauthorized exploitation of an author's work. This attribute of fair dealing defences is also shared by various moral rights allowing authors to control uses made of their copyright works⁹³ and it assumes great significance where the infringed work is unpublished. Conversely, some strong fair dealing defences

89. *CCH Canadian Ltd v. Law Society of Upper Canada* (1999) 2 CPR (4th) 129 (Fed Ct); *Longman Group Ltd v. Carrington Technical Institute Board of Governors* (1991) 2 NZLR 574, *Television New Zealand Ltd v. Newsmonitor Services Ltd* (1994) 2 NZLR 91; *Sillitoe v. McGraw Hill Book Co (UK)* (1983) FSR 545; *Boudreau v. Lin* (1997) 75 CPR (3d) 1; *University of London Press v. University Tutorial Press* (1916) 2 Ch. 601.

90. *Newspaper Licensing Authority v. Marks & Spencer* (1999) RPC 536, 547; *Princeton University Press v. Michigan Document Services Inc* 99 F 3d 1381 (6th Circ 1996); *Haines v. Copyright Agency Ltd* (1982) 40 ALR 264.

91. The Royal Society, 'Keeping science open: the effects of intellectual property policy on the conduct of science' <www.royalsoc.ac.uk/displaypagedoc.asp?id=11403>, 20.

92. M. Spence, *Intellectual Property* (OUP: Clarendon Law Series 2007) 55.

93. M. Spence and L.K. Treiger-Bar-Am 'Private Control/Public Speech' in K. Ziegler, *Human Rights and Private Law: Privacy as Autonomy* (Oxford: Hart, 2006) 177.

may also promote some authors' expressive autonomy if authors desire widespread dissemination of their ideas through derivative uses of their expressions. However, authors or copyright owners are unlikely to rely on the later type of expressive autonomy because it may allow users to interfere with their copyright works. Third, a purposive interpretation of fair dealing defences may enhance the autonomy of users in that they may decide how to use prevailing cultural expressions, in furtherance of their own autonomy.

Delimiting the recipients of one's intimate personal communications may be a manifestation of expressive autonomy. Courts generally protect this interest indirectly by rejecting the fairness of dealing with unpublished works containing authors' intimate personal details.⁹⁴ For example, in *HRH Prince of Wales v. Associated Newspapers*,⁹⁵ the Prince of Wales was able to prevent widespread publication of his private journals detailing his observations of Hong Kong's handover to Chinese rule. Similarly, in *Ashdown v. Telegraph Group Ltd*,⁹⁶ the Court of Appeal refused to sanction the fairness of dealing in an unpublished *aide memoir* belonging to a leader of an opposition party. Similar considerations influenced the decision in *Commonwealth of Australia v. Fairfax*⁹⁷ where a defendant was prohibited from disclosing embarrassing state secrets. In common with other rules respecting the confidentiality of information, prohibiting interferences with personal correspondence or diaries may allow authors to express themselves candidly. Eventual publication of these candid materials may enhance public or political discourse.

Safeguarding an author's expressive autonomy may prevent important information from reaching the public. This may be the case if a copyright work is never published. The problem of access to copyright works is intensified after the author dies. Heirs may control the presentation of their ancestor's character thereby censoring disclosures of important information. Two Canadian cases reveal the negative consequences of post-mortem copyright protection. In *Michaud v. Turgeon*,⁹⁸ an heir prevented disclosures of his ancestor's sharp business practices by withdrawing the raw materials needed for writing a biography. Similarly, in *Morang v. Le Seuer*,⁹⁹ a distinguished politician's heirs nearly succeeded in barring a visceral biography minimizing their illustrious ancestor's contribution to the making of Canada. Similar results were achieved in *Salinger v. Random House*,¹⁰⁰ in which an author successfully censored a biography containing his personal correspondence. It is understandable if an author controls her expressions but the participation of heirs questions the very nature of protecting the expressive autonomy of speakers. Arguably, it is efficient to allow heirs to police uses made of

94. T. De Turris 'Copyright Protection of Privacy Interests in Unpublished Works' (1994) *Ann Survey of American Law* 277.

95. (2007) 3 WLR 222.

96. (2002) Ch. 149.

97. (1981) 55 ALJR 45.

98. (1998) 80 CPR (3d) 416.

99. (1911) 45 SCR 95.

100. 811 F 2d 90 (2d 1990).

their ancestor's works but their views may be coloured by financial considerations, privacy and inertia.¹⁰¹

Autonomy is closely allied with privacy.¹⁰² Although access to unpublished works aids freedom of expression by making new or restricted information available for public consumption, there is a possibility that some authors may genuinely desire to secure a personal zone in which they can delimit the recipients of their expressions. Authors faced with unauthorized disclosures of their intimate details may protect their privacy indirectly by suing for copyright infringement hoping that courts may rule against the fairness of dealing in unpublished works. This factor received an implicit recognition in *Hyde Park Residences Ltd v. Yelland*,¹⁰³ where the Court of Appeal prohibited dealings in unpublished photographs of Diana, Princess of Wales and her male companion. It can be argued that in that case, the court was minded to prevent media intrusion into a private residence. This concern was heightened by the media scrum surrounding the death of the Princess of Wales. Similarly, courts are anxious to prevent the fairness of dealing with works obtained in circumstances that involve a breach of a copyright owner's privacy. This concern is most relevant in cases involving unpublished materials¹⁰⁴ because the difficulties surrounding access to these works may tempt defendants to obtain them illegally or clandestinely. Arguably, in *HRH Prince of Wales v. Associated Newspapers*, the Court of Appeal rejected the application of fair dealing defences because it disapproved of using illicitly obtained private information in the mass media. Considering the manner of obtaining the infringed work also stems from a desire to prevent misappropriation of valuable information. It may also be contrary to ordinary notions of *fairness* to hold that a work obtained and used illegally was dealt with fairly. Fairness encompasses 'honesty' and 'uprightness',¹⁰⁵ and these ingredients may be conspicuously absent from the methods used to access the infringed work. Although a fair dealing defence may be vitiated by the methods used to obtain the infringed work, it must be noted that a fair dealing inquiry is primarily concerned with the treatment of expressions of ideas in the infringed work.¹⁰⁶ Introducing elastic notions of fairness into a fair dealing inquiry creates additional confusion in an area teeming with uncertainties. Relying on 'the manner of obtaining information' also amplifies the reasons for rejecting the fairness of dealing in unpublished works and may impede dissemination of information. This dangerous outcome was achieved in *Commonwealth of Australia v. John Fairfax Ltd* where the Australian Government's incompetent foreign policy in the Asia-Pacific basin was effectively censored.¹⁰⁷

101. J.L. Sax, *Playing Darts with a Rembrandt: Public and Private Rights in Cultural Treasures* (Michigan, 2001).

102. L. Zucca, *Constitutional Dilemmas: Conflicts of Fundamental Legal Rights in Europe and the USA* (OUP, 2007).

103. (2001) 3 WLR 1172 (CA).

104. *Time Warner Entertainments Company LP v. Channel Four Television Corporation plc and Anor* (1994) EMLR 1, 10; *Beloff v. Pressdram* (1973) 1 All ER 241, 263.

105. *Oxford English Dictionary* (2nd ed. 1989).

106. *Time Warner Entertainments v. Channel Four Television Corporation* above.

107. (1981) 55 ALJR 54.

The genesis of using copyright protection as a privacy tool can be traced to the interpretation of *Prince Albert v. Strange*¹⁰⁸ and common law copyright in Warren and Brandeis' seminal article on privacy.¹⁰⁹ However, several shortcomings spring from relying on copyright law to protect rights of privacy. First, copyright law may not protect privacy adequately because it sanctions disclosures of the ideas in copyright works. Arguably, the major function of copyright law in these circumstances is to minimize widespread disclosures of leaked private information through interlocutory proceedings. Second, although there are grounds for proscribing compelled speech, freedom of expression envisages a speaker's interaction with the outside world. Given that the principal goal of privacy laws is to prevent disclosures of information, privacy sits uneasily with copyright protection. This difficulty may be avoided if we perceive some of the fundamental attributes of privacy because they both give the rightholder the power to control dissemination of personal information and freedom of expression as encompassing autonomy. If that is the case, there is a common denominator between copyright and privacy. Third, there is a distortion relating to the term of protection. Apart from the provisions of some civilian jurisdictions,¹¹⁰ privacy rights generally terminate at the right holder's death. Conversely, copyright has a post-mortem term. Although an author's heirs may have legitimate interests in safeguarding their ancestor's reputation, copyright law may over protect privacy rights. Apart from these distortions, using copyright law as a tool for protecting privacy may censor disclosures of embarrassing information.¹¹¹ For instance, the Prince of Wales managed to stem widespread disclosures of his uncharitable views on Chinese politicians. Similarly, Mohammed al Fayed censored disclosures of photographic stills challenging the accuracy and honesty of his version of the events surrounding the death of Diana, Princess of Wales. This anti-dissemination effect of copyright is firmly rooted in its early links with censorship.¹¹² Additionally, where unauthorized disclosures interfere with an author's plans to publish the same materials, the exercise of copyright may delay publication of important current information.

A major problem revolves around the privacy interests of companies. Given that companies are artificial legal persons,¹¹³ they may not have strong privacy interests deserving protection by copyright laws.¹¹⁴ However, this analysis depends on the characterization of the rights protected by privacy laws. If privacy is aimed at preserving autonomous decision making,¹¹⁵ there is scope for

108. (1849) 41 ER 1171.

109. L. Brandeis and S. Warren 'The Right to Privacy' (1990) 4 Harv LR 193.

110. See E. Picard, 'The Right to Privacy in French Law' in B.S. Markesinis (ed.) *Protecting Privacy* (OUP, 1999).

111. *Commonwealth v. John Fairfax & Sons Ltd* (1981) 55 ALJR 45; *Hyde Park v. Yelland* (2000) RPC 604; *Salinger v. Random House Inc and Anor* 811 F 2d 90 (2d 1990); L.L. Weinreb 'Fair's Fair: A Comment on the Fair Use Doctrine' (1990) 103 Harv LR 1137, 1147.

112. B. Kaplan, *An Unhurried View of Copyright* (Columbia, 1967).

113. *Salomon v. Salomon* (1897) AC 22.

114. *Australian Broadcasting Corporation v. Lenah Game Meats Pty Ltd* (2002) 76 ALJR 1 para. 26.

115. S Scoglio, *Transforming Privacy: A Transpersonal Philosophy of Rights* (Praeger, 1998).

companies to control uses made of their unpublished materials. It is for this reason that companies use copyright law to shore doubtful breach of confidence claims. As Mance, L.J. observed in *Hyde Park Residence Ltd v. Yelland*, the claimant's copyright case was essentially a claim for breach of confidence. Similar sentiments were expressed by J. Ungood-Thomas in *Beloff v. Pressdram Ltd*.¹¹⁶ True, the information in those cases had been disclosed but claimants who use copyright to maintain confidences may be anxious to withdraw damaging information from widespread circulation. Copyright may therefore be used to censor disclosures of personally embarrassing or important secrets. For example, in *Distillers Co (Biochemicals) Ltd v. Times Newspapers Ltd* *Distillers*,¹¹⁷ a company successfully relied on copyright to gag dissemination of information exposing the dangers of *thalidomide*. Using copyright as a censorship tool is not always successful. In *Hubbard v. Vosper*¹¹⁸ the claimant failed to suppress publication of information exposing some contentious aspects of Scientology. A similar result was reached in the *Lion Laboratories v. Evans*.¹¹⁹ Relying on copyright law to prosecute breach of confidence claims blurs the distinction between copyright law and breach of confidence claims and may result in an unprincipled development of copyright law.

Arguably, there is no need to rely on copyright law to vindicate privacy interests given judicial expansion of the parameters of breach of confidence claims.¹²⁰ However, a claim for breach of confidence retains some advantages in several circumstances. Claimants may rely on copyright law to avoid the application of strong public interest defences in breach of confidence claims.¹²¹ Arguably, this consideration informed the claimants' course of action in *HRH Prince of Wales v. Associated Newspapers Ltd* and *Ashdown v. Telegraph Group Ltd* in which the claimants avoided disclosures of information in the public interest. Additionally, a claimant may fail to prove a third party's knowledge of the confidentiality of information contained in the infringed work.¹²² However, these attempts are not universally successful. In *Lion Laboratories v. Evans*¹²³ an attempt to suppress publication of information casting severe doubt on the accuracy of breathalyzers was unsuccessful. Although, copyright claims retain some advantages in this area owing to the systemic weaknesses of most copyright exceptions. Using copyright to maintain confidences censors disclosures of important information, restrict public access to current information for an unduly long time and proscribes access to crucial unknown information.

116. (1973) 1 All ER 241.

117. (1975) QB 61. The case was also decided on other grounds which are not discussed here. See also *Rosemont Enterprises Inc v. Random House Inc* 366 F 2d 303 (2d 1966).

118. (1972) 2 WLR 389 (CA).

119. (1985) QB 526.

120. G. Phillipson and H. Fenwick, 'Breach of Confidence as a Privacy Remedy in the Human Rights Act Era' (2000) 63 Modern LR 660.

121. (2000) 3 WLR 215, 238–239.

122. *PCR Limited v. Dow Jones Telerate Ltd* (1998) FSR 170, 180.

123. (1985) QB 526.

V. CONCLUSION

The preceding discussion explored the relationship between fair dealing defences and freedom of expression in the UK. The importance of safeguarding the pecuniary advantages arising from copyright ownership is usually superimposed over other public interests and in common with other copyright exceptions, fair dealing defences do not necessarily ameliorate conflicts between copyright and freedom of expression. True, there are aberrations from that norm but the free speech advantages of fair dealing defences are of marginal importance to copyright exploitation. The shortcomings of fair dealing defences were exacerbated by the limitations of the Copyright Directive. This section explores some of the measures for reform that have been mooted in this area. The major argument advanced in this section is that unless there is a purposive interpretation of copyright laws, various proposals for reform are likely to fail.

The fashionable reaction to the decision in *Ashdown v. Telegraph Group Ltd* was to call for an independent free speech defence to claims for copyright infringement.¹²⁴ These calls were not limited to the UK and they also received attention in the US.¹²⁵ In both the US¹²⁶ and Canada,¹²⁷ for instance courts prevent misappropriation of information by relying heavily on copyright's internal balancing processes when resolving fair use cases. Promoting a separate freedom of expression defence to copyright infringement is designed to obviate the systemic weaknesses of the internal tools for balancing copyright ownership with other public interests. This argument has considerable force because an independent freedom of expression defence to copyright infringement may mitigate the deleterious effects of the Copyright Directive on the purposes of fair dealing¹²⁸ and minimize the technical difficulties arising from allocating various copyright uses to the recognized statutory exceptions. A specific free speech defence to copyright infringement also has the added advantage of allowing courts to determine freedom of expression issues outside the constraints of weak copyright doctrines.

However, the benefits of a separate freedom of expression defence to copyright infringement are generally illusory. There is a questionable assumption that courts may interpret the new defence purposively. Arguably, fair dealing defence cases involving freedom of expression issues fail not because of judicial unawareness of the importance of freedom of expression issues in copyright law. Rather, economic considerations are allowed to prevail over other public interests

124. J. Griffiths 'Copyright Law after Ashdown – time to deal fairly with the public' (2002) 3 IPQ 240; M.D. Birnhack 'Acknowledging the Conflict Between Copyright Law and Freedom of Expression Under the Human Rights Act' (2003) Ent LR 24.

125. N.W. Netanel, 'Locating Copyright within the First Amendment Skein' (2001) 54 Stanford LR 1.

126. *Harper & Row v. Nation Enterprises*, 471 US 539 (1985); *Eldred v. Ashcroft* 537 US 186 (2003).

127. *Cie Générale des Établissements Michelin v. CAW-Canada* (1996) 71 CPR (3d) 348 (Fed Ct; *R v. James Lorimer & Co Ltd* (1984) 1 FC 1065.

128. For instance, users may rely on the new defence to circumvent Art. 5 3(d) of the Copyright Directive which states that criticism or review should be limited to published works.

including freedom of expression. Additionally, in most instances, existing fair dealing purposes and the public interest defence may cover the ground covered by any proposed freedom of expression defence to copyright infringement. In any event, there is an assumption that where rights of freedom of expression conflict with an author or owner's rights, freedom of expression must prevail. Freedom of expression is not absolute and it has to be balanced with other fundamental rights including the rights to private property and privacy. This line of argument found favour with the courts in the *Ashdown* and *Prince of Wales* cases where the Court of Appeal balanced the right to freedom of expression with other fundamental rights. Whether the balancing exercise in those cases was correct is another matter. A new freedom of expression defence to copyright infringement is therefore likely to be a triumph of hope over experience given the growing economic importance of copyright ownership and prevailing judicial attitudes to unauthorized exploitation of copyright works. The same objections apply to adopting the broad fair use provisions in American copyright law.¹²⁹ The presence of those elastic provisions has not prevented the phalanx of disputes surrounding their interpretation.

Given the serious distortions arising from using copyright law to protect the right of privacy, judges must police the intersection between copyright and privacy carefully. True, it can be argued that the right of privacy and the personality justifications for copyright protection are closely allied in that they protect the dignitary interests of authors but eliding copyright and privacy is fraught with serious difficulties including duration and scope of protection. Arguably, these distortions are not a result of the inherent weaknesses of copyright or privacy doctrines. Rather, they are a manifestation of the incremental and unprincipled growth of these regimes. Nevertheless, the current fluid state of privacy and copyright doctrines generally calls for an end to a conflation of the legal regimes protecting copyright works and rights of privacy. Developments in the law relating to breach of confidence also call for a reassessment of the relationship between copyright law and the right of privacy. Claims for breach of confidence have been extended to cover privacy rights by a series of cases.¹³⁰ Given that privacy rights are usually concerned with protecting limited dissemination of information, their natural home should be a claim for breach of confidence or a privacy claim under the ECHR.

In his *Review of Intellectual Property*, Andrew Gowers recommended introducing parody, pastiche and transformative use exceptions to fair dealing defences in the UK. These recommendations were partly motivated by two closely-related factors. Firstly, there was an assumption that fair dealing defences do not protect parodies and pastiches adequately. This position is understandable given the changes in judicial attitudes to parodies in the UK and the bristling uncertainties surrounding the definition of parodies. Secondly, there was an assumption that the existing fair dealing categories did not cover transformative or derivative uses of copyright works adequately. Arguably, it would have been sufficient for the *Review* to recommend a transformative use purpose in the existing fair dealing

129. R. Burrell 'Reigning in Copyright Law: is fair use the answer' (2001) IPQ 361.

130. *Campbell v. MGN Ltd* (2004) 2 AC 457; *Douglas v. Hello* (2007) UKHL 21.

purposes. Transformative uses cover derivative uses of copyright works including parodies and pastiches. Presumably, the reason for having specific parody and pastiche exceptions was designed to achieve clarity in this area.

A fundamental question relates to the usefulness in practice of these new purposes of fair dealing defences. True, a measure of clarity may emerge from having specific exceptions covering parodies and pastiches but an old chestnut stands in the way of any new copyright exceptions. The new laws would need to be interpreted by the courts. If current judicial attitudes to misappropriation of copyright works prevail, any new copyright exceptions will be subordinated to the economics of copyright protection. It is not a shortage of appropriate categories which plagues the current treatment of fair dealing defences in the UK. Instead, it is predominantly a case of a lack of a purposive interpretation of copyright exceptions. Apart from this problem, it is difficult to understand why parodies, pastiches and transformative uses were singled out for preferential treatment. Arguably, they are important for developing artistic and literary genres and disseminating information but other public interests including the importance of safeguarding freedom of expression in copyright law vie for our attention. Similarly, the *Review* could have recommended strengthening the public interest defence in copyright law. Additionally, the *Gowers Review* did not address the exclusion of news photographs from the ambit of fair dealing for the purpose of reporting news. Apart from these problems it is notoriously difficult to define parodies and pastiches. Some authors view pastiches as a sub-species of parodies.¹³¹ All these uncertainties would diminish the utility of the proposed exceptions. The solution to the intractable difficulties in the relationship between copyright and freedom of expression does not lie in new defences or highly nuanced interpretations. Instead, what is required is an understanding that misappropriation alone does not inform the existence of copyright. This shift would give fair dealing and other copyright exceptions a genuine opportunity to secure the public interest in copyright disputes.

The most credible solution in this area involves a purposive interpretation of fair dealing and public interest defences. This approach may balance unauthorized exploitation of copyright works promoting various public interests including freedom of expression and protecting incentives for creativity. A purposive interpretation of the public interest defence may cure the current exclusion of news photographs from fair dealing for reporting news and current events. A purposive interpretation of copyright exceptions cannot confine the application of vital copyright exceptions to 'rare circumstances'. Another advantage arising from interpreting copyright exceptions purposively is that there will be less need to rely on the vagaries of 'fairness' when applying fair dealing defences to the merits of individual cases. Instead, purposive interpretation of copyright exceptions balances the various competing public interests in copyright law. The advantages of purposive interpretation of copyright exceptions notwithstanding, the likelihood of major shifts from prevailing judicial attitudes to unauthorized copyright exploitation is remote.

131. M. Spence, 'Intellectual Property and the Problem of Parody' (1998) 114 LQR 594.

There are two potential avenues for enhancing access to some of the information in unpublished works. First, access to information controlled by public organizations may be disclosed in pursuance of freedom of information laws. However, owing to privacy considerations, freedom of information laws do not apply to materials held by private individuals. Additionally, these laws do not allow access to the actual documents containing the information. This shortcoming is of some importance given the need in some cases to make verbatim extracts from copyright works to enhance efficiency and authenticity. Information held by government departments may be disclosed under the thirty-year rule on disclosure of official documents. Nevertheless, although the thirty-year rule mitigates the effects of non-disclosure of confidential information held by the government, it does not permit access to privately held information. In any event, the rule may not help a defendant who requires the information well before the expiry of the thirty-year period. Subsequent disclosure of the information may therefore limit its impact on current events. Despite the limitations of these regimes, they offer some opportunities for access to vital information.

A potential avenue for minimizing conflicts between copyright exceptions and freedom of expression is to refuse an injunction and allow continued exploitation of the expressions in the infringed work and limit the available remedies to a claim for damages. This approach was mooted in *Ashdown v. Telegraph Group Ltd.*¹³² Nevertheless, despite reducing the impact of unauthorized exploitation of a copyright work on the pecuniary advantages of copyright protection, requiring a defendant to pay damages departs from one of the cardinal features of copyright exceptions namely, unauthorized and uncompensated exploitation of copyright works. Additionally, damages may dissuade impecunious defendants from appropriating expressions from copyright works. Confining the claimant to a claim for damages for copyright infringement may also be an indirect form of compulsory licensing and assumes that in suing the defendant for copyright infringement, the claimant is principally motivated by a desire to recover her financial losses. However, as observed earlier, some claimants may rely on copyright infringement claims to vindicate their privacy rights.

Ordinarily, the use of interlocutory injunctions in civil cases reduces the risks, costs and delays associated with full-scale litigation.¹³³ However, the significant risk of error¹³⁴ arising from hasty decisions and the limited opportunities for cross-examination poses serious challenges to freedom of expression in copyright cases. Although judges may restrain the chilling effects of interlocutory injunctions by refusing to grant these remedies in cases involving freedom of expression¹³⁵ or by relying on section 12(4) of the Human Rights Act 1998, the application of these

132. *Ashdown v. Telegraph Group Ltd* (2001) 3 WLR 1368 (CA).

133. A.A.S. Zuckerman 'Interlocutory Remedies in Quest of Procedural Fairness' (1993) 56 Modern LR 325.

134. *Douglas v. Hello! Ltd* (2001) 2 WLR 992 (CA) 1019 (Brooke LJ).

135. *Hubbard v. Vosper* (1972) 2 WLR 397 but cf. *Commonwealth of Australia v. John Fairfax & Sons Ltd* (1981) 55 ALJR 45, 58.

safety valves has been largely conservative.¹³⁶ True, interlocutory injunctions are only provisional and their drawbacks may be exterminated by a subsequent trial on the merits but in many cases, these injunctions finalize the dispute between the parties.¹³⁷ It is therefore conceivable that prohibitive costs and the uncertainty of success at the trial may be used to coerce defendants to settle their claims unfavourably.¹³⁸ Settlements of this kind reduce the opportunities for a judicial delimitation of the boundaries of the public interest in copyright cases.

In their magisterial treatment of copyright exceptions, Burrell and Coleman¹³⁹ suggested that the Copyright Directive is a blueprint for reforming fair dealing defences in the UK. The perceived advantages of the directive relate to its flexibility. However, the Copyright Directive is replete with provisions suffocating dissemination of information. Following the directive would champion the superiority of economic interests in copyright law and foster a climate of limited access to information stored digitally. Perhaps, Burrell and Coleman's position stems from a realization of the limited avenues for reform in this area. Although several measures may redress the balance between maintaining the incentives for creativity and other public interests, the various proposals for reform in this area can only be meaningful if they are accompanied by changes in judicial attitudes to unauthorized exploitation of copyright works.

136. *Ashdown v. Telegraph Group Ltd* (2001) 2 All ER 370; *Imutran v. Uncaged Campaigns Ltd* (2002) FSR 2.

137. J. Leubsdorf, 'The Standard for Preliminary Injunctions' (1978) 91 Harv LR 525; *Associated Newspapers Group Plc v. News Group Ltd and Ors* (1986) RPC 515, 516.

138. *Williams v. Spautz* (1992) 174 CLR 509 (Deane J).

139. *Copyright Exceptions: The Digital Impact* (CUP, 2005).

Chapter 10

Copyright Law Reform through a Human Rights Lens

*Graeme W. Austin & Amy G. Zavidow**

I. INTRODUCTION

In this chapter, we argue that creators' human rights should inform analysis of the implications of proposals for reforming domestic copyright law. Our approach here is different from much of the recent literature on the human rights/intellectual property interface, which typically concerns the potential of human rights to constrain the seemingly inexorable expansion of intellectual property.¹ We consider

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1. UN Comm'n on Human Rights, *The Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights*, Report of the High Commissioner, UN Doc. E/CN.4/Sub.2/2001/13 (2001); UN Comm'n on Human Rights, *Globalization and Its Impact on the Full Enjoyment of Human Rights*, Report of the High Commissioner, UN Doc. E/CN.4/2002/54 (2002); M. Chon, 'Intellectual Property from Below: Copyright and Capability for Education (2007) 40 *UC Davis Law Review*, 803 [hereinafter Chon, 'IP from Below']; C. Geiger, "'Constitutionalising" Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property in the European Union' (2006) 37 *International Review of Intellectual Property and Competition Law*, 371; L. Helfer, 'Adjudicating Copyright Claims under the TRIPS Agreement: The Case for a European Human Rights Analogy' (1998) 39 *Harvard*

that project also to be critically important, especially when it involves the realization of fundamental rights, such as the right to an adequate standard of health and to life itself,² the right to freedom of expression, the right to an adequate education,³ and, more generally, the right to self-determination.⁴ When considering the relationship between human rights and intellectual property, however, is also useful to recall that there is a long tradition of suppression of creators' creative endeavours.⁵ This is also a human rights issue. The project of recognizing and protecting human rights for creators *as* creators is connected to other human rights concerns, such as freedom of expression, the ability to earn an income through work of one's choosing, personal autonomy and freedom of thought, and more general non-discrimination principles.

Our discussion proceeds as follows. First, we briefly describe the turn to human rights in intellectual property law. Creators' human rights⁶ are recognized in a variety of international human rights instruments, most prominently in the Universal Declaration of Human Rights,⁷ and the International Covenant on Economic, Cultural and Social Rights (ICESCR).⁸ While the international community's understanding of creators' human rights is still emerging, we now have the General Comment⁹ on Article 15(1)(c) of the ICESCR, which was published by the

International Law Journal, 357; L.S. Rubenstein, 'Human Rights and Fair Access to Medication' (2003) 17 *Emory Int'l Law Review* 525, 532. See also J. Waldron, 'From Authors to Copiers: Individual Rights and Social Values in Intellectual Property' (1993) 68 *Chicago Kent Law Review*, 841 (noting the civil rights issues raised by intellectual property's imposition of duties on citizens).

2. See e.g., S. Picciotto, 'Private Rights vs. Public Interests in the TRIPS Agreement: The Access to Medicines Dispute', Presentation to the Annual Conference of the American Society of International Law, Washington DC, 2-5 April 2003 <www.lancc.ac.uk/staff/lwasp/asil2003.pdf>, 3 November 2007.
3. Chon, 'IP from Below'. R. Okediji, *The International Copyright System: Limitations, Exceptions and Public Interest Considerations for Developing Countries* (2006) <www.iprsonline.org/unctadictsd/docs/Okediji_Copyright_2005.pdf>, 3 November 2007 [hereinafter R. Okediji, 'Exceptions and Public Interest'].
4. See generally B. Barclay, *Manatuturu: Maori Treasures and Intellectual Property Rights* (Auckland University Press, 2005).
5. See generally J. Greene, *The Trouble with Ownership: Literary Property and Authorial Liability in England, 1660-1730* (University of Pennsylvania Press, 2007).
6. In this chapter, we use the term 'creators' human rights' to signify the rights of authors and innovators guaranteed by international human rights instruments. We use this term in contrast with 'intellectual property rights', which are governed at international law by bespoke intellectual property treaties, such as the Berne and Paris Conventions and the TRIPS Agreement.
7. *Universal Declaration of Human Rights*, G.A. Res. 217A(III), U.N. GAOR, 3d Sess., pt. 1, Art. 27, U.N. Doc. A/810 (1948) [hereinafter *Universal Declaration of Human Rights*].
8. *International Covenant on Economic, Social and Cultural Rights*, adopted 16 December 1966, Arts 15(1)(b) & 15(1)(c), S. Exec. Doc. D, 95-2, at 18, (1977), 993 U.N.T.S. 3, 9 (entered into force 3 January 1976).
9. Committee on Economic, Social and Cultural Rights, General Comment No. 17, the right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he or she is the author (Art. 15, para. 1(c), of the Covenant), U.N. Doc. E/C.12/GC/17 (2006) [hereinafter *General Comment No. 17* or *General Comment*]. General Comments provide detailed interpretations of provisions in the Covenants

Committee on Economic, Cultural and Social Rights in 2005. General Comment 17 sheds important light on the states parties' obligations to protect creators' human rights.¹⁰ We note the concern expressed by some commentators that invoking human rights in the context of intellectual property risks bolstering the agenda of expanding intellectual property rights.¹¹ We do not engage with the wider controversies that surround the expansion of intellectual property rights, but note instead that the interpretation of creators' human rights set forth in the General Comment offers little support to an agenda of hyper-extension of intellectual property rights; nor would it allow intellectual property rights to facilitate or placate corporate greed.¹²

As the interpretation set forth in the General Comment underscores, respect for the human rights of creators does not necessarily lead to deleterious consequences for the realization of other human rights. The General Comment notes at a number of points that creators' human rights are different from the traditional conception of intellectual property rights articulated in international intellectual property instruments. The General Comment emphasizes that the right is for human authors, rather than corporations,¹³ and that the purpose of the remuneration to be derived from exploitation of intellectual property is to ensure creators an adequate standard of living. The General Comment also insists that the realization of the human right must be balanced with other rights, including rights associated with public health, education, agriculture, biodiversity, food, education and freedom of expression.¹⁴

Next, we briefly introduce three proposals for reform of domestic US copyright law that have been advanced in US copyright scholarship. There is now a voluminous literature criticizing the direction of US copyright law.¹⁵

and elaborate upon the contemporaneous meaning of the obligations therein. See Patricia C. Kuszler, 'Global Health and the Human Rights Imperative', (2007) 2 *Asian Journal of WTO & International Health Law and Policy* 99.

10. Important analysis of the human rights/intellectual property interface was also provided by the Committee on Economic, Social and Cultural Rights in its 2001 paper, 'Substantive Issues Arising in the Implementation of the International Covenant on Economic, Social and Cultural Rights, Follow-up to the day of general discussion on Art. 15.1(c), Monday 26 November 2001' (14 December 2001), E/C.12/2000/15. For the sake of brevity, this chapter focuses on the later *General Comment No. 17*, published by the same committee in 2005. See *supra* n. 9.
11. See generally R. Okediji, 'The Limits of Development Strategies at the Intersection of Intellectual Property and Human Rights', in *Intellectual Property, Trade and Development: Strategies to Optimize Economic Development in the TRIPS-Plus Era* (D. Gervais ed., 2007).
12. J. Ginsburg, 'How Copyright Got a Bad Name for Itself' (2002) 26 *Columbia Journal of Law & Arts*, 61 (noting how 'greed', manifest by both copyright owners and consumers, affects copyright markets and policy debates).
13. *General Comment No. 17*, para. 7. An issue that may require further elaboration is whether legal vehicles that individual authors select for the purpose of participating in economic life are emphatically excluded from the scope of the human rights protections.
14. See generally L. Helfer, 'Collective Management of Copyright and Human Rights: An Uneasy Alliance', in *Collective Management of Copyright and Related Rights* 85 (D. Gervais ed., 2006), 91.
15. As we note, the literature is now vast. Parts of the debate are captured well in P.K. Yu, 'The Escalating Copyright Wars' (2004) 32 *Hofstra Law Review*, 907.

Amongst other things, copyrights are said to last too long;¹⁶ provide rights that are too powerful;¹⁷ and assert too much control over tangible possessions.¹⁸ The three proposals for reform of copyright law that we briefly describe are: jettisoning the reproduction right for musical works;¹⁹ resurrecting formalities;²⁰ and significantly curtailing the derivative work right.²¹ Difficult issues of principle and policy arise when these suggestions are tested against prescriptions in the public international law of intellectual property. Aspects of each may also be in tension with the emerging international law on creators' human rights, as this concept is explicated in the General Comment. We do not suggest that human rights dictate specific outcomes in the domestic debates over intellectual property policy. Dispositive principles in this field have yet to emerge, a point that is underscored by the aspirational character of many human rights norms in the social, cultural, and economic context.²² Nevertheless, we hope to show how debates about domestic law reform agenda in the copyright field could be richer and more salient if they were accompanied by deeper engagement with public international law – both the public international law of intellectual property²³ and international human rights laws.

16. L. Lessig, *Free Culture* (Penguin, 2004), 292–93.

17. See, e.g., G. Pessach, 'Copyright Law as a Silencing Restriction on Noninfringing Materials: Unveiling the Scope of Copyright's Diversity Externalities', (2003) 76 *Southern California Law Review* 1067; J. Cohen, 'Creativity and Culture in Copyright Theory', (2007) 40 *U.C. Davis Law Review* 1151; J. Litman, *Digital Copyright* (Free Press, 2006).

18. See, e.g., N. Lucchi, 'The Supremacy Of Techno-Governance: Privatization Of Digital Content And Consumer Protection In The Globalized Information Society', (2007) 15 *International Journal of Law and Information Technology* 192; P. Samuelson, 'Intellectual Property Rights for Digital Library and Hypertext Publishing Systems' (1993) 6 *Harvard Journal of Law & Technology*, 237, 259.

19. See R. S. R. Ku, 'The Creative Destruction of Copyright: Napster and the New Economics of Digital Technology' (2002) 69 *University of Chicago Law Review*, 269.

20. See W. Landes and R. Posner, 'Indefinitely Renewable Copyright' (2003) 70 *University of Chicago Law Review*, 471; Christopher Sprigman, 'Reform(aliz)ing Copyright', (2004) 57 *Stanford Law Review* 485.

21. See J. Rubenfeld, 'The Freedom of Imagination: Copyright's Constitutionality' (2002) 112 *Yale Law Journal*, 1.

22. Parties to the ICESCR are required to 'take steps' to the 'maximum available resources, with a view to achieving progressively the full realization of the rights recognized in the [ICESCR] by all appropriate means, including particularly the adoption of legislative measures.' ICESCR, Art. 2(1). Economic, social, and cultural rights are nevertheless enforceable, as the well-known South African decision in *Grootboom* illustrates: Government of the *Republic of South Africa v. Grootboom* 2000 (11) BCLR 1169 (CC) (S. Afr.). Art. 2(1) has been the topic of a General Comment, Committee on Economic, Social and Cultural Rights (CESCR), General Comment No. 3: The Nature of States Parties Obligations, 5th Session (1990), which explores in detail states parties obligations in this field. <[www.unhcr.ch/tbs/doc.nsf/\(symbol\)/CESCR+General+comment+3.En?OpenDocument](http://www.unhcr.ch/tbs/doc.nsf/(symbol)/CESCR+General+comment+3.En?OpenDocument)>.

23. Professor Sprigman's advocacy of resurrecting formalities is an example of work that does engage with impediments imposed by the public international law of intellectual property. See Sprigman, *supra* n. 20. Professor Sprigman urges supplementation of the Berne Convention prohibition against formalities with *inter alia* a reciprocity principle, whereby authors could register their works either in the work's country of origin or in the country of protection. This,

II. CREATORS' HUMAN RIGHTS

II.A THE HUMAN RIGHTS TURN IN INTELLECTUAL PROPERTY

The turn to human rights in intellectual property scholarship, and in a number of policy and legal contexts, is partly a reaction against the expansion of intellectual property.²⁴ One result of the contextual and territorial expansion of intellectual property is that intellectual property laws now impact on a range of highly-contested economic, social and cultural issues about which human rights also have much to say,²⁵ including public health, agriculture, biodiversity, food, education and freedom of expression.²⁶ Human rights are posited as a source of doctrine, principles and norms that might serve to constrain intellectual property rights.²⁷ As Professor Larry Helfer has noted, there has also been a turn to human rights *institutions* as contexts within which limiting principles might be developed, a 'regime shift' that is indicative of a significant degree of scepticism about the ability or willingness of intellectual property institutions to themselves constrain intellectual property's expansion.²⁸

In 2000, the United Nations Sub-commission on the Promotion and Protection of Human Rights issued the much-discussed (non-binding) 'Resolution 2000/7',²⁹ which set forth the claim that 'actual or potential conflicts exist between the implementation of the TRIPS Agreement'³⁰ and the realization of economic, social

Sprigman suggests, would not be particularly onerous, due to the development of information technology, and the ability to provide internationally administered, and searchable, registers. This chapter is not the context in which to analyze this proposal in detail. However, we note that we are perhaps less confident than Professor Sprigman as to the viability of this proposal, particularly for authors located in technology-poor nations. Broadly similar issues have been discussed by Professors Sunder and Chander in Anupam Chander and Madhavi Sunder, 'The Romance of the Public Domain', (2004) 92 *California Law Review* 331, discussing political, cultural and economic impediments to utilization of public domain material.

24. L. Helfer, 'Regime Shifting: The TRIPS Agreement and New Dynamics of International Intellectual Property Lawmaking' (2004) 29 *Yale Journal of International Law* 1 [hereinafter 'Regime Shifting'].
25. *Ibid.*
26. L. Helfer, 'Toward a Human Rights Framework for Intellectual Property' (2007) 40 *U.C. Davis Law Review*, 971, 973. For a more detailed explication of the General Comment, see Helfer, 'Collective Management', *supra* n. 10.
27. See the sources cited at n. 26 *supra*.
28. See generally, L. Helfer, 'Regime Shifting' *supra* n. 24.
29. Sub-Commission on Human Rights Res. 2000/7, *Intellectual property rights and human rights*, ESCOR, Commission on Human Rights, Sub-Commission on the Promotion and Protection of Human Rights, 52nd Sess., 25th mtg., U.N. Doc. E/CN.4.Sub.2/Res/2000/7 (2000) [hereinafter Resolution 2000/7]. The drafting history of Resolution 2000/7 is discussed in detail in D. Weissbrod & K. Schoff, 'Human Rights Approach to Intellectual Property Protection: The Genesis and Application of Sub-Commission Resolution 2000/7' (2003) 5 *Minnesota Intellectual Property Review*, 1.
30. Agreement on Trade-Related Aspects of Intellectual Property Rights, 15 April 1994, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C, Legal Instruments-Results of the Uruguay Round, vol. 31, 33 I.L.M. 1197 (1994) [hereinafter TRIPS Agreement].

and cultural rights'.³¹ Reminding all governments of the 'primacy of human rights obligations over economic policies and agreements', Resolution 2000/7 identified a number of specific areas where implementation of the TRIPS Agreement did not 'adequately reflect the fundamental nature and indivisibility of all human rights'. These included: technology transfers to developing countries; the consequences for the right to food of plant breeders' rights and patenting of genetically modified organisms; biopiracy; control of indigenous peoples' natural resources and culture; and the impact on the right to health from restrictions on access to pharmaceuticals.³²

Rather than engaging in doctrinal analysis about TRIPS's violation of specific human rights norms, Resolution 2000/7 set forth an agenda for future study and analysis.³³ As leading commentators have discussed, there is a striking asymmetry between the human rights and intellectual property regimes.³⁴ The recognition of intellectual property in the form of creators' human rights dates from the beginning of the post-World War II international human rights movement. Included among the fundamental liberties set forth in the 1948 Universal Declaration of Human Rights, for example, is protection of authors' 'moral and material interests' in their 'scientific, literary or artistic production[s]'.³⁵ A similar guarantee appears as Article 15(1)(c) in the International Covenant on Economic, Social and Cultural Rights, which entered into force in 1976.³⁶ In the regional context, the American Declaration on the Rights and Duties of Man³⁷ announced the right of everyone 'to the protection of his moral and material interests as regards his inventions or any

31. Resolution 2000/7, Preamble.

32. *Ibid.* The Committee on Economic, Social and Cultural Rights announced in December 2001 that 'the current debate over intellectual property and human rights centres on two separate but deeply entwined issues: . . . concern over patented scientific advances that impact on human health and food supply; and . . . concern of misappropriation of traditional knowledge held by communities rather than invented by contemporary individuals.' From 'Substantive issues arising in the implementation of the international covenant on economic, social and cultural rights: Follow-up to the day of general discussion on Art. 15.1 (c), Monday, 26 November 2001', Human rights and intellectual property statement by the Committee on Economic Social and Cultural Rights, E/C.12/2000/15, para. 1. However, the Preamble to Resolution 2000/7 also referred to the rights set forth in the ICESCR, and the 'need to work towards the realization for all people and communities of the rights . . . to food housing, work, health and education.' This broader statement of relevant rights anticipated more recent analysis of the adverse impact that the assertion of copyright might have on education and development rights. See, e.g., Chon, 'IP from Below', *supra* n. 3.

33. L. Helfer, 'Toward a Human Rights Framework for Intellectual Property' (2007) 40 *U.C. Davis Law Review*, 971, 986.

34. *Ibid.*

35. *Universal Declaration of Human Rights*, Art. 27.

36. ICESCR, *supra* n. 8, Art. 15(1)(b)-(c). As of 11 October 2007, the International Covenant on Economic, Social and Cultural Rights had 157 states parties, and 66 signatories. Ratifications and Reservations <www.ohchr.org/english/bodies/ratification/3.htm#ratifications>, 3 November 2007.

37. American Declaration of the Rights and Duties of Man, O.A.S. Res. XXX, adopted by the Ninth International Conference of American States (1948), reprinted in *Basic Documents Pertaining to Human Rights in the Inter-American System*, OEA/Ser.L.V/II.82 doc.6 rev.1 at 17 (1992).

literary, scientific or artistic works of which he is the author'.³⁸ And the First Protocol³⁹ of the European Human Rights Convention⁴⁰ protects the right to property, a guarantee that in some contexts reaches intellectual property.⁴¹ This is matched by complete silence about human rights in the public international intellectual property instruments.⁴² This has invited scholarly analysis of 'textual' and 'institutional' questions concerning the potential for bringing the public international human rights and intellectual property law together, an agenda that is based on the premise that the two areas of law are mutually relevant. This project requires detailed textual analysis of the WTO instruments, to see if deliberation on the scope of intellectual property rights within that institutional setting allows for any supplementation by other sources of law or norms, including those derived from human rights instruments.⁴³

Human rights guarantees for creative activity appear to treat the fruits of intellectual endeavour on a different plane from the instrumentalist approach to rights apparent from the TRIPS Agreement itself.⁴⁴ TRIPS announces simply that 'intellectual property rights are private rights'.⁴⁵ Whereas international intellectual property instruments appear to treat intellectual property rights as means to socio-economic ends,⁴⁶ human rights instruments appear to accord

38. *Ibid.*, Art. 8.

39. Convention for the Protection of Human Rights and Fundamental Freedoms, 4 November 1950, 13 U.N.T.S. 222.

40. Protocol to the Convention for the Protection of Human Rights and Fundamental Freedoms, opened for signature 20 March 1952, Art. 1, 213 U.N.T.S. 262, 262 [hereinafter Art. 1]. Art. 1 of Protocol No. 1 states in its entirety: 'Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law. The preceding provisions shall not, however, in any way impair the right of a State to enforce such laws as it deems necessary to control the use of property in accordance with the general interest or to secure the payment of taxes or other contributions or penalties.'

41. For a meticulous exploration of the role of the First Protocol in intellectual property claims within European human rights laws, see L. Helfer, 'The New Innovation Frontier? Intellectual Property and the European Court of Human Rights', (2008, forthcoming) 49 *Harvard International Law Journal*

42. *Ibid.*, at 979.

43. C. Geiger, *supra* n. 1; A. Chapman, 'The Human Rights Implications of Intellectual Property Protection', (2002) 5 *Journal of International Economic Law* 861. For a path-breaking analysis of the broader question of the relevance to WTO jurisprudence of sources of law other than WTO instruments see J. Pauwelyn, *Conflict of Norms in Public International Law: How WTO Law Relates to other Rules of International Law* (Cambridge University Press, 2003). For a vehement attack against 'integration' between human rights and economic norms, see P. Alston, *Resisting the Merger and Acquisition of Human Rights by Trade Law: A Reply to Petersmann* (2002) 13 *European Journal of International Law* 815.

44. TRIPS Agreement, *supra* n. 30.

45. TRIPS Agreement, Preamble. See Helfer, 'Regime Shifting', *supra* n. 24.

46. In the copyright context, perhaps not entirely. In later drafts of the Berne Convention, we see the two dominant strands of copyright philosophy, *droit d'auteur* and utilitarianism coming together in the public international law context. On the influence of each strand in *domestic* traditions, see Jane C. Ginsburg, 'A Tale of Two Copyrights: Literary Property in Revolutionary

protection of intellectual property the normative and moral gravitas associated with rights that derive from the inherent dignity and worth of all persons.⁴⁷ Even so, some scholars have recognized that the turn to human rights is accompanied by risks.⁴⁸ Considerable embarrassment for the human rights agenda might be caused if a human right to intellectual property were understood as coinciding exactly with the ‘instrumentalist’ intellectual property rights protections required by the TRIPS Agreement.⁴⁹ Rather than providing a source of limiting principles, human rights could instead establish a basis for assertions of requirements for stronger protections than are provided by existing intellectual property laws. If human rights ‘trump’ intellectual property law, their power to constrain intellectual property may be undermined if human rights law *itself* requires protection of intellectual property.

Additional difficulties may be caused by counterweights that are internal to the human rights system itself. Aspirations of ‘balance’ between the two legal regimes may be displaced, or, at least, deferred, by an initial obligation to reconcile competing imperatives imposed by the human rights instruments.⁵⁰ Consider the

France and America’ in *Of Authors and Origins: Essays in Copyright Law* 131, eds Sherman and Strowel, (1994).

47. General Comment No. 17, para. 1: ‘The right of everyone to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he or she is the author is a human right which derives from the inherent dignity and worth of all persons. This fact distinguishes Art. 15, paragraph 1(c), and other human rights from most legal entitlements recognized in intellectual property systems. Human rights are fundamental, inalienable and universal entitlements belonging to individuals and, under certain circumstances, groups of individuals and communities. Human rights are fundamental as they are inherent to the human person as such, whereas intellectual property rights are first and foremost means by which States seek to provide incentives for inventiveness and creativity, encourage the dissemination of creative and innovative productions, as well as the development of cultural identities, and preserve the integrity of scientific, literary and artistic productions for the benefit of society as a whole.’
48. See, e.g., M. Chon, ‘Intellectual Property and the Development Divide’ (2006) 27 *Cardozo Law Review*, 2821; K. Raustiala, ‘Density and Conflict in International Intellectual Property Law’ (2007) 40 *UC Davis Law Review*, 1021; S. Marks, ‘Tying Prometheus Down: The International Law of Human Genetic Manipulation’ (2002) 3 *Chicago Journal of International Law* 115, 125 (noting that intellectual property rights may protect biotech firms against human rights claims). See also Helfer, ‘Human Rights Framework’, *supra* n. 26, at 1014 (noting how in EU jurisprudence, human rights claims have been invoked in support of intellectual property rights).
49. See *generally* Okediji, ‘The Limits of Development Strategies’ *supra* n. 11. The risk is particularly acute if human rights critiques are located solely within the discourse of ‘first generation’ rights protections trained on the liberal protection of private property and individual liberty. Intellectual-property rich sectors, such as the pharmaceutical industry has not been reticent about couching their claims in human rights terms, as was evidenced by the high-profile constitutional challenge that was brought by pharmaceutical firms against South Africa’s medicines legislation in which the claim invoked the human right to private property. *Pharmaceutical Manufacturers’ Association a.o. v. Pres. of the Rep. of S. Africa*, Case 4183/98, High Court of South Africa (Transvaal Provincial Division) (2001). See further, Picciotto, ‘Private Rights vs. Public Interests in the TRIPS Agreement: The Access to Medicines Dispute’ *supra* n. 2. See also Helfer, ‘Human Rights Framework’, *supra* n. 26.
50. See Commission on Intellectual Property Rights, UK Sec’y of State for Int’l Dev., *Integrating Intellectual Property Rights and Development Policy* (2002) [hereinafter CIPR Report]

tension between the right to education and authors' rights to benefit from the material fruit of their labours.⁵¹ The claim that the right to education, a venerable right articulated in numerous human rights instruments – including the Universal Declaration and the ICESCR – requires free text books, or free translation, or some other exception to the traditional prerogatives associated with copyright,⁵² might look different once it is remembered that the relevant human rights instruments themselves also aspire to protect authors. Indeed, a similar tension appears to arise from the language of the clauses surrounding the statements of authors' rights in both instruments. Both the Universal Declaration and the ICESCR also promise 'everyone' the right to participate in cultural life and to benefit from scientific advancement. As the Committee on Economic, Social and Cultural Rights has said of Article 15 of the ICESCR, 'the drafters set up a tension that must be resolved if Article 15 is to be made effective'.⁵³ Moreover, the turn to human rights invites the further possibility of creating a hierarchy between authors' human rights and any limitations that the public international law of intellectual property itself permits.⁵⁴

II.B CREATORS' RIGHTS AS HUMAN RIGHTS

The potential for this kind of 'embarrassment' to accompany the human rights turn has prompted a variety of responses. One has been to question whether any benefits of the turn to human rights in intellectual property law are likely to be outweighed by the risks,⁵⁵ an approach that perhaps suggests that human rights' role in intellectual

<www.iprcommission.org/papers/pdfs/final_report/CIPRfullfinal.pdf>, 'Overview' (noting the recognition of creators' human rights in the UN Declaration on Human Rights but concluding that 'an intellectual property right is best viewed as one of the means by which nations and societies can help promote the fulfillment of human, economic and social rights'). In the Commission's analysis, intellectual property rights are (pragmatic) instruments of domestic social policy; even so, the Commission's vision of local social policy was informed by the universalizing discourse of human rights. See G. Austin, 'Copyright's Modest Ontology – Theory and Pragmatism in *Eldred v. Ashcroft*', (2003) 16 *Canadian Journal of Law and Jurisprudence* 163, 165–6. See also Helfer, 'Human Rights Framework', *supra* n. 26.

51. See generally Chon, 'IP from Below', *supra* n. 1.

52. *Id.*

53. ICESCR, para. 45. The Committee also noted that 'the distinguished men and women who gave us the ICESCR did not seem to deeply consider the difficult balance between public needs and private rights when it comes to intellectual property.' *Id.*

54. For instance, if intellectual property rights enjoy the same kind of 'primacy' that is accorded to other human rights, this might inhibit the development of further exceptions consistent with the 'flexibilities' in the TRIPS Agreement. See World Trade Organization, Declaration on the TRIPS Agreement and Public Health, WT/MIN(01)/DEC/2, 41 I.L.M. 755 (20 November 2001), <www.wto.org/english/thewto_e/minist_e/min01_e/mindecl_trips_e.htm>, 3 November 2007. See further S. Picciotto, 'Private Rights vs. Public Interests in the TRIPS Agreement: The Access to Medicines Dispute' *supra* n. 2.

55. See, e.g., M. Chon, 'Intellectual Property and the Development Divide' (2006) 27 *Cardozo Law Review*, 2821; K. Raustiala, 'Density and Conflict in International Intellectual Property Law', (2007) 40 *UC Davis Law Review*, 1021. For an important early analysis of the inconsistencies

property law should be quite modest. Another has been to argue that the lack of consensus as to the inclusion of creators' human rights recognition in international human rights instruments reduces their significance in human rights terms.⁵⁶ Yet another response has been to expose the absence of clear black-letter legal support for human rights to act as any kind of constraint on public international law obligations in the intellectual property field.⁵⁷ Any engagement with these issues must now take account of General Comment 17, in which the Committee on Economic, Social and Cultural Rights provided a detailed interpretation of Article 15(1)(c). This interpretation suggests that the scope of the rights at stake are significantly more confined than the rights guaranteed by the public international law of intellectual property, an interpretation that might assuage some of the concerns associated with recognizing creators' rights as human rights.⁵⁸

Before summarizing some of the key aspects of the General Comment, it may also be helpful to consider why protection of creators' human rights should be a matter of international concern at all. One of a number of normative concerns that underscore the importance of this human rights guarantee is the particular vulnerability of those who do creative work in a number of societies. While this is not the only issue informing the recognition and protection of creators' rights, it may be useful to recall this vulnerability when engaging in debates about the scope of intellectual property rights and their interaction with human rights norms.

1. Creators' vulnerability: An interpretive instrument, the General Comment does not say very much about the justifications for the right guaranteed by Article

between human rights and intellectual property, see R. Gana, 'The Myth of Development, The Progress of Rights: Human Rights to Intellectual Property and Development' (1996) 18 *Law and Policy* 315.

56. See, e.g., P. Yu, 'Reconceptualizing Intellectual Property Interests in a Human Rights Framework' (2007) 40 *UC Davis Law Review* 1039, 1060–1069. The drafting history suggests that inclusion of a guarantee in respect of authors' rights in the ICESCR was particularly fraught, and was met with significant objections from a number of delegates to the Commission on Human Rights, which was tasked with drafting the ICESCR. The authors' rights guarantee was rejected by the Commission, and was reinstated when the draft reached the General Assembly in 1957 on the urgings of a handful of nations. See E.C.12/2001/15 *supra* n. 27, para. 33 et seq. At the General Assembly Third Committee, twelfth session, France had urged that the authors' rights provision be included, with the formal proposal coming from the Uruguayan delegation. The proposal eventually passed, with the vote being 'straight down cold war faultlines.' *Idem*, para. 43. But see R. Okediji, 'Exceptions and Public Interest' (questioning the relevance of the absence of consensus that is revealed in the drafting history to the strength of the right).
57. R. Okediji, *Supra-National Copyright* (paper presented at the University of Arizona, James E. Rogers College of Law, 12 October 2007: on file with author).
58. The General Comment No. 17 was preceded in 2001 by a Statement on Human Rights and Intellectual Property, which established part of the framework for the later General Comment. U.N. Econ. & Soc. Council [ECOSOC], Comm. on Econ., Soc. & Cultural Rights, Substantive Issues Arising in the Implementation of the International Covenant on Economic, Social and Cultural Rights, U.N. Doc. E/C12/2001/15 (14 December 2001) [hereinafter Statement on Human Rights and Intellectual Property], available at <[www.unhchr.ch/tbs/doc.nsf/0/1e1f4514f8512432c1256ba6003b2cc6/\\$FILE/G0146641.pdf](http://www.unhchr.ch/tbs/doc.nsf/0/1e1f4514f8512432c1256ba6003b2cc6/$FILE/G0146641.pdf)> (follow-up to day of general discussion on Art. 15.1(c), Monday, 26 November 2001).

15(1)(c), other than to link the right to the inherent dignity of the person, an approach that is typical of much human rights discourse. There may, however, be more specific reasons for locating creativity within the human rights skein. In particular, the right to *be* an author or an innovator has never been entirely secure at all times and in all places. Acknowledging the particular vulnerability associated with being a creative professional in some societies may provide a counterweight to critiques of intellectual property rights generally, and perhaps also to criticisms trained on the elevation of creators' rights to the level of human rights.

Famously, the US Supreme Court has explained that copyright is the engine of free expression: by creating markets for copyright-protected works copyright provides the incentives for authors to express themselves.⁵⁹ Within the US, this analysis is directed at countering attacks against copyright's apparent suppression of expressive freedoms by its privatization of speech. The Supreme Court's analysis underscores the marketplace reality that certain forms of speech flourish best if they are paid for. But there may also be deeper links between authorship and expressive freedoms, links that are sometimes missed within an economy such as the US with a long tradition of celebrating the private profit motives to which copyright systems respond. At different times in history, and still today in a number of places, the freedom to be creative has been contingent at best, and sometimes downright denied. Censorship of authorial and scientific activity is a notorious tool of oppression.

Attacks against authors, both blatant and covert, continue today.⁶⁰ Suppression of writing that might draw the public's attention to controversial activity is still active, and authors continue to be exiled, executed, assassinated, and threatened into silence.⁶¹ Subtler forms of attack occur when the national government in question exerts pressures to enforce a censorship policy that is unwritten, unspoken, and that the government outwardly disavows.⁶² These attacks include the concept of the 'gray list', 'selective censorship', and forced assimilation of authors into the political fold. Feminist writer Nawal el Saadawi describes the gray list as a subversive method of achieving censorship without expressly going against free expression. Economic controls are sometimes used to enforce 'gray list' censorship.⁶³ This type of suppression occurs under the guise of democracy and free expression. An author who finds herself on the 'gray list' does not encounter outright censorship by the governing body of her home country, but

59. *Harper & Row v. Nation Enterprises*, 471 U.S. 539 (1985); *Eldred v. Ashcroft*, 537 U.S. 186 (2003).

60. Mechanisms of authorship suppression include methods of censorship that evade international criticism. See S. C. Jansen and B. Martin, 'Exposing and Opposing Censorship: Backfire Dynamics in Freedom-of-Speech Struggles' (2004) 10 *Pacific Journalism Review*, 29–45.

61. H. Gafaiti, *Between God and the President: Literature and Censorship in North Africa*, 27.2 *DIACRITICS* 59, 68 (1997) (quoting writer Nawal el Saadawi's comment on the continuing persecution of non-Western authors).

62. *Ibid.* at 66.

63. A state could exert control over the literary market by refusing to buy an author's books, and so use its monopoly status to dictate which works were published, and which works were publicly disseminated. *Ibid.*

instead finds that she cannot get her work published by large publishers, and that she cannot appear on television or be heard on the radio.⁶⁴

'Selective censorship' occurs when the amount of opposition or persecution an author experiences changes depending on the extent to which she is well-known or recognized by the public.⁶⁵ Unknown writers might find themselves arrested or exiled, or their work seized or destroyed.⁶⁶ For writers who have achieved notoriety, however, or who have won public support, governments might go to great lengths to encourage their work, so that those authors might serve as examples of the nation's efforts to promote free expression.⁶⁷ Government bodies have also suppressed authorial freedom in the opposite manner, by *recruiting* authors to serve the interests of their 'communities.'⁶⁸ This allowed governments to control literary production while they continued to feign adherence to democratic precepts such as free expression.

With the advent of global digital communication, organizations emerged whose entire focus was identifying and publicizing incidents of authorial persecution worldwide;⁶⁹ NGOs and concerned academic publications are constantly working to 'out' these abuses.⁷⁰ For example, International PEN monitors countries across the globe to provide news updates on issues of authorial freedom. PEN organizes international fora to discuss attacks on writers and journalists around the world.⁷¹ PEN also publishes articles about instances of author suppression, commemorating those authors who fall victim to threats, violence, or political persecution.⁷² These groups are, however, only able to draw attention to the

64. Gafaiti, at 66 (quoting Nawal el Saadawi's analysis of Egyptian methods of censorship).

65. *Ibid.*, at 66, 67.

66. *Ibid.*

67. *Ibid.*

68. In Algeria, the government recruited authors to join Writers Unions, under the guise of organizing writers' activities. These writers were enlisted to serve the 'community' by, in essence, praising the actions of the government. The eventual result of these groups was a growing rift between two categories of authors: a group of less talented writers who were content to play this superficial role, and a group of more talented writers who were either forced into silence or into exile. This method of controlling national literary output was and has been used fairly successfully by many nations. *Ibid.*, at 65, 66.

69. These groups function as 'freedom of expression' whistleblowers, reporting abuses almost instantaneously with their occurrence.

70. These groups and concerned publications include: International PEN (<www.internationalpen.org.uk>); the Free Expression Policy Project (<www.fepproject.org>); Index on Censorship (<www.indexonline.org>); National Coalition Against Censorship (<www.ncac.org/home.cfm>); Human Rights Watch (<<http://hrw.org>>); IFLA Committee on Free Access to Information and Freedom of Expression (FAIFE) (<www.ifla.org/faife>); United Nations Educational, Scientific, and Cultural Organization (UNESCO) (<http://portal.unesco.org/ci/en/ev.php-URL_ID=2493&URL_DO=DO_TOPIC&URL_SECTION=201.html>)

71. D. Wills (WiPC Africa and Americas Researcher), *Pen's Nov 03 Mexico Congress Condemns Attacks on Writers* (WiPC Press Release) (5 December 2003) <www.internationalpen.org.uk/index.php?pid=33&aid=17&return=33>, 15 October 2007.

72. 'Free Expression monitors' have 'recorded the killings' of more than 300 writers and journalists. *Day Of The Imprisoned Writer: 22 Writers And Journalists Murdered Since 2002*,

incidents. They are not empowered to prevent or punish those behind the instances of author-abuse.

Past and present threats to authorial freedom highlight the need to view authorship and creativity and innovation generally as human rights issues. Many authors are not secure in their ability to *create*, and earn a living from creative work, safe from governmental interference, suppression, or persecution. This is not exclusively an issue relating to freedom of expression. The human right set forth in Article 15(1)(c) is certainly about expressive freedoms; but it also concerns the freedom to *be* an author, not only to pursue a creative life, but to pursue it in a way that enables authors to earn a living from their profession.

2. General Comment 17: General Comment Number 17 emphasizes at a number of points that the right set forth in Article 15(1)(c), while protective of authors' moral and material interests, 'does not necessarily coincide with what is referred to as intellectual property rights under national legislation or international agreements'.⁷³ The General Comment immediately notes that '[h]uman rights are fundamental as they are inherent to the human person as such, whereas intellectual property rights are first and foremost means by which States seek to provide incentives for inventiveness and creativity, encourage the dissemination of creative and innovative productions as well as the development of cultural identities, and preserve the integrity of scientific, literary and artistic productions for the benefit of society as a whole'.⁷⁴ The General Comment persistently links creators' human rights to an irreducible core of rights, which, as Professor Helfer explains, protects 'a zone of personal autonomy in which authors can achieve their creative potential, control their productive output, and lead independent intellectual lives that are essential requisites for any free society'.⁷⁵ The General Comment captures the distinction between human rights and intellectual property rights as follows: 'intellectual property rights are generally of a temporary nature, and can be revoked, licensed or assigned to someone else'.⁷⁶ The document also observes that '[w]hile under most intellectual property systems, intellectual property rights, often with the exception of moral rights, may be allocated, limited in time and scope, traded, amended and even forfeited, human rights are timeless expressions of fundamental entitlements of the human person'.⁷⁷

The General Comment underscores a key distinction between the 'primary' protections that intellectual property rights afford to 'business and corporate interests and investments', and the safeguards that human rights offer to 'the personal link between authors and their creations and between peoples, communities, or

International PEN (15 October 2003) <www.internationalpen.org.uk/index.php?pid=33&aid=6&return=33>, 20 October 2007, commemorating 22 of the writers and journalists who were killed between 2003 and 2003.

73. General Comment No. 17, para. 2.

74. *Id.*, para. 1.

75. Helfer, 'Collective Management', *supra* n. 10, at 97.

76. General Comment No. 17, para. 2.

77. *Ibid.*

other groups and their collective cultural heritage, as well as their basic material interests which are necessary to enable authors to enjoy an adequate standard of living'.⁷⁸ Within the human rights skein, creators' rights are linked to the personality of the individual author, or, alternatively, are connected to the protection of communal interests in cultural heritage. Because creators' human rights concern the *personal* link between human creators and their works; non-legal persons (other than tribal groups and the like) do not enjoy the 'human right' guaranteed by Article 15(1)(c). And the right enjoyed by human authors does not necessarily provide pecuniary rights to the full extent of the rights provided by copyright law: rather, the human right is instead linked to authors' ability to enjoy an *adequate* standard of living.

The General Comment also links the guarantee to other rights set forth in the ICESCR, as the following paragraph explains:

The right to benefit from the protection of the moral and material interests resulting from one's scientific, literary and artistic productions seeks to encourage the active contribution of creators to the arts and sciences and to the progress of society as a whole. As such, it is intrinsically linked to the other rights recognized in article 15 of the Covenant, i.e. the right to take part in cultural life (art. 15, para. 1(a)), the right to enjoy the benefits of scientific progress and its applications (art. 15, para. 1(b)), and the freedom indispensable for scientific research and creative activity (art. 15, para. 3). The relationship between these rights and article 15, paragraph 1(c), is at the same time mutually reinforcing and reciprocally limitative. . . . As a material safeguard for the freedom of scientific research and creative activity, guaranteed under article 15, paragraph 3 and article 15, paragraph 1(c), also has an economic dimension and is, therefore, closely linked to the rights to the opportunity to gain one's living by work which one freely chooses (art. 6, para. 1) and to adequate remuneration (art. 7(a)), and to the human right to an adequate standard of living (art. 11, para. 1). Moreover, the realization of article 15, paragraph 1(c), is dependent on the enjoyment of other human rights guaranteed in the International Bill of Human Rights and other international and regional instruments, such as the right to own property alone as well as in association with others, the freedom of expression including the freedom to seek, receive and impart information and ideas of all kinds, the right to the full development of the human personality, and rights of cultural participation, including cultural rights of specific groups.

Differences between the human right set forth in Article 15(1)(c) and the instrumentalist approach to protection of rights within the intellectual property regime are further evidenced by the articulation of core obligations within the General Comment which must be guaranteed immediately, and more aspects of

78. *Ibid.*

the right that must be progressively realized. Key parts of the statement of the 'specific legal obligations' are set forth in the following paragraphs:

30. States parties are under an obligation to *respect* the human right to benefit from the protection of the moral and material interests of authors by, inter alia, abstaining from infringing the right of authors to be recognized as the creators of their scientific, literary or artistic productions and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, their productions that would be prejudicial to their honour or reputation. States parties must abstain from unjustifiably interfering with the material interests of authors, which are necessary to enable those authors to enjoy an adequate standard of living.

31. Obligations to *protect* include the duty of States parties to ensure the effective protection of the moral and material interests of authors against infringement by third parties. . . . Similarly, States parties are obliged to prevent third parties from infringing the material interests of authors resulting from their productions. To that effect, States parties must prevent the unauthorized use of scientific, literary and artistic productions that are easily accessible or reproducible through modern communication and reproduction technologies, e.g. by establishing systems of collective administration of authors' rights or by adopting legislation requiring users to inform authors of any use made of their productions and to remunerate them adequately. States parties must ensure that third parties adequately compensate authors for any unreasonable prejudice suffered as a consequence of the unauthorized use of their productions.

32. With regard to the right to benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of indigenous peoples, States parties should adopt measures to ensure the effective protection of the interests of indigenous peoples relating to their productions, which are often expressions of their cultural heritage and traditional knowledge. . . . States parties should respect the principle of free, prior and informed consent of the indigenous authors concerned and the oral or other customary forms of transmission of scientific, literary or artistic production; where appropriate, they should provide for the collective administration by indigenous peoples of the benefits derived from their productions.

33. States parties in which ethnic, religious or linguistic minorities exist are under an obligation to protect the moral and material interests of authors belonging to these minorities through special measures to preserve the distinctive character of minority cultures.

34. The obligation to *fulfil* (provide) requires States parties to provide administrative, judicial or other appropriate remedies in order to enable authors to claim the moral and material interests resulting from their scientific, literary or artistic productions and to seek and obtain effective redress in cases of violation of these interests. States parties are also required to *fulfil* (facilitate) the right in article 15, paragraph 1(c), e.g. by taking financial and other

positive measures which facilitate the formation of professional and other associations representing the moral and material interests of authors, including disadvantaged and marginalized authors, in line with article 8, paragraph 1(a), of the Covenant. The obligation to *fulfil* (promote) requires States parties to ensure the right of authors of scientific, literary and artistic productions to take part in the conduct of public affairs and in any significant decision-making processes that have an impact on their rights and legitimate interests, and to consult these individuals or groups or their elected representatives prior to the adoption of any significant decisions affecting their rights under article 15, paragraph 1(c).

The General Comment also identifies the connection between the rights set forth in Article 15(1)(c) and other rights guaranteed by the ICESCR. For example, the General Comment specifies that authorial rights cannot be ‘isolated from the other rights recognized in the Covenant’.⁷⁹ And states parties are obliged to strike an ‘adequate balance’ between their obligations under Article 15(1)(c) and other rights in the Covenant ‘with a view to promoting and protecting the full range of rights guaranteed in the Covenant.’ States parties should also ‘ensure that their legal or other regimes for the protection of the moral and material interests resulting from one’s scientific, literary or artistic productions constitute no impediment to their ability to comply with their core obligations in relation to the rights to food, health and education, as well as to take part in cultural life and to enjoy the benefits of scientific progress and its applications, or any other rights enshrined in the Covenant’. The General Comment reasons that ‘ultimately’ intellectual property is ‘a social product [that] has a social function’. It follows that ‘[s]tates parties have a duty to prevent unreasonably high costs for access to essential medicines, plant seeds or other means of food production, or for schoolbooks and learning materials, from undermining the rights of large segments of the population to health, food and education’.⁸⁰

The General Comment returns to many of these issues in its statement of core obligations. These require states parties to: take legislative and other necessary steps to ensure the effective protection of the moral and material interests of authors; ensure equality of access to administrative, judicial or other appropriate remedies when their rights are breached; and to strike an adequate balance between the rights set forth in Article 15(1)(c) and states parties’ obligations in relation to the rights to food, health and education, the right to participate in cultural life, to benefit from scientific progress and its applications, and any other right recognized by the ICESCR.

As Professor Helfer has noted, the General Comment does not explain exactly how states parties are to undertake the balancing between Article 15(1)(c) and other rights, or how they are to realize the accompanying proscriptions against intellectual property rights coming to impose barriers to the realization of other

79. General Comment, para. 2.

80. *Id.*, Art. 35.

rights relating to topics such as food, health and education.⁸¹ Even so, it is not at all clear that conceiving of creators' rights as human rights impedes the agenda of tempering intellectual property rights according to the demands of other norms that are external to intellectual property, including other human rights guarantees. It is true that limitations on the right protected under Article 15(1)(c) must 'pursue a legitimate aim, and must be strictly necessary for the promotion of the general welfare in a democratic society',⁸² language that seems significantly more demanding than the, now standard, 'three-step test' by which domestic law exceptions must typically be tested for compliance with international intellectual property instruments.⁸³ However, as was noted above, the scope of the human right already is significantly more confined than the instrumentalist intellectual property rights guaranteed under TRIPS. Accordingly, if recognition of creators' rights as human rights were to jeopardize the realization of other aspects of the international human rights agenda, this result would be inconsistent with the understanding of the scope of creators' human rights that is set forth in General Comment 17.

III. DOMESTIC LAW REFORM PROPOSALS VIEWED THROUGH A HUMAN RIGHTS LENS

Creators' human rights, like all human rights obligations, impose potential constraints on domestic sovereignty. At their highest, they impose legal restrictions on what domestic law reform is able to achieve. They also bear significant normative and rhetorical weight, a point that may be particularly relevant for human rights obligations in the economic, social and cultural field. The normative weight of creators' human rights obligations may also be especially important for deliberations on law reform within the US, which has signed, but not ratified, the ICESCR.

In this Part, we briefly outline three law reform proposals: jettisoning the reproduction right for musical works; resurrecting formalities; and significantly curtailing the derivative work right. We then consider the implications of these law reform proposals through the lens of international law, both the international law of intellectual property and the international law of creators' human rights.

III.A DOMESTIC LAW REFORM PROPOSALS

III.A.1 Jettisoning the Reproduction Right

Because new technologies of distribution have altered the economics of dissemination of copyright-protected works so dramatically in recent years, some

81. Helfer, 'Toward a Human Rights Framework', *supra* n. 26.

82. General Comment, para. 22.

83. However, as is noted by Professor Larry Helfer, the specific guarantees embodied in Art. 15(1)(c), as interpreted in General Comment No. 17, are not coexistent with the public law obligations set forth in international intellectual property instruments. Helfer, *supra* n. 20.

commentators have suggested that authors of musical works and sound recordings no longer need a reproduction right.⁸⁴ According to this logic, now that ordinary consumers bear the costs of dissemination, through payments for computer hardware, software and network connections, there is no need for copyright to recognize a distribution right, at least in the context of 'digital works'. This is underscored by the reality that many contemporary musical artists now derive most of their income from concerts and merchandizing, rather than through sales of 'copies' of their works.

According to one proposal, musical artists would continue to derive income from live performances and from merchandizing, but income formerly derived from the reproduction right would be replaced by distributions from a new tax on computer and other electronic equipment.⁸⁵

III.A.2. Resurrecting Formalities

Another set of law reform proposals focuses on the issue of copyright formalities. Successive drafts of the Berne Convention⁸⁶ gradually evolved away from permitting the protection of copyright to be conditioned on compliance with formalities that were imposed either by the country of origin of the work or by the country under whose laws protection is claimed.⁸⁷ The Berne Convention now requires that

84. See, e.g., R.S.R. Ku, 'The Creative Destruction of Copyright: Napster and the New Economics of Digital Technology' (2002) 69 *University of Chicago Law Review*, 269.

85. R.S.R. Ku, 'The Creative Destruction of Copyright: Napster and the New Economics of Digital Technology' (2002) 69 *University of Chicago Law Review*, 269. Many other distinguished commentators have explored variations on, or abolition of, traditional copyright models for compensating authors. W.W. Fisher, *Promises to Keep: Technology, Law and the Future of Entertainment* (Stanford University Press 2004); N. Netanel, 'Impose a Non-commercial Use Levy to Allow Free Peer-to-Peer File Sharing' (2003) 17 *Harvard Journal of Law & Technology* 1, 4; Jessica Litman, 'Sharing and Stealing', (2004) 27 *Hastings Comm. & Ent. Law Journal* 1. Professor Ku explores these issues in further detail in R.S.R. Ku, 'Promoting Diverse Cultural Expression: Lessons from the U.S. Copyright Wars' (2007) 2 *A.J.W.H.*, 369. The US has adopted a (very limited) levy system in the music context. Audio Home Recording Act of 1992; Pub. L. No. 102-563, 106 Stat 4237 (1992) (codified at 17 U.S.C. ss. 1001-1010 (2000)). For a recent analysis contesting the viability of compensation systems based on taxation and levies (but concluding that most unauthorized distribution of musical works via P2P networks should nevertheless be permitted), see H. Pettit Jr., 'New Architectures for Music: Law Should Get Out of The Way', (2007) 29 *Hastings Communications and Entertainment Law Journal* 259. The issue has become more complex in recent years due to the merging of the reproduction and public performance right. For instance, in some circumstances, a digital phonorecord delivery might be functionally equivalent to a public performance even though it is not perceived contemporaneously with the delivery. The economic implications of jettisoning the reproduction right may be significantly affected by how courts characterize these 'disseminations' of copyright-protected works. See, *In re America Online, Inc.*, 485 F.Supp. 2d 438 (S.D.N.Y. 2007) (public performance generally requires contemporaneous perception).

86. Berne Convention for the Protection of Literary and Artistic Works, 9 September 1886, last revised at Paris, 24 July 1971, 1161 U.N.T.S. 31 [hereinafter Berne Convention], Art. 5(2).

87. S. Ricketson and J. Ginsburg, *International Copyright and Neighbouring Rights: The Berne Convention and Beyond* (Oxford, 2005), 321-2. Although, as is discussed *infra*, under US

the enjoyment and exercise of rights set forth in the Convention ‘shall not be subject to any formality’ and ‘such enjoyment and such exercise shall be independent of the exercise of protection in the country of origin of the work’.⁸⁸

The public international law shift toward prohibiting Berne Member States from conditioning copyright protection on compliance with formalities reflected one of the principal purposes of the Berne Convention, which was to enhance international protections for authors. Domestic laws that conditioned protection on compliance with formalities frequently had the effect of stripping copyright owners of their rights under those laws. As Professor Greene recounts, copyright formalities could also be an instrument for suppressing authors’ expressive freedoms. For instance, the Statute of Anne’s⁸⁹ requirement that literary works be registered as a precondition to copyright protection ensured that censors could locate authors, and hold them accountable for their works.⁹⁰

US copyright law provides a notorious example of how formalities could impede authors’ ability to derive income from their works: publication without affixing a copyright notice could effect a ‘divestive publication,’ consigning the work to the public domain.⁹¹ Even if the first term was secured, enjoyment of the ‘renewal term’ was, prior to important amendments to the Copyright Act in 1992,⁹² conditioned on registration of that term. Failure to register shortened the copyright term to the initial term of twenty-eight years, a very short period compared with prevailing international standards. The endurance of formalities within the US copyright system was one of the principal reasons why the US did not join the Berne Convention until 1988.⁹³ On accession to the Convention, the US finally removed most of the conditions that were formerly relevant to the subsistence and/or endurance of individual copyrights.⁹⁴ Even today, however, US-origin works must be registered with the Copyright Office before a federal court has

copyright law, registration remains a pre-condition for bringing an action for infringement of a ‘US work’. 17 U.S.C. § 411(a).

88. Berne Convention, Art. 5(2).

89. 1710, 8 Ann., c. 19 (Eng.).

90. Greene, *supra* n. 5.

91. See generally *Estate of Martin Luther King, Jr., Inc. v. CBS, Inc.*, 194 F.3d 1211 (11th Cir. 1999). As Professor Sprigman explains, the formalities in the first federal copyright statute, the Copyright Act of 1791, Act of 31 May 1790 ch. 15, 1 Stat. 124, had three principal effects: failure to comply could result in the work not being copyrighted at all, being unenforceable, or being terminated at the end of the first term. Sprigman, *supra* n. 20, at 493. Later enactments imposed requirements as to the recordation of all transfers or assignments of copyrights, failure to comply with which could lead to the transfers being adjudged fraudulent and void against parties who subsequently dealt with the copyright in prescribed ways. Act of 30 June 1834, ch. 157, 4 Stat 778 (1834).

92. Pub. L. 102–307, 106 Stat. 264 (1992) (providing for the automatic renewal of pre-1978 works in their first term of copyright).

93. Implementing legislation was passed in 1988, effective 1 March 1989. Berne Convention Implementation Act 1988; Pub. L. No. 100–568, 102 Stat. 2853. See J. Ginsburg and J. Ker-nochan, ‘One Hundred and Two Years Later: The U.S. Joins the Berne Convention’, (1988) 13 *Columbia-VLA Journal of Law and the Arts*, 1.

94. P. Goldstein, *Goldstein on Copyright* (3rd edn, Aspen, 2006), 3:2–4.

subject-matter jurisdiction over allegations of infringement,⁹⁵ and, for both foreign and US-origin works, significant remedial advantages still attach to registration.⁹⁶

As a result, there is no comprehensive or reliable copyright register that prospective authors might search in order to establish the provenance of prior works that they might want to use in their future creative endeavours. This situation, a number of scholars argue,⁹⁷ impedes development of an efficient licensing scheme because owners of the relevant copyrights often cannot be found easily, with the result that further creative activity that utilizes pre-existing creative works may be impeded. To some extent, these problems might be addressed by the adoption of orphan works schemes, as has recently been proposed in the US.⁹⁸ Broadly, the US proposal would impose on those who would use a copyright-protected work without a license an obligation to perform and document a reasonably diligent search for the copyright owner. Under the proposed legislation, if the search is unsuccessful, but an infringement action is brought nonetheless, the available remedies would be significantly curtailed.⁹⁹ But an orphan works regime may not be enough to curtail the chilling effect of the removal of formalities, however, and some US commentators have advanced a variety of proposals for resurrecting the requirement that works be registered and renewed as a precondition for subsistence of copyright.¹⁰⁰

III.A.3 Constraining the Derivative Works Right

The derivative work right has also been the focus of law reform proposals. A number of US commentators have been concerned with the scope of the exclusive

95. 17 U.S.C. § 411(a).

96. 17 U.S.C. § 412 (attorneys fees and statutory damages).

97. W. Landes and R. Posner, 'Indefinitely Renewable Copyright' (2003) 70 *University of Chicago Law Review*, 471. Lessig, *supra* n. 16.

98. Orphan Works Bill HR. 5439 (2006).

99. Those who were deemed to have performed a reasonably diligent search would have only to pay reasonable compensation for the use of the work, should the copyright owner bring an infringement claim later on. No award for compensation may be granted if the infringement is not performed for a commercial purpose and the infringer ceases the infringement after receiving notice. Furthermore, courts considering requests for injunctive relief would take into account the harm such relief would cause to the party who relied on having performed a reasonably diligent search, and injunctive relief would not be granted to prevent the infringing party from continuing to exploit an unauthorized derivative work. Orphan Works Bill, H.R. 5439.

100. See generally Sprigman, *supra* n. 20; Landes and Posner 'Indefinitely Renewable Copyright' *supra* n. 20. Registration issues are implicated by the continuing controversy over the 'Google Library' project, under which extracts from copyright-protected works would be scanned and made available through various search functions. According to the Complaint filed by publishers in the US District Court for the Southern District of New York, Google has required publishers to provide a list of scanned books they do not want to include in the electronic library (an 'opt out' option). *McGraw Hill v. Google, Inc.*, 05-CV 881, filed 19 October 2005. Requiring publishers to, in effect, register their works in this way in order to limit their incorporation into the Google Library project has echoes of the registration debated in international and domestic law.

right to create derivative works, and specifically, how assertion of this right can chill speech, and even imagination.¹⁰¹ According to one analysis, the First Amendment demands replacement of copyright owners' right to authorize the making of derivative works with a right to share in profits from the exploitation of any derivative work.¹⁰²

Under this proposal,¹⁰³ derivative works would be immune from injunctions and damages. The copyright owner would keep the reproduction right, but could not choose between different parties who might want to use the underlying copyright-protected work to make a derivative work. The copyright owner would be entitled to share in the profits from the exploitation of such works, and from paid performances. However, she would presumably have no basis to object or to receive any remuneration if every amateur dramatic society in the nation performed her work and did not charge admission – or even if they charged only what was required to cover costs.

III.A.4 Public International Law and Domestic Law Reform

Each of these law reform proposals briefly described here makes provocative contributions to the on-going dialogue about copyright's scope. On their own terms, each raises challenging policy issues, but more general analysis of these can be left to other occasions. Here, we note that, in differing ways, each law reform proposal is in tension with public international law norms and legal obligations in the intellectual property and human rights fields. In this Part we do not attempt to provide an exhaustive analysis of the international law issues that are implicated by each idea for reforming domestic US copyright law: the proposals for jettisoning or constraining the reproduction and derivative work rights would need to be tested against the 'three step test', an analysis that we do not attempt here.¹⁰⁴ Our goal is more modest: to suggest that these sources of international law might enhance deliberations as to the viability and the costs and benefits of domestic law reform.

III.A.4.a Public International Intellectual Property Law

For example, even if some authors of some categories of works don't *need* to exploit the reproduction right in order to make a living, public international law obligations require there to be a reproduction right.¹⁰⁵ Hardware and media levies

101. See the works cited at n. 17, *supra*.

102. Rubinfeld, 'Freedom of Imagination' *supra* n. 21.

103. *Idem*.

104. One version of the 'three step test' is set forth in Art. 13 of the TRIPS Agreement: 'Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder'.

105. 'Authors of literary and artistic works protected by this Convention shall have the exclusive right of authorizing the reproduction of these works, in any manner or form.' Berne Convention, Art. 9, para. 1.

are of course not impermissible as a matter of international law,¹⁰⁶ and many copyrights are of course not directly marketed by their owners, particularly in the music context, where there is considerable reliance on aggregated rights management.¹⁰⁷ Even so, jettisoning the reproduction right entirely for a specific category of works would immediately run afoul of the most fundamental guarantees provided to authors under major international intellectual property instruments: the right to authorize the making of reproductions of their works.¹⁰⁸ The proposal may also be inconsistent with the exclusive rights of making their works available to the public that is set forth in later international instruments.¹⁰⁹ The suggestion that authors should not have a fully-fledged derivative works right is also facially inconsistent with the Berne Convention's exclusive right of authors of literary or artistic works to authorize the making of adaptations of their works.¹¹⁰ The proposal that authors should not be able to restrain adaptations would in some cases also implicate the moral rights of authors, which nations are obliged to protect under both the Berne Convention¹¹¹ and TRIPS.¹¹² Likewise, as was noted above, conditioning the subsistence of copyright on compliance with formalities is also forbidden by international law.¹¹³

A number of distinguished commentators have argued that public international law is part of the problem – that powerful copyright industries have hijacked the international law reform agenda.¹¹⁴ Viewed in this light, whether or not a particular domestic law reform proposal conforms with public international norms may seem beside the point. That said, the reality of domestic law reform

106. For example, Art. 5 (2)(b) of the EU Copyright Directive allows member states to 'provide for exceptions or limitations to the reproduction right' of the copyright owner in the case of private copying, as long as the rightholders receive 'fair compensation'. Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society, *Official Journal*, L 167, 22/06/2001 0010–0019, Art. 5 (2)(b). This provision has led some member states to apply levies to sales of blank media, the proceeds from which are then given to collection agencies responsible for distributing the funds among rights holders.

107. See *generally* L. Helfer, 'Collective Management of Copyright and Human Rights: An Uneasy Alliance', in *Collective Management of Copyright and Related Rights* 85 (Daniel J. Gervais ed., 2006).

108. See Berne Convention, Art. 9(1): 'Authors of literary and artistic works protected by this Convention shall have the exclusive right of authorizing the reproduction of these works, in any manner or form.'

109. See WIPO Performances and Phonograms Treaty, adopted on 20 May 2002, 36 I.L.M. 76; WIPO Copyright Treaty, adopted on Mar. 6, 2002, 36 I.L.M. 65.

110. Berne Convention, Art. 12.

111. *Id.*, Art. 6bis.

112. TRIPS Agreement, Art. 13. Compliance with the moral rights provision in Art. 6bis of the Berne Convention is required by TRIPS; however, TRIPS specifically excludes Art. 6bis from the obligations that trigger the WTO dispute process. See Art. 9.1.

113. Berne Convention, Art. 5(2).

114. See, e.g., P. Samuelson, 'The U.S. Digital Agenda at WIPO', (1997) 37 *Virginia Journal of International Law*, 369. See also A. Story, 'Burn Berne: Why the Leading International Copyright Convention Must Be Repealed', (2003) 40 *Houston Law Review* 763.

initiatives is that they now occur in a legal environment in which international law and international norms impose parameters on what is possible to achieve at the domestic law level. Conversations about law reform initiatives would better expose what is at stake if they engaged with the implications of these parameters.

For instance, how might the suggestion that the derivative work right must be transformed into a right to receive profits look if it were accompanied by an analysis of the public international law implications? Assuming *arguendo* that the First Amendment does require constraining the derivative work right,¹¹⁵ the law reform proposal may seem particularly confronting once it is recognized that denying authors a full derivative works right would likely involve unravelling the TRIPS Agreement – or, at the very least, defying the TRIPS obligations and enduring sanctions or an obligation to pay compensation.¹¹⁶ The point perhaps has greater significance if the First Amendment argument is more normative than dispositive – that is, the First Amendment gives normative heft to the argument that the derivative work right should be constrained. If constraining the derivative work right is not dictated by domestic constitutional doctrine, it may be even more appropriate to consider the international law implications of the proposal.¹¹⁷ Serious pursuit of a law reform agenda requiring resurrection of formalities for *all* works would likewise conflict with one of the major achievements of successive drafts of the Berne Convention.¹¹⁸ Either the Convention would need to be changed, or nations adopting such proposals would need to face up to the reality that this could cause the unravelling of intellectual property's incorporation into the world trade regime.

A more limited version of the latter proposal would be to limit the registration requirements to works whose origin was the home country.¹¹⁹ The Berne Convention and TRIPS would allow the US to resurrect formalities as a precondition to the subsistence or sustenance of copyright-protection, but only for US-origin works.¹²⁰

115. Rubinfeld, 'Freedom of Imagination', *supra* n. 21.

116. See, e.g. WT/DS160/ARB25/1, Recourse to Arbitration under Art. 25 of the DSU, Award of the Arbitrators, 9 November 2001.

117. The First Amendment concerns have the potential to become significantly more complex when viewed in an international light. It is not clear, for instance, that the First Amendment demands that US authors' derivative work rights in *foreign* markets be replaced with a right to share in profits.

118. TRIPS incorporates the substantive obligations of Berne, requiring WTO members to comply with Arts 1 through 21 of the Paris (1971) Act of Berne, as well as the Appendix. Compliance with the moral rights provision in Art. 6bis of the Berne Convention is required by TRIPS; however, TRIPS specifically excludes Art. 6bis from the obligations that trigger the WTO dispute process. See TRIPS Art. 9.1.

119. See Sprigman, *supra* n. 20; William M. Landes and Richard A. Posner, *The Economic Structure of Intellectual Property Law* (2003), at 215 n. 15. Under US law, subject matter jurisdiction is denied to courts in infringement actions in respect of unregistered 'US works'. 17 U.S.C. § 411(a).

120. See Ricketson and Ginsburg, *supra* n. 88, at 319, '[I]f local law does not otherwise provide a level of protection consistent with Berne minima, it must nonetheless adhere to these supranational norms when non-local Berne works are at issue'.

Presumably, if formalities are such a good thing, many, perhaps all, nations will adopt such a system, with the prospect that, internationally, there would be a wide variety of different systems in operation – although the start up costs for nations that had long ago jettisoned their registrations systems might be significant. Even so, without unravelling or significantly altering¹²¹ international commitments, individual nations would be permitted to condition copyright protection on compliance with formalities for domestic-origin works. The same point is true of other domestic law reform agenda.

However, even these more modest proposals might lead to some difficult political difficulties. Consider the proposal to jettison the reproduction right. Assuming that it were possible to arrive at a legislative solution that would comply with public international law obligations by denying the reproduction right only to American-origin music, realization of such a proposal could affect the negotiating strategy of the US in its dealings with foreign nations.¹²² Whatever one's views about the ability of the US to 'export' domestic intellectual property norms, this should provoke pause. Some may regret returning the US to the days when its domestic approach to copyright law made it something of an outlier, which apparently made it difficult to adopt the 'moral high ground' in international negotiations relating to intellectual property.¹²³ Others may adopt a contrary view: if jettisoning the reproduction right for domestic-origin musical works makes it more difficult for the US to pursue its international copyright agenda, then this provides another reason to *support* the proposal. Even so, engaging with the international concerns may deepen our appreciation of what might be at stake when new proposals for reform of domestic copyright laws are advanced.¹²⁴

III.A.4.b *International Human Rights Law*

Each of the three proposals discussed here also distils potential problems of consistency with creators' human rights guarantees. We do not claim here that any particular law reform proposal is, as a matter of positive law, inconsistent with the international law of human rights. Nor could we. As the discussion of the General Comment above suggests, it is often not clear exactly what recognition of creators' human rights requires. Moreover, as the discussion above also noted, the General

121. See Sprigman, *supra* n. 20, advocating significant changes to the Berne Convention's approach to formalities.

122. The House Report accompanying the legislation implementing the Berne Convention (Berne Convention Implementation Act 1988; Pub. L. No. 100-568, 102 Stat. 2853) referred to the disadvantage to the US negotiating position in international copyright relations that had resulted from not being a member of the Berne Union. H.R. Rep. No. 609, 100th Cong., 11-20 (1988). The House Report explained that adherence by the US to the Berne Convention would also preclude trading partners from questioning domestic political will to achieve strong and uniform intellectual property protection worldwide.

123. See H.R. Rep. No. 609, 100th Cong., 11-20 (1988).

124. For an example of analysis that does explore the implications of withdrawal from the Berne Convention, see Sprigman, *supra* n. 20, at 552.

Comment itself recognizes the need to balance creators' human rights with other well-recognized human rights. More recent initiatives, such as the UNESCO Convention on the Protection and Promotion of the Diversity of Cultural Expressions which was adopted by the United Nations in 2007¹²⁵ and the draft 'Access to Knowledge Treaty',¹²⁶ should also inform discussion. Even so, human rights provide another lens through which we can examine the question 'what is at stake?' in the context of scrutinizing domestic law reform agenda. And of course, human rights concerns should also inform debates about maintaining the status quo.

For example, there may be some tension between creators' human rights and the suggestion that authors of musical works should not have an independent exclusive reproduction right. Recall that the General Comment linked creators' rights to the ability to make a living from one's own profession. According to one version of this proposal, composers who *performed* music would still be compensated directly from their performances (and, presumably, from payouts from the granting of blanket licenses to live performance venues) and composers would also be compensated from the hardware and media levies, which, for some composer/performers, may transpire to be more lucrative than those provided by enforcing the reproduction right directly.¹²⁷ However, the opportunity for sales of copies and/or phonograms to contribute to an author's livelihood would be foreclosed, and for all but the very few composers who both become stars *and* who perform their music, the possibility of deriving income from merchandizing rights is likely to be meaningless. For many composers, the few thousand dollars a year they might derive from music publishing may be much more relevant to their ability to make a living from their work than merchandising income. Denying composers and musicians the ability to earn income by directly marketing reproductions of their works to their public seems at least facially inconsistent with a human rights guarantee that is closely linked to the 'opportunity to gain one's living by work which one freely chooses'.¹²⁸

This does not necessarily portend a breach of creators' human rights. It might transpire, for instance, that income from levies may be more meaningful in the long term than sales and distribution of copies. Furthermore, General Comment 17 does not specify precisely the sources of funds that are relevant to securing authors' income. For example management of aggregated rights may be required by the human rights obligations: given the prohibitive transaction costs associated with individualized enforcement of copyrights, efficient and fair collective rights management may be the only realistic way to secure authors' right to derive income from their work.¹²⁹ The new economics of distribution of copyright-protected

125. United Nations Educational, Scientific and Cultural Organization, Convention on the Protection and Promotion of the Diversity of Cultural Expressions, 20 October 2005, 33rd session of the General Conference.

126. Treaty on Access to Knowledge (draft, 9 May 2005) <www.cptech.org/a2k/a2k_treaty_may9.pdf>, (4 November 2007).

127. See, e.g., Fisher, *supra* n. 85 at 203.

128. General Comment No. 17, para. 4.

129. See *generally* Helfer, 'Collective Management', *supra* n. 14.

works may also make this observation true of hardware and media levies. Even so, the text of the General Comment should at least alert us to the possibility that human rights issues may be implicated by telling composers that they may derive income *only* from performances, merchandizing and levies – and *not* from direct sales of copies.

Curtailling the derivative work right similarly risks depriving authors of a significant source of income. Authors who derive a significant portion of their livelihood through *copyright* income, in contrast to those whose principal income sources are through foundation grants, patronage, or academic salaries,¹³⁰ will know the difference to their income position that income from exploiting their derivative works right can make. Even for a modestly successful writer, sale of a film option, for example, can provide rent or mortgage just long enough to complete and sell the next work. It is difficult to assess how the price for derivative works might be affected by such a scheme, but in all likelihood, the overall price would go down, due to the increased competition from the ‘free’ derivative works. Hence, were this proposal adopted, it could damage, if not destroy, one important source of income that is often critically important to the livelihood of working authors.

As was noted above, denying authors’ control over the promulgation of unlicensed derivative works may also impinge upon creators’ moral interests, a key point of cross-over between the protections afforded by intellectual property instruments and human rights guarantees.¹³¹ The connection between human rights and moral rights was made at a number of points in the drafting Article 27 of the Universal Declaration, the predecessor to Article 15(1)(c) of the ICESCR. In some aspects, the recognition of creators’ moral interests seems to mirror the provision for moral rights in international intellectual property instruments, most notably the Berne Convention. At its most specific, the protection of moral rights recognized in the General Comment extends only to the right ‘to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, their productions that would be prejudicial to their honour or reputation’.¹³² This of course tracks the language in Article 6bis of the Berne Convention.¹³³

If the protection of creators’ human rights to their moral interests offers no more protection than is afforded by intellectual property law, then it might be thought that evaluation of the human rights implications of denying authors the power to object to the creation of unlicensed derivative works would need to be done on a case by case basis. Some unlicensed derivative works may be prejudicial to the author’s honour or reputation, but other adaptations could be perfectly fine,

130. See generally G. Austin, ‘The Metamorphosis of Authors’ Rights in the Digital Era’ (2005) 28 *Columbia Journal of Law & Arts*, 397.

131. See generally R. Gana, ‘The Myth of Development’, *supra* n. 55, 318–323.

132. General Comment No. 17, para. 13.

133. ‘Independently of the author’s economic rights, and even after the transfer of the said rights, the author shall have the right to claim authorship of the work and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, the said work, which would be prejudicial to his honor or reputation.’ Berne Convention, Art. 6bis.

and, presumably would not impugn the original author's honour or reputation. It is possible, however, that creators' human rights protection may go further than these minimal protections for authors' moral rights. At a number of points, however, the General Comment emphasizes the close connection between authors and their creations, a connection that may recognize a violation for any number of unauthorized *uses*, regardless of whether the resulting derivative work was prejudicial to the author's honour or reputation. According to one commentator the connection between authors and their works establishes the very basis for recognizing human rights associated with authorship.¹³⁴ And in some domestic legal systems, moral rights protection goes further than that offered by Article 6bis of the Berne Convention, whose somewhat cabined quality results from significant conflict and compromise in the course of its drafting.¹³⁵ The Berne Convention does not, for instance, create an international obligation comparable to the right of divulgation that exists under a number of national copyright laws – the right to decide whether a work will be divulged to the public at all.¹³⁶

Finally, all of the proposals for reform of copyright laws discussed here, even if limited to domestic-origin works, are likely to implicate the right to be free from discrimination.¹³⁷ Part of the achievement of the international intellectual property system was the adoption of broad non-discrimination principles:¹³⁸ in the copyright context, for instance, international agreements were animated by a concern that foreigners should be treated as well as domestic authors.¹³⁹ Most favoured nation obligations add to national treatment obligations; they preclude domestic nations from discriminating in the treatment they afford to intellectual property proprietors from other nations.¹⁴⁰ Human rights obligations in the intellectual property context may add to these obligations: unlike the international

134. M. Vivant, 'Authors' Rights, Human Rights', (1997) 174 *Revue Internationale du Droit D'Auteur* 60.

135. See Ricketson and Ginsburg, *supra* n. 88.

136. See, e.g., French Copyright Act, Art. L 121–2 'The author alone shall have the right to divulge his work.' <<http://195.83.177.9/code/liste.phtml?lang=uk&c=36&r=2497>>, 3 November 2007. US copyright law provides more limited guarantees as to first publication rights. See *Harper & Row v. Nation Enterprises*, 471 U.S. 539 (1985).

137. The right to be free from discrimination on the grounds of national origin is guaranteed by the ICESCR, Art. 2.2: 'The States Parties to the present Covenant undertake to guarantee that the rights enunciated . . . will be exercised without discrimination of any kind as to race, colour, sex, language, religion, political or other opinion, national or social origin, property birth or other status.'

138. Famously, the European Court of Justice has established a general non-discrimination principle in the administration of intellectual property rights. See *Phil Collins v. Imtrat Handelsgesellschaft*, Case C-92/92, *EMI v. Patricia*, Case C-326/92 [1993] 3 C.M.L.R. 773 (E.C.J. 1993).

139. Ricketson and Ginsburg, *supra* n. 88 at 6.74 et seq.

140. Art. 4 of the TRIPS Agreement sets forth the most favoured nation obligation that is imposed on all members of the WTO: 'With regard to the protection of intellectual property, any advantage, favour, privilege or immunity granted by a Member to the nationals of any other country shall be accorded immediately and unconditionally to the nationals of all other Members.'

intellectual property instruments which concern relations external to the nation state, human rights obligations are, among other things, promises to the international community about how nations will treat their own.¹⁴¹

Creators' human rights are a possible vehicle for domesticating non-discrimination principles in intellectual property law. General Comment 17 characterizes freedom from discrimination as a key obligation accompanying the guarantee of creators' human rights.¹⁴² As is typical of human rights obligations in the economic and social context, some aspects of the human right for creators might only be progressively realized, as resources permit.¹⁴³ But other aspects raise immediate obligations, including a broad non-discrimination principle precluding states from discriminating in how they protect authors' material and moral interests in the fruits of their creativity. Even if the public international intellectual property law would permit discriminating against domestic authors by providing less expansive rights than are afforded to foreign-origin works, this approach may be more troubling when viewed through a human rights lens.¹⁴⁴ The approach would, for most practical purposes, be tantamount to discriminating against certain authors due to their national origin. The same issues would arise if governments adopted either of the other proposals – jettisoning the reproduction right or curtailing the derivative work right – just for domestic-origin works.

IV. CONCLUSION

Rightly or wrongly, the public international law of intellectual property imposes parameters on the domestic law reform agenda. Within the legislative branch, of course, cognizance of international obligations in the intellectual property context is now a necessity, given the integration of intellectual property obligations within the world trade regime. Without engaging with public international law parameters, all agenda for reform of domestic law risks being 'thought experiment'. We do not decry the utility of thought experiments in the context of domestic copyright law policy – indeed, such work is enormously valuable for the possibilities it offers *beyond* legal and institutional impediments. Even so, engaging with relevant public international law parameters can also provide necessary insights about what any particular domestic law reform agenda puts at stake.

Similar points can be made about the public international law of human rights. We do not propose that recognition of creators' human rights precludes adoption of any of the law reform suggestions discussed above, either as a normative matter, or as a matter of dispositive legal principle. Much more work will need to be

141. See *generally* Okediji, 'The Limits of Development Strategies', *supra* n. 11, at 358. Human rights obligations may thus provide the opportunity to 'domesticate' key aspects of the public international law of intellectual property by making it more difficult for nations to treat domestic creators differently from foreigners.

142. General Comment No. 17, para. 20.

143. *Id.*, para. 26.

144. See General Comment No. 17, para. 11.

done before clear ‘human-rights-consistent’ principles will emerge that have the capacity to guide domestic law reform initiatives toward specific outcomes. Moreover, legal obligations relating to creators’ human rights do not of course enjoy the same dispositive ‘bite’ as specific obligations in the international intellectual property regime.¹⁴⁵ But creators’ human rights should have at least some, perhaps powerful, normative claims that should be reckoned with in the context of domestic law reform agenda. Acknowledging creators’ human rights may deepen our understanding of the implications of law reform deliberations. Unlike the public international law of intellectual property, the human rights lens is not predominantly crafted out of instrumentalist concerns. Acknowledging creators’ human rights in deliberations on possibilities for reform of domestic copyright laws can focus attention on the importance of creative work, on the vulnerability of the people who do it, and on the connections between creativity and the dignity of the human person.

145. See generally Dinah Sheldon, *Remedies in International Human Rights* (Oxford 2005).

Chapter 11

The Conflict between the Human Right to Education and Copyright

*Sharon E. Foster**

Caution may be needed to avoid giving normative effect to rules which merely reflect local or temporary factors.

I. INTRODUCTION

There are quite a few treaties and conventions that address the issue of the human right to education, however, many of them deal with the issue of gender and racial discrimination in access to education.² While the elimination of such discrimination is critical to the realization of the human right to education, this chapter discusses the particular problem of potential conflicts between the realization of the human right to free primary education and the human right of authors to

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1. Ian Brownlie, *Principles of Public International Law*, 5th edn, (2002) (hereinafter 'Brownlie') at 256.
2. For example, the Convention on the Elimination of all Forms of Discrimination Against Women, G.A. res. 34/180, 34 U.N. GAOR Supp. (No. 46) at 193, U.N. Doc. A/34/46 (3 September 1981); and the International Convention on the Elimination of all Forms of Racial Discrimination, G.A. res. 2106 (XX), Annex, 20 U.N. GAOR Supp. (No. 14) at 47, U.N. Doc. A/6014 (1966), 660 U.N.T.S. 195, (4 January 1969).

material interests in their creations usually realized through domestic copyright legislation.

The critical problem of the potential conflicts arises from the fact that the educational materials, in which authors may have a material interest, are critical to the realization of the human right to education. The World Bank in its World Development Report 2004 noted that the problems in the educational systems for some States were primarily due to unaffordable access, dysfunctional schools, low technical quality, low responsiveness and stagnant productivity.³ While all factors need to be addressed, providing access to instructional materials has the greatest impact.⁴ For example, in North East Brazil during the 1980s increases in test scores were measured based upon dollars spent on different inputs. Increased teacher's salaries resulted in an increase of 1; ensuring all teachers have three years of secondary schooling resulted in an increase of 1.9; providing tables, chairs and other hardware for the teachers and students resulted in an increase of 7.7; and providing a packet of instructional materials (access) resulted in an increase of 19.4.⁵ In India during the 1990s a similar study was conducted. Increased teacher's salaries resulted in an increase of 1; facility improvements resulted in an increase of 1.2; one additional square foot of space per student resulted in an increase of 1.7; and providing a packet of instructional materials (access) resulted in an increase of 14.⁶

There are three principle documents that deal with the right to free primary education; The Universal Declaration of Human Rights⁷ (UDHR), the International Covenant on Economic, Social and Cultural Rights⁸ (ICESCR), and the Convention on the Rights of the Child (CRC).⁹ Section II provides the historical context for the human right to education through an examination of the creation of the United Nations Charter and the UDHR. Both of these documents created vague rights in order to achieve consensus and provide flexibility. But, as we shall see, it is the attempt to introduce normative rules that creates the potential for conflict.

Section III provides the relevant language from the UDHR, the ICESCR and the CRC relating to the human right to free primary education and available interpretations for these provisions. Specifically, what is meant by 'primary education' and 'available free'. These terms pose the most immediate conflict with the human right of authors to their material interests in their creations for their interpretation will tell us what potentially protected materials need to be made available and who, if anybody, is to pay for them.

3. *World Development Report* 2004, 111, available at econ.worldbank.org/wds/wds 2004 (last accessed 23 April 2008).

4. *Id.* at 112–16.

5. *Id.* at 116 fig. 7.3.

6. *Id.* at 116 fig. 7.3.

7. G.A. res. 217A (III), U.N. Doc A/810 at 71 (1948).

8. G.A. res. 2200A (XXI), 21 U.N. GAOR Supp. (No. 16) at 49, U.N. Doc. A/6316 (1966), 993 U.N.T.S. 3, (3 January 1976).

9. G.A. res. 44/25, annex, 44 U.N. GAOR Supp. (No. 49) at 167, U.N. Doc. A/44/49 (1989), (2 September 1990).

In section IV of this chapter, author's human right to moral and material interests is discussed. Again, as in section III, the historical background, specific language and interpretation is addressed. While moral interests are mentioned, the main focus throughout this chapter is on the material interest as that interest presents the primary problem of conflict. Here we see that the UDHR and ICESCR provide the human right protection to authors material interests creating the first conflict discussed in section VI, the internal conflict. An internal conflict is presented when two or more provisions in the same document appear to distract from the ability to comply with one or the other, or both.

The agreement on Trade-Related Aspects of Intellectual Property Rights¹⁰ (TRIPS) is discussed in section V as it has been given much attention in academic circles and the international community in creating an external conflict with the human right to education. An external conflict becomes a problem when provisions in two separate documents have conflicting requirements. For example, TRIPS incorporated the Berne Convention for the Protection of Literary and Artistic Works¹¹ (Berne) except for moral rights.¹² Berne provides for protection of authors economic rights¹³ which seems to basically equate to material interests.¹⁴ This requirement may conflict with the requirement to provide primary education, for free, contained in the ICESCR.

Sections VI and VII, address the internal and external conflicts and how to resolve such conflicts when they occur. Here, there seems to be consensus that a balancing test, balancing the educational need for educational materials that may be protected with the right of authors to material interests, is the best resolution.

Finally, section VII addresses the false conflict paradigm. The false conflict arises in situations where there is market failure; that is to say in situations where the market in question does not have the economic ability to pay for educational materials. In such a situation the authors of the educational materials have no material interest or economic rights because there is no commercial gain to be had.

II. THE FOUNDATION FOR THE HUMAN RIGHT OF EDUCATION: THE UNITED NATIONS CHARTER AND THE UNIVERSAL DECLARATION OF HUMAN RIGHTS

The United Nations Charter, adopted in 1945, was deliberately vague on the human rights issue, as it was believed that a consensus would never be reached in the short

10. Marrakesh Agreement Establishing the World Trade Organization Annex 1C, 1869 *U.N.T.S.* 157; 33 *I.L.M.* 1125, (Marrakesh, 15 April 1994).

11. (Paris 1971) 828 *UNTS* 221.

12. TRIPS, *supra*. n. 10 at Art. 9; James J. Fawcett and Paul Torremans, *Intellectual Property and Private International Law* 480 (1998).

13. Berne, *supra*. n. 11 at Arts 6bis, 8-9 and 13.

14. See *WTO Panel Report* in United States-section 110(5) of the Copyright Act, WT/DS160/R, para. 6.74, 15 June 2000 (hereinafter *WTO Panel Report*), available at <<http://homepages.law.asu.edu/~dkarjala/InternationalIP/WTO-USSec110%285%29PanRep.html>>, (last accessed 23 April 2008).

time period allotted at the San Francisco Conference to adopt the Charter.¹⁵ Accordingly, all that was stated on the issue was:

Preamble: WE THE PEOPLES OF THE UNITED NATIONS DETERMINED . . . to reaffirm faith in fundamental human rights, in the dignity and worth of the human person, in the equal rights of men and women . . .

Chapter 1, Article 1, The Purposes of the United Nations are: . . .

3. To achieve international co-operation in solving international problems of [a] . . . humanitarian character, and in promoting and encouraging respect for human rights . . .

Chapter IV, Article 13, The General Assembly:

1. The General Assembly shall initiate studies and make recommendations for the purpose of: . . . b. assisting in the realization of human rights . . .

Chapter IX, International Economic and Social Co-operation . . . Article 55

With a view to the creation of conditions of stability and well-being . . . the United Nations shall promote: . . . c. universal respect for, and observance of, human rights . . .

Chapter X, Composition of the Economic and Social Council . . .

Functions and Powers . . . Article 62

2(A). It may make recommendations for the purpose of promoting respect for, and observance of, human rights.¹⁶

From this vague language we see that the concept of human rights was not an operative principle of the United Nations Charter when that document was created. Rather, it was a desideratum of the Charter as opposed to a legal obligation.¹⁷ For example, the United Nations Charter is silent on identifying particular rights as human rights. Accordingly, after the United Nations Charter was approved a sub-committee was appointed by the Economic and Social Council (ECOSOC) in 1945–1947 to address the issue of what were these ‘human rights’ alluded to in the United Nations Charter. The result of the sub-committee’s work was loosely articulated in the UDHR.¹⁸

John Humphrey, an international lawyer from Canada, prepared the first draft of the UDHR.¹⁹ Humphrey gathered materials from all over the world in preparing what would be the first working draft.²⁰ The drafting group received the

15. Mary Ann Glendon, *A World Made New*, Random House Inc., 2001, p.5 (hereinafter ‘Glendon’).

16. United Nations Charter, available at <www.un.org/aboutun/charter/>, (last accessed 23 April 2008).

17. See Michla Pomerance, *Self-Determination in Law and Practice: The New Doctrine in the United Nations* 9 *The Hague Kluwer Law International* 1982 p.9.

18. Johannes Morsink, *The Universal Declaration of Human Rights* (University of Pennsylvania Press, 1999), pp.1–12, (1999)(hereinafter ‘Morsink’).

19. Glendon, *supra*. n. 15 at 43, 48; Henry J. Steiner and Philip Alston, *International Human Rights in Context: Law Politics Morals* 138 OUP, New York (2nd edn 2000) (hereinafter ‘Steiner’ Morsink, *supra* n. 18 at pp. 2, 5–6).

20. Glendon, *supra*. n. 15 at 49–50.

Humphrey draft in June of 1947.²¹ René Cassin, the delegate from France, was assigned the task of revising the Humphrey draft in June, 1947.²² A working group then took the Cassin draft and made revisions producing what has been termed the Geneva Draft in December, 1947.²³ The Geneva draft received comments and the Human Rights Commission drafting committee met again in early May, 1948 to revise the Geneva draft.²⁴ The entire committee met to further revise the Geneva draft in June of 1948.²⁵

Through out the drafting process there were admonitions to avoid creating a document that reflected an emphasis on a particular culture, religion, socio-economic system, political or philosophical beliefs.²⁶ To avoid claims of bias and build consensus the drafters created a document that was envisioned as common standards not rigid uniform practices.²⁷

The UDHR passed 10 December 1948 with forty-eight in favour and eight abstentions. There were no negative votes. Honduras and Yemen were absent.²⁸ The pertinent provision of the UDHR that relates to education is:

Article 26

(1) Everyone has the right to education. Education shall be free, at least in the elementary and fundamental stages. Elementary education shall be compulsory. Technical and professional education shall be made generally available and higher education shall be equally accessible to all on the basis of merit.

In Article 26(1) education is understood to be in a broad sense, the right to a free, fundamental education.²⁹ 'Free' probably means free of charge but certain expenses may have to be covered by the students.³⁰ This fundamental education curriculum was probably to be left to the states to determine.³¹ Elementary education is to be compulsory but there is no clear distinction between fundamental education and elementary education.³² Most likely elementary education includes such things as reading, writing, arithmetic and other basic needs to function in a society.³³

21. Glendon, *supra*. n. 15 at 54, 58; Morsink, *supra*. n. 19 at 5.

22. Glendon, *supra*. n. 15 at 61; Morsink, *supra*. n. 19 at 8–9.

23. Glendon, *supra*. n. 15 at 79–94; Morsink, *supra*. n. 19 at 9–10.

24. Glendon, *supra*. n. 15 at 107; Morsink, *supra*. n. 19 at 10–11.

25. Glendon, *supra*. n. 15 at 111–119; Steiner, *supra*. n. 19 at 139; Morsink, *supra*. n. 19 at 11.

26. Glendon, *supra*. n. 15 at 38–43, 68–70, 73–78, 89–92, 140–42, 161, 222–23; Steiner, *supra*. n. 19 at 139; Morsink, *supra*. n. 19 at 4–5, 24.

27. Glendon, *supra*. n. 15 at 230.

28. Glendon, *supra*. n. 15 at 169–70.

29. *The Universal Declaration Of Human Rights: A Commentary* (ed. Asbjörn Eide, Pentti Arajärvi, Gudmundur Alfredsson, Göran Melander, Lars Adam Rehof and Allan Rosas, with collaboration of Theresa Swinehart, 408 Scandinavian University Press (1992)) (hereinafter 'Commentary').

30. *Id.*

31. Commentary (Pentti Arajärvi), *supra*. n. 29 at 408.

32. *Id.* at 408–09.

33. *Id.*

There have been attempts to assert that the UDHR is legally binding under international law through various mechanisms. Arguments based upon treaty law and customary international law,³⁴ are the most prominent. Declarations, such as the UDHR, do not have the force of a treaty or convention³⁵ but some core provisions of the UDHR may be considered customary and, thus, potentially binding.³⁶ However, the right to an education as well as the moral and material interests of authors reflected in copyright laws has not risen to the level of customary international law. Not only is there a dearth of authority to indicate such customary international law, there is no general and consistent practice necessary for the distinction of customary international law.

III. APPLICABLE TREATIES AND CONVENTIONS ON THE RIGHT TO EDUCATION AND HOW THEY HAVE BEEN INTERPRETED

Recognizing the aspiration as opposed to binding nature of the UDHR there was a move to propose a binding treaty addressing the goals stated in the UDHR. It was urged by some that it would be best to create two separate treaties; one addressing economic rights and another addressing political rights.³⁷ This was the course taken by the Sub-Committee and the drafting of the ICESCR and the International Convention on Civil and Political Rights (ICCPR) commenced shortly after the passage of the UDHR. For purposes of the right to education, the ICESCR is the critical document and, thus, the one addressed in this chapter.

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34. Customary international law is evidenced by numerous sources such as diplomatic correspondence, policy statements, press releases, the opinions of official legal advisors, official manuals on legal questions, comments by governments on drafts, recitals in treaties and other international instruments, a pattern of treaties in the same form, practices of international organs, judicial decisions and United Nations resolutions. Although no particular duration of a practice is required to establish custom, a longer duration may help establish consistency and generality of the practice, which is required. With respect to consistency of the practice, substantial uniformity is required. As for generality, this compliments consistency and looks to the conduct of a state such as acquiescence. However, a state may contract out of custom in the process of its formation as a persistent objector. Brownlie, *supra*. n. 1 at 5–10.
35. A treaty is an 'international agreement concluded between States in written form and governed by international law', (Vienna Convention on the Law of Treaties, Art. 2(1)(a), 23 May 1969, 1155 U.N.T.S. 331; Restatement 3rd of Foreign Relations Law Ch.301(1) 1987. A covenant, like a treaty, must be capable of legal enforcement. The term 'declaration' has officially been defined by the United Nations Secretariat as: 'a formal and solemn instrument, suitable for rare occasions when principles of great and lasting significance are being enunciated'. Glendon, *supra*. n. 15 at 174 (citing to E/CN.4/L.610).
36. *Yearbook of the United Nations, Special Edition United Nations Fiftieth Anniversary 1945–1995*, Dept. of Public Information, United Nations, N.Y. (1995) 295. Customary provisions would include: Art.2 (to the extent that it is a prohibition on racial discrimination; Art.4 (slavery prohibition); and Art.5 (torture prohibition).
37. Steiner, *supra*. n. 19 at 139.

III.A THE ICESCR

The provisions in the final version of the ICESCR that relate to the right to free, primary education are:

Article 13 . . .

2. The States Parties to the present Covenant recognize that, with a view to achieving the full realization of this right:

(a) Primary education shall be compulsory and available free to all; . . .

(d) Fundamental education shall be encouraged or intensified as far as possible for those persons who have not received or completed the whole period of their primary education; . . .

Article 14

Each State Party to the present Covenant which, at the time of becoming a Party, has not been able to secure in its metropolitan territory or other territories under its jurisdiction compulsory primary education, free of charge, undertakes, within two years, to work out and adopt a detailed plan of action for the progressive implementation, within a reasonable number of years, to be fixed in the plan, of the principle of compulsory education free of charge for all.

The right to education articulated in Articles 13 and 14 is considered an economic right, a social right, a cultural right, a civil right and a political right given the fact that education is central to the realization of all of these rights.³⁸ Because of this critical importance, primary education is compulsory, meaning that neither parents, nor guardians, nor State may treat primary education as optional.³⁹

Primary education must be available without charge including hidden or indirect charges that may serve as a barrier to the right of the child to receive a primary education.⁴⁰ However, if a State party has inadequate financial resources to provide free, primary education other State parties have an obligation to assist.⁴¹ Just what is meant by ‘assist’ has yet to be determined.

Primary education has been defined as: the basic learning needs of all children are satisfied, and take into account the culture, needs and opportunities of the community.⁴² Basic learning needs are defined as:

essential learning tools (such as literacy, oral expression, numeracy, and problem solving) and the basic learning content (such as knowledge, skills,

38. Committee on Economic, Social and Cultural Rights, Plans of action for primary education (Art. 14): 10/05/99 E/C.12/1999/4, Substantive Issues Arising in the Implementation of the International Covenant on Economic, Social and Cultural Rights: General Comment 11 (hereinafter ‘GC11’) at para. 2.

39. *Id.* at para. 6.

40. *Id.* at para. 7.

41. *Id.* at para. 9.

42. Committee on Economic, Social and Cultural Rights, The right to education (Art.13): 08/12/99, E/C.12/1999/10, Implementation of the International Covenant on Economic, Social and Cultural Rights, General Comment 13 (hereinafter ‘GC13’) at para. 9 (citing to The World Declaration on Education for All, at Art. 1).

values, and attitudes) required by human beings to be able to survive, to develop their full capacities, to live and work in dignity, to participate fully in development, to improve the quality of their lives, to make informed decisions, and to continue learning.⁴³

States are primarily responsible for achieving human rights, such as the right to education for their people, but other actors are responsible as well including corporations.⁴⁴

III.B THE CONVENTION ON THE RIGHTS OF THE CHILD (CRC)

The pertinent language in the CRC relating to free primary education is Article 28 which provides:

1. States Parties recognize the right of the child to education, and with a view to achieving this right progressively and on the basis of equal opportunity, they shall, in particular:

(a) Make primary education compulsory and available free to all;

As with the ICESCR, the CRC requirement of compulsory and free primary education would seem to have a similar effect and, thus, interpretation.

IV. APPLICABLE HUMAN RIGHTS TREATIES ON AUTHORS MORAL AND MATERIAL INTERESTS

For better or worse the moral and material interests of authors were included in the UDHR and the ICESCR. This fact can not legitimately be denied despite the questionability of the appropriateness for the inclusion of such rights as a human right.⁴⁵ Indeed, during the drafting of these documents the possible conflicts that could arise due to the inclusion of such rights were, briefly, discussed.

43. *Id.*

44. *Economic, Social and Cultural Rights, Status of the International Covenants on Human Rights*, Report by Hatem Kotrane, independent expert on the question of a Draft Protocol For the ICESCR, E/CN.4/2003/53 para. 12 13 January 2003; Glendon, *supra*. n. 15 at 69, 114.

45. Sub-Commission on Human Rights Resolution 2000/7, E/CN.4/Sub.2/2000/7 (17 August 2000) (hereinafter 'Resolution 2000/7') para. 1; Comm. on Econ., Soc. & Cultural Rights, General Comment No. 17: The Right of Everyone to Benefit from the Protection of the Moral and Material Interests Resulting from Any Scientific, Literary or Artistic Production of Which He or She is the Author (Art. 15(1)(c)), U.N. Doc. E/C.12/GC/17 (12 January 2006) [hereinafter General Comment No. 17], available at <[www.unhcr.ch/tbs/doc.nsf/898586b1dc7b4043c1256a450044f331/03902145edbbe797c125711500584ea8/\\$FILE/G0640060.pdf](http://www.unhcr.ch/tbs/doc.nsf/898586b1dc7b4043c1256a450044f331/03902145edbbe797c125711500584ea8/$FILE/G0640060.pdf)> (last accessed 23 April 2008) (hereinafter 'GC17').

IV.A ARTICLE 27 OF THE UDHR SPECIFIES THAT THE MORAL AND MATERIAL INTERESTS OF AUTHORS ARE A HUMAN RIGHT

While the history of the drafting of the UDHR indicates some reluctance to include protection of moral and material interests of authors as a human right they were ultimately included. René Cassin, the delegate from France who was assigned the task of revising the Humphrey draft of the UDHR in June, 1947 included a provision protecting author's rights.⁴⁶ A working group then took the Cassin draft and made revisions producing the Geneva Draft in December, 1947.⁴⁷ In this draft the author's rights provision was deleted. The Geneva Draft received comments and the Human Rights Commission drafting committee met again in early May, 1948 to revise the Geneva Draft.⁴⁸ The entire committee met to revise again in June, 1948 and added back the author's rights provision.⁴⁹

There was not much disagreement regarding the right to enjoy the benefits of scientific advances to be included in Article 27(1) of the UDHR.⁵⁰ There was more debate regarding the issue of author's rights contained in what became Article 27(2). The French delegation proposed including moral and material interests but was more concerned with moral rights.⁵¹ The French argued that, in addition to remuneration, an author should retain a right over his work that would not disappear even after the work entered the public domain.⁵² The Chinese delegate, Peng-Chun Chang, later stated that this moral right was not merely to protect the artist but also the public to ensure that the work was available in its original form.⁵³

Although the Human Rights Commission rejected the provision, it passed in the Third Committee though objections were raised that these moral and material interests were not, properly speaking, a basic human right.⁵⁴ Some delegates from the Third Committee voted for this provision with the moral rights issue in mind and others voted for it in the hope that it would be a step towards internationalization of copyright.⁵⁵ Article 27 of the UDHR states:

ARTICLE 27

(1) Everyone has the right freely to participate in the cultural life of the community, to enjoy the arts and to share in scientific advancement and its benefits.

46. Glendon, *supra*. n. 15 at 61; Morsink, *supra*. n. 19 at 220.

47. Glendon; *supra*. n. 15 at 61; Morsink, *supra*. n. 19 at 9–10.

48. Glendon, *supra*. n. 15 at 107; Morsink, *supra*. n. 19 at 9.

49. Glendon, *supra*. n. 15 at 111–119; Morsink, *supra*. n. 19 at 10–11.

50. Green, *supra*. n. 35 at para. 4 (citing to Johannes Morsink, the Universal Declaration of Human Rights: Origins, Drafting and Intent. (1999)); Morsink, *supra*. n. 19 at 217–19.

51. Green, *supra*. n. 35 at para. 5; Morsink, *supra*. n. 19 at 219–21.

52. Green, *supra*. n. 35 at para. 5. Public domain is defined as expressions that are available for common use rather than owned. William M. Landes and Richard A. Posner: *The Economic Structure of Intellectual Property Law* ('economic structure') 14–15 (2003).

53. Green, *supra*. n. 35 at para. 5; Morsink, *supra*. n. 19 at 221–22.

54. Green, *supra*. n. 35 at para. 6; Morsink, *supra*. n. 19 at 220.

55. Green, *supra*. n. 35 at para. 6.

(2) Everyone has the right to the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.⁵⁶

Article 27(1) addresses enjoyment rights relating to the arts and scientific benefits and can be interpreted as applying to both groups and individuals.⁵⁷ However, it is limited to the enjoyment of arts and scientific benefits of the community and it is unclear if this means the domestic community or the international community. It is also unclear if these rights are to be interpreted as requiring free enjoyment, inexpensive enjoyment or just non-discriminatory enjoyment. This is the section that is associated with the access quotient in the copyright balance.⁵⁸ Indeed, in addressing the apparent conflict between education and author's rights several commentators point to Article 27(1) for the proposition that it requires access to knowledge.⁵⁹

Article 27(2) is a declaration that author's rights relating to moral and material interests have been given the rank of a human right.⁶⁰ It is an individual right delegated to states and, as such, is more similar to a civil and political right and has certain similarities with property rights.⁶¹ It imposes on states restrictions on creating obstacles to impede the ability of individuals to obtain these rights and has some similarities to the right to freedom of expression, freedom of thought, conscience and religion which are also civil and political rights.⁶²

René Cassin observed in 1960 that Article 27 (2) was still 'shrouded in penumbra'.⁶³ It is claimed that the UDHR and the ICESCR mark the apex of the French vision of literary and artistic property.⁶⁴ Such a statement gives an improper implication of a dominate philosophical view in these documents which runs counter to the *travaux préparatoires* expressing the desire to create, at least with respect to the UDHR, a document of a universal nature.⁶⁵ Still, Cassin was correct in asserting that Article 27(2) was then as it is now unclear regarding the reason for its inclusion. The language of Article 27(2) is, however, clear in granting author's moral and material interests the status of human rights.

56. UDHR, *supra*. n. 7.

57. Commentary (Göran Melander), *supra*. n. 29 at 430.

58. Resolution 2000/7, *supra*. para. 2, n. 45.

59. Dr. Audrey R. Chapman (American Association For The Advancement Of Science), *Implementation Of The International Covenant On Economic, Social And Cultural Rights*, E/CI.12/2000/12, 3 October 2000 (Discussion Paper) (hereinafter 'Chapman'). at 3, para. 29: *Economic, Social and Cultural Rights, the Impact of the Agreement on Trade-Related Aspects of Intellectual Property Rights on Human Rights, Report of the High Commissioner – Commission on Human Rights*, E/CN.4/Sub.2/2001/13 (27 June 2001) (hereinafter 'HC Report') at para. 10.

60. Commentary, *supra*. n. 29 at 431.

61. *Id.* at 430–31.

62. Commentary, *supra*. n. 29 at 432.

63. François Dessemontet, Copyright and Human Rights, at <www.unil.ch/cedidac/articles/copyrightandhumanrights.pdf>, at para. 4 (last accessed 23 April 2008).

64. *Id.* at para. 5

65. Glendon, *supra*. n. 15 at 65, 69.

IV.B ARTICLE 15 OF THE ICESCR SPECIFIES THAT ‘THE MORAL AND MATERIAL INTERESTS OF AUTHORS ARE A HUMAN RIGHT’

In drafting the ICESCR the moral and material interests provision found in Article 15(1) was explicitly excluded from several drafts and only made its way into that document during the debate of the Third Committee of the General Assembly in 1957, three years after the Commission on Human Rights had completed its work and five years after it had last been debated.⁶⁶

With respect to Article 15(1) of the ICESCR, there was some dissention regarding having its provisions dovetail the UDHR. In particular, the US delegate, Eleanor Roosevelt, stated that the documents should not be a mirror image as these documents had very different legal effects. Again there seemed to be little dissention over a provision that granted people the right to benefit from the advances of science,⁶⁷ but author’s rights were more contentious. The United Nations Educational, Scientific and Cultural Organization UNESCO and the French supported the inclusion of author’s rights. The UNESCO representative, Havet, stated that its inclusion would help to harmonize national and international legislation and practice in this field.⁶⁸ The French delegate argued that its inclusion stressed that the moral and material interest of creators should be safeguarded.⁶⁹ The US delegate, speaking in opposition, pointed out that UNESCO was studying the issue of copyright and that until the study of the complexities of the subject had been completed it would be impossible to include the provision as a general principle.⁷⁰ The Chilean delegate, Hernan Santa Cruz, also voiced opposition with the concern that this was not a question of a fundamental human right.⁷¹ The provision was rejected at this point seven to seven with four abstentions.⁷²

A year later, in May of 1952 the issue again came up with the US, the UK and Yugoslavia against the inclusion of the author’s rights provision for the reasons articulated a year before by the US. France and UNESCO were still in favour of its inclusion.⁷³ The Chilean delegate, Valenzuela, articulated his state’s concern in voting against the provision that the rights of the author should not be protected without safeguards for the under-developed states that would be harmed by such a monopoly as the developed states controlled a significant amount of the technical knowledge.⁷⁴ The French delegate did not believe such protection presented a *grave danger* and that, in any event, the absence of such protection was not a solution for under-developed states.⁷⁵ The representative from the UK, Hoare,

66. Green, *supra*. n. 35 at para. 3.

67. Green, *supra*. n. 35 at para. 19.

68. *Id.* at para. 21.

69. *Id.* at para. 22.

70. *Id.* at para. 23; E/CN.4/SR.229.

71. Green, *supra*. n. 35 at para. 24; E/CN.4/SR.230.

72. Green, *supra*. n. 35 at para. 25; E/CN.4/SR.230.

73. Green, *supra*. n. 35 at paras 26–28; E/CN.4/SR.292–93.

74. Green, *supra*. n. 35 at para. 29; E/CN.4/SR.292.

75. Green, *supra*. n. 35 at para. 31; E/CN.4/SR.292.

was not in favour of the inclusion of such rights but observed that the Chilean delegate's remarks shed a new light on his interpretation of the provision relating to the rights of all to the benefits of scientific advancements. If Mr. Valenzuela was reading that provision as in conflict with the proposed author's rights, and, hence, reading it as an unqualified right, such a reading was far beyond the scope of the covenant and one to which the UK could not subscribe.⁷⁶ There appears to be no record of further discussion on this topic and the proposal was again rejected this time seven to six with four abstentions.⁷⁷

The Commissions final draft, without the provision protecting author's rights, was sent to the General Assembly and then to the Third Committee for review. The Third Committee further reviewed the author's rights proposal in October–November 1957. Again there was no dissent regarding the rights to enjoy the benefits of science. As for author's rights, the French delegate, Juvigny, argued for its inclusion but did not make the proposal. This time it was made by the Uruguay delegate, Tejera.⁷⁸ Tejera argued that the rights of the public and the author were not contradictory but complimented each other. For example, protecting the author would ensure the authenticity of the work.⁷⁹ Chile was now in favour of the provision as were Sweden, Israel, the Dominican Republic and UNESCO. Indonesia and the United Socialist Soviet Republic were opposed for reasons already stated by the US delegate to the Human Rights Commission. Saudi Arabia and Czechoslovakia also expressed concerns against its inclusion such as the fact that the provision seemed to protect individuals when much scientific work was completed by team effort and that such a delicate subject should not be included in haste without full debate and with an unsatisfactory text that could be misinterpreted.⁸⁰ In the end the provision was voted in by a vote of thirty-nine to nine with twenty-four abstentions.⁸¹ The provision in the final version of the ICESCR that relates to the moral and material rights of authors issue is:

Article 15

1. The States Parties to the present Covenant recognize the right of everyone:

- (a) To take part in cultural life;
- (b) To enjoy the benefits of scientific progress and its applications;
- (c) To benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

Given the vague language in Article 15 and the lack of attention paid to the issues of any conflict of author's rights and other human rights such as education, it was

76. Green, *supra*. n. 35 at para. 31; E/CN.4/SR.292.

77. Green, *supra*. n. 35 at para. 31; E/CN.4/SR.292.

78. Green, *supra*. n. 35 at paras 33–35.

79. Green, *supra*. n. 35 at para. 35.

80. Green, *supra*. n. 35 at para. 40; A/C.3/SR.798–99.

81. Green, *supra*. n. 35 at para. 41; A/C.3/SR.799.

unlikely that the drafters imagined the key role intellectual property would play in the fields of trade, development or education.⁸²

With regard to Paragraph 15(1)(c), the Committee on Economic, Social and Cultural Rights (the 'Committee') has recently issued General Comment No.17, a non-binding assertion of the present Committee's interpretation of that paragraph protecting, as a human right, moral and material interests of authors. First, the Committee asserts that human rights are 'inalienable'⁸³ and with respect to the ICESCR 15(1)(c) 'safeguards the personal link between authors and their creations'.⁸⁴ Next, the Committee asserts that only natural persons or certain groups may claim a human right to moral and material interests as an author, not corporations.⁸⁵ Moral interests are defined as proclaiming the intrinsically personal character of every creation and including:

the right of authors to be recognized as the creators of their scientific, literary and artistic productions and to object to any distortion, mutilation or other modification of, or other derogatory action in relation to, such productions, which would be prejudicial to their honour and reputation.⁸⁶

Material interests are proclaimed to have a close linkage to the right to own property as stated in the ICESCR at paragraph 17 and, while not directly linked to the author's personality, contribute to the right to an adequate standard of living as stated in the ICESCR at paragraph 11.

V. TRIPS INTERPRETED

Since at least the 1980s the US, supported by the European Union and Japan, sought to tie intellectual property to international trade policy.⁸⁷ The impetus was the increasing economic dependence for these economies on the sale of intellectual property, such as copyrighted goods.⁸⁸ This economic consideration, along with the fact that many developing states had weak or no intellectual property laws caused concern in developed states. While Berne was an important step toward international copyright protection, it provided for national treatment. Many developing states had weak or no copyright law and had not ratified Berne evidencing a weakness in the international intellectual property regime.⁸⁹ In 1994, at the

82. *HC Report*, *supra*. n. 59 at 22, n. 4 (citing to Green, *supra*. n. 35).

83. GC17, *supra*. n. 45 at para. 1.

84. *Id.* at para. 2.

85. *Id.* at paras 7 and 8.

86. *Id.* at para. 13.

87. David C. Richards, *Intellectual Property Rights and Global Capitalism: The Political Economy of the Trips Agreement* 123 (2004).

88. See Ruth Okediji, 'Toward an International Fair Use Doctrine', 39 *COLUM. J. TRANSNAT'L L.* 75, 81 (2000).

89. Robert J. Gutowski, 'The Marriage of Intellectual Property and International Trade in the TRIPS Agreement: Strange Bedfellows or a Match Made in Heaven?' 47 *BUFF.L.REV.* 713, 720 (1999).

Uruguay round of trade negotiations for the General Agreement on Tariffs and Trade (GATT) intellectual property was included under TRIPS and the World Trade Organization (WTO) was created.⁹⁰ In order to reap the benefits of free and open trade, in essence a most favoured nation trading status, a state would have to join the WTO.⁹¹ Membership in the WTO required agreeing to the requirements of TRIPS.⁹² TRIPS incorporated Berne except for moral rights.⁹³ Thus, many developing states had to agree to incorporate the minimum requirements of Berne in order to reap free trade benefits.⁹⁴ But, unlike Berne, TRIPS provides for coercive measures for failure to comply through trade sanctions. Further, the WTO provides a dispute resolution mechanism.⁹⁵

In 1999, around the time that the transitional arrangements provided for in Article 65 of TRIPS started to expire,⁹⁶ ECOSOC, the United Nations agency responsible for the oversight of the UDHR, the ICESCR and the CRC, was being petitioned by certain non-governmental organizations (NGO's) regarding the impact of globalization on human rights. In response these concerns, several studies, reports and academic articles were published discussing the conflict between the realization of human rights and certain trade agreements, in particular TRIPS.⁹⁷

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90. Julie Cheng, 'China's Copyright System: Rising to the Spirit of TRIPs Requires an Internal Focus and World Trade Organization Membership' 21 *FORDHAM INT'L L. J.* 1941, 1948–49 (1998); Jared R. Silverman, 'Multilateral Resolution Over Unilateral Retaliation: Adjudicating the Use of Section 301 Before the WTO', 17 *U. PA. J. INT'L ECON. L.* 233, fn 101 and 102 (1996).
91. Amy Nelson, 'Is There an International Solution to Intellectual Property Protection For Plants?' 37 *GEO. WASH. INT'L L. REV.* 997, 1008 (2005).
92. *Id.*
93. TRIPS, *supra*. n. 10 at Art. 9; Fawcett, *supra*. n. 12 at 480.
94. From 1994 to 2006, fifty seven additional states have ratified Berne. <www.wipo.int/treaties/en/ShowResults.jsp?lang=en&treaty_id=15>.
95. Robert J Gutowski, 'The Marriage of Intellectual Property and International Trade in the TRIPS Agreement: Strange Bedfellows or a Match Made in Heaven?' 47 *BUFF.L.REV.* 713, 714–15.
96. The language in Art.65 of TRIPS provides: '1. Subject to the provisions of paragraphs 2, 3 and 4, no Member shall be obliged to apply the provisions of this Agreement before the expiry of a general period of one year following the date of entry into force of the WTO Agreement. 2. A developing country Member is entitled to delay for a further period of four years the date of application, as defined in paragraph 1, of the provisions of this Agreement other than Art. 3, 4 and 5.'
97. J. Oloka Onyango and Deepika Udagama, *The Realization of Economic, Social and Cultural Rights: Globalization and its Impact on the Full Enjoyment of Human Rights, Final Report of the U.N. Sub-Commission on the Promotion and Protection of Human Rights*, U.N. Doc. E/CN.4/Sub.2/2000/13 (2000) (hereinafter 'E/CN.4/Sub.2/2000/13'); David Weissbrodt and Kell Schoff, 'Human Rights Approach To Intellectual Property Protection: The Genesis And Application Of Sub-Commission Resolution 2000/7', 5 *MINN. INTELL. PROP. REV.* 1, 26 (2003) (hereinafter 'Weissbrodt'); Globalization and Human Rights, Joint Oral Statement by Lutheran World Federation, Habitat International Coalition and International Commission of Jurists to the Sub-Commission on the Promotion and Protection of Human Rights, 8 August 2000 (hereinafter 'Lutheran World') UN DOC. E/CN.4/Sub.2/2000/NGO/14 at para. 2; Intellectual Property and Human Rights, Sub-Commission On Human Rights, E/CN.4/Sub.2.Res/2001.21

In examining the potential conflict between TRIPS and the human right to education, TRIPS incorporates Berne, except for moral rights, so it protects what amounts to the means of achieving the material interests of authors. Additionally, TRIPS protects access rights, which are necessary for education. For example:

Article 7

Objectives

The protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations.⁹⁸

Article 7 addresses access, through the language such as the ‘promotion of . . . innovation’ and ‘transfer and dissemination of technology’. It also seeks a balanced approach focusing on the mutual advantages for owners and users.

Further, Article 8 provides:

Article 8

Principles

1. Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement.

2. Appropriate measures, provided that they are consistent with the provisions of this Agreement, may be needed to prevent the abuse of intellectual property rights by right holders or the resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology.⁹⁹

Article 8 is sensitive to access issues advocated by human rights groups with regard to what amounts to a fair dealing provision. Article 13 does, however, present an access problem in that it limits fair dealing to exceptions that do not unreasonably prejudice the legitimate interests of the rights holder.¹⁰⁰ Specifically, Article 13 has a three part test: (1) the limitations or exceptions are confined to certain special

(16 August 2001)(hereinafter ‘Resolution 2001/21’); *Substantive Issues Arising In The Implementation Of The International Covenant On Economic, Social And Cultural Rights, Follow-Up To The Day Of General Discussion On Article 15.1(C)*, Monday, 26 November 2001, *Human Rights And Intellectual Property, Statement By The Committee On Economic Social And Cultural Rights*, E/C.12/2001/15, 2 (14 December 2001) (hereinafter ‘Statement 26 November 2001’).

98. The US ratified TRIPS in 1994. The UK and France ratified TRIPS in 1995.

99. TRIPS, *supra*. n. 10 at Art. 8.

100. Art.13 provides: ‘Members shall confine limitations or exceptions to exclusive rights to certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder’.

cases; (2) they do not conflict with a normal exploitation of the work; and (3) they do not unreasonably prejudice the legitimate interests of the right holder.

A limitation or an exception is consistent with Article 13 only if it fulfils each of the three conditions.¹⁰¹ With respect to the first prong, the terms ‘certain special cases’ are defined by referring to the ordinary meaning of the terms in their context and in the light of its object and purpose.¹⁰² This has been held to mean:

a limitation or exception in national legislation should be clearly defined and should be narrow in its scope and reach. On the other hand, a limitation or exception may be compatible with the first condition even if it pursues a special purpose whose underlying legitimacy in a normative sense cannot be discerned. The wording of Article 13’s first condition does not imply passing a judgment on the legitimacy of the exceptions in dispute.

The second prong deals with the exception not conflicting with the normal exploitation of the work and has been held to mean that:

an exception or limitation to an exclusive right in domestic legislation rises to the level of a conflict with a normal exploitation of the work . . . if uses, that in principle are covered by that right but exempted under the exception or limitation, enter into economic competition with the ways that right holders normally extract economic value from that right to the work . . . and thereby deprive them of significant or tangible commercial gains.¹⁰³

and includes actual or potential effects on that market.¹⁰⁴ Finally, the third prong has been defined as:

[W]hether the prejudice caused by the exemptions to the legitimate interests of the right holder is of an unreasonable level. . . . [M]arket conditions [may be taken] into account, to the extent feasible, [in addition to] the actual as well as the potential prejudice caused by the exemptions, as a prerequisite for determining whether the extent or degree of prejudice is of an unreasonable level.¹⁰⁵

The second and third prong are, perhaps the most troublesome as they do not provide states with much guidance. Accordingly, Article 13 has the same problem of a lack of certainty that the domestic fair dealing doctrines have. While this may lead to some frustration, it also has the benefit of being flexible enough to adjust to various needs in the international community.

101. *WTO Panel Report in United States-section 110(5) of the Copyright Act*, WT/DS160/R, para. 6.74, 15 June 2000 (hereinafter ‘*WTO Panel Report*’), available at <<http://homepages.law.asu.edu/~dkarjala/InternationalIP/WTO-USSec110%285%29PanRep.html>> (last accessed 23 April 2008).

102. *Id.* at para. 6.107.

103. *Id.* at para. 6.183–4.

104. *Id.* at paras 6.183–84.

105. *Id.* at para. 6.236.

VI. THE INTERNAL CONFLICT

The internal conflict exists in situations where one document contains two or more provisions that appear to or do, in fact, conflict. For example, Article 13 of the ICESCR granting the human right to education appears to, and may in some situations, conflict with Article 15(1)(c) of that same document granting as a human right an author's right to moral and material interests resulting from any scientific, literary or artistic production.¹⁰⁶ When such a conflict does arise, the conflict resolution approach suggested by ECOSOC is a balancing test:

The right of authors to benefit from the protection of the moral and material interests resulting from their scientific, literary and artistic productions cannot be isolated from the other rights recognized in the Covenant. States parties are therefore obliged to strike an adequate balance between their obligations under article 15, paragraph 1 (c), on one hand, and under the other provisions of the Covenant, on the other hand, with a view to promoting and protecting the full range of rights guaranteed in the Covenant. In striking this balance, the private interests of authors should not be unduly favoured and the public interest in enjoying broad access to their productions should be given due consideration. States parties should therefore ensure that their legal or other regimes for the protection of the moral and material interests resulting from one's scientific, literary or artistic productions constitute no impediment to their ability to comply with their core obligations in relation to the rights to food, health and education, as well as to take part in cultural life and to enjoy the benefits of scientific progress and its applications, or any other right enshrined in the Covenant. Ultimately, intellectual property is a social product and has a social function. States parties thus have a duty to prevent unreasonably high costs for access to essential medicines, plant seeds or other means of food production, or for schoolbooks and learning materials, from undermining the rights of large segments of the population to health, food and education.¹⁰⁷

Thus, utilizing a balancing test as suggested, a state may implement domestic copyright laws that provide less protection in terms of years or more exceptions to protection for purposes of education in order to strike a balance that reflects that state's social and economic condition and priorities. A state lagging in education may decide to provide weaker copyright laws than a state with relatively high education achievement but, perhaps, an economic dependence on copyright industries.

Such a balancing approach is not new to similar internal conflicts in the domestic setting. For example, the US court decisions regarding conflicting constitutional rights provide another example of a balancing test approach. The First Amendment of the United States Constitution, the right to free speech and

106. GC17, *supra*. n. 45 at para. 35; Peter K. Yu, 'The International Enclosure Movement', 82 *Ind. L.J.* 827, 866 (2007).

107. 4 GC17, *supra*. n. 45 at para. 35.

freedom of the press, may conflict with the copyright provision in the same document but the courts balance the interests to be protected in these provisions based upon the circumstances of each case to determine which provision should prevail.¹⁰⁸

VII. THE EXTERNAL CONFLICT

The internal conflict exists in situations where the separate documents have potentially conflicting provisions. The possible conflict between TRIPS and the human rights to education as articulated in the CESC Round the CRC is less in the language of TRIPS than in the implementation and practices after TRIPS. TRIPS incorporates Berne, except for moral rights, which sets forth the minimal protection allowed. Domestic legislation may, and often does, set forth greater protections. For example, Berne requires a basic term of protection of the author's life plus fifty years.¹⁰⁹ Political and economic pressure, however, may be exerted on developing states to provide domestic legislation that gives more than the minimal protection to conform to the developed states copyright terms, in some cases the author's life plus seventy years¹¹⁰ – the TRIPS-plus problem. Some have argued that a solution to this problem is to change international intellectual property agreements to reflect a maximum standard of protection.¹¹¹ Yet, the history of international copyright law has taught that such a lack of flexibility inherent in this solution will lack consensus. The more realistic solution is political pressure through the international community directed toward those suggested that attempt to gain TRIPS-plus protection in developing states. As Charles H. Malik stated with regard to the UDHR, more has been gained through such political pressure tactics for the advancement of human rights goals than attempts to obtain consensus necessary for a binding convention.¹¹²

Even assuming that there is a true conflict between TRIPS and other human rights how might such a conflict be addressed? The WTO has applied a balancing test regarding conflicting rights in Appellate Body in Korea – Various Measures on Beef¹¹³ and United States – Measures Affecting the Cross-Border Supply of Gambling and Betting Services¹¹⁴ where the WTO Dispute Resolution Panel articulated a three part balancing test including (a) the importance of interests or values that the challenged measure is intended to protect. (With respect to this requirement, the Appellate Body has suggested that, if the value or interest pursued is

108. *Harper & Row Publishers, Inc. v. Nation Enterprises*, 471 US 539 (1985); *Eldred v. Ashcroft*, 537 US 186. 218–221 (2003).

109. Berne, *supra*. n. 11 at Art. 7(1).

110. Lawrence Helfer, 'Regime Shifting: The TRIPS Agreement and the New Dynamics of International Intellectual Property Law Making', 29 *Yale J. Int'l Law* 1, 24 (2003).

111. Laurence Helfer, 'Human Rights And Intellectual Property: Conflict Or Coexistence', 5 *MINN. INTELL. PROP. REV.* 47, 58 (2003).

112. Glendon, *supra*. n. 15 at 25.

113. WT/DS19/AB/R, adopted 10 January 2001.

114. WT/DS285/AG/R, 7 April 2005.

considered important, it is more likely that the measure is ‘necessary’); (b) the extent to which the challenged measure contributes to the realization of the end pursued by that measure (in relation to this requirement, the Appellate Body has suggested that the greater the extent to which the measure contributes to the end pursued the more likely that the measure is ‘necessary’); and (c) the trade impact of the challenged measure (with regard to this requirement, the Appellate Body has said that, if the measure has a relatively slight trade impact, the more likely that the measure is ‘necessary’. The Appellate Body has also indicated that whether a reasonably available WTO-consistent alternative measure exists must be taken into consideration in applying this requirement).¹¹⁵ This is consistent with the balancing test suggested in General Comment 17.¹¹⁶

Applying this test to the conflict between TRIPS and the right to education; (a) the importance of the interest in education would be highly ranked given the social, political and economic ramifications of an educated public.¹¹⁷ Additionally, the history of copyright indicates a strong interest in encouraging creation for the purpose of education.¹¹⁸ Finally TRIPS itself recognizes the necessity of the transfer of information, a function of the educational process.¹¹⁹

As for the second requirement (b), access to educational materials, does contribute greatly to education according to the World Development Report 2004.¹²⁰ Accordingly, making those materials available at a reduced cost or for free to realize the goal of education in a state with a depressed economy may be ‘necessary’.

Finally, the third requirement, (c), trade impact, would be negligible in the situation of a depressed economy where the population does not have the ability to pay for educational materials as discussed in more detail below.

VIII. THE FALSE CONFLICT

The alleged ‘conflict’ between the right to education and laws implemented to protect author’s moral and material interests often does not exist due to market failure. Market failure stems from the fact that information is non-rivalrous, that is, once it is created it is inexhaustible; the making of a copy of information does not deprive the owner of the original. Further, if the cost of copying is inexpensive, in terms of time and money, free-riders, (people who copy a creation without paying for the right to do so), will reduce the material interests of the author.¹²¹ Thus,

115. United States – Measures Affecting The Cross-Border Supply Of Gambling And Betting Services WT/DS285/R at 236.

116. GC17, *supra*. n. 45, at para. 35.

117. GC11, *supra*. n. 38.

118. *Millar v. Taylor*, 98 E.R. 201 at p. 207.

119. See TRIPS, *supra*. n. 10 at Arts 7–8.

120. *World Development Report 2004*, *supra*. n. 3.

121. Wendy J. Gordon, ‘Fair Use and Market Failure: A Structural and Economic Analysis of the Betamax Case and its Predecessors’, 82 *COLUM. L. REV.* 1600, 1610–12 (1982); see Linda J. Lacy, ‘Of Bread and Roses and Copyright’, 1989 *DUKE L.J.* 1532, 1553–54 (1989).

market failure occurs when there is no market for a good either due to free-riders or a price beyond the market's ability to pay. In the situation where a market, say in a developing state, does not have an ability to pay, there can be no material interest due to market failure. In the case of market failure due to a state's inability to afford to pay there would be a false conflict as there is no reasonable expectation of material gain but moral interests would have to be protected.

Certainly, from the perspective of the interpretation of the ICESCR the false conflict paradigm would seem to comply with GC17, giving due regard to the importance of education while at the same time recognizing that the material interests of authors of educational material has little to no weight in market failure situation. This does not diminish the material interests of authors; rather it accepts the economic reality of the market failure situation. In a market where the population does have an ability to pay there would be a potential conflict if authors' material interests are not protected and such interests would be given more weight.

Even from the WTO perspective regarding TRIPS we see little to no trade impact, the third prong of the WTO balancing test, in a market failure situation as there can be little to no trade with a market that can not afford to buy the goods in question. The real problem in the false conflict situation arises from the parallel imports problem¹²². Accordingly, the state where there is market failure would be outlawed and access to copyrighted materials for little to nothing, but would have to ensure that the protected educational materials are not exported for commercial gain to a state where there is no market failure.

IX. CONCLUSION

The potential for conflicts do exist between the human right to education and the human right to material interests for authors, as realized through international and domestic copyright law. But, these conflicts seem to be more of a political or academic problem than a legal and economic one. Internal and external conflicts, when they do arise, may be resolved through a balancing test where the competing interests are weighed in a case by case situation. This provides the necessary flexibility to address the variety of factors that may have an impact, such as market conditions and educational needs. Many of the alleged conflicts will fall into the false conflict paradigm given the fact that most of the states with an acute need for imported educational materials have partial or full market failure. In such situations, there is little to no material interest to protect for authors as well as little to no trade impact. International law as well as most domestic laws provide for the economic reality analysis suggested under the false conflict paradigm. Accordingly, many times a potential conflict appears, beware of false conflicts.

122. Parallel imports is the problem where copyrighted goods are created by infringement in one market, say a state where there is market failure, and imported to another state, where there is no market failure, for commercial gain. In that situation there would be an impact on trade.

Part III

Trade Marks, Related Rights
and Human Rights

Chapter 12

Is There a Right to an Immoral Trade Mark?

*Jonathan Griffiths**

I. INTRODUCTION – FREEDOM OF EXPRESSION AND THE LAW OF TRADE MARKS

Recently, the relationship between intellectual property rights and the human right to freedom of expression has attracted a great deal of attention.¹ This has often focused on the impact of free speech in the law of copyright and confidentiality. However, it is also clear that trade mark law presents interesting challenges. Commentators have observed that the enhancement of trade mark rights,

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1. See, for example, N.W. Netanel, 'Locating Copyright within the First Amendment Skein' (2001) *Stanford L Rev* 1; J. Rubinfeld, 'The Freedom of Imagination: Copyright's Constitutionality' (2002) 112 *Yale LJ* 1; R. Tushnet, 'Copy this Essay: How Fair Use Doctrine Harms Free Speech and how Copying Serves it' (2004) 109 *Yale LJ*; P. Loughlin, 'Copyright Law, Free Speech and Self-Fulfilment' (2002) 24 *Sydney Law Rev* 427; J. Griffiths & U. Suthersanen (eds), *Copyright and Free Speech* (OUP, 2005); B. Hugenholtz, 'Copyright and Freedom of Expression in Europe' in N. Elkin-Koren and N.W. Netanel (eds), *The Commodification of Information* (Kluwer Law International, 2002); C. Geiger, '“Constitutionalising” Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property' 36 *IIC* 371 (2006); T. Aplin, 'The Development of the Action for Breach of Confidence in the post-HRA Era' [2007] *IPQ* 19; H. Fenwick and G. Phillipson, *Media Freedom under the Human Rights Act* (OUP, 2006).

particularly a weapon against ‘dilution’, has increased the potential for conflict with the interests of parodists, protestors and other cultural commentators.² Significant disputes have already arisen³ and, in some instances, the clash with free speech has been acknowledged.⁴

In the UK, under the influence of the Human Rights Act, courts have begun to take account of the relationship between expression rights and trade marks. Perhaps the most striking example of this development is provided by *Miss World Ltd v. Channel Four Television Corporation*,⁵ in which the claimant brought proceedings for infringement of its mark, MISS WORLD, against a broadcaster proposing to transmit a television programme about a beauty contest for transvestites and transsexuals under the title, ‘Mr Miss World’. The defendant argued that use of the title was protected by the right to freedom of expression under Article 10 of the European Convention on Human Rights (ECHR). Pumfrey J. did not accept this argument and granted an interim injunction. However, *obiter*, he noted that a case in which a defendant’s use of a sign was ‘telling a political story, making a political point or identifying some matter of public importance’⁶ could potentially come into conflict with Article 10. In cases concerning comparative advertising, courts have also acknowledged the relevance of free speech.⁷ Indeed, arguments based on Article 10 have even arisen in less predictable areas of trade mark law. Perhaps the most surprising example was the attempted reliance placed on Article 10 by the defendant in the

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2. See, for example, R. Cooper Dreyfuss, ‘Expressive Genericity: Trademarks as Language in the Pepsi Generation’ 65 *Notre Dame L. Rev.* 397; R. Cooper Dreyfuss, ‘Surveying the Arsenal: Tools for Reconciling Trademark Rights and Expressive Values’, *Proceedings of the ALAI Congress 2006* (to be published); C. Geiger, ‘Trade Marks and Freedom of Expression – the Proportionality of Criticism’ [2007] *IIC* 317; P.N. Leval, ‘Trademark: Champion of Free Speech’, 2004 *Columbia J of Law & the Arts* 187; M. Spence, ‘The Mark as Expression/the Mark as Property’ (2005) *Current Legal Problems* 491; E. Barendt, *Freedom of Speech*, 2nd edn (OUP, 2005) 263–267.
 3. *Dallas Cowboys Cheerleaders v. Pussycat Cinema Ltd* 604 F.2d 200 (2nd Cir, 1979); *San Francisco Arts and Athletics Inc. v. US Olympic Committee* 483 US 522 (1987); *Mattel Inc v. MCA Records Inc.* 296 F.3d 894 (9th Cir, 2000); cert denied 123 Sup. Ct. 993; *Taubman Company v. Mishkoff* 319 F.3d 770 (6th Cir, 2003); *South African Breweries International (Finance) BV v. Laugh it Off Promotions* (2006) EIPR N45–49 (Constitutional Court, S. Africa); *Alles Wird Teurer* [1999] ETMR 49 (KG Berlin Court of Appeal); *Sté Gervais Danone v. Société Le Riveau Voltaire, Société Gandhi, Valentin Lacambre* [2003] ETMR 321; *Association Greenpeace France v. SA Société Esso* [2003] ETMR 867 (Cour d’appel de Paris); *SA Société des Participations du CEA v. Greenpeace France et al* [2003] ETMR 870 (Cour d’appel de Paris).
 4. See, for example, *South African Breweries International (Finance) BV v. Laugh it Off Promotions* (2006) EIPR N45–49 (Constitutional Court, S Africa); *Sté Gervais Danone v. Société Le Riveau Voltaire, Société Gandhi, Valentin Lacambre* [2003] ETMR 321; *Association Greenpeace France v. SA Société Esso* [2003] ETMR 867 (Cour d’appel de Paris); *SA Société des Participations du CEA v. Greenpeace France et al.* [2003] ETMR 870 (Cour d’appel de Paris).
 5. [2007] FSR 30 (Pumfrey J).
 6. *Ibid.*, [47].
 7. *Red Dot Technologies Ltd v. Apollo Fire Detectors Ltd* [2007] EWHC 1166 (Ch) (David Richards J); *Boehringer Ingelheim Ltd v. Vetplus Ltd* [2007] ETMR 67 (CA); cf. *O2 Holdings Ltd v. Hutchison 3G Ltd* [2006] RPC 29, [167]–[169] (Lewison J.).

parallel imports case, *Levi Strauss & Co and Levi Strauss (UK) Ltd v. Tesco Stores Ltd*.⁸ Nevertheless, while Article 10 has played some role in these disputes, its proper scope and effect has not been thoroughly analyzed. Indeed, the treatment of the relationship between freedom of expression and trade mark rights has been remarkably superficial. There is certainly a need for more thorough analysis.⁹ However, the aim of this chapter is more limited. It seeks only to illuminate one specific aspect of trade mark law upon which Article 10 has begun to exercise an influence in the UK and Community trade mark systems. In a series of recent cases concerning the absolute ground for refusal of registration on grounds of immorality or public policy, decision-makers have made explicit reference to the relevance of Article 10. It has increasingly been accepted that any refusal to register a mark on public policy/morality grounds constitutes an interference with the applicant's right to freedom of expression and, therefore, calls for justification under Article 10(2) of the ECHR.¹⁰

This chapter reviews the UK and European case law on the public policy and morality exclusions and explains how Article 10 has begun to assert an influence on the jurisprudence. It argues that, if more detailed attention were paid to the decisions of the European Court of Human Rights, it would be discovered that Article 10 really has very little role to play in such cases.

II. MARKS CONTRARY TO PUBLIC POLICY AND MORALITY – UNITED KINGDOM AND COMMUNITY LAW

Within the European Economic Area, trade mark law is largely harmonized. The provisions governing the registration of marks contrary to public policy and morality are therefore very similar at national and Community level. The Trade Marks

8. *Levi Strauss & Co and Levi Strauss (UK) Ltd v. Tesco Stores Ltd* [2002] ETMR 95, [38]–[44].

9. '[T]he scope of the intervention of Art. 10 in matters concerning registered trade marks is far from well worked out. Indeed, I think it is fair to say that it is almost completely unworked out.' (per Pumfrey J., *Miss World Ltd v. Channel Four Television Corporation* [2007] FSR 30, [41]).

10. '(1) Everyone has the right to freedom of expression. The right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

(2) The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.'

Directive governs national law on this issue¹¹ and has been implemented in the UK by Trade Marks Act 1994, s. 3(3)(a):¹²

A trade mark shall not be registered if it is-

(a) contrary to public policy or to accepted principles of morality

As required under the directive, the act also includes legal mechanisms for ensuring that marks registered in breach of this provision can be declared invalid.¹³ Under Article 7(1)(f), the Community Trade Mark Regulation¹⁴ has a parallel provision:

The following shall not be registered:

...

(f) trade marks which are contrary to public policy or to accepted principles of morality

This exclusion is effective even where the mark for which registration has been applied is contrary to public policy or accepted principles of morality in part only of the Community.¹⁵ A Community Trade Mark registered in breach of Article 7(1)(f) is to be declared invalid on application to the Community Trade Mark Office or on counterclaim to an infringement action.¹⁶ Provisions such as these, ensuring that rights are not granted in signs that contravene public policy or morality, are found in trade mark laws around the world.¹⁷ Indeed, they are a feature of intellectual property laws more generally. Legislation establishing registered rights normally provides that rights are not to be granted in respect of subject-matter that is contrary to public policy or is

11. Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks ('the Trade Marks Directive'), Art. 3(1)(f):

'The following shall not be registered or if registered shall be liable to be declared invalid; . . .
(f) trade marks which are contrary to public policy or to accepted principles of morality;'

This reflects Art. 6 quinquies, para. B (3) of the Paris Convention. The power to deny registration on morality or public policy grounds is also preserved under the TRIPS Agreement (Art. 15(2)).

12. In the UK, this harmonized morality and public policy exclusion has a series of statutory predecessors – Trade Marks Act 1938, s. 11; Trade Marks Act 1905, s. 11 and Patents, Designs and Trade Marks Act 1883, s. 73.

13. Trade Marks Act 1994, s. 47(1).

14. Regulation 40/94 on the Community Trade Mark.

15. Regulation 40/94, Art. 4(2).

16. Regulation 40/94, Art. 51(1)(a).

17. For discussion, see, for example, S. Baird, 'Moral interventions in the trademark arena: banning the registration of scandalous and immoral trademarks' (1993) 83 TMR. 661; T. Davis, 'Registration of scandalous, immoral and disparaging matter under s. 2(a) of the Lanham Act; can one man's vulgarity be another registered trade mark?' (1993) 83 T.M.R. 801; J. Leftin, 'Does the First Amendment bar cancellation of Redskins?' (2001) 52 *Stanford Law Review* 665 (US); J. Tessensohn, 'Case Comment' [2004] EIPR N-188; J. Tessensohn & S. Yamamoto, 'Case Comment' [2006] EIPR N-108 (Japan).

immoral¹⁸ Such provisions are themselves a particular reflection of a broader refusal to lend the support of the legal system to those seeking to rely upon interests in anti-social, or otherwise improper, subject-matter.¹⁹

III. APPLICATION OF THE MORALITY AND PUBLIC POLICY EXCLUSION – CASES FROM THE UNITED KINGDOM

The scope of section 3(3)(a) has been considered briefly in the High Court. In *Philips Electronics NV v. Remington Consumer Products*, the defendant argued that section 3(3)(a) prohibited the registration of the shape of a particular three-headed rotary shaver because it was contrary to public policy to protect an article in trade mark law where pre-existing patent protection had expired. Jacob J. dismissed this argument, holding that the scope of the provision was ‘confined to matters such as are covered by the French legal term *ordre publique*, a matter involving some sort of question of morality’ and was not concerned with ‘economic grounds of objection’.²⁰ It is, however, in decisions of the Lord Chancellor’s Appointed Person²¹ that section 3(3)(a) has received closest attention.

III.A CASES DECIDED BY THE LORD CHANCELLOR’S APPOINTED PERSON

*Ghazilian’s Application*²²

The first such decision was that of Simon Thorley QC in *Ghazilian’s Application*, which concerned an application to register the mark, TINY PENIS, in respect of clothing. The Registry’s hearing officer refused the application on the ground that, as clothes would be displayed in public, use of the mark would cause offence to a substantial proportion of the purchasing public. On appeal, the Appointed Person upheld this decision.²³ He approved the approach adopted by Aldous J.

18. See, for example, Registered Designs Act 1949, s. 1D; Community Designs Regulation 6/2002, Art. 9; European Patents Convention, Art. 53(a); Patents Act 1977, s. 193, sch. A2; Directive 98/44 on the legal protection of biotechnological inventions; *The Netherlands v. Commission and Council* (C-377/98) [2001] 3 CMLR 49 (ECJ).

19. In the UK, see, for example, *Hyde Park Residence Ltd v. Yelland* [2000] RPC 604; *Gartside v. Outram* (1856) 26 LJ Ch 113; *Initial Services Ltd v. Putterill* [1968] 1 QB 396; *Hubbard v. Vosper* [1972] 2 QB 84 (CA).

20. [1998] ETMR 124, 152.

21. A decision by the Registrar is subject to appeal to the High Court or to the Lord Chancellor’s Appointed Person (Trade Marks Act 1994, ss. 76–77. For discussion of the Appointed Person’s status and jurisdiction, see *Elizabeth Emmanuel TM* [2006] ETMR 750.

22. [2002] ETMR 57.

23. The case was decided under the ‘accepted principles of morality’ aspect of s. 3(3)(a).

in *Re Masterman's Application*,²⁴ interpreting equivalent morality provisions under the Registered Designs Act 1949.²⁵ In particular, he adopted the standard of the 'right-thinking member of the public' against which to measure the application of section 3(3)(a).²⁶ He summarized his view of the scope of section 3(3)(a) thus:

Section 3(3) refers to 'accepted principles of morality' . . . In any given social group, there are certain standards of behaviour or moral principles which society requires to be observed and there are standards of conduct which are widely shared. Society requires this so as to ensure that religious, social or family values are not unreasonably undermined. . . [It] is only in cases where it is plain that an accepted principle of morality is being offended against that registration should be denied. Mere offence to a section of the public, in the sense that that section of the public would consider the mark distasteful, is not enough.²⁷

From this perspective, he concluded that the Hearing Officer had not clarified sufficiently the forms of 'offence' relevant to section 3(3)(a) and, in failing to do so, may have adopted too low a threshold for the provision's application.²⁸ Nevertheless, he upheld the refusal to register the mark:

Placing myself in the shoes of the 'right-thinking' member of the public in the way I have indicated above, I have concluded that this trade mark would cause greater offence than mere distaste to a significant section of the public. The offence resides in the fact that an accepted social and family value is likely to be significantly undermined. This value lies in the belief that the correct anatomical terms for parts of the genitalia should be reserved for serious use and should not be debased by use as a smutty trade mark for clothing.²⁹

This conclusion has been criticized³⁰ and, indeed, the Appointed Person's conclusion that 'right-thinking' members of the public would be offended by the registration of TINY PENIS seems to be based on relatively scant evidence. Nevertheless, his wish to emphasize that section 3(3)(a) requires an objective approach and will only apply in 'clear' cases is understandable. The argument

24. *Masterman's Design Application* [1991] RPC 89.

25. 'Nothing in this Act shall be construed as authorising or requiring the registrar to register a design the use of which would, in his opinion, be contrary to law or morality' (Registered Designs Act 1949, s. 43(1)).

26. [2002] ETMR 57, [19].

27. *Ibid.*, [21].

28. *Ibid.*, [46]–[47].

29. *Ibid.*, [50].

30. Bently & Sherman describe it as 'surprising' (L. Bently & B. Sherman, *Intellectual Property Law*, 2nd edn (OUP, 2004), 842–3); Phillips describes it as 'a good example of "how not to do it"' (J. Phillips, *Trade Mark Law: a Practical Anatomy* (Oxford University Press, 2003) at 4.37). Richard Arnold QC also questions the decision in *French Connection Ltd's Trade Mark Registration* [2007] ETMR 8, [61].

based on the undermining of the family use of the word ‘penis’ is at least based on a *tangible* form of harm, rather than upon pure offence or distaste.³¹

*Basic Trademark SA’s Application*³²

The next case in which the application of section 3(3) was considered in detail was *Basic Trademark*. This concerned an application to the UK Trade Marks Registry for the registration of the word mark JESUS in respect of a wide range of different goods. Under section 3(3)(a), the hearing officer refused the application, in the light of the guidance given in *Ghazilian*.³³ The applicant appealed to the Lord Chancellor’s Appointed Person, who upheld the decision. Geoffrey Hobbs QC considered that religious significance alone does not preclude registration of a mark. Nevertheless, in the case at hand, JESUS was ‘the ultimate Christian name’ and its appropriation for general commercial use would be ‘anathema to believers and those who believe in the need to respect the religious sensibilities of others’.³⁴

The use of [JESUS] as a trade mark should – to use the expression I have used several times already – be regarded as seriously troubling in terms of the public interest in the ‘prevention of disorder’ and ‘protection of morals’ . . . It is legitimate to apply the prohibition in s. 3(3)(a) of the Trade Marks Act 1994 to branding which is anti-social by reason of its ability to undermine an accepted social and religious value to a significant extent. That is the position here. There will be cases where the need to adopt a proportionate response to the problem of anti-social branding requires less than 100 per cent rejection of the request for registration. This is not one of them. The power of the word JESUS to give rise to the relevant concern is not diminished by the nature of the goods in the different categories specified by the applicant in the present case.³⁵

Again, a form of substantial harm – here the significant ‘undermining’ of social and religious values – is identified. However, the manner in which such harm might arise as a result of the debasement of the name JESUS is not at all fully explored or explained. As in *Ghazilian*, one is left with the feeling that, in order to secure validation of the decision-making process under section 3(3)(a), distaste is presented as a more tangible form of harm.

*Scranage’s Trade Mark Application*³⁶

In *Scranage*, the applicant sought to register the mark FOOK in respect of clothing, footwear and headgear. The Registry’s hearing officer refused the application on

31. In this respect, there is perhaps a parallel with the law regulating obscene publications. Under the Obscene Publications Act 1957, an offence is committed only where a publication can be shown to have a tendency to ‘degrade and corrupt’.

32. [2006] ETMR 24.

33. *Ibid.*, [19].

34. *Ibid.*, [25].

35. *Ibid.*, [26].

36. O/182/05, 23 June 2005.

the ground that the mark consisted exclusively of a word that was phonetically very similar to (or, in some parts of the UK, identical to) the offensive word ‘Fuck’. As such, registration of the mark was contrary to accepted principles of morality.³⁷ The applicant appealed to the Appointed Person, David Kitchin QC, who upheld the decision. Having made extensive reference to the decisions in *Ghazilian* and *Basic Trademark*,³⁸ he held that registration of the word ‘Fuck’ as a trade mark would be unacceptable because, although commonly employed, its ‘general use’ would be ‘likely to cause justifiable outrage amongst a significant section of the public’.³⁹ Use of the mark at issue in this case was likely to be indistinguishable from use of the word, ‘Fuck’ and would therefore cause equal offence and outrage.

*French Connection Ltd’s Trade Mark Registration*⁴⁰

The last case in which the Appointed Person has given detailed attention to the application of s 3(3)(a) is rather different. The TINY PENIS, JESUS and FOOK cases were all heard on appeal from a refusal to register a mark. However, *French Connection Ltd’s Trade Mark Registration* was a decision on the *validity* of an existing registration. The applicant was the proprietor of a UK word mark, FCUK, registered in respect of a number of different goods in Class 14. A member of the public, Dennis Woodman, (who claimed to be acting in the public interest) applied for the registration to be declared invalid on the ground that it had contravened section 3(3)(a). In proceedings before the Trade Mark Registry, the hearing officer rejected his application.⁴¹ While the word FUCK would not itself be registrable, there was a greater distinction between FCUK and ‘Fuck’ than there was between FOOK and ‘Fuck’. Woodman appealed to the Lord Chancellor’s Appointed Person, who upheld the refusal to cancel the mark’s registration.

Richard Arnold QC’s decision contains an interesting attempt to explore the fundamental rationale of the morality/public policy exclusion. He identified the paradox (also touched upon in both *Masterman* and *Ghazilian*) that refusal of an application to register a design or mark does not prevent its use. Legal protection is simply withheld and, as a result, it is at least possible that the mark or design will actually be more widely disseminated.⁴² He then claimed that provisions such as section 3(3)(a) cannot be explained on the ground that registration amounted to an ‘official seal of approval’ because registration was purely an adjudicative

37. *Ibid.* [2].

38. Also to the decision of OHIM’s Fourth Board of Appeal in *Dick Lexic Ltd’s Application* [2005] ETMR 99, discussed further below.

39. O/182/05, 23 June 2005, [13].

40. [2007] ETMR 8.

41. [2007] ETMR 8, para. [64]–[72].

42. *Ibid.*, [54].

recognition that an application complied with the statutory requirements.⁴³ Rather, he concluded that:

[t]he purpose of provisions such as s. 3(3)(a) . . . is to prevent the conferring of intellectual property rights which a court would refuse to enforce . . . [Section] 3(3)(a) refers to the *trade mark* being contrary to *ordre public* or morality rather than its *use*. In my view this is not inconsistent with the foregoing analysis. Trade marks are registered with a view to being used. Furthermore, it is not easy to see how a trade mark can be contrary to *ordre public* or morality as a thing in itself considered in the abstract rather than by reason of the effect of its use⁴⁴

Having identified section 3(3)(a)'s fundamental basis, the Appointed Person then made a comprehensive attempt to distil the interpretative principles found in earlier case-law on that provision.⁴⁵ These were:

- The applicability of section 3(3)(a) depends on the intrinsic qualities of the mark itself rather than upon circumstances relating to the conduct of the applicant;⁴⁶
- The applicability of section 3(3)(a) is to be assessed at the date of application;
- Section 3(3)(a) is to be interpreted and applied consistently with Article 10 ECHR. Therefore, registration is only to be refused where refusal is justified by a pressing social need and is proportionate to the legitimate aim pursued. Any real doubt as to the applicability of the objection is to be resolved by upholding the right to freedom of expression by permitting the registration;⁴⁷
- Section 3(3)(a) is to be objectively applied. The personal views of the tribunal are irrelevant;
- While section 3(3)(a) may apply to a mark whose use would not be illegal, the legality or otherwise of use of the mark is a relevant consideration;
- For section 3(3)(a) to apply, there must be a generally accepted moral principle that use of the mark would plainly contravene;
- The fact that a section of the public is offended by a mark (in the sense that they find it distasteful) is not enough to bring section 3(3)(a) into issue;
- Section 3(3)(a) will apply if the use of a mark would justifiably cause outrage, or would be the subject of justifiable censure, amongst an identifiable section of the public as being likely significantly to undermine current religious, family or social values;

43. *Ibid.*, [56].

44. *Ibid.*, [57]–[58].

45. Including the decision of OHIM's Fourth Board of Appeal in *Dick Lexic Ltd's Application* [2005] ETMR 99, discussed further below.

46. Case T-224/01 *Durferrit GmbH v. OHIM* [2004] E.T.M.R. 32, [76]; T-140/02 *Sportwetten GmbH Gera v. OHIM* [2006] E.T.M.R. 15, [27]–[29].

47. This issue is discussed in greater detail below.

- It is necessary to consider any usage that the public makes of the word or words of which the mark is comprised. Thus the slang meaning of a word may lead to an objection even if its normal meaning does not;⁴⁸
- A mark that does not proclaim an opinion, or contain an incitement or convey an insult is less likely to be objectionable than one that does;⁴⁹ and
- Different considerations apply to different categories of mark.

In applying these principles, he upheld the decision of the Hearing Officer. A mark was only objectionable under section 3(3)(a) if its use would contravene a generally accepted moral principle by reason of its ‘intrinsic qualities’. The manner in which a mark was subsequently used was irrelevant. FCUK was distinguishable from FOOK because FCUK, an acronym for the right-holder’s business, was not intrinsically objectionable and, accordingly ‘the generally accepted moral principle prohibiting the use of swear words’ did not apply.⁵⁰ The evidence that FCUK had never been found to be objectionable by industry regulators or by the market strongly supported this result. Given the lengthy analysis of precedent earlier in the decision, this conclusion seems disappointingly technical. Nevertheless, the use of evidence in the case perhaps indicates a systematic reluctance to find that a mark is invalid as a result of the public policy/morality provisions in anything other than the clearest case. The mark owner’s own word-play on the similarity between FCUK and ‘fuck’ was not considered to be relevant. However, evidence of the mark’s acceptability on the market was considered to be very relevant in supporting the maintenance of the registration.

III.B DECISIONS OF THE REGISTRAR

In addition to the disputes that have come before the Lord Chancellor’s Appointed Person considered above, it is worth noting three further decisions made in the Trade Marks Registry.

*CDW Graphic Design Ltd’s Application*⁵¹

The applicant applied to register <www.standupifyouhateamanu.com> in respect of a range of goods falling within Classes 16, 21 and 25. The application was opposed by Manchester United Merchandising Ltd and refused, inter alia, on the ground that registration of the mark would be contrary to public policy under section 3(3)(a). Although explicitly based on the ‘public policy’, rather than the morality, aspect of section 3(3)(a), the hearing officer, noting the close connection between the two aspects of the provision,⁵² relied on Simon Thorley QC’s decision in *Ghazilian’s*

48. *Dick Lexic Ltd’s Application* [2005] ETMR 99.

49. *Ibid.*

50. *Cf. French Connection Ltd v. Sutton* [2000] ETMR 341, 343–346 (Rattee J.).

51. [2003] RPC 30.

52. *Ibid.*, [29].

Application. He held that the use of the applicant's mark did not have to be shown to amount to the criminal act of incitement of violence in order for section 3(3)(a) to apply. It was enough if normal and fair use of the mark would be likely to lead to criminal or other offensive behaviour.⁵³ In this instance, he concluded that, in normal and fair use, the mark could function as a 'badge of antagonism' and was liable to increase the incidence of football violence or of other offensive behaviour. The objection under section 3(3)(a) was therefore successful.

*Sporting Kicks Ltd's Application*⁵⁴

Sporting Kicks is very similar to *CDW Graphic Design Ltd*. The applicant sought to register a sign consisting of the words INTER CITY FIRM, the letters ICF, two crossed hammers and the 'British Rail' symbol as a trade mark in respect of certain classes of goods. 'The Inter City Firm' had, in the past, been used as a name by a group of violent supporters of West Ham United FC. The hearing officer, referring to the decisions in *Basic Trademark SA's Application* and *CDW Graphic Design Ltd* discussed above, concluded that registration and use of the mark on clothing and badges was likely to lead to an increase in football violence by individuals or gangs and was liable to be seen by the public as a badge of allegiance to, or membership of, a criminal gang. It was, therefore, the opinion of the hearing officer that registration of the mark (a form of 'anti-social branding' as in *Basic Trademark*) would be contrary to public policy. In this respect, the fact that other, allegedly more offensive, marks had been accepted onto the Register was irrelevant.

*Toke UK Ltd's Application*⁵⁵

In this case, the application was for the word mark TOKE for trays and for clothing, footwear and headgear. The examiner initially refused the application on the ground that 'toke' had a dictionary meaning of 'to take a draw on a cannabis cigarette'. The possession and use of such cigarettes was illegal and, therefore, the sign was contrary to public policy or accepted principles of morality. At a hearing, the Registrar waived the ground of refusal in respect of trays. However, the refusal to register the goods in respect of clothing, footwear and headgear was maintained. The hearing officer followed *Ghazilian* and *Masterman* in approaching the issue from the perspective of the 'right-thinking' member of the public and concluded that use of the mark as a trade mark in relation to clothing, footwear and headgear would cause 'greater offence than mere distaste to a significant section of the general public'.⁵⁶ The mark would be regarded as promoting illegal activity. As such, it was contrary to public policy or to accepted principles of morality.⁵⁷

53. *Ibid.*, [39].

54. [2007] ETMR 10.

55. [2007] ETMR 9.

56. *Ibid.*, [17].

57. *Ibid.*, [19].

IV. CASES UNDER THE COMMUNITY TRADE MARK REGULATION

Under the Community Trade Mark Regulation, applications for registration as a Community Trade Mark are made to the Office of Harmonisation in the Internal Market (OHIM). Where an application is rejected, an appeal can be made to the Boards of Appeal.⁵⁸ Further appeals are available to the Court of First Instance and, ultimately, to the Court of Justice. As under the UK's domestic system, certain basic parameters for the application of Article 7(1)(f) have been established. The Court of First Instance has held that objections to registration under this provision must relate to the intrinsic qualities of the mark and not to the personal qualities of the applicant for registration.⁵⁹ It has also held that the fact that an applicant does not have a legal entitlement to market the goods and services within the registration in the Community, or in a part of the Community, is equally irrelevant under Article 7(1)(f).⁶⁰ It is, however, in the OHIM decisions in *Dick Lexic* and *Application of Kenneth (trading as Screw You)* that Article 7(1)(f) has received closest scrutiny.⁶¹

IV.A DICK LEXIC LTD'S APPLICATION⁶²

In *Dick Lexic*, the applicant sought to register DICK & FANNY as a Community trade mark for certain classes of goods. The examiner refused the application under Article 7(1)(f) on the ground that 'Dick' and 'Fanny' are slang words for the human reproductive organs and that use of the mark would be liable to offend a significant proportion of English-speaking consumers. The applicant's appeal was heard by OHIM's Fourth Board of Appeal, which held that, while the mark had a sexual connotation in coarse slang, it was not sufficiently offensive to justify denial of registration on grounds of either public policy or accepted principles of morality. The Board doubted whether the fact that the mark had a sexual connotation was sufficient alone to justify the rejection of an application under Article 7(1)(f). The words 'Dick' and 'Fanny' simply designated things and did not 'transmit any message': In particular, the mark did not 'proclaim an opinion', 'contain [an] incitement' or 'convey [an] insult'.⁶³ On this basis, the registration of terms that were simply smutty would not fall within the scope of the morality and public policy exclusion. The second reason advanced by the Board allowing the appeal

58. Regulation 40/94, Title VII.

59. T-224/01 *Durferrit GmbH v. OHIM* [2004] ETMR 32.

60. T-140/02 *Sportwetten GmbH Gera v. OHIM* [2006] E.T.M.R. 15.

61. Although note the comments of Advocate General Colomer (BABY KILLER for a pharmaceutical abortifacient) in *Koninklijke Philips Electronics NV v. Remington Consumer Products* (C-299/99) [2002] I ECR 5475 (para. 18) (AG Colomer). See also R 176/2004-2 BIN LADEN (signs glorifying terrorism not permitted). See also, *Reva Electric Car Co. (PVT) Ltd.* R 558/2006-2 (18th July 2006) (OHIM, Board of Appeal).

62. R 111/2002 (25 March 2003), OHIM (Fourth Board of Appeal) [2005] ETMR 99.

63. *Ibid.*, [10].

was that the association of the two words at issue did not necessarily reinforce any sexual connotation of the mark. DICK & FANNY could be read simply as ‘a combination of the diminutive form of forenames’.⁶⁴

Thus, although the mark was smutty in non-formal English, the fact that it did not convey an offensive message and had an entirely innocuous meaning in ‘formal English usage’ took it outside Article 7(1)(f). The idea that DICK & FANNY would be likely to be perceived as a combination of the diminutive forms of Richard and Frances is, of course, ridiculous. Nevertheless, it is apparent that the decision of the Board in this case also adopts an approach that was seen in the UK decisions. A relatively high threshold is provided for Article 7(1)(f) and emphasis is placed upon the fact that applications must not be refused purely on the basis of ‘taste’. In *Application of Kenneth*, discussed below, OHIM’s Grand Board had further opportunity to consider the boundary between ‘bad taste’ and the forms of offence prohibited under Article 7(1)(f).

IV.B APPLICATION OF KENNETH (TRADING AS SCREW YOU)⁶⁵

The applicant had applied to register a sign consisting of the words SCREW YOU as a Community Trade Mark in respect of a broad range of goods. The examiner refused the application under Art. 7(1)(f), on the ground that, in the UK and Ireland, ‘screw’ was a coarse sexual term and ‘screw you’ was a crude insult. The applicant appealed, arguing that the sign was not offensive in the eyes of the British public and that the mark had subsequently been registered in the UK. As in *Dick Lexic*, the Grand Board noted that it was not bound by the acceptance of the mark onto the Register in the UK. It went on to provide its view of the underlying rationale for Article 7(1)(f):

[T]he purpose of Art. 7(1)(f) is not to identify and filter out signs whose use in commerce must at all costs be prevented; rather the rationale of the provision is that the privileges of trade mark registration should not be granted in favour of signs that are contrary to public policy or the accepted principles of morality. In other words, the organs of government and public administration should not positively assist people who wish to further their business aims by means of trade marks that offend against certain basic values of civilised society.⁶⁶

With this foundation in mind, the Board considered the distinction between marks that were ‘merely irreverent or distasteful’ and those that were ‘seriously abusive and likely to cause deep offence’. It was of the view that ‘slightly rude words or mild sexual innuendo’ (such as the mark in *Dick Lexic*)⁶⁷ might be registered, but

64. *Ibid.*, [11].

65. R 495/2005-G, OHIM (Grand Board), 6 July 2006, [2007] ETMR 7.

66. *Ibid.*, [13].

67. It is suggested that this was also true of ‘mildly pejorative’ terms, such as ‘Pommy’ and ‘Yank’, *ibid.*, [19].

signs that consisted of ‘manifestly profane language’, depict ‘gross obscenity,’ glorify terrorism⁶⁸ or severely offend the religious sensitivities of a substantial group of the population⁶⁹ could not be registered. In distinguishing between registrable and non-registrable marks, the Board held that the OHIM had to apply ‘the standards of a reasonable person with normal levels of sensitivity and tolerance’. Such a person was an ‘ordinary citizen’ and not one of a ‘small minority of exceptionally puritanical citizens’ or one of ‘the equally small minority at the other end of the spectrum who find even gross obscenity acceptable’.⁷⁰ The context in which the mark was likely to be encountered was also significant.⁷¹

In applying these principles, the Board held that ‘Screw You’ was a vulgar interjection using sexuality for the purpose of expressing contempt and loathing. A substantial number of citizens with a normal level of sensitivity and tolerance would be likely to find regular commercial exposure to the term offensive and objectionable, particularly parents of young children and older people. Accordingly, the rejection of the registration was upheld in respect of those goods which were ordinary items marketed to the general public. However, the appeal was allowed in respect of goods of a type that were normally sold exclusively in sex shops or on websites devoted to sex products.⁷²

V. THE IMPACT OF FREEDOM OF EXPRESSION

One of the most interesting aspects of the cases outlined above is the increased role that Article 10 appears to have begun to play in them. Decision-makers have come to accept that any refusal of an application under section 3(3)(a) or Article 7(1)(f) must be made with due regard to an applicant’s right to freedom of expression. This development is considered in greater detail below. First, however, it is important to outline the scope and application of Article 10 and to explain how it appears to be relevant in cases concerning the morality/public policy exclusion.

68. See, for example, Case R 176/2004-2 BIN LADEN.

69. ‘Signs which severely offend the religious sensitivities of a substantial group of the population are also best kept off the register, if not for moral reasons, at least for reasons of public policy, namely the risk of causing public disorder,’ [2007] ETMR 7, [20].

70. *Ibid.*, [21].

71. ‘If the goods are of a type that are only sold in licensed sex shops, a more relaxed attitude may be appropriate. If the goods are likely to be advertised on prime-time television or worn in the street with the trade mark prominently displayed, a stricter approach may be justified. It is also necessary to bear in mind that, while broad-minded adults may enjoy bawdy humour in a particular context, they might not wish to be exposed to material with explicit sexual content when walking down the street or watching television in the company of their children or elderly parents.’ *Ibid.*, [21].

72. Registration was also permitted in respect of condoms, *Ibid.*, [29]. See also, *Reva Electric Car Co. (PVT) Ltd.* R 558/2006-2 (18th July 2006) (OHIM, Board of Appeal), in which a distinction was drawn between use of a potentially indecent term on electric cars (acceptable) and on T-shirts (unacceptable).

V.A

THE SCOPE AND STATUS OF ARTICLE 10

The rights protected under the ECHR ostensibly bind only State parties, which agree to 'secure to everyone within their jurisdiction the rights and freedoms' protected under the ECHR.⁷³ The European Court of Human Rights may receive applications from any person claiming to be a victim of a violation of a protected right by a State party.⁷⁴ One such right is the right to freedom of expression, as defined in Article 10:

(1) Everyone has the right to freedom of expression. The right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This Article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

(2) The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.

In order to demonstrate a violation of Article 10, an applicant must first establish an 'interference' with 'expression' (that is, that the right set out in Article 10(1) is 'engaged'). Where there is such an 'interference', the relevant State must establish that the restriction in question is (1) prescribed by law; (2) has been imposed for one of the legitimate reasons listed in Article 10(2) and (3) is 'necessary in a democratic society'. Such an analytical structure appears, at first sight, to impose strict scrutiny upon all interferences with expression, but the European Court of Human Rights has not, in practice, treated all forms of expression alike. Interferences with expression concerning politics and public affairs have generally been reviewed strictly,⁷⁵ particularly where they affect the mass media.⁷⁶ On the other hand, states have been allowed greater freedom to restrict artistic and commercial expression. In this respect, the doctrine of 'margin of appreciation', under which national authorities benefit from greater latitude in certain situations, has been particularly significant.⁷⁷

73. European Convention on Human Rights and Fundamental Freedoms, Art. 1.

74. *Ibid.*, Art. 34. Applications to the Court can be made by legal, as well as natural persons. See, for example, in the context of Art. 10, *Sunday Times v. United Kingdom* (1979–80) 2 EHRR 245; *VgT Verein gegen Tierfabriken v. Switzerland* (2002) 34 EHRR 4.

75. See, for example, *Lingens v. Austria* (No. 2) (1986) 8 EHRR 407; *Thorgeirson v. Iceland* (1992) 14 EHRR 843.

76. See, for example, *Sunday Times v. United Kingdom* (1979–80) 2 EHRR 245; *Goodwin v. United Kingdom* (1996) 22 EHRR 123.

77. See, for example, *Müller v. Switzerland* (1991) 13 EHRR 212; *Wingrove v. United Kingdom* (1997) 24 EHRR 151; *Otto-Preminger Institute v. Austria* (1995) 19 EHRR 34.

The ECHR imposes obligations directly only upon states. However, indirectly, the protected rights also have a ‘horizontal’ impact in private proceedings. State activity in resolving disputes must always respect protected rights, including Article 10.⁷⁸ As a result, a legislature or court must ensure that it does not breach the right to freedom of expression when distributing entitlements between private parties. Furthermore, Article 10 is not only relevant in proceedings before the European Court of Human Rights. Many European states have, to one degree or other, incorporated the standards established under the ECHR into national law. The UK has done so, for example, through the Human Rights Act 1998, which obliges public authorities (including courts, but excluding the legislature) to act compatibly with the ECHR.⁷⁹ The rights protected under the ECHR also now form an integral part of the structure of fundamental rights underpinning the law of the European Union. The European Court of Justice requires Community measures to be interpreted in accordance with the rights protected under the ECHR.⁸⁰

This summary of the scope and application of Article 10 will have demonstrated how those bodies responsible for determining the application of the public policy/morality exclusions are bound by the norms and rules to be found in the ECHR. The UK’s Registrar is undoubtedly a ‘public authority’ and therefore must act compatibly with Article 10 under the Human Rights Act 1998. The same is true of the Lord Chancellor’s Appointed Person and of any court hearing an appeal under section 3(3)(a).⁸¹ The European Community is not itself a party to the ECHR. Nevertheless, as an organ of the Community, the OHIM (including the Boards of Appeal) must also interpret European trade mark law compatibly with the Convention. Thus, whether in the UK or in the Community Trade Mark system, the bodies responsible for determining the scope and application of the public policy/morality exclusions are undoubtedly bound to secure the fundamental rights protected under the ECHR. The manner in which this obligation has been interpreted is explained further below.

V.B THE APPLICATION OF ARTICLE 10 IN IMMORALITY/PUBLIC POLICY CASES

In the UK, an argument based on freedom of expression under the Human Rights Act was first made before Simon Thorley QC in *Ghazilian*. He was sceptical about the relevance of the right, noting that refusal to register TINY PENIS would not prevent the applicant from using the phrase as a mark. However, he did not ‘find it

78. See, for example, *Steel and Morris v. United Kingdom* (2005) 41 EHRR 22.

79. Human Rights Act 1998, ss. 6, 3(1), 2(1).

80. See, for example, (C-112/00) *Schmidberger Internationale Transporte und Planzuge v. Austria* [2003] 2 CMLR 34, [71]–[74]; Case C-71/02 *Herbert Karner Industrie-Aultionen GmbH v. Troostwijk GmbH* [2005] ETMR 59.

81. Once domestic routes of redress have been exhausted, an affected party would be entitled to bring proceedings against the United Kingdom at Strasbourg.

necessary to enter this debate.’ In his view, the structures of analysis under the Trade Marks Act 1994 and Article 10 were, in any event, identical:

Section 3(3) indicates that the Registrar should refuse registration where the mark is contrary to accepted principals of morality. To redefine this as saying that he should only refuse registration where there is a pressing social need to do so, is, to my mind, merely a matter of words. The same principles are at work. There must be a clearly identified aspect of morality which exists and which would be undermined by the registration . . . This does not however assist in defining the dividing line between cases where registration should be allowed or refused.⁸²

He thus satisfied himself that he was entitled to proceed much as he would have done prior to the coming into force of the Human Rights Act because there was, in substance, no distinction between the approach required under Article 10 and that required under section 3(3)(a).⁸³

A movement away from this rather conservative approach was clearly apparent in the decision of Geoffrey Hobbs QC in *Basic Trademark SA’s Application*. Indeed, that case could be argued to mark a turning-point in the approach taken to the relationship between Article 10 and the public policy/morality exclusion. The structure of analysis required under Article 10 was employed in a central role as a framework for the decision. At the very outset, the Appointed Person noted that ‘it is necessary to interpret and apply the prohibition in section 3(3)(a) of the Act consistently with the provisions of the Convention’, and in particular with Article 10.⁸⁴ In this respect, he explained that such a consistent and ‘disciplined’⁸⁵ interpretation was readily achieved under section 3(3)(a):

Section 3(3)(a) seeks to prohibit registration in cases where it would be legitimate for the ‘prevention of disorder’ or ‘protection of . . . morals’ to regard use of the trade mark in question as objectionable in accordance with the criteria identified in Art.10 ECHR. It does so in terms which disclose no intention to prohibit registration in cases where use of the relevant trade mark would not be objectionable under Art.10 on either or both of those bases.⁸⁶

This general conclusion is similar to Simon Thorley QC’s in *Ghazilian*. However, the tone is quite different. A much stronger role for Article 10 is accepted:

[T]he right to freedom of expression must always be taken into account without discrimination under s. 3(3)(a) and any real doubt as to the

82. [2002] ETMR 57, [22]–[23].

83. This approach was also taken at first instance in copyright proceedings in *Ashdown v. Telegraph Group Ltd* [2001] Ch 685 (Morritt V-C.). Potential incompatibility between copyright law and Article 10 was, however, acknowledged by the Court of Appeal in the same case, *Ashdown v. Telegraph Group Ltd* [2002] Ch 149, (CA) para. 44.

84. [2006] ETMR 24, [3].

85. *Ibid.*, [22].

86. *Ibid.*, [6].

applicability of the objection must be resolved by upholding the right to freedom of expression, hence acceptability for registration.⁸⁷

In coming to a final assessment on the facts, the Appointed Person placed explicit reliance on Article 10:

[In] my view . . . the hearing officer was right to conclude that use of the word JESUS as a trade mark would cause greater offence than mere distaste and do so to a significant section of the general public. The use of it as a trade mark should . . . be regarded as seriously troubling in terms of the public interest in the ‘prevention of disorder’ and ‘protection of morals’ under Art. 10 ECHR. It is legitimate to apply the prohibition in s. 3(3)(a) of the Trade Marks Act 1994 to branding which is anti-social by reason of its ability to undermine an accepted social and religious value to a significant extent. That is the position here . . . I consider that the applicant’s right to freedom of expression can and should be taken to require moderation by refusal of registration on the basis of the prohibition against registration contained in s. 3(3)(a) of the Trade Marks Act 1994.⁸⁸

Thus, while Article 10 was undoubtedly engaged, the refusal to register JESUS was a necessary and proportionate response in the legitimate interests of preventing disorder and protecting morals.

The constraints of Article 10 were also accepted in *Scranage’s Trade Mark Application*, in which David Kitchin QC satisfied himself that the approach adopted in *Ghazilian* and *Dick Lexic* was compatible with the right to freedom of expression because, under that approach, only weighty countervailing interests bring the morality/public policy exclusions into operation:

Registration is not to be refused on the grounds of taste. For the prohibition to operate a mark must be one which will justifiably cause outrage or be the subject of justifiable censure as being likely significantly to undermine current religious, family or social values.⁸⁹

The manner in which an application to register FUCK ought to be resolved was explained with explicit reference to the vocabulary of Article 10:

I have no doubt that it would not be appropriate to allow registration of the word FUCK. Although it may be used commonly it is, nevertheless, a swear word and deeply offensive and insulting to many people. It is more than distasteful or smutty. The general use of the word is likely to cause justifiable outrage amongst a significant section of the public. I can see no justification based on the right to freedom of expression or otherwise to allow such a word to proceed to registration.⁹⁰

87. *Ibid.*, [6]–[7].

88. *Ibid.*, [26]–[27]. The use of the ‘seriously troubling’ standard seems to add unjustified complexity to an already difficult assessment.

89. O/182/05, 23 June 2005, [8].

90. *Ibid.*, para. 10.

In *French Connection Ltd's Trade Mark Registration*, the obligation to secure compliance with Article 10 was accepted by Richard Arnold QC as one of the principles to be derived from the case law on section 3(3)(a) and Article 7(1)(f). He confirmed that registration should only be refused where this course of action was justified by a pressing social need and was proportionate to the legitimate aim pursued.⁹¹ Any doubt as to the applicability of the objection was to be resolved by upholding the right to freedom of expression by permitting registration.⁹²

Within the Community system, it was only with *Application of Kenneth (trading as Screw You)* that the role of Article 10 in the interpretation of Article 7(1)(f) was acknowledged. In that case, however, the Grand Board went further than any decision-making body within the UK in explaining *why* the failure to register a mark might be regarded as engaging Article 10:

While it is true to say that a refusal to register does not amount to a gross intrusion on the right of freedom of expression, since traders can still use trade marks without registering them, it does represent a restriction on freedom of expression in the sense that businesses may be unwilling to invest in large-scale promotional campaigns for trade marks which do not enjoy protection through registration because the Office regards them as immoral or offensive in the eyes of the public.⁹³

Failure to register a mark may have a 'chilling' effect on expression.⁹⁴ The Grand Board also demonstrated a closer awareness of the Strasbourg jurisprudence than has been apparent in the UK decisions. It explained that, under Article 10:

Freedom of artistic expression is regarded as a higher priority than freedom of commercial expression and consequently it is more fiercely protected. The use of profanities in the name of art and literature is circumscribed with great reluctance in democratic and open societies. The same is true in relation to expressing opinions. A militant atheist may write an article for public consumption ridiculing religion, for example, and the State will not intervene. But a trade mark mocking, or exploiting the name of, the founder of a major world religion might nonetheless be kept off the register.⁹⁵

Interferences with commercial expression, including the use of a mark, may thus be more readily justified under the structure of analysis imposed by Article 10 than interferences with creative expression. The fact that the term 'screw you' had occasionally been heard on British television at family viewing times did not therefore mean that the phrase had to be accepted for registration as a trade mark.⁹⁶ Nevertheless, despite having gone further in analyzing and explaining

91. [2007] ETMR 8, [60].

92. *Ibid.*

93. [2007] ETMR 7, [15].

94. For discussion of the significance of 'chilling effects' in free speech jurisprudence, see E. Barendt, *Free Speech*, 2nd edn (OUP, 2005).

95. [2007] ETMR 7, [24].

96. *Ibid.*, [25].

the principles governing the relationship between Article 10 and the morality and public policy exclusions than any previous decision-making body, in reaching its decision on the facts, the Grand Board made no explicit reference to the detailed exercise of proportionality required under Article 10. Its conclusion that the insulting and extremely offensive message conveyed by the phrase ‘screw you’ was covered by Article 7(1)(f) was delivered without overt consideration of the question whether the interference with commercial expression represented a ‘proportionate’ response to a ‘pressing social need’.

VI. HAS ARTICLE 10 BEEN CORRECTLY APPLIED?

Thus, following initial scepticism, there now seems to be general acceptance that a refusal to register a trade mark under these provisions is to be considered within the framework established by Article 10. In this section, I ask whether this approach is, in fact, necessary. I argue that public policy/morality cases actually have little to do with the right of freedom of expression and that decision-makers have been mistaken in giving a central role to Article 10.

VI.A IS ‘EXPRESSION’ AT ISSUE AT ALL?

The first question to be considered is whether an applicant for registration of a mark is ‘covered’ by the right to freedom of expression at all? Article 10 protects only *expression*. Under the Strasbourg case law, this concept has been interpreted broadly. The European Court of Human Rights, unlike the Supreme Court in the US, has not found it necessary to adopt a restricted definition of ‘expression,’ excluding, for example, hard-core pornography or ‘fighting words’.⁹⁷ Article 10 has been held to encompass such forms of expression as pornography,⁹⁸ hunt sabotage⁹⁹ and light music.¹⁰⁰ Despite the generosity of this definition, it is nevertheless necessary, as a first step, to consider whether the activities of an applicant for registration fall within the scope of that right.

What is the form of ‘expression’ allegedly at issue in cases such as these? This is not a question raised explicitly in any of the decisions noted above. Is it the *registration* of a mark, or is it its *use*? As a bureaucratic act carried out by the Registrar (rather than by the applicant), the act of registration cannot itself constitute ‘expression’ for the purpose of Article 10. However, an argument that *use* of a trade mark constitutes ‘expression’ looks more promising. At very least, a trade mark in use provides information about the commercial origin of goods or

97. *Miller v. California* 413 US 15 (1973); *Chaplinsky v. New Hampshire* 315 US 568 (1942); *Lewis v. New Orleans II* 415 US 130 (1974).

98. *Hoare v. UK* [1997] EHRLR 678.

99. *Steel v. UK* (1999) 28 EHRR 603; *Harrup & Hashman v. United Kingdom* (2000) 30 EHRR 241.

100. *Groppera Radio AG v. Switzerland* (1990) 12 EHRR 321.

services.¹⁰¹ The fact that use of a mark on a product is generally a *commercial* activity does not, in it of itself, place it beyond the scope of Article 10. The European Court of Human Rights has confirmed that Article 10 *covers* commercial expression.¹⁰² Furthermore, while there may appear to be a distinction between the relatively complex forms of expression at issue in most of the commercial advertising cases before the Strasbourg court and the very simple application of a mark to products in the public policy/morality cases noted above, this distinction may not be a significant one under the Convention. In *Casado Coca v Spain*, a case concerning restrictions on lawyers' advertising, the European Court of Human Rights stated that:

In the instant case the impugned notices merely gave the applicant's name, profession, address and telephone number. They were clearly published with the aim of advertising, but they provided persons requiring legal assistance with information that was of definite use and likely to facilitate their access to justice. Article 10 is therefore applicable.¹⁰³

This argument would appear to be equally tenable in respect of the placing of marks on goods or services. Even if one does not accept any of the more elaborate claims made for the use of a mark as a form of expression,¹⁰⁴ a mark undoubtedly provides information of some use to consumers. As such, it seems quite likely that, in the eyes of the Strasbourg Court, the *use* of a mark by its proprietor will fall within the scope of protected 'expression' under Article 10. Consequently, it is necessary to consider whether refusal to register such a mark is to be regarded as an 'interference' with that expression.

VI.B DOES REFUSAL TO REGISTER A MARK CONSTITUTE AN INTERFERENCE WITH THE RIGHT PROTECTED BY ARTICLE 10?

At first sight, it would seem difficult for an applicant to demonstrate that failure to register a mark interferes with the use of that mark. As pointed out in *Ghazilian*, rejection of a mark under section 3(3)(a) or Art. 7(1)(f) does not prevent the

101. For discussion of the argument that signs express considerably more than this, see R. Cooper Dreyfuss, 'Expressive Genericity: Trademarks as Language in the Pepsi Generation' 65 Notre Dame L. Rev. 397; R. Cooper Dreyfuss, 'Surveying the Arsenal: Tools for Reconciling Trademark Rights and Expressive Values', *Proceedings of the ALAI Congress 2006* (to be published); M. Spence, 'The Mark as Expression/the Mark as Property' (2005) Current Legal Problems 491.

102. See, for example, *Markt Intern Verlag GmbH v. Germany* (1989) 12 EHRR 161; *Casado Coca v. Spain* (1994) 18 EHRR 1; *Krone Verlag gmbH & Co KG (No. 3) v. Austria*, (2006) 42 EHRR 28.

103. (1994) 18 EHRR 1, [37].

104. See, for example, M. Spence, 'The Mark as Expression/the Mark as Property' (2005) Current Legal Problems 491.

applicant from using that mark.¹⁰⁵ In this respect, the situation differs significantly from that considered by the European Court of Human Rights in *Gaweda v. Poland*, in which the Court held that a refusal to register the titles of periodicals under the Polish Press Act violated Article 10.¹⁰⁶ In that case, without registration, the applicant could not publish its periodicals in Poland. Refusal was therefore a form of prior restraint on expression. Nevertheless, under the Strasbourg jurisprudence, it is not only prior restraints that are capable of constituting actionable ‘interferences’. *Ex post facto* penalties can also interfere with expression as a result of their ‘chilling effect’ on speech. Thus, for example, the imposition of criminal fines, awards of damages and employment sanctions can constitute interferences for the purposes of Article 10. Can refusal to register a mark also be regarded as a relevant interference?¹⁰⁷

Again, at first glance, a refusal to register could seem to be an equivalent disadvantage accruing to a particular form of expression. However, there is a significant difference between situations in which a penalty is actively imposed or upheld by a state body and refusal of registration. Where a mark is refused under the public policy/morality exclusions, no penalty is imposed. The national, or supra-national, registration authority simply fails to provide positive assistance to the applicant. The European Court of Human Rights has interpreted Article 10 as imposing positive obligations only in extreme cases. For example, in *Ozgur Gundem v. Turkey*, the applicant newspaper’s staff had suffered serious physical attack by unknown persons.¹⁰⁸ The state’s failure to offer assistance, despite knowledge of the circumstances, was held to constitute a violation of Article 10. In less extreme situations, the Court has been reluctant to impose positive obligations under this provision. In *Appleby v. United Kingdom*,¹⁰⁹ it held that there was no violation of Article 10 when the state failed to secure access for protestors to a privately-owned shopping centre. The context of *Appleby* is quite different from the cases with which we are concerned here.¹¹⁰ Nevertheless, it exemplifies the Strasbourg court’s reluctance to impose positive obligations except in circumstances where the ‘essence of the right’¹¹¹ under Article 10 is affected. Even if the very basic nature of the communicative act at issue in the public policy/morality cases is overlooked, it is difficult to see how they engage the ‘essence’ of Article 10 when traders remain free to use a particular mark and when one of the potential consequences of non-registration is greater use of the mark by third parties.

105. [2002] ETMR 57, [22].

106. *Gaweda v. Poland* (2004) 39 EHRR 4.

107. For an argument that refusal of registration under the equivalent provision of US law requires justification under the First Amendment, see J. Leftin, ‘Does the First Amendment bar cancellation of Redskins?’ (2001) 52 *Stanford Law Review* 665.

108. (2001) 31 EHRR 49.

109. (2003) 37 EHRR 38.

110. Notably, by contrast with both *Ozgur Gundem* and *Appleby*, the imposition of a positive obligation in s. 3(3)(a)/Art. 7 (1)(f) cases would not impose potentially onerous obligations on the state or a third party.

111. (2003) 37 EHRR 38, [47].

VI.C IS IT 'NECESSARY IN A DEMOCRATIC SOCIETY' TO REFUSE REGISTRATION?

It has been argued above that, although the use of a mark is likely to fall within the definition of 'expression' under Article 10, refusal to register a mark seems unlikely to constitute an 'interference' with that use. In any event, even if Article 10 were to be interpreted as imposing positive obligations in this situation, a registration authority may very well be able to argue that refusal of a mark in a particular case is 'necessary in a democratic society' for one of the permitted purposes listed under Article 10(2).

In making this claim, it would, first, be obliged to demonstrate that refusal to register a mark under section 3(3)(a) or Article 7(1)(f) was 'prescribed by law'. This condition would easily be satisfied. There is little doubt that the principles applied under these provisions possess sufficient legal certainty and foresight to qualify as 'law' under the ECHR.¹¹² Having surmounted this hurdle, the registration authority would have to demonstrate that its rejection of the application in question is covered by one or more of the permitted purposes listed in Article 10(2). These reasons may well differ from case to case. For example, in *Basic Trademark SA*, Geoffrey Hobbs QC considered that the refusal to register JESUS fell under two of the listed purposes ('prevention of disorder' and 'protection of morals').¹¹³ In the other public policy/morality decisions considered in this chapter, explicit attention has not been directed to this issue. Nevertheless, it can be assumed that a decision to refuse registration of DICK & FANNY, FOOK or FCUK would be potentially justifiable as an interference for 'the protection of . . . morals'. In cases such as *CDW Graphic Design Ltd's Application*, *Sporting Kicks Ltd* and *Application of Kenneth (trading as Screw You)* (the 'badge of antagonism' cases), both the 'protection of public order' and 'the protection of . . . morals' would appear to be relevant.

The question of whether or not any such refusal to register is 'necessary in a democratic society' is more complex. The European Court of Human Rights has held that this requirement encompasses three separate conditions. Firstly, any interference must respond to a 'pressing social need'. Secondly, it must be proportionate and, finally, it must be accompanied by relevant and sufficient reasons.¹¹⁴ As noted above, despite the disciplined scrutiny apparently demanded by such a test, the European Court of Human Rights has applied varying levels of scrutiny to different forms of communication under Article 10(2). There are good reasons to suppose that the refusal to register a mark under the public

112. For discussion of this requirement, see *Harrup & Hashman v. United Kingdom* (2000) 30 EHRR 24.

113. The 'rights of others' to practice their religious beliefs free from interference could also, controversially, have been regarded as relevant in these circumstances, see *Otto-Preminger Institute v. Austria* (1995) 19 EHRR 34.

114. The third of these requirements should present no difficulties in the cases under consideration as written reasons are available when registration is refused under s. 3(3)(a) or Art. 7(1)(f).

policy/morality provisions would be subject at most to very relaxed scrutiny. As a consequence, even if refusal to register a mark is *covered* by Article 10, it is highly unlikely that the European Court of Human Rights would regard it as violating Article 10. Under Article 10(2), a registration authority¹¹⁵ is obliged to conduct a form of disciplined ‘balancing’ exercise in order to establish whether or not the refusal to register a mark is necessary for one of the permitted purposes. Clearly, in any such balancing exercise, the strength of the applicant’s expression right is relevant. In this regard, it is important to note that, even if the exercise of a trade mark can be demonstrated to be ‘covered’ by Article 10(1), it certainly does not fall close to the core of that right. The simple application of mark to product or services is in no sense comparable with the complex forms of expression on matters of significant public interest that the European Court of Human Rights has valued most highly.¹¹⁶ The expressive act at issue in the public policy/morality cases is not only very simple; it is also motivated by purely commercial ends. As noted above, commercial expression is accorded less weight by the Strasbourg court than forms of expression regarded as having greater intrinsic value.¹¹⁷ In considering the balance of interests in such cases, it is also important to bear in mind the gravity of the restraint on expression at issue. Very serious restrictions on expression, such as criminal sanctions and prior restraint will require very clear justification.¹¹⁸ However, the form of restraint applied in the cases with which we are concerned is far from total. A disappointed trader retains the ability to apply the mark to goods or services.

Thus, for a number of reasons, an applicant’s rights under Article 10 are not particularly weighty. While the European Court of Human Rights has recently held an application for a trade mark to be protected as a human right under Article 1 of the First Protocol to the ECHR, such protection is relatively easily overcome by competing state interests.¹¹⁹ Furthermore, it is also likely that the nature of the public interests advanced by a registration authority in refusing registration of a mark will also weigh against an applicant. In a number of the cases discussed in this chapter, marks have been refused for reasons of public decency. It is a striking feature of the Strasbourg case law on Article 10, that contracting parties have been accorded a particularly wide margin of appreciation on questions of decency and morality.¹²⁰ A similarly wide margin of discretion has been accorded in situations

115. Or body hearing appeals from the registration authority.

116. See, for example, *Sunday Times v. United Kingdom* (1979–80) 2 EHRR 245; *VgT Verein gegen Tierfabriken v. Switzerland* (2002) 34 EHRR 4; *Lingens v. Austria (No 2)* (1986) 8 EHRR 407; *Thorgeirson v. Iceland* (1992) 14 EHRR 843; *Alinak v. Turkey* (40287/98) 29th March 2005.

117. See, for example, *Casado Coca v. Spain* (1994) 18 EHRR 1; *Markt Intern v. Germany* (1990) 12 EHRR 161; *Demuth v. Switzerland* (2004) 38 EHRR 20.

118. See, for example, *Observer & Guardian v. United Kingdom* (1992) 14 EHRR 153; *Sokolowski v. Poland* (7585/01) 29 March 2005; *Malisiewicz-Gasior v. Poland* (97/98) 6 April 2006.

119. See *Anheuser-Busch Inc. v. Portugal* [2007] ETMR 24.

120. See, for example, *Müller v. Switzerland* (1991) 13 EHRR 212; *Wingrove v. United Kingdom* (1997) 24 EHRR 151.

in which a state has claimed to interfere with expression in order to protect the religious rights of others¹²¹ or in order to maintain public security or prevent disorder.¹²² These are precisely the competing interests that have been advanced most frequently by registration authorities in refusing to register marks under the public policy/immorality provisions. Thus, upon looking a little more closely at the Strasbourg jurisprudence, it would appear that the European Court of Human Rights would be extremely unlikely to intervene in decisions to refuse to register a mark under section 3(3)(a) or Article 7(1)(f).¹²³

VII. CONCLUSION

This is a rather peculiar conclusion. Commentators usually argue that intellectual property courts take insufficient account of free speech interests.¹²⁴ By contrast, in the cases discussed in this chapter, decision-makers appear to have become over-zealous in their determination to adopt a framework for decision-making borrowed from Article 10. However, this contrast may not be as odd as it initially appears. Both phenomena may have much the same cause. Courts come to mistaken conclusions about the requirements of Article 10 when they do not engage adequately with the detailed rules and principles governing its application. This lack of engagement may not actually have had a great deal of impact in the public policy/morality cases with which we have been concerned in this chapter. There is little evidence that the rhetoric of compliance is anything more than misplaced lip-service. Nevertheless, to the extent that registration authorities act in the belief that Article 10 obliges them to operate a strong presumption in favour of registration in such cases, there is a myth worth dispelling.

121. See, for example, *Wingrove v. United Kingdom* (1997) 24 EHRR 151; *Otto-Preminger Institute v. Austria* (1995) 19 EHRR 34.

122. See, for example, *Choherr v. Austria* (1994) 17 EHRR 358.

123. In this respect, it is interesting to note that in the most significant case concerning trade mark registration before the European Court of Human Rights, *Anheuser-Busch Inc v. Portugal* [2007] ETMR 24. Art. 10 was neither relied upon by the applicant nor raised by the Court. At very least, this suggests that the claim is far from obvious under the Convention system.

124. See, for example, J. Rubinfeld, 'The Freedom of Imagination: Copyright's Constitutionality' (2002) 112 Yale LJ 1; C. Geiger, '“Constitutionalising” Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property' 36 IIC 371 (2006); J. Griffiths, 'Copyright Law after *Ashdown*: Time to Deal Fairly with the Public [2002] 6 IPQ 240–264.

Chapter 13

Trade Marks and Human Rights

*Andreas Rahmatian**

I. INTRODUCTION: THE RELEVANCE OF HUMAN RIGHTS TO TRADE MARK LAW

The relevance of human rights in the context of intellectual property has only recently attracted interest, mostly with regard to copyright, and in this respect an extensive academic discussion emerged quickly.¹ As copyright is the most important intellectual property right in relation to (chiefly spoken and written) human expressions, the emphasis on copyright is apt. Tensions between copyright and human rights have been considered especially in the context of freedom of expression/freedom of speech and, occasionally, the right to privacy as the most obvious candidates for a conflict.

Trade mark rights are only on the fringes of a concern for human rights protection, which is not entirely justified; furthermore, possible conflict situations between trade marks and human rights do not necessarily parallel the copyright-human rights scenario. A general problem is the fact that the human rights dimension has been discussed practically only from the perspective of intellectual

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1. See e.g. the relevant contributions in the first and current editions of this book, and J. Griffith and U. Suthersanen (eds), *Copyright and Free Speech. Comparative and International Analyses* (Oxford, OUP, 2005).

property law;² it seems that human rights lawyers do not venture into the area of the technical and unfamiliar commercial law. A look into four human rights textbooks in the UK³ reveals that intellectual property is not discussed specifically at all, and property protection generally, its limits and its commercial law aspects, only in passing⁴ or, again, not at all.⁵ Given that the private, commercial and especially property laws are the most important rules that determine every person's subsistence and commercial life, this is rather astonishing. A result from this one-sided approach is that intellectual property lawyers seek to squeeze the unfamiliar concept of human rights into the familiar one of, say, copyright, and argue that the human right of free speech is catered for sufficiently (or perhaps not) by the permitted acts, such as fair dealing and fair use. This view has probably correctly been criticized as 'judicial formalism at its worst',⁶ but it is currently difficult to see any alternatives, especially since this approach is arguably the only one which could convince a commercial court in an action. Indeed, even in the common law, where the divide between public law (that is constitutional and human rights law) and private law (that is intellectual property law) is not as much engrained in legal training and the court systems as on the European continent, judges have pronounced that copyrights are 'categorically immune' from constitutional/human rights challenges, as the US case of *Eldred* has recently shown.⁷ The incorporative approach of human rights in existing intellectual property legislation, without any real attempt at a purposive interpretation of intellectual property law in the light of the human right in question, does not foster a culture which human rights lawyers would probably prefer.⁸ that human rights, due to their fundamental importance and (often) quality as constitutional rights, prevail over commercial law in defining the limits of an individual's claim, not conversely, as it is presently effectively the

2. E.g. J. Griffith and U. Suthersanen (eds), *Copyright and Free Speech*, n. 1 above, xxi–xxvi. All contributors are intellectual property or media lawyers. The same is true of the present collection. (The writer of this contribution is no exception.)
3. R. Smith, *Textbook on International Human Rights*, 3rd ed. (Oxford, OUP, 2007); R. Stone, *Textbook on Civil Liberties and Human Rights*, 6th ed. (Oxford, OUP, 2006); C. Ovey and R. White (Jacobs and White), *The European Convention on Human Rights*, (Oxford, OUP, 2006); H. Fenwick, *Civil Liberties and Human Rights*, 4th ed. (Oxford, Routledge-Cavendish, 2007).
4. Ovey and White, n. 3 above, 349–351; Stone, n. 3 above, 160.
5. Smith, n. 3 above, 165 (conflict of freedom of expression with other rights, but no reference to property interests); Fenwick, n. 3 above, 104 (very cursory treatment of Art. 1 of the First Protocol to the European Convention on Human Rights).
6. N. W. Netanel, 'Copyright and the First Amendment: What *Eldred* misses – and portends', in J. Griffith and U. Suthersanen (eds), *Copyright and Free Speech. Comparative and International Analyses*, (Oxford, OUP, 2005), 129.
7. *Eldred v Ashcroft* 537 US 186 (2003), 221, the quote from the decision of *Eldred v. Reno* 239 F. 3d 372, 375 (United States CADDC). The Supreme Court noted that this statement was too broad but did not consider further First Amendment scrutiny as necessary in the case in question. See also W. J. Gordon, 'Copyright Norms and the Problem of private Censorship', in J. Griffith and U. Suthersanen (eds), *Copyright and Free Speech. Comparative and International Analyses*, (Oxford, OUP, 2005), 70–71.
8. Stone, n. 3 above, 7–8.

case. This aspect is of even greater importance in the area of trade mark law, because the permitted acts or limits on the effects of registered trade marks, which may allow some ingress of human rights law (when following the copyright-human rights conflict model), are particularly narrow and full of restrictive technical detail, when compared with copyright.⁹ If the limitations to the proprietary power of trade mark ownership, which the trade mark laws provide, are to be the yardstick for the determination of the effect of human rights in trade mark law, then this effect would be almost irrelevant.

Furthermore, the harmonization of trade mark laws, and therefore of their defence provisions, is far more advanced than in copyright, both at regional level in Europe, as a result of the EC-Trade Mark Directive and Regulation,¹⁰ and world-wide, because of the TRIPS Agreement,¹¹ which provides trade mark provisions that are unusually detailed for an international instrument. The underlying or conflicting human rights regime has by no means reached this level of international harmonization, at least as far as human rights are concerned that are *enforceable* by individuals against authorities and, increasingly, non-state entities, especially businesses. The question arises as to which set of human rights rules is to be applicable in cases of challenges of, for instance, the German, US-American or Brazilian trade mark law.

Thus there are several problem areas which will be discussed in the following. First, it needs to be established what the subject-matter of protection, the trade mark right, consists of, what its nature and limits are. That will be discussed in section II. This is the prerequisite for ascertaining the extent of possible effects of human rights from two perspectives of human right protection, that of the trade mark proprietor, and that of the non-owning trade mark user. Section III deals with the question as to which human rights regime is one supposed to refer to in a commercial law context. In section IV, the relevant types of human right which potentially affect trade mark laws, are discussed. In principle, the following discussion also applies to unregistered trade marks and passing off, but that is probably of less practical relevance, because under the vastly expanded possibilities of registration under modern trade mark legislation (advertising jingles, three-dimensional marks and so forth) businesses are able to register a trade mark easily and usually have done so.

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9. Compare e.g. TRIPS Agreement, Art. 17 (only limited exceptions taking account of the legitimate interests of the owner and third parties are permitted) and Art. 21 (complete prohibition of compulsory licenses); UK: Trade Marks Act (TMA) 1994, subs 11–12; Germany: *Markengesetz* 1994 (BGBl. I, S. 3082, as amended) §§ 20–26; US: 15 USC §§ 1114(2)–1115; France: *Code de la Propriété Intellectuelle* (consolidated version 22 December 2007), L713–4, 713–6.
 10. First Council Directive 89/104 EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks, Arts 6 and 7 (limitation of the effects of trade marks, exhaustion of the rights conferred by a trade mark); Council Regulation (EC) No. 40/94 of 20 December 1993 on the Community Trade Mark (as amended), Arts 12 and 13.
 11. Agreement on Trade-related Aspects of Intellectual Property Rights 1994 (TRIPS Agreement), especially Art. 17, but also Arts 19 and 20 are relevant.

II. NATURE AND FUNCTION OF TRADE MARKS

There is generally agreement in all jurisdictions, reinforced by Articles 15 and 16 of the TRIPS Agreement, that trade marks have to be signs capable of distinguishing goods or services of one undertaking from those of other undertakings in order to be able to protect the first undertaking's goodwill which they denote and symbolize. Thus the protection of the goodwill is bound up with the essential function of a trade mark.¹² This idea is particularly apparent in the case of the protection of marks 'with a reputation' against dilution in relation to dissimilar goods or services.¹³ However, the trade mark is not merely the visible manifestation of the business goodwill behind it without any independent role beside its symbolizing function. Trade marks today also have an advertising and communication function which is combined with its quality function, and which is central to modern branding strategies.¹⁴

Judgments of the European Court of Justice (ECJ) illustrate well the close connection of the goodwill of an undertaking with the essential function of its trade mark. This essential trade mark function is, in the words of the ECJ in *Hoffmann-La Roche*,¹⁵

to guarantee the identity of the origin of the trade-marked product to the consumer or ultimate user, by enabling him without any possibility of confusion to distinguish that product from products which have another origin.

Any unauthorized use of the trade mark which impedes or interferes with this essential function is to be regarded as an infringement, even if the ultimate user in question was not necessarily or clearly not confused, because the sign was perceived as a badge of support for, or loyalty or affiliation to, the trade mark proprietor, as the ECJ case of *Arsenal* has shown.¹⁶ The ECJ restated the essential function definition in *Hoffmann-La Roche* and continued:¹⁷

For that guarantee of origin, which constitutes the essential function of a trade mark, to be ensured, the proprietor must be protected against competitors

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12. P. Torremans, *Holyoak and Torremans, Intellectual Property Law*, 5th ed. (Oxford, OUP, 2005), 438.
 13. Community Trade Mark Regulation, Reg. 9(1)(c), TM Directive, Art. 5(2); UK: TMA 1994, s. 10(3); Germany: *Markengesetz* 1994, § 14(2) s. 3; US: 15 USC § 1125(c); France: *Code de la Propriété Intellectuelle*, L713-5.
 14. F. Schechter, 'The Rational Basis of Trade Mark Protection' (1926-1927) 40 *Harvard L. Rev.*, 813, 818; L. Bently and B. Sherman, *Intellectual Property Law*, 2nd ed. (Oxford, OUP, 2004), 694-695.
 15. *F Hoffmann La Roche & Co AG v Centrafarm Vertriebsgesellschaft Pharmazeutischer Erzeugnisse mbH* (Case 102/77), 1978 WL 139250, [1978] ECR 1139, Celex No. 677C0102, at para. 7.
 16. *Arsenal Football Club Plc v Reed* (Case C206/01), 2002 WL 31712, [2002] ECR 10,273, [2003] E.T.M.R. 19, [2003] 1 C.M.L.R. 12, Celex No. 601J0206.
 17. *Ibid.*, paras 50, 51 and 54. See also A. Rahmatian, 'Infringing Use of a Trade Mark as a Criminal Offence', in J. Phillips and I. Simon, *Trade Mark Use* (eds) (Oxford, OUP, 2005), 203, 213.

wishing to take unfair advantage of the status and reputation of the trade mark by selling products illegally bearing it. . . . The exclusive right under Article 5(1)(a) of the Directive was conferred in order to enable the trade mark proprietor to protect his specific interests as proprietor, that is, to ensure that the trade mark can fulfil its functions. The exercise of that right must therefore be reserved to cases in which a third party's use of the sign affects or is liable to affect the functions of the trade mark, in particular its essential function of guaranteeing to consumers the origin of the goods. . . . The proprietor may not prohibit the use of a sign identical to the trade mark for goods identical to those for which the mark is registered if that use *cannot* affect his own interests as proprietor of the mark, having regard to its functions. Thus certain uses for *purely descriptive purposes* are excluded from the scope of Article 5(1) of the Directive because they do not affect *any* of the interests which that provision aims to protect (emphasis added).

Similar pronouncements from the US courts exist from very early on, for example in *Hanover Star Milling Co. v. Metcalf*:¹⁸

The redress that is accorded in trademark cases is based upon the party's right to be protected in the good will of a trademark or business. The primary and proper function of a trademark is to identify the origin or ownership of the article to which it is affixed.

From a human rights perspective, these dicta are important, because they delineate the extent of the property right which the trade mark confers, and this potentially far-reaching property right can be protected as a human right. The property protection claim can be directed at two areas: the trade mark itself, and the goodwill the trade mark refers to. Trade mark protection originates from the protection against passing off which protects the proprietary interest of the business goodwill, so that initially the sign itself did not obtain property protection.¹⁹ The actual nature and extent of business goodwill is difficult to ascertain,²⁰ but that may become relevant in relation to some human rights, especially the right to work under fair working conditions and will be considered then.²¹ Trade marks are now generally regarded as forms of property in their own right,²² which is reflected

18. 240 US 403, 412 (1916).

19. For example in the United States, see S.J. Liddy, 'The Problem of State Trade Mark Registrations' (1949) 39 *Trade Mark Rep.*, 667, 669, and L.H. Johnston, 'Drifting toward Trade Marks Rights in Gross' (1995) 85 *Trade Mark Rep.*, 19, 21–22. This idea of the sign connected with the goodwill is also a reason for the fact that until recently many European countries prohibited the transfer of the trade mark without the transfer of the business. This is now permitted, see Community Trade Mark Regulation, Art. 17(1), UK: TMA 1994, s. 24(1), but see the rebuttable presumption in Germany: *Markengesetz* 1994, § 27(2).

20. For the UK a well known definition can be found in *IRC v. Muller & Co's Margarine* [1901] AC 217, 224 (Lord Macnaghten). See also Bently and Sherman, n. 14 above, 709–710.

21. See also below under IV.D.

22. Bently and Sherman, n. 14 above, 946.

especially well in their dilution protection.²³ They are either expressly²⁴ or obliquely²⁵ referred to as property in the relevant statutes, and even where they are not explicitly named as property, they are effectively regarded as such in academic doctrine and court decisions.²⁶ The human rights implications of trade marks as property rights are discussed below.²⁷

III. WHICH HUMAN RIGHTS REGIME APPLIES AND WHAT IS ITS EFFECT?

The human rights regime, both internationally and regionally, is multilayered. The apex of the international human rights system is the Universal Declaration of Human Rights of 10 December 1948, venerable indeed, but as such not legally binding.²⁸ Besides, there is a number of international and regional instruments, some with a general, some with a quite specific remit. The most important ones for present purposes include the International Covenant on Civil and Political Rights,²⁹ the International Covenant on Economic, Social and Cultural Rights,³⁰ and the regional human rights protection systems, such as the Organization of American States 1948 (OAS, which entered into force in 1978),³¹ the African Union 2002 (originally Organization of African Unity 1963),³² and, particularly important, the Council of Europe, which has the oldest and most developed system with an established judicial mechanism for individual complaints through the European Convention on Human Rights 1950 and the European Court of Human Rights.³³

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23. R. N. Klieger, 'Trade Mark Dilution: The Whittling Away of the Rational Basis for Trade Mark Protection', (1996–1997) 58 U. Pitt. L. Rev. 789, 792, 794, 831, 839.
 24. Community Trade Mark Regulation, Art. 16(1); UK: TMA 1994, s. 22; France: *Code de la Propriété Intellectuelle*, L713-1.
 25. E.g. German Markengesetz, § 14(1): the trade mark grants its holder an exclusive right; heading of section 5 (before § 27): 'trade marks as subject-matter of the assets (*Vermögen*)', and s. 29 which allows that the mark be pledged or subjected to another real right.
 26. The German notion of *Immaterialgüterrecht* (increasingly referred to as '*Geistiges Eigentum*') illustrates this approach well.
 27. Under IV.A.
 28. Universal Declaration of Human Rights, adopted and proclaimed by UN General Assembly resolution 217 A (III) of 10 December 1948. See, on the moral authority of the Universal Declaration, Smith, n. 3 above, 36. On the 'soft-law' status of the Universal Declaration, see A. Boyle, 'Soft Law in International Law-Making', in M. D. Evans (ed.) *International Law*, 2nd ed. (Oxford, OUP, 2006), 142, 146, 151.
 29. International Covenant on Civil and Political Rights, adopted by the UN General Assembly resolution 2200A (XXI) of 16 December 1966 (entry into force: 23 March 1976).
 30. International Covenant on Economic, Social and Cultural Rights, adopted by the UN General Assembly resolution 2200A (XXI) of 16 December 1966 (entry into force: 3 January 1976).
 31. Smith, n. 3 above, 109 et seq.
 32. Smith, n. 3 above, 125 et seq.
 33. Ovey and White, n. 3 above, 3–6, 10–11; Smith, n. 3 above, 88 et seq.

Of actual importance to a commercial lawyer is whether a civil liberty or a social and economic right in a legal instrument is enforceable through an effective mechanism or merely has some 'moral force', in which case – one should be realistic – it can largely be ignored in a commercial context. (The persistent neglect of legally unenforceable moral obligations may, however, affect negatively the goodwill of an undertaking and can therefore have an indirect impact.)³⁴ The first port of call will usually still be the national constitutions and the civil liberties enshrined in these,³⁵ because these provide the quickest enforcement procedure (and often the only one), and the exhaustion of the national judicial system is also the requirement for being able to resort to the European Court of Human Rights,³⁶ if it has jurisdiction in the case in question. Although the United Kingdom does not have a (written) constitution, the introduction of the Human Rights Act in 1998 which gives 'further effect' to the European Convention on Human Rights, allows the direct enforcement of the substantive rights in the Convention before the national courts and puts Britain on an equal footing with the constitutions of continental European countries, as far as civil liberties are concerned.³⁷ In fact, in Britain human rights issues are potentially even more entwined with commercial matters now, because it is the same set of courts which decides over both types of cases, while on the European continent the court system is usually divided between the civil (and – often separate – commercial) and criminal courts on the one hand, and the public law courts (constitutional and administrative courts) on the other,³⁸ and it is typically in the latter, where one can expect the judges to be familiar with, and sympathetic to, direct or indirect human rights complaints. The continental European concept of human rights within a legal system, both in the court hierarchy, and in legal training and academic doctrine, is generally not particularly open to a uniform appreciation of human rights in all areas of the law. Traditionally, human rights are considered as part of the public sphere and public law and provide a system which assists the individual against the State. They are universal, perpetual and inalienable personal rights, while rights in commercial law, especially (intellectual) property rights, are territorial, between individuals, regulate economic/proprietary interests, are transferable and often also of limited duration. Even common law jurisdictions do not promote human rights or constitutional rights as an essential source of commercial law in everyday practice, which the

34. See also below under IV.D.

35. Depending on the country, the constitution may well incorporate an international convention, as is the case with Germany (where the European Convention on Human Rights is part of domestic law), or in Austria (where the European Convention has been made part of its constitution), see Ovey and White, n. 3 above, 19–20.

36. Convention for the Protection of Human Rights and Fundamental Freedoms (as amended by Protocol No. 11), Art. 35(1).

37. Stone, n. 3 above, 8–9, 13, 29 et seq.; Ovey and White, n. 3 above, 20.

38. For the French court system, see e.g. J. Bell, S. Boyron, S. Whittaker, *Principles of French Law* (Oxford, OUP, 1998), 38 et seq. For the German court system, see e.g. K. Heilbronner and H.-P. Hummel, 'Constitutional Law', in W. Ebke and M. Finkin (eds), *Introduction to German Law* (The Hague, Kluwer, 1996), 63.

recent dicta of *Eldred* in the US have documented well.³⁹ The courts are still reluctant to allow human rights legislation to have horizontal effect between individuals,⁴⁰ although recently they have tended to open up more to the idea of a horizontal effect in the situation of trade mark parody and free speech, even on the European continent.⁴¹ However, especially in civil law countries, any general ‘constitutionalization’ of private and commercial law is likely to be fiercely resisted.

A certain parallel to the national judicial systems can be found at European level in the case of trade mark law because this area of intellectual property law has truly become part of European Union law as a result of the Trade Mark Directive and the Regulation. Therefore judgments on trade mark law are ultimately delivered by the ECJ, while human rights complaints (also in the context of trade mark law) would normally be brought before the European Court of Human Rights which is not an organ of the EU. The relationship between the ECJ and the European Court of Human Rights is fairly complex, but there are indications that human rights could become a foundation of the legal order of the EU.⁴² A first sign of this development was the *Internationale Handelsgesellschaft* case,⁴³ in which the ECJ stated that the EC was bound by human rights. In the last twenty years or so, the ECJ adopted a generally deferential attitude towards the European Court of Human Rights, by referring to the European Court of Human Rights frequently, and sometimes also by giving effect, within EU law, to Member States’ human rights laws which typically reflect the European Convention on Human Rights.⁴⁴ The high water mark is arguably Advocate General Jacobs’ opinion in the ECJ case of *Bosphorus*, when he said that ‘for practical purposes the Convention can be regarded as part of Community law and can be invoked as such both in this Court and in national courts’.⁴⁵ The European Court of Human Rights is more reticent when referring to ECJ judgments,⁴⁶ but that does not stop the Court from assuming jurisdiction for the decision whether conventional rights have been breached by the implementation of EU measures (for example an EC-Regulation), even if such

39. *Eldred v. Ashcroft* 537 US 186 (2003), 221. See also above under A.

40. Stone, n. 3 above, 38–39; Ovey and White, n. 3 above, 31–32 (on the European Convention on Human Rights and its possible ‘Drittwirkung’).

41. See Ch. Geiger, ‘Trade Marks and Freedom of Expression – The Proportionality of Criticism’, (2007) 38 IIC 317, 318.

42. S. Douglas-Scott, ‘A Tale of Two Courts: Luxembourg, Strasbourg and the growing European Human Rights Acquis’ (2006) 43 *Common Market Law Review*, 629, 661; T. Ahmed and I. Butler, ‘The European Union and Human Rights: An International Law Perspective’, (2006) 17(4) *European Journal of International Law*, 771, 773–775.

43. Case 11/70, *Internationale Handelsgesellschaft*, [1970] ECR 1125, paras 3 and 4.

44. Since Member States have to observe human rights when implementing EU law, see Douglas-Scott, n. 42 above, 634, 644–645, 650.

45. Opinion of the Advocate General in Case C84/95, *Bosphorus Hava Yollari Turizm ve Ticaret AS v. Minister for Transport, Energy and Communications (Ireland)*, [1996] ECR I-3953.

46. Douglas-Scott, n. 42 above, 641. Where the Court does refer to the ECJ, it tends to be approving of it.

measures have been challenged earlier and upheld by the ECJ in relation to a possible breach of fundamental rights.⁴⁷

The expansion of jurisdictions of the ECJ and the European Court of Human Rights has developed into an overlap of jurisdictions.⁴⁸ This is what a national constitution and a court system usually seek to avoid. The attempt at clear-cut jurisdictional division contributes to the fact that human rights issues currently do not fit well in commercial law. However, at European level, there seems to be some preparation of the judicial systems of the ECJ and the European Court of Human Rights for future human rights complaints which may be provoked by the application of the EC Trade Marks Directive or the Regulation. An even stronger candidate for such a development would obviously be copyright, but at present EU legislation in this area is piecemeal and deals with special issues. (However, application of the Information Society Directive or the Term Directive,⁴⁹ for example, may well trigger human rights complaints.) It is possible that future European jurisprudence may require national commercial courts to open up more to human rights concerns.

In comparison to the European Convention on Human Rights, other human rights instruments beyond the constitutionally safeguarded ones in national jurisdictions are much less relevant. Their main problem is their lack of reliable enforceability. In a commercial law setting, the International Covenant on Economic, Social, and Cultural Rights is of particular interest, but it has been pointed out that this treaty has not actually been taken seriously,⁵⁰ despite the fact that close to 150 states (as at 2004) have signed it. There are several reasons for that. First, the scope of economic, social and cultural rights is much more uncertain than that of 'classical' civil and political rights, because unlike the latter, they are not universal and fundamental and therefore do not share the principal features of a human right.⁵¹ Civil and political rights also tend to be negative, non-interference rights, while economic and social rights require positive action which is difficult to enforce and monitor. However, it has been argued that at the very least, international recognition of the economic, social and cultural rights entitles an individual to a strong moral or political claim against the state, particularly if it

47. *Bosphorus Hava Yollari Turizm Ve Ticaret Anonim Sirketi v. Ireland* [2006] 42 EHRR 1 (no violation of Art. 1 of Protocol 1 to the European Convention on Human Rights).

48. Douglas-Scott, n. 42 above, 630.

49. Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonization of certain aspects of copyright and related rights in the information society, and European Parliament and Council Directive 2006/116/EC of 12 December 2006 on the term of protection of copyright and certain related rights (codified version).

50. B. Simma, 'The implementation of the International Covenant on Economic, Social and Cultural Rights', in F. Matscher (ed.), *Die Durchsetzung wirtschaftlicher und sozialer Grundrechte. Eine rechtsvergleichende Bestandsaufnahme* (Kehl/Straßburg, N. P. Engel Verlag, 1991), 75.

51. R. Machacek, 'Über das Wesen der wirtschaftlichen und sozialen Grundrechte', in F. Matscher (ed.), *Die Durchsetzung wirtschaftlicher und sozialer Grundrechte. Eine rechtsvergleichende Bestandsaufnahme* (Kehl/Straßburg, N. P. Engel Verlag, 1991), 23–26; M. Craven, *The International Covenant on Economic, Social, and Cultural Rights* (Oxford, Clarendon Press, 1995), 13.

is party to the International Covenant on Economic, Social, and Cultural Rights.⁵² Reliance on the International Covenant on Civil and Political Rights is still likely to be more successful, but the rights contained in this treaty will usually be absorbed by the national constitutional civil liberties protection system, provided the State in question has a functioning one: if not, the treaty can also be regarded as immaterial from an individual's point of view.

Secondly, if one follows the argument of an individual's strong moral or political claim against the State under the International Covenant on Economic, Social, and Cultural Rights, then this treaty itself makes it difficult to ascertain the extent and content of the right claimed. In relation to intellectual property, one finds Article 15(1) which states cryptically:

The States Parties to the present Covenant recognize the right of everyone:

- (a) To take part in cultural life;
- (b) To enjoy the benefits of scientific progress and its applications;
- (c) To benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author.

This article alludes mainly to patents and copyright, but it does not grant or define any specific rights or clear right limitations. Under Article 2, the State Parties are required to take steps to achieve progressively the full realization of broad rights such as under Article 15, but Article 15 does not actually tell a State what exactly to achieve. Article 15(2) could be interpreted as a vague right limitation provision which could be relevant to trade mark law: 'The steps to be taken . . . to achieve the full realisation of this right [i.e. Article 15(1)] shall include those necessary for the conservation, the development and the diffusion of science and culture.' These 'steps' could include a restriction of the exercise of intellectual property rights to avoid a hampering of such development and diffusion. However, this rule is really not more than a declaration of intent directed at the States Parties.⁵³

Thirdly, this treaty has no implementation mechanism (the implementation by periodic States' reports does not qualify for practical purposes), which is something international lawyers are traditionally prepared to live with,⁵⁴ but commercial lawyers (and indeed constitutional lawyers) are not: there is much appeal in the somewhat simplistic rule of *ubi remedium ibi ius*. But even if the treaty had an enforcement system, the rights granted would be too vague for commercial law purposes and one would be unable to determine what to enforce.

52. Craven, n. 51 above, though with a more differentiated view at 15 and 16.

53. It is significant that Craven in his comprehensive book on the International Covenant on Economic, Social, and Cultural Rights, n. 51 above, does not discuss Art. 15 at all in any detail.

54. However, the WTO implementation mechanism ('Dispute Settlement Understanding', WTO-Agreement, Art. III s. 3) is a prominent example which departs from this characteristic of many international treaties. On the possibility of a complaints mechanism for the International Covenant on Economic, Social, and Cultural Rights in a future protocol, see Craven, n. 51 above, 98–102.

At European level, the economic and social rights referred to in the Charter of Fundamental Rights of the European Union (proclaimed in 2000) would provide the same situation. The legal status of this Charter within the EU is unclear; but it is certainly not formally binding.⁵⁵ Similar problems would also emerge if an application of other regional human rights instruments were sought, for example, if one uses human rights under the OAS Charter (Article 34 et seq.) to attack claims under Brazil's trade mark law.⁵⁶ The grant of economic, social and cultural rights has undoubtedly great moral appeal, but an instrument that is to be taken seriously needs to have an enforcement mechanism which implements at least aspects of the usually rather vaguely delineated economic and social rights. Such an enforcement mechanism could partially lie in the commercial law itself.⁵⁷

IV. HUMAN RIGHTS RELEVANT TO TRADE MARKS

IV.A PROTECTION OF PROPERTY

This aspect of human rights protection concerns the holder of a trade mark as the holder of a property right.⁵⁸ The extent of this property right is defined by the essential function of the trade mark.⁵⁹ The protection of property can normally be found in national constitutions, but is not a typical feature of international human rights protection.⁶⁰ Neither the International Covenant on Civil and Political Rights, nor the International Covenant on Economic, Social and Cultural Rights, contain property protection provisions. The European Convention on Human Rights protects property not in its main body, but only through the First Protocol which was added later.⁶¹ Article 1 of the First Protocol provides that every natural or legal person⁶² is entitled to the peaceful enjoyment of his possessions, but the rule allows interference with this right subject to a proportionality test that balances individual interests against those of the public. Article 1 only applies to the person's existing possessions and does not guarantee the right to acquire possessions.⁶³ The meaning of 'possessions' is not confined to tangible objects, but

55. T. Hervey and J. Kenner, *Economic and Social Rights under the EU Charter of Fundamental Rights – A Legal Perspective* (Oxford-Portland Oregon, Hart Publishing, 2003), vii.

56. Compare Art. 1 of the OAS Charter: 'The Organization of American States has no powers other than those expressly conferred upon it by this Charter, none of whose provisions authorizes it to intervene in matters that are within the internal jurisdiction of the Member States.'

57. See below under IV. D and E.

58. For the British position under the Human Rights Act 1998, see T. Pinto, 'The Influence of the European Convention on Human Rights on Intellectual Property Rights', (2002) 24 EIPR, 209, 218.

59. See above under II.

60. See, however, Art. 17 of the Universal Declaration of Human Rights.

61. Ovey and White, n. 3 above, 345. The Protocol entered into force in 1954.

62. The protection of legal persons is particularly relevant in a trade mark context because most trade mark holders are companies.

63. *Marckx v. Belgium*, Series A, No. 31 (1979–80) 2 EHRR 330, para. 50.

includes intangible property and rights, such as planning permissions,⁶⁴ company shares,⁶⁵ business goodwill⁶⁶ and patents.⁶⁷ The relevant criteria for establishing 'possession' or 'property' or '*biens*'⁶⁸ are whether the right or interest has economic value and whether there is a legitimate expectation of gaining effective enjoyment of this right.⁶⁹

The newest, and in the present context of trade marks, most relevant decision of the European Court of Human Rights is *Anheuser-Busch Inc v. Portugal*, handed down on 11 January 2007.⁷⁰ The applicant, an American brewing company, produced BUDWEISER beer and applied for registration of this name as a trade mark in Portugal. The Czech company Budějovický Budvar, which produced and marketed beer under the Czech name Budvar or the German name BUDWEISER, opposed successfully the application which was subsequently refused. The applicant then sought the cancellation of the Czech company's registration of the BUDWEISER appellation of origin, and was initially successful, but following appeals from the Czech company, the Lisbon Court of Appeal ordered the intellectual property office to refuse to register BUDWEISER as a trade mark. This decision was upheld by the Portuguese Supreme Court. The American company applied to the European Court of Human Rights and claimed that the Supreme Court's decision to order the refusal of the registration of the trade mark amounted to an infringement of its right under Article 1 of the First Protocol to peaceful enjoyment of its possessions. The European Court of Human Rights held that a trade mark, as well as a trade mark application, and indeed any intellectual property right is 'possession' within the meaning of Article 1.⁷¹ However, Article 1 only protects existing possessions. The problem with a trade mark application is that, unlike a registered trade mark which is clearly 'possession', an application does not confer a definitive legitimate expectation to acquire such a 'possession'. The applicant only obtained a conditional right upon the application which was extinguished retrospectively because the condition had not been fulfilled.⁷² The Court followed earlier case law which decided that patents and patent applications were 'possessions' for the purpose of Article 1,⁷³ and considered

64. *Pine Valley Developments Ltd. v. Ireland*, Series A, No. 222, (1992) 14 EHRR 319.

65. App. 11189/84, *Company S. & T. v. Sweden*, (1987) 50 European Commission of Human Rights, DR 121.

66. *Van Marle v. Netherlands*, Series A, No. 101, (1986) 8 EHRR 483, paras 41–42.

67. App. 12633/87, *Smith Kline and French Laboratories Ltd. v. Netherlands*, (1990) 66 European Commission of Human Rights, DR 70.

68. The French term '*biens*' is used in the French text of the Convention.

69. *Nerva and Others v. United Kingdom*, App. No.42295/98 (gratuities as possessions) (2003) 36 EHRR 4; A. v. Rijn, 'Right to the Peaceful Enjoyment of One's Possessions' (Chapter 17), in P. v. Dijk *et al.* (eds.) *Theory and Practice of the European Convention on Human Rights*, 4th ed. (Antwerpen-Oxford, Intersentia, 2006), 866, 869.

70. (2007) 45 EHRR 36, [2007] ETMR 24 (Grand Chamber).

71. *Ibid.*, paras 47, 49 (Chamber judgment), 72, 78 (Grand Chamber).

72. *Ibid.*, para. 49.

73. *Ibid.*, paras 67–68. The cases are App. 12633/87, *Smith Kline and French Laboratories Ltd. v. Netherlands*, (1990) 66 European Commission of Human Rights, DR 70, and *Lenzing AG v. United Kingdom*, Case 38817/97, unreported, 9 September 1998.

whether the trade mark applicant obtained title to a substantive interest that is protected by Article 1. The Court concluded that upon an application for the registration of a trade mark a bundle of financial rights and interests arise which may bring about assignment and licensing transactions that are capable of possessing a substantial financial value. The trade mark application therefore gave rise to interests of a proprietary nature and fell within Article 1. Although the rights connected with the application were conditional upon successful registration, the applicant was still entitled to expect that the application would be examined under the relevant Portuguese legislation. Hence the applicant already had a set of (revocable) proprietary rights within the meaning of Article 1.⁷⁴ The Court nevertheless rejected the claim that the refusal to register amounted to an interference with the applicant's peaceful enjoyment of its possessions. In the absence of any arbitrariness or manifest unreasonableness, the Court could not review the findings of the Portuguese Supreme Court. Since the applicant had the opportunity in the proceedings before the Portuguese courts to make all relevant representations, there was no element of arbitrariness or manifest unreasonableness which could have affected the Supreme Court's decision. Thus the Supreme Court's judgment did not constitute interference.⁷⁵

Anheuser-Busch follows the existing line of reasoning of the European Court of Human Rights in earlier cases in relation to Article 1 of the First Protocol and contains no surprises. However, it is a judgment which for the first time clearly states the position of trade marks and intellectual property rights in general (including applications for registration) within the property protection system of the European Convention on Human Rights.

IV.B FREEDOM OF EXPRESSION

The right of freedom of expression is the human right which is most likely to conflict with the use of a trade mark. Apart from national constitutions, this right can be found, for example, in Article 19 of the International Covenant on Civil and Political Rights. At European level, Article 10 of the European Convention on Human Rights provides the right to freedom of expression, subject to a proviso which allows the restriction of this right under the conditions in Article 10(2).

Relevant in this context are two case scenarios, first, when a trade mark is used *by* the trade mark holder which may conflict with public policy or public order, and secondly, when a trade mark is used *against* the trade mark holder by someone else, or at least without the trade mark holder's consent, usually or primarily outside the course of trade, for the purpose of artistic expression, parody or critique of commercial practices of an undertaking associated with the trade mark in question.

74. *Anheuser-Busch Inc v. Portugal* (2007) 45 EHRR 36, [2007] ETMR 24 (Grand Chamber), paras 75–78. In their dissenting opinion the judges Caflisch and Cabral Barreto JJ. point out that their would prefer to hold that the filing of an application for registration of a trade mark creates a 'legitimate expectation' in the sense of the case law to Art. 1, see Joint Dissenting Opinion, para. 3.

75. *Ibid.*, 85–87.

IV.B.1 Use of the Trade Mark by the Proprietor

The first situation comprises cases in which a trade mark applicant seeks to register a mark (sometimes successfully) which is potentially contrary to public policy or accepted principles of morality. International and national trade mark laws treat such reasons as absolute grounds for refusal of registration.⁷⁶ A refusal of registration may conflict with the right to free speech, because also commercial speech, for instance in the form of advertising, is ‘expression’ and as such enjoys protection,⁷⁷ but subject to the restrictions which apply to the right of freedom of expression in general.⁷⁸ According to the European Court of Human Rights, where advertising performs more than a purely commercial function and also serves a wider public interest, the national authorities have a narrower margin of appreciation.⁷⁹ However, in the context of trade mark law, this problem area seems to have little practical relevance and is rather confined to some bizarre fringe cases. In Italy, for example, litigation arose because wines were marketed with a Hitler label and Nazi slogans.⁸⁰ In the UK, the application for registration of FCUK as a (potentially offensive) trade mark was accepted.⁸¹ In cases which involve the refusal of a trade mark registration on grounds of public policy and morality, the UK authorities (courts and trade mark registrar) usually pay due regard to freedom of expression when deciding on the application.⁸²

IV.B.2 Use of the Trade Mark against the Proprietor: Rarody and Criticism

IV.B.2.a Europe

The second scenario is that of trade mark use by non-owners for parody, artistic purposes or for criticism. Only in this situation a significant number of court cases

76. Paris Convention 1883 (as revised Stockholm 1967 and as amended 1979), Art. 6 B. 3; TRIPS Agreement, Art. 15(2) (referring to the Paris Convention); EC-Trade Mark Directive, Art. 3(1) (f) and (2); UK: TMA 1994, s. 3(3)(a); Germany: Markengesetz 1994, § 8(2)(5); US: 15 USC § 1052(a); France: *Code de la Propriété Intellectuelle*, L711-3.

77. *Casado Coca v. Spain* (1994) 18 EHRR 1 at paras 33–37; Stone, n. 3 above, 282–283. See also the UK case of *R (British American Tobacco) v. Secretary of State for Health* [2004] EWHC 2493.

78. European Convention of Human Rights, Art. 10(2).

79. *Ovey and White*, n. 3 above, 333–334. *Vgt Verein gegen Tierfabriken v. Switzerland* (App. 24699/94), (2002) 34 EHRR 159.

80. See, with appropriate strong criticism, J. Phillips and I. Simon, ‘No Marks for Hitler: A Radical Reappraisal of Trade Mark Use and Political Sensitivity’, (2004) 26 *EIPR*, 327–330.

81. *French Connection Ltd’s Trade Mark Application* [2007] ETMR 8 (Lord Chancellor’s Appointed Person); in this case the issue of freedom of expression was referred to in paras 46–48. This trade mark was also subject to a ‘cyber squatting’ case earlier in *French Connection Ltd v. Sutton (t/a Teleconexus Email)* [2000] ETMR 341 (Ch D) in which the judge accepted the validity of the mark (though with strong misgivings).

82. See e.g. in *Basic Trademark SA’s Application* (Lord Chancellor’s Appointed Person) [2006] ETMR 24 (JESUS Trade Mark Application), paras 4 and 22.

arose in several jurisdictions. In Germany, a few cases of satirizing or criticizing advertisements came before the German Supreme Court. In *Marlboro/Mordoro*,⁸³ the defendant used the 'Marlboro' trade mark in a grotesquely altered form and context in a calendar which promoted non-smoking. The court held that in principle a trade mark infringement could be justified on the basis of freedom of expression: economic interests must yield to the basic human right of freedom of expression, but criticism also has to be materially justified when weighed against the trade mark owner's economic interests. In *BMW*,⁸⁴ a trader of joke articles used the trade mark of the famous car manufacturer in stickers which invited to sexual intercourse using words with the same initial letters of BMW. The court held that the trade mark was not infringed because the use in question was not trade mark use, and the defendant did not actually try on an anticompetitive free-ride on the claimant's reputation (or debased it), but presented a vulgar joke which the public recognized as such. It was therefore probably not necessary for the court to refer directly to freedom of expression. In a recent case, *Lila-Postkarte*,⁸⁵ the issue of the potentially competitive nature of the use of the trade mark was interpreted more narrowly (because it was a well-known mark), but in turn, human rights were specifically addressed. The claimant produced and marketed chocolate under the trade mark MILKA with a characteristic lilac background and used images of cows in lilac in its advertisements. The defendant, a publisher of postcards, produced postcards in the same lilac colour with a text which referred satirically to two famous poets and a cow, and in this way alluded to the claimant's well-known mark. The Supreme Court held that the use of the colour lilac is trade mark use, and the marketing of the postcard does make use of the reputation of the claimant's trade mark, since a parody relies on the fact that the public are able to associate it with the well-known mark. However, there is still no infringement because the defendant could invoke the constitutional right of freedom of the arts (a specific version of freedom of expression).⁸⁶ The postcard is a satirical artistic engagement with the claimant's trade mark. Where trade marks are not used in a derogatory way or in an exclusively commercial context, the right of the freedom of the arts prevails.

Several cases also arose in France. The Paris Court of Appeal decided whether the use of the ESSO trade mark by the French branch of Greenpeace on its website in the form of 'STOP ESSO', or 'STOP E\$\$O, E££O' amounted to trade mark infringement. The claimant submitted that these acts were parasitic and denigratory, and that the defendant sought to discredit the claimant's products and services in the eyes of the public. The court held that there was no trade mark infringement because the defendant kept its activities within the constitutional rights of freedom of expression. This right includes the right to be able to denounce attacks on the environment and the risks to human health caused by certain industrial activities.

83. BGHZ 91, 117, 121; *Neue Juristische Wochenschrift* 1984, 1956; [1986] ECC 1, at 4–5, 7.

84. BGH *Neue Juristische Wochenschrift* 1986, 2951 (judgment of 3 June 1986).

85. BGH I ZR 159/02 – *Lila Postkarte* (judgment of 3 February 2005).

86. Art. 5(3) of the Basic Law or *Grundgesetz*.

The defendant's use of the trade marks did not promote the marketing of products or services in competition with the claimant.⁸⁷ In a recent case, the defendants targeted the cigarette trade mark CAMEL in an anti-smoking campaign. The defendants, the *Comité National contre les Maladies Respiratoires et la Tuberculose*, had designed posters depicting the famous trade marked dromedary, with a cigarette between its lips that produced smoke in the shape of a skull and was accompanied by the slogan: 'The fog is worse than crossing the desert...'. The French Supreme Court, reversing the ruling by the Paris Court of Appeal, dismissed the trade mark infringement claim on the grounds that the humorous use of the mark was on the occasion of a preventive campaign aimed at adolescents and warned against tobacco consumption which is detrimental to health. This did not constitute an abuse of the right to the liberty of expression by the defendant, because means appropriate to the aim of public health had been used.⁸⁸

However, the Court of Appeal of Amsterdam ruled that where an act is dressed up as a parody, but in fact creates competition and takes unfair advantage of the reputation of the trade mark, the freedom of expression defence does not apply, and the act amounts to an infringement.⁸⁹ Similarly, in an English case it was held that where a trade mark is used more as a shorthand expression rather than a means of parody, the right of freedom of expression does not intervene in the absence of telling a political story or making a political point or identifying some matter of public importance. The mere use itself of someone else's mark without these attributes does not engage the freedom of expression right and is infringement.⁹⁰ But passing off or trade mark infringement is not likely to occur with a genuine parody, because the parodist does not seek to associate himself with the trade mark owner,⁹¹ or as it was put in another English case: 'If the defendant employs a successful parody, the customer would not be confused, but amused.'⁹²

It appears that generally the courts are willing to dismiss trade mark infringement actions on the basis of freedom of expression where the mark was not used to take commercial advantage of a competitor's reputation associated with the mark, but as a means of expression, critique or parody.⁹³ At first glance, this appears to be

87. *Esso Plc. v. Greenpeace France*, *Cour d'Appel de Paris* (Case 04/12417, Fourth Chamber, Section A) [2006] ETMR 53.

88. *Comité national contre les maladies respiratoires et la tuberculose v. Société JT International GmbH et al.*, *French Cour de Cassation* (Second Civil Div.) 19 October 2006 – Case No. 1601, (2007) 38 IIC 357–358.

89. *Uitgeverij Byblos BV v. Joanne Kathleen Rowling, Uitgeverij De Harmonie BV and Time Warner Entertainment Company, LP*, [2004] ECDR 7 at 61, at paras 36–37 (HARRY POTTER/TANJA GROTTER; also a copyright parody case where the parody defence also failed).

90. *Miss World Ltd. v. Channel Four Television Corp.* [2007] EWHC 982 (Pat), [2007] ETMR 66, at paras 41, 47.

91. M. Spence, 'Intellectual Property and the Problem of Parody' (1998) 114 LQR 594, 598–599.

92. *Alan Clark v. Associated Newspapers Ltd.* [1998] RPC 261, at 272. The High Court quoted here the US Court of Appeals for the 7th Circuit in *Nike Inc. v. 'Just Did It' Enterprises* (1993) 6F.3d 1225 at 1227–8.

93. See Geiger, n. 41 above, 320 et seq. with discussion of further cases from France, Germany and South Africa (South Africa: *Laugh it Off Promotions CC v. South African Breweries Int.*

a good sign, but one should not ignore the underlying serious and worrying defects of the current state of commercial law. Ideally, commercial law should give effect to human rights in its specialist area, not being kept in check by them as a last resort. The problems arise primarily from an increasingly perverted notion of an ever-extending scope of protection of the property rights which the trade mark confers. Rather than establishing a clear boundary between trade mark use *in the course of trade*,⁹⁴ which is within the protected property right, and any other (non-commercial) use of the mark (for criticism, parody and so forth), which attracts no protection under trade mark law,⁹⁵ the property right is presumed to be an all-encompassing diffuse right. The defendant now has the burden of proof to show that he, most unusually, might benefit from an exception by invoking fundamental laws. This is a sad retrogressive social step. The ECJ in *Arsenal*⁹⁶ has not done anything to stop this perilous development; furthermore, the improved protection of trade marks against dilution reinforces this trend.

IV.B.2.b United States

In the United States, the picture is quite similar. Trade mark parody is considered in the light of the parodist's right of free speech under the First Amendment of the US-Constitution, and a distinction is drawn between confusion and dilution cases.⁹⁷ Dilution is a violation of a famous trade mark which is not the result of potentially confusing use, but of use diminishing the distinguishing quality of the mark, either through 'blurring' (weakening of the ability to distinguish the source) or through 'tarnishment' (degrading of positive associations evoked by the mark).⁹⁸ A parody of a trade mark which leads to likelihood of confusion is usually not permitted. In *Anheuser-Busch v. Balducci Publications*,⁹⁹ the defendant placed a fictitious advertisement, which used several of Anheuser-Busch's trade marks, to protest against toxic dumping. The court decided against upholding the defendant's right to free speech, because the parody was likely to confuse consumers and the

(France) *B. V. t/a Sabmark Int.*, CCT 42/04, See also D. Greenberg, 'To Dilute your Trade Mark just add Parody' (2005) 27 *EIPR* 436). The scenarios of the cases are similar.

94. Compare EC Trade Marks Directive, Art. 5(1).

95. The sign itself could be subject to copyright protection: in that situation, the permitted acts (parody, criticism and review etc.) under the copyright laws would theoretically apply. However, the French courts, for example, keep the intellectual property rights separate and do not allow copyright-based defences in trade mark infringement claims, see Geiger, n. 41 above, 325 n. 36.

96. *Arsenal Football Club Plc v. Reed* (Case C206/01), 2002 WL 31712, [2002] ECR 10,273, [2003] ETMR 19, and above under II.

97. M. Dagitz, 'Trade Mark Parodies and Free Speech: An Expansion of Parodists' First Amendment Rights in *L.L. Bean, Inc. v. Drake Publishers, Inc.*', (1987–1988) 73 *Iowa L. Rev.*, 961.

98. On a federal level, see 15 USC § 1125(c). Overview in H. Shire, 'Varying Standards for Assessing whether there is Dilution under the Federal Trade Mark Dilution Act', (2001) 91 *Trade Mark Rep.*, 1124; K. Baxter, 'Trade Mark Parody: How to Balance the Lanham Act with the First Amendment' (2003–2004) 44 *Santa Clara L. Rev.*, 1179, 1184.

99. 28 F.3d 769 (8th Cir. 1994).

defendant could have found less confusing means to convey its message.¹⁰⁰ Where the parody leads to only a slight risk of consumer confusion, it tends to be allowed.¹⁰¹

Use of a trade mark in a parody that is not likely to cause confusion but may cause dilution was at issue in the case of *L.L. Bean, Inc. v. Drake Publishers, Inc.*¹⁰² The defendant published in its magazine for adult erotic entertainment a parody of the claimant's popular catalogue alluding to the claimant's get-up and trade marks. The court allowed this unauthorized use of the trade mark, because, although the use was in a tarnishing, negative or offensive context, it was also non-commercial use and editorial artistic parody. A trade mark cannot be diluted by unauthorized use unless that use is commercial. Otherwise, the claimants would have unlimited control over protected forms of free speech.¹⁰³ However, in *Deere & Co. v. MTD Products, Inc.*,¹⁰⁴ the use of the claimant's trade mark, a deer, was used by the competitors in an advertisement cartoon in a parodying fashion. The court found a likelihood of dilution and stressed the difficulty in distinguishing between non-commercial and commercial use. It also highlighted the commercial impact parodies may have on a mark, because some alterations of the mark have the potential to lessen the selling power of a distinctive mark. In the present case the court ruled that the injunction should stand.¹⁰⁵ In another case, the court rejected the claimant's dilution argument because the defendant's product was not in direct competition with the claimant's product.¹⁰⁶ A similar reasoning seems to have been the basis of *Mattel, Inc. v. MCA Records Inc.*,¹⁰⁷ a case which was already decided under the then new Federal Trade Mark Dilution Act 1995. The Danish pop group Aqua released a song that parodied Barbie and its blond 'bimbo girl' plastic image. Mattel's contention that the defendant infringed and diluted the Barbie trade mark was rejected by the court. The song was a parody which fell under the right to free speech under the First Amendment and was non-commercial use; furthermore, the claimant failed to show tarnishment or dilution: trade mark owners shall not seek to censor parodies.

The US cases show inconsistency in the application of trade mark laws to parodies. The divide between likelihood of confusion on the one hand and commercial and non-commercial use on the other is a matter of interpretation with an unpredictable outcome. Parodies can also involve a mixture of commercial and non-commercial use.¹⁰⁸ It is noteworthy that even the US courts wrestle with

100. See in relation to this and more cases, Baxter, n. 98 above, 1190–1192.

101. *Cliffs Notes, Inc. v. Bantam Doubleday Dell Publishing Group, Inc.* 886 F.2d 490 (2nd Cir. 1989).

102. 811 F.2d 26 (1st Cir. 1987).

103. Discussion of *L.L. Bean* in M. Dagitz, n. 97 above, 961–973.

104. 41 F.3d 39 (2nd Cir. 1994).

105. Discussion of this and other relevant cases in K. Levy, 'Trade Mark Parody: A Conflict between Constitutional and Intellectual Property Interests', (2000–2001) 69 *Geo. Wash. L. Rev.*, 425, 440–447.

106. *Hormel Foods Corp. v. Jim Henson Productions, Inc.*, 73 F.3d 497 (2nd Cir. 1996).

107. 28 F. Supp. 2d 1120 (C.D. Cal. 1998).

108. Baxter, n. 98 above, 1208–1209.

the constitutional (and human rights) aspects in trade mark disputes, despite the deeply entrenched constitutional tradition in the US. It has therefore been suggested that the federal trade mark laws should be amended to give a specific defence for parody and satire to safeguard adequate protection of the right to free speech.¹⁰⁹

IV.C PROTECTION OF PRIVACY AND REPUTATION

Although of significant importance in copyright law, these rights have little relevance as self-standing human rights in a trade mark context. The issues that could arise here are usually completely absorbed by the remedies and defences in the trade mark laws themselves (for example the defences of using one's own name or address, or of using the mark purely descriptively),¹¹⁰ so that the rights of privacy and of reputation are unlikely to be raised separately as human rights in a trade mark infringement action. Business reputation is in any case central to a trade mark or passing off claim. The conventional right to privacy¹¹¹ may become relevant, however, where someone's name or likeness has been registered as a trade mark without that person's permission.¹¹²

IV.D RIGHT TO FAIR WORKING CONDITIONS

The manufacturing industries have diminished rapidly in the Western world, and today the production of consumer goods for multinational corporations and bearing famous Western trade marks increasingly, if not predominately, takes place in low-wage economies of South Asia and East Asia, often under working conditions which even social commentators of the 1830s may have found hair-raising.¹¹³ That problem also undermines the current anti-counterfeiting rhetoric which claims that genuine trade marked goods are of reliably good quality, while trade mark-pirated goods are not, and the trade mark acts as a consumer protection measure. But if the lawfully trade marked products and the pirated products are made by the same South-East Asian 'sweatshop' (that is partly under a license, and partly without one), then the trade mark is by no means capable of denoting only 'good quality' products, and the current scope and severity of criminal sanctions for trade mark piracy becomes doubtful.¹¹⁴

109. Levy, n. 105 above, 447; Baxter, n. 98 above, 1209.

110. See EC Trade Mark Directive, Art. 6. In the UK see TMA 1994, s. 11.

111. Art. 8 of the European Convention on Human Rights.

112. See T. Pinto, n. 58 above, 218.

113. On the ethical implications of these commercial practices, see e.g. D. Arnold and L. Hartman, 'Worker Rights and Low Wage Industrialization: How to Avoid Sweatshops', (2006) 28 *Human Rights Quarterly*, 676, 681, 686.

114. A. Rahmatian, 'Trade Mark Infringement as a Criminal Offence', (2004) 67 *MLR* 670, 680–681.

The question arises whether the goodwill of an undertaking which has its products manufactured under unacceptable labour practices is affected in some way, in that these practices are part of the goodwill which the undertaking's trade mark denotes.¹¹⁵ The definition of goodwill is difficult; some tentative definitions by the courts, which never claimed comprehensiveness, included: the probability that customers will revert to the old place, a privilege of reasonable expectancy of preference among competitors, a continuity of a place and name.¹¹⁶ Thus there must be some causative positive impact on the behaviour of customers to bring in custom.¹¹⁷ But in relation to trade marks, there is a strong argument that goodwill should be seen as a neutral term, being potentially positive or negative goodwill.¹¹⁸ Goodwill and the essential function of trade marks are strongly intertwined,¹¹⁹ and it is obvious that a trade mark for a qualitatively inferior product can claim the same legal protection as a trade mark for high quality products. Therefore, it is not always *good* will which the trade mark denotes, and negative aspects (a subjective judgement in many cases) can also form part of goodwill. Hence the conditions under which trade marked goods are produced arguably form one part of the goodwill which the trade mark symbolizes; if these are satisfactory, for example in a kind of fair trade arrangement or a code respecting ethical obligations towards workers,¹²⁰ then undertakings would certainly not hesitate to claim this aspect as part of their goodwill, but if the conditions are unacceptable, then there is no reason why these should not be associated with the goodwill.

It is the aspect of the working conditions surrounding the production of trade marked goods and the making of a goodwill associated with them where human rights could seek to intervene. The International Covenant on Economic, Social, and Cultural Rights, for example, contains the obligation to safeguard just and favourable conditions of work in Article 7, with some States Parties' responsibility to improve conditions of work in a progressive manner,¹²¹ but the problem with this provision is that it is particularly broad and requires in most cases horizontal effectiveness for having any impact, because usually employers are private entities.¹²² A certain improvement of the present enforcement situation could lie in the recognition of this principal human right *within* trade mark law, especially by disallowing the enforcement of the trade mark right (effectively on the basis of a public policy ground) if the circumstances of the production of the trade marked

115. The following argument also applies to service marks.

116. See overview of US judgments in J. Hoffman, 'One Step Forward and Two Steps Backward – Goodwill as distributable Asset of a Law Partnership' (1986–1987) 20(1) *Akron Law Review*, 157, 159–160.

117. For the UK see *IRC v. Muller & Co's Margarine* [1901] AC 217, 224 (Lord Macnaghten) Bantly and Sherman, n. 14 above, 710.

118. Compare Torremans, n. 12 above, 438.

119. See above under II.

120. For example practiced by companies like Motorola or Levi Strauss, see D. Arnold and L. Hartman, n. 113 above, 684.

121. Craven, n. 51 above, 227.

122. Craven, n. 51 above, 246, on the issue of horizontal effectiveness or *Drittwirkung* of human rights, *ibid.*, 111.

goods clearly violate human rights to fair working conditions. These negative aspects of the goodwill which the trade mark denotes may justify that trade mark protection should be denied, because negative goodwill arguably deserves no protection. In this way human rights would act through commercial law and not against it in an interventionist manner. This would be particularly important when child labour is involved which international conventions prohibit unequivocally and strictly.¹²³ Several problems remain in such a solution: it needs to be defined when the right to fair working conditions is violated and what the exact sanction should be in individual cases; and the territoriality principle of trade mark law needs to be overcome, because human rights enforcement is only effective if, say, a US trade mark holder is denied trade mark protection by an English court in respect of its trade marked goods manufactured in China. The insertion of an appropriate provision in the TRIPS Agreement in this respect would probably be desirable, but seems to be unrealistic at present.

IV.E RIGHT TO SELF-DETERMINATION/MINORITY CULTURE PROTECTION

In the context of intellectual property, attempts have been made to give effect to the right to self-determination and to protect minority cultures by introducing a protection regime for traditional cultural expressions of indigenous peoples.¹²⁴ Such protection provisions, which broadly cover the area of copyright (from a Western perspective), can be found in numerous national laws, and at international level,¹²⁵ but can be highly problematic, because they may reinforce a segregationist policy with neo-colonial features, disguised as a protection of indigenous/minority cultures.¹²⁶ Usually traditional cultural protection measures can be found as 'folklore' provisions in copyright laws, but also trade mark law has been used to achieve these ends. The New Zealand Trade Marks Act 2002 protects indigenous signs of the Maori community. In section 17(1)(ii), the absolute grounds for not registering a trade mark include the prohibition to register signs if their 'use or registration would be likely to offend a significant section of the community, including Maori'.¹²⁷ Another protection method could be a register in which signs

123. E.g. United Nations Convention on the Rights of the Child 1989, especially Art. 32, but also Arts 18–19, 24, 26–28.

124. See e.g. J. Gibson, *Community Resources. Intellectual Property, International Trade and Protection of Traditional Knowledge* (Aldershot, Ashgate, 2005), 19, 22, 25, for definitions.

125. UNESCO Convention on the Protection and Promotion of the Diversity of Cultural Expressions (20 October 2005).

126. A. Rahmatian, 'Universalist Norms for a Globalised Diversity: On the Protection of Traditional Cultural Expressions' in F. Macmillan (ed.) *New Directions in Copyright Law*, vol. 6 (Cheltenham, Edward Elgar Publishing, 2007), 199, 223–228.

127. See discussion of this measure e.g. by D. Zografos, 'Tradition v. Trade Marks: The New Zealand Trade Marks Act 2002', in F. Willem Grosheide and Jan J. Brinkhof (eds), *Intellectual Property Law 2004, Articles on Crossing Borders between Traditional and Actual* (Antwerpen, Intersentia, 2005), 279 et seq.

(for example traditional signs of indigenous communities) could be entered which would bar the registration of such signs as trade marks. Such ‘negative trade mark registers’ (*Freizeichenrollen*) existed in several German states in the first half of the nineteenth century.¹²⁸ In this way, a human rights enforcement mechanism could partially be provided by the commercial law itself.

IV.F OTHER RELEVANT RIGHTS

A number of other human rights can be relevant in the context of trade marks, but usually these human rights aspects are not specific to trade mark rights. For example, the question of whether the right to a fair hearing in a trade mark dispute was violated had to be decided by the European Court of Human Rights in a recent case against Russia.¹²⁹ The right to a fair hearing can also be important, for instance, in respect of the reversal of the burden of proof in the criminal infringement provision of section 92(5) in the British Trade Marks Act 1994 and its compatibility with the proviso regarding the presumption of innocence in Article 6(2) of the European Convention on Human Rights.¹³⁰ The free use of trade marked material for the purpose of education, and the reference to trade marks and trade names in dictionaries or encyclopaedias¹³¹ can also be the subject of human rights protection. However, these matters tend to be of very limited significance, at least at the moment.

V. CONCLUSION

Human rights and trade mark law sit uneasily together. This is in part the result of an educational tradition and the division of legal research into the spheres of private and commercial law on the one hand, and public law, international law and human rights law on the other. This division is also reinforced by the historically grown court systems in many countries. However, human rights concerns become increasingly relevant in trade mark law, an area of intellectual property law which is seemingly of little importance to human rights in comparison to copyright. This development is the result of an expansion – arguably an unwarranted expansion – of the powers of the property right which the trade mark confers. More and more areas of human activity have become affected by trade mark rights, and human rights have been invoked to keep these economic interests in check. The

128. See E. Wadle, *Geistiges Eigentum. Bausteine zur Rechtsgeschichte* (Weinheim, VCH Verlagsgesellschaft, 1996), s. IV.

129. *OA O Plodovaya Kompaniya v. Russia* [2007] ETMR 55.

130. *R. v. Johnstone* [2003] UKHL 28, [2003] FSR 748, paras 50, 53–54.

131. The German *Markengesetz* contains a provision (§ 16) according to which a trade mark owner can require the publisher of a dictionary or lexicon to include an indication that a sign/word is a registered trade mark if the citation of the mark gives the impression that the mark is a generic term for the goods or services for which it is registered.

courts in Europe and the United States have been willing to consider especially freedom of expression in trade mark infringement actions where a trade mark has been parodied or used for the purpose of criticism, but the courts have still been reticent about human rights in general in a commercial setting. However, the recognition of human rights protection of trade marks as property rights never seemed to have been a controversial issue, and this stance has recently been confirmed at the highest level by the European Court of Human Rights for European Convention countries.

While in Europe the enforcement of human rights is effective, the situation in relation to human rights at international level is not encouraging. Because of the absence of an effective enforcement mechanism in all relevant international human rights conventions, the human rights enshrined in these tend to remain without any real consequences in most commercial or trade mark cases. For a commercial lawyer, this often means that international human rights can be dismissed as worthless talk, and this is unfortunately often correct. Furthermore, the method of enforcement is also problematic. An interventionist human rights regime would need a separate enforcement system including a kind of constitutional court – an unrealistic scenario at international level in any case. A more effective approach would be that commercial law should incorporate essential human rights and give effect to them within its own system, whereby it should be the human right, not the framework of commercial law, which defines the limits of an individual's claim. This would also address the problem of horizontal effectiveness of human rights. Only then international human rights could make an impact in international trade mark law. Otherwise they would remain what they are often today: the pastime of students filling their gap year with ethically acceptable work before moving on safely to a well-paid business job, of bored pop stars 'giving something back to the community' other than their wealth, and of retired politicians making after-dinner speeches.

Chapter 14

Some Cultural Narrative Themes and Variations in the Common Law

*Catherine W. Ng**

I. INTRODUCTION

Cultural expressions and an identity with them bind a community and define it against others.¹ In North America, for example, appellations such as Cherokees for an indigenous nation, designs such as the Snuneymuxw First Nation's rock carvings or petroglyphs, and names such as Pocahontas evoke and supply narratives of history, meanings, and values shared among individuals to nourish a sense of both individual identity and community belonging, and to distinguish one community of such individuals from other communities. The authenticity and meaning of cultural expressions often lie in the integrity of their form and context.² Cultural

* D. Phil., Lecturer, University of Aberdeen, with special thanks to the LD for his dedicated research assistance, to B. Toebes and S. Wong for their assistance, and to Quicklaw for its generous support throughout. In honour of Prof. D. Vaver on his retirement, and with gratitude for his significant contribution to legal scholarship and education from which I have benefited so enormously.

1. Y.M. Donders, *Towards a Right to Cultural Identity?* (Antwerp, Intersentia, 2002), 34 et seq.
2. E.g. R. Overstall, 'The Law is Opened' in *Protection of First Nations' Cultural Heritage; Policy, Laws and Reform* (provisional title), C. Bell and R. Paterson (eds) (Vancouver, UBC Press, 2008, forthcoming).

expressions may however be reproduced and revised with the same ease as other intellectual properties of their genre.

II. THE ISSUE

This work examines the extent to which Canada's common law may protect certain cultural expressions for their source cultures. The broad term 'cultural expression' is used here to refer to the appellations, designs, and names such as those mentioned above. Much has been written about the inadequacies of using internationally recognized intellectual property regimes to protect indigenous interests.³ These regimes are founded on a different theoretical footing from those of indigenous intellectual properties. As a result, structural limitations such as the authorship and novelty requirements for copyright and patents, and the requirement for use in trade for particular goods or services for trade marks render these regimes largely unsuitable for addressing many indigenous intellectual property concerns. Where indigenous cultural expressions are goods and services in trade, however, cultural expressions used as trade marks affirm the goodwill of the source culture in that trade. One example is the certification mark COWICHAN, registered in Canada by the Cowichan Band Council for its certified sweaters and knitwear made in accordance with traditional tribal methods by members of the Coast Salish Nation using material prepared in accordance with traditional tribal methods.⁴

Earlier work⁵ has proposed that the unifying and consistent aim between the common law right against passing off and that against appropriation of personality lies in apportioning rights to control social identities, such as brand identities or public personae, through certain uses of identity signs. The present work will reverse the view to illustrate that common law identity rights may be

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3. E.g. E.I. A. Daes, *Protection of the Heritage of Indigenous Peoples* (New York, United Nations Publication, 1997); D. Burkitt, 'Copyrighting Culture – the history and cultural specificity of the Western model of copyright', [2001] 2 *Intellectual Property Quarterly*, 146; World Intellectual Property Organisation, *Consolidated Analysis of the Legal Protection of Traditional Cultural Expressions / Expressions of Folklore* (Background Paper No 1, 2003); E. Gray, 'Maori Culture and Trade Mark Law in New Zealand' in *New Frontiers of Intellectual Property Law: intellectual property and cultural heritage, geographical indicators, enforcement, overprotection*, C. Heath and A. Kamperman Sanders (eds) (Oxford, Hart Publishing, 2005), 71; A. Kur and R. Knaak 'Protection of Traditional Names and Designations' in *Indigenous Heritage and Intellectual Property: genetic resources, traditional knowledge and folklore*, S. von Lewinski (ed.) (The Hague, Kluwer Law International, 2004), 221; J. Gibson, 'Freedoms and Knowledge, Access and Silence: traditional knowledge and freedom of speech' in *New Direction in Copyright Law*, F. Macmillan (ed.) (Cheltenham, Edward Elgar, 2006), vol. 2, 198; S. Frankel, 'Trademarks and Traditional Knowledge and Cultural Intellectual Property', ch. 16 in *Trademark Law and Theory: a handbook of contemporary research*, G.B. Dinwoodie and M.D. Janis (eds) (Cheltenham, Edward Elgar, 2008, forthcoming).
 4. Registration No: TMA465836 <<http://cipo.ic.gc.ca>>, 2 November 2007.
 5. C.W. Ng, 'A Common Law of Identity Signs' (2007) 20 *Intellectual Property Journal*, 177.

sympathetically employed to protect cultural expressions for their source cultures. Indigenous as well as non-indigenous peoples desire rights to control their social identities through their cultural expressions. For indigenous peoples, '[t]he right to cultural autonomy and integrity should include the right to respect for one's own name',⁶ as well as other distinctive expressions including designs. Similarly, the Paris Convention⁷ protects state emblems from third party registration and use because

such registration or use would violate the right of the State to control the use of symbols of its sovereignty and furthermore might mislead the public with respect to the origin of goods to which such marks would be applied.⁸

While this work will focus on certain North American indigenous cultural expressions, it should equally be applicable to the cultural expressions of other source cultures in Canada. Canada does not specifically provide legislative protection for indigenous cultural expressions. It has implemented the pertinent provisions of the Paris Convention⁹ and accepted the 2005 United Nations Educational, Scientific and Cultural Organization (UNESCO) Convention on the Protection and Promotion of the Diversity of Cultural Expressions which entered into force on 18 March 2007.¹⁰ In 1996, the Comox Band of Indians applied to join a defendant in a passing-off action¹¹ on the basis that 'the term QUENEESH is associated with the Band and has been since time immemorial and the Band has a common-law aboriginal right to the exclusive use of the word'. The court responded: 'If there is any such proprietary and enforceable interest, it cannot, I think, arise out of the English common law.'¹²

6. E.I. A. Daes, *Protection of the Heritage of Indigenous Peoples* (New York, United Nations Publication, 1997), para. 89.

7. The Paris Convention for the Protection of Industrial Property of 1883, as revised at Brussels 1900, Washington 1911, The Hague 1925, London 1934, Lisbon 1958 and Stockholm 1967, and as amended in 1979.

8. G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as revised at Stockholm 1967* (United International Bureaux for the Protection of Intellectual Property (BIRPI), 2004), 96.

9. See s. VI below.

10. Article 1: 'The objectives of this Convention are:

(a) to protect and promote the diversity of cultural expressions;

(...)

(e) to promote respect for the diversity of cultural expressions and raise awareness of its value at the local, national and international levels;

(...)

(g) to give recognition to the distinctive nature of cultural activities, goods and services as vehicles of identity, values and meaning;'

Although the present discussion relates to these objectives, consideration of the Convention is beyond the scope of this work.

11. See s. IV below.

12. *Queneesh Studios Inc. v. Queneesh Developments Inc.* (1996) 67 CPR (3d) 452 (British Columbia Supreme Court) paras 5 and 8 (per Master Horn).

III. OVERVIEW

The idea of protecting cultural expressions as a right of collective identity is not new.¹³ The aim here is to examine first how protecting certain cultural expressions as a right of identity may work in Canada where a common law of identity signs arguably already operates in practice,¹⁴ and second how this right may apply to a collective, in particular a source culture. By analyzing the established common law against passing-off, the evolving common law against appropriation of personality, and the emerging though still uncertain common law right of privacy within Canadian jurisprudence, this work assesses the robustness of the current common law in protecting cultural expressions, their underlying narratives, meanings, and values for their source cultures, in permitting source cultures some control over the symbols of their sovereignty.

Four scenarios are considered here:

Where a cultural expression is deployed among a public

1. generally aware of its meaning in the source culture (for example, CHEROKEE);
 2. generally unaware of its origin or meaning (for example, NISKA¹⁵);
 3. generally alert to its origin in or connection to a source culture, though not the specific source culture (for example, the petroglyphs of the Snuneymuxw First Nation),
- and where a cultural expression is deployed by a party;
4. not entitled to its use because of its secret nature within its source culture.

IV. THE LAW OF PASSING-OFF

The law of passing-off, the source of the current Canadian common and statutory trade mark laws, is summed up by the English judiciary and adopted by the Supreme Court of Canada as: ‘no man may pass off his goods as those of another’.¹⁶ It consists of three elements:

1. a goodwill or reputation attached to the goods or services supplied by the plaintiff in the minds of the purchasing public by association with the identifying ‘get-up’ under which his goods or services are offered to the public, such that the get-up is recognised by the public as distinctive specifically of his goods or services;
2. a misrepresentation to the public (whether or not intentional) leading or likely to lead the public to believe that the defendant’s goods or services offered are those of the plaintiff; and

13. T. Antony, ‘Is there a Right of Collective Personality’ (2006) 28(9) *European Intellectual Property Review*, 485.

14. C.W. Ng, ‘A Common Law of Identity Signs’ (2007) 20 *Intellectual Property Journal*, 177.

15. *Lortie v. Standard Knitting* (1991) 35 CPR (3d) 175 (TMOB); see text relating to n. 18 below.

16. *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] 1 WLR 491 at 499, HL(E); *Ciba-Geigy Canada Ltd v. Apotex Inc.* [1992] 3 SCR 120 at 132, 95 DLR (4th) 385 at 393.

3. damage or likelihood of damage by reason of the erroneous belief engendered by the defendant's misrepresentation above.¹⁷

With its origin in trade, the action of passing-off has a limited reach in protecting cultural expressions. The first requirement of goodwill limits the protection to the extent of the plaintiff's goodwill. Where a cultural expression is not known to its audience, the law affords no protection. Secret cultural expressions are certainly excluded from this protection. In 1991, the expression NISKA was noted by the Trade Mark Opposition Board to mean, in addition to the name of the opponent to the trade mark registration – the Canadian artist Niska: '1a: a Tsimshian people or group of peoples of the Nass river valley and contiguous Pacific coast, British Columbia, Canada 1b: a member of any of such peoples 2: the language of the Niska people.' Nonetheless, with no evidence of record indicating the number of Canadians aware of such indigenous significance of the word, the Board concluded that relatively few would be aware of it.¹⁸ A similar finding within a relevant public in a passing-off action would disentitle the Nisga'a Nation to the protection. Where a cultural expression has been consistently applied to goods and services such that the relevant public is aware that the applications all signify a single source of the goods and services, even if unaware of the specific identity of the source, the expression may enjoy protection under the law of passing-off.¹⁹ Thus, if a source culture applies its design consistently and exclusively to signify it as the source of the goods or services bearing the design, the design would gain protection under the law of passing-off even where the market is not informed about the source culture behind the trade or the design.

A passing-off action would succeed where consumer confusion is likely to falsely attribute to the source of a cultural expression the goods or services underlying the expression used as trade mark, and damage results or is likely. For example, a passing-off action would succeed against the unauthorized use of COWICHAN on sweaters causing or likely to cause such confusion and damage to the goodwill of the Cowichan Band Council in its sweaters. While the intention of the defendant is not an element of the tort, it is often considered.²⁰ While the tort often attracts pecuniary consequences, for example, from a diversion of trade from the plaintiff, it is also concerned with the reputation of the plaintiff. The tort is often rationalized for its role in informing consumers so that they can infer from the trade mark the source, or the quality and character of their purchase. However, this rationalization appears illusory.²¹

17. *Reckitt & Colman Products Ltd v. Borden Inc.* [1990] 1 WLR 491 at 499, HL(E); *Ciba-Geigy Canada Ltd v. Apotex Inc.* [1992] 3 SCR 120 at 132, 95 DLR (4th) 385 at 393.

18. *Lortie v. Standard Knitting* (1991) 35 CPR (3d) 175 (TMOB): the proceeding was brought inter alia under s. 9(1)(k) of the *Trade-marks Act*. D. Vaver, *Copyright Law* (Toronto, Irwin Law, 2000), p. 297: the Nisga'a people were not notified of the proceeding.

19. *Powell v. Birmingham Vinegar Brewery Co.* [1897] AC 710 at 715, HL as cited in *Oxford Pendaflex Canada Ltd v. Korr Marketing Ltd* [1982] 1 SCR 494 at 503, 64 CPR (2d) 1 at 8.

20. C. Ng, 'A Common Law of Identity Signs' (2007) 20 *Intellectual Property Journal*, 177.

21. C. Ng, 'The Irrational Lightness of Trade Marks: a legal perspective' in *Trade Marks and Brands*, by L. Bently, J. Davis and J. Ginsburg (eds) (Cambridge University Press, 2008, forthcoming), p. 515.

The tort has been extended in three notable ways relevant here. First, it is no longer limited to protecting plaintiffs in trade. Source cultures are often not in trade, especially for the particular goods or services at issue. For example, the Cherokee Nation is not known for its automotive trade, yet CHEROKEE has been adopted by third party for the trade. A religious organization²² has succeeded as a plaintiff to a passing-off action, albeit one against another religious organization. Arguably, the action can extend to protect cultural groups as plaintiffs.

Second, it has been extended to protect the interests of collectives, so those of a source culture would qualify for its protection. A series of English cases often referred to as the 'Drinks Cases',²³ has been influential in Canada in establishing a collective right of protection under the law of passing-off.²⁴ Typically the defendants in these cases marketed a drink similar, but not identical, to the drink marketed by the plaintiffs, under a trade mark similar or identical to the plaintiffs'. The plaintiffs in the initial case consisted collectively of almost all producers of champagne under a central quality control authority who supplied champagne to England and Wales. The defendants' marketing of a Spanish wine under SPANISH CHAMPAGNE in England would have had the effect of undermining the central control over the quality of drinks bearing the name CHAMPAGNE among the plaintiffs. The resulting harm would have been borne directly and almost entirely by the plaintiffs collectively.

There seems to be no reason why such licence should be given to a person, competing in trade, who seeks to attach to his product a name or description with which it has no natural association so as to make use of the reputation and goodwill which has been gained by a product genuinely indicated by the name or description. In my view, it ought not to matter that the persons truly entitled to describe their goods by the name and description are a class producing goods in a certain locality, and not merely one individual. The description is part of their goodwill and a right of property. I do not believe that the law of passing off, which arose to prevent unfair trading, is so limited in scope.²⁵

In the final case in the Drinks Cases series, Lord Diplock confirmed that the principles of passing-off were applicable to a collective which was a contained class of plaintiffs who had individually built up goodwill under a shared name.²⁶

22. *Arabian Muslim Association v. Canadian Islamic Centre* (2004) 36 CPR (4th) 6 (Alberta QB) affirmed (2006) 48 CPR (4th) 305 (Alberta CA).

23. They deal with champagne: *J Bollinger SA v. Costa Brava Wine Co Ltd* [1961] RPC 116, Ch D; sherry: *Vine Products Ltd v. MacKenzie & Co Ltd* [1969] RPC 1, HCl Ch D; scotch whisky: *John Walker & Sons Ltd v. Henry Ost & Co Ltd* [1970] RPC 489, Ch D; champagne again: *HP Bulmer Ltd v. Bollinger SA* [1978] RPC 79, CA; and advocaat: *Erven Warnink Besloten Vennootschap v. J Townend & Sons (Hull) Ltd* [1979] AC 731, HL.

24. *Institut National des Appellations d'Origine des Vins et Eaux-de-Vie v. Andre Wines Ltd* (1990) 30 CPR (3d) 279 (Ontario CA) affirming (1987) 16 CPR (3d) 385 (Ontario HCl); *Dairy Bureau of Canada v. Annable Foods Ltd* (1993) 46 CPR (3d) 289 (British Columbia SC) 309.

25. *Bollinger v. Costa Brava Wine* [1960] Ch 262 at 283–284 (per J. Danckwerts).

26. *Erven Warnink Besloten Vennootschap v. J Townend & Sons (Hull) Ltd* [1979] AC 731 at 744, HL.

Analogous 'natural association' exists between a cultural expression and its source culture. Analogous protection should be afforded to those sharing a cultural expression for their specific goods and services (such as COWICHAN for sweaters²⁷).

Third, a 1992 case openly dismissed an earlier requirement of a common field of activity between the plaintiff and the defendant in an action passing-off. The case recognized a

more common type of passing-off . . . where it is alleged that a defendant has promoted his product or business in such a way as to create the false impression that his product or business is in some way approved, authorised or endorsed by the plaintiff or that there is some business connection between the defendant and the plaintiff. By these means a defendant may hope to 'cash in' on the goodwill of the plaintiff.²⁸

Therefore while North Americans may be aware that the Cherokee Nation is not responsible for the manufacture of automobiles, where the Cherokee Nation may be seen to have approved or endorsed the automobiles by lending its name, a tort of passing-off may be constituted. Where a disclaimer of any relationship or an understanding of the lack of relationship between the automobiles and the source culture is clear, however, passing-off would not succeed.

Beyond the law of passing-off, where cultural expressions, such as the Snuneymuxw First Nation's petroglyphs, are fictitiously used to envelope goods or services with qualities associated with the source culture,²⁹ courts may exercise their equitable jurisdiction to protect the public from fraud³⁰ where the trader has not acquired a secondary meaning in the expressions. Such secondary meaning is acquired where the expression refers in the minds of the relevant public to the trader, rather than to its primary meaning of the cultural source. One example of a foundation fiction occurred where a medicine was claimed to have been the invention of

Charles Forde, who was declared to be a skilled scientist, [and who] had, while in Australia, noted the fact that the aborigines were markedly free from certain bodily ailments, and that by patient research and exhaustive investigation he had ascertained that this immunity was obtained by the use of a natural vegetable substance, whose properties for cure of such ailments were extraordinary, and that as the result of his research this wonderful remedy was now given to the world.³¹

The named 'skilled scientist' never existed in relation to the product; the discovery was fictitious. The advertisements were 'often embellished with pictorial

27. See n. 4 above.

28. *National Hockey League v. Pepsi-Cola Canada Ltd* (1992) 42 CPR (3d) 390 (British Columbia SC) 401 affirmed (1995) 59 CPR (3d) 216 (British Columbia CA).

29. *Newman v. Pinto* (1887) 4 RPC 508 (CA); *Bile Bean Manufacturing Company v. Davidson* (1906) 23 RPC 725, Inner House.

30. *Canadian Encyclopaedic Digest* paras 540 and 547 (Westlaw 2007), 9 October 2007.

31. *Bile Bean Manufacturing Company v. Davidson* (1906) 23 RPC 725 at 733, Inner House.

representations of the healthy savage, and with pictures of the imaginary scientist (duly bearded and begoggled) having the precious root pointed out to him by the Australian native.³² The Scottish court in 1906 found this fiction affected the very essence of the article offered for sale and refused to protect any right the claimant might have had in its descriptive name of BILE BEAN against another user. In this instance, the ruling in effect allowed the fiction associated with the name to be diluted by other traders' use of the name, and the source culture to be eventually freed from the association.³³

The transference of the social meanings and values imbued by a source culture in its cultural expression to underlying goods and services and those imbued by goods and services through the expression they bear to the cultural source may affect not only the public perception of the expression and its source culture and people with which the expression is identified, but also the self-perception or identity of the people.

[E]xpression through ancestral symbols and designs constitutes the means by which the identity of the community is constructed, and by which that identity is recognised (and recognisable) by others, arguably the expropriation of this language outside the community constitutes identities of mis-recognition and the transformation of the means of communication.³⁴

V. THE COMMON LAW AGAINST APPROPRIATION OF PERSONALITY

A legal scholar has speculated that the earlier requirement of a common field of activity between the parties in actions against passing-off may have encouraged the development of a separate tort against appropriation of personality in Canada.³⁵ Although some of its constituting elements and its relationship with the law of passing-off remain unclear, the common concern between the common law against

32. *Bile Bean Manufacturing Company v. Davidson* (1906) 23 RPC 725 at 734, Inner House.

33. D. Vaver, 'Responding Legally to "Images in Brand Culture"' in *Trade Marks and Brands*, by L. Bently, J. Davis and J. Ginsburg (eds) (Cambridge University Press, 2008, forthcoming), p. 422 at 454–455: "The bile bean sellers dropped their Australian story after losing the Scottish litigation but nonetheless continued to market the product as a panacea. Apparently no worse than other tonic-cum-laxatives, bile beans were selling a million a day by 1930 and disappeared only in the mid-1980s when people abandoned their "obsession with purgation and inner cleanliness".' (Footnote omitted.)

34. J. Gibson, 'Freedoms and Knowledge, Access and Silence: traditional knowledge and freedom of speech' in *New Direction in Copyright Law*, F. Macmillan (ed.) (Cheltenham, Edward Elgar, 2006) vol. 2, 198 at 214.

35. R.G. Howell, 'Character Merchandising: the marketing potential attaching to a name, image, persona or copyright work' (1991) 6 *Intellectual Property Journal*, 197; R.G. Howell, 'The Common Law Appropriation of Personality Tort' (1985–86) 2 *Intellectual Property Journal*, 148 at 155.

passing-off and that against appropriation of personality³⁶ is the control over one's social identity. For the latter, '[i]t is the unauthorised use of a name or likeness of a person as a symbol of his identity that constitutes the essential element of the cause of action'.³⁷ Source cultures share this concern in the use of their cultural expressions.

Ontario was the first Canadian province to have declared the existence of a common law right against appropriation of personality, even though the plaintiff did not succeed under that right in the case. Since then, the right has been recognized in other provinces in Canada. The initial case involved the use of the plaintiff's photograph on the defendant's promotional device. The plaintiff footballer was identifiable only by the number on his shirt. The Ontario Court of Appeal found no reasonable basis for inferring or implying the plaintiff's endorsement of the defendant's products or the plaintiff's involvement in the design or manufacture of those products to establish passing-off. However, it concluded that 'the common law does contemplate a concept in the law of torts which may be broadly classified as an appropriation of one's personality',³⁸ and which would protect a plaintiff from damage by others' use of his image, voice, or otherwise.³⁹ The tort did not apply in the initial case because the court found it was the game of Canadian football, rather than the plaintiff which was deliberately incorporated in the promotional device.

The elements of the tort observed in the series of cases involving appropriation of personality are:

1. The plaintiff must be identifiable in the offending material.
2. The plaintiff's identity must play a specific role in the offending material;
3. Injury and damage to the plaintiff must be shown as a result of the material;
4. Social policy may override the prima facie rights of both parties.

Based on these elements, the tort appears to broaden the potential for common law protection of cultural expressions in some respects.

First, unlike under the law of passing-off, the plaintiff here need not have accrued goodwill. Its identity in the offending use must however be recognizable by members of the relevant public.⁴⁰ Again, secret cultural expressions would be excluded from this protection. Under this protection, the plaintiff only needs to be recognizable, it need not be known. Unlike under the law of passing-off, even though the Snuneymuxw First Nation may not engage in trade with its petroglyphs, and its relationship to the petroglyphs may not be generally known, it may still have a right of action under this tort where damage would result or likely result from a

36. T. Frazer, 'Appropriation of Personality – a new tort?' (1983) 99 *Law Quarterly Review*, 281 at 297.

37. *Joseph v. Daniels* (1986) 11 CPR (3d) 544 (British Columbia SC) 549.

38. *Krouse v. Chrysler Canada Ltd* (1973) 13 CPR (2d) 28 (Ontario CA) 42.

39. *Krouse v. Chrysler Canada Ltd* (1973) 13 CPR (2d) 28 (Ontario CA) 44.

40. *Joseph v. Daniels* (1986) 11 CPR (3d) 544 (British Columbia SC); *Mavis v. Lavoie* [2000] NBJ 527 (New Brunswick Small Claims Court).

third party use of its petroglyphs if these petroglyphs are recognizable and are distinctly identified with the Snuneymuxw First Nation.⁴¹ However protection would not be available for an expression (such as NISKA) by which any source culture referent (the Nisga'a Nation) may not be generally recognizable to the relevant public.

Arguably, a tort against an 'appropriation' of personality should not require a misrepresentation leading or likely to lead to public confusion as is required under the law against passing-off. However, the use of the plaintiff's identity or components of the plaintiff's individuality or personality to associate with the defendant's identity⁴² or to appeal to the public⁴³ would be required to constitute the tort. 'The gravamen of the tort is the usurpation of the plaintiff's right to control and market his own image.'⁴⁴ New cases akin to the third party use of CHEROKEE on merchandise would afford a right of action for the Cherokee Nation, despite any disclaimer of association to avoid passing-off.

The tort is subject to a balance of public interest. The Canadian courts have drawn a distinction based on the role of the plaintiff's identity in the disputed material: the role (for example of a spokesperson) in attracting sales for the defendant's goods or services, and the role (for example of the Canadian pianist Glenn Gould) in being the subject of the defendant's goods (of a biography of Gould).⁴⁵ In the latter cases, the use may be justified by social policy, such as that based on the public interest in information. Within the limits of free expression enabled within a free and democratic society, the public invocation of and discussion about historical or public figures ought not be inhibited by the tort of appropriation of personality.

The Canadian courts have, however, considered the right against appropriation of personality descendible to the heirs of the personality with little explanation or limitation for the duration of this right.⁴⁶ This puts into question the exclusive claims to the names and images of historical figures. Who, if anyone, should have a right to this claim and for how long? The public interest rationale would arguably permit the use of POCAHONTAS for a cartoon, albeit one which Disney does not

41. *Athans v. Canadian Adventure Camps Ltd* (1977) 17 OR (2d) 425 (Ontario HCJ).

42. *Athans v. Canadian Adventure Camps Ltd* (1977) 17 OR (2d) 425 (Ontario HCJ) 436; *Holdke v. The Calgary Convention Centre Authority* [2000] AJ 631 (Provincial Court of Alberta Civil Division) para. 16.

43. *Joseph v. Daniels* (1986) 11 CPR (3d) 544 (British Columbia SC) 549; *Mavis v. Lavoie* [2000] NBJ 527 (NB Small Claims Court) para. 27; *Dubrulle v. Dubrulle French Culinary School Ltd* (2000) 8 CPR (4th) 180 (SC British Columbia) paras 19–20.

44. *Horton v. Tim Donut Ltd* (1997) 75 CPR (3d) 451 (Ontario Court (General Division)) 459 affirmed (1997) 75 CPR (3d) 467 (Ontario CA).

45. *Gould Estate v. Stoddart Publishing Co Ltd* (1996) 74 CPR (3d) 206 (Ontario Court (General Division)) 212 affirmed on copyright grounds (1998) 39 OR (3d) 545 (Ontario CA); *Shaw v. Berman* (1997) 144 DLR (4th) 484 (Ontario Court (General Division) affirmed (1998) 167 DLR (4th) 576 (Ontario CA).

46. *Gould Estate v. Stoddart Publishing Co Ltd* (1996) 74 CPR (3d) 206 (Ontario Court (General Division)) 212 affirmed on copyright grounds (1998) 39 OR (3d) 545 (Ontario CA), *Hapi Feet Promotions Inc. v. Martin* (2004) 36 CPR (4th) 193 (Nova Scotia SC) affirmed [2005] NSJ 178 (Nova Scotia CA).

claim to be an accurate portrayal of its namesake, but merely that one 'based on historical fact'.⁴⁷ The right to merchandise under the name would warrant a different consideration.

Finally, in respect of the harm to the plaintiff as an element of the tort, even though the founding case insisted on a finding of damage and injury, it compared the tort to conversion.⁴⁸ In subsequent cases, the appropriation appeared actionable *per se*, in terms of proprietary rights.⁴⁹ However a factual analysis of those cases suggests that passing-off type considerations were taken into account in determining harm or likelihood of harm to the plaintiff.

The defendant's intent, while not often considered in these cases, may be implicit. Despite speculation in the founding case that the defendants' intent may be of receding importance in establishing liability,⁵⁰ in all but one case,⁵¹ the defendants knew of the claimants whose personalities were appropriated. In the case of cultural expressions, however, the link between the expressions and their source cultures is often less clear, and a potential appropriator's appreciation of this link even less so. Even given such an appreciation, not all third party riders on this link are offensive. For example, the use of CANADIAN for beer⁵² or Canada in CANADA DRY⁵³ for a beverage is not offensive to Canadians. CANADA DRY's invocation of Canada is evident in its tagline: 'Just north of everyday.'TM⁵⁴ The name Canada has enjoyed constitutional definition.⁵⁵ It is derived from *kanata*, the Huron-Iroquois word for 'village' or 'settlement' reportedly used by two native youths when speaking to Jacques Cartier in 1535 in reference to a village (now Québec City). In time, its applicable area grew.⁵⁶ In this context, *kanata* was perhaps never an expression of identity or other significance to the Huron-Iroquois culture. The public appreciation for and indeed the definition of what is and is not of identity or other significance to a source culture remain problematic in the protection of many cultural expressions under common law.

47. <<http://disney.go.com/vault/archives/movies/pocahontas/pocahontas.html>>, 10 October 2007.

48. *Krouse v. Chrysler Canada Ltd* (1973) 13 CPR (2d) 28 (Ontario CA) 41.

49. *Athans v. Canadian Adventure Camps Ltd* (1977) 17 OR (2d) 425 (Ontario HCJ) 434; *Joseph v. Daniels* (1986) 11 CPR (3d) 544 (British Columbia SC) 549; *Holdke v. The Calgary Convention Centre Authority* [2000] AJ 631 (Provincial Court of Alberta Civil Division) para. 20; *Salé v. Barr* (2003) 25 CPR (4th) 449 (Alberta QB) para. 19.

50. *Krouse v. Chrysler Canada Ltd* (1973) 13 CPR (2d) 28 (Ontario CA) 32.

51. *Mavis v. Lavoie* [2000] NBJ 527 (New Brunswick Small Claims Court) para. 27.

52. See n. 117 below.

53. Registered in Canada under TMDA55340 since 1932 <<http://cipo.ic.gc.ca>>, 2 November 2007. The right to the exclusive use of the word Canada is disclaimed.

54. <www.canadadry.com>, 10 October 2007.

55. The *Constitution Act 1867* Vict. 30–31 c. 3 (UK) s. 4, as amended by the *Statute Law Revision Act 1893* Vict. 56–57 c. 14 (UK): 'Unless it is otherwise expressed or implied, the Name Canada shall be taken to mean Canada as constituted under this Act.'

56. Canadian Heritage, Government of Canada <www.canadianheritage.gc.ca/progs/cpsc-ccsp/sc-cs/o5_e.cfm>, 10 October 2007: 'The first use of "Canada" as an official name came in 1791 when the Province of Quebec was divided into the colonies of Upper and Lower Canada. In 1841, the two Canadas were again united under one name, the Province of Canada. At the time of Confederation [in 1867], the new country assumed the name of Canada.'

The tort against appropriation of personality appears to occupy a middle ground between the commercial interests which gave easily identifiable and quantifiable birth-right to the common law against passing-off, and the personal interests which are struggling for recognition under an emerging common law right of privacy. It is at times brought with passing-off as a parallel cause of action.⁵⁷ It is also at times considered with privacy right.⁵⁸ Indeed, the founding case for the tort considered rights against passing-off and took initial steps in recognizing privacy rights in common law.

VI. A COMMON LAW RIGHT OF PRIVACY

The protection of Indigenous knowledge and heritage represents the protection and preservation of Aboriginal humanity. Such protection is not about preserving dead or dying cultures. It is about the commercial exploitation and appropriation of living consciousness and cultural orders. It is an issue of privacy and commerce.⁵⁹

A right of privacy is awaiting recognition under common law. The difficulties in gaining recognition are often attributed to conceptual issues such as its undefined boundaries and its philosophical and theoretical foundations which are susceptible to intuitionism, to competing public policy concerns such as freedom of information and freedom of expression,⁶⁰ and to pragmatic issues of appreciating and quantifying intangible harm which the common law has traditionally been slow to recognize.⁶¹ The articulated interests at stake range from property to the autonomy and dignity in personhood.⁶² In the context of cultural expressions, ‘a tidy

57. *Athans v. Canadian Adventure Camps Ltd* (1977) 17 OR (2d) 425 (Ontario HCJ); *Salé v. Barr* (2003) 25 CPR (4th) 449 (Alberta QB).

58. *Krouse v. Chrysler Canada Ltd* (1971) 5 CPR (3d) 30 (Ontario High Court); *Salé v. Barr* (2003) 25 CPR (4th) 449 (Alberta QB).

59. M. Battiste and J. Youngblood Henderson, *Protecting Indigenous Knowledge and Heritage* (Saskatoon, Purich Publishing Ltd, 2000), at 292.

60. R.B. Bruyer, ‘Privacy: a review and critique of the literature’ (2006) 43 *Alberta Law Review*, 553.

61. G.H.L. Fridman, *The Law of Torts in Canada* (2002, Toronto, Carswell), 707: ‘The reason for the clearer and more definite acceptance of liability for appropriation of personality may be that courts find it easier to recognise an economic or proprietary right of the kind discussed in the appropriation cases than the vaguer, less obvious personal right to privacy that is involved and urged in other situations where commercial exploitation is not a factor’; P.H. Osborne, *The Law of Torts* (2nd edn, Toronto, Irwin Law, 2003), p. 241; R.M. Ryan Bell ‘Tort of invasion of privacy – has its time finally come?’ in *Annual Review of Civil Litigation*, T.L. Archibald and M.G. Cochrane (eds) (Toronto, Carswell, 2004), 225.

62. E. Bloustein, ‘Privacy as an Aspect of Human Dignity: an answer to Dean Prosser’, (1964) 39 *New York University Law Review*, 963 at 1003; P. Jaffey, ‘Rights of Privacy, Confidentiality, and Publicity, and Related Rights’ in *Copyright and Human Rights: Freedom of Expression – Intellectual Property – Privacy*, P.L. Torresmans (ed.) (The Hague, Kluwer Law international, 2004); D.J. Solove, ‘A Taxonomy of Privacy’ (2005–2006) 154 *University of Pennsylvania Law*

separation of property and privacy is impossible within a market system that turns identity into a commodity.⁶³ The inquiry here is to what extent, if any, a privacy right at common law may protect the types of cultural expression under consideration.

In Canada, some privacy right is protected by statute federally⁶⁴ and provincially in four of the nine common law provinces.⁶⁵ The provincial legislation creates a tort of invasion of privacy of a person without proof of damage.⁶⁶ Such violation includes, in three provinces, the willful use (and in the fourth province of Manitoba the substantial and unreasonable use), without consent or claim of right, of the name or likeness of an identified or identifiable person for the purpose of exploitation for trade.⁶⁷ In three provinces, the statutory rights are extinguished by the death of the alleged victim.⁶⁸ None of the legislation defines 'privacy'. Three of the four provincial statutes explicitly recognize other right of action or remedy.⁶⁹ The statutes and the cases which interpret and apply them can provide some guidance for common law development.⁷⁰

Despite the bold but *obiter* declaration of a potential independent common law right of privacy in the founding case for the tort against appropriation of personality in Ontario,⁷¹ the development of the right of privacy as the basis for a separate cause of action in common law has remained uncertain. There is no broad statutory

Review, 477 at 546; R.B. Bruyer 'Privacy: A review and critique of the literature' (2006) 43 *Alberta Law Review*, 553 para. 3; G. Gomery 'Whose Autonomy Matters? Reconciling the competing claims of privacy and freedom of expression' (2007) 27 *Legal Studies* 404.

63. M.F. Brown, *Who Owns Native Culture?* (Cambridge, Harvard University Press, 2003), 38.
64. Privacy Act RS 1985 c. P-21 s. 2: 'The purpose of this Act is to extend the present laws of Canada that protect the privacy of individuals with respect to personal information about themselves held by a government institution and that provide individuals with a right of access to that information.'
65. British Columbia: Privacy Act, RSBC 1996 c. 373; Saskatchewan: The Privacy Act, RSS 1978 c. P-24; Manitoba: The Privacy Act, CCSM c. P-125; Newfoundland and Labrador: Privacy Act, RSNL 1990 c. P-22.
66. British Columbia: s. 1; Saskatchewan: s. 2; Manitoba: s. 2; Newfoundland and Labrador: s. 3.
67. British Columbia: ss 1(1), 3(2), (4); Saskatchewan: ss 2, 3(c); Manitoba: ss 2(1), 3(c), 5(a); Newfoundland and Labrador: ss 3(1), 4(c). See D. Vaver, 'What's Mine is Not Yours: commercial appropriation of personality under the Privacy Acts of British Columbia, Manitoba and Saskatchewan' (1982) 15 *University of British Columbia Law Review*, 241; B. McIsaac, R. Shields, K. Klein, *The Law of Privacy in Canada* (Toronto, Carswell, 2000), paras 2–58.45 et seq.
68. British Columbia: s. 5; Saskatchewan: s. 10; Newfoundland and Labrador: s. 11.
69. Saskatchewan: s. 8(1); Manitoba: s. 6; Newfoundland and Labrador: s. 7.
70. P.H. Osborne, *The Law of Torts* (2nd edn, Toronto, Irwin Law, 2003), 244; R.M. Ryan Bell 'Tort of Invasion of Privacy – has its time finally come?' in *Annual Review of Civil Litigation*, T.L. Archibald and M.G. Cochrane (eds) (Toronto, Carswell, 2004), 225 at 243.
71. *Krouse v. Chrysler Canada Ltd* [1972] 2 OR 133, 25 DLR (3d) 49 (Ontario SC) at paras 18–19 (per Haines J.): 'However, upon reviewing the authorities cited and found, I must conclude that the privacy *per se* aspect of this action is novel in principle . . . Were it necessary for me to decide this point to determine this action, this novelty would not be an excuse in and of itself, for me to deny the plaintiff relief.'

privacy right in Ontario. The clearest pronouncement⁷² on the issue came in a 2006 Ontario Superior Court decision: ‘Even if the plaintiff’s claim for invasion of privacy were classified as “novel” (which, in any event, is not a proper basis for dismissing it) the foregoing analysis leads me to conclude that the time has come to recognize invasion of privacy as a tort in its own right.’⁷³ The issues under consideration were limited to determining if it was plain and obvious that there was no independent tort of invasion of privacy at common law, and if so, if it was plain and obvious that the plaintiff would not succeed. A full trial at an appellate level would lend more weight to the pronouncement.⁷⁴ Nonetheless, the case is a useful backstop to bolster the recognition of some independent common law right against the invasion of privacy in Ontario.⁷⁵ In the past, the protection of privacy could only be achieved through the use of other legal doctrines, such as nuisance or trespass.⁷⁶

While the classic conception of the right to privacy as the right to be let alone is cited in Ontarian case law,⁷⁷ text authorities and recent case law⁷⁸ use as a reference point Prosser’s construction of the right, consisting of a right against:

1. the intrusion on seclusion, solitude or private affairs;
2. the publication of embarrassing private (but true) facts;
3. the publicity which portrays a person in a false light; and/or
4. the appropriation of a person’s name or likeness.⁷⁹

Under the first two instances set out by Prosser, privacy has the sense of confidentiality; the intended audience, if any, is finite and presumed to appreciate some obligation of confidence or propriety in privacy. In the latter two instances, privacy has the sense of private proprietary control: in the third instance, of the reputation

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72. A.M. Linden and B. Feldthusen, *Canadian Tort Law* (8th ed, Markham, LexisNexis Butterworths, 2006), 59.
73. *Somwar v. McDonald’s Restaurants of Canada Ltd* [2006] OJ No 64 (Ontario SCJ) at para. 31 (per Stinson J.); see also *Shred-Tech Corp v. Viveen* [2006] OJ 4893 (Ontario SCJ).
74. A. Cameron, ‘Recognition of Invasion of Privacy as a Tort in its Own Right: has Gordias’ ox cart been freed in Ontario?’ *Ontario Bar Association Privacy Section Personally Yours*, vol. 6, no. 3 – May 2006.
75. E.g.: *Krouse v. Chrysler Canada Ltd* [1970] 3 OR 135 (Ontario HCJ) at para. 5 (per Parker J.): ‘It may be that the action is novel, but it has not been shown to me that the Court in this jurisdiction would not recognize a right of privacy’; *Saccone v. Orr* [1981] OJ No 3132 (Ontario CoCt) 34 OR (2d) 317 para. 23; *Palad v. Pantaleon* [1989] OJ No 985 (Ontario Dist Ct); *Roth v. Roth* [1991] OJ No 1301; 4 OR (3d) 740 (Ontario Gen Div).
76. *Capan v. Capan* [1980] OJ No 1361 (Ontario HCJ) at paras 14–15: ‘What is complained of here is, in its very essence, an abuse of personal rights to privacy and to freedom from harassment. The common law, developing as it did from property concerns, speaks vaguely or not at all of personal rights . . . it has not been demonstrated that the rights referred to will not be recognised by our courts nor that their infringement will not found a cause of action.’
77. *Krouse v. Chrysler Canada Ltd* [1972] 2 OR 133, 25 DLR (3d) 49 (Ontario SC) at para. 10(a).
78. G.H.L. Fridman, *The Law of Torts in Canada* (2002, Toronto, Carswell), 698 et seq.; A.M. Linden and B. Feldthusen, *Canadian Tort Law* (8th edn, Markham, LexisNexis Butterworths, 2006), 59; *Somwar v. McDonald’s Restaurants of Canada Ltd* [2006] OJ No 64 (Ontario SCJ).
79. W. Prosser, ‘Privacy’ (1960) 48 *California Law Review*, 383.

or goodwill akin to that in passing-off,⁸⁰ and in the fourth instance, of the name or likeness itself.

These latter two instances involve no secrecy. They may not confer proprietary rights, but consistent with other instances of privacy, they confer some desired exclusivity of access to oneself or information about or items closely associated with oneself.⁸¹ The right against appropriation of personality appears as a strand here.⁸² The privacy right to be protected from false light may be guided by pre-existing concepts in the law of defamation and passing-off. Charles Forde, the skilled scientist had he existed, would have had a cause of action under the head of false light for having been falsely portrayed as the inventor of BILE BEANS. The indigenous source culture referred to or analogously the source culture whose distinctive cultural expressions have been so used fictitiously would have been entitled to the same right. Likewise, the Snuneymuxw First Nation would be entitled to this right if its petroglyphs were used fictitiously to envelope goods or services with qualities associated with the source culture.

While the exact foundation, nature, definition, and taxonomy of privacy rights in the first two instances are still the subject of much academic and judicial consideration,⁸³ some basic elements are evident. First, the plaintiff need not enjoy any goodwill through its identity sign or cultural expression within any relevant public such as required under the law of passing-off. While under the second instance, the plaintiff may need to be identifiable to render certain facts private, under the first instance, the plaintiff's right to seclusion may be breached even when the plaintiff is not identifiable. '[T]he real interest at stake in intrusion cases is not the subject's interest in not being found out about, but his or her interest in not being looked at, listened to, touched or imposed upon against his or her wishes.'⁸⁴ This threshold would certainly protect secret cultural expressions from disclosure.

Second, and most fundamentally, the existence and the extent of a right of privacy under the first two instances depend on whether there is a reasonable or shared expectation of privacy or of confidence between the parties.⁸⁵ This

80. *AG Spalding & Bros v. AW Gamage Ltd* (1915) 32 RPC 273, HL.

81. N.A. Moreham, 'Privacy in the Common Law: a doctrinal and theoretical analysis' (2005) 121 *Law Quarterly Review*, 628 at 636 et seq.; D.J. Solove, 'A Taxonomy of Privacy' (2005–2006) 154 *University of Pennsylvania Law Review*, 477.

82. G.H.L. Fridman, *The Law of Torts in Canada* (Toronto, Carswell, 2002) 703, 707; R. Brown, 'Rethinking Privacy: Exclusivity, private relation and tort law' (2006) 43 *Alberta Law Review* 589; A.M. Linden and B. Feldthusen, *Canadian Tort Law* (8th edn, Markham, LexisNexis Butterworths, 2006), 59–60.

83. See n. 62 above.

84. N.A. Moreham, 'Privacy in the Common Law: a doctrinal and theoretical analysis' (2005) 121 *Law Quarterly Review*, 628 at 650–651.

85. *R v. Dyment* [1988] 2 SCR 417 paras 30, 34–355 citing *Hunter v. Southam Inc* [1984] 2 SCR 145.

expectation may arise from secrecy, anonymity, an obligation, or a shared or reasonable understanding.⁸⁶ The Canadian common law⁸⁷ on such privacy and its reasonable expectation is influenced by the values expressed in the constitutionally entrenched⁸⁸ *Charter of Rights and Freedoms* particularly sections 7 and 8.⁸⁹ These values reflect a respect for a retreat from public gaze. In this retreat, each individual may preserve his or her personal dignity while exercising autonomy in developing and forging an identity. While the right against a breach of confidence protects an express or implied equitable, contractual, proprietary (or proprietary-like) and/or other right,⁹⁰ and that for privacy protects the private substance of the matter under the obligation, the actions are not mutually exclusive.⁹¹ In the case of a disclosure of secret cultural expressions, both are conceivable. Certain members of a source culture or certain anthropologists⁹² may be entrusted with secret cultural expressions which are substantively private to the culture. Those entrusted would thus be entrusted under an obligation of confidence as well as privacy. Non-secret and non-sacred cultural expressions would not ordinarily be protected under this obligation.

Third, the right of privacy is not absolute; rather it must be balanced against other rights and freedoms⁹³ such as the freedom of information and the freedom of expression. While the freedom of expression is a right protected under the *Charter*

86. E. Paton-Simpson, 'Privacy and the Reasonable Paranoid: the protection of privacy in public places' (2000) 50 *University of Toronto Law Journal*, 305; G. Gomery, 'Whose Autonomy Matters? Reconciling the competing claims of privacy and freedom of expression' (2007) 27 *Legal Studies* 404.

87. E.g.: *Hill v. Church of Scientology of Toronto* [1995] 2 SCR 1130 at para. 97: 'Charter values, framed in general terms, should be weighed against the principles which underlie the common law. The Charter values will then provide the guidelines for any modification to the common law which the court feels is necessary.' *Somwar v. McDonald's Restaurants of Canada Ltd* [2006] OJ No 64 (Ontario SCJ) para. 20: 'Protection of those privacy interests by providing a common law remedy for their violation would be consistent with *Charter* values and an "incremental revision" and logical extension of the existing jurisprudence.'

88. Enacted as Schedule B to the *Canada Act 1982*, (UK) 1982.

89. S. 7 guarantees the right to 'life, liberty and security of the person and the right not to be deprived thereof except in accordance with the principles of fundamental justice'; *R v. O'Connor* [1995] 4 SCR 411. S. 8 provides that 'everyone has the right to be secure against unreasonable search or seizure'; *R v. Dyment* [1988] 2 SCR 417. Note also s. 25: 'The guarantee in this Charter of certain rights and freedoms shall not be construed so as to abrogate or derogate from any aboriginal, treaty or other rights or freedoms that pertain to the aboriginal peoples of Canada.'

90. D. Vaver, 'Civil Liability for Taking or Using Trade Secrets in Canada' (1981) 5 *Canadian Business Law Journal*, 253.

91. I.D.F. Callinan, 'Privacy, Confidence, Celebrity and Spectacle' (2007) *Oxford University Commonwealth Law Journal* 1.

92. E.g.: *Foster v. Mountford* (1976) 14 ALR 71 (SC of the Northern Territory).

93. *R v. Dyment* [1988] 2 SCR 417 at 427-428; *R v. O'Connor* [1995] 4 SCR 411 at para. 65; R.M. Ryan Bell, 'Tort of Invasion of Privacy - has its time finally come?' in *Annual Review of Civil Litigation*, T.L. Archibald and M.G. Cochrane (eds) (Toronto, Carswell, 2004), 225 at 235; B. McIsaac, R. Shields, K. Klein, *The Law of Privacy in Canada* (Toronto, Carswell, 2000), para. 2-67 et seq.

of *Rights and Freedoms*,⁹⁴ even within the *Charter* context,⁹⁵ the right would be balanced by the demands of a free and democratic society.⁹⁶ This is intended to achieve a balance between privacy from both public intrusion and exposure on the one hand, and freedoms of information and expression on the other, between privacy from the public exposure of a secret cultural expression on the one hand, and on the other, a public interest such as that in 'fair dealing' in the copyright sense: for research or private study, for criticism or review, and for news reporting.⁹⁷ Some of the considerations in balancing between public and private interests in the tort against appropriation of personality would resonate here.

In all four instances of Prosser's privacy right, the challenge remains in locating a reasonable expectation to be let alone.⁹⁸ The divide here is not one between indigenous and non-indigenous cultures. State emblems are prohibited marks under section 9 of the Canadian *Trade-marks Act* which implements Article 6*ter* of the Paris Convention. Where such explicit protection is lacking, mutual respect and community consultation may be the safest guide for appreciating the reasonable expectation for each expression in that culture.⁹⁹

Another way to establish an expectation may be through a central database with materials to be produced upon request to substantiate the exclusivity of control and the expectation of privacy by the source culture. As with any such central record, some items listed may have an unnecessarily broad chilling effect on the prospective users of cultural expressions, while others may be subject to legal challenges regarding, inter alia, the source culture's claim of exclusive identification with the expression, the identity, spiritual or other significance of the expression, and the social policy considerations against third party use. Nevertheless, such a database may be a starting point for researchers and may educate the public generally about indigenous cultures. The past decades have seen a raised public awareness of intellectual property rights and a raised sensitivity to the potentially different expectations in the use of cultural expressions.

This expectation of awareness and sensitivity would inform the constructive knowledge and intention of the defendant user where such knowledge or intention

94. S. 2: Everyone has the following fundamental freedoms: (...) b) freedom of thought, belief, opinion and expression.

95. S. 32: '(1) This Charter applies

(a) to the Parliament and government of Canada in respect of all matters within the authority of Parliament . . . ; and

(b) to the legislature and government of each province in respect of all matters within the authority of the legislature of each province.'

96. S. 1: 'The *Canadian Charter of Rights and Freedoms* guarantees the rights and freedoms set out in it subject only to such reasonable limits prescribed by law as can be demonstrably justified in a free and democratic society.'

97. *Copyright Act* (R.S., 1985, c. C-42) ss. 29, 29.1, 29.2.

98. W. Prosser, 'Privacy' (1960) 48 *California Law Review*, 383 at 389.

99. D.J. Gervais, 'Spiritual but not Intellectual? The protection of sacred intangible traditional knowledge' (2003) 11 *Cardozo Journal of International and Comparative Law*, 467.

may be elements of the common law.¹⁰⁰ Notably, three of the four provincial privacy statutes as well as the recent Ontario case, *Somwar v. McDonald's Restaurants of Canada Ltd*, affirming the existence of a right of privacy all demand as an element of the offence that the defendant willfully violate the privacy of another.¹⁰¹ The fourth province, Manitoba, requires under its statute a substantial and unreasonable violation¹⁰² as an element of the offence.

This exploration, however, anticipates the birth of a common law right to privacy,¹⁰³ whose parentage, precise genetic and external make-up, and relationship to the laws against passing-off and against appropriation of personality remain to be determined. Nevertheless, where this right is available for the protection of cultural expressions, it may extend the scope of protection from the current law of passing-off and its alleged progeny that is the appropriation of personality

VII. COLLECTIVE RIGHTS

As with the law of passing-off which protects collective identities, privacy right and the right against appropriation of personality, in essence, seek to protect from 'an impingement on the victim's freedom in the authorship of her self-narrative'.¹⁰⁴ The 'victim' may be a collective in all cases.

The protection offered to collectives or classes of traders in the Drinks Cases under the law of passing-off does not transpose easily to the protection of cultural expressions for source cultures. First, a collective expectation to be let alone may be difficult to establish within a source culture. Second, the collective must be able to demonstrate its exclusive identification with the expression. This is problematic for a source culture where others' goods and services are named after a place which is in turn named after the source culture. Once expressions become generic geographic words, the issue of public domain is often addressed in the context of geographical indications, such as the global campaign for the exclusive use of CHAMPAGNE.¹⁰⁵ CANADIAN CHAMPAGNE was found to have acquired a

100. G.H.L. Fridman, *The Law of Torts in Canada* (Toronto, Carswell, 2002), 697.

101. See n. 69 above. *Somwar v. McDonald's Restaurants of Canada Ltd* [2006] OJ No. 64 (Ontario SCJ) para. 12 (per Stinson J.): 'Based on Prosser's description of intrusion of privacy interests and Fridman's observations on treatment of "invasion of privacy" by courts, I conclude that the plaintiff's complaint concerning the invasion of his privacy could be categorized as an intentional tort.'

102. See n. 67 above.

103. R.B. Bruyer, 'Privacy: a review and critique of the literature' (2006) 43 *Alberta Law Review*, 553 at para. 89; R.M. Ryan Bell, 'Tort of Invasion of Privacy – has its time finally come?' in *Annual Review of Civil Litigation*, T.L. Archibald and M.G. Cochrane (eds) (Toronto, Carswell, 2004), 225 at 251.

104. D.J. Solove, 'A Taxonomy of Privacy' (2005–2006) 154 *University of Pennsylvania Law Review*, 477 at 549.

105. See also the Drinks Cases, n. 23 above; A. Corte-Real, 'The Conflict between Trade Marks and Geographical Indications – the Budweiser case in Portugal' in *New Frontiers of Intellectual Property Law: intellectual property and cultural heritage, geographical*

secondary meaning to refer to its trader in Canada.¹⁰⁶ Finally, the boundaries of the collective may not be as clear for a source culture as it would be for a group of commercial enterprises sharing a common interest in protecting their trade under a mark from passing-off. The issue of defining which individual's use and what type of use of a cultural expression should accrue to its source culture is far more complex and multi-dimensional.¹⁰⁷ Nonetheless, some source cultures have succeeded in gaining statutory protection for their cultural expressions.

The protection of identity signs for collectives is evident in subsections 9(1)(i) and (i.2) of the Canadian *Trade-marks Act* which implement parts of Article 6*ter* of the Paris Convention. These subsections prohibit the adoption 'in connection with a business, as a trade-mark or otherwise, any mark consisting of, or so nearly resembling as to be likely to be mistaken for', certain territorial or civic flag, certain national, territorial or civic arms, crest or emblem, [or any national flag of a member state of the Paris Convention. As mentioned, '[t]he reasons . . . are that such registration or use would violate the right of the State to control the use of symbols of its sovereignty and furthermore might mislead the public with respect to the origin of goods to which such marks would be applied.'¹⁰⁸ They concern not only trade, but also the use of the symbols of sovereignty and the dignitary interest and national honour affected by such use as trade marks or elements thereof.¹⁰⁹ The protection under Article 6*ter*(9) of the Paris Convention¹¹⁰ in respect of armorial bearings which may mislead, and that under section 9 of the *Trade-marks Act* are cast broadly to include not only use as trade marks but also other uses in trade, such as decorative trade uses. Thus the use need not be distinguishing, but merely distinctive of the source. Intention is not cited as an element. These prohibited marks must be made known but the exceptions flags of states are presumably already publicly known or knowable must be made known.¹¹¹ The exclusive access

indicators, enforcement, overprotection, C. Heath and A. Kamperman Sanders (eds) (Oxford, Hart Publishing, 2005), 149; S. Frankel, 'Trademarks and Traditional Knowledge and Cultural Intellectual Property', chapter 16 in *Trademark Law and Theory: a handbook of contemporary research*, G.B. Dinwoodie and M.D. Janis (eds) (Cheltenham, Edward Elgar, 2008, forthcoming).

106. *Institut national des appellations d'origine des vins et eaux-de-vie v. Andre Wines Ltd* (1990) 30 CPR (3d) 279 (Ontario CA) affirming (1987) 16 CPR (3d) 385 (Ontario HCJ). See also *Trade-marks Act* Subs. 11–18(3).
107. E.g. see Y.M. Donders, *Towards a Right to Cultural Identity?* (Antwerp, Intersentia, 2002), 10–11, 102, 204 et seq., 329 et seq.; H.P. Glenn, 'Continuity and Discontinuity of Aboriginal Entitlement' (Summer 2007) *Oxford University Commonwealth Law Journal*, 23.
108. G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as revised at Stockholm 1967* (United International Bureaux for the Protection of Intellectual Property (BIRPI) 2004), 96.
109. S.P. Ladas, *The International Protection of Industrial Property* (Cambridge, Harvard University Press, 1930), 562.
110. S.P. Ladas, *The International Protection of Industrial Property* (Cambridge, Harvard University Press, 1930), 566; G.H.C. Bodenhausen, *Guide to the Application of the Paris Convention for the Protection of Industrial Property as revised at Stockholm 1967* (United International Bureaux for the Protection of Intellectual Property (BIRPI) 2004), 103.
111. Art. 6*ter* (3)(a); *Trade-marks Act* ss 9(1)(i), (i.1), (1.3).

to the identity signs protected under Article 6ter of the Paris Convention as implemented in subsections 9(1)(i) and (i.2) of the Canadian *Trade-marks Act* is granted to collectives which are source cultures as defined by political boundaries.

In Canada, section 9(1)(n)(iii) of the *Trade-marks Act* is used to protect the Snuneymuxw First Nation's petroglyphs and other designs.¹¹² It is also used by the Nisga'a Nation for the protection of NISGA'A. For a similar rationale¹¹³ as for Article 6ter of the Paris Convention, the Canadian *Trade-marks Act* protects, from third party adoption for use in connection with a business, a mark adopted and used by a public authority as an official mark of which the Registrar has given public notice.¹¹⁴ All third-party business uses of an official mark are prohibited, as are such uses of marks 'consisting of, or so nearly resembling as to be likely to be mistaken for,'¹¹⁵ the official mark. Only resemblance to the official mark is considered a potential cause of confusion.¹¹⁶ The goods and services underlying the mark are not considered. The prohibition is therefore different from that against passing-off, and is closer to that against appropriation of personality. Unlike trade-marks,¹¹⁷ descriptive and confusing marks,¹¹⁸ including those descriptive of a collective, qualify for protection even if the marks have not acquired any secondary meaning. Official marks need not be distinctive of their source, and may not work in favour of source cultures. The Federal Court has remarked in *obiter* that '[i]t would be counterproductive to prohibit Jewish organizations and associations from using and adopting a mark such as the menorah, since it has always been historically associated with the Jewish culture.'¹¹⁹ It is unclear how subsections 9(1)(n)(iii) can prevent a public authority from claiming a mark which refers to a source culture unrelated to that authority.

The protection for cultural expressions as official marks is more limited than that potentially afforded under common law. First, the cost involved in applying for an official mark may be prohibitive, given the sheer number of potential cultural

112. Application numbers: 0910391, 0910393, 0910397, 0910394, 0910390, 0910398, 0910395, 0915023, 0910396, 0910392, 0909991. <<http://cipo.ic.gc.ca>>, 2 November 2007.

113. *Techniquip Ltd v. Canadian Olympic Assn* (1998) 80 CPR (3d) 225 (FCTD) 233 at para. 28, affirmed (1999) 3 CPR (4th) 298 (FCA) 303 at para. 13: 'These emblems, badges or crests are associated with public institutions, not involved in trade or business, but which nevertheless are deemed to be invested with respectability, credibility and other civic virtues. S. 9, in a sense, ensures that these symbols do not become pawns of trade or proprietorship.'

114. S. 11.

115. Subs. 9(1).

116. *Techniquip Ltd v. Canadian Olympic Assn* (1998) 80 CPR (3d) 225 (FCTD) 233 at para. 17, affirmed (1999) 3 CPR (4th) 298 (FCA) 303; *Canadian Council of Professional Engineers v. APA-Engineered Wood Assn* [2000] FCJ No. 1027 (FCTD) at para. 69–71: 'The words "consists of" in the subsection of the Act are to be interpreted to mean "identical to".'

117. E.g. for the mark CANADIAN for beer in *Carling Breweries Ltd. v. Molson Companies Ltd.* (1988), 19 CPR (3d) 129 (FCA).

118. *Ontario Assn of Architects v. Assn of Architectural Technologists of Ontario* (2002) 19 CPR (4th) 417 (FCA) at para. 63.

119. *Canadian Jewish Congress v. Chosen People Ministries, Inc.* (2002) 19 CPR (4th) 186 (FCTD) at para. 64, the issue was not addressed (2003) 27 CPR (4th) 193 (FCA).

expressions at stake.¹²⁰ Second, the prohibition is only against use in connection with a business.¹²¹ The social and personal uses of a cultural expression, for example for home or jewellery decoration, are not prohibited.¹²² Furthermore, the mark must have been adopted and used as an official mark prior to the registrar's publication of the section 9 notice;¹²³ the protection begins from the date of this notice.¹²⁴ Some cultural expressions, for example secret or sacred names and ancient petroglyphs carved at sacred locations, may not have been so adopted or used. A common feature of 'adoption' and 'use' is the element of public display.¹²⁵ Finally, to qualify as a public authority, the activities of the official mark applicant must be subject to a significant degree of control by the appropriate government and those activities must benefit the public.¹²⁶ In 1998, the Snuneymuxw First Nation cited the *Indian Act*¹²⁷ and case law in support of its claim to be a public authority: 'An Indian band council is an elected public authority, dependent on [the Canadian] Parliament for its existence, powers and responsibilities, whose essential function it is to exercise municipal and government power'.¹²⁸ Presumably, in support of the same, the 2001 NISGA'A official mark application file contains a press release concerning the royal assent of its treaty:

Today, the Nisga'a people become full-fledged Canadians as we step out from under the Indian Act – forever. Finally, after a struggle of more than 130 years,

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120. C. Bell and M. Solowan, 'A Selected Review of Canadian Legislation Affecting First Nation Cultural Heritage' (October 2004 Draft) 48 <www.law.ualberta.ca/research/aboriginalculturalheritage/researchpapers.htm>, 3 October 2007.
121. *Canadian Olympic Assn v. Konica Canada Inc.* (1991) 39 CPR (3d) 400 (FCA).
122. A.D. Morrow, 'Official Marks' in *Trade-marks Law of Canada*, G.H. Henderson (ed.) (Scarborough, Carswell Thomson Limited, 1993), 377 at 380; K. Gill and R.S. Jolliffe, *Fox on Canadian Law of Trade-marks and Unfair Competition* (4th edn, Toronto, Carswell Thomson Limited, 2003), 5–58.
123. *Big Sisters Assn of Ontario v. Big Brothers of Canada* (1997) 75 CPR (3d) 177 (FCTD) 222 affirmed (1999) 86 CPR (3d) 86 CPR (3d) 504 (FCA); *Techniquip Ltd v. Canadian Olympic Assn* (1998) 80 CPR (3d) 225 (FCTD) 233 at para. 30–31 affirmed (1999) 3 CPR (4th) 298 (FCA) 303 at para. 13; See *You In – Canadian Athletes Fund Corporation v. Canadian Olympic Committee* [2007] FCJ No. 541 (FC).
124. *Canadian Olympic Assn v. Konica Canada Inc.* (1992) 39 CPR (3d) 400 (FCA) at para. 21–23; *Ontario Assn of Architects v. Assn of Architectural Technologists of Ontario* (2002) 19 CPR (4th) 417 (FCA) at para. 34.
125. See *You In – Canadian Athletes Fund Corporation v. Canadian Olympic Committee* [2007] FCJ No. 541 (FC) at para. 48.
126. *Canadian Jewish Congress v. Chosen People Ministries, Inc* (2002) 19 CPR (4th) 186 (FCTD) at paras 52–58 affirmed (2003) 27 CPR (4th) 193 (FCA); Canadian Intellectual Property Office Practice Notice 'Official Marks pursuant to Sub-paragraph 9(1)(n)(iii)' 22 August 2007 <http://strategis.gc.ca/sc_mrksv/cipo/tm/tm_notice/tmn2007-08-22-e.html>, 3 October 2007.
127. RSC 1985 c. I – 5.
128. *Whitebear Band Council v. Carpenters Provincial Council of Saskatchewan* [1982] 3 WWR 554 at 560–561 (CA) as cited in a letter dated 3 July 1998 from M. Browne, barrister and solicitor for the Snuneymuxw First Nation to the Canadian Intellectual Property Office, on file as at 9 October 2007.

the government of this country clearly recognizes that the Nisga'a were a self-governing people since well before European contact. We remain self-governing today, and we are proud to say that this inherent right is now clearly recognized and protected in the Constitution of Canada.¹²⁹

It remains unclear how this self-governing status would fulfill the current requirement for an official mark: that the applicant public authority must be under a significant degree of control by a Canadian government.¹³⁰ The common law is, however, indifferent to the status of such sovereignty or autonomy of its subjects.

VIII. CONCLUSION

As demonstrated above, the common law shows potential for the protection of certain cultural expressions. Freed from the requirement for application within a context of trade and the requirement for a common field of activity between the parties, the law of passing-off would be capable of protecting such expressions where they attract sufficient goodwill within the relevant public. Public confusion or likelihood of confusion and harm or likelihood of harm to the plaintiff also need to be proven. The confusion or likelihood of confusion required is no longer that of the source or the quality or character of the goods or services, but also that of an association between the contending parties. While the user's intention is not an element of the tort, it is often considered. In this context, the use of a mark such as CHEROKEE, broadly known to North Americans as the name for an indigenous nation, on automobiles may cause confusion that the indigenous nation is endorsing the automobiles which underlie the mark. However, the law of passing-off is not of any assistance where no public confusion is caused or likely caused by such use.

The evolving tort of appropriation of personality may offer further protection. The tort does not require goodwill, or even that the cultural expression be distinguishing of the source, but merely distinctive of it. The tort can therefore, subject to public domain and other public policy concerns, shelter cultural expressions such as CHEROKEE, NISKA and Snuneymuwx petroglyphs where their identities play a specific role in the third-party use and the use is likely to cause harm to the source culture. While the role of the user's intention remains unclear in the tort, where the source of the expression and the offence in its use are well publicized and substantiated, the user's intention may be inferred. Alternatively, the reasonableness

129. Statement by Nisga'a Chief Joseph Gosnell in the press release 'Historic Nisga'a Treaty Ratified; Receives Royal Assent' (13 April 2000) in the NISGA'A official mark application file at the Canadian Intellectual Property Office as at 11 October 2007. S. 42 of the Nisga'a Final Agreement which became the Nisga'a Treaty read: 'Except as provided for by federal or provincial law, Nisga'a Lisims Government jurisdiction under paragraph 41 to make laws in respect of Nisga'a culture and Nisga'a language does not include jurisdiction to make laws in respect of intellectual property . . . or the prohibition of activities outside of Nisga'a Lands.' <www.ainc-inac.gc.ca/pr/agr/nsga/nisdex8_e.pdf>, 25 October 2007.

130. *United States Postal Service v. Canada Post Corporation* (2007) 54 CPR (4th) 121 (FCA).

of the use may be assessed in this light. One reasonable use guided by the public policy favouring the freedom of information and of expression is that of POCAHONTAS in the portrayal of the historical figure.

Finally, while the tort of appropriation of personality is articulated as one aspect of privacy right under Prosser's model, the privacy right under his model may also protect the Snuneymuxw petroglyphs from false light and protect secret cultural expressions from disclosure. The privacy right under common law, however, awaits further definition as it emerges from the shadows of other established torts and statutory privacy rights.

In the light of these common law torts, the law against passing-off appears to have the capacity to reach beyond the pecuniary interests which gave the law its initial recognition. For cultural expressions and their underlying cultural narratives, meanings, and values, other interests are also at stake. These interests include the public and self-perception of the source cultures. These perceptions nourish a sense of community within a people and a sense of identity for the people. A seamless common law which addresses these interests holistically and fluidly from passing-off to appropriation of personality to privacy may be achievable. Meanwhile, the interests represented in the four scenarios above may inform the footing upon which the common law may develop in the broader context to apportion the right for individuals as well as for source cultures to the symbols of their sovereignty, at least in respect of their identity and their heritage.

Chapter 15

Geographical Indications and Human Rights

*Dev Gangjee**

I. INTRODUCTION

Geographical Indications (GIs) are a notoriously controversial addition to the Intellectual Property canon. While a flute of Champagne or cup of Darjeeling is usually well met, the international legal regime governing the use and misuse of these product designations remains unpalatable to many. To the extent that consensus exists, there is agreement that a GI is a sign with an actual or potential commercially valuable reputation. This portrayal has evident similarities with trade marks, suggesting that parallels may be drawn with the interaction between human rights and trade mark law. However it is the divergence between the distinct regimes governing GIs and trade marks, based upon the link between product and place, which is of far greater interest. In this chapter I trace the emergence of a cultural heritage preservation argument in international GI discourse, which is used as a partial justification for both the basis and scope of protection. This trend is significant because it marks a departure from the dominant discourse of unfair competition prevention, which has otherwise grounded as well as constrained the international GI regime for over a century. An emerging narrative posits that to the

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extent that GI labelled products are cultural artefacts, the protection of these signs is normatively defensible as it sustains cultural diversity. Enabling such diversity is a crucial aspect of preserving distinct cultural identities and therefore an important goal of human rights instruments concerned with cultural rights. The aim here is to set out these innovative claims against the broader backdrop of the law regulating GIs, while exploring key implications for the basis of GI protection.

II. GEOGRAPHICAL INDICATIONS AS THE OBJECTS OF INTELLECTUAL PROPERTY LAW

II.A WHAT IS A GEOGRAPHICAL INDICATION?

This section briefly sketches the story so far. A GI is a sign indicating a product's specific geographical origin and information associated with that origin. Article 22.1 of the Trade Related Agreement on Intellectual Property Rights (TRIPS) stipulates that

Geographical indications are, for the purposes of this Agreement, indications which *identify* a good as originating in the territory of a Member, or a region or locality in that territory, where a given *quality, reputation or other characteristic* of the good is *essentially attributable to its geographical origin*. (emphasis added)

Unlike a trade marked product's commercial origin that may vary over time and place, a GI such as Bordeaux or Prosciutto di Parma is prescriptively embedded in a particular geographical locale. The 'substance of the concept' of GIs is that they are 'used to demonstrate a link between the origin of the product to which it is applied and a given quality, reputation or other characteristic that the product derives from that origin'.¹ The connoisseur will buy (or avoid, depending on preferences) Champagne precisely because of its regional provenance. Consequently the legal regulation of GIs was premised upon enabling this marketplace signalling function. Both the law of trade marks and that of GIs have therefore emerged as distinct regimes for preventing unfair competition between marketplace rivals, by preventing unwarranted interference with the messages contained in such signs.²

The conventional account holds that protecting the communicative integrity of trade marks and GIs serves a dual purpose. By granting exclusive rights to the sign, consumer deception or confusion as to origin is prevented, while simultaneously shielding legitimate producers against a particular species of unfair competition.³

1. WIPO 'The Definition of Geographical Indications' 1 October 2002 (SCT/9/4) at para. 4.
2. In Europe there is an enduring view that GI protection is a subset of Unfair Competition law. See E. Ulmer 'Unfair Competition Law in the European Economic Community' [1973] *IIC* 188, 199–200; F. Henning-Bodewig & G. Schricker 'New Initiatives for the Harmonisation of Unfair Competition Law in Europe' [2002] *EIPR* 271: 273; C Wadlow 'Unfair Competition in Community Law – Part 1: The Age of the "Classical Model"' [2006] *EIPR* :433, 440.
3. This is the standard account in Anglo-American trademark jurisprudence. See generally W.R. Cornish & D. Llewelyn *Intellectual Property* 5th edn, (Sweet & Maxwell London 2003),

An instrumentalist account by the Chicago School is the predominant theoretical justification for this exclusivity, in a marketplace characterized by information asymmetries between producers and consumers.⁴ Trade marks enhance efficiency. They lessen consumer search costs by making products easier to identify in the marketplace, while encouraging producers to invest in improving or maintaining levels of quality by ensuring that they, and not their rivals, reap the reputational rewards of that investment. In order to preserve the communicative integrity of the sign, its use by others should therefore be restricted. The little that exists in the GI literature suggests a similar economic rationale,⁵ with the added dimension of GIs exhibiting features of club goods, whereby the exclusivity is enjoyed by a collective entity. Where a collective reputation is at stake, institutional mechanisms are required to set and police common standards of production, ensuring that competing members will co-operate to maintain quality. Otherwise in light of their functional similarity, instrumentalist theory accounts for the right to exclude in a congruent manner.

II.B SIMILARITIES WITH TRADE MARKS

Accordingly, countries such as the US propose that since GIs and trade marks share an apparent functional equivalence, the former regime should be merged into the latter. GIs 'can be viewed as a subset of trade marks. [They] serve the same functions as trade marks, because like trade marks they are: 1) source-identifiers, 2) guarantees of quality, and 3) valuable business interests'.⁶ The US argues that 'both aim to prevent consumers from being misled or confused as to whether the goods they buy possess the anticipated qualities and characteristics'.⁷ This

586–587; J.T. McCarthy *McCarthy on Trademarks and Unfair Competition* 4th edn, (West Group St Paul 2006), Ch. 3. The European Court of Justice has echoed this sentiment for GIs on several occasions: See e.g. *Commission v. Germany* (C-12/74) [1975] ECR 181: 7, ('[T]hese appellations . . . must satisfy the objectives of such protection, in particular the need to ensure not only that the interests of the producers concerned are safeguarded against unfair competition, but also that consumers are protected against information which may mislead them.').

4. W.M. Landes & R.A. Posner 'Trademark Law: An Economic Perspective' (1987) 30 *JL & Econ* 265; N. Economides 'The Economics of Trademarks' (1988) *Trademark Rep* 523.
5. See OECD *Appellations of Origin and Geographical Indications in OECD Member Countries: Economic and Legal Implications* (December 2000) COM/AGR/APM/TD/WP(2000)15/FINAL 7–8, 31–34; D. Rangnekar *The Socio-Economics of Geographical Indications: A Review of the Empirical Evidence from Europe* (UNCTA/ICTSD Issue Paper No. 4, May 2004), 13–16; W. van Caenegem 'Registered Geographical Indications: Between Rural Policy and Intellectual Property – Part I' (2003) 6 *J World Intell Prop* 699: 709–710. However as we will see *below*, historical debates addressing GI protection contain a persistent misappropriation prohibition seam. This does not sit comfortably with the purely communicative and consumer orientated model espoused by law and economics analysis, at least as an accurate descriptive proposition.
6. See USPTO 'Geographical Indication Protection in the United States' at <www.uspto.gov/web/offices/dcom/olia/globalip/pdf/gi_system.pdf> (last accessed 21 April 2008).
7. *EC – Protection of Trademarks and Geographical Indications for Agricultural Products and Foodstuffs* First Submission of the United States, 23 April 2004 (WT/DS174 and 290), para. 132.

correspondence has been appreciated by European courts as well. The Swiss Federal Court of Justice has observed that the ‘function both of trade mark protection and of protection for appellations of origin is to ensure the distinguishing function of the designation and to prevent mistaken attributions – whether regarding the manufacturer or the place of origin’.⁸ Several countries have opted to protect GIs within the trade mark system as certification marks or collective marks.⁹ By implication this suggests that issues arising out of the interaction between trade mark law and human rights would map on to GIs as well.

While the principal focus of this contribution is to consider the human rights implications for GIs as a *sui generis* regime, I shall briefly consider the extent to which the GI-trade mark overlap is relevant. Regarding the nature of this interaction, Laurence Helfer has identified three trends:¹⁰ (1) human rights language is co-opted to expand the scope of IP; (2) human rights law is an externally imposed limit upon the scope of IP protection; and (3) achieving human rights ends through IP means, where a desirable outcome such as improved public health is furthered by an appropriately crafted IP regime. Although each of these trends is visible in the human rights-trade marks interface, the ‘conflict or coexistence’ polarization¹¹ is more prominent. Much of this concerns the impact of trade mark rights upon the right to free speech and expression.¹² The impact of GI protection on commercial speech is unexplored, but could inter alia arise in the context of a generic status determination. By declaring a formerly generic term to be a protected expression (such as parmesan for a type of cheese in several countries outside the EU), this would deny external producers the use of the term, thereby placing limits on commercial speech.

Apart from speech related concerns, there are human rights repercussions associated with the treatment of trade mark rights as property.¹³ GIs have been questionably categorized as ‘private rights’ in the preamble to TRIPS¹⁴ and this taxonomic status has important repercussions in a ‘takings’ situation. The

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8. *Anheuser-Busch Inc v. Budejovicky Budvar Narodni Podnik* [2001] *ETMR* 7 (Swiss FC) 82.
 9. WTO *Review under Art. 24.2 of the Application of the Provisions of the Section of the TRIPS Agreement on Geographical Indications*, 24 November 2003 (IP/C/W/253/Rev.1), 13–14.
 10. L.R. Helfer ‘Toward a Human Rights Framework for Intellectual Property’ (2007) 40 *UC Davis L Rev* 971: 1014–1020.
 11. P. Torremans ‘Copyright as a Human Right’ in P Torremans (ed.) *Copyright and Human Rights: Freedom of Expression – Intellectual Property – Privacy*, (Kluwer, The Hague 2004) 1, 2–3; L.R. Helfer ‘Human Rights and Intellectual Property: Conflict or Coexistence?’ (2003) 5 *Minn. Intell. Prop. Rev.* 47: 48–49.
 12. See generally the contribution by Andreas Rahmation ‘Trade Marks and Human Rights’ in Ch. 13 of this volume.
 13. The matter was recently considered by the European Court of Human Rights in *Anheuser-Busch, Inc. v. Portugal*, Application No. 73049/01 (Grand Chamber, 2007).
 14. For the objections to classifying rights to GIs as private property, see D. Gangjee ‘Quibbling Siblings: Conflicts between Trade Marks and Geographical Indications’ (2007) 82 *Chicago Kent L Rev* 1253: 1256–1257.

expropriation of a GI by state action could lead to demands for compensation for the loss of a proprietary interest. This argument was unsuccessfully rehearsed in the European Court of Justice's (ECJ) *Tocai* decision.¹⁵ An agreement between the Community and Hungary meant that the use of the Italian grape variety '*Tocai friulano*' would have to give way to the Hungarian appellation '*Tokaj*'. In the challenge to the Italian law which implemented this, a central issue was whether the law was inconsistent with the right of ownership protected by the ECHR and the Charter of Fundamental Rights of the EU. While deciding that a grape varietal designation is not the same as a GI, the court nevertheless did consider this within the recognized category of 'incorporeal goods of economic value'. On this issue the deprivation was reasonable and not disproportionate. Italian wine could continue to be marketed using regional appellations and alternative names for the grape varietal.

The references to rights engaging speech and property suggest that to the extent that GIs are functional isomorphs of trade marks, human rights law is engaged in equivalent ways. Yet of far greater interest is the potential for normative human rights based argument to sustain a *sui generis* GI protection regime and its transformation of the manner in which GIs have been historically conceptualized thus far.

II.C DIFFERENCES IN SCOPE

At the risk of oversimplifying, the history of international GI protection can be depicted as a sequence of episodic attempts to break away from the limitations of a misrepresentation prevention regime of protection. Prior to TRIPS, three multilateral agreements administered by the World Intellectual Property Organization (WIPO) addressed the protection of GIs. These not only set the parameters for subsequent negotiations but also introduced two very different definitional visions – the Indication of Source (IS), corresponding to a minimalist account of protection and the Appellation of Origin (AO), which generates a more elaborate, registration based architecture. The Paris Convention for the Protection of Industrial Property of 1883¹⁶ introduces both in its description of industrial property,¹⁷ but regulates only the former. WIPO's suggested definition for the IS is an 'expression or sign used to indicate that a product or service originates in a country, region or specified place'.¹⁸ Article 10 of the Paris Convention prohibits the use of signs which are false indications of source, through border measures such as

15. *Regione autonoma Friuli-Venezia Giulia v. Ministero delle Politiche Agricole e Forestali* (C-347/03) [2005] ECR I-3785.

16. The Paris Convention for the Protection of Industrial Property, 20 March 1883 as revised at Stockholm on 14 July 1967, 828 UNTS 305 (1972). (Hereinafter, the Paris Convention). Also at <www.wipo.int/treaties/on/ip/paris>, (last accessed 21 April 2008).

17. See Art. 1(2).

18. In s.1 of the WIPO *Model Law for Developing Countries on Appellations of Origin and Indications of Source*.

seizure by customs authorities to prevent the movement of goods which are falsely labelled. By the end of the nineteenth century, the limitations of protection premised on the communicative content of the sign became painfully obvious to GI proponents. If the test for infringement is consumer confusion or deception, it cannot apply where the sign in question becomes generic (as Champagne is in the US), where the relevant public are unfamiliar with the product (such as traditional Bangladeshi textiles replicated externally and sold on the Australian market) or the use of the sign is qualified to avoid deception as to origin or quality ('Swiss Champagne' or 'Roquefort style cheese'). The AO subsequently emerges as a response to the limitations of a truth-telling model, with its restricted consumer protection rationale.

The Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods of 1891¹⁹ marks the transition from the IS to the AO. While marginally extending the scope of protection for the IS,²⁰ it more significantly afforded higher levels of protection for products of the vine.²¹ Finally, the Lisbon Agreement for the Protection of Appellations of Origin of 1958²² established an international registration system for AOs.²³ The AO is defined in Article 2(1) as

[T]he geographical name of a country, region, or locality, which serves to designate a product originating therein, the quality and characteristics of which are due exclusively or essentially to the geographical environment, including natural and human factors.

Both the Madrid and Lisbon Agreements introduce the notion of a link between the qualities of the product and its geographical environment, including both natural and human influences, which is what sets apart GIs as the objects of a discrete IP regime. Building on this distinctive anchor to place, Article 3 of Lisbon sets out property-like standards of protection by doing away with a 'false or misleading use' requirement and preventing misappropriation of goodwill even in the absence of consumer confusion:

Protection shall be ensured against any usurpation or imitation, even if the true origin of the product is indicated or if the appellation is used in translated form or accompanied by terms such as 'kind', 'type', 'make', 'imitation', or the like.

19. Madrid Agreement for the Repression of False or Deceptive Indications of Source on Goods 14 April 1891, 828 UNTS 389 (Hereinafter, the Madrid Agreement). Also at <www.wipo.org/treaties/en/ip/mmopecd/>, (last accessed 21 April 2008).

20. Art. 1(1) of Madrid states that: 'All goods bearing a false or deceptive indication by which one of the countries to which this Agreement applies, or a place situated therein, is directly or indirectly indicated as being the country or place of origin shall be seized on importation into any of the said countries'.

21. The hard-earned innovation is found in Art. 4, which effectively states that products of the vine may not become generic.

22. Lisbon Agreement for the Protection of Appellations of Origin and their International Registration 31 October 1958, 923 UNTS 205 (Hereinafter, the Lisbon Agreement). Also at <www.wipo.int/treaties/en/registration/lisbon/>, (last accessed 21 April 2008).

23. The register can be searched at: <www.wipo.int/ipdl/en/search/lisbon/search-struct.jsp>.

The legal assumptions underpinning such *sui generis* protection have historically been informed by French experiences with viti-cultural regulation. Rules have accreted around the influential notion of *terroir*, with products of the vine as the archetypal subject matter for GI protection.²⁴ *Terroir* is a key ingredient in differentiating between wines by reference to a distinct origin. It influences quality and in so doing shapes the reputation of the wine. In its more geographically deterministic iteration, this concept suggests that the human and physical geography of a discrete region shapes a product's qualities, making it impossible to faithfully replicate the product elsewhere. This view also finds traction with courts on occasion:

The two features of Champagne of prime importance for its uniqueness are the soil and climate in which the grapes are grown, and the method of manufacture by skilled personnel. The first of those elements cannot be exactly duplicated anywhere in the world, but the second can. It apparently is generally recognised among wine experts that the precise geographical location (i.e. soil and climate) for the growing of a vine is the outstanding, unchanging factor which governs the final product. Hence the predominance of place names for appellations.²⁵

and:

The region in which the Champagne vineyards are found is about one hundred miles east of Paris around Reims and Épernay, where there is a chalky, flinty soil and the climate is subject to extreme variations of heat and cold. It appears that these factors give to the wine its particular qualities.²⁶

Assuming geographically deterministic *terroir* holds true, referring to an external product by the original's name is therefore a wrongful act, either because it misleads consumers into believing the original and replica are substitutable (that is, based on its effect on consumers) or because the external producer has illegitimately misappropriated the name, knowing that her product does not share the same history and qualities (that is, based on producer conduct).

The contested essence of this unique link argument is summarized in a League of Nations Report as early as 1922:

[It is argued that] some products of the vine derive their special qualities from the peculiar characteristics of the soil or climate of one particular district, and are therefore inherently incapable of being produced of the same quality elsewhere. So far as this is really true, the particular district in which they are produced may be said to have an absolute natural monopoly of their production, and it would seem that any geographical appellation in their

24. See D. Gangjee *Relocating Geographical Indications: A Response to Bronwyn Parry* in L. Bently, J. Davis and J. Ginsburg (eds) *Trade Marks and Brands: An Interdisciplinary Critique* (CUP, Cambridge 2008) [Forthcoming]

25. 'Comite Interprofessionnel du Vin de Champagne v. Wineworths Group Ltd' [1991] 2 NZLR 432 at para. 10 (Wellington HC).

26. '*J Bollinger v. Costa Brava Wine Co Ltd*' [1961] 1 All ER 561, 563 (Ch. D) (J. Danckwerts).

title can never be employed properly in a ‘generic’ sense as the result of use or custom. Unfortunately, there is not always general agreement either as to the fact of the regional monopoly or as to the limits of the area possessing such monopoly. There is a natural tendency to exaggerate the view that the special qualities of a wine are in reality a ‘regional’ monopoly, and in many cases there has been keen dispute as to the limits of the area (if it exists) which is alone capable of producing a speciality.²⁷

The legacy of these competing visions helps explain the apparent incongruity in TRIPs today. The agreement contains a single definition for GIs in Article 22.1, but two distinct levels of protection. Under Article 22, the scope of protection consists of the following three components:

- protection against uses of indications that mislead the public²⁸ or are false despite being literally true;²⁹
- protection against uses of indications where this amounts to acts of unfair competition;³⁰ and
- refusal or invalidation of trade marks that contain or consist of indications, where they may mislead the public.³¹

This clutch of substantive rules seeks to preserve the integrity of consumer information by preventing misleading use, while also protecting producer goodwill and thereby enabling product differentiation in the marketplace. By contrast protection for wines and spirits is significantly stronger and is referred to as ‘absolute’ protection. There are three commitments involved here:

- Members shall provide the legal means for interested parties to prevent the use of GIs for wines and spirits on such products when they do not originate in the designated place, ‘even where the true origin of the goods is indicated or the [GI] is used in translation or accompanied by expressions such as “kind”, “type”, “style”, “imitation” or the like’.³²
- Trade marks which contain or consist of such GIs shall be refused or invalidated for wines and spirits which do not have this origin.³³
- Coexistence in the case of homonymous indications for wines and spirits provided misleading uses are controlled for.³⁴

What remains conspicuously absent is any legislative or doctrinal explanation addressing the existence of these two levels. This explanatory gap continues to

27. Report on Unfair Competition, Particularly in Relation to False Marks and Indications [1922] League of Nations Official Journal 625, 630.

28. Art. 22.2(a).

29. Art. 22.4.

30. Art. 22.2(b).

31. Art. 22.3.

32. Art. 23.1.

33. Art. 23.2.

34. Art. 23.3.

obstruct progress for those who propose that Article 23 standards should be applied beyond the restrictive confines of wines and spirits to all products.

If GIs are to be protected against any references on similar goods even in the absence of consumer confusion or deception, there are limitations on the ability of physically deterministic *terroir* to justify such absolute protection. There is no disputing the importance of geographical origin for certain products such as wines, mineral water or even fruits and vegetables. However the range of products covered by national or even international GI regimes extends to traditional crafts, textiles and jewellery, where human skills are of far greater significance. Thus the majority of registrations pending before India's national GI Registry consist of traditional crafts and textile products,³⁵ while the international Lisbon register includes 'Olinalá' for wooden handcrafted objects, 'Jablonec' (or 'Gablonz') for utility and decorative glassware, and 'Kraslické Krajky' for embroidery and lace goods.³⁶ Such products are of greater relevance to many of the developing countries lobbying for greater GI protection as the human skills dimension gains in importance.

III. GEOGRAPHICAL INDICATIONS AND CULTURAL HERITAGE

There are several indications that the intertwined themes of cultural heritage preservation and rewarding traditional knowledge are powerful motivating factors for demandeurs proponents of GI extension at the WTO. Some argue that calls for GI extension 'emerged as a reaction to concerns of an ever greater number of countries to promote their goods which are fruits of their culture and know how and their unique blend of soil, water and climate'.³⁷ Proponents once again resort to *terroir* language, but this time the human element is acknowledged. 'The geographical origin confers, whether due to natural or human factors, intrinsic qualities to a good which a similar product without this origin will not have.'³⁸ GIs could be based on local human factors such as manufacturing techniques or a traditional production method. If local producers had a reputation for a production method which they had developed over time, it was their legitimate right to enjoy the benefits of it.³⁹ These aspects find mention in official policy documents, legal decisions and academic writing on GIs, where they are offered as additional reasons for protecting such signs.⁴⁰ Yet there is little

35. These product specifications are available in the Indian Geographical Indications Journal. "For further details on the registry, see <www.patentoffice.nic.in>, (last accessed 21 April 2008). For specific illustrations see NS Gopalakrishnan et al *Exploring the Relationship between Geographical Indication and Traditional Knowledge* (ICTSD Working Paper, August 2007)."

36. See respectively Lisbon Registration Nos. 732, 66 and 22.

37. (WT/GC/W/206) at para. 1.

38. Bulgaria et al (IP/C/W/247/Rev.1) at para. 16.

39. See e.g. (IP/C/W/353) at para. 6; (IP/C/M/35) at para. 165.

40. See generally Rhonda Chesmond 'Protection or Privatisation of Culture? The Cultural Dimension of the International Intellectual Property Debate on Geographical Indications of Origin' [2007] EIPR 379

elaboration of how they are to be incorporated into a legal framework erected upon the doctrinal premises of unfair competition law, with its principal focus being the regulation of signs based on truthful usage. One possibility is that cultural heritage preservation could account for Article 23 standards being applied beyond merely wines and spirits, for appropriately qualified products.

This possibility is presently being explored in WTO discussions. The WTO Review of national GI legislation emphasizes ‘human creativity and human factors’ as one of the major criteria which determine eligibility for protection. Members ‘have highlighted the relevance of human factors to matters such as quality, traditional methods of production, vini-cultural practices and methods of production, preparation and cultivation.’⁴¹ Switzerland noted that as opposed to private trade marks rights, GIs ‘form part of the national, cantonal or communal heritage’.⁴² Whilst introducing its *sui generis* GI legislation, India stated that a GI ‘is considered under the act to be the property or heritage of all the persons engaged in the activity of creating [such] products’.⁴³ The Representative from Thailand supported extending GI protection since ‘GIs were often related to culture and ancestors’ traditional knowledge’.⁴⁴ Over the course of discussions on whether the extend the scope of international GI protection, it has been argued that the

implication that the efforts invested in the reputation of any famous product in relation to its geographical origin would not be creative failed to recognize that sometimes this reputation was based on decades or even centuries of creativity, including in the development of traditional knowledge.⁴⁵

However such cultural claims have also been challenged. Since some members had large immigrant populations ‘who had brought with them their cultural traditions, including names and terms, it would be culturally insensitive . . . to try to claim back terms that had been used for decades without being contested . . . Immigrants’ customs were acquired rights which Members could not wipe out in the course of negotiations’.⁴⁶ GI proponents respond by suggesting that existing safety valves including the generic exception and grandfathering would incorporate these concerns, while prospectively ‘the names of the teas, coffees, rice, bananas, carpets and handicrafts of the proponents were at stake [as was the] cultural heritage that GI extension sought to protect’.⁴⁷

This rendering of GI products as symbols of heritage is increasingly circulating in policy debates. The European Commission advocates the position that ‘GIs are key to EU and developing countries cultural heritage, traditional methods of

41. *WTO Review under Art. 24.2*, 24 November 2003 (IP/C/W/253/Rev.1) at para. 44.

42. *Review under Art. 24.2 – Switzerland’s Response to the Checklist*, 16 February 1999 (IP/C/W/117/Add.13) 10 at footnote 11.

43. See the response to Q.13 in *Review of Legislation – India*, 8 October 2003 (IP/Q/IND/1).

44. *TRIPs Council Special Session on GI Extension*, November and December 2002 (IP/C/M/38) at para. 180.

45. *Compilations of Issues Raised and Views Expressed*, 18 May 2005 (TN/C/W/25) at para. 13.

46. *Ibid.* at para. 14.

47. *Ibid.*

production and natural resources'.⁴⁸ Judicial opinions also provide an occasional glimpse of this aspect when they refer to the traditional know how of a local community of practice.⁴⁹ Tomer Broude proposes that GI products are viewed as cultural artefacts in three overlapping ways via the culture of consumption, the culture of production or the culture of identity.⁵⁰ The latter two are more significant for our purposes. Where the method of production ordains it with cultural value, preserving this method of production and the associated lifestyle is important. Traditional crafts would be a good example. When an object is related to the culture of identity, it is representative of a cultural value that is associated with the relevant group's identity. National flags epitomize this category of objects and some GIs are not far behind.⁵¹ A further and relatively unexplored possibility is that GIs, by laying down traditional production methods in registration specifications, help preserve cultural landscapes.⁵² According to Janet Blake, physical elements of cultural heritage are the vehicles by which this heritage, in its intangible sense, is conveyed between generations.⁵³ In this context heritage is understood to be a form of inheritance, which is to be kept in safekeeping, and handed down to future generations. Thus, such objects serve both as symbols of a group identity and as essential elements in inter-generationally constructing that very group identity.⁵⁴ The desirable result is varied communities and cultural diversity. A certain degree of control over objects and associated signs representing the intangible heritage may therefore prove vital for the political purposes of reinforcing identity.

Although the Right to Culture has not been articulated as a free standing human right, several international and regional human rights instruments refer

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48. EC 'Why do Geographical Indications Matter to Us?' (Brussels, 30 July 2003) at <http://ec.europa.eu/trade/issues/sectoral/intell_property/argu_en.htm>.
49. There is an extended treatment of the cottage industry nature of hand woven 'Harris Tweed' and its development over several centuries in *Argyllshire Weavers Ltd v. A Macaulay (Tweeds) Ltd* [1965] *SLT* 21, 24–26 (OH). As part of the *Feta* litigation, Advocate General Colomer surveyed literary references in Greek, Spanish, French and Italian, finally observing: 'Cheese forms part of western food and culture. It is often mentioned in the great works of literature.' *Canadane Cheese Trading v. Hellenic Republic* (C-317/95) [1997] *ECR I-4681* at [10] (AGO).
50. Tomer Broude 'Taking "Trade and Culture" Seriously: Geographical Indications and Cultural Protection in WTO Law' (2005) 26 *U Penn J of International Economic Law* 623. However Broude is critical of attempts to construct a cultural heritage rationale for GI protection.
51. The Peruvian National Institute of Culture has declared 'Pisco' to be part of the National Cultural Heritage. See <www.peruembassy-uk.com/art_culture/pisco_history_english.pdf>, (last accessed 21 April 2008). See also K. M. Guy *When Champagne Became French: Wine and the Making of a National Identity* (Johns Hopkins University Press, Baltimore 2003).
52. On the preservation of cultural landscapes by maintaining traditional production methods, see I.B. Thompson 'The Role of Artisan Technology and Indigenous Knowledge Transfer in the Survival of a Classic Cultural Landscape: The *Marais Salants* of Gu erande, Loire-Atlantique, France' (1999) 25 *Journal of Historical Geography* 216.
53. J. Blake 'On Defining the Cultural Heritage' (2000) 49 *ICLQ* 61, 74.
54. Blake concludes that understood in this sense, heritage is more of a quality and less of an objective physical reality. *Ibid.* 83–84.

to it.⁵⁵ The relationship between culture and human rights is nuanced, the two forming an oppositional dyad in some situations (such as where a cultural practice offends human rights values) while enjoying a symbiotic relationship in others.⁵⁶ Given the recent emergence of a seam of heritage preservation arguments in GI debates as a method of rationalizing enhanced protection, GI proponents would benefit from engaging with related developments in the domain of international cultural heritage protection. I will briefly consider the three most promising instruments here. The first is the reference to culture in the Covenant on Economic, Social and Cultural Rights.⁵⁷ Enhanced GI protection would be one of the methods by which States could fulfil their obligations under this instrument. An additional space is created by the Convention for the Safeguarding of the Intangible Cultural Heritage.⁵⁸ Here the preservation of heritage relates to an established cultural identity. According to Ziegler, ‘the concept goes beyond protecting tangible objects of objectively or universally recognised “high culture”. It also comprises individually or collectively subjectively relevant, intangible forms of cultural expressions . . . provided that they are recognised by a community or individual “as part of their cultural heritage”’.⁵⁹ The Convention’s definition of the ‘intangible cultural heritage’ resonates strongly with the archetypal notion of a GI product:

‘The “intangible cultural heritage” means the practices, representations, expressions, knowledge, skills – as well as the instruments, objects, artefacts and cultural spaces associated therewith – that communities, groups and, in some cases, individuals recognize as part of their cultural heritage. This intangible cultural heritage, transmitted from generation to generation, is constantly recreated by communities and groups in response to their environment, their interaction with nature and their history, and provides them with a sense of identity and continuity, thus promoting respect for cultural diversity and human creativity.’⁶⁰

The third resource is yet another potentially binding treaty; UNESCO’s Convention on the Protection and Promotion of the Diversity of Cultural Expressions.⁶¹

55. For a convenient summary, see M. Hadjiouannou ‘The International Human Right to Culture: Reclamation of the Cultural Identities of Indigenous Peoples under International Law’ (2005) 8 *Chapman L Rev* 201.

56. See K. Ziegler *Cultural Heritage and Human Rights* (Oxford Legal Studies Research Paper Series; No. 26/2007).

57. As set out in Arts 1 and 15 of the International Covenant on Economic, Social and Cultural Rights G.A. Res. 2200 (XXI), UN Doc A/6316 (1966), 993 *UNTS* 3, entered into force 3 January 1976.

58. Convention for the Safeguarding of the Intangible Cultural Heritage, 17 October 2003, UN Doc MISC/2003/CLT/CH/14 (2003), at: <<http://unesdoc.unesco.org/images/0013/001325/132540e.pdf>>.

59. Ziegler (n. 56) at 5.

60. See Art. 2(1).

61. Convention on the Protection and Promotion of the Diversity of Cultural Expressions was adopted on 20 October 2005 by the General Conference of the United Nations Educational, Scientific and Cultural Organization (UNESCO).

While these instruments are avenues worth exploring, some of the more obvious objections to this cultural turn in GI law arise from setting the threshold benchmarks. How does one define the cultural group? Do traditional production methods have to be frozen in time or are innovations permitted? Given the rhetoric of artisanal production, to what extent is modern technology acceptable? And what if the profile of producers changes, such as Californian winemakers buying up French vineyards or the employment of itinerant students for grape harvesting as rural French populations are depleted? It may be possible to construct an argument whereby the GI designation acts as a symbol of collective identity, but this is far from unopposed and not all GIs will satisfy these requirements.

IV. CONCLUSION

GIs have traditionally been conceived as signs operating in the marketplace and their legal regulation has evolved based upon this classification. The international legal regime is broadly committed to rules governing producer conduct which ensure the truthful use of these designations. Yet this reliance upon consumer perceptions has meant that international protection is unsatisfactory for GI proponents, who would prefer more robust proprietary rights even where no consumer is confused. An influential, albeit geographically deterministic, notion of *terroir* served as the initial anchor for enhance protection against any ‘usurpation’ or misappropriation. However this concept cannot account for the diversity of products entering national and regional GI registries – olives and wines coexist with traditional toys and textiles. What is then common to all categories is the inter-generational human investment and issues relating to communal identity and heritage, as opposed to the singular chemical cocktail of soil and climate. At the very least, this introduces an additional range of values into international GI protection debates and provides proponents with an alternative to the relative sterile language of narrow unfair competition prevention, which has obstructed any progress thus far. Such recasting is not unproblematic, since it opens up the field to recurrent temptations to romanticize GI products and their producer communities, while inventing a traditional past for some of these products. However the interpenetration of the GI protection and heritage preservation debates will provide a relatively grounded legal basis for what has thus far been political manoeuvring at the TRIPS Council, while also forming part of the broader conversation between human rights and intellectual property law. The result should be a more lucid understanding of why we ought to protect GIs, which can only be a good thing.

Part IV

Rights in Informations

Chapter 16

Recapturing Liberated Information: The Relationship Between the United Kingdom's Freedom of Information Act 2000 and Private Law Restraints on Disclosure

*Jonathan Griffiths**

I. INTRODUCTION

Increasingly, it is understood that the 'right to know' plays an essential part in any democratic society. Access to information is, in some circumstances, regarded as a human right.¹ In many countries, citizens are granted rights of access to information held by public bodies. In the UK, general access legislation, in the form of the Freedom of Information Act 2000 (FOIA 2000), has been enacted. The scope of this Act is controversial. It has, for example, been suggested that there are too many exemptions to the right of access to information under the Act.² There is, however,

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1. See, for example, '*Gaskin v. United Kingdom*' (1989) 12 E.H.R.R. 36; '*Guerra v. Italy*' (1998) 26 E.H.R.R. 357; '*Claude Reyes and others v. Chile*, Case No.12.108, Report 60/03 (Inter-American Court of Human Rights).
2. See, for example, D. Feldman, *Civil Liberties and Human Rights in England and Wales*, 2nd edn, (O.U.P., 2002), 783–5.

a feature of the FOIA 2000 that has generated little commentary; yet may detract significantly from its effectiveness as an access regime. The Act fails to regulate the potential conflict between the right of access to information and the continuing ability of individuals or bodies to employ private law rights to resist, or to sanction, disclosure.³ In this chapter, the extent to which rights established under the laws of defamation, confidentiality and copyright can be used to prevent the disclosure of information requested under FOIA 2000 is examined.

The chapter begins with an outline of the structure of the Act and an introduction to the different ways in which disclosure of information could be hampered through reliance on the laws of defamation, confidentiality and copyright. It then goes on to show how freedom of information laws in a number of other common law jurisdictions (Australia, New Zealand, Canada and Ireland) contain immunities from liability that serve to minimize potential conflict between these competing bodies of law. The central argument advanced in this chapter is that the absence of comparable immunities in the FOIA 2000 is likely to diminish the effectiveness of the right of access to information in the UK.

II. ACCESS TO INFORMATION UNDER FOIA 2000 – AN INTRODUCTION

FOIA 2000 provides a right of access to information held by over 50,000 public authorities.⁴ These include departments of central government, local authorities and a wide range of lesser bodies (from the Administrative Justice and Tribunals Council to the Zoos Forum).⁵ Under the Act, public authorities are obliged to provide access to ‘information recorded in any form’⁶ without significant formality,⁷ without inquiry into the applicant’s motives and at subsidized cost.⁸ The right of access applies to any information ‘held’ by a public authority – and thus extends to information which, while originally created or held by third parties, has fallen into a public authority’s hands.⁹ Applicants for information under FOIA 2000 are entitled to express a preferred means of communication from a list set out in the Act. This list includes the communication of copies of the requested information,

3. There are also numerous potential conflicts between the right introduced by the FOIA 2000 and statutory obligations to maintain confidentiality. In order to minimize such potential conflicts, a wide-ranging power to amend or repeal enactments prohibiting disclosure of information is provided under the FOIA 2000 (s. 75).

4. For further analysis of the rights granted under FOIA 2000, see J. Wadham, J. Griffiths & K. Harris, *Blackstone’s Guide to the Freedom of Information Act 2000*, 3rd edn, (Oxford University Press, 2007); P. Coppel, *Information Rights* 2nd ed. (Thomson, 2007).

5. FOIA 2000 ss 3–7, Sch. 1.

6. *Ibid.*, s. 84.

7. *Ibid.*, s. 8.

8. The fees payable in connection with an application under the Act are set out under the Freedom of Information and Data Protection (Appropriate Limit and Fees) 2004 SI 2004/3244.

9. FOIA 2000 ss 1, 3(2).

the provision of applicants with a reasonable opportunity to inspect a record and the furnishing of a digest or summary. Where the applicant's preference is reasonable, the public authority must comply with it.¹⁰

As with all freedom of information regimes, the right of access under the FOIA 2000 is subject to a number of exemptions – that is, legislative provisions which, in specified circumstances, permit public authorities to refuse to communicate information to an applicant. Some exemptions are designated 'absolute exemptions' and are effective regardless of any conflicting public interest in disclosure of the information to which they relate.¹¹ The majority of exemptions are, however, only effective where a public authority can demonstrate that the public interest in maintaining confidentiality outweighs the public interest in disclosure.¹² Where an exemption applies to requested information, a public authority is entitled to refuse to disclose that information. However, under the FOIA 2000, it is not obliged to do so. Responsibility for determining whether or not disclosure should be made rests with the public authority itself. In this respect, the Act's exemptions differ from the mandatory exemptions to be found in some jurisdiction's freedom of information legislation.¹³

Unlike freedom of information legislation in many other jurisdictions, the FOIA 2000 makes no provision for 'reverse FOI' – that is, for a procedure under which third parties have a legal right to challenge disclosures harmful to their interests.¹⁴ Under the Code of Practice issued under section 45, FOIA 2000, public authorities are required to consult third parties whose rights or interests may be affected by disclosure.¹⁵ However, there is no statutory obligation to do so. In the absence of such a 'reverse FOI' procedure, third parties wishing to take proceedings to prevent, or to seek remedies for, disclosure of information by a public authority must employ existing private law causes of action, such as defamation, breach of confidence and infringement of copyright.¹⁶ A third party concerned about a threatened disclosure under FOIA 2000 may seek an interim injunction to

10. *Ibid.*, s. 11.

11. *Ibid.*, s. 2(3). See, for example, s. 21 (Information reasonably accessible by other means), s. 23 (Information supplied by, or concerning, certain security bodies) and s. 32 (Information contained in court records).

12. *Ibid.*, s. 2(2). See, for example, s. 30(1) (Information held for the purpose of criminal investigations), s. 35(1) (Information relating to the formulation or development of government policy) and s. 37(1) (Information relating to communications with Her Majesty, with other members of the Royal Family or with the Royal Household).

13. See, for example, Ireland's Freedom of Information Act 1997 (ss 22, 26, 27, 28 and 32); Regulation 1049/2001, Art. 4(1)-(3) (European Union).

14. Such procedures exist in other jurisdictions. See, for example, the Australian Freedom of Information Act 1982, s. 27 7 27A and the Canadian Access to Information Act 1982, s. 28.

15. See *Code of Practice on the discharge of public authorities functions under Part I of FOIA 2000 – dealing with requests for information*, November 2004, paras 25–30.

16. Judicial review of an authority's decision to disclose information would also seem to be possible. Nevertheless, the restricted form of review and limited orders available in judicial review may mean that third parties prefer to rely upon their private law rights in challenging decisions to disclose.

prevent that disclosure or, if the information in question has already been disclosed, he or she may seek damages and an injunction preventing future disclosure.

Responsibility for enforcing the legislation's right of access lies with the information commissioner.¹⁷ On complaint by an applicant, the Commissioner has the power to investigate whether a public authority's reliance upon an exemption is justified. If not, she can order disclosure of the requested information.¹⁸ A third party who considers that a public authority is about to (or already has) disclosed information wrongfully has no right to seek redress from the information commissioner.

III. POTENTIAL PRIVATE LAW CLAIMS ARISING FROM DISCLOSURE

It has been suggested above that challenges to disclosure of information under the FOIA 2000 may be brought under the laws of defamation, breach of confidence or copyright.¹⁹ In this section, the likely nature of such challenges is outlined. More detailed analysis of the conditions of liability within form of action is provided later in the chapter.

In order to appreciate how proceedings for defamation could be brought to prevent, or penalize,²⁰ disclosure, it may be helpful to examine a hypothetical disclosure under the Act. Consider, for example, a case in which A, a local resident, has sent a letter to her local authority. The letter is defamatory of B plc. Under the Act, C, a journalist, applies to the local authority, requesting disclosure of the information in the letter. The local authority may consider that it does not have to disclose this information under the Act and may, therefore, refuse to do so. In resisting disclosure, it may, for example, cite section 43(2), exempting public

17. See FOIA 2000, ss 47–56. The information commissioner also supervises the data protection regime established under the Data Protection Act 1998.

18. *Ibid.*, ss 50–52. Although, see the limitation on this power imposed by s. 53. Also, note that the Commissioner cannot make compensation orders.

19. While defamation, breach of confidence and copyright are perhaps the most likely causes of action to be employed in resisting disclosure, others may be relevant (e.g. the torts of misfeasance in public office or negligence or an action for infringement of database right under the Copyright and Rights in Databases Regulations 1997 (SI 1997/3032). An individual seeking to prevent disclosure of *personal* information, will be able to rely upon his or her rights under the Data Protection Act 1998 or upon rights to privacy developed within the law of breach of confidence (see, for example, '*Campbell v. M.G.N. Ltd*' [2004] 2 A.C. 457 (H.L.)). Disputes arising in relation to private information are not, however, my primary focus in this chapter because they are comprehensively regulated by expressly co-ordinated provisions of FOIA 2000 and the Data Protection Act 1998.

20. A claimant seeking an interim injunction in libel proceedings faces particular difficulties. These arise from the 'rule against prior restraint', under which a court will not normally grant an interim injunction if a defendant intends to rely on a defense of justification ('*Bonnard v. Perryman*' [1891] 2 Ch 269; '*Holley v. Smyth*' [1998] 2 WLR 742). The rule has been held to survive the introduction of the Human Rights Act 1998 (see '*Greene v. Associated Newspapers*' [2004] EWHC 2322).

authorities from the duty to release information where disclosure ‘would be likely to prejudice the commercial interests of any person’ (B plc in this example). Alternatively, the public authority may, on balance, decide that the public interest favours disclosure, and following consultation with B plc under the Code of Practice, provide the information to C.²¹ As a further possibility, it may simply overlook the possibility that the information in the letter is defamatory of B plc and disclose the information. On receipt of the requested information, C may decide to publish the defamatory information to the world at large.

Questions of liability under defamation law arise on these hypothetical facts. Could the public authority, for example, be liable for defamation for disclosing information in response to a request under the Act?²² In this respect, a distinction may have to be drawn between information to which access could have been refused under one of FOIA 2000’s exemptions (albeit the public authority did not rely on the exemption) and information that the public authority was obliged to disclose because it was not covered by any of the FOIA 2000’s exemptions? Could A, the initial supplier of the defamatory information, also incur liability as a result of the public authority’s disclosure? Is C, the recipient of defamatory information disclosed under the procedure established under the Act entitled to publish it further without liability?

Similar questions arise in relation to breach of confidence. Consider, for example, a situation in which X plc provides information to a public authority for a specific statutory purpose.²³ Y, a member of a pressure group, requests access to this information under the FOIA 2000. In response to Y’s request, the public authority may be entitled to argue that the information is exempt from the duty to disclose under section 41 of the Act (‘Information provided in confidence’).²⁴ However, the public authority is not obliged to rely on the exemption. It may overlook its potential application and disclose the information requested in any event. Alternatively, as the scope of an implied obligation of confidentiality is often uncertain, the public authority may not be sure whether the information is covered by section 41 or not and may decide, on balance, to disclose it. Again, disclosure of the information by the public authority under FOIA 2000 may be the

21. S. 43(2) is a qualified exemption.

22. A claimant can only succeed in defamation where a defamatory statement has been *published*, i.e. has been communicated to some person other than the claimant. (see ‘*Huth v. Huth*’ [1915] 3 KB 32). Disclosure under FOIA 2000 constitutes ‘publication’ for this purpose.

23. For example, in compliance with obligations under legislation passed to ensure the safety of pharmaceutical products. Such legislation may itself contain prohibitions on disclosure. Under those circumstances, a public authority would not be obliged to disclose the information under FOIA 2000 s. 44 (Disclosure otherwise prohibited).

24. ‘(1) Information is exempt information if –

- (a) it was obtained by the public authority from any other person (including another public authority), and
- (b) the disclosure of the information to the public (otherwise than under this Act) by the public authority holding it would constitute a breach of confidence actionable by that or any other person’.

first in a chain of disclosures. Y may decide to share what she has discovered with other members of her pressure group. Ultimately, the information could be published by the media. Would X plc be entitled to bring proceedings in breach of confidence against the public authority for disclosure of the information? What if the authority had acted in the bona fide belief that disclosure would not constitute a breach of confidence? Once the information is released under the Act, has it entered ‘the public domain’ and, as a result, are Y and others entitled to re-publish it without restriction?

When information is requested under FOIA 2000, issues may also arise under copyright law. As noted above, an applicant under the legislation is entitled to request disclosure of information in a variety of ways. Where he or she is provided with an opportunity to inspect a record containing requested information, copyright is unlikely to be infringed.²⁵ However, where information is reproduced in the course of disclosure – for example, where copies are provided to an applicant – potential infringement undoubtedly occurs. Could the owner of the copyright in the recorded information rely on his/her copyright interest to prevent disclosure of the information under FOIA 2000 and/or to prevent its subsequent publication? Could a public authority’s disclosure of information under the Act constitute ‘authorisation’ of infringement by an applicant who re-publishes disclosed information? Furthermore, would a public authority itself be entitled to rely on a copyright interest in refusing disclosure or further dissemination of requested information?

These are important questions. If private law actions can be maintained in the situations outlined above, the strength of the ‘right to know’ provided under the FOIA 2000 may be significantly diminished.

IV. STATUTORY IMMUNITY IN OTHER JURISDICTIONS

An understanding of the risk presented by the existence of private law claims in such circumstances has led common law states with comparable freedom of information regimes to provide explicit answers to some of the questions raised above. Public authorities, and others involved in the disclosure of information under freedom of information legislation, are, in certain circumstances, granted immunity from liability for defamation, breach of confidence and infringement of copyright. In this section, the relevant provisions in Australia, New Zealand, Canada and Ireland are considered.

25. There will be no infringement where an applicant inspects, for example, a letter, memorandum or photograph, because the provision of information in this manner will not constitute any of the infringing acts listed under s. 16 of the CDPA 1988. However, it is quite possible that gaining access to information recorded digitally could fall within the definition of ‘reproduction’ because a transient copy of the record in question will inevitably be produced when access to the record is granted (see CDPA 1988, s. 17(2)). Although, see now CDPA 1988, s. 28A.

IV.A

AUSTRALIA

In Australia, freedom of information legislation has been introduced at federal and state levels.²⁶ In this chapter, the federal statute, the Freedom of Information Act 1982 (Cth), is considered. Section 91(1) of that Act provides immunities against liability for certain specific causes of action – defamation, breach of confidence and infringement of copyright – arising from disclosure of ‘documents’²⁷ under the Act²⁸

[W]here access has been given to a document and:

- (a) the access was required by this Act to be given . . . or
- (b) the access was authorized by a Minister, or by an officer having authority . . . to make decisions in respect of requests, in the *bona fide* belief that the access was required by this Act to be given;
 - no action for defamation, breach of confidence or infringement of copyright lies against the Commonwealth, an agency, a Minister or an officer by reason of the authorizing or giving of the access,
 - and no action for defamation or breach of confidence in respect of any publication involved in, or resulting from, the giving of the access lies against the author of the document or any other person by reason of that author or other person having supplied the document to an agency or Minister.

The beneficiaries of the immunity are the public authority itself and the author and supplier of the information in question. There is no immunity from liability for an applicant who receives disclosed information or to anyone making subsequent disclosures of information released under the statute. Indeed, section 91(2) specifies that disclosure of information by a public authority under the Act does not constitute ‘authorization or approval’ of subsequent publication of disclosed information by the person to whom access is given for the purposes of the laws of defamation, breach of confidence or copyright.²⁹ Thus, immunity is enjoyed where

26. At state level, access to information is provided under the Freedom of Information Act 1989 (New South Wales), the FOIA 1992 (Queensland), the FOIA 1991 (South Australia), the FOIA 1982 (Victoria) and the FOIA 1992 (Western Australia).

27. The Freedom of Information Act 1982 (Cth) provides access to ‘documents’ rather than to ‘information’ (as in the FOIA 2000). See, the Irish Freedom of Information Act 1997, which provides a right of access to ‘records’.

28. Note that the FOIA 1982 (Cth) also provides immunity from criminal prosecution arising as a result of the grant of access to information under the act (s. 92).

29. ‘The giving of access to a document (including an exempt document) in consequence of a request shall not be taken to constitute an authorization or approval:

- (a) for the purposes of the law relating to defamation or breach of confidence – of the publication of the document or its contents by the person to whom access is given;
- (b) for the purposes of the law of copyright – of the doing, by the person to whom access is given, of any act comprised within the copyright in:
 - (i) any literary, dramatic, musical or artistic work;
 - (ii) any sound recording, cinematograph film, television broadcast or sound broadcast; or

the Act requires access to be granted; that is, where information is not covered by any of the exemptions provided under the federal statute.³⁰ Immunity is also granted where access is given to a document by a properly authorized person in the ‘*bona fide* belief’ that access is required under the Act.³¹ Thus, for example, if an authorized officer of a government agency considers, in good faith, that a requested document is not covered by any of the statute’s exemptions and, as a result, discloses it, neither that person nor the author or supplier of the document in question can be liable for defamation, breach of confidence or infringement of copyright.³²

IV.B NEW ZEALAND

In New Zealand, a right of access to information is provided under the Official Information Act 1982. The relevant immunities are contained in section 48

(1) Where any official information is made available in good faith pursuant to this Act, –

(a) No proceedings, civil or criminal, shall lie against the Crown or any other person in respect of the making available of that information or for any consequences that flow from the making available of that information; and

(b) No proceedings, civil or criminal, in respect of any publication involved in or resulting from, the making available of that information shall lie against the author of the information or any other person by reason of that author or other person having supplied the information to a Department or Minister of the Crown or organisation.

As can be seen, immunity is not restricted to particular causes of action under the Official Information Act 1982. It covers any civil or criminal proceedings arising as a result of disclosure of information under the legislation.³³ However, in

(iii) a published edition of a literary, dramatic, musical or artistic work; contained in the document.’

(Freedom of Information Act 1982 (Cth), s. 91(2))

30. Part IV of the statute contains a list of documents exempt from the obligation to disclose.

31. Section 23 of the FOIA (Cth) 1982 explains who the persons authorized to decide on the disclosure of documents are. Thus, for example, s. 23(1) provides that, in relation to most government agencies, ‘a decision in respect of a request made to an agency may be made, on behalf of the agency, by the responsible Minister or the principal officer of the agency or . . . by an officer of the agency acting within the scope of authority exercisable by him in accordance with arrangements approved by the responsible Minister or the principal officer of the agency’.

32. Rather oddly, it is the state of belief of the responsible person within the public authority which determines whether or not the immunity applies to an author or supplier of information (as well as to the public authority itself).

33. When it first came into force, the provision only provided immunity against liability for the same specific causes of action covered by the Australian statute. However, it was amended by s. 21 of the Official Information Amendment Act 1987. See Eagles et al, *Freedom of Information in New Zealand* (Auckland: Oxford University Press, 1992), 613–5.

other respects, section 48 has a very similar scope to the corresponding provision in the Australian federal statute. Immunity is granted to those responsible for the disclosure of information under the Act and to the supplier (but not the author) of the information disclosed.³⁴ No immunity is granted to the applicant or to anyone making a subsequent disclosure. Indeed, as under the Australian Act, disclosure of information under the statute is explicitly stated not to constitute authorisation or approval of publication of the disclosed information by the recipient.³⁵ Again, the immunity will only apply where information is made available in good faith pursuant to the Act.

IV.C CANADA

As in Australia, freedom of information regimes exist at both federal and state level in Canada. In this section, consideration is restricted to the federal statute – the Access to Information Act 1985. The immunity granted under this statute is terser than the equivalent provisions in Australia and New Zealand:

Notwithstanding any other Act of Parliament, no civil or criminal proceedings lie against the head of any government institution, or against any person acting on behalf or under the direction of the head of a government institution, for the disclosure in good faith of any record or any part of a record pursuant to this Act or for any consequences that flow from such disclosure³⁶

As in New Zealand, this immunity is not restricted to particular causes of action. However, in contrast with the provisions considered above, it extends only to the public authority itself and does not, therefore, cover the author or supplier of information.³⁷ Again, as in Australia and New Zealand, an official disclosing information under the access legislation will be entitled to benefit from the immunity where he or she discloses information ‘in good faith’.

34. The provision refers to the ‘Crown’ because the 1982 Act applies only to bodies forming part of New Zealand’s central government. Access to information held by local authorities is available under the Local Government Official Information and Meetings Act 1987.

35. ‘The making available of, or the giving of access to, any official information in consequence of a request made under this Act shall not be taken, for the purposes of the law relating to defamation or breach of confidence or infringement of copyright, to constitute an authorisation or approval of the publication of the document or of its contents by the person to whom the information is made available or the access is given’ (s. 48(2)).

36. Access to Information Act 1985, s. 74.

37. Unlike the equivalent provisions in Australia and New Zealand, s. 74 does not state whether or not disclosure under the Act could constitute authorisation or approval of subsequent publication or disclosure of the information.

IV.D

IRELAND

The Irish Freedom of Information Act 1997 also contains broadly comparable immunities.³⁸ These apply to any ‘civil or criminal proceedings’ and are enjoyed by the public authority and the author or supplier of a disclosed document. As in Australia and New Zealand, it is expressly provided that the grant of access by a public body is not to be taken as authorisation or approval of subsequent publication for the purposes of defamation, breach of confidence or copyright law.³⁹ However, the Irish provision differs from those previously discussed in respect of the conditions that must be satisfied before the immunity can be enjoyed. Under section 45 of the Irish Act, immunity arises where the public authority’s grant of access constitutes

an act that was required or authorised by, and complied with the provisions of, this Act or was reasonably believed by the head concerned to have been so required or authorised and to comply with the provisions of this Act.⁴⁰

Again, any disclosure required under the Act is immune. However, where disclosure is not required under the Act (that is, because an exemption would have permitted the public body to refuse to disclose the information in question), a public body disclosing information will only be protected if the disclosing ‘head’ had a reasonable belief that disclosure was required. Good faith alone is insufficient.

IV.E

COMMON PRINCIPLES

Thus, despite differences of detail, the common law jurisdictions considered above have arrived at similar solutions to the issues under consideration here. There is general agreement that public authorities ought to be granted some protection against private law liability for disclosure of information under freedom of information legislation. The statutory protection granted generally extends to disclosures which were made despite the fact that the requested information in question was covered by an exemption from the duty to disclose. Most of the jurisdictions considered above also provide protection to those who supply information that is subsequently disclosed and to the authors of that information. In none of the jurisdictions, however, does immunity extend to an applicant for information or to a person who subsequently obtains disclosed information.⁴¹

38. See s. 45.

39. Freedom of Information Act 1997, s. 45(4).

40. The reference to ‘the head’ in this provision is a reference to the head of a public body covered by the legislation.

41. This position is justified as a ‘fair balance of the competing public and private interests involved’ by Eagles et al. *Freedom of Information in New Zealand* (Auckland: Oxford University Press, 1992), 618.

This common position inevitably compromises the rights of third parties in information held by public authorities. In such circumstances, it is important to consider how the statutory immunities can be justified. It seems unlikely that the common approach has a rights-based reasoning. Public authorities are the primary beneficiaries of the immunities under consideration here. Governmental bodies are not generally considered to be entitled to benefit from human rights, such as the right of freedom of expression. Any rights enjoyed by lesser public authorities must be very significantly circumscribed by their corporate status and public functions.⁴² Equally, it seems unlikely that an individual officer of a public authority carrying out his or her function in disclosing information under the legislation can be said to be exercising his or her right of freedom of expression in doing so.

The true justification for the immunities discussed above appears to be entirely instrumental. In the absence of immunity, a public authority would find itself in a very difficult situation. On one hand, it would be subject to obligations of disclosure under freedom of information legislation. On the other, it would be subject to civil claims for disclosing potentially exempt information. Faced with the need to make delicate judgments with potentially onerous consequences for misjudgment, a rational public authority would be likely to follow the least risky course open to it. As failure to comply with the obligation to disclose information under freedom of information legislation does not generally result in financial penalties, an authority faced with this dilemma is likely to err on the side of non-disclosure.⁴³ Thus, if immunities are not provided to public authorities, it is likely that less information will be disclosed. The effect of immunity for suppliers and authors of information is likely to be less pronounced. However, it is certainly possible that the flow of information into a public authority's hands could be reduced if authors and suppliers of information were aware that they could incur liability as a result of subsequent disclosure of the information by a public authority.

What, then, is the justification for refusing to extend immunity to an applicant who receives information under freedom of information legislation? At first sight, it would appear to be easier to construct an argument for immunity based upon the right to freedom of expression for an applicant natural person than for the primary beneficiary of the immunity. However, the grant of immunity to an applicant (and to a subsequent recipient) of information would be tantamount to the denial of all third party rights in information coming into a public authority's hands. Such an unbalanced result is hard to justify where, in any event, an applicant's rights to freedom of expression are already secured by mechanisms within the laws of the jurisdiction concerned – for example, by defenses within the law of defamation, breach of confidence or copyright. Furthermore, by contrast with the position of public authorities, there are no easily identifiable instrumental reasons for granting immunity to the recipient of information. Indeed, the existence of such immunity could produce undesirable consequences. The knowledge that information obtained under freedom of information legislation is free from obligations

42. See, for example, *Derbyshire C.C. v. Times Newspapers* [1993] A.C. 534.

43. See FOIA 2000, ss 50–56.

applying more generally to the disclosure of information, may tempt applicants to make speculative requests for information in the hope that a public authority will overlook the potential applicability of any relevant exemptions.

Thus, it would appear that the common approach adopted to this issue in Australia, New Zealand, Canada and Ireland can be justified by reference to the purpose of the legislation, that is, to the promotion of maximum disclosure of information by public authorities, without unreasonably encroaching upon the rights of third parties. It is now necessary to move on to consider the extent to which the models identified within these jurisdictions are reflected in the UK's FOIA 2000.

V. THE FREEDOM OF INFORMATION ACT 2000 – RELATIONSHIP WITH PRIVATE RIGHTS

Surprisingly, a different approach has been taken in this jurisdiction. The Freedom of Information Act 2000 contains only one provision granting immunity (section 79). This applies solely to defamation:

Where any information communicated by a public authority to a person ('the applicant') under section 1 was supplied to the public authority by a third person, the publication to the applicant of any defamatory matter contained in the information shall be privileged unless the publication is shown to have been made with malice

As a result of this limited approach to immunity, the question of whether or not a disclosure under FOIA 2000 could result in private law liability can only be answered following a close examination of the conditions of liability in each relevant area of law. In this section, therefore, potential liability for defamation, breach of confidence and infringement for copyright law are considered closely in turn.

V.A DEFAMATION

Under English law, defamation is

the publication of a statement which reflects on a person's reputation and tends to lower him in the estimation of right-thinking members of society generally or tends to make them shun or avoid him.⁴⁴

Under section 79, a public authority will not be liable in defamation for communicating information 'supplied to the public authority by a third person' unless the public authority makes the disclosure with 'malice'. In effect, the provision creates

44. *Winfield and Jolowicz on Tort*, 17th edn, W.V.H. Rogers (ed.), (London: Sweet & Maxwell 2006), 515.

a statutory form of the common law defense of ‘qualified privilege’. ‘Malice’ has a technical meaning in defamation law. A publication will be malicious where a defendant uses a privileged occasion⁴⁵ for an improper purpose.⁴⁶ For example, a public authority’s disclosure of defamatory information would be malicious if the authority’s agent knew that the information disclosed was false and was exempt from the duty to disclose under FOIA 2000 but, through a desire to damage a third party, chose to provide it anyway.⁴⁷

Unlike the provisions in other common law jurisdictions discussed above, section 79 does not state clearly whether it covers both disclosures required under the Act and potentially exempt disclosures. It speaks simply of the communication of information ‘by a public authority to a person . . . under section 1’. On the face of it, this suggests that the provision covers both forms of disclosure. If it had been intended to apply only to disclosures required under the Act, there would have been no reason to exempt malicious disclosures from the scope of section 79, as it is difficult to see how such disclosures could ever be malicious. In any event, where a disclosure is required under the Act, a defense of statutory authorization would seem to be available.

Section 79 can thus be assumed to cover both ‘correct’ and ‘incorrect’ disclosures. Indeed, its primary function must be to insulate public authorities against liability for mistaken disclosures. Public authorities (and persons acting on their behalf) will not be liable in defamation where they disclose information supplied by a third party in the bona fide belief that they are obliged to do so under the Act. Although differently expressed, the position is similar to that in Australia, Canada and New Zealand. The immunity is more generous than that provided under the Irish Freedom of Information Act.⁴⁸ However, in one respect, it should be noted that section 79 is significantly more limited than its overseas counterparts. It applies only to information supplied to it by third parties and not to information generated within the public authority itself. Thus, for example, section 79 would not apply to internal minutes or departmental reports released under FOIA 2000. If sued in defamation for the publication of defamatory information within such documents, a public authority would have to fall back upon existing defenses within the law of defamation.⁴⁹

Authors and suppliers of information have no immunity from liability for defamation under FOIA 2000. However, this does not mean that they will necessarily be liable where a public authority discloses defamatory information. Under

45. Here, the disclosure of information in response to an application under the FOIA 2000.

46. ‘*Horrocks v. Lowe*’ [1975] AC 135, 149–50.

47. For consideration of the concept of malice in this context, see ‘*Horrocks v. Lowe*’ [1975] 1 AC 135.

48. In ‘*Horrocks v. Lowe*’ [1975] A.C. 135, a defamatory statement was made with ‘gross and unreasoning prejudice’. However, the defendant believed everything he said and, therefore, the statement was not malicious.

49. It seems unlikely that the authority would be able to claim common law qualified privilege for a disclosure because it will be difficult to argue that it had a *duty* to reveal information that is exempt from disclosure.

the law of defamation, the re-publication of a defamatory statement through the voluntary act of another generally breaks the chain of causation from the initial publisher of that statement.⁵⁰ However, where the maker of a defamatory statement should have known that there was a significant risk that the statement would be repeated, he or she could be liable for the subsequent re-publication.⁵¹ It is possible that, in certain circumstances, the supplier of information to a public authority could reasonably foresee that the information supplied would probably be released in response to a request under FOIA 2000. However, such circumstances seem unlikely to arise often. On this point, thus, there is little difference between the position under the Act and the position in the other jurisdictions considered above.

In common with the overseas FOI laws investigated above, no immunity against liability for defamation is provided for applicants for information under the Act. If an applicant (or subsequent recipient) faces a claim for defamation as a result of his or her further dissemination of disclosed information, he or she can only avoid liability by relying upon the defenses generally available under the law of defamation. In the case of a media defendant, the development of the defense of qualified privilege arising from the decision of the House of Lords in *Reynolds v. Times Newspapers Ltd* may offer protection for ‘public interest’ disclosures.⁵² Unlike most of the overseas laws discussed above, the FOIA 2000 is silent on the question of whether or not disclosure by a public authority can be deemed to constitute authorisation or approval of an applicant’s publication of disclosed information for the purpose of the law of defamation.⁵³ In the absence of such immunity, a public authority would be at risk of liability if it authorized re-publication. This is perhaps unlikely to occur in practice. Nevertheless, as noted above, there is also the possibility of liability for subsequent re-publication of a defamatory statement where there was a significant risk of such re-publication.⁵⁴ In the absence of a clear warning against re-publication at the time of disclosure, the risk that re-publication will follow a successful request for information under FOIA 2000 would seem to be quite high.

V.B BREACH OF CONFIDENCE

No immunity against liability for breach of confidence is provided in the FOIA 2000. Accordingly, it is necessary to consider the equitable doctrine itself when

50. *Weld-Blundell v. Stephens* [1920] A.C. 945.

51. *McManus v. Beckham* [2002] 1 WLR 2982 (CA).

52. [2001] 2 A.C. 127. There have been numerous subsequent cases in which the scope and application of ‘*Reynolds* privilege’ have been considered. The defense has recently been revisited by the House of Lords in *Jameel v. Wall Street Europe Sprl* [2006] UKHL 44.

53. Liability for authorizing a publication can arise in the law of defamation. See discussion in *Gatley on Libel and Slander*, 10th edn, Milmo et al (eds) (Sweet and Maxwell, 2004), 8.28.

54. *McManus v. Beckham* [2002] 1 WLR 2982 (CA).

asking whether disclosure under the Act could lead to liability. In J. Megarry's often-quoted words:

[T]hree elements are normally required if . . . a case of breach of confidence is to succeed. First, the information itself, in the words of Lord Greene MR . . . must 'have the necessary quality of confidence about it'. Secondly, that information must have been imparted in circumstances importing an obligation of confidence. Thirdly, there must be an unauthorised use of that information to the detriment of the party communicating it.⁵⁵

Under FOIA 2000, public authorities are exempt from the duty to communicate information where to do so would constitute a breach of confidence owed to a third party.⁵⁶ Thus, if a public authority discloses information in breach of an obligation of confidence, it will not be able to rely upon a defense of statutory authorization to a confidence claim. It would only be able to escape liability if it could rely on a defense available within the action for breach of confidence itself. In this regard, in some circumstances, it may be able to claim that the information in question was not provided to the authority under an obligation of confidence or that the authority was entitled to disclose the information 'in the public interest'.⁵⁷ This latter claim is, however, likely to be of limited effectiveness in protecting a public authority from liability for disclosure of confidential information. While the scope of the 'public interest defence' is uncertain, it has often been described in terms that are narrower than the concept of 'public interest' underpinning freedom of information legislation.⁵⁸ Such legislation is premised upon a belief that information held by public authorities should be available to the public unless there is a good reason for secrecy to be maintained. The 'public interest' defense to breach of confidence is not, however, based upon such a generous presumption.⁵⁹ In the past, it has been suggested that it will only apply where disclosure is required in the public interest.⁶⁰ This conception of the defense has been expanded significantly in recent

55. '*Coco v. A. N. Clark (Engineers) Ltd*' [1969] *RPC* 41.

56. FOIA 2000, s. 41. Note that this exemption only applies where communication of information would breach an obligation of confidence owed to some person or body other than the public authority receiving the request under the FOIA 2000 (see s. 41(1)(a)).

57. For examples of the use of the 'public interest' claim, see '*Initial Services v. Putterill*' [1968] 1 *QB* 396; '*Lion Laboratories v. Evans*' [1985] *QB* 526; '*W. v. Egdell*' [1990] 2 *WLR* 47. Where this 'defence' applies to particular information, a public authority will (unless the information is covered by another exemption under FOIA 2000) be obliged to communicate it because disclosure could not constitute an actionable breach of confidence (as required under s. 41).

58. See, Lord Falconer of Thoroton, *Hansard HL*, 17 October 2000, col. 928.

59. This is particularly so in the case of private claimants. Public bodies seeking to rely upon the equitable duty of confidence will themselves have to establish a public interest in maintaining confidentiality (see '*A-G v. Guardian Newspapers Ltd*' (No.2) [1990] 1 *AC* 109).

60. See, for example, Toulson and Phipps, *Confidentiality* (London: Sweet & Maxwell, 1996), 80:

[T]he true principle is not (as dicta in some cases suggest) that the court will permit a breach of confidence whenever it considers that disclosure would serve the public interest more than non-disclosure, but rather that no obligation of confidence exists in contract or in equity, in so far as the subject matter concerns a serious risk of public harm (including but not limited to cases of

cases in which claims for breach of confidence in respect of 'private' information have been made.⁶¹ However, the extent to which this expansion will apply in more traditional claims for breach of confidence remains uncertain. Furthermore, even the broadest construction of the defense will not extend to information of no general public concern or to information released through inadvertence.

An author or supplier of information disclosed by a public authority may, in certain circumstances, be liable in breach of confidence for disclosing information to a public authority.⁶² The author or supplier of information will, however, be unlikely to incur liability as a result of a subsequent disclosure of the information by a public authority. While the law of breach of confidence is not as well-developed on this point as defamation law, it would seem unlikely that the independent act of a public authority in disclosing information in response to a request under FOIA 2000 could result in liability for the original author or supplier of that information.

The question of whether or not an applicant for information under the FOIA could be liable for breach of confidence as a result of his or her further disclosure of disclosed information is interesting. Once implicated in the public authority's breach of confidence by knowledge of the breach, the applicant would appear to be vulnerable to such an action. Third party recipients of information who become aware that it was originally disclosed in breach of confidence are normally themselves also bound by an obligation of confidence.⁶³ However, where an applicant is unaware of the confidential status of disclosed information, he or she will not incur liability for disclosure.⁶⁴ Furthermore, an applicant or subsequent recipient of disclosed information may also, where applicable, be entitled to rely on the 'public interest' defense.⁶⁵ The argument that, once information has been disclosed by a public authority under the FOIA 2000, it forms part of the 'public domain' and therefore cannot form the basis of an action for breach of confidence, seems unlikely to succeed. Courts have shown themselves willing to restrain disclosure of information having only relative confidentiality.⁶⁶ Where a

'iniquity') and the alleged obligation would prevent disclosure appropriate to prevent such harm.

61. See '*Campbell v. M.G.N. Ltd*' [2004] 2 A.C. 457 (H.L.). For discussion, see H. Fenwick & G. Phillipson, *Media Freedom under the Human Rights Act* (Oxford University Press, 2006), 707–809; T. Aplin, 'The Development of the Action for Breach of Confidence in a post-HRA Era' [2007] *IPQ* 19.
62. He or she may, however, be able to rely upon the defense of statutory authorisation (for example, where there is a statutory obligation to supply information to the public authority) or upon the 'public interest' defense discussed above.
63. '*A-G v. Guardian Newspapers Ltd*' (No.2) [1990] AC 109 at 260 (per Lord Keith).
64. See, for example, '*Thomas v. Pearce*' [2000] *FSR* 718.
65. For example, where disclosed information reveals wrongful conduct on the part of the person to whom the obligation of confidence is owed.
66. See, for example, '*Franchi v. Franchi*' [1969] *RPC* 149. Compare the position of the recipient of information justifiably disclosed in breach of confidence under New Zealand's Official Information Act 1982 (Eagles et al, *Freedom of Information in New Zealand* (Auckland: Oxford University Press, 1992), 617). As a result of s. 41, it would not appear to be possible to release

public authority has disclosed information in breach of confidence, a court is unlikely to be deterred from preventing further disclosure simply because it has been disclosed under the Act.

V.C

COPYRIGHT

The circumstances in which disclosure of information under the Act can give rise to liability for infringement of copyright are more limited than in the case of defamation and breach of confidence. For example, while unrecorded, private communications can give rise to liability in defamation or breach of confidence, such communications are unlikely to infringe copyright because they will not involve the commission of any of the ‘restricted acts’ under the CDPA 1988. However, the provision of copies of requested information may constitute an infringement of copyright. Whether the copying and disclosure of information protected by copyright will in fact infringe copyright in any particular case is considered more closely below.

Where disclosure of copyright-protected information is mandatory under the FOIA 2000 (that is, where there is no applicable exemption), a public authority will be protected against any action for copyright infringement. This protection will derive from two sources. First, the defense of statutory authority applying generally in the law of tort may cover the disclosure.⁶⁷ Secondly, section 50 of the Copyright Designs and Patents Act may also provide protection. This provides that

(1) Where the doing of a particular act is specifically authorised by an Act of Parliament, whenever passed, then, unless the Act provides otherwise, the doing of that act does not infringe copyright

However, these defenses are only be effective where disclosure is authorized (at common law) or where it is ‘specifically authorised’ (under section 50). Where a public authority releases copies of copyright-protected information that is covered by an exemption from the duty of disclosure, it would not appear to be possible to describe the disclosure as authorized or ‘specifically authorised’ by the statute.⁶⁸

information justifiably in breach of confidence under FOIA 2000 (save where it is covered by the ‘public interest’ or other defense within that cause of action).

67. For discussion of the application of this defense in copyright law, see Laddie, Prescott & Vitoria, *The Modern Law of Copyright and Designs*, 3rd edn, (London: Butterworths, 2000), 20.47.

68. This may also be true where a public authority could reasonably have disclosed information in a manner that would not infringe copyright (for example, by allowing an applicant a reasonable opportunity to inspect records containing the information). Indeed, a copyright owner may argue that, as a result of s. 44(1) of the FOIA 2000, infringement of copyright can never be authorized under that Act. Section 44(1) provides that ‘Information is exempt information if its disclosure (otherwise than under this Act), by the public authority holding it – (a) is prohibited by or under any enactment’ Such an argument would rely upon the fact that the CDPA 1988 is an enactment prohibiting disclosure of information and, therefore, that a public authority is *never* obliged to make any disclosure infringing copyright. As a result, disclosures of information

Under the exemption, it need not have been made. In such circumstances, therefore, a public authority would appear to be vulnerable to liability for copyright infringement⁶⁹ unless it can bring itself within the scope of any other copyright limitation or exception. It is likely to face considerable difficulty in doing so because the statutory ‘permitted acts’ within the CDPA 1988 are closely tailored to specifically articulated uses of a copyright work. ‘Mistaken’ disclosure of information by a public authority under FOIA 2000 does not easily fall within any such statutory permitted act. The common law defense of ‘public interest’ is even more uncertain in scope in copyright law than it is in breach of confidence⁷⁰ and, in any event, would not apply to inadvertent disclosure.

What, then, is the position of the author or supplier of information disclosed under the Act? Is it possible that such a person could be liable for ‘authorising’ an authority’s subsequent disclosure of information protected by copyright? The authority’s subsequent disclosure will not infringe copyright where disclosure is required under the Act. Equally, in such a case, it would not be possible for the supplier or author of the information in question to incur liability for authorizing an infringement. There would be no infringement to authorize. However, where a public authority discloses information covered by an exemption, a supplier or author could potentially be liable if he or she could be regarded as granting or purporting to grant a right to commit copyright infringement in disclosing the information.⁷¹ In practice, it seems very unlikely that a supplier or author of information would ever be regarded as having any authority to grant such a right when supplying or creating such information and, therefore, such liability is unlikely to arise. Simple knowledge that information could be disclosed in response to a request under FOIA 2000 would not be sufficient to give rise to liability for authorizing copyright infringement.

What then of the applicant who receives information disclosed under the Act? Receipt of information is unlikely to infringe copyright. However, if a recipient

involving infringement of copyright could never be regarded as authorized or ‘specifically authorised’ by FOIA 2000. The difficulty with this argument is that, if it were accepted, the purpose of the FOIA 2000 would be frustrated entirely. This could surely not be justified (*cf.* M.McDonagh, *Freedom of Information Law in Ireland* (Dublin: Round Hall, 1998), 74). The Act contains ample protection for the commercial interests of third parties and it would not be satisfactory for copyright owners to argue that public authorities could disclose requested information without infringing copyright – for example, by providing a summary or digest. It is questionable whether ‘information’ disclosed in such a form would be the same ‘information’ as that requested by an applicant. In any event, the FOIA 2000 clearly reveals an intention that an applicant should, wherever practicable, be able to obtain disclosure in his or her chosen form. As acceptance of this argument would tend to frustrate the purpose of the FOIA 2000, it is suggested that courts will be likely to interpret s. 44(1) in such a way that a copyright interest is not regarded as prohibiting ‘disclosure’ (as opposed to reproduction, performance in public etc.) and therefore that the CDPA 1988 is not considered to fall within the scope of s. 44(1).

69. Where a ‘substantial part’ is reproduced (see CDPA 1988, s. 16(3)(a)).

70. See *Hyde Park Residence Ltd v. Yelland* [2001] Ch. 143 (C.A.); *Ashdown v. Telegraph Group plc* [2002] Ch. 149 (C.A.).

71. ‘*CBS Songs v. Amstrad*’ [1988] 2 All ER 484.

wishes to reproduce and further disseminate disclosed information, he or she may incur liability. Neither the common law defense of statutory authorization, nor section 50 CDPA 1988 protects an applicant or subsequent recipient in such circumstances. The duty to disclose information under FOIA 2000 cannot provide the basis of a claim to statutory authorization because that duty applies solely to public authorities. It would appear, therefore, that copyright owners could employ copyright law to prevent further dissemination of disclosed information (where such information is protected by copyright) whether or not that information was 'correctly' disclosed by a public authority.⁷² This is problematic. It may be considered acceptable for a copyright owner to rely upon its interest to prevent the reproduction of information that need not have been disclosed by a public authority. However, it is surely not acceptable for a copyright owner to have a power to prevent all further dissemination of information properly disclosed under FOIA 2000. While the continued application of rights in defamation and breach of confidence following disclosure will be restricted to cases in which a third party's interest in reputation or confidentiality is jeopardized, there is no such restriction under copyright law. Whenever disclosed information is clothed in copyright, a potential infringement will arise. Particularly where a copyright owner's motivation in bringing proceedings in such circumstances is to impede the flow of information (as opposed, say, to protect the commercial value of the information in question), a threat to the underlying purpose of FOIA 2000 would appear to arise. It is possible that, in such circumstances, courts may be willing to develop the common law 'public interest' defense to ensure that the right of access to information is not frustrated.⁷³

Because FOIA 2000 does not contain a provision stating that disclosure of information by a public authority cannot be deemed to authorize or approve further publication by an applicant, copyright owners may also be able to argue that, in disclosing information, public authorities can incur liability for authorizing an applicant's subsequent copyright infringement. Again, such an argument could be made whether or not the public authority's initial disclosure was 'correct' or not. The chances of success of such a claim will depend upon the manner in which the authority discloses the information in question. If disclosure is accompanied by a suitably worded disclaimer, it seems unlikely that the authority could be regarded as granting, or purporting to grant, the right to commit an infringing act to the applicant.

72. In some cases, the copyright owner could even be the public authority itself. See J. A. Kidwell 'Open Records Law and Copyright' [1989] *Wisconsin LR* 1021. The applicant or subsequent recipient may, of course, be entitled to rely upon the statutory 'permitted acts' within the CDPA 1988. For example, in some cases, disclosure may be justifiable under s. 30(2) CDPA, which permits fair dealing with copyright works for the purpose of reporting current events.

73. See the Court of Appeal's application of the public interest defense to ensure that copyright law does not contravene the European Convention on Human Rights in *Ashdown v. Telegraph Group plc*. [2002] Ch. 149.

VI. POTENTIAL PROBLEMS ARISING AS A RESULT OF THE LIMITED STATUTORY IMMUNITY GRANTED UNDER FOIA 2000

As has been demonstrated above, the FOIA 2000 allows considerable scope for the continued use of private law actions to impede disclosure of information. In this respect, it differs significantly from comparable legislation in other common law jurisdictions. In this section, some of the problems arising as a result of the decision to introduce only limited statutory immunity are explored.

VI.A PROBLEMS FOR PUBLIC AUTHORITIES

Public authorities are not generally protected against ‘unnecessary’ or ‘mistaken’ disclosures under FOIA 2000. Limited protection against liability for defamation only is available. However, no protection at all is available in the case of breach of confidence or infringement of copyright. An authority is therefore at risk even if it acts in good faith or on a reasonable belief that it is obliged to disclose requested information. This absence of protection places a public authority in an awkward position. On one hand, it is subject to statutory duties to disclose under FOIA 2000. If it fails to disclose information that ought to be disclosed, the information commissioner will enforce compliance with the Act. On the other hand, if it wrongly assesses the scope of an exemption or fails to appreciate the status of information in its hands, it may face civil proceedings for breach of confidence or infringement of copyright. Its position is rendered even less attractive by the difficulty of predicting the exact scope of the FOIA’s exemptions and of the relevant causes of action in civil law.

These difficulties do not only present a problem for public authorities. They also create a real threat to the effective operation of the freedom of information regime introduced under FOIA 2000. As has previously been indicated, when faced with the dilemma outlined above, a public authority is likely to opt for a conservative approach to information disclosure. The consequences of breaching the private law rights of third parties (awards of damages and orders for legal costs) are more onerous than those of failing to comply with the requirements of the Act.⁷⁴ FOIA 2000 was introduced to improve the accountability and quality of administration. Adoption of a conservative approach to disclosure will reduce the likelihood that this aim will be achieved and will increase the administrative burden on the information commissioner. In addition to liability arising from its own disclosure of information in response to a request under FOIA 2000, a public authority may face potential liability for authorizing or approving subsequent disclosures by applicants or subsequent recipients. This problem, however, is rather less serious. Faced with the risk of such liability, authorities are likely to

74. The enforcement powers of the information commissioner are set out in FOIA 2000, ss 50–56.

seek to protect themselves by developing disclosure forms that strongly discourage further dissemination of information communicated under FOIA 2000. Such documents may themselves tend to ‘chill’ public debate; thus further frustrating the rationale for of freedom of information legislation.

VI.B PROBLEMS FOR AUTHORS/SUPPLIERS

Authors and suppliers of information are less vulnerable to civil action under FOIA 2000. As noted above, a public authority’s disclosure of information is unlikely to lead to liability for the original supplier or author of that information in very many cases. Nevertheless, other jurisdictions have considered it worthwhile to provide immunity for suppliers and authors. Presumably, in doing so, they have been motivated by the fear that, in the absence of such immunity, the communication of information to public authorities may be reduced. It is difficult to imagine that the fear of liability for authorizing defamation, breach of confidence or infringement of copyright would have a very significant impact upon the flow of information to public authorities. Nevertheless, to the extent that it would, the absence of immunity in FOIA 2000 will tend to interfere with the public interest in free communication of information.

VI.C PROBLEMS FOR APPLICANTS

As has been demonstrated above, those to whom information is disclosed under FOIA 2000 may face civil proceedings for further dissemination of that information. In this respect, the Act does not differ from equivalent legislation in other common law jurisdictions. Nevertheless, such potential liability may have adverse consequences. This is particularly so in the case of information protected by copyright. Applicants, and subsequent recipients, may face liability in copyright law if they are unable to bring themselves within a limitation or exception under the CDPA 1988. They may be entitled to explain the content of disclosed works without infringement. However, a paraphrase of information is unlikely to be as effective as verbatim disclosure. Furthermore, it has been noted above that, in order to avoid potential liability for authorizing subsequent information wrongs, public authorities are likely to disclose information under cover of strongly-worded disclaimers. Such notices may have a ‘chilling’ effect on the further dissemination of disclosed information – even where further dissemination is lawful.

VII. CONCLUSION

What then does the approach to immunity adopted in the FOIA 2000 tell us about the prevailing attitude towards the law of information disclosure in this jurisdiction? It seems possible to draw a number of tentative conclusions. First, tenderness

towards private law rights (to reputation, confidentiality and property in creative works) marks the disclosure regime introduced under the FOIA 2000. This is in keeping with a historical tendency for law-makers in this jurisdiction to favour individual first-generation liberties over positive rights such as the right of access to information. The recent incorporation of the European Convention on Human Rights could be argued to reinforce this preference for individual liberties and is likely to have made those responsible for the FOIA 2000 particularly wary of introducing a regime that interferes substantially with third party rights (to privacy, reputation or enjoyment of property, for example).

Secondly, the absence of a more general immunity could be argued to reflect governmental ambivalence about the desirability of freedom of information legislation. As noted above, the risk of civil proceedings may cause public authorities to adopt a conservative approach to information disclosure. The UK government may not regard this as particularly problematic. There is ample evidence to demonstrate its lukewarm commitment to freedom of information. This evidence ranges from the delays in bringing a bill before Parliament and the postponement of the Act's coming into force to the extensive range of exemptions available to public authorities and the existence of a ministerial power to override decisions of the information commissioner.⁷⁵

Finally, however, it is also possible to suggest that the situation described in this paper is representative of the increasingly complex and inconsistent body of 'information law' in this jurisdiction. There are now a huge number of measures governing the circumstances in which information can, or must, be disclosed. Despite the impact of the Human Rights Act 1998, these measures are often overlapping and inconsistent.⁷⁶ The fact that the aims of the FOIA 2000 can be frustrated through reliance on competing private law rights is typical of a continued tendency to allow the features of particular causes of action, rather than underlying principle, to determine the contours of our information law. Section 75 of the FOIA 2000 grants a power to the Secretary of State to amend or repeal any enactment 'capable of preventing the disclosure of information' under the Act.⁷⁷ The time may, however, have come for a much more radical review of all our laws governing disclosure of information.

75. See FOIA 2000, s. 53.

76. See, for example, uncertainty caused by the re-shaping of the law of confidentiality to protect personal privacy (*Campbell v. M.G.N. Ltd* [2004] 2 A.C. 457 (H.L.)) and by the overlapping forms of protection offered by breach of confidence and copyright (*Hyde Park Residence Ltd v. Yelland* [2001] Ch. 143 (C.A.)).

77. A review of such enactments has been conducted and a number have been identified as suitable for repeal or amendment, see *Annual report on bringing fully into force those provisions of the FOIA 2000 which are not yet fully in force* (Lord Chancellor's Department, November 2002, H.C. 6).

Chapter 17

‘Holding the Line’ – the Relationship between the Public Interest and Remedies Granted or Refused, be it for Breach of Confidence or Copyright

*Alison Firth**

I. INTRODUCTION

Copyright and breach of confidence may both be used to regulate the flow of information. The extent to which this is possible, and the consequences of failure to control the flow, ultimately depend upon the availability of judicial remedies, in particular the injunction or restraining order. In breach of confidence and in copyright cases, common law courts have considered the notion of public interest when deciding how to address alleged breaches. The English Court of Appeal in *Ashdown v. Telegraph*¹ has somewhat revived the defense for copyright in England, after blows dealt by an earlier Court of Appeal decision in *Hyde*

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1. *The Right Honourable Paddy Ashdown MP PC v. Telegraph Group Limited* [2002] Ch. 149; [2002] RPC 5; [2002] ECDR 32; [2002] ECC 19; [2001] 3 W.L.R. 1368; [2001] 4 All E.R. 666; [2001] EMLR 44; [2001] HRLR 57. J. Griffiths, ‘Copyright law after Ashdown – time to deal fairly with the public’, [2002] IPQ 240; T. Pinto ‘The influence of the European Convention on Human Rights on intellectual property rights’ [2002] EIPR 209; L. Joseph ‘Human rights versus copyright: the Paddy Ashdown case’ [2002] Ent LR 72.

Park v. Yelland.² Public interest as a defense in copyright and breach of confidence has its proponents³ and its critics,⁴ whether as a complete defense or merely as a defense to the remedy of injunction; this chapter seeks to locate the defense in the context of other discretionary decision-making in copyright and confidence cases.

The tendency to refuse a remedy on the ground of a public interest in the disclosure of information has been joined by a small sister trend, recalling the discretionary nature of injunctions – consideration of the adequacy of damages when deciding whether to grant a permanent injunction. In the English case of *Ludlow Music Inc v. Robbie Williams*,⁵ the court discussed the role of the permanent injunction and declined to award such an order on application in proceedings for summary judgment, although in subsequent proceedings an injunction was granted.⁶

The injunction's counterpart is damages in Equity.⁷ On this point, Canadian jurisprudence in the shape of cases such as *Cadbury Schweppes v. FBI Foods*⁸ is of

2. *Hyde Park Residence Ltd v. Yelland* [2001] Ch 143; [2000] 3 WLR 215; [2000] ECDR 275; [2000] EMLR 363; [2000] RPC 604 (CA).
3. For example Burrell and Coleman *Copyright Exceptions: The digital impact* (Cambridge, CUP, 2005); Sims 'the public interest defence in copyright law: myth or reality' [2006] EIPR 335.
4. For example D.F.C. Thomas 'A public interest defence to copyright infringement?' (2003) 14 Aus IPJ 225; Dworkin 'Judicial control of copyright on public policy grounds' in Kabel and Mom (eds) *Intellectual Property and Information Law: Essays in Honour of Herman Cohen Jehoram* (The Hague, Kluwer Law International, 1998).
5. *Ludlow Music Inc v. Robbie Williams* [2001] FSR 19 (Nicholas Strauss Q.C. sitting as a Deputy High Court Judge).
6. *Ludlow Music Inc v. Williams (No.2)* [2002] EMLR 29; [2002] F.S.R. 57; [2002] ECDR CN6 (Pumfrey, J).
7. 'Common law' [initially discerned from general customary principles of law] and Equity [based upon conscience] developed in parallel in England and related jurisdictions. The two systems were merged by C19 Judicature Acts. 'Lord Cairns' Act', the Chancery Amendment Act of 1858, by s2 (subsumed into s50, Supreme Court Act 1981) had made the common law remedy of damages available in lieu of an injunction, thus providing the courts with a mechanism for providing compensation for *future*, as well as past, breaches. Analogously, damages have been made available for past breaches of confidence: *AG v. Guardian Newspapers (No.2)* [1990] 1 AC 109, at 286 per Lord Goff: 'the remedy of damages, which in cases of breach of confidence is now available, despite the equitable nature of the wrong, through a beneficent interpretation of the Chancery Amendment Act 1858 (Lord Cairns' Act)'. For a trenchant account of these matters and their relation to restitution, see D. Campbell, 'Hamlet without the Prince: How Leng and Leong use Restitution to extinguish Equity', [2003] JBL 131. The Canadian Supreme Court in *Cadbury Schweppes v. FBI Foods* [2000] FSR 491, rejected Lord Cairns' Act as a basis for damages in breach of confidence cases, holding the court's inherent Equitable jurisdiction to be the adequate and correct basis. In discussing relief to be granted in *Durand v. Molino* [2000] ECDR 320 (facts and decision as to liability), Pumfrey J held that equitable damages could be awarded in lieu of an order for delivery up: see G. Harbottle, 'Permanent injunctions in copyright cases: when will they be refused?', [2001] EIPR 154, at n8. The New Zealand courts have taken the view that compensatory damages are available in Equity: *Coleman v. Myers* [1977] 2 NZLR 225 (CA); *Aquaculture Corp v. New Zealand Green Mussel Co Ltd* [1990] 3 NZLR 299 (CA); *Chirnside v. Fay* [2006] NZSC 68; [2007] PNLR 6, para. [20] at n27 (SC).
8. [2000] FSR 491. The New Zealand Supreme Court in *Chirnside & v. Fay* [2006] NZSC 68; [2007] PNLR 6 did not refer to *Cadbury Schweppes*, despite the fact that both cases involved secret profits made after failed joint venture negotiations.

particular interest to the intellectual property community. In *Cadbury*, the Supreme Court of Canada made much pertinent comment on damages in breach of confidence cases and held that a permanent injunction was inappropriate to restrain the defendant's use of 'not very special' commercial information.

II. COPYRIGHT, BREACH OF CONFIDENCE AND OTHER CAUSES OF ACTION

Although copyright protects expression whilst breach of confidence protects the underlying information,⁹ in cases where the public has a serious interest in the disclosure of information, the form in which that information appears is often important. In *Fressoz and Roire v. France*,¹⁰ a journalist received copy tax returns of the chairman of Peugeot, a large French car manufacturer. After checking against public domain material, the journalist wrote an exposé which was published with reproductions of the tax returns in the satirical magazine 'Le Canard Enchaîné'. The journalist and a director of the publisher were convicted of handling stolen copies. In holding the convictions to be contrary to Article 10 of the European Convention on Human Rights (freedom of expression) the European Court distinguished between the underlying information (public domain) and the tax returns themselves, which might need to be reproduced to lend credence to the story. Likewise, it was argued in *Hyde Park v. Yelland* that, in order to refute public claims as to the length of time spent at a villa by the late Princess Diana and her companion Dodi Al-Fayed on the day before their death, it was necessary for a tabloid newspaper to publish security camera footage showing times. At first instance Jacob J held that Yelland had arguable defenses and declined to grant summary judgment in favour of the claimant.¹¹ However, the Court of Appeal subsequently disagreed that printing the footage was legitimate¹² since the information could have been conveyed in a way that did not infringe copyright. The

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9. In *Cadbury Schweppes v. FBI* [2000] FSR 491, at 504, the Supreme Court of Canada opined that 'whether a breach of confidence in a particular case has a contractual, tortious, proprietary or trust flavour goes to the *appropriateness* of a particular equitable remedy but does not limit the court's *jurisdiction* to grant it'. On the various bases for breach of confidence claims in England, see J. Hull, *Commercial Secrecy*, (2nd ed. London, Sweet and Maxwell 2003). Lang, 'The protection of commercial trade secrets', [2003] EIPR 462.
10. *Fressoz & Roire v. France* (29183/95) (2001) 31 EHRR 2; comment at [2000] EL Rev 25 suppl (Human rights survey) 150; Bratza, 'The implications of the Human Rights Act 1998 for commercial practice', [2000] EHRLR 1. Griffiths, 'Copyright law and the public's right to receive information: Recent developments in an isolated community', in E. Barendt and A. Firth (eds), *Yearbook of copyright and media law VI* (2001–2), OUP (2002), at 29. *Fressoz* was recently applied in *HRH Prince of Wales v. Associated Newspapers* [2007] 3 WLR 222 CA at [49].
11. *Hyde Park Residence Ltd v. Yelland* [1999] E.M.L.R. 654; [1999] R.P.C. 655.
12. *Hyde Park Residence Ltd v. Yelland* [2001] Ch 143; [2000] 3 WLR 215; [2000] ECDR 275; [2000] E.M.L.R. 363; [2000] R.P.C. 604 (Eng CA).

defense of public interest, to the extent that it exists in copyright, appears to be a residual defense, relied upon in these rare cases where the form in which information appears is highly significant. In these cases, copyright, privacy and commercial confidence are often intertwined.¹³ The public's right to be informed is also relevant to other torts, such as defamation.¹⁴ Conversely, the courts may consider that an action for breach of confidence or copyright infringement has been brought to circumvent the remedial limitations of defamation cases¹⁵ and refuse injunctive relief.¹⁶

III. GUARDIANS OF THE PUBLIC INTEREST

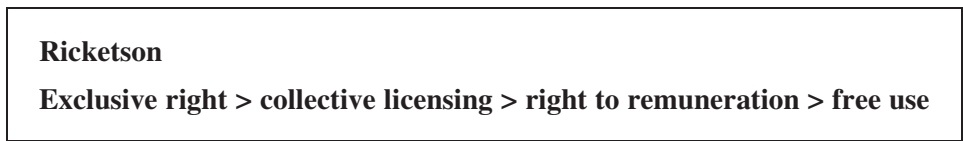
Solicitude for the public interest in the appropriate flow of information is not, of course, the courts' sole province. It can be found in international conventions,¹⁷ national constitutions,¹⁸ legislation or draft legislation,¹⁹ press or broadcasting codes, academic commentary²⁰ and in the notions of fair play, discretion and

13. For argument that the action for breach of confidence should not be applied to privacy cases, but rather a separate tort of invasion of privacy should be recognized or enacted, see A. Schreiber 'Confidence crisis, privacy phobia: Why invasion of privacy should be independently recognised in English law' [2006] IPQ 160.
14. E.g. *Dalban v. Romania* (2000) 8 BHRC 91 (ECHR), case comment 'Freedom of expression: conviction of journalist for criminal defamation', [2000] EHRLR 84–85; *Thoma v. Luxembourg* (38432/97) noted at [2001] EHRLR 587.
15. Refusal of injunction in the interests of free speech: *Bonnard v. Perryman* [1891] 2 Ch 269; *Bestobell v. Bigg* [1975] FSR 421. For the relevance of these principles to trade mark cases involving comparative advertising, see Evans 'Case Comment: *Boehringer Ingelheim Ltd v. Vetplus Ltd*' [2007] EIPR 500 (case reported at [2007] EWCA Civ 583; [2007] E.T.M.R. 67; [2007] H.R.L.R. 33). On freedom of speech generally, see E. Barendt *Freedom of Speech* (2nd edn. OUP, 2005).
16. See, e.g., Lightman J's comments on this in *Service Corporation International v. Channel 4* [1999] EMLR 83; Phillips 'Forebodings and a funeral' [1998] Ent LR 211; E. Barendt *Freedom of speech* (2nd edn. OUP, 2005), cited as the 'surrogacy' argument by Blackburn J in *HRH Prince of Wales v. Associated Newspapers* [2007] 3 WLR 222 at [181].
17. Ricketson, 'The boundaries of copyright: its proper limitations and exceptions: international conventions and treaties', [1999] IPQ 56; the preamble to the WIPO Copyright Treaty of 1996 states 'Recognizing the need to maintain a balance between the rights of authors and the larger public interest, particularly education, research, and access to information, as reflected in the Berne Convention'. See K. Weatherall 'An end to private communications in copyright? The expansion of rights to communicate works to the public' [1999] EIPR 342 (Part 1) and 398 (Part 2); T. Vinje 'Copyright imperilled?' [1999] EIPR 192.
18. For example, the constitutional provisions discussed by the Privy Council in *Observer Publications Limited v. Campbell 'Mickey' Matthew, The Commissioner of Police, The Attorney General* 2001 WL 395210 CA, a case on appeal from The Eastern Caribbean Court of Appeal of Antigua and Barbuda about the refusal of a broadcasting licence. E. Barendt *Freedom of Speech* (OUP, 2005) ch. 1 discusses the provision on freedom of speech in German Basic Law.
19. E.g. EU Proposal for a Decision of the European Parliament and of the Council on establishing a multiannual Community programme on promoting safer use of the Internet and new online technologies COM(2004) 91.
20. E.S. Fitzpatrick 'Copyright imbalance: U.S. and Australian responses to the WIPO Digital Copyright Treaty' [2000] EIPR 214 refers to the public interest in having access to others'

honourable conduct held by individual citizens. This chapter examines the role of public interest considerations at the boundaries between full exclusivity of rights at one extreme, wholly uncontrolled use at the other extreme and several intermediate possibilities. Its focus is mainly on the role of the courts in common law and civil law jurisdictions, but we shall refer to analogous action by treaty makers and legislators.

IV. RICKETSON'S SPECTRUM

Prof Ricketson has suggested²¹ a spectrum for copyright:



A full²² exclusive right does not necessarily empower an author to obtain fair return for use of a work; this will depend on the author's bargaining position, which may be bolstered by a collective agreement, restrictions on assignment or waiver of the right or other statutory backup.²³

'Free use' implies that the work may be used without permission/or payment and can be further subdivided into:

- a. the free use of otherwise protected material (termed 'free use' below); and
- b. use which is free because the material in question enjoys no protection.

In the latter category belong the non-original work and its close relation, the insubstantial part²⁴ of a copyright work.

A similar spectrum may be drawn for confidential information; information lacking the necessary quality of confidence will be unprotected and therefore free for use. Since collective licensing is not usually employed for confidential

works, citing O. Cosgrove, 'Keeping Legal Issue in Perspective on the Internet' (1995) 95 Comp Comm 7. Barendt *Freedom of Speech* (Oxford OUP, 2005) ch. 1 discusses the 'free speech interest' of the public.

21. 'International conventions and treaties', in *The boundaries of copyright*, ALAI study days, Cambridge 1998, published 1999, 5.

22. For the distinction between full exclusive right and the possibility of prevention under the Rome Convention in the context of performers' rights, see J. Reinbothe and S. Von Lewinski, 'The WIPO Treaties 1996: ready to come into force', [2002] EIPR 199, 201.

23. As with the new provisions of s. 32, German Copyright Act: Gutsche, 'New copyright legislation in Germany: Rules on equitable remuneration to provide "just rewards" to authors and performers', [2003] EIPR 366.

24. UK copyright is only infringed by using a substantial part of a work. For comparison of this concept in the context of parody in Spain & elsewhere, see Gimeno 'Parody of songs: a Spanish case and an international perspective' [1997] Ent LR 18.

information, that part of Ricketson's spectrum may be omitted. Whether a defense of public interest leaves a right to remuneration or takes information fully into the free use category is discussed below.

'Modified Ricketson' spectrum for breach of confidence and copyright

Exclusive right > right to remuneration > free use > beyond the bounds of protection

This spectrum is *all* judicially conditioned, but in drawing and holding the lines between the different zones of the spectrum, availability of judicial remedies and the exercise of discretion by judges are of supreme importance. We shall use this spectrum to explore the use of public interest considerations both for copyright and confidential information, in 'holding the line' between the categories.

The intermediate categories are not always in evidence. By way of example, one might consider the judicial 'experiments' in the US with tests for infringement of copyright in software: 'structure, sequence, organisation', 'look and feel', 'abstraction-filtration'.²⁵ Adoption of the latter test moved much software copying from infringement of exclusive rights at the left of the spectrum to use of unprotected material at the right-hand end. It is submitted that the burgeoning of software patenting in the USA and the use of patents to protect online business methods owes much to the failure of copyright to protect software in the USA.²⁶ In the English High Court, Jacob J²⁷ in *Ibcos*²⁸ declined to apply the abstraction/filtration test to determine substantiality, taking what has been described as a 'common-sense application of traditional UK copyright principles to software infringement'.²⁹

As regards the boundary between exclusive right of authors and collective licensing, collective licensing is sometimes said to be a response to market failure,³⁰ in that authors cannot hope to enforce their copyrights on an individual basis. Although the author trades her exclusivity for a right of remuneration by mandating

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25. For an overview of these concepts, see for example P. Samuelson, 'Economic and constitutional influences on copyright law in the United States', [2001] EIPR 409; Derclaye, 'Software copyright protection: can Europe learn from American case law? Part 2', [2000] EIPR 56.
 26. For the death of 'strong copyright' in the USA, see G. Lea, 'Software: protection trends in the 1990s', [1995] Ent LR 276. see also K. Tumbraegel & P. de Villiers 'Copyright protection for the non literal elements of a computer program' [2004] CTLR 34, comparing US, UK, South African and Australian approaches.
 27. Now Jacob LJ, a judge of the Court of Appeal.
 28. [1994] FSR 275.
 29. Stokes 'The development of UK software copyright law: from *John Richardson Computers to Navitaire*' [2005] CTLR 129.
 30. Ricketson, 'The boundaries of copyright: Its proper limitations and exceptions: international conventions and treaties', [1999] IPQ 56; Gordon, 'Fair Use as market failure: A structural and economic analysis of the Betamax case and its predecessors', (1982) 82 Col LR 1600, at 1620 to 1621. Of course, copyright itself may be regarded as an answer to market failure,

a collecting society to license works to third parties,³¹ the collecting society in turn may benefit from the sanctions of exclusivity.³² This will require appropriate standing, access to justice, and the possibility of injunctive relief.³³ A collecting society's standing to sue may be conferred by legislation or by transfer of exclusive rights from authors. Thus copyright collectively enforced may fall into the category of 'exclusive right' or 'right to remuneration', depending on the arrangements between the society and its members. Even those societies which take partial assignments or exclusive licenses of their members' copyrights may find themselves hampered by the limited nature of those rights. In an age of converging rights and for reasons of operational efficiency, collecting societies are merging³⁴ or engaging in joint enforcement ventures.

V. THE PUBLIC INTEREST

The phrase 'public interest' eludes precise definition.³⁵ Considering the public interest in disclosure,³⁶ such an indefinite character is consistent with its role as a defense to otherwise legitimate restrictions upon freedoms. The public interest does *not* comprise all matters in which the public is *interested* as a matter of gossip or curiosity.³⁷ Rather, it covers matters of 'real' or 'legitimate' public concern, on such wide-ranging subjects as the propriety of seal hunting methods,³⁸ the conduct of security forces,³⁹ the identification of a self-publicizing extremist by non-domestic photographs,⁴⁰ the reliability of intoximeters,⁴¹ the exposure of

e.g. Hugenholtz, 'Caching and copyright: the right of temporary copying', [2000] EIPR 482; and T. Power, 'Digitisation of serials and publications', [1997] EIPR 444 and citations.

31. A process characterized as voluntary compulsory licensing by Cohen Jehoram, 'The future of copyright collecting societies', [2001] EIPR 134,135-6.
32. E.g. *Phonographic Performance Ltd v. Maitra* [1998] 1 WLR 870; [1998] 2 All ER 638. Interim relief may be granted where the claimant is equitable rather than full legal owner, e.g. *Performing Right Society v. London Theatre of Varieties* [1924] A.C. 1, 14.
33. R. Fry, 'Copyright infringement and collective enforcement', [2002] EIPR 516.
34. E.g., H. Knopf chronicles the merger of Canadian collecting societies in 'Copyright and the internet in Canada and beyond: convergence, vision and division', [2000] EIPR 262. See also, U. Suthersanen, 'Collectivism of Copyright: The Future of Rights Management in the European Union', in E. Barendt & A. Firth, eds, *The Yearbook of Copyright and Media Law Vol. V* (Oxford, 2008); N. Frabboni 'Cross-border licensing and collective management: a proposal for the online context' [2005] Ent LR 204; Tuma 'Pitfalls and challenges of the EC Directive on the collective management of copyright and related rights' [2006] EIPR (2nd ed. London, Sweet & Maxwell 1994).
35. E.g. Dreier, 'Balancing proprietary and public domain interests', in R. Dreyfuss, L. Zimmerman and H. First (eds), *Expanding the boundaries of intellectual property*, (OUP, 2001) (2001), 297: 'while the term "public interest" is often cited, there is a certain vagueness inherent in it.'
36. See, e.g. A. Sims, 'The Denial of Copyright Protection on Public Policy Grounds' Y. Cripps, 'The legal implications of disclosure in the public interest,' Sweet & Maxwell (2nd edn. London 1994); T. Aplin 'The development of the action for breach of confidence is a post-HRA era' [2007] 1 PQ 19.
37. E.g. *British Steel Corporation v. Granada Television Ltd* [1981] AC 1069.
38. *Bladet Tromso v. Norway* (2000) 29 EHRR 125.
39. *Ogur v. Turkey*, noted at [1999] EHLR 531; *Surek v. Turkey* (1999) BHRC 339.

iniquity,⁴² the correction of misleading information on a celebrity's habits,⁴³ the proper administration of justice,⁴⁴ the perils of Scientology⁴⁵ and possibly brief coverage of sporting fixtures⁴⁶ and other 'major events'.⁴⁷ The public interest in disclosure may of course be outweighed by a countervailing public interest⁴⁸ in respect for copyright⁴⁹ or the maintenance of confidentiality,⁵⁰ for example the confidentiality of medical records,⁵¹ the ability of hospital staff to do their work without being harried by the press,⁵² the identity⁵³ or addresses⁵⁴ of vulnerable children or more generally at the interim stage of litigation, pending trial of the merits.⁵⁵

VI. PUBLIC INTEREST – THE EXCEPTION OR THE RULE?

Although the public interest has been described above as a residual defence, is it really a starting point rather than a final consideration? The US Congressional

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40. *News Verlags GmbH & Co KG v. Austria* (31457/97) (2001) 31 EHRR 8; I. Simon, 'Picture Perfect', [2002] EIPR 368.
 41. *Lion Laboratories v. Evans* [1984] 2 All ER 417.
 42. *Gartside v. Outram* (1856) 26 LJ Ch. 113.
 43. But this did not extend to the use of photographs, even taken in the street outside: *Campbell v. Mirror Group Newspapers Ltd* [2004] UKHL 22; [2004] 2 W.L.R. 1232.
 44. *Medcalf v. Mardell* [2003] 1 AC 120, a case on the wasted costs order.
 45. *Hubbard v. Vosper* [1972] 2 QB 84.
 46. G. Davies, *Copyright and the public interest*, (2nd edn., London, Sweet and Maxwell, 2002), 168–169 cites the French case of *FOCA v. FR3*.
 47. G. Davies, *Copyright and the public interest*, (2nd edn., London, Sweet and Maxwell, 2002), 168–169 cites French Law No. 2000-719 of 1 August 2000 to permit broadcasting of such events on free television.
 48. The balancing act contemplated by Art. 10(2) of the European Convention on Human Rights.
 49. *The Right Honourable Paddy Ashdown MP PC v. Telegraph Group Limited* [2002] Ch. 149; [2002] RPC 5; [2002] ECDR 32; [2002] ECC 19; [2001] 3 W.L.R. 1368; [2001] 4 All E.R. 666; [2001] EMLR 44; [2001] HRLR 57.
 50. *HRH Prince of Wales v. Associated Newspapers Ltd* [2007] 3 WLR 222 CA at 67.
 51. *X v. Y* [1988] 2 All E.R. 648; [1988] R.P.C. 379; *Cornelius v. De Taranto* [2001] EMLR 12 affd [2001] EWCA Civ 1511; [2002] E.M.L.R. 6; (2002) 68 B.M.L.R. 62; [2001] MHLR 217. See also the 'disclosure of source cases' such as *Ashworth Hospital Authority v. MGN Ltd* [2002] UKHL 29; *Aegis Defence Services Ltd v. Stoner* [2006] EWHC 1515 (Ch).
 52. *Nottinghamshire Healthcare National Health Service Trust v. News Group Newspapers Limited* [2002] E.M.L.R. 33; [2002] EWHC 409 (Ch. D); [2002] R.P.C. 49 (Ch. D).
 53. *T v. BBC* [2007] EWHC 1683 (QB); [2007] Fam. Law 904.
 54. *Green Corns* [2005] EMLR 31 (children's care homes).
 55. *Attorney General v. Punch Ltd* [2003] HRLR 14; [2003] EMLR 7; [2002] UKHL 50 (HL); confidentiality in the litigation process itself is discussed by R. Toulson and C. Phipps, *Confidentiality*, Sweet & Maxwell (1996). See also, S.M. Joshua, 'Balancing the public interests: confidentiality, trade secret and disclosure of evidence in EC competition procedures', [1994] ECLR 68.

power to enact copyright laws is premised upon society's interest in the progress of science and the useful arts.⁵⁶ In *Universities UK Ltd v. Copyright Licensing Agency Ltd*,⁵⁷ the UK Copyright Tribunal discussed the 'symbiotic relationship' between publishing and academia in serving the public interest in learning and scholarship. Austin puts it thus:

In the Anglo-American tradition, the conceptual underpinnings of intellectual property rights have much to do with the public interest.⁵⁸

Article 10 of the European Convention on Human Rights⁵⁹ puts freedom of expression first and exceptions second:

1. Everyone has the right to freedom of expression. This right shall include freedom to hold opinions and to receive and impart information and ideas without interference by public authority and regardless of frontiers. This article shall not prevent States from requiring the licensing of broadcasting, television or cinema enterprises.

2. The exercise of these freedoms, since it carries with it duties and responsibilities, may be subject to such formalities, conditions, restrictions or penalties as are prescribed by law and are necessary in a democratic society in the interests of national security, territorial integrity or public safety, for the prevention of disorder or crime, for the protection of health or morals, for the protection of the reputation or rights of others, for preventing the disclosure of information received in confidence, or for maintaining the authority and impartiality of the judiciary.⁶⁰

56. Art. I, s. 8: 'The Congress shall have power . . . to promote the Progress of Science and useful Arts, by securing for limited Times to Authors and Inventors the exclusive Right to their respective Writings and Discoveries.' G. Davies, *Copyright and the public interest*, (2nd edn., London, Sweet and Maxwell, 2002) discusses this 'underlying philosophy in the US law of copyright' at para. 5-038 et seq.

57. *Universities UK Ltd v. Copyright Licensing Agency Ltd*, *Design and Artists Copyright Society Ltd intervening* [2002] EMLR 35; [2002] RPC 36.

58. G. Austin, *Private international law and intellectual property rights: a common law overview*, (Geneva, January 2001) WIPO/PIL/01/5.

59. T. Pinto, 'The influence of the European Convention On Human Rights on intellectual property rights', [2002] EIPR 209; ? cite Phillipson & Fenwick on bipartite nature of Arts 8 and 10.

60. Convention rights under Arts 10 and 8 have been given horizontal effect by absorption into existing causes of action such as breach of confidence: *Murray v. Express Newspapers plc* [2007] EWHC 1908 at [18]–[21], commenting upon Campbell, n. 43 above at [213–22] as regard remedies, convention rights must be taken into account by the court when deciding whether or not to grant an injunction. Thus, in *The Right Honourable Paddy Ashdown MP PC v. Telegraph Group Limited* [2002] Ch. 149; [2002] RPC 5; [2002] ECDR 32; [2002] ECC 19; [2001] 3 WLR 1368; [2001] 4 All E.R. 666; [2001] EMLR 44; [2001] HRLR 57 one also finds the following statement:

'We would add that the implications of the Human Rights Act 1998 must always be considered where the discretionary relief of an injunction is sought, and this is true in the field of copyright quite apart from the ambit of the public interest defence under section 171(3).'

The European Court of Human Rights has not ranked the various rights conferred by the Convention,⁶¹ and allows a wide ‘margin of appreciation’ in Member States’ implementation of the rights *inter se*. English⁶² quotes the German Federal Constitutional Court as holding that neither privacy nor free speech ‘can claim precedence over the other’. However, it appears that the courts of other states have historically used freedom of expression as the starting point. Freedom of expression has been characterized as the basic rule in France to which privacy is the exception.⁶³ Similar judicial comments may be found in UK case-law.⁶⁴ For example, in *Douglas, Zeta-Jones and Northern & Shell Plc. v. Hello! Ltd.*⁶⁵

English law, as is well known, has been historically based on freedoms, not rights. The difference between freedom-based law and rights-based law was memorably expressed by Lord Goff of Chieveley in the course of his speech in *Att.-Gen. v. Guardian Newspapers Ltd. (No. 2)* [1990] 1 A.C. 109 when he said he could see no inconsistency between English law on freedom of speech and Article 10 of the European Convention on Human Rights. He said at 283F: ‘The only difference is that, whereas Article 10 of the Convention, in accordance with its avowed purpose, proceeds to state a fundamental right and then to qualify it, we in this country (where everybody is free to do anything, subject only to the provisions of the law) proceed rather upon an assumption of freedom of speech, and turn to our law to discover the established exceptions to it’.

Although in *Campbell v. Mirror Group*⁶⁶ Lord Hope stated that a balancing act between Article 8 and Article 10 was required once a case passed the initial threshold of confidence or privacy, he went on to stress the need for caution in impeding freedom of speech and the public’s right to receive information and ideas.⁶⁷

61. This is reflected in the decisions of the English courts; e.g. *Campbell v. MGM* [2004] 2 AC 457; Lord Browne of Madingley *v. Associated Newspapers Ltd* [2007] EWCA Civ 295 [2007] 3 W.L.R. 289 at [39], citing *In re S (A Child) (Identification: Restrictions on Publication)* [2005] 1 AC 593; *McKennitt v. Ash* [2007] 3 WLR 194; and *HRH Prince of Wales v. Associated Newspapers Ltd* [2007] 3 WLR 222. G. Beck ‘Human Rights Adjudication under the ECHR between Value Pluralism and Essential Contestability’ [2008] EHRLR 214 argues a bias in favour of Art. 8.

62. ‘Protection of privacy and freedom of speech in Germany’, in M. Colvin (ed.), *Developing key privacy rights*, Hart Publishing (2002), at 87, citing a 1973 case; the freedom of expression guaranteed by Art. 10 of the European Convention on Human Rights appears in Art. 5 of the German Constitution. However, the European Court of Justice found the German Courts’ protection of privacy too weak in *Van Hannover v. Germany* [2004] EMLR 21; (2005) 4 EHRR 1.

63. M. Colvin (ed.), *Developing key privacy rights*, Hart Publishing (2002), 11 and ch. 3 therein by C. Dupre, ‘The protection of private life versus freedom of expression in French law’, 68–69.

64. And in the legislation and case law of Commonwealth jurisdictions, such as New Zealand: R. Tobin, ‘Freedom of expression and privacy in New Zealand’, in M. Colvin (ed.), *Developing key privacy rights*, Oxford Hart Publishing 2002, 129–130.

65. [2001] HRLR 26; [2001] QB 967; [2001] FSR 40; [2001] EMLR 9 (CA).

66. [2004] 2 AC 457 at 107 et seq.

67. Citing *Jerslid v. Denmark* [1994] 19 EHRR 1 [31].

A less hierarchical approach was described in the breach of confidence case of *Imutran Limited v. Uncaged Campaigns Limited and Daniel Louis Lyons*.⁶⁸

In the case of subsection (4) it must be borne in mind that the courts emphasised the importance of freedom of expression or speech long before the enactment of Human Rights Act 1998. See Halsbury's Laws of England 4th ed. reprint Vol. 8(2) para. 107 and cases there cited. But neither those cases nor the provisions of s.12(4) require the court to treat freedom of speech as paramount. There are many reported cases in which the court has had to balance freedom of expression or speech with other aspects of the public interest. See also Snell's Equity 30th ed. paras 45–75.

In those circumstances I do not consider that the subsection is intended to direct the court to [p]lace even greater weight on the importance of freedom of expression than it already does. As I said in paragraph 34 of my judgment in *Ashdown v. Telegraph Group Ltd* the requirement 'to pay particular regard' contemplates specific and separate consideration being given to this factor.

I turn then to the claim for breach of confidence. I have been referred to the well known line of cases consisting of *Initial Services v. Putterill* [1968] 1 Q.B. 396; *Hubbard v. Vosper* [1972] 2 Q.B. 84; *Francome v. Mirror Group Newspapers Ltd* [1984] 1 W.L.R. 892; *Lion Laboratories Ltd v. Evans* [1985] Q.B. 526; *Re A Company's Application* [1989] Ch. 477 and *A-G v. Observer Ltd* [1990] 1 A.C. 109. Each of them demonstrates that the public interest in disclosure may outweigh the right of the plaintiff to protect his confidences. They demonstrate that the court will also consider how much disclosure the public interest requires; the fact that some disclosure may be required does not mean that disclosure to the whole world should be permitted.

In *HRH Prince of Wales v. Associated Newspapers*,⁶⁹ the Court of Appeal criticized the approach at first instance of starting from *Campbell*, Article 8 and Article 10 ECHR in a case such as this where the source of the leak was under express obligations of confidence. As the initial judgment was a summary one, it behoved the court to consider whether the law was settled such that it could be satisfied there was no defense on the facts. Lord Phillips CJ went on to observe, at 68:

[t]he test to be applied when considering whether it is necessary to restrict freedom of expression in order to prevent disclosure of information received in confidence is not simply whether information is a matter of public interest but whether, in all the circumstances, it is in the public interest that the duty of confidence should be breached.

68. [2001] ECDR 16; [2001] HRLR 31; [2001] EMLR. 21; [2002] FSR 2. E. Barendt. *Freedom of Speech* (Oxford, OUP, 2005) advocates priority of free speech over the 'reputation rights' of Art. 10(2), but not privacy rights under Art. 8, echoing H. Rogers and H. Tamlinson's 'Privacy and Expression' [2003] EHRLR 37.

69. [2007] 3 WLR 222 CA at [24].

This may be compared to the contextual approach of the Canadian courts to balancing the rights and freedoms conferred by the 1982 charter of rights.⁷⁰ On the balance between freedom of speech and privacy, Australian law has been described as establishing ‘ad hoc balances between the public interest in freedom of expression and the protection of privacy’, resolving conflicts through ‘pragmatic compromise’.⁷¹ In New Zealand, the courts have chosen to make a clear distinction between breach of confidence and an action for invasion of privacy,⁷² an approach applauded by Morgan⁷³ and consonant with Barendt’s argument that privacy should be a constitutional value (available for horizontal application through the courts) as well as a right (vertical application).⁷⁴ In *Newspapers*⁷⁵ Lord Phillips CJ commented on horizontal *HRH Prince of Wales v. Associated* effect in the following terms:

The importance of private duties of confidence in the context of Article 10 rights is not much explored in either the English or the Strasbourg authorities. Mr Tomlinson [Queen’s counsel for Prince Charles] suggested that this was because the horizontal effect of the convention consequent upon the recognition by the Strasbourg court that states are under a positive obligation to ensure that their laws protect the fundamental freedoms is a recent development. We suspect that this is correct.

It is clear from cases such as *Murray, McKennet, Campbell, Theakston*, and *Hyde Park* that different aspects of personal information may be treated differently, both as regards the quality of confidence/privacy and the operation of the public interest defense. In particular, photographs are regarded as more intrusive but more indicative than words.

Many of the earlier cases⁷⁶ and much literature⁷⁷ on freedom of expression concerned what may loosely be called political speech. However, public interest cases appear to defy meaningful categorization.⁷⁸ This may be evidence of the ‘pragmatic genius of the common law’⁷⁹ but may also be a sign that the public

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70. Russell, ‘The impact of the charter of Rights on privacy and freedom of expression in Canada’, M. Colvin (ed.), *Developing key privacy rights*, (Hart Publishing 2002), at p. 119–121 cites *Big M Drug Mart* [1985] 1 SCR 295; *Dagenais v. CBC* [1994] 3 SCR 835; *R v. Mills* [1999] 3 SCR 668.
 71. Lindsay, ‘Freedom of expression, privacy and the media in Australia’, in Colvin (ed.) *Developing key privacy rights* edn. 70 at pages 195 and 160.
 72. *Hosking v. Runting* [2005] 1 N.Z.L.R. 1; however, in *HRH Prince of Wales v. Associated Newspapers* [2007] 3 WLR 222 CA, Lord Phillips CJ observed at [65] that time had moved on and the New Zealand court’s view of development of English law was seen as inaccurate.
 73. S. Morgan ‘Privacy in the House of Lords, again’ [2004] LQR 563.
 74. E. Barendt *Freedom of Speech* (Oxford, OUP, 2005) at 245.
 75. [2007] 3 WLR 222 C. at [31].
 76. E.g. *R (on the application of Pro-Life Alliance) v. BBC* [2003] 2 All ER 977; [2003] 2 WLR 1403; [2003] ACD 65; [2003] EMLR 23; E. Barendt, ‘Free Speech and Abortion’, [2003] PL 580.
 77. With honourable exceptions, e.g. Munro, ‘The value of commercial speech’, [2003] CLJ 134 and citations. Hare, ‘*Is the privileged position of political expression justified?*’, in J. Beatson and Y. Cripps (eds.), *Essays in honour of Sir David Williams QC*, Oxford, Clarendon Press (2000).
 78. *Hyde Park Residence Ltd v. Yelland*, [2000] 3 WLR 215 (Eng CA), per Mance LJ, dissenting.
 79. C. Forsyth, ‘The protection of political discourse: pragmatism or incoherence’, in J. Beatson and Y. Cripps (eds.), *Essays in honour of Sir David Williams QC*, Oxford, Clarendon Press (2000).

interest is a more general and fundamental consideration. It is submitted that the public interest in fact operates at four stages in the determination of rights. First, the public interest may be served by the establishment or recognition of a private right – to confidence, private life, or author’s right.⁸⁰ Secondly it is the basis for ‘everyday’ exceptions to private rights, such as the exceptions and limitations to copyright.⁸¹ Thirdly it may provide a defense to a claim, which is likely to be exceptional and residual where legislation provides a system of specific defenses. Fourthly, it may enter into the exercise of judicial discretion how precisely to enforce a right.

This means that, far from being an impermissible extension of freedom of speech or of the exceptions and limitations to copyright, the public interest may be taken into account at each stage to ensure that a system of rights is working reasonably fairly.⁸² The analysis is supported in the EU and elsewhere by acceptance that intellectual property may be overridden by competition law,⁸³ constitutional law,⁸⁴ media and consumer laws⁸⁵ and (sometimes) contract. Furthermore, proper consideration of a public interest or a competition argument in a copyright case will necessarily satisfy the ‘three-step test’ required by Article 13 TRIPS. This argument will be elaborated next.

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80. Recital 9 of Directive 2001/29/EC asserts that copyright and related rights should be harmonized at a high level to encourage creativity in the interests of ‘authors, performers, producers, consumers, culture, industry and the public at large’.
 81. Now somewhat harmonized within the EU by Arts 5 and 6 of Directive 2001/29/EC on the harmonization of copyright and related rights in the Information Society. For a summary of the recommendations of the Gowers Review of Intellectual Property, see <www.ipo.gov.uk/policy.htm> and links, (last accessed 28 April 2008).
 82. See also the preamble to the Draft Protocol to the WIPO Performances and Phonograms Treaty concerning Audiovisual Performances: ‘Recognizing the need to maintain a balance between the rights of performers in their audiovisual performances and the larger public interest, particularly education, research and access to information’. Von Lewinski, ‘The WIPO diplomatic conference on audiovisual performances: a first resume’, [2001] EIPR 333.
 83. For the EC, see O. Vrins, ‘Intellectual property licensing and competition law: some news from the front – the role of market power and double jeopardy in the EC Commission’s new deal’, [2001] EIPR 576; see also McCurdy, ‘Intellectual property and competition: Does the essential facilities doctrine shed any new light?’, [2003] EIPR 472. For the US, Antitrust Guidelines for the Licensing and Acquisition of Intellectual Property, 59 Fed. Reg. 41, 339 (1994). For recognition of antitrust competence in the context of the Berne Convention, see S. Ricketson, ‘The boundaries of copyright: its proper limitations and exceptions: international conventions and treaties’, [1999] IPQ 56. ‘Although Article 17 has been interpreted as being restricted to matters of censorship, it has also been acknowledged by successive Revision Conferences that Member States still retain certain rights to regulate the rights of copyright owners where this is necessary for the control of monopolistic and other anti-competitive practices.’
 84. Clashes between US trade secret law and the Constitutional first amendment (free speech) are said to be rare – e.g. R. Milgrim, *Milgrim On Trade Secrets*, LexisNexis (1967), at 12.06 (as updated at 2002), but Samuelson has predicted that first amendment defenses will increase: ‘Resolving Conflicts Between Trade Secrets and the First Amendment’, (Draft as of 20 March 2003) posted at <www.sims.berkeley.edu/~pam/papers/ TS%201st%20A%203d%20dr.pdf>.
 85. T. Dreier, ‘Balancing proprietary and public domain interests’, in R. Dreyfuss, D. Zimmerman and H. First (eds), *Expanding the boundaries of intellectual property*, Oxford University Press (2001), at 309–312.

VII. COPYRIGHT, COMPETITION LAW AND THE THREE-STEP TEST⁸⁶

It would be a serious error to see intellectual property rights and competition law as irreconcilable opponents that fight for supremacy. Instead one should start by looking at the way in which intellectual property rights fit into our modern society and how their existence can be justified.⁸⁷ Why are these intangible property rights created? Economists argue that if everyone would be allowed to use the results of innovative and creative activity freely, the problem of ‘free riders’⁸⁸ would arise.⁸⁹ No one would invest in innovation or creation, except in a couple of cases where no other solution would be available,⁹⁰ as it would give them a competitive disadvantage.⁹¹ All competitors would just wait until someone else made the investment, as they would be able to use the results as well without investing money in innovation and creation and without taking the risks that the investment would not result in the innovative or creative breakthrough it aimed at.⁹² The cost of the distribution of the knowledge is, on top of that, insignificant.⁹³ As a result the economy would not function adequately because we see innovation and creation as an essential element in a competitive free market economy. In this line of argument innovation and creation are required for economic growth and prosperity.⁹⁴ In this

86. I am grateful to Prof. Paul Torremans for his assistance in drafting this section of the chapter.

87. See in general P. Torremans, *Holyoak and Torremans Intellectual Property Law*, Butterworths (5th edn., 2008, OUP), pp. 10–24.

88. See R. Benko *Protecting Intellectual Property Rights: Issues and Controversies American Enterprise Institute for Public Policy Research* (AEI Studies 453) (1987), 17.

89. Inappropriability, the lack of the opportunity to become the proprietor of the results of innovative and creative activity, causes an under-allocation of resources to research activity, innovation and creation: see K. Arrow, ‘Economic Welfare and the Allocation of Resources for Invention’, in National Bureau for Economic Research, *The Rate and Direction of Inventive Activity: Economic and Social Factors*, Princeton, Princeton University Press (1962), at 609–625. The role of licensing income in support of the ‘never-ending task’ of mapping the UK was referred to in *Her Majesty’s Stationery Office and Another v. The Automobile Association Limited and Another* [2001] E.C.C. 34; allegations of abuse of dominance, contrary to Art. 82 EC Treaty, were struck out.

90. E.g. a case where the existing technology is completely incapable of providing any form of solution to a new technical problem that has arisen.

91. See H. Ullrich, ‘The Importance of Industrial Property Law and Other Legal Measures in the Promotion of Technological Innovation’, [1989] *Industrial Property* 102, at 103.

92. One could advance the counter-argument that inventions and creations will give the innovator an amount of lead time and that the fact that it will take imitators some time to catch up would allow the innovator to recuperate his investment during the interim period. In many cases this amount of lead time will, however, only be a short period, too short to recuperate the investment and make a profit. See also E. Mansfield, M. Schwartz and S. Wagner, ‘Imitation Costs and Patents: An Empirical Study’, [1981] *Ec J* 907, 915 et seq.

93. See R. Benko, *Protecting Intellectual Property Rights: Issues and Controversies*, American Enterprise Institute for Public Policy Research (AEI Studies 453)(1987), 17.

94. See R. Benko, *Protecting Intellectual Property Rights: Issues and Controversies*, American Enterprise Institute for Public Policy Research (AEI Studies 453)(1987), Ch. 4 at 15, and US Council for International Business, *A New MTN: Priorities for Intellectual Property*, (1985), 3.

starting point one recognizes very clearly elements of public interest, i.e. as the needs of society. Property rights should be created if goods and services are to be produced and used as efficiently as possible in such an economy. The perspective that they will be able to have a property right in the results of their investment will stimulate individuals and enterprises to invest in research and development.⁹⁵ These property rights should be granted to someone who will economically maximize profits.⁹⁶ It is assumed that the creator or inventor will have been motivated by the desire to maximize profits, either by exploiting the invention or creation himself or by having it exploited by a third party, so the rights are granted to them.⁹⁷

But how does such a legally created monopolistic exclusive property right fit in with the free market ideal of perfect competition? At first sight every form of a monopoly might seem incompatible with free competition, but we have already demonstrated that some form of property right is required to enhance economic development as competition can only play its role as market regulator if the products of human labour are protected by property rights.⁹⁸ In this respect the exclusive monopolistic character of the property rights is coupled with the fact that these rights are transferable. These rights are marketable; they can, for example, be sold as an individual item. It is also necessary to distinguish between various levels of economic activity as far as economic development and competition are concerned. The market mechanism is more sophisticated than the competition/monopoly dichotomy. Competitive restrictions at one level may be necessary to promote competition at another level. Three levels can be distinguished: production, consumption and innovation. Property rights in goods enhance competition on the production level, but this form of ownership restricts competition on the consumption level. One has to acquire the ownership of the goods before one is allowed to consume them and goods owned by other economic players are not directly available for one's consumption. In turn, intellectual property imposes competitive restrictions on the production level. Only the owner of the patent in an invention may use the invention and only the owner of the copyright in a literary work may produce additional copies of that work. These restrictions benefit competition on the innovative level. The availability of property rights on each level guarantees the development of competition on the next level. Property rights are a prerequisite for the normal functioning of the market mechanism.⁹⁹ Or, to take the example of patents: 'patents explicitly prevent the

95. Lunn, 'The Roles of Property Rights and Market Power in Appropriating Innovative Output', [1985] *Journal of Legal Studies* 423, 425.

96. M. Lehmann, 'Property and Intellectual Property – Property Rights as Restrictions on Competition in Furtherance of Competition', [1989] *IIC* 1, 11.

97. For an economic-philosophical approach see also Mackaay, 'Economic and Philosophical Aspects of Intellectual Property Rights', in M Van Hoecke (ed.), *The Socio-Economic Role of Intellectual Property*, Rights Story-Scientia (1991), 1–30.

98. M. Lehmann, 'Property and Intellectual Property – Property Rights as Restrictions on Competition in Furtherance of Competition', [1989] *IIC* 1, 12.

99. M. Lehmann, 'The Theory of Property Rights and the Protection of Intellectual and Industrial Property', [1985] *IIC* 525, 539.

diffusion of new technology to guarantee the existence of technology to diffuse in the future'.¹⁰⁰ Copyright and the restrictions on copying and communication to the public which it imposes are needed to enhance further creation of copyright work, which is clearly what is required and desirable from a public interest point of view. This is the only way in which copyright can in the words of the American Constitution play its public interest role 'to promote science and the useful arts'.¹⁰¹

Not only does this go a long way in demonstrating that the copyright system right from its inception is influenced heavily by public interest imperatives and that the balance which it tries to achieve between the interest of the rightholders and of the users-public is based on public interest considerations. Competition law is also used as a tool to regulate the use that is made of copyright in a later stage. Excesses that can not be reconciled with the justification for the existence of copyright, i.e. that do not serve to achieve the public interest aims of copyright, will come to be seen as breaches of competition law. Yet again the public interest is involved, this time in regulating the use of the exclusivity granted by copyright.¹⁰² The *Magill*¹⁰³ and *IMS*¹⁰⁴ cases are good examples in this area.

Magill was concerned with the copyright in TV listings.¹⁰⁵ The broadcasters who owned the copyright refused to grant a license to Magill, to produce a comprehensive weekly TV listings magazine for the Irish market. The case shows clearly that there is nothing wrong with the copyright as such. The problem is clearly situated at the level of the use that is made of the copyright. Here again the starting point is that it is up to the rightholder to decide which use to make of the right and that as such a refusal to license does not amount to a breach of competition law. But the Court of Justice argued that a refusal might in exceptional circumstances constitute an abuse.¹⁰⁶ These exceptional circumstances involved the following in this case. The broadcaster's main activity is broadcasting; the TV guides market is only a secondary market for them. By refusing to provide the basic programme listing information, of which they were the only source, the broadcasters prevented the appearance of new products which they did not offer and for which there was a consumer demand. The refusal could not be justified by virtue of

100. R. Benko, *Protecting Intellectual Property Rights: Issues and Controversies*, American Enterprise Institute for Public Policy Research (AEI Studies 453)(1987), ch. 4 at 19.

101. US Constitution, Art. 1, s. 8, clause 8.

102. See P. Torremans, *Holyoak and Torremans Intellectual Property Law*, OUP (5th ed. 2008), 297–312.

103. Joined cases C-241/91 P and C-242/91 P *Radio Telefis Eireann and Independent Television Publications Ltd v. EC Commission* [1995] ECR I-743, [1995] All ER (EC) 4161.

104. Case C-481/01 *IMS Health v. NDC Health*, [2004] 4 CMLR; 1543 Order of the President of the Court of Justice of 11 April 2002 in Case C-481/01 P(R) [2002] 5 CMLR 44; Order of the President of the Court of First Instance of 10 August 2001 in case T-184/01 R [2001] ECR II-2349 and Order of the President of the Court of First Instance of 26 October 2001 in case T-184/01 R [2001] ECR II-3193.

105. The English cases of *ITP/BBC v. Time Out* [1984] FSR 64 had established the subsistence of copyright in such listings.

106. Joined cases C-241/91 P and C-242/91 P *Radio Telefis Eireann and Independent Television Publications Ltd v. EC Commission* [1995] ECR I-743, [1995] All ER (EC) 4161, paras 54, 57.

their normal activities. And, by denying access to the basic information which was required to make the new product, the broadcasters were effectively reserving the secondary market for weekly TV guides to themselves.

In essence, the use of copyright to block the appearance of a new product for which the copyright information is essential and to reserve a secondary market to oneself is an abuse and cannot be said to be necessary to fulfil the essential function (reward and encouragement of the author) of copyright. Here again one clearly sees the public interest input. Competition law is used to make sure that copyright is used according to its proper intention, i.e. in the public interest. Any abuse of the right against the public interest will constitute a breach of competition law.¹⁰⁷

*IMS Health*¹⁰⁸ is the complex follow up case. IMS Health had developed a brick structure to facilitate the collection of marketing data on the German pharmaceutical market. It owned the copyright in that brick structure and refused to grant a license to its potential competitors. In comparison with *Magill* a number of complicating factors arise. First of all it was not entirely clear whether there is a secondary market involved at all, as IMS Health and its competitors both wished to operate on the primary market for the collection of pharmaceutical data in Germany and secondly it is also not clear whether in the circumstances the emergence of a new product would be blocked, as the competitors were only interested in copying IMS' block structure without necessarily providing the user with a different product as a result of such use. The main point in *IMS Health* is however not as much the question whether the requirements of reserving a secondary market to oneself and of blocking the emergence of a new product can be defined in a more flexible way, but rather the question whether these two requirements need to be met cumulatively or whether meeting one of them is sufficient to trigger the operation of competition law. The definitional problems really come down to defining the boundaries of the public interest on this point and the question whether the requirement apply in a cumulative manner defines when the threshold for an intervention by competition law in defense of public interest concerns is met.

It is therefore also obvious that proper consideration of a public interest argument in a copyright case will necessarily satisfy the three step test.¹⁰⁹ We are here by definition not concerned with the first part of the argument developed above, that is, the public interest input in designing the rules of copyright themselves as a bundle of rights that are awarded in the public interest. We are rather concerned with the stage at which the exercise of these rights is interfered with for public

107. P. Torremans, *Holyoak and Torremans Intellectual Property Law*, OUP (5th edn. 2008), pp. 298–302.

108. Case C-481/01 *IMS Health v. NDC Health*, [2004] 4 CMLR 1543 Order of the President of the Court of Justice of 11 April 2002 in case C-481/01 P(R) [2002] 5 CMLR 44; Order of the President of the Court of First Instance of 10 August 2001 in case T-184/01 R [2001] ECR II-2349 and Order of the President of the Court of First Instance of 26 October 2001 in case T-184/01 R [2001] ECR II-3193.

109. Art. 13 TRIPS Agreement 1994; see M. Senftleben *Copyright, Limitations and the Three-step Test: An Analysis of the Three-step Test in International and EC Copyright Law: Vol 13 (Information Law)* The Hague, (Kluwer Law International, 2004).

interest reasons. First of all, such an interference will only occur in special cases, i.e. when public interest concerns are raised by a certain use of copyright. Secondly, the interference will not conflict with the normal exploitation of the copyright work, as it will only occur when copyright is used for purposes for which it was not intended and which cannot be justified under the economic justification for the existence of copyright. In such circumstance the use that is affected is clearly not normal use. And thirdly, there cannot be an unreasonable prejudice to the legitimate interests of the copyright owner. Any legitimate interest concerns the correct, (that is, justifiable), use of copyright by the rightholder. Such use is not affected in the first place. This explains why all three stages of the test are satisfied.

We shall now consider how other aspects of the public interest govern the setting and enforcement of boundaries on the ‘modified Ricketson’ spectrum.

VIII. EXCLUSIVITY VERSUS RIGHT TO REMUNERATION

As mentioned earlier, authors may voluntarily convert their exclusivity into a right to remuneration by mandating a collecting society to administer the right. In the case of reprographic copying, German and other countries’ laws permit private copying of works, subject to the payment and distribution of levies on machines such as photocopiers, fax machines, scanners and CD writers.¹¹⁰ This system may be regarded as an involuntary conversion of exclusive rights into a mere right to remuneration. In this case, the collecting societies do not take over any rights of exclusion against users. The system is permitted by Article 5(2)(a) of directive 2001/29 on copyright in the information society and is being retained¹¹¹ and extended to a wider range of works, subject to the ability of authors to use technical copy-protection measures.¹¹² Distribution of reprographic levies must inevitably be an inexact science. Rosenblatt¹¹³ refers to claims by users that even collecting societies’ standard tariffs are not in the public interest but they provide at least some correlation between use, payment and reward to creators.

110. Schaal, ‘The copyright exceptions of Art.5(2)(a) and (b) of the EU Directive 2001/29’, [2003] Ent LR 117, sets forth the relevant provisions of the German Urheberrechtsgesetz or Copyright Act of 1965 and case law on its application to newer copying technologies. Recital 37 of Directive 2001/29/EC merely asserts that national reprographic schemes do not create barriers to the internal market, although Recital 38 makes distinction between analogue and digital private copying.

111. M. Schwarz, ‘Germany: Copyright – Legislation’, [2002] Ent LR N74; see also M. Liholm, ‘GEMA and IFPI’, [2002] EIPR 112 for information on collecting societies.

112. S. 95(a); recital 39 of directive 2001/29/EC states that an exception for private copying should not inhibit the use of technological protection measures or their enforcement but Art. 6(4) obliges rightsholders or Member States to enable a user with legal access to benefit from the exception – principles difficult to reconcile.

113. H. Rosenblatt, ‘Copyright assignments: rights and wrongs – the collecting societies’ perspective’, [2000] IPQ 187: ‘Some users express concern that set tariffs are not in the public interest and argue on this basis for non-exclusivity. However, the amount of remuneration set by a collecting society may be subject to public supervision such as a reference to the Copyright Tribunal.’

The ‘rental and lending’ directive 92/100/EEC harmonized the laws of EC Member States with regard to the rights of authors and performers over commercial rental and public lending. Article 2(5) contains a mandatory provision that, by entering into a film production agreement, a performer is presumed to have transferred his or her rental right to the producer. The performer may contract to the contrary and in any event has an unwaivable right to equitable remuneration for rental. A preamble to the Directive makes clear that such remuneration may comprise a single contract payment.

Where exclusive rights are conferred and retained, judges might be expected to uphold them by granting injunctions to restrain unauthorized use. In *Shelfer v. City of London Electric Lighting Company*,¹¹⁴ the English Court of Appeal held that only in exceptional cases should the court refuse injunctions to prevent continuing damage to property. An attack on this principle was launched in *Phonographic Performance Ltd v. Maitra*,¹¹⁵ where it was argued that the grant of an unlimited injunction to restrain future infringement amounted to an abuse of process. The argument was rejected, even although such an injunction might also operate as a lever to obtain payment for past infringement. The court affirmed that the owner of exclusive rights was, in general, entitled to prevent unlicensed use and to grant licenses on such terms as they thought fit.

However, the remedy of a final injunction may sometimes be refused, even though infringement of rights has been established. In *Ludlow Music Inc v. Williams (No.1)*¹¹⁶ the claimant sought summary judgment for infringement of copyright. Despite giving judgment in the claimant’s favour on infringement, Nicholas Strauss, QC, sitting as a deputy high court judge, refused to grant an injunction. He reiterated the general principle that, in the absence of special circumstances, property rights would be enforced by injunction, so that a defendant could not buy the ability to infringe rights by payment of damages. Noting the original reason for this general rule – the inadequacy of damages as a remedy in respect of future acts – the judge held it arguable that there had been acquiescence by the claimant, whose original complaint mentioned only financial compensation, thus suggesting that the claimant was interested only in money. There was a further hearing¹¹⁷ by Pumfrey J. of the claims to relief, at which the defendant argued that damages in lieu of an injunction could and should be awarded under section 50 of the Supreme Court Act 1981.¹¹⁸ In the outcome, an injunction was awarded to prevent future pressings of the disputed record track, but the defendant was not restrained in relation to existing pressings. ‘Exceptional’ circumstances were held to be present in *Banks v. EMI Songs Ltd (formerly CBS Songs Ltd) (No.2)*.¹¹⁹ The

114. [1895] 1 Ch. 287.

115. [1998] 1 WLR 870, [1998] 2 All ER 638.

116. [2000] EWHC 456; [2001] FGR 271. See J. Phillips ‘The risk that rewards: copyright infringement today’, [2001] Ent LR 103. See also, G. Harbottle, ‘Permanent injunctions in copyright cases: when will they be refused’, [2001] EIPR 154.

117. [2002] FSR 57; [2002] ECDR CN6; Robinson, ‘Copyright – lyrics – remedies’, [2003] Ent LR N-38.

118. The statutory successor to Lord Cairns’ Act.

119. [1996] EMLR 452.

defendant had received assurance from a friend that he, not the claimant, was the author of a disputed song. By the time of the hearing as to remedies, the claimants' song had been used for eleven years and had enjoyed its commercial success in their hands.

Although the decision in *Ludlow Music* has been criticized by Phillips and others,¹²⁰ it is submitted that the existence of a discretion to grant or refuse an injunction, even when infringement has been established at trial or in summary judgment, is an important power and safeguard of the public interest. There is implicit support for this in the case of *Biogen v. Medeva*,¹²¹ where the defendant had pleaded that an injunction restraining the manufacture or sale of its hepatitis B vaccine¹²² would lead to loss of human life and/or avoidable damage to human health. The claimant asked the court to strike out this part of the defense, but the court declined to do so.

The Supreme Court of Canada considered the propriety of granting a final injunction for breach of confidence in *Cadbury Schweppes v. FBI Foods*.¹²³ In that case the defendant had for nearly six years been marketing a product originally developed using information confidential to the plaintiff's predecessor in title. The product could have been developed without breach of confidence, leading the court to conclude that the information was not very special. In the circumstances the court took the view that a money remedy was adequate, limited to a twelve month period within which an alternative product could have been developed. In the circumstances the court of first instance had been justified in refusing an injunction.

In *Ashdown v. Telegraph*,¹²⁴ the English Court of Appeal recognized that the public interest might militate against the grant of an injunction, but leave a claimant free to seek remuneration or damages for use of material protected by copyright as well as confidentiality:

For these reasons, we have reached the conclusion that rare circumstances can arise where the right of freedom of expression will come into conflict with the protection afforded by the 1988 Act, notwithstanding the express exceptions to be found in the Act. In these circumstances, we consider that the court is bound, in so far as it is able, to apply the Act in a manner that accommodates the right of freedom of expression. This will make it necessary for the court to look closely at the facts of individual cases (as indeed it must whenever a 'fair dealing' defense is raised). We do not foresee this leading to a flood of litigation.

The first way in which it may be possible to do this is by declining the discretionary relief of an injunction. Usually, so it seems to us, such a step will

120. N. 116, above. In *Nairtaire Inc. v. Easyjet airline Co Ltd.* (No. 2) [2005] EWHC 0282; [2006] RPC 4, Jumpfrey I. discussed the court's discretion and granted an injunction.

121. [1993] RPC 475.

122. Allegedly superior to the claimant's vaccine.

123. [2000] FSR 491.

124. *The Right Honourable Paddy Ashdown MP PC v. Telegraph Group Limited* [2002] Ch. 149; [2002] RPC 5; [2002] ECDR 32; [2002] ECC 19; [2001] 3 WLR. 1368; [2001] 4 All ER. 666; [2001] EMLR 44; [2001] HRLR 57.

be likely to be sufficient. If a newspaper considers it necessary to copy the exact words created by another, we can see no reason in principle why the newspaper should not indemnify the author for any loss caused to him, or alternatively account to him for any profit made as a result of copying his work. Freedom of expression should not normally carry with it the right to make free use of another's work.¹²⁵

A defense of public interest may therefore prevent a claimant for exercising full exclusive rights, but does not necessarily deny a claim to remuneration. This view appears to be shared by Burrell and Coleman,¹²⁶ although Sims argues that only a complete defense is meaningful.¹²⁷ The latter view runs counter to the thrust of English authority.

IX. EXCLUSIVE RIGHT OR RIGHT TO REMUNERATION VERSUS FREE USE

In the case of texts and speeches of public importance, the Berne Convention provides that signatory states may refrain from conferring protection, or may permit certain uses. For example, Article 2(4) provides that for official texts of a legislative, administrative or legal nature, protection is a matter for the state concerned, rather than a specific obligation (Stockholm revision onwards). Ricketson¹²⁸ refers to the public policy reasons for making these texts available to all and asserts that they should not be subject at all to private proprietary restrictions. He notes that most national laws, including those of Germany, Italy, Japan and Mexico, excluded protection for official texts, although in the UK they are copyright but subject to 'permitted acts', so may be used freely in appropriate circumstances. The public interest argument here seems to be that copyright ensures investment in their publication and distribution, especially where a publisher 'adds value'. Lambert suggests that the US case of *Veck v. Southern Building Code Congress International Inc*¹²⁹ demonstrates the desirability of the UK's combination of copyright and permitted acts.¹³⁰ Berne Article 2bis(1) allows countries of the Berne Union to exclude political speeches and speeches delivered

125. Applied in *HRH Prince of Wales v. Associated Newspapers* [2007] 3 WLR 222 by Lord Blackburn at [186].

126. R. Burrell and A. Coleman *Copyright Exceptions: The digital impact* Cambridge, Ch. 5, (CUP, 2005).

127. Sims 'the public interest defence in copyright law: myth or reality' [2006] EIPR 335.

128. S. Ricketson, *The Berne Convention: 1886–1986*, Kluwer (1987), para. 6.67.

129. Court of Appeals for the Fifth Circuit: Circuit Wiener and Stewart JJ. and District Judge Little, 2 February, 2001 <www.ca5.uscourts.gov/opinions/pub/99/99-40632-cv0.htm>, (last discussed 28 April 2008).

130. J. Lambert, 'Access to legislation on the internet: An English lawyer's reflections on *Veck v. Southern Building Code Congress*', [2001] Ent. LR 145. P. Leith, 'Owning legal information', [2000] EIPR 359 discusses legal publishing in the UK.

in the course of legal proceedings from copyright protection, wholly or in part whilst Article 2 bis(2). Again, Ricketson¹³¹ points to recognition of public interest arguments for keeping such speeches out of copyright. Considerable latitude is given by Article 2bis(2) as regards the protection of lectures and other addresses, subject to permitted uses justified by informatory purpose. However, collections of these works by their authors must be accorded full exclusive rights: Article 2bis(3).

Articles 10(1) and (3) of Berne provides for mandatory free use of acknowledged quotations from published works, provided that the use is compatible with fair practice and justified in degree. Article 10(2) is permissive as to fair use for illustration in publications, teaching, broadcasts and recordings. Article 10bis permits Berne Union countries to make exceptions to copyright for the reporting of current events. Such exceptions seem to work well in national laws although *Hyde Park Residence Ltd v. Yelland*¹³² demonstrates that a public interest defense may be particularly desirable in relation to an *unpublished* work.¹³³ It is submitted that the Court of Appeal's holding that Mr Yelland's newspaper did not need to use actual CCTV footage to refute an exaggerated claim by Mr Al Fayed is unconvincing.

From time to time defendants attempt a quotation defense in relation to whole works. An interesting example of this occurred in *Queneau v. Christian Leroy*¹³⁴ where the defendant had digitised an entire collection of poems, although each visitor to his web site could display only one poem at a time. Not surprisingly, the tribunal held that the defendant's activity did not fall within the 'brief quotation' defense of section L.122-5-3 of the French Intellectual Property Code. The court observed that poems viewed by visitors to the web site were not intended to be incorporated in another work to which it contributed a 'pedagogical, scientific or informative element'. Furthermore, it was possible in principle to reconstitute the entire work by juxtaposing successive 'quotations'.

In another French case, *Fabris v. Société Nationale de Television France 2*,¹³⁵ the claimant was holder of moral rights and co-owner of economic rights in the works of the deceased artist Utrillo. The defendant televised a one-off news report of an exhibition of Utrillo's works. The 128-second news broadcast showed twelve of Utrillo's paintings without permission. In proceedings for infringement of copyright, the court of first instance dismissed the claim, holding that the use of the entire work did not fall within the short quotation exception of Article.L.122-5. However, the court accepted the argument that the report was justified by the television viewers' right to receive up-to-date information of a cultural event in a current news item about the work or its author. It was relevant that the report was

131. S. Ricketson, *The Berne convention: 1886–1986*, Kluwer (1987), para. 6.16.

132. [2001] Ch. 143; [2000] 3 WLR 215; [2000] ECDR 275; [2000] EMLR363; [2000] RPC 604 (CA).

133. Especially in the UK since the fair dealing defence of the Copyright Designs and Patents Act 1988 s30 (criticism or review) were amended to limit them statutorily to published works, implementing the InfoSoc directive 2001/29/EC. A. Sims n.3 above argues that the public interest defence should operate only in respect of published works.

134. [1998] E.C.C. 47 (Trib Gde Inst Paris).

135. [2003] E.C.D.R. 13 (C d'A Paris).

not in competition with usual forms of exploitation of the work.¹³⁶ The claimant appealed. The Court of Appeal confirmed that the short quotation exception did not apply to the showing of the whole works. It went on to reject as 'baseless' the defendant's reliance upon a right of communication under the European Convention on Human Rights, since showing the paintings was clearly not essential. However, the Court of Appeal did at least entertain the argument and further referred to Article 1 of the first additional Protocol to the Convention, 'every natural or legal person is entitled to peaceful enjoyment of his possessions', which the court viewed as substantially guaranteeing the right to property, tangible or intangible. Thus the Cour d'Appel can be seen engaging in the exercise of balancing of public interests.

In Austria the quotation defense under the Copyright Act applied to words but not to pictures. In *R. v. Re Quotation of News Pictures*¹³⁷ the public interest was held to justify applying the quotation defense by analogy to pictures, the court recognizing that these days' pictures are of more and more importance in the news media.

The phrase 'justified by informatory purpose' in Berne Article 2bis(2) suggests public interest may demand more lenient criteria for copying works of fact,¹³⁸ the line between restricted and free use being drawn to favour the user. In *Ravenscroft v. Herbert*,¹³⁹ a comment to this effect was based upon the author's presumed intention to add to society's corpus of useable knowledge:

The author of a historical work must, I think, have attributed to him an intention that the information thereby imparted may be used by the reader, because knowledge would become sterile if it could not be applied. Therefore, it seems to me reasonable to suppose that the law of copyright will allow a wider use to be made of a historical work than of a novel so that knowledge can be built upon knowledge.

A similar approach may be discerned in map cases. In the early English case of *Sayre v. Moore*¹⁴⁰ the court held that there would be infringement only if a derivative map was a 'servile imitation' (it was not). In *Geographia v. Penguin*,¹⁴¹ Whitford J observed

In a map case, even if, on a close examination, there be some apparent similarity in the finer features the question is always going to remain as to whether having regard to the quantity and quality of the information taken there has been any real prejudice to the interests of the copyright owner.

136. The editors of *Copinger & Skone James on Copyright* suggest that this factor would be of little weight today in respect of substantial copying under UK copyright: para. 8–37, n. 33. It would of course be germane to alleged fair dealing: e.g. *Sillitoe v. McGraw-Hill* [1983] FSR 545. J. Griffiths, 'Copyright law after Ashdown – time to deal fairly with the public', [2002] IPQ 240.

137. [2002] E.C.C. 20 (OGH Austria).

138. A. Sims, n.3 above, argues that the public interest defence operates only upon works of fact.

139. [1980] RPC 193 at 206. In this case the defendants' taking was held sufficient to infringe.

140. (1785) 102 ER 139.

141. [1985] FSR 208.

However, the public interest in access to copyright works is generally served by exceptions and limitations. Where exceptions are clear and reasonably up-to-date, courts will refrain from elaborating them with public interest arguments. For example, in *Phonographic Performance Ltd v. South Tyneside Metropolitan Borough Council*¹⁴² the court rejected the defendant's argument that since as a local authority it performed social welfare functions, it could rely on section 67, which permitted charitable organizations to play copyright works.

A public interest in laughter is served by the defense of parody, in some jurisdictions a specific defense,¹⁴³ in others an aspect of fair dealing or fair use.¹⁴⁴ Courts in most jurisdictions would agree with the analysis of the Dutch court in *Rowling v. Byblos*, that:-

The aim of making a parody of another's work is to create humour, not competition.

If these conditions are satisfied, free use may be allowed, but the courts are quick to detect a competitive motive. Because parody relies upon the public's familiarity with the material used, it does not tend to arise in breach of confidence cases.

X. FREE USE VERSUS NO PROTECTION

Arguments that protection should be denied outright may be based upon the notion that the material should be positioned in the public domain, free for use by all, or upon the contrasting principle that iniquitous material should be used by none, and should certainly not lead to benefit or recovery by a claimant. The case of a non-original work falls into the first category, as does the idea that non-substantial taking should be permitted.

The exceptions for short quotations or fair dealing deal with the situation where the quantity of the work used would normally require authorization, but (to use the words of the 'three-step test') but the use is for 'certain special cases which do not conflict with a normal exploitation of the work and do not unreasonably prejudice the legitimate interests of the right holder'.¹⁴⁵ If a sufficiently short or non-original portion of a work is used, no infringement is committed. A short cut may be to consider whether the portion would attract copyright, although the UK courts have been prepared to contemplate the notion that a substantial taking of a copyright work may occur even where the taking would

142. [2001] RPC 29.

143. See e.g. L. Gimeno, 'Parody of songs: a Spanish case and an international perspective', [1997] Ent LR 18. In *Uitgeverij Byblos Bu u Joanne Kathleen Rowling* [2004] ECDR 7, CA Amsterdam, the court discussed an appeal against an infringement ruling [2003] ECDR 23: a book about 'Tanja Grotter' was neither a parody of 'Harry Potter' nor a permitted polemic.

144. E. Gredley and S. Maniatis, 'Parody: a fatal attraction? Part 1: the nature of parody and its treatment in copyright', [1997] EIPR 339; W. Hayhurst, 'Canada: Copyright – copyright in fictional characters – parody as fair dealing for the purpose of criticism', [2000] EIPR N 55 (*Productions Avanti Cine-Video Inc v. Favreau*); Macmillan, 'The cruel C: Copyright and film', [2002] EIPR 483.

145. Berne Art. 9(2); TRIPS Art. 13; Directive 2001/29/EC Art. 5(5).

not independently attract copyright. This is in contrast to the position in the US and other jurisdictions.¹⁴⁶ Altered, as opposed to partial, copying¹⁴⁷ often gives rise to problems of substantiality in copyright – has the expression been taken or the idea, the form or the content?¹⁴⁸ Even in the UK, where the idea/expression or content/form dichotomy has received less judicial attention than elsewhere, the extreme case of *Bowater Windows Ltd v. Aspen Windows Ltd*¹⁴⁹ shows that where only commonplace ideas are taken, there will be no infringement.

The equivalent in breach of confidence cases involves information which lacks the necessary quality of confidence because it is trivial¹⁵⁰ or commonplace, such as workplace procedures concerned with personal health and cleanliness and janitorial cleaning in *Ocular Sciences v. Aspect Vision Care*.¹⁵¹

A public interest could be claimed in the protection of morals, the prevention of crime, the exposure of iniquity and the principle that turpitude should not be rewarded. In both breach of confidence and copyright cases, courts have denied protection or remedies because of the unacceptable nature of the information or work. A classic statement was made in *Gartside v. Outram*,¹⁵² that ‘there is no confidence as to the disclosure of iniquity’. Not every human weakness amounts to ‘iniquity’ and the courts are slow to characterize personal behaviour as such.¹⁵³ In the case of hypocrisy of public figures, however, public interest favours the correction of false impressions.¹⁵⁴

Given that iniquity will not be protected by confidence, is copyright recognized in iniquitous works? There is venerable English case law to this effect. It was suggested in *Glyn v. Western Feature Film Co*,¹⁵⁵ that an immoral work should be denied copyright. The House of Lords were divided on this issue in *Spycatcher*,¹⁵⁶ but it is submitted that the better view is that the courts will decline to enforce copyright where restricted acts such as publication and sale would operate against the law or the public interest.¹⁵⁷ This approach is consistent with the early case of

146. See the comparisons in *IBCOS Computers Ltd v. Barclays Mercantile Highland Finance Ltd* [1994] FSR 275; cf. *John Richardson Computers Ltd v. Flanders (No.2)* [1993] FSR 497.

147. H. Laddie, P. Prescott and M. Vitoria, *The modern law of copyright*, London (Butterworths, 2000), para. 3.130.

148. I. Dreier, ‘Balancing proprietary and public domain interests’, in R. Dreyfuss, D. Zimmerman and H. First (eds), *Expanding the boundaries of intellectual property*, Oxford University Press (2001), at 304 and citations.

149. [1999] FSR 759.

150. *Coco v. AN Clark (Engineers) Ltd* [1969] RPC 41 at 48; *AG v. Guardian Newspapers Ltd* [1988] 3 All ER 545, per Lord Goff.

151. [1997] RPC 289.

152. (1856) 26 LJ Ch. 113, characterized by Bingham LJ as public interest in *AG v. Guardian* [1988] 3 All ER 545.

153. *Stephens v. Avery* [1988] Ch. 449; A v. B [2000] E.M.L.R. 1007.

154. *Woodward v. Hutchins* [1977] 1 WLR 760; 2 All ER 751; *Campbell v. MGN Ltd* [2002] EMLR 30, [2003] HRLR 2; *Campbell v. Frisbee* 2002 WL 32273641.

155. [1916] 1Ch. 261.

156. *AG v. Guardian Newspapers (No 2)* [1988] 3 All ER 545.

157. In *Hyde Park Residence Ltd v. Yelland* [2000] 3 W.L.R. 215, Aldous LJ listed situations where the court might refuse to enforce copyright – where a work was immoral, scandalous or

Lawrence v. Smith,¹⁵⁸ where the court declined to continue an *ex parte* injunction in relation to medical lectures which were said to be ‘hostile to natural and revealed religion and denied the immortality of the soul’. The turpitude of a work should therefore be relevant to remedies rather than the subsistence of rights. A similar approach has been adopted in Switzerland in *Re Copyright in Maps and Plans*.¹⁵⁹ The case concerned a ‘Map for Men’, whose purpose was summed up in the caption ‘What’s where, streetwalkers, bars where prostitutes gather, brothels, strip shows, drag, gay clubs, bars for connoisseurs, dancing dives and many others’. The court reasoned that although the work constituted a guide to ‘opportunities for the conclusion of contracts which private law classifies as immoral, the explanatory notes attached to it are nevertheless statistically unique and thus entitled to copyright protection’. However, although copyright subsisted, the offending of morals could be an obstacle to publication. In the circumstances the claimant could not claim loss-of-profit damages for another’s publication. Any copyright protection should be limited to an injunction to prevent copying and publication.

XI. CONCLUSION

At the boundaries between each of the categories in the ‘modified Ricketson’ scheme, courts everywhere use their powers to grant remedies consistent with the competing public interests in disclosure and confidentiality, freedom of expression and the protection of intellectual property.

contrary to family life, or was injurious or incited or encouraged others to act in a way which was injurious to public life, public health and safety or the administration of justice.

158. Jac. 471, cited in *Bowman v. Secular Society* [1917] A.C. 406.

159. [1985] E.C.C. 549 (ObG Zurich).

Chapter 18

Privacy, Confidentiality and Property

*Peter Jaffey**

I. INTRODUCTION

My aim in this chapter is to differentiate between various types of legal claim that appear to overlap or are sometimes conflated. The claims are concerned, broadly speaking, with the disclosure or exploitation of information, though the discussion sometimes goes beyond this for the purposes of comparison. More particularly, I deal with ‘informational privacy’ and its relation to the law of confidentiality; aspects of a wider notion of privacy not concerned with private information; aspects of the law of confidentiality concerned with commercial rather than private information, that is to say, the law of trade secrets, and more generally, claims arising from the ownership of intangibles, including information. The objective is not to provide a detailed account of the law, but to consider it broadly in order to identify the principles underlying the different claims and thereby highlight the confusion and incoherence that is liable to result from a failure to separate distinct categories based on different principles.¹ Although the principal concern is with English law, the arguments are of more general relevance.

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1. Some of these issues are discussed in similar fashion in Peter Jaffey, *Private Law and Property Claims* (Hart Publishing, 2007), Ch. 1–3.

II. PRIVACY AND CONFIDENTIALITY

Until quite recently it was said straightforwardly that there was no right of privacy in English law, and there were cases that gave striking support to this proposition. In the notorious *Kaye v. Roberston*,² newspaper journalists entered the hospital room of the claimant where he was bedridden and recovering from a serious accident, and took a photograph which was to be published without his consent. The court described this as a ‘monstrous invasion of privacy’,³ but denied that there was any right of privacy in English law.⁴ In the light of this case and others, the subject of privacy has long been controversial. The enactment of the Human Rights Act 1998, giving effect to the European Convention on Human Rights, has revived the issue, in the light of Article 8 of the Convention, which provides in paragraph 1:⁵ ‘Everyone has the right to respect for his private and family life, his home and his correspondence.’ In recent cases the courts have taken the position that, although there is still no action for breach of privacy as such, the right of privacy under Article 8 does now receive satisfactory protection, principally through the ancient action for breach of confidence, as it has been developed by the courts.

II.A THE LAW OF CONFIDENTIALITY

The basis of the law of confidentiality is a matter of controversy. In the simplest case, C confides in D, who has agreed to keep the information confidential, and the law prohibits D from divulging the secret. More commonly, although D has not made an explicit undertaking of confidentiality, it is clear that there is an agreement to keep the information confidential, but one that is unspoken and indeed need not be expressed because of the nature of the relationship and the circumstances: there is, in other words, a confidential relationship, carrying with it an implied undertaking of confidentiality. In such cases, the law can in principle be explained in terms of agreement or contract, broadly understood.⁶

2. [1991] *FSR* 62.

3. At 70, per Bingham L.J., using Griffiths J.’s expression in *Bernstein v. Skyviews* [1978] *QB* 479, 489.

4. The court contrived to give some protection on the unsatisfactory basis of injurious or malicious falsehood. This applied only because the court found: (1) a false implication that the photograph was consented to by the claimant; and (2) a pecuniary loss in the form of the loss of the commercial value of the story. Such a false implication is not a necessary characteristic of a breach of privacy, and the loss identified is based on the value of the claimant’s story for commercial exploitation, not the value of his privacy, and the implication is that if the claimant would not have been willing to sell his story he should have no claim.

5. Subject to the proviso in para. 2.

6. As noted in W.R. Cornish & D. Llewelyn, *Intellectual Property* (Sweet & Maxwell, 6th edn, 2007), 8-06. Historically the claim was governed by equity rather than common law and so would never have been regarded as a matter of contract. The difficulty at common law would have been the inadequacy of the common law remedy of pecuniary damages compared to the equitable remedy of injunction.

Say C confides in D1 and D1 conveys the information to D2. It is established that D2 can also incur a duty not to publish the information.⁷ It is sometimes argued that D2's duty is a duty not to interfere with the performance by D1 of his duty of confidentiality, or not to induce D1 to breach it.⁸ But this explanation is plausible only where D2's disclosure makes him complicit in a wrong by D1, as for example where D1 relayed the information to D2 with a view to D2's disclosing it. If D1 intended D2 to keep the confidence, D2's breach cannot plausibly be understood as wrongful on the ground that it procured or assisted in a breach by D1.⁹ The point is even clearer where D2 eavesdrops on C confiding in D1. It may have been thought at one time that in such a case D2 incurs no duty to keep the information confidential because D2 is clearly not an accessory to a breach by D1,¹⁰ but it now seems clear that D2 can be bound by a duty of confidentiality in such a case,¹¹ and this surely cannot be understood as incidental to or dependent on the undertaking of confidentiality by D1.¹² On what basis, then, is D2 bound by a duty of confidentiality?

It is sometimes said that the basis of D2's duty is a principle of 'good faith' or a principle of 'unconscionability'. These ideas are of course associated with the origins of the law of confidentiality in the law of equity as opposed to the common law, but in themselves they do not disclose any meaningful basis for a claim.¹³ The basis of the claim must lie in the fact that, where C has given personal information to D1 in confidence,¹⁴ disclosing the information is liable to cause harm to C: it is liable to cause him embarrassment or humiliation or to demean him in the eyes of some people – this is why C wanted the information kept confidential.¹⁵ The duty of D2 not to disclose the information must be based, not on D1's undertaking to maintain its confidentiality, but on a duty arising under the general law not to cause C harm of this sort by revealing the information. Thus the basis of the claim must surely be, not that the information was divulged to D1 in confidence, but that the information was private. The fact that the information was divulged in confidence merely demonstrates its private nature and the fact that its disclosure is liable to

7. See e.g. *Attorney-General v. Guardian Newspapers (Spycatcher)* [1990] AC 109.

8. See e.g. Cornish & Llewelyn, *supra* n. 6, 8-06.

9. The fact that by making the disclosure D2 destroys the value of D1's undertaking to C does not mean that D2 has induced a breach or unlawfully interfered with its performance: See *RCA v. Pollard* [1983] 1 Ch 135; *Douglas v. Hello!* [2003] All ER 996 at para. 243, per Lindsay J.

10. This may have been the position of Megarry V.C. in *Malone v. Metropolitan Police Commissioner* [1979] Ch 344, 375-7.

11. *Francome v. Mirror Group Newspapers* [1984] 1 WLR 892, *Attorney-General v. Guardian Newspapers (Spycatcher)* [1990] AC 109.

12. Lord Goff in *Attorney-General v. Guardian Newspapers (Spycatcher)* [1990] AC 109, 281 referred to the 'public interest in the maintenance of confidences', but if this does not refer to enforcing undertakings of confidence or preventing interference by third parties in the performance of such undertakings, then it is not clear what it can really mean other than, as argued below, the protection of privacy.

13. See further Jaffey, *supra* n. 1, Ch. 4.

14. As to information that is not personal, see the section below concerning trade secrets.

15. See *infra*, text at n. 64. Where the confidential information concerns a third party, it is the third party's privacy that is in issue.

cause harm to C. This seems to be the only plausible basis for the duty binding third parties. Understood in this way, the claim for breach of confidence is clearly a claim in tort, though because of its origins in the law of equity it is not traditionally so described.

This understanding is confirmed by a consideration of the principal condition for a duty of confidentiality to arise. This is said to be that the information 'must have been imparted in circumstances importing an obligation of confidence'.¹⁶ On its most natural interpretation, this means that the information must originally have been communicated or acquired in a confidential relationship in the sense explained above, that is, subject to an actual express or implied agreement to respect confidentiality. In some cases, it seems that the absence of a genuine confidential relationship in this sense was enough to preclude any legal duty of confidentiality.¹⁷ But it now seems clear that there is no requirement of a genuine confidential relationship in this sense. Thus in *Attorney-General v. Guardian Newspapers (No. 2) (Spycatcher)*,¹⁸ Lord Goff said: '[I]n the vast majority of cases . . . the duty of confidence will arise from a transaction or relationship between the parties . . . But it is well settled that a duty of confidence may arise in equity independently of such cases'. He also said that a duty of confidence could arise when 'an obviously confidential document, such as a private diary, is dropped in a public place, and is then picked up by a passer-by'.¹⁹ A personal diary is not a communication made subject to a confidential relationship, but it is clearly private.

A good example of this point is provided by *Hellewell v. Chief Constable of Derbyshire*.²⁰ Here Laws J. took the view that when the police take photographs of suspects who are subsequently convicted, although the police are free to distribute the photographs for the purpose of promoting law and order, their freedom to do so is subject to constraints to protect the suspect's privacy. It is clear here that the protection is not based on any undertaking of confidentiality given by the police, or on any confidential relationship in the sense above. The police are empowered to take the photographs without giving any such undertaking. As the judge said, the duty of confidentiality protects the claimant's right of privacy. Laws J. also said:²¹

If someone with a telephoto lens were to take from a distance and with no authority a picture of another engaged in some private act, his subsequent disclosure of the photograph would . . . as surely amount to a breach of confidence as if he had found or stolen a letter or diary in which the act was recounted and proceeded to publish it.

16. '*Coco v. Clark*' [1969] *RPC* 41, 47, per Megarry V.C.

17. See e.g. '*Malone v. Metropolitan Police Commissioner*' [1979] Ch. 344.

18. [1990] 1 *AC* 109, 281.

19. *Ibid.*

20. [1995] 1 *WLR* 804.

21. At 807.

Clearly there is no confidential relationship between the photographer and the subject, just as there is no confidential relationship with a stranger in respect of a diary.²²

These cases begin to reveal the transition in the law of confidentiality from the idea of an undertaking of confidentiality, arising from a confidential relationship, as the justification for a duty of confidentiality or non-disclosure, to the idea of a duty of confidentiality or non-disclosure as the remedy to protect a right of privacy. The transition is disguised by the ambiguity in the expression 'circumstances importing an obligation of confidence'. This seems originally to have been intended to refer to a genuine confidential relationship in which there was an actual, though tacit, confidentiality agreement, but was subsequently understood to mean circumstances in which it is justified to impose a duty of confidentiality, *viz.*, where disclosure would infringe a right of privacy. The same ambiguity can be found in the expression 'confidential relationship', since one might take it to refer to a situation where, by virtue of the claimant's interest in his privacy, the defendant incurs a duty of confidentiality. Where a real confidential relationship (and not privacy) is said to be the basis of the law in such circumstances, a fiction is at work in disguising the true basis of the law. Thus, even before the need arose to take account of Article 8, in cases such as the ones mentioned the law of confidentiality could only be understood on the basis that its function was to protect privacy.

As the courts have acknowledged, the application of Article 8 to English private law is not a straightforward matter. As Lord Hoffmann said in *Campbell v. MGN*, Article 8 'is not directly concerned with the protection of privacy against private persons or corporations. It is . . . a guarantee of privacy only against public authorities'. But he went on:

What human rights law has done is to identify private information as something worth protecting as an aspect of human autonomy and dignity. And this recognition has raised inescapably the question of why it should be worth protecting against the state but not against a private person.²³

Thus, on Lord Hoffmann's view, the courts have developed the English domestic law of privacy by analogy with the Convention rather than by direct application of it.²⁴

In the light of Article 8, the courts have made it explicit that the claim for breach of confidence protects a right of privacy. This is well illustrated by the case of *X & Y v. News Group Newspapers*,²⁵ where an injunction was issued prohibiting the media from revealing the new name of the applicant who had been notorious under her original name as a convicted murderer.²⁶ In *Douglas v. Hello!*,²⁷

22. Maybe this could not be said of correspondence.

23. [2004] UKHL 22, paras 49–50.

24. See, the view of Baroness Hale at para. 132, that Art. 8 enters private law because the court as a public authority must act in conformity with the Convention.

25. [2003] EWHC 1101.

26. Cf 'Venables v. News Group Newspapers' [2001] Fam 430.

27. [2001] QB 967.

Sedley L.J., taking account of Article 8 and the state of the common law, said:²⁸ ‘The law no longer needs to construct an artificial relationship of confidentiality . . . it can recognise privacy itself as a legal principle’ and in *A v. B*, Lord Woolf C.J. said:²⁹ ‘A duty of confidence will arise whenever the party subject to the duty is in a situation where he either knows or ought to know that the other person can reasonably expect his privacy to be protected.’ He added:³⁰ ‘The bugging of someone’s home or the use of other surveillance techniques are obvious examples of such an intrusion.’ Thus the defendant incurs a duty of confidentiality not because of an undertaking of confidentiality or a confidential relationship in a natural sense, but in order to protect privacy. This development was made clear by the House of Lords in *Campbell v. MGN*.³¹ On the basis that a field of law should be defined by reference to the rationale for the claim, the law of confidentiality should now really be described as the law of informational privacy, i.e. the law restricting disclosure of information on the ground that it is private. For reasons discussed below, however, the courts have been at pains to insist that there is no tort of breach of privacy, only an action for breach of confidence that protects an aspect of privacy.

II.B THE LIMITS OF INFORMATIONAL PRIVACY

There are two main problems that arise concerning the right to informational privacy. The first is the scope of the right: when are the circumstances private, such as to generate protection through an action for breach of confidence? In *A v. B*, Lord Woolf said that ‘usually the answer to the question whether there exists a private interest worthy of protection will be obvious.’³² He also quoted from the judgement of Gleeson L.J. in *Australian Broadcasting Corpn v. Lenah Game Meats*:³³

The requirement that disclosure or observation of information or conduct would be highly offensive to a reasonable person of ordinary sensibilities is in many circumstances a useful practical test of what is private.

One suspects that Lord Woolf may have been too sanguine in thinking that particular cases will not raise difficulty on this point. But at least it seems clear that the claimant in *Kaye v. Robertson* would have been protected. Similarly it is surely clear that someone who is surreptitiously photographed in private using a long lens camera is covered, certainly if he is dressed or presents himself or acts in a way that he would not in public.³⁴ In *Campbell v. MGN*, it was suggested that the

28. Para. 126.

29. [2003] *QB* 195, 207.

30. *Ibid.* See also ‘*WB v. Bauer Publishing*’ [2002] *EMLR* 8.

31. [2004] *UKHL* 22, paras 13–14, per Lord Nicholls.

32. [2003] *QB* 195, 206.

33. (2001) 185 *ALR* 1, 13.

34. This is the position under the Press Complaints Commission Code of Practice, referred to by Woolf CJ in *A v. B*, at 209, which the Human Rights Act 1998 by s. 12 requires the courts to take

'highly offensive to disclose' test might not always be apt, and that sometimes it would be better to ask simply whether there was a reasonable expectation of privacy.³⁵ There are some cases where it is quite clear that information is private, as for example with respect to information about medical treatment, whether or not a reasonable person would consider disclosure to be highly offensive.

Lord Woolf also quoted from the judgment of Gleeson L.J. to the effect that there is no hard and fast line between what is public and what is private.³⁶ An activity may not be private even though it occurs on private property and is not open to the public. On the other hand, there can presumably be a right of privacy in respect of what is said or done in a public place or is open to the gaze of strangers who happen to be in the vicinity: for example where someone is lying injured in the road after an accident. The latter point is illustrated by the case of *Peck*, a case from the UK in the European Court of Human Rights.³⁷ In *Peck*, the applicant had been filmed on a closed circuit television (CCTV) used for security purposes by the local authority. The applicant was seen with a knife which he subsequently used to attempt suicide, although the suicide attempt was not caught on film. The film was subsequently shown on television in a programme about CCTV. The court held that the English law of confidentiality was inadequate to protect the applicant because it did not apply where the claimant was in a public street. This would have been indisputable as a statement of English law at one time, but following recent cases there seems no reason to think that the applicant would not now be protected.

An interesting case on this point is *Douglas v. Hello!*³⁸ Here the claimants held a large wedding with several hundred guests and imposed a condition on everyone attending that no-one other than the claimants' authorized photographers was permitted to take photographs. The restriction was enforced by tight security. This was in accordance with a contractual arrangement with OK magazine, and the intention was that the claimants would be able to select photographs that showed them at their best, to be published exclusively by OK, for which OK paid a considerable sum, reflecting the commercial value of this exclusive. An unauthorized photographer entered and took clandestine photographs which he sold to a rival magazine, the defendant Hello. The claimants asserted a right to stop the publication by the defendant. One might ask first what the position would have been if no confidentiality or security arrangements had been put in place. Would the nature of the occasion in itself have given the claimants a right of privacy? It could certainly be described as a private occasion, though it is less clear that the claimants would have a right of privacy, and it would not seem apt to say, applying

account of. In *Spencer v. United Kingdom* (1998) 25 EHRR CD 105 before the European Commission of Human Rights, one alleged invasion of privacy was the taking of a telephoto picture of the claimant in a private garden of a hospital. It was held that the applicant had not established that there was no claim in English law, although one can have some sympathy with the applicants' view that at the time the authorities did not support such a claim.

35. At paras, 22, 94.

36. (2001) 185 ALR 1, 13.

37. *Peck v. United Kingdom* [2003] EMLR 15.

38. Interim proceedings [2001] QB 967; final proceedings [2003] All ER 996.

Gleeson L.J.'s formula, that it would be 'highly offensive' to publish photographs of such an occasion.³⁹

What about the effect of the arrangements to secure confidentiality? Leaving aside the question of the duty imposed on people who attended by the conditions of entry, and the liability of third parties as accessories in a breach of this duty, can one infer from the fact that the claimants made these arrangements that they regarded the occasion as a private one, and is this sufficient to establish that they did indeed have a reasonable expectation of privacy even if they otherwise would not have done? There seems to be no reason why this should not be the case. If the claimants wanted to have an occasion where they could be confident that no photographs would be published, so that they could feel free to look and behave as they might at home, say, why should they not be able to do this?⁴⁰ The fact that the claimants also intended to release specially selected photographs to preserve and enhance their public image does not seem to undermine this right, though it was suggested that the concern for privacy and for commercial exploitation of the occasion were at odds with each other.⁴¹ In fact it was held that there was a right of privacy, but compensation for invading the right by the release of unauthorized photographs was very modest, certainly by comparison with the commercial value of the information,⁴² and this seems reasonable because, although the claimants' privacy may have been invaded, the photographs published did not embarrass them or show them in an adverse light.

The second main problem is in what circumstances the right of privacy is overridden by a countervailing public interest in disclosure. Some judges have suggested that this would be an insuperable problem, or at least one that requires a legislative solution.⁴³ No doubt difficult questions can arise, but it is an issue that already has to be addressed in connection with the public interest defense in confidentiality and copyright.⁴⁴ It is on this issue that the influence of the European Convention on Human Rights has been most apparent. Under the Convention, the scope of the public interest justification for disclosure of private information under Article 8 has to be assessed in the light of the right to freedom of expression under Article 10, and the conversely the limitations on the right conferred by Article 10 have to be assessed in the light of the right to privacy conferred by Article 8. The two provisions are interrelated and together provide a framework for addressing the issue.⁴⁵

39. As noted by Lindsay J., [2003] *All ER* 996 at para. 192.

40. Subject to any public interest justification for disclosure in respect of particular events.

41. See, for example, the judgment of Lord Walker in the House of Lords [2007] *UKHL* 22.

42. See *ibid.* at para. 248.

43. See e.g. *Malone v. Metropolitan Police Commissioner* [1979] *Ch* 344, 373, per Megarry V.C.: *Wainwright v. Home Office* [2002] *QB* 1334, para. 60, per Mummery L.J.

44. See e.g. the earlier case of *Woodward v. Hutchins* [1977] 1 *WLR* 760.

45. See *Campbell v. MGN* [2004] *UKHL* 22, per Lord Nicholls at para. 20. See also *A v. B* [2003] *QB* 195, para. 4.

It was on this issue that the House of Lords was divided in *Campbell v. MGN*. It was agreed that, although it was private,⁴⁶ information about the claimant's drug addiction and the fact that she was having treatment for it could be published by the defendant newspaper, because it was in the public interest to correct the false impression, cultivated and exploited by the claimant, that she did not take drugs. The majority held that the defendant's right to publish information in the public interest did not extend to publishing any more detailed information about the claimant's treatment, including the fact that she was having treatment at Narcotics Anonymous, nor to publishing photographs showing the claimant in the street leaving a meeting of Narcotics Anonymous. The minority thought that, given that the defendant newspaper was entitled to publish the facts of the claimant's addiction and that she was having treatment, it should also have been entitled to add supporting detail about the nature of the treatment and the photograph in order to make a more convincing and appealing story for commercial publication. Although Lord Hoffmann, one of the minority, said that the House was divided on a 'narrow point',⁴⁷ in practice the weight attached, in balancing freedom of expression against privacy, to the commercial interest of newspapers in being free to add such background detail and photographs to a story in order to attract readers is bound to have a significant effect on what newspapers actually choose to publish.

II.C INFORMATIONAL PRIVACY AND THE 'BLOCKBUSTER TORT' OBJECTION

There is now in reality a right of privacy in English law, and the English courts consider that the law now provides protection in accordance with Article 8; as argued above, even the old law of confidentiality could not adequately be explained except in terms of the protection of privacy. But most judges still insist that there is no 'freestanding' tort of privacy in English law,⁴⁸ merely a tort of breach of confidence, which protects privacy.

The discussion above has concerned informational privacy, the protection of private information against disclosure. This is of course why the appropriate remedy is an order against disclosure or publication, just as for the original case of confidentiality where the private information was initially divulged in a confidential relationship. Privacy is often taken to be a broader concept than informational privacy.⁴⁹ In the US, the right of privacy is famously said to be 'a right to be

46. According to Lord Nicholls, the information ceased to be private (as opposed to being private but subject to disclosure in the public interest), because the claimant could no longer have a reasonable expectation of privacy: See para. 24.

47. At para. 36.

48. For example, *Khorasandjian v. Bush* [1993] 727, 744; *Wainwright v. Home Office* [2002] *QB* 1334 (CA) para. 57, para. 96ff, [2003] *UKHL* 53 (HL), paras 16–19, 29–35; see also '*X & Y v. News Group Newspapers*' [2003] *EWHC* 1101, para. 14; '*A v. B*' [2003] *QB* 195, 206.

49. See e.g. S. Deakin, A. Johnston & B. Markesinis, *Tort Law* (OUP, 6th edn, 2007), 701–3.

left alone',⁵⁰ and the Restatement of Torts, adopting the famous analysis by Prosser,⁵¹ reflects the idea that the right to be left alone is a fundamental right that supports a number of more specific rights, of which a right against the disclosure of private information is only one.⁵² Another specific right said to be an aspect of the general right of privacy is a right of seclusion or right against intrusion. This would appear to include rights against physical intrusion into the home and against intrusive noise or smells. On this understanding, the right of privacy appears to underlie at least part of the law of trespass, assault, and nuisance.⁵³ Indeed 'a right to be left alone' might seem broad enough to cover any form of harm to or constraint of the individual and so to underlie much of the law of tort. As considered further below, the right against 'false light portrayal' and the right against 'appropriation of personality' are also identified as elements of the general right to be left alone in the Restatement and are recognized in some jurisdictions in the US. Furthermore, in the US the right of privacy has notoriously been invoked as the basis for the protection of certain liberties, for example to use contraception, have an abortion, or engage in homosexual relations.⁵⁴ In this context, privacy seems to refer to what in other contexts is described as autonomy, and is concerned with a right to be free to take certain decisions bearing on the conduct of one's life free of state interference. This is again very broad – it amounts to a general criterion for limiting the scope of civil and criminal law.⁵⁵

Thus there is an important issue whether a right of informational privacy is an element of a broader and more fundamental right of privacy. If this is the case, the recognition of a right of informational privacy implies, in principle, the recognition of such a broader right, at least subject to countervailing considerations. Indeed the controversy over the recognition of a right of privacy in English law has involved discussion of harassment in particular as well as informational privacy. In the recent case law, some judges have been particularly insistent that no right of privacy has been or should be recognized in English law, unless introduced through legislation in Parliament, apparently mainly because they have assumed that this would have broad implications beyond informational privacy. For example, in *Malone v. Commissioner of the Metropolitan Police*,⁵⁶ where the judge said that a right of privacy could be introduced only by Parliament and not by the courts

50. The formulation is apparently attributable to T. Cooley, *Cooley on Torts* (2nd edn, 1888), 29, although it is generally associated with the famous article by S.D. Warren & L.D. Brandeis (1890) 4 *Harv LR* 193.

51. Restatement (Second) of Torts (1977); W. Prosser, 'Privacy' 48 *Cal LR* 383 (1960).

52. For a brief survey, see D.A. Anderson, 'An American Perspective' in Deakin, Johnston & Markesinis, above n. 49, 735–739.

53. See e.g. Deakin, Johnston & Markesinis, above n. 49, 701. In the US, it appears that many such cases actually concern intrusive means of acquiring and revealing information, and so are really a matter of informational privacy: see Anderson, above n. 52, 737–8.

54. E.g. *Griswold v. Connecticut* 381 *US* 479 (1965); *Roe v. Wade* 410 *US* 113 (1973); see e.g. J. Rubinfeld, 'The Right of Privacy' 102 *Harv LR* 737 (1989).

55. See R. Wacks, 'The Poverty of Principle' (1980) 96 *LQR* 73.

56. [1979] *Ch* 344, 372–3, Megarry V.C.

because of its very broad and indefinite character, he clearly understood the right of privacy to include a right against physical intrusion as well as a right to informational privacy. In *Kaye v. Robertson*, as mentioned above the court again insisted that the courts were unable to remedy the absence of a right of privacy, and Leggatt L.J. referred to the ‘right to be left alone’ in US law and the four heads of privacy that have sprung from it.⁵⁷ In *Khorasandjian v. Bush*,⁵⁸ Peter Gibson J. said simply that the argument for a right of privacy ‘was not open to him in the light of the decision of this court in *Kaye v. Robertson*, confirming that English law has recognised no such right’. But this was not a case of informational privacy; it was a case where the defendant had harassed and pestered the claimant, in particular by making unwanted telephone calls.

More recently in *Wainwright v. Home Office*,⁵⁹ where the claimants had been subjected to a strip search on a prison visit, in the Court of Appeal Mummery L.J. said:

[T]here is no tort of invasion of privacy. Instead there are torts protecting a person’s interests in the privacy of his body, his home and his personal property. There is also available the equitable doctrine of breach of confidence for the protection of personal information, private communications and correspondence.

He continued:⁶⁰ ‘I foresee serious definitional difficulties and conceptual problems in the judicial development of a “blockbuster” tort vaguely embracing such a potentially wide range of situations.’ Similarly Buxton L.J. insisted that all the cases where privacy had actually been protected were actions to prevent disclosure of information, and he inferred that they could all be explained in terms of breach of confidence without any need for a tort of breach of privacy.⁶¹ ‘These cases therefore do nothing to assist the crucial move now urged, that the courts in giving relief should step outside the limits of confidence, artificial or otherwise.’ Buxton L.J. was right to reject the ‘crucial move’, but it would be better to say, not that this is a move from confidentiality to privacy, but that it is a move beyond informational privacy to some other supposed notion of privacy. Buxton L.J.’s approach is misleading as an analysis of the case law, since it suggests that confidentiality supplies a basis for the claims distinct from privacy, which as discussed above is not the case. It suggests that he was deceived by the fiction referred to above. This point causes some inconsistency, or at least the appearance of inconsistency, in Lord Hoffmann’s judgment in *Wainwright* in the House of Lords. Lord Hoffmann also rejected the possibility of a tort of invasion of privacy, because he denied that the law recognized or ought to recognize a ‘high-level principle of invasion of privacy’, but he did accept that the action for breach of confidence

57. [1991] *FSR* 62, 70–71, per Bingham and Leggatt L.J.J.

58. [1993] *QB* 727, 744.

59. [2002] *QB* 1334, para. 57 per Mummery L.J.

60. *Ibid.* Para. 60.

61. *Ibid.* Para. 99.

‘might as well be renamed invasion of privacy’.⁶² The same point was reiterated by Lord Nicholls in *Campbell v. MGN*:

In this country, unlike the United States of America, there is no over-arching, all-embracing cause of action for ‘invasion of privacy’ . . . The present case concerns one aspect of invasion of privacy: wrongful disclosure of private information.⁶³

There is a clear rationale for protecting informational privacy.⁶⁴ Most people are concerned about what other people think about them, about their reputation in the broadest sense. This is based on general self-consciousness, on disquiet at being evaluated on the basis of limited information by strangers, and on a fear of prejudice. Consequently most people behave differently in different contexts, showing more restraint in public and revealing weaknesses, sensitivities and abnormalities only in private. By enabling people to prevent the dissemination of private information, the right of privacy protects their reasonable expectations concerning the nature of their audience. The case of an express undertaking of confidentiality or a confidential relationship is covered by this principle, but the principle is broad enough to justify protection whenever it is reasonable for the claimant to assume in the circumstances that information divulged by him or information about his behaviour or appearance will not be publicized. This is the reasonable expectation of privacy that is now protected through the law of confidentiality.

This rationale is distinct and limited to informational privacy. It is not, it seems to me, derived from a broader principle or value that requires the recognition of a broader right of privacy of which informational privacy is merely an element. Thus there is no reason to think that in recognizing that English law has a right of informational privacy – which is now simply an accurate statement of the law – the courts have also implicitly recognised or are bound to recognize a ‘right to be left alone’ or some form of right of autonomy as a concrete legal right, or more particularly a right against intrusion or harassment. Furthermore, as considered further below, a right of informational privacy does not entail a right against ‘false light portrayal’ or a right against ‘appropriation of personality’.⁶⁵ The problem that persists in the case law is that if, as the courts have repeatedly said, informational privacy is an aspect of a broader concept of privacy, and is protected as such, it would appear that the rationale for protecting informational privacy extends to the broader concept, and on this basis it is difficult to see how the development of a

62. [2003] UKHL 53, paras 29–30.

63. Paras 11–12.

64. There is a large literature on the nature and rationale of privacy, e.g. R. Gavison, ‘Privacy and the Limits of the Law’ 89 *Yale LJ* 421 (1980); Rubinfeld, above n. 47; R.C. Post, ‘Three Concepts of Privacy’ 89 *Geo LJ* 2087 (2001), discussing J. Rosen, *The Unwanted Gaze: The Destruction of Privacy in America* (Random House, 2000); D. J. Solove, ‘Conceptualising Privacy’ 90 *Cal LR* 1087 (2002).

65. [2003] UKHL 53, paras 29–30.

broader right of privacy can be resisted.⁶⁶ In my view, it should be resisted, by rejecting the idea that informational privacy is an aspect of a more general principle or concept of privacy.

III. CONFIDENTIALITY AS THE OWNERSHIP OF TRADE SECRETS

In many cases where confidential information is protected, the information is clearly not private at all, but commercial, that is, it is a trade secret, or 'know-how' concerning industrial or commercial activities.⁶⁷ Clearly protection for trade secrets cannot be explained in terms of a right of informational privacy. One might object that the law of confidentiality cannot therefore be regarded as based on privacy. But the point here is that there is a fundamental divide in the law of confidentiality that has not previously been recognized in English law. Only part of what is traditionally described as the law of confidentiality is based on a right to informational privacy. In *Douglas v. Hello!*⁶⁸ Lord Nicholls said that, following the developments discussed above, the law of breach of confidence 'now covers two distinct causes of action, protecting two different interests: privacy, and secret ("confidential") information'.

But surely what the developments discussed above indicate is that confidentiality is not itself a basis for a claim, unless this is taken to refer to the original case where someone has explicitly or implicitly undertaken to keep a confidence and a claim arises against that person or an accessory who has assisted in or procured a breach of the undertaking. In this type of case the basis of the claim is, as mentioned above, in essence contractual, though not conventionally so treated. In some other cases the basis is the right of privacy. But neither of these explains the law of trade secrets. What then is the basis of this aspect of the law?

In my view, the justification for protecting a trade secret is that it is the property of the claimant.⁶⁹ Property rights are capable of binding 'all the world', and this is why a third party is bound by a duty of confidentiality even though he did not give an undertaking of confidentiality and is not complicit in a breach of such an undertaking by anybody else. But of course this explanation is incomplete. Why should the claimant have ownership of the confidential information? The only plausible answer is that ownership of a trade secret is justified (in this situation) as a means of providing an incentive or reward for the creation of value. A right of ownership achieves this by securing to the owner the power to

66. Deakin, Johnston & Markesinis, above n. 49, 712-3, arguing for a general right of privacy encompassing physical intrusion and 'appropriation of personality' as well as disclosure of private information, but without offering a general concept of privacy to explain this.

67. A well-known example is *Seager v. Copydex* [1967] 2 All ER 415.

68. [2007] UKHL 21, para. 255.

69. See further Jaffey, *supra* n. 1, Ch. 3. There has been some discussion in the literature of whether the right to confidential information can or should be understood as a property right: see e.g. Cornish & Llewelyn, *supra* n. 6, 8-50.

exploit the property by exclusive use, licensing or sale. On this understanding the right to a trade secret is a form of intellectual property, in terms of both its proprietary nature and its rationale, and of course the law of trade secrets or know-how is commonly associated with patent law and treated in this way.

In *Douglas v. Hello!* Lord Walker was particularly critical of any such analysis of trade secrets. Quoting Finn, he said:⁷⁰

Perhaps the most sterile of debates which have arisen around the subject of information received in confidence is whether or not such information should be classified as property.

And he made it clear that in his view this was not the basis of the claim for breach of confidence in a trade secret. But this leaves obscure what the justification is for the claim, if it does not lie in the enforcement of an undertaking to keep a confidence, or in the protection of informational privacy, or in securing to the claimant the value of information he has created by way of a property right.

It seems to me that (leaving aside the contractual basis), the two different rationales for protecting confidential information are privacy and property.⁷¹ They characteristically raise different types of issue. The justification for the first category is simply to protect against a certain type of harm, and the existence of a claim depends on whether the claimant has a reasonable expectation of privacy and whether there is countervailing interest in the disclosure of the information. For the second category, the fundamental issue of principle is whether it is justified to give the right-holder the right to all the value to be made from exploiting the information. The two different rationales support different types of legal regime. If the claimant has a right of ownership of information, designed to secure to him the commercial value of the information, he should be able to license the use of the confidential information or sell it by transferring his right of ownership. By contrast, in the case of a right of privacy, designed to protect the claimant from personal harm caused by the disclosure of private information, the purpose of the law is not to secure to the claimant the commercial value of the information, or to empower him to sell the information or licence its use, although there is no reason why he should not be free to waive his right of privacy. For example, a newspaper that has paid for a waiver of privacy in order to be free to publish private information would not thereby acquire the right to prevent third parties from publishing the information, as would the purchaser of a trade secret. Secondly, in the case where the claimant has a right of ownership, he should be entitled to what might be called a 'use claim', that is to say, a claim for payment of a reasonable licence fee as a remedy for unauthorized use of the confidential information, as an alternative to a claim for compensation for loss caused by the disclosure

70. At para. 276, quoting from P.D. Finn, *Fiduciary Obligations* (CUP, 1977), para. 293.

71. See further Jaffey, *supra* n. 1, Ch. 3.

72. I.e., where the information is still confidential and there has been no loss to the claimant through the defendant's use. As to the use claim in general, See P. Jaffey, *The Nature and Scope of Restitution* (Hart, 2000), Ch. 4. In the ownership case, the claimant can of course and normally

of the confidential information.⁷² This is justified on the basis of the claimant's right to the 'use-value' of the information, as an element of his ownership of it. But in the case of the right of privacy, there is no basis for such a claim, and the normal pecuniary remedy will be compensation for the harm caused by the disclosure.⁷³

The essential difference between the two categories is not the type of information or the context, but the principle underlying that category, which determines the nature of the right and its relation to the information in question, that is to say, whether it is a right of ownership of confidential information as property, or whether it is a right against a certain type of harm arising from the disclosure of information. Generally the right of ownership subsists in respect of industrial or technical or business information or know-how, but in principle there can be ownership of information that is also private. As mentioned above, in *Douglas v. Hello!* one issue considered was whether unauthorized wedding photographs were protectable as a trade secret.⁷⁴ This point is considered further in the last section below.

IV. PRIVACY, DEFAMATION AND 'FALSE LIGHT' PORTRAYAL

IV.A PRIVACY AND DEFAMATION

The interest in privacy – that is, informational privacy – arises from people's sensitivity to other people's opinions and judgments about them. It is concerned, in a broad sense, with reputation, although there is no requirement for the claimant actually to show that his reputation has been adversely affected in anyone's eyes: it is better to say that the right of privacy is based on a legitimate concern about reputation.⁷⁵ There is an obvious question of the relationship of privacy to defamation. Consider the famous case of *Yousoupoff v. MGM*.⁷⁶ The claimant succeeded in a claim for defamation in respect of a false statement by the defendant that she had been the victim of a rape. It has been argued that such a case involves artificially stretching the law of defamation, because the reputation of the claimant is not lowered in the eyes of 'right-thinking people' as the conventional test for defamation requires, and that it might be better regarded as a case of invasion of privacy.⁷⁷ Indeed, it has been argued that this reveals the basic distinction between defamation and privacy, namely that the former is concerned with reputation in the eyes of right-thinking people and the latter with reputation in the eyes of what

will make a claim for compensation for loss, but this is damage to the property, which is the right to the exclusive value of the information.

73. Leaving aside the question of 'disgorgement' to remove the profits of wrongdoing, or exemplary or punitive damages: see Jaffey, *ibid.*, Ch. 11.

74. See [2003] *All ER* 996, para. 195; [2007] *UKHL* 21.

75. See *supra*, text at n. 64.

76. (1934) 50 *TLR* 581.

77. This argument is advanced by M. Tugendhat, 'Privacy & Celebrity' in E. Barendt, A. Firth et al, eds, *The Yearbook of Copyright & Media Law 2001/2* (OUP, 2002), 13.

might be called 'wrong-thinking people', which would include people who are liable to be prejudiced against someone who has been raped.⁷⁸ The implication is that defamation and privacy should operate in parallel to deal with protection of reputation, the distinction between the two turning on whether reputation in the eyes of 'right-thinking' or 'wrong-thinking' people is in issue, and this would avoid the need to stretch the law of defamation in this artificial way.⁷⁹

It is no doubt fair to say that the right of privacy is often concerned with protecting against the prejudice of 'wrong-thinking' people. Private matters are particularly prone to be the subject of prejudice.⁸⁰ But this is surely not the basis for the distinction between defamation and privacy. The problem of damage to reputation amongst 'wrong-thinking people' can also arise in respect of matters that are not private at all – an example might be the statement that the claimant at one time had an official position in a certain political party. The development of the law of privacy will leave unresolved the question of the proper scope of this aspect of the law of defamation. In any case, on one view the 'right-thinking people' test is not an accurate statement of the current law of defamation, and a statement can indeed be defamatory if it is liable to harm the claimant's reputation in any significant section of the community.⁸¹

More generally, this approach ignores a basic feature of privacy. By contrast with defamation, privacy is not concerned with the falsity of statements. It is concerned with protecting against loss of reputation (in a broad sense) resulting from the disclosure of true private information, for example the true information that the claimant has been raped, or rather statements about private matters irrespective of their truth or falsity. (It cannot be relevant whether the information is true or false, because otherwise the claimant would have to show the truth of the statement, or the defendant would escape liability by showing its falsity, and yet if the claimant has a right of privacy in respect of the information he can prevent its disclosure without having to bring its truth into consideration at all.) Thus the point in *Yousouppoff* is not that the claimant had a grievance that was strictly a matter of privacy rather than defamation; it was that the claimant had two distinct grievances, one the publication of a falsehood, and the other an invasion of privacy, namely the statement about private matters, whether true or false. Although it might seem that subsuming privacy under an expanded notion of defamation would be a compact way to bring together two forms of protection for reputation,

78. *Ibid.*

79. Alternatively privacy could be subsumed into defamation by expanding what is counted as loss of reputation. There have at various times been proposals for legislation to modify the law of defamation to protect privacy by withholding the defence of justification if the statement relates to a private matter – the claimant would sue for defamation and if the matter is private then the defendant would be liable irrespective of truth or falsity: see J.G. Fleming, *The Law of Torts* (LBC, 9th edn, 1998), 613. This would no doubt have served a useful purpose in providing some protection for privacy in the absence of an explicitly recognized right of privacy.

80. For example, matters of sexuality or medical conditions, where people are prone to be prejudiced and to take account of irrelevant matters: see Tugendhat, *supra* n. 77.

81. Fleming, *supra* n. 79, 583.

broadly understood,⁸² to the contrary it is surely preferable for the two categories to be kept distinct, even if both are relevant in some circumstances, because they have distinct rationales and raise distinct issues. The essence of the law of defamation is to protect reputation against inaccuracy, whereas the essence of the law of privacy is to protect reputation from being influenced by private information that disclosure might be unfairly prejudicial, even if true.⁸³

IV.B 'FALSE LIGHT' PORTRAYAL

In the US, many jurisdictions recognize a tort of 'false light' portrayal. As mentioned above, the tort is recognized in the Restatement of Torts and was identified by Prosser as one of the four privacy torts derived from the 'right to be left alone'.⁸⁴ It appears that the tort is committed where the defendant depicts the claimant in a false light and the depiction would be highly offensive to a reasonable person.⁸⁵ The claim clearly has an affinity with defamation. Often it operates in tandem with defamation, and some US jurisdictions have denied the existence of the tort on the ground that it subverts the law of defamation.⁸⁶ The development of the tort in the US raises the question whether it is a necessary aspect of a right of privacy and so should be recognised in English law by virtue of the development of a fully-fledged right of privacy in accordance with Article 8.

Some commentators in the US regard false light portrayal as an aspect of informational privacy, on the basis that informational privacy is concerned with a right to control information about oneself and that this extends to suppressing false information in some circumstances.⁸⁷ Some false light cases do indeed appear to concern the exposure of private information.⁸⁸ In such cases, the portrayal is presumably 'highly offensive' because of its private nature. The question then is why there is no ordinary claim for informational privacy to suppress the information irrespective of its truth or falsity. The answer may be that the defendant is entitled to publish the information, despite its private nature, because of the legitimate public interest in the events in question, but that this defence is available only if the account is true, or at least if the defendant has not been reckless as to its truth.

82. The range of statements that would count as defamatory would have to be wide enough to encompass all types of private information.

83. And even though it would enhance the accuracy of reputation amongst entirely dispassionate and objective parties.

84. Above, text following n. 49.

85. With knowledge or recklessness as to falsity.

86. See e.g. D. Zimmerman, 'False Light Invasion of Privacy: The Light that Failed' 64 *NYULR* 364 (1989); B.R. Lasswell, 'In Defence of False Light: Why False Light Must Remain a Viable Cause of Action' 34 *S Tex L Rev* (1993).

87. See the discussion in Solove, *supra* n. 64, 1109–15.

88. For example, *Time Inc v. Hill* 385 *US* 374 (1967), concerning the claimants' experiences whilst they were being held hostage; *Wood v. Hustler Magazine* 736 F.2d 1084 (1984), concerning the publication of a nude photograph of the claimant in circumstances arguably implying that the publication was with consent.

On this basis, the claim can be explained entirely in terms of the ordinary claim for informational privacy.

In other cases of false light portrayal it appears that the information is not private and the claim cannot be understood in terms of informational privacy. For example, the case might concern aspects of the professional life of the claimant that are entirely in the public domain, and not in any sense private.⁸⁹ But there is no reason to think that such a claim is based on some broader right of privacy of which informational privacy is also an aspect. The issue here is simply whether the claimant's reputation has been damaged by a false account of his life. It is in principle a matter for the law of defamation, and if the law of defamation is inadequate the reason may be the difficulty considered above, that the false account is not liable to lower his reputation amongst 'right-thinking people'.⁹⁰ It is surely not helpful to address this issue by way of the development of a different tort that circumvents this possible limitation in the law of defamation without directly considering whether it is justified.⁹¹

V. PUBLICITY AND MERCHANDISING

V.A PRIVACY AS THE OWNERSHIP OF IMAGE: THE RIGHT OF PUBLICITY

In the US, the general right of privacy has also been understood to give rise to a tort of 'appropriation of personality', which is committed by a defendant who without permission uses the name or image of the claimant (generally a celebrity) for commercial purposes, typically to promote the sale of a product by exploiting the claimant's appeal to consumers.⁹² This is said to be based on a 'right of publicity'.⁹³ The idea of the right of informational privacy as a right to control personal information might lead to the misconception that this tort is an aspect of informational privacy as described above. But again this is not the case. The right to prevent the commercial use of one's public image does not relate to private information; indeed the commercial use of a public image does not involve the transmission of information at all (unless it is understood as an endorsement).⁹⁴ That is

89. See the case discussed in M. Stohl, 'False Light Invasion of Privacy in Docudramas: The Oxymoron which Must Be Solved' 35 *Akron L Rev* 251 (2002).

90. See Stohl, *ibid.* There are procedural differences between the torts that do not provide a principled basis for recognising two different torts.

91. Lasswell, *supra* n. 86, 170, suggests that false light privacy protects against emotional disturbance whereas defamation protects reputation, but protection for reputation is surely designed to protect against emotional disturbance caused by damage to reputation (as surely is false light privacy). See also Zimmerman, *supra* n. 86, 431ff.

92. This is the fourth category of privacy identified by Prosser and incorporated in the Restatement of Torts. A standard example is '*Carson v. Here's Johnny Portable Toilets*' (1983) 698 F.2d 831.

93. The term comes from *Haelen Laboratories v. Topps Chewing Gum* 202 F.2d 866 (1953).

94. It does not convey information about the product, or about the celebrity. An endorsement does convey information: *viz.*, that the product meets the standards of the celebrity.

not to say that such a right is not justified. But it has to be justified on quite different grounds from a right against the invasion of informational privacy.

Furthermore, there is an important distinction that is often disregarded in connection with the concept of appropriation of personality. This is the distinction made above in connection with informational privacy and trade secrets, between a right against harm to the claimant, and a right of ownership.⁹⁵ The point is that it is one thing to recognize that a celebrity has a right against the use of his image for commercial purposes on the ground that the association with a commercial product or activity causes harm to an interest of his that should be protected, possibly an interest in reputation or dignity or autonomy; and it is quite another to say that a celebrity owns his image, and so is entitled to its commercial value. The latter right would be designed to enable the celebrity to license his image and realize its commercial value, whereas the former would be designed to save him from a certain type of harm. In the US, it appears that the law has moved from the former to the latter without appreciation of the distinction: thus it is said that this form of privacy claim 'often seems to have more to do with commerce than with personal privacy'.⁹⁶ This point will be returned to below, after a brief discussion of the law of trade marks, which, as will be seen, impinges on the same issue from a different direction.

V.B TRADE MARKS: THE INFORMATION FUNCTION

The principal function of a trade mark has always been said to be the 'origin function'. This should be understood in the following sense.⁹⁷ A trade mark tells a consumer that the quality and attributes of the product bearing the mark are under the control of some person (whoever it may be) who uses or authorizes the use of the mark to signify this fact. For this reason the consumer can infer that a product bearing a certain trade mark will have the quality and attributes that he has come to associate with products he has previously encountered bearing the trade mark. Thus the trade mark is a simple and powerful tool for communicating information,⁹⁸ albeit information that is vague and impressionistic and not entirely reliable. The use of a trade mark to communicate information allows a producer to build up and exploit a reputation in his products, *viz.*, goodwill. This goodwill is valuable to the trader because it attracts custom. It represents the fruits of his efforts in providing products that have the quality and attributes that satisfy customers.

95. *Supra*, text n. 71.

96. Anderson, *supra* n. 52, 738. Anderson also notes that this right is assignable and inheritable as property unlike other privacy rights.

97. As defined in the text, the origin function is not the function of revealing the identity of the manufacturer or distributor of the product, which is how it is sometimes understood. The function of a trade mark is not a question of law: identifying the function is a matter of explaining social and economic practices.

98. This understanding is associated with the economic analysis of trade marks; see e.g. W.M. Landes and R.A. Posner, 'The Economics of Trademark Law' 78 *TMR* 267 (1988).

The law of trade mark infringement prohibits the deceptive use of the claimant's trade mark.⁹⁹ It is only because the trade mark conveys information that its unauthorized use can be deceptive. The law of trade mark infringement thus reflects the information-related function of trade marks. It might seem that the law of trade marks is the counterpart of the law of defamation, protecting commercial reputation or goodwill as opposed to personal reputation. In fact a closer commercial equivalent to defamation is injurious or malicious falsehood,¹⁰⁰ which concerns false statements that damage the claimant's business and products, including his goodwill. The law of trade mark infringement has a different function: it is characteristically concerned not with actions that cause damage to the claimant's goodwill, but with deceptive use of the claimant's trade mark by which the defendant exploits the claimant's goodwill for his own benefit, typically by diverting custom to himself. There is no equivalent in defamation. This is an example of what was referred to above as a 'use claim',¹⁰¹ and it reflects the fact that the law of trade marks protects goodwill as a form of property belonging to the claimant, whereas personal reputation is not property in this sense under the law of defamation.¹⁰²

V.C THE NON-INFORMATION-RELATED 'IMAGE' FUNCTION OF A TRADE MARK

Trade marks can also have an important effect that is not concerned with communicating information to consumers.¹⁰³ A trade mark can acquire an 'image' through advertising. The image embodies attitudes or feelings or 'values' that the producer through advertising has managed to associate with the trade mark. If a trade mark has such an image, consumers may be influenced to purchase the product by their attraction to the image or their desire to associate themselves with it. Insofar as a trade mark operates through its image, it does not communicate information to consumers about the product. This non-information-related, image-based function can be described as the advertising or merchandising function.

Trade mark owners see their trade marks as embodying and protecting a mixture of goodwill and image, and therefore serving both information-related and non-information-related functions. The concept of 'brand', although originally

99. The law of trade marks encompasses the common law of passing off and the statutory law of registered trade marks. By preventing deception in this way, the law remedies the particular harm suffered by the trade mark owner as a result of the deception, and also sustains the trade mark system in general against the degradation in its efficacy as a means of communication that would result from deceptive use.

100. Injurious or malicious falsehood extends to damage to reputation but is not confined to it.

101. See *supra* n. 72.

102. Similarly, goodwill is transferable but personal reputation is not.

103. The aesthetic appearance of a trade mark may in itself induce some consumers to buy the product, but a stronger effect of the aesthetic appeal would be to enhance the efficacy of the trade mark as a sign communicating information about the product.

understood to mean a trade mark having the traditional information-related function, is now generally used more broadly to refer to a trade mark as the repository of the advertising image of the product as well as its reputation in the quality and attributes of the product.

In principle, the justifications for supporting the two functions are quite different. Protecting the pure trade mark or origin function and the ownership of goodwill is easily justified because it merely prohibits the provision of false information and thereby sustains the ability of producers to convey information to consumers and to profit from the reputation in their products that they have established amongst consumers. But protection for the merchandising function cannot be justified in this way. It is not concerned with prohibiting deceptive statements in order to promote the supply of true information. The unauthorized use of an image cannot in itself be deceptive because its purpose is not to convey information, or at least not information about the product. With respect to the merchandising function, the question is whether it is right to recognise ownership of an image cultivated through advertising and exercising an emotional appeal to consumers. Can it, for example, be justified as a way of rewarding and encouraging the investment of the trader in the development of the image? Are such images valuable things that traders ought to be rewarded for developing?¹⁰⁴ In practice, however, the protection provided by the law of trade marks, even if intended to protect the pure trade mark or origin function, in practice inevitably also provides protection for the merchandising function, that is, it supports trade mark owners in developing and exploiting the image of their trade marks.¹⁰⁵

V.D PROTECTING IMAGES FOR MERCHANDISING THROUGH THE LAW OF TRADE MARKS

A trade mark's image can receive protection through the law of trade marks as discussed above. A different issue is whether the law recognizes a merchandising right – that is, an exclusive right to use or license an image for commercial purposes – in respect of the images of celebrities, cartoon characters, or other things or events that may be appealing to consumers. In the absence of explicit merchandising rights in English law, claimants have sometimes sought to secure the exclusive right to such images through the law of trade marks, by an action in passing off or by seeking to register the image as a trade mark. As discussed above, an image designed for merchandising is distinct in function from a trade mark, or at least a trade mark in its pure trade mark or origin function; by contrast with a trade

104. See e.g. M. Madow, 'Private Ownership of Public Image: Popular Culture and Publicity Rights' 81 *Cal L Rev* (1993).

105. In modern times, trade mark regimes have increasingly recognized that non-deceptive 'dilution' can constitute infringement, e.g. tarnishing of the trade mark or blurring of its distinct. This is readily understood to be intended to protect the image of a trade mark and so to support the advertising or merchandising function of a trade mark, but it is also explicable in terms of the origin function, i.e. in terms of its effect in hindering communication with consumers.

mark, such an image does not purport to convey information, and so its use (whether authorized or not) cannot be deceptive. Since, as explained above, deceptiveness is the essence of trade mark infringement, English law traditionally denied any protection of an image for merchandising by this avenue, though arguably recent developments in the law of registered trade marks give increasing support to the protection of merchandising marks through trade mark registration.¹⁰⁶

The attempt to found merchandising rights on trade mark law has found more success in other jurisdictions. But this has depended on establishing deceptiveness in some artificial way;¹⁰⁷ in reality, deceptiveness is not really in issue at all. One might argue that this is a reasonable fiction by which to make a natural extension to the law in order to generate merchandising rights in law. But the move away from deceptiveness and the promotion of supply of information means that a different justification of the claim is required and this issue is obscured by the fiction.

The right of publicity discussed earlier is a merchandising right in their images for celebrities. It was suggested that the argument for a right of publicity based on the general right of privacy was unconvincing. The argument for a merchandising right arising from the law of trade marks and goodwill is an attempt to establish the same right (although not confined to celebrities) from a different direction, and the discussion above shows that it is also unconvincing.

VI. INTELLECTUAL PROPERTY AND THE OWNERSHIP OF INTANGIBLES

The law of intellectual property is concerned with the ownership of ideas or information or certain other types of valuable intangible.¹⁰⁸ An intellectual property right is a right of ownership in the sense discussed above.¹⁰⁹ It is designed to secure to the owner the commercial value of the intangible created, as a reward for the work and effort involved in creating it and the contribution it makes to the society,

106. The leading cases are *Lyngstrad v. Anabas Products* [1977] FSR 62; *Wombles v. Wombles Skips* (1977) RPC 99; *Tavener Rutledge v. Trexapalm* [1975] FSR 179; and more recently *BBC Worldwide v. Pally Screen Printing* [1998] FSR 665. For the same reason, registration of a merchandising mark has been denied on the ground that the mark is not capable of acting as a trade mark because it will not be so understood by consumers: *Elvis Presley Trade Marks* [1999] RPC 567. More recently *Arsenal FC v. Reed (no. 2)* [2003] RPC 39 suggests a turn in favour of the protection of merchandising rights through trade mark registration.

107. For example, it might be argued that the consumer is deceived because he mistakenly thinks that the use of the merchandising mark was authorized, i.e., a misrepresentation 'as to licensing': see e.g. *Dallas Cowboys Cheerleaders v. Pussycat Cinema* 604 F.2d 200 (1979) and '*Boston Athletic Association v. Sullivan*' 9 USPQ 2d 1960 (1989) in the United States; '*Pacific Dunlop v. Hogan*' (1989) 87 ALR 14 in Australia; and in the English courts *Mirage Studios v. Counter-Feat Clothing* [1991] FSR 145; see further P. Jaffey, 'Merchandising and the Law of Trade Marks' [1998] IPQ 240.

108. This refers to 'non-exclusive' intangibles, which can be used by different people at once, not intangible transferable wealth or money.

109. See *supra* n. 71.

rather than to provide protection from harm or to compensate for harm to an antecedent interest.¹¹⁰ Thus an intellectual property right-holder can make a use claim as explained above as well as a simple claim for compensation for harm; and he can license and sell his right.

In English law, it seems that generally intellectual property rights have not been recognized by the common law, only through a statutory regime:¹¹¹

[C]ourts of equity have not in British jurisdictions thrown the protection of an injunction around all the intangible elements of value, that is, value in exchange, which may flow from the exercise by an individual of his powers or resources whether in the organisation of a business or undertaking or the use of ingenuity, knowledge, skill or labour.

There appear to be certain exceptions to this, however. First, in the law of confidentiality, although the right of privacy is a right against harm, not a right of ownership of private information, as suggested above the right to a trade secret does appear to be a right of ownership, and it is recognized at common law. This may well be justified, though it has emerged from the development of a law of confidentiality that did not identify clearly the principles behind its operation or the interests that it protected. Employers can clearly impose binding obligations of confidentiality on their workers, but this does not necessarily imply that it is justified to have a right of ownership of the information developed in the business. Furthermore, if the trade secret concerns an invention, one might argue that it should be required to be patented and regulated by the statutory patent regime, which is designed to secure an appropriate return to the inventor, and accordingly limits the term of protection.

Secondly, in the law of trade marks, goodwill is a form of intangible property (by contrast with personal reputation, which as discussed above is not recognized as a form of property in the sense above), and it is protected at common law through the law of passing off. This is justifiable, it seems, because goodwill is distinct from other forms of intellectual property in an important respect alluded to above. Normally recognizing an intellectual property right has the drawback of imposing a significant cost on consumers. For example, a patent or copyright allows the right-holder to exclude competitors from selling a product incorporating the protected matter and the effect is to raise prices to the consumer in order to confer a return to the right-holder in excess of what he would otherwise get through the market. It is a complex question involving empirical issues to determine what sort of regime is justified, arguably a question that the courts are not qualified to answer, and this may be why it is appropriate for the recognition of intellectual property rights to be left to the legislature. But the protection of goodwill does not

110. I.e., as opposed to harm to the prospects of securing the benefit of the property, including damage to the property. But some aspects of intellectual property law are concerned with protecting against harm e.g. moral rights in copyright, or copyright where it protects privacy in unpublished works, rather than with securing the value of the intangible to the right-holder.

111. *Victoria Park Racing v. Taylor* (1937) 58 CLR 479, per Dixon J. at 509.

impose any such cost on consumers; to the contrary, the protection of goodwill also benefits consumers by facilitating the supply of information to them.

Thirdly, in recent years there has been a tendency towards recognizing merchandising rights – rights of ownership of images whose appeal to consumers can promote the sale of products. As discussed above, one argument for this in connection with celebrities is the argument for the right of publicity recognized in US law as an aspect of the law of privacy. As pointed out above, the distinction has often been missed here between a right against harm to an interest of the celebrity caused by the commercial use of his image and the celebrity's right of ownership of his image. Neither is plausibly based on a right of informational privacy, and this is particularly clear in the case of the latter. As considered above, another argument for merchandising rights has come from the law of trade marks, through the attempt to characterize the image or a celebrity or other object of fame as a trade mark. This is also misconceived, because an image does not communicate information about the product, and so its use is not deceptive and does not fall within the scope of trade mark infringement, at least as it is conventionally understood. Although image and goodwill are often confused, they are not the same in principle and ownership of image cannot be justified in the same way as ownership of goodwill. The effect of these two lines of argument, if they were to succeed in establishing a merchandising right or a right of publicity, would be to circumvent the traditional aversion to the judicial recognition of intellectual property rights in the common law, without addressing or overcoming the objection mentioned above.

Douglas v. Hello! provides an interesting set of facts to illustrate some of these issues.¹¹² The issue from that case discussed above was whether the claimants Douglas and Zeta-Jones had a claim against the defendant magazine arising from the publication by the defendant of unauthorized photographs of their wedding. When the case eventually reached the House of Lords,¹¹³ the House was concerned only with the claim of the other claimant, OK magazine, which had contracted with Douglas and Zeta-Jones to publish exclusive pictures of the wedding, pursuant to which Douglas and Zeta-Jones had taken the measures to exclude unauthorized photographers.

There are a number of possible types of claim that might arise in these circumstances. The claim by Douglas and Zeta-Jones for breach of confidence based on invasion of privacy succeeded and the couple were awarded a modest sum in damages for compensation.¹¹⁴ For these claimants, there was also the possibility of a claim for breach of contract against an authorized photographer or invited guest who breached an undertaking not to divulge photographs without permission, or a claim against a third party for procuring a breach of contract, but the defendant Hello had only taken advantage of unauthorized photographs and had not procured a breach of contract. Neither had Hello acted unlawfully with a view to causing

112. See also P. Jaffey, *Privacy, Publicity Rights, and Merchandising*, in E. Barendt, A. Firth et al., *infra* n. 77.

113. [2007] UKHL 21.

114. Also there is the possibility of passing off if an endorsement can be found.

harm to OK, so as to have committed the tort of causing harm by unlawful means.¹¹⁵ The possibility of a right of ownership of image, (that is, a right of publicity or merchandising right), not dependent on confidentiality or the privacy of the occasion, which, as Lord Nicholls pointed out might be available in the US,¹¹⁶ was adverted to and rejected.¹¹⁷ As argued above, there is no basis for developing such a right by analogy with the right of informational privacy, or by extension of the law of trade marks.

Also there is the possibility of a right to the photographs as a trade secret. This was not relevant to Douglas and Zeta Jones, who had been paid to transfer the commercial benefit of the photographs to OK, but the majority concluded that, because Douglas and Zeta-Jones had taken the undertakings of confidentiality from their guests on behalf of OK as well as themselves, OK had the benefit of the right to the trade secret which they could enforce against Hello. It was argued above that the law of trade secrets should be understood in terms of ownership of confidential information as property, but the claim was characterised simply as a traditional claim for breach of confidence, and as discussed above there was opposition to a property analysis.

Lord Nicholls, who would have denied OK's claim, took the view that when OK brought forward its own publication of the authorized photographs, knowing that Hello was about to publish unauthorized photographs, it thereby put the trade secret into the public domain, so that when Hello's unauthorized photographs appeared there could be no breach of confidence: 'the unapproved pictures contained nothing not included in the approved pictures'.¹¹⁸ Lord Hoffmann, for the majority, insisted that each photograph was a separate piece of information, and its value, as a photograph, was not lost as a result of a similar photograph having been published.¹¹⁹

Lord Walker made another objection to the claim. He thought that Douglas and Zeta-Jones could not 'invest the wedding reception with the quality of confidentiality, if it did not otherwise attract it', just by taking stringent security arrangements.¹²⁰ But Lord Hoffmann's straightforward view was that any commercially valuable information was capable of being the subject matter of a trade secret, like any other industrial or commercial information.¹²¹

Lord Walker was also concerned that, by recognizing what was in effect a right of confidentiality in respect of any aspect of the appearance of the occasion that might be captured by a photograph, the court was verging on recognizing 'property in a spectacle'. He referred to *Victoria Park Racing v. Taylor*, which was quoted from above, in which the claimant organized a sporting event, and the

115. See para. 129ff, per Lord Hoffmann.

116. See para. 253.

117. See at para. 253 per Lord Nicholls; para. 285 per Lord Walker.

118. See para. 259.

119. See paras 122–3.

120. See para. 294.

121. See per Lord Hoffmann at paras 118–120.

defendant commentated on it from a vantage point outside the stadium. As the quotation shows,¹²² the mere fact that the claimant had generated an object of commercial value was not taken to establish that he had an exclusive right to it, and was entitled to prevent the defendant commentating on it or exact a licence fee from him. In the light of his discussion of the idea of 'property in a spectacle' it is difficult to see why Lord Walker should want to deny that the right to a trade secret is a form of property ownership. But Lord Walker's concern points to something that does appear anomalous: if it is practicable to make arrangements that will secure the confidentiality of an occasion or 'spectacle' then (if the arrangements fail) the organizers will be able to protect it through the law of trade secrets, whereas if such arrangements are impracticable, as in *Victoria Park Racing v. Taylor*, anyone is entitled to exploit the occasion without having to pay anything to the organizers. Similarly, in *Sports & General Press Agency v. Our Dogs Publishing Co.*,¹²³ the claimant sought to prevent the defendant from publishing photographs of a sporting event put on by the claimant, who controlled entry but had not imposed any condition of confidentiality or restriction on taking photographs. It was held that he had no right to prevent the publication of photographs or demand payment.

If the claimant does not have the exclusive right to profit from an event by publishing photographs of it, just by virtue of being the person who organized and managed it, why should he acquire this right through the imposition of confidentiality conditions on the people who attend the event? Why should so much turn, *vis-à-vis* third parties, on whether it is possible to control access and thereby impose confidentiality conditions on visitors? In fact this argument applies to trade secrets in general. A manufacturer who discovers a new method of manufacture that can be put into use without being revealed can rely on the law of trade secrets, but a manufacturer who discovers a new method of manufacture that is inevitably revealed when the product is released onto the market has no protection unless he can get a patent.

VII. CONCLUSION

The action for breach of confidence in English law has evolved to protect the right of privacy, meaning informational privacy. The interest it protects is, broadly speaking, the interest in being free from public scrutiny in circumstances when it is reasonable to act on this assumption. The English courts insist that although the action for breach of confidence protects a right of informational privacy, there is no tort of privacy. This is because of an assumption that the recognition of such a tort would mean recognising a more general, fundamental right of privacy going beyond the right to informational privacy and supporting the recognition of other specific new rights, for example rights against physical intrusion, harassment,

122. See also K Gray, 'Property in Thin Air' [1991] CLJ 252.

123. [1917] KB 125, mentioned by Lindsay J, [2003] All ER 996 para. 222.

‘false light’ invasion of privacy, or the ‘appropriation of personality’. In fact these are either reducible to a right of informational privacy or are quite distinct claims that have different rationales and are based on different interests.

In addition to enforcing express or implicit undertakings of confidentiality against the parties who accepted them and third party accessories, the law of confidentiality in English law includes a law of informational privacy and a law of trade secrets or know-how. Whereas the right of informational privacy is a right against a certain type of personal harm caused by the disclosure of information, the right to a trade secret is, it was argued above, a right of ownership of confidential information.

The right of informational privacy is concerned with reputation, inasmuch as it responds to a general concern with the way in which private information will affect other people’s opinions. In some circumstances, a defamation claim can arise from the same events as a claim for breach of privacy. The two are distinct because defamation is concerned with false statements that damage reputation, whereas privacy is concerned with the disclosure of private information irrespective of its truth or falsity, and without any requirement to show that reputation has actually been adversely affected. ‘False light’ privacy is reducible in principle to either informational privacy or defamation.

The ‘right of publicity’ amounts to a right of ownership of image for celebrities. It is said to be a type of privacy right, but it is not based on the same principle as informational privacy and the recognition of a right of informational privacy provides no support for the recognition of a right of publicity. The right of publicity is a type of merchandising right, and it is sometimes argued that merchandising rights can be established through a natural development of the law of trade marks. This is also unconvincing, because trade marks are in principle concerned with communicating information to consumers, whereas merchandising images do not communicate information but operate purely through their inherent appeal to consumers.

For good reason, the common law has generally avoided recognizing intellectual property rights in the intangible products of labour, leaving it to the legislature to enact an appropriate regime. The recognition of the ownership of confidential information is an exception and so would be the recognition of a merchandising right or right of publicity. According to the decision of the House of Lords in *Douglas v. Hello!*, there can be a right of confidentiality in respect of all aspects of the appearance of an occasion or ‘spectacle’, as a trade secret, if it is held in circumstances such that the organizers can control access to it and take undertakings of confidentiality from people admitted, but there is no ‘property right in a spectacle’ as such, and so no exclusive right to the commercial value of a spectacle if it is not practicable to make such arrangements. This may be anomalous, but if so it is an anomaly that can occur in other contexts in connection with the law of trade secrets.

Chapter 19

A Right of Privacy for Corporations?

*Tanya Aplin**

I. INTRODUCTION

Breach of confidence has become the primary common law vehicle through which English courts protect privacy, a development which has been driven by the European Convention on Human Rights (ECHR), in particular Article 8, and the Human Rights Act 1998 (HRA), in particular sections 6 and 12.¹ Whether one takes the view that English law now recognizes a ‘tort of misuse of private information’² or simply an ‘extended’ form of breach of confidence in relation to private information,³

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1. For a detailed discussion of this development see Aplin, T, ‘The development of the action for breach of confidence in a post-HRA era’ (2007) 1 *IPQ* 19.
2. See *obiter dicta* of the Court of Appeal in *Campbell v. MGN Ltd* [2003] QB 633, 663 and in *Campbell v. MGN Ltd* [2004] 2 AC 457 (‘Campbell’), 465 per Lord Nicholls. See also Singh, R, and Strachan, J, ‘Privacy Postponed’ (2003) *EHRLR* 11, 19–20; Phillipson, G, ‘The “right” of privacy in England and Strasbourg’ in Kenyon, A and Richardson, M, (eds), *New Dimensions in Privacy Law* (Cambridge: CUP, 2006), 184–228; and Toulson, RG and Phipps, CM, *Confidentiality* (London: Sweet & Maxwell, 2006), paras 2–029 and 2–109.
3. See *obiter dicta* of Lord Phillips MR in *Douglas v. Hello! (No 3)* [2006] QB 125 (CA) (‘*Douglas v. Hello! (No 3)*’), 160 and also of Lord Hope in *Campbell*, 480. See also Sims, A, ‘“A Shift in the Centre of Gravity”: the Dangers of Protecting Privacy through Breach of Confidence’ [2005] *IPQ* 27.

an important, and unanswered, question is whether the scope of this protection extends, or should extend, to corporate entities.⁴

This article argues (in section I) that, as the law of confidence now stands, corporations do not have a right of privacy and that there is little legal imperative, either from Strasbourg jurisprudence (see section II) or from other common law jurisdictions, (see section IV), for the courts to develop such a right. Further, there are significant objections to recognizing such a right (discussed in section V). To the extent that a right of privacy protects human dignity and autonomy, corporate entities do not have these qualities and to the extent that privacy may be associated with *other* types of interests existing law adequately protects these.

II. RECENT DEVELOPMENTS IN THE ENGLISH LAW OF CONFIDENCE

In recent years, under the impetus of Article 8 of the ECHR and the HRA, English courts have interpreted and developed the action for breach of confidence in a way that provides much fuller protection to privacy. Courts have achieved this, primarily, by their willingness to protect ‘private’ information that is not necessarily ‘confidential’ and to impose an obligation of confidence because of the private nature of information and in the absence of a confidential relationship.⁵ Although the House of Lords firmly rejected a general tort of privacy in *Wainwright v. Home Office*,⁶ it is arguable that they implicitly recognized a (limited) tort of misuse of private information in *Campbell v. Mirror Groups Newspapers Ltd.*⁷ However, this is far from being universally accepted as the case and the more cautious view is that, in respect of personal or private information, there is now a very different type of action involved – an ‘extended’ action for breach of confidence.⁸

The question to be addressed in this section is whether the ‘extended’ action for breach of confidence encompasses corporate, as well as natural, persons. At the outset, it is important to remember that recent developments to the law of confidence have been *confined* to cases of personal or private information⁹ and

4. A limited discussion of this issue appears in Mulheron, R, ‘A Potential Framework For Privacy? A Reply to *Hello!*’ (2006) 69 *MLR* 679, 709–712.

5. See further Aplin, T, ‘The development of the action for breach of confidence in a post-HRA era’ (2007) 1 *IPQ* 19.

6. [2004] 2 AC 406 (HL) (*‘Wainwright’*).

7. [2004] 2 AC 457 (HL) (*‘Campbell’*). See references in note 2.

8. The merits of recognizing a limited tort of privacy (in the form of misuse of private information) rather than relying on ‘extended’ action for breach of confidence have been discussed at length elsewhere: Aplin, T, ‘The future of breach of confidence and the protection of privacy’ (2007) 7(2) *Oxford University Commonwealth Law Journal* 137.

9. See *Douglas v. Hello! (No 3)*, 150: ‘We conclude that, *in so far as private information is concerned*, we are required to adopt, as the vehicle for performing such duty as falls on the courts in relation to Convention rights, the cause of action formerly described as breach of confidence.’ (emphasis added). See also *Campbell*, 473 per Lord Hoffman: ‘The result of these developments has been a shift in the centre of gravity of the action for breach of confidence

that there is little justification for extending such developments to *commercial* information.¹⁰ Nevertheless, this still leaves open whether juristic entities, such as corporations, can be considered to have *private* – as opposed to *commercial* – information that is capable of protection. The House of Lords decision in *Douglas v. Hello!*¹¹ sheds some light on this issue.

The *Hello!* litigation was prompted by *Hello!* magazine's threatened publication of surreptitiously taken photographs¹² of the high-profile celebrity wedding between Michael Douglas and Catherine Zeta-Jones, in advance of *OK! Magazine's* exclusive coverage of the event. The claimants were unsuccessful in obtaining an interim injunction to prevent the threatened publication,¹³ but at trial Lindsay J found in favour of the claimants on the basis of an actionable breach of confidence¹⁴ and awarded the first and second claimants (the Douglases) pound sterling (GBP) 3,750 each in respect of the distress caused by publication of the unauthorized photographs and GBP 7,000 combined for wasted costs incurred by their having to bring forward preparation, approval and provision of the authorized photographs to the third claimant, *OK! Magazine*.¹⁵ A sum of GBP 1,033,156 was awarded to *OK! Magazine* in respect of lost profits and wasted costs.¹⁶ The Court of Appeal dismissed *Hello! Magazine's* appeal against the first and second claimants but allowed their appeal against *OK! Magazine*. In the House of Lords, *OK! Magazine's* appeal was upheld and the order of Lindsay J restored.¹⁷

Importantly, the House of Lords drew a distinction between the 'traditional' action for breach of confidence and the 'extended' action, which protects privacy. Lord Hoffmann commented: 'English law has adapted the action for breach of confidence to provide a remedy for unauthorized disclosure of personal information'.¹⁸ Similarly, Lord Nicholls stated: 'As the law has developed breach of confidence, or misuse of confidential information, now covers two distinct causes of action, protecting two different interests: privacy, and secret ("confidential") information'.¹⁹ Even more significantly, both Lord Hoffmann and Lord Nicholls were at pains to locate *OK! Magazine's* claim within the realm of 'traditional' breach of confidence, emphasizing that *OK!'s* appeal was *not* concerned with privacy. Lord Nicholls stipulated that, *OK's* interest was wholly commercial,

when it is used as a remedy for the unjustified publication of personal information.' (emphasis added)

10. See further Aplin, T, 'Commercial Confidences after the Human Rights Act' (2007) 10 *EIPR* 411.
11. Reported as *OBG Ltd v. Allan* [2007] UKHL 21 ('*Douglas* (HL)').
12. These were taken by a third party and the photographs subsequently acquired by *Hello!*
13. *Douglas v. Hello! Ltd (No 1)* [2001] QB 967.
14. *Douglas v. Hello! Ltd* [2003] EMLR 31 (Ch D).
15. *Douglas v. Hello!* [2004] EMLR 2 (Ch D), 33.
16. *Douglas v. Hello!* [2004] EMLR 2 (Ch D), 33.
17. Mr Douglas and Ms Catherine Zeta-Jones did not appeal.
18. *Douglas* (HL), para. 118. Baroness Hale and Lord Brown were in agreement with Lord Hoffmann on the breach of confidence issue.
19. *Douglas* (HL), para. 255. Although Lord Nicholls dissented on the issue of whether *OK!* could recover damages for breach of commercial confidentiality, his statement of general principle is consistent with Lord Hoffmann's comments.

in maximizing the financial advantage flowing from having an exclusive right to publish the authorized pictures.²⁰ Lord Hoffmann made the same point, but in stronger terms:

But this appeal is not concerned with the protection of privacy. Whatever may have been the position of the Douglasses, who, as I mentioned, recovered damages for an invasion of their privacy, *OK!'s claim is to protect commercially confidential information and nothing more*. So your Lordships need not be concerned with Convention rights. OK! has no claim to privacy under Article 8 nor can it make a claim which is parasitic upon the Douglasses' right to privacy.²¹ (emphasis added)

Thus, regardless of the Douglasses' privacy interests, OK! was treated as having only commercial interests in the photographs of the wedding. Considering the facts of the case this view makes sense. It is true that OK! wanted to keep the photographs *secret* until it was ready to publish them, but it is difficult to see how the information contained in those photographs could be considered *private vis-à-vis* OK! since the photographs related to the Douglasses' demeanour and activities at their wedding and had nothing to do with OK!'s activities. Instead, OK!'s interest related to *commercial* and not private information.

The above conclusion does not, therefore, preclude the possibility of corporate persons claiming protection for *private* information and relying on 'extended' breach of confidence principles. To do so, however, corporations would have to satisfy the test of 'reasonable expectation of privacy' that was set out in *Campbell*²² and subsequently followed and applied by lower courts.²³ In the recent Court of Appeal decision in *Browne v. Associated Newspapers Ltd*,²⁴ Sir Anthony Clarke MR (delivering the judgment of the Court) held that:

whether any particular piece of information qualifies as private and the claimant has a reasonable expectation of privacy in respect of it, requires a detailed examination of all the circumstances on a case by case basis.²⁵

20. *Douglas* (HL), para. 256.

21. *Douglas* (HL), para. 118.

22. *Campbell*, 466, per Lord Nicholls and 496, per Baroness Hale. See also Lord Hope at 480, however, at 482 and 483, his Lordship appears to substitute this test with an 'obviously private' test and a modified version of the test from *Australian Broadcasting Corporation v. Lenah Game Meats Pty Ltd* (2001) 208 CLR 199, 226 per Gleeson CJ.

23. *Douglas v. Hello! (No 3)*, 161 per Lord Phillips MR (delivering the judgment of the court); *McKennitt v. Ash* [2007] EMLR 4, 123 per Buxton LJ (with whom Latham LJ and Longmore LJ agreed); *HRH The Prince of Wales v. Associated Newspapers Ltd* [2007] 3 WLR 222, 276–277 per Lord Phillips MR (delivering the judgment of the court); *Lord Browne of Madingley v. Associated Newspapers Ltd* [2007] 3 WLR 289, 298 per Sir Anthony Clarke MR (delivering the judgment of the court); *Murray v. Express Newspapers* [2007] EWHC 1908 (Ch), para. 22 per Patten J.

24. [2007] 3 WLR 289 ('*Browne*').

25. *Browne*, 301.

Relevant factors will include the nature of the information itself, the circumstances in which it has been imparted or obtained and the relationship between the relevant persons or parties.²⁶ Interestingly, the Court accepted that information relating to the activities of a business, communicated as a part of a *personal* relationship, could be classified as private.²⁷ But this does not tell us whether business information, communicated by a company as part of a commercial relationship, could give rise to a reasonable expectation of privacy. On the one hand, information such as the activities of board meetings, documentation concerning the finances of a company, or confidential internal correspondence is arguably 'private'. On the other hand, the scope of Article 8 of the ECHR is influential in determining whether there is private information²⁸ and English courts appear to doubt whether Article 8 embraces corporate privacy. This is aptly illustrated by *R v. Broadcasting Standards Commission ex parte BBC* ('BBC').²⁹

BBC concerned a decision of the Broadcasting Standards Commission; a body established pursuant to the Broadcasting Act 1996, that the secret filming of Dixons by the BBC for the purposes of their *Watchdog* programme was an unwarranted infringement of Dixons' privacy according to broadcasting standards. The BBC argued that the decision was *ultra vires* and unlawful and sought judicial review of the decision on the grounds:

- (i) that a company cannot enjoy a right to privacy;
- (ii) that privacy cannot apply to the filming of events in a place to which the public has access; and
- (iii) that the decision of the BSC was unreasonable.

Forbes J quashed the decision of the BSC and granted permission to appeal to the BSC on grounds (i) and (ii). Lord Woolf MR delivered the leading judgment of the Court of Appeal, with which Hale LJ (as she then was) and Lord Mustill agreed. Lord Woolf MR began by emphasizing that the BSC are concerned with ensuring that the media achieve appropriate standards of conduct and not 'with establishing legal rights, human or otherwise.'³⁰ Rather, the BSC provides an avenue through which to make a complaint about broadcasters' conduct which, if upheld, may be published as the BSC consider appropriate. Lord Woolf MR stressed that courts should not interfere with decisions of the BSC where 'the approach which the BSC adopt is one to which, in their statutory context, the words infringement of privacy are capable of applying' and that courts can intervene 'only if an approach to

26. *Browne*, 301.

27. *Browne*, 301.

28. See *Douglas v. Hello!*(CA), 150 per Lord Phillips MR: 'In considering the nature of those rights [Art. 8 and Art. 10], account should be taken of the Strasbourg jurisprudence. In particular, when considering what information should be protected as private pursuant to Art. 8, it is right to have regard to the decisions of the ECtHR.'

29. [2001] QB 885 ('BBC').

30. *BBC*, 892.

“infringement of privacy” by the BSC goes beyond the area of tolerance.³¹ In difficult cases, courts can look to ECtHR, ECJ and other jurisprudence but must be wary of the different contexts in which the word ‘privacy’ is used.³²

The Court of Appeal held that a company could be the subject of a complaint of unwarranted interference with privacy under the Broadcasting Act 1996. Lord Woolf MR explained how that interference could occur:

While the intrusions into the privacy of an individual which are possible are no doubt more extensive than the infringements of privacy which are possible in the case of a company, *a company does have activities of a private nature which need protection from unwarranted intrusion. It would be a departure from proper standards if, for example, the BBC without any justification attempted to listen clandestinely to the activities of a board meeting. The same would be true of secret filming of the board meeting.* The individual members of the board would no doubt have grounds for complaint, but so would the board and thus the company as a whole. The company has *correspondence which it could justifiably regard as private and the broadcasting of the contents of that correspondence would be an intrusion on its privacy.* It could not possibly be said that to hold such actions an intrusion of privacy conflicts with the Convention.³³ (emphasis added)

Lord Woolf MR concluded that it was unlikely that Parliament intended to exclude companies from protection under the Broadcasting Act 1996 and without giving ‘any indication of my view as to the proper application of Article 8 of the Convention to companies’³⁴ that the Act extends to unwarranted interference with the privacy of a company. The BSC’s decision that secret filming was an unwarranted infringement of privacy was also ‘well within’ its discretion.³⁵

Hale LJ agreed, pointing out that the Broadcasting Act 1996 has a concept of ‘privacy’ that differs from Article 8 of the ECHR and that ‘there are many things which companies may (legitimately or illegitimately) wish to keep private, including their property, their meetings and their correspondence’.³⁶ Hale LJ emphasized that the context was one of broadcasting standards, and not legal rights and, as such, this justified ‘a wider view of the ambit of privacy than might be appropriate in some other contexts.’³⁷ However, she acknowledged that ‘[t]here may well be contexts in which the concept should be limited to human beings, whose very humanity is defined by their own particular consciousness of identity and individuality, their own wishes and their feelings.’³⁸

31. *BBC*, 893.

32. *BBC*, 893.

33. *BBC*, 897.

34. *BBC*, 897.

35. *BBC*, 898.

36. *BBC*, 899.

37. *BBC*, 899.

38. *BBC*, 899.

Lord Mustill also took into account the fact that the BSC's task 'is not to declare and enforce sharp-edged legal rights but rather to establish and by admonishment uphold general standards of decent behaviour'³⁹ and he accepted an 'expanded reading of privacy for this special purpose'.⁴⁰ However, Lord Mustill was at pains to 'emphasise the degree to which this conclusion is dependent on the language and purpose of this particular statute'⁴¹ and expressed serious concerns regarding whether an 'impersonal corporate body' could have a right to privacy.⁴²

Thus, the *BBC* decision sends out mixed signals on the issue of corporate privacy. On the one hand, by holding that regulation of broadcasting standards under the Broadcasting Act 1996 extends to unwarranted interferences with the privacy of a company, the Court recognized that corporate entities have privacy *interests*. However, on the issue of whether a corporation has a *legal* right to privacy, in particular under Article 8 of the ECHR, Lord Woolf MR adopted a non-committal stance, Hale LJ expressed some doubts and Lord Mustill voiced serious scepticism. With the law as it now stands, it seems that English courts will be reluctant to expand breach of confidence principles to protect the privacy of corporations. However, the *BBC* decision pre-dated the ECtHR decision in *Societe Colas Est v. France*.⁴³ The impact of this case, along with other Article 8 jurisprudence, on the future development of English law is therefore considered in the next section.

III. ARTICLE 8 JURISPRUDENCE AND ITS IMPACT ON ENGLISH LAW

Article 8 of the ECHR⁴⁴ states:

1. Everyone has the right to respect for his private and family life, his home and his correspondence.
2. There shall be no interference by a public authority with the exercise of this right except such as in accordance with the law and is necessary in a democratic society in the interests of national security, public safety or the economic well-being of the country, for the prevention of disorder or crime, for the protection of health or morals, or for the protection of the rights and freedoms of others.

39. *BBC*, 900.

40. *BBC*, 900.

41. *BBC*, 900.

42. *BBC*, 900.

43. (2004) 39 EHRR 17.

44. On the origins of Art. 8 see Velu, J, 'The European Convention On Human Rights And The Right To Respect For Private Life, The Home And Communications' in A.H. Robertson (ed.), *Privacy and Human Rights* (Manchester University Press, 1973, Manchester), 12–95 at 14–18.

Given the influence that Article 8 of the ECHR has had on English courts' development of the law of confidence, as a result of the HRA,⁴⁵ it is important to consider the scope of protection provided by this article. It is clear that natural persons are entitled to the protection of Article 8 and that this right is engaged in various situations, including when State authorities intercept an individual's mail and telephone conversations,⁴⁶ regardless of whether these communications occur from their home or work premises.⁴⁷ Article 8 also applies to the execution of civil search orders and search warrants at an individual's domestic or business premises.⁴⁸ The basis for widening the notion of 'private life' and 'home' to include the business premises of an individual was explained by the ECtHR in *Niemetz v. Germany*.⁴⁹ This was a case in which a lawyer complained that execution of a search warrant at his offices amounted to a breach of Article 8 of the ECHR. In contesting this complaint, the Government of Germany argued that Article 8 drew a clear distinction between private life and home, on the one hand, and professional and business life and premises, on the other. This submission was rejected by the Court, who held that respect for private life comprised 'to a certain degree the right to establish and develop relationships with other human beings' and that there was:

no reason of principle why this understanding of the notion of 'private life' should be taken to exclude activities of a professional or business nature since it is, after all, in the course of their working lives that the majority of people have a significant, if not the greatest, opportunity of developing relationships with the outside world.⁵⁰

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45. For a comprehensive and general discussion of the status of the ECHR on UK domestic law both pre and post the HRA see Blackburn, R, 'The United Kingdom' in Blackburn, R and Polakiewicz, J (eds), *Fundamental Rights in Europe* (OUP, 2001), chapter 36.
46. *Klass v. Federal Republic of Germany* (1979) 2 EHRR 214 (legislation permitting government surveillance of mail and telephone conversations interfered with an individual's Art. 8 rights but were held to be measures necessary in a democratic society in the interests of national security and for the prevention of disorder or crime, thus there had been no breach of Art. 8).
47. *Huwig v. France* (1990) 12 EHRR 528 (police tapping of an individual's business and private telephone lines was held to be a violation of Art. 8 because there were inadequate safeguards against various possible abuses); *Halford v. United Kingdom* (1997) 24 EHRR 523 (interception of private telephone calls made from business premises on a private telecommunications network a violation of Art. 8).
48. *Chappell v. United Kingdom* (1990) 12 EHRR 1 (the execution of an Anton Piller order requiring the applicant to allow the plaintiffs in a copyright infringement action to search his business premises, that also served as his domestic premises, was an interference with the applicant's Art. 8 right to respect for his 'private life' and 'home' but one that was justified under Art. 8(2)); *Niemetz v. Germany* (1993) 16 EHRR 97 (execution of a search warrant by the police at a lawyer's offices was held to be a violation of the lawyer's rights under Art. 8); *Tamosius v. United Kingdom* (2002) 35 EHRR CD 323 (search warrant executed at the applicant's offices constituted an interference with his Art. 8 rights, but one that was justified under Art. 8(2)).
49. (1993) 16 EHRR 97. For a discussion of how this decision impacts on the private life of employees *vis-à-vis* their employers see Ford, Michael, 'Two Conceptions of Worker Privacy' (2002) 31 *Industrial Law Journal* 135.
50. *Niemetz*, 111.

Further, the notion of ‘home’ could include business premises because this was a view accepted in certain Contracting States, such as Germany, and was consistent with the French text of the Convention, which uses the word ‘domicile’.⁵¹ Finally, the Court stated that interpreting ‘private life’ and ‘home’ to include professional or business activities or premises ‘would be consonant with the essential object and purpose of Article 8, namely to protect the individual against arbitrary interference by the public authorities.’⁵²

The ECtHR has therefore interpreted Article 8 in a manner that embraces an *individual’s* work communications and premises and, until its decision in *Societe Colas Est v. France*,⁵³ had not addressed the question of whether Article 8 extends to the premises and communications of a *corporate* person. On the issue of whether Article 8 extends to corporate entities the *travaux preparatoires* offers little guidance. It appears that Article 8 was based on Article 12 of the Universal Declaration of Human Rights, which states:

No one shall be subjected to arbitrary interference with his privacy, family, home or correspondence, nor to attacks upon his honour and reputation. Everyone has the right to the protection of the law against such interference or attacks.

Further, the words ‘nor to attacks upon his honour and reputation’ in Article 12 of the Declaration were intentionally omitted from what would become Article 8 of the ECHR, although the reasons for this omission are not apparent.⁵⁴ In fact, there is remarkably little discussion of the ambit of Article 8 in the *travaux preparatoires*. Even so, Marius Emberland has argued that, ‘the drafting process nonetheless supports an individualized reading of the provision’⁵⁵ on the basis that Article 12 of the Universal Declaration of Human Rights was mainly concerned

51. Niemetz, 112.

52. Niemetz, 112.

53. (2004) 39 EHRR 17 (*Societe Colas Est*).

54. See the Report presented by Mr P. H. Teitgen (Doc A 290), in the name of the Committee on Legal and Administrative Questions of the Consultative Assembly of the Council of Europe on 5 September 1949, paras 6–8. This Report may be found in Martinus Nijhoff (ed.), *Collected Edition of the Travaux preparatoires of the European Convention on Human Rights/Council of Europe*, (The Hague, 1975), volume 1 at 192 et seq. See also Report to the Committee of Ministers submitted by the Committee of Experts instructed to draw up a draft convention of collective guarantee of human rights and fundamental freedoms, Doc. CM/WP 1 (50) 15; 16 March 1950. This Report may be found in Martinus Nijhoff (ed.), *Collected Edition of the Travaux preparatoires of the European Convention on Human Rights/Council of Europe*, (The Hague, 1975), volume IV at 18 et seq. For discussion of the relevant excerpts of *travaux preparatoires* see Velu, J, ‘The European Convention On Human Rights And The Right To Respect For Private Life, The Home And Communications’ in A.H. Robertson (ed.), *Privacy and Human Rights* (Manchester University Press, 1973, Manchester), 12–95 at 14–18. See also Council of Europe, European Commission of Human Rights, Preparatory Work on Art. 8 of the European Convention on Human rights Information Document prepared by Secretariat of the Commission DH(56) 12, Strasbourg 9 August 1956 found at <www.echr.coe.int/Library/COLENTTravauxprep.html>.

55. Emberland, Marius, *The Human Rights of Companies: Exploring the Structure of ECHR Protection* (Oxford: OUP, 2006), 115.

with the protection of individuals and formed the model for Article 8 of the ECHR and given the post-World War II climate in which the ECHR was adopted.⁵⁶

*Societe Colas Est v. France*⁵⁷ is the first (and so far only) ECtHR decision concerning the scope of Article 8 as it relates to corporate persons. The case involved inspection of premises of various companies in the course of investigating violations of French competition law. Pursuant to an ordinance that conferred a general right of inspection of business premises without prior judicial authorization, inspectors from the National Investigation Office in France entered the premises of the three applicant companies and seized documents containing evidence of their anti-competitive practices pertaining to the construction industry. The companies were later found to be in breach of competition rules and fined accordingly.⁵⁸ Before the ECtHR the applicant companies contended that the raids and seizures carried out by the National Investigation Office were contrary to Article 8 of the Convention, specifically, the ‘right to respect for one’s...home’. In response, the French Government submitted that while juristic persons could claim protection under the ECHR, a claim to the protection of their professional or business premises could not be made with as much force as an individual and that the entitlement to interfere might be more far-reaching.⁵⁹ Referring to its earlier decisions in *Chappell v. United Kingdom*⁶⁰ and *Niemetz v. Germany*⁶¹ and adopting a dynamic interpretation of the Convention, the Court held that: ‘in certain circumstances the rights guaranteed by Art. 8 of the Convention may be construed as including the right to respect for a company’s registered office, branches or other business premises.’⁶² On the issue of whether the interference was justified by Article 8(2), the Court held that the raids and seizures were in accordance with the law and in pursuance of a legitimate aim. However, due to lack of adequate and effective safeguards in the relevant legislation, the Court held that they were not strictly proportionate to the legitimate aims pursued, even assuming

56. Emberland (2006), 115 discussing Doswald-Beck, L, ‘The Meaning of the “Right to Respect for Private Life” under the European Convention on Human Rights’ (1983) 4 *HRLJ* 283, 286–287. He further argues at 116 that the philosophical justifications for privacy protection ‘reinforce the doctrinally founded sentiment that corporate claims are located at best on the margins of the provision’s compass.’

57. For extensive discussion see Emberland, M, ‘Protection against Unwarranted Searches and Seizures of Corporate Premises under Art. 8 of the European Convention on Human Rights: the *Colas Est SA v. France* Approach’ (2003) 25 *Mich J Intl L* 77.

58. The fines in *Societe Colas Est* were levied on the companies and not on the corporate officers, thus there was no question of protecting individual privacy. Note that in France administrative fines for breaches of competition law by companies can only be levied on the company and not on corporate officers (see Code de Commerce L464-2 at <<http://195.83.177.9/code/liste.phtml?lang=uk&c=32&r=3108>>), although the position is different for criminal proceedings (see Code de Commerce L420-6 at <<http://195.83.177.9/code/liste.phtml?lang=uk&c=32&r=3096>>), (last accessed 21 April 2008).

59. *Societe Colas Est*, 385.

60. (1990) 12 EHRR 1.

61. (1993) 16 EHRR 97.

62. *Societe Colas Est*, 388.

that the entitlement to interfere with the business premises of a juristic person was more far reaching.⁶³ The applicant companies were awarded ‘just satisfaction’, under Article 41 of the Convention, for the violation of their Article 8 rights. This included a sum in respect of non-pecuniary damage (EUR 5,000 each) and a sum in respect of the legal costs incurred during the domestic proceedings (ranging from EUR 4,400 to 6,700).

Following the ECtHR decision in *Societe Colas Est* it may be said that Article 8 of the ECHR encompasses the right to respect for the privacy of a company’s registered office, branches or other business premises.⁶⁴ This apparently covers searches of, and seizure of documents from, such premises. Consistent with a dynamic interpretation of the Convention, one might expect the ECtHR to accept, in the future, that Article 8(1) prohibits the interception of telephone, mail or electronic communications to business premises. What the decision does not tell us, however, is when such activities will be regarded as justified under Article 8(2).

Although decisions of the ECtHR are not binding on English courts, section 2(1) of the HRA requires courts to ‘take into account’ the relevant Strasbourg jurisprudence.⁶⁵ In *R (on the application of Alconbury Developments Ltd) v. Secretary of State for the Environment, Transport and the Regions*,⁶⁶ Lord Slynn indicated that:

In the absence of some special circumstances it seems to me that the court should follow any clear and constant jurisprudence of the European Court of Human Rights. If it does not do so there is at least a possibility that the case will go to that court, which is likely in the ordinary case to follow its own constant jurisprudence.⁶⁷

As Fenwick and Phillipson have argued, English courts, in applying Strasbourg decisions, should be aware of the fact that this jurisprudence reflects the margin of appreciation doctrine and is thus already a deferential standard.⁶⁸ As such, courts could go beyond the minimal standards applied in the Strasbourg jurisprudence.⁶⁹ In relation to *Societe Colas Est*, therefore, it could be argued that courts should ensure that the business premises of corporations are not unduly interfered with by the State and that the level of interference that can be tolerated is lower.

63. *Societe Colas Est*, 391.

64. Note also that the ECJ relied on *Societe Colas Est* in Case C-94/00, *Roquette Frères SA v. Directeur general de la consommation et de la repression des frauds* [2002] ECR I-9011 §§ 29 & 52, to reject the position it adopted in *Hoescht AG v. EC Commission* [1991] 4 CMLR 410 that the right to inviolability of the home did not include business premises.

65. Blackburn, R, ‘The United Kingdom’ in Blackburn, R and Polakiewicz, J (eds), *Fundamental Rights in Europe* (OUP, 2001), Ch. 36, 964–965.

66. [2003] 2 AC 295.

67. *R (on the application of Alconbury Developments Ltd) v. Secretary of State for the Environment, Transport and the Regions* [2003] 2 AC 295, 313.

68. Fenwick and Phillipson, *Media Freedom under the Human Rights Act* (OUP, 2006), 146–147.

69. Fenwick and Phillipson (2006), 147.

But what of situations where the interference is by a private, rather than state, entity? Do English courts come under an obligation to protect a corporation's Article 8 rights? The ECtHR decision in *Von Hannover v. Germany*⁷⁰ held that failure by the German courts to provide a remedy to Princess Caroline of Monaco against publication of photographs taken by the paparazzi of her in public contravened Article 8.⁷¹ Based on *Von Hannover*, it could be argued that failure to provide corporations with a remedy⁷² against interference with their business premises and seizure of business documents by private entities *itself* amounts to a breach of Article 8. However, given the torts of trespass to land, trespass to chattels and conversion, it may be questioned whether English law fails to provide a remedy against such interference. What then of situations where the interference comprises acts beyond the search of premises and seizure of documents, such as wiretapping of telephones, the use of listening devices, surreptitiously filming or photographing activities within an organization, or taking copies of documents (or other media) and then using or publishing this information? ECtHR jurisprudence provides no answer, although it may be speculated that a 'dynamic interpretation' of Article 8 could lead to such activities being caught. Assuming they were, the question again would be whether English law fails to provide a remedy. Here, it would be possible to point to copyright law (for prohibiting the copying and communication of documents and other media), trespass to land (where surveillance devices are installed on property),⁷³ trespass to chattels (where computers are 'hacked' into from outside an organization)⁷⁴ and 'traditional' breach of confidence (for use or disclosure of information obtained through wiretapping, listening devices, and surreptitious filming or photography in non-public spaces),⁷⁵

70. (2005) 40 EHRR 1.

71. Fenwick and Phillipson (2006), 672–674 are highly critical of the court's lack of explanation of this important finding.

72. It is unclear to what extent a remedy has to be adequate. In *Winer v. UK* (1986) 48 IR 154 a defamation action was available but not particularly helpful in respect of truthful statements, yet the Commission declared inadmissible the applicant's complaint that his lack of a remedy in respect of truthful statements was a contravention of Art. 8. In *Earl Spencer v. United Kingdom* (1998) 25 EHRR CD 105, the Commission stated that it 'would not exclude that the absence of an actionable remedy in relation to the publications of which the applicants complain could show a lack of respect for their private lives' and had regard to 'Contracting States' obligation to provide a measure of protection to the right of privacy of an individual affected by others' exercise of their freedom of expression'. As Fenwick and Phillipson (2006), 669 point out: 'the sting lies in what counts as a "measure of protection".' The Commission declared the applicants' complaints under Art. 8 inadmissible because they had not exhausted domestic remedies (specifically breach of confidence).

73. *Clerk and Lindsell on Torts* 19th ed. (Sweet & Maxwell, London, 2005) ('Clerk & Lindsell'), para. 19–02.

74. Clerk & Lindsell, para. 17–126.

75. *Attorney General v. Guardian Newspapers (No 2)* [1990] 1 AC 109 ('A-G v. Guardian'), 281 per Lord Goff; *Francome v. Mirror Group Newspapers Ltd* [1984] 2 All ER 408; *Hellewell v. The Chief Constable of Derbyshire* [1995] 1 WLR 804, 807; *Shelley Films Ltd v. Rex Features Ltd* [1994] EMLR 134; *Creation Records Ltd v. News Group Newspapers Ltd* [1997] EMLR 444.

as offering remedies. As such, it may be questioned whether ‘extended’ breach of confidence would have to be expanded further to embrace corporate entities. Therefore, it is submitted that as ECtHR jurisprudence currently stands, Article 8 would not compel courts to create a tort of privacy for, or apply ‘extended’ breach of confidence to, corporations.

None of this is to say that English courts are *prevented* from applying ‘extended’ breach of confidence to corporations. Indeed, given that ‘extended’ breach of confidence is a recent development in English law and its contours have only started to take shape, the action could be used to embrace corporate privacy if courts so desired. But, at present, there is little to suggest that the judiciary will do so. Further, as we shall see from the next section, English courts will find minimal support for this kind of development in other, common law jurisdictions.

IV. COMPARATIVE EXPERIENCES: AUSTRALIA, NEW ZEALAND AND THE UNITED STATES

While English courts are not bound by jurisprudence from other, common law jurisdictions, they have on occasions found it a useful source of comparison and of some persuasive value.⁷⁶ Thus, this section briefly compares the ways in which courts in Australia, New Zealand and the US have reacted to the notion of a right to privacy for corporate entities. As will be seen, the support has been underwhelming.

IV.A AUSTRALIA

A tort of invasion of privacy does not exist under Australian law.⁷⁷ Moreover, the Australian High Court in *ABC v. Lenah Game Meats Pty Ltd*⁷⁸ has indicated that if

76. For example see *Campbell*, 482 per Lord Hope; 496 per Baroness Hale; and 504 per Lord Carswell where use is made of *ABC v. Lenah Game Meats Pty Ltd* (2001) 208 CLR 199 and *Murray v. Express Newspapers* [2007] EWHC 1908 (Ch), paras 33–35, and para. 68 where Patten J considers and applies *Hosking v. Runting* [2005] 1 NZLR 1.

77. In *Victoria Park Racing and Recreation Grounds Co Ltd v. Taylor* (1937) 58 CLR 479, Latham CJ at 496 rejected the argument that the law recognizes a right of privacy, commenting that ‘[h]owever desirable some limitation upon invasions of privacy might be, no authority was cited which shows that any general right of privacy exists.’ See also the dissenting judgment of Evatt J at 517 where he states: ‘the defendants insist that the law of England does not recognize any general right of privacy. That is true, but it carries the defendants no further’.

78. (2001) 208 CLR 199 (*‘Lenah’*). For excellent analysis of the decision see Heath, William M, ‘Possum Processing, Picture Pilfering, Publication and Privacy: *Australian Broadcasting Corporation v. Lenah Game Meats Pty Ltd*’ (2002) 28 *Monash University Law Review* 162; Stewart, D, ‘Protecting Privacy, Property, and Possums: *Australian Broadcasting Corporation v. Lenah Game Meats Pty Ltd*’ (2002) 30 *Federal Law Review* 177; Taylor, G and Wright, D, ‘*Australian Broadcasting Corporation v. Lenah Game Meats*’ (2002) 26 *Melbourne University Law Review* 707; Trindade, F, ‘Possums, privacy and the implied freedom of communication’ (2002) 10 *Torts Law Journal* 119.

such a tort were to be recognized it would be unlikely to apply to corporations. In this case, the respondent ran a brush tail possum processing facility. A surreptitiously and unlawfully obtained film of activities occurring at the respondent's facility had been supplied to the appellant, who proposed to broadcast footage from the film in one of its current affairs programmes. The respondents applied to the Supreme Court of Tasmania for an interlocutory injunction. This was refused by Underwood J, but on appeal was granted by a majority of the Full Court. The ABC's appeal to the High Court was allowed.

One of the issues raised on appeal was whether broadcast of the film by the ABC would amount to an actionable invasion of privacy. The ABC argued that it would not, on the basis that privacy is not a right enjoyed by corporations. Gleeson CJ took the view that, if the activities occurring at Lenah's facility were private, the case would be adequately protected by the law of confidence.⁷⁹ However, he found that the information was neither secret nor confidential⁸⁰ and thus it was unnecessary to determine whether, and in what circumstances, a corporation may invoke privacy.⁸¹ In *obiter*, his honour expressed the view that some forms of corporate activity could be considered private, such as directors' meetings and internal corporate communications,⁸² but that 'the foundation of much of what is protected, where rights of privacy, as distinct from rights of property, are acknowledged, is human dignity' and that this 'may be incongruous when applied to a corporation.'⁸³

Gummow and Hayne JJ, delivering a joint judgment, held that the earlier High Court decision of *Victoria Park Racing and Recreation Grounds Co Ltd v. Taylor*⁸⁴ did not stand in the way of courts' developing a tort of privacy but that if such a development took place it would be for the benefit of natural, and not artificial, persons.⁸⁵ This was because legal personalities could not invoke the 'fundamental value of personal autonomy'⁸⁶ and because Australia should not depart from the position in the US, developed over a long period time, that an action for invasion of privacy (aside from appropriation of one's name or likeness) can only be maintained by an individual.⁸⁷

Kirby J. did not consider it necessary to decide whether there was a corporate right to privacy. He preferred to postpone to another day the difficult question of whether *Victoria Park Racing* presented an obstacle to developing a tort of privacy and his reluctance was compounded by doubts about whether a corporation can enjoy a right to privacy. He commented that Article 17 of the International

79. *Lenah*, 225.

80. *Lenah*, 223 & 224. A view criticized by Horton, 'Towards a Real Right of Privacy' (2003) 29 *Monash University Law Review* 401; Stewart (2002), 194–195 and Taylor and Wright (2002), 714–718.

81. *Lenah*, 226.

82. *Lenah*, 226.

83. *Lenah*, 226.

84. (1937) 58 CLR 479.

85. *Lenah*, 258.

86. *Lenah*, 256.

87. Citing Section 652I of the *Restatement of the Law Second, Torts* (1977) – see *Lenah*, 257.

Covenant on Civil and Political Rights appeared to be limited to individuals, as did the position under US law, where privacy ‘has had a long gestation’.⁸⁸ Moreover, he regarded it as ‘artificial to describe the affront to the respondent as an invasion of privacy’.⁸⁹

Callinan J was the most positive about the possibility of recognizing a tort of privacy and also about extending this to juristic persons. He observed that ‘the time is ripe for consideration whether a tort of invasion of privacy should be recognized in this country’⁹⁰ and that he ‘would not rule out the possibility that in some circumstances, despite its existence as a non-natural statutory creature, a corporation might be able to enjoy the same or similar rights to privacy as a natural person’.⁹¹

Thus, four members of the Australian High Court expressed significant doubts about whether any emergent tort of privacy would apply to corporations,⁹² while one member remained open to the possibility and another (Gaudron J) did not address the issue at all.

IV.B NEW ZEALAND

In *Hosking v. Runtig*⁹³ a majority of the New Zealand Court of Appeal chose to recognize a tort of interference with privacy, rather than develop the action for breach of confidence along similar lines to English courts. Gault and Blanchard JJ (in a joint judgment) and Tipping J narrowly defined the tort as relating to wrongful publicity of private facts.⁹⁴ The elements of the action were set out in the leading judgment of Gault and Blanchard JJ as:

1. The existence of facts in respect of which there is a reasonable expectation of privacy; and
2. Publicity given to those facts that would be considered highly offensive to an objective reasonable person.⁹⁵

Neither the judgment of Gault and Blanchard JJ nor that of Tipping J considers whether the new tort of wrongful disclosure of private facts extends to corporate entities. This is perhaps unsurprising given that the case concerned whether or not the Hoskings could prevent photographs taken of their children in a public place from being published and the fact that earlier lower court decisions recognizing a

88. *Lenah*, 279.

89. *Lenah*, 279.

90. *Lenah*, 328.

91. *Lenah*, 326.

92. The view that corporations should be excluded from any emergent tort of privacy has been criticized by Taylor and Wright (2002), 719–725.

93. [2005] 1 NZLR 1 (*Hosking v. Runtig*).

94. See *Hosking v. Runtig*, 32 per Gault and Blanchard JJ and Tipping J, 62.

95. *Hosking v. Runtig*, 32. Gault and Blanchard JJ left open for another time the possibility of a tortious remedy for ‘unreasonable intrusion into a person’s solitude or seclusion’.

tort of privacy also concerned the claims of individuals.⁹⁶ Arguably, however, there are hints that the court envisaged the tort as restricted to individuals. For example, Tipping J comments that: ‘It is of the essence of the dignity and personal autonomy and wellbeing of *all human beings* that some aspects of their lives should be able to remain private if they so wish.’⁹⁷ (emphasis added) Further, in justifying why a separate tort should be recognized, instead of relying on breach of confidence, Gault and Blanchard JJ comment: ‘Privacy and confidence are different concepts. To press every case calling for a remedy of unwarranted exposure of information about the *private lives of individuals* into a cause of action having as its foundation trust and confidence will be to confuse those concepts.’⁹⁸ (emphasis added) It is admitted that these *dicta* are a weak basis for ruling out the possibility of the tort applying to juristic persons. However, it is difficult to predict whether the tort will develop to encompass corporate entities, particularly as decisions of lower courts following *Hosking v. Runting*⁹⁹ have also involved claims by individuals of unwarranted interference with privacy. Thus, it appears that, for the time being at least, the tort is being restricted to natural, and not juristic, persons.

IV.C UNITED STATES

The US is the common law jurisdiction with the longest standing tort of privacy. The prevailing orthodoxy is that the renowned article of Samuel Warren and Louis Brandeis,¹⁰⁰ published in 1890, significantly influenced the development of the tort in the US.¹⁰¹ A common law right to privacy was first recognized in *Pavesich v. New England Life Insurance Co.*¹⁰² where the Georgia court refused

96. *Tucker v. News Media Ownership Ltd* [1986] 2 NZLR 716; *Bradley v. Wingnut Films Ltd* [1993] 1 NZLR 415; *P v. D* [2000] 2 NZLR 591; and *L v. G* [2002] DCR 234.

97. *Hosking v. Runting*, 58.

98. *Hosking v. Runting*, 16.

99. *Rogers v. Television New Zealand* [2007] NZSC 91 (16 November 2007) and *Andrews v. Television New Zealand* [2006] NZHC 158 (15 December 2006).

100. Warren and Brandeis, ‘The Right to Privacy’ (1890) 4 *Harvard Law Review* 193.

101. Numerous leading articles treat the Warren and Brandeis’s article as influential in the development of the US tort of privacy. See, for example, Prosser, William L., ‘Privacy’ (1960) 48 *California Law Review* 383, 386; Bloustein, Edward J., ‘Privacy as an Aspect of Human Dignity: An Answer to Dean Prosser’ (1964) 39 *N. Y. U. L. Rev.* 962, 964; Kalvern Jr, Harry, ‘Privacy in Tort Law – Were Warren and Brandeis Wrong?’ (1966) 31 *Law & Contemp. Probs.* 326, 327; Zimmerman, Diane L., ‘Requiem for a Heavyweight: A Farewell to Warren and Brandeis’s Privacy Tort’ (1983) 68 *Cornell Law Review* 291, 292; Turkington, Richard C., ‘Legacy of the Warren and Brandeis Article: The Emerging Unencumbered Constitutional Right to Informational Privacy’ (1990) 10 *N. Ill. U. L. Rev.* 470, 481; and Bezanson, Randall P., ‘The Right to Privacy Revisited: Privacy, News, and Social Change, 1890–1990’ (1992) 80 *California Law Review* 1133. Although see Whitman, James Q., ‘Two Western Cultures of Privacy: Dignity Versus Liberty’ (2004) 113 *Yale Law Journal* 1151 at 1204 commenting that ‘it is best to think of the Warren and Brandeis tort not as a great American innovation, but as an unsuccessful continental transplant’.

102. 122 Ga 190 (1905).

to follow the New York decision in *Roberson v. Rochester Folding Box Co*¹⁰³ which rejected a right to privacy.¹⁰⁴ Courts in numerous states subsequently recognized a common law right to privacy¹⁰⁵ and by 1939 the tort was referred to in the *Restatement of Torts* (1939), section 867. In the *Restatement of Torts Second* (1977), section 652A, the tort of privacy is formulated as having the following four components:¹⁰⁶

1. Intrusion upon seclusion: ‘One who intentionally intrudes, physically or otherwise, upon the solitude or seclusion of another or his private affairs or concerns, is subject to liability to the other for invasion of his privacy, if the intrusion would be highly offensive to a reasonable person.’
2. Appropriation of name or likeness: ‘One who appropriates to his own use or benefit the name or likeness of another is subject to liability to the other for invasion of his privacy.’
3. ‘Publicity given to private life: One who gives publicity to a matter concerning the private life of another is subject to liability to the other for invasion of his privacy, if the matter publicized is of a kind that
 - (a) would be highly offensive to a reasonable person, and
 - (b) is not of legitimate concern to the public.’
4. Publicity placing Person in False Light: ‘One who gives publicity to a matter concerning another that places the other before the public in a false light is subject to liability to the other for invasion of his privacy, if
 - (a) the false light in which the other was placed would be highly offensive to a reasonable person, and
 - (b) the actor had knowledge of or acted in reckless disregard as to the falsity of the publicized matter and the false light in which the other would be placed.’

Despite the width of the US tort, it has been criticized for failing adequately to protect privacy.¹⁰⁷ This is partly due to courts’ willingness to impose empirical,

103. 171 NY 538 (1902).

104. The decision was effectively overturned by the New York Legislature’s subsequent enactment of a statute making it both a tort and misdemeanour to make use of the name, portrait or picture of any person for ‘advertising purposes or for the purposes of trade’ without his written consent: see NY Sess. Laws 1903, Ch 132 ss. 1–2, replaced by NY Civil Rights Law 2000 §§ 50-1.

105. See Prosser (1960), 386–388.

106. A formulation heavily influenced by Prosser (1960).

107. For example see Anderson, David A, ‘The Failure of American Privacy Law’ in Markesinis, B (ed.), *Protecting Privacy* (Oxford, OUP, 1999), 139–167; and Harvey, G. Michael, ‘Confidentiality: A Measured Response to the Failure of Privacy’ (1992) 140 *University of Pennsylvania Law Review* 2385 who argues that it would be preferable to inter the ‘impotent private-facts tort’ and adopt a much narrower tort of breach of confidence than is in the case in England. See also Bezanson, ‘*The Right to Privacy Revisited: Privacy, News, and Social Change, 1890–1990*’ (1992) 80 *California Law Review* 1133 who argues for interring the privacy tort because it no longer relevant to today’s society and relying on a tort of breach of confidence instead. Contrast Whitman (2004) who does not characterize the US law of

rather than normative, notions of what is 'private',¹⁰⁸ and in large part due to the constitutional protection of free speech, which has supported an extremely generous defense of publication in the public interest¹⁰⁹ and prohibited liability for disclosing information obtained from open court records.¹¹⁰

There have been court decisions rejecting the notion that corporations have a right to privacy,¹¹¹ although these precedents have been described as 'neither too numerous nor compelling'.¹¹² It is only in relation to the appropriation limb of privacy that courts have been less reluctant to extend the common law tort of privacy to juristic entities. Thus, section 652I of the *Restatement* states that: 'Except for the appropriation of one's name or likeness, an action for invasion of privacy can be maintained only by a living individual whose privacy is invaded.'

Courts have also occasionally suggested that corporate privacy is an interest legitimately protected by trade secrets law. For example, in *E.I. duPont de Nemours & Co v. Christopher*¹¹³ the US Court of Appeals for the Fifth Circuit held that aerial photography of the plaintiff's manufacturing plant that was under construction was an 'improper means' of obtaining another's trade secret, giving as one of their reasons the protection of commercial privacy.¹¹⁴ Further, in *Kewanee Oil Company v. Bicron Corporation*¹¹⁵ the US Supreme Court, in deciding that Ohio's trade secrets law were not pre-empted by Federal patent laws, commented that: 'A most fundamental human right, that of privacy, is threatened when industrial espionage is condoned or is made profitable; the state interest in denying profit to such illegal ventures is unchallengeable.'¹¹⁶ As will be argued in Section V, part B,

privacy as having failed, but rather as having a fundamentally different focus to continental notions of privacy. He describes at 1161 the US conception of privacy as 'oriented toward values of liberty, and especially liberty against the state' whereas continental privacy protections are primarily concerned with 'a right to respect and personal dignity'.

108. Anderson (1999), 148–150.

109. Kalvern Jr, Harry, 'Privacy in Tort Law – Were Warren and Brandeis Wrong?' (1966) 31 *Law & Contemp. Probs.* 326, 335–337; Anderson (1999), 150–152.

110. Anderson (1999), 157–159.

111. Lindsay, William C., 'When Uncle Sam Calls Does Ma Bell Have To Answer?: Recognizing A Constitutional Right To Corporate Informational Privacy' (1985) 18 *J. Marshall L. Rev.* 915. See also Comment, 'Corporate Privacy: A Remedy for the Victim of Industrial Espionage' (1971) *Duke L. J.* 391, 400–403 and Nizer, Louis, 'The Right of Privacy: A Half Century's Developments' (1941) 39 *Michigan Law Review* 526, 550.

112. Allen, Anita L., 'Rethinking the Rule against Corporate Privacy Rights: Some Conceptual Quandries For the Common Law' (1987) 20 *J. Marshall L. Rev.* 607, 612.

113. 341 F. 2d 1012 (1970).

114. *E.I. duPont de Nemours & Co v. Christopher* 341 F. 2d 1012 (1970), 1016: 'Commercial privacy must be protected from espionage which could not have been reasonably anticipated or prevented'. Bone (1998), 298 criticizes this view.

115. 94 S.Ct. 1879 (1974).

116. *Kewanee Oil Company v. Bicron Corporation* 94 S.Ct. 1879 (1974), 1889. Although, it may be queried whether the passage relied upon by the Supreme Court (Note, 'Patent Preemption of Trade Secret Protection of Inventions Meeting Judicial Standards of Patentability (1974) 87 *Harvard Law Review* 807, 828) in fact supports this view since it refers to an the interest that an individual has in keeping ideas secret.

English law, especially the equivalent of trade secrets law (that is, ‘traditional’ breach of confidence), adequately protects any ‘privacy’ interests of a corporation.

V. ARGUMENTS AGAINST RECOGNIZING A RIGHT OF PRIVACY FOR CORPORATIONS

Thus far, it has been argued that a right of privacy for corporations is not recognized under the English law of confidence and that there is a lack of legal imperative to do so, based on the jurisprudence of Strasbourg and other, common law jurisdictions. This next section deals with arguments for continuing to deny corporate entities a right of privacy and concludes that, on balance, there are sound reasons for resisting such protection.

V.A NATURE OF CORPORATIONS AND THE HARM THEY SUFFER

A key objection to corporations benefiting from a right of privacy is that, as juristic entities, they lack the necessary traits to suffer the harm that is associated with invasions of privacy.¹¹⁷ This is both an argument about the nature of corporations and about the nature of privacy interests¹¹⁸ and is one that both judges and commentators have found appealing. Take, for example, the *obiter* statement of Lord Mustill in *BBC*:

To my mind the privacy of a human being denotes at the same time the personal ‘space’ in which the individual is free to be itself, and also the carapace, or shell, or umbrella, or whatever other metaphor is preferred, which protects that space from intrusion. *An infringement of privacy is an affront to the personality*, which is damaged both by the violation and by the demonstration that the personal space is not inviolate. The concept is hard indeed to define, but if this gives something of its flavour *I do not see how it can apply to an impersonal corporate body, which has no sensitivities to wound, and no selfhood to protect.*¹¹⁹ (emphasis added)

117. See Allen (1987), 613–615 discussing this objection, which she calls the metaphysical ground. See also Bone, Robert G., ‘A New Look at Trade Secret Law: Doctrine in Search of Justification’ (1998) 86 *California Law Review* 241, 286–287; D’Amato, Anthony, ‘Comment: Professor Posner’s Lecture on Privacy’ (1978) 12 *Ga. L. Rev.* 497, 500; Jinghun, Cao, ‘Protecting the Right to Privacy in China’ (2005) 36 *Victoria University Wellington Law Review* 645, 652–653; Mulheron (2006), 710; Stevenson, Russell B., *Corporations and Information: Secrecy, Access and Disclosure* (John Hopkins University Press, Baltimore and London, 1980), 51 & 69.

118. Allen (1987), 614; Comment: ‘Corporate Privacy: A Remedy for The Victim of Industrial Espionage’ (1971) *Duke Law Journal* 391, 411.

119. *BBC*, 900.

Comments to a similar effect were made by Gummow and Hayne JJ in *Lenah Game Meats*:

Lenah can invoke no fundamental value of personal autonomy . . . Lenah is endowed with legal personality only as a consequence of the statute law provided for its incorporation . . . Lenah's activities provide it with a goodwill which no doubt has a commercial value. It is that interest for which, as indicated earlier in these reasons, it seeks protection in this litigation. *But, of necessity, this artificial legal person lacks the sensibilities, offence and injury to which provide a staple value for any developing law of privacy.*¹²⁰ (emphasis added)

The above statements emphasize that individuals have personality attributes, in the form of sensibilities and dignitary interests, which are simply not shared by legal persons. In other words, corporate entities are *unable* to suffer distress or offence from an invasion of privacy in the way that natural persons can.¹²¹

It seems relatively uncontroversial to accept that, unlike individuals, corporations are unable to experience offence, emotional harm or distress, or injury to dignity. Indeed, this probably explains why a statute, such as the Protection from Harassment Act 1997 ('PHA'), has been interpreted as excluding corporations from its scope. Section 1 of the PHA stipulates that a person must not pursue a course of conduct '(a) which amounts to harassment of another and (b) which he knows or ought to know amounts to harassment of the other'. A course of conduct must involve conduct on at least two occasions¹²² and can include speech¹²³ and references to harassing a person 'include *alarming* the person or *causing* the person *distress*'.¹²⁴ The statute makes it a criminal offence to engage in harassment¹²⁵ and also permits the victim of the course of conduct to bring a claim in civil proceedings.¹²⁶ The practice of stalking was the principal mischief at which the PHA was aimed. However, in *Thomas v. News Group Newspapers Ltd*¹²⁷ Lord Phillips MR (with whom Jonathan Parker LJ and Lord Mustill agreed) accepted that the PHA applies to activities that go beyond stalking¹²⁸ and that it was arguable that the

120. *Lenah*, 256.

121. Allen (1987), 613–615; Bone (1998), 286–287. The same may also be said for other legal persons, such as the Crown: see *A-G v. Guardian*, 256 per Lord Keith: 'The Crown, however, as representing the nation as a whole, has no private life or personal feelings capable of being hurt by the disclosure of confidential information'. But contrast Callinan J in *Lenah*, 326–327: 'Nor would I rule out the possibility that a government or a governmental agency may enjoy a similar right to privacy over and above a right to confidentiality in respect of matters relating to foreign relations, national security or the ordinary business of government notwithstanding the single Justice decision in the *Commonwealth v. John Fairfax & Sons Ltd.*'

122. S. 7(3), PHA.

123. S. 7(4), PHA.

124. S. 7(2), PHA (emphasis supplied).

125. S. 2, PHA.

126. S. 3, PHA.

127. [2002] EMLR 4 ('*Thomas*').

128. *Thomas*, 86.

defendants had harassed the claimant by publishing racist criticism of her in *The Sun* newspaper.¹²⁹ The PHA has also been relied upon against protestors, particularly those concerned with animal welfare, who have engaged in extreme and unlawful behaviour.¹³⁰ Recently, Lord Nicholls in *Majrowski v. Guy's and St Thomas's NHS Trust*¹³¹ has described the purpose of the statute as to 'provide protection against stalkers, racial abusers, disruptive neighbours, bullying at work, and so forth'.¹³²

The PHA is therefore a legislative instrument that provides a measure of privacy protection,¹³³ however, a handful of decisions indicate that corporations are excluded from this protection. In *DPP v. Dziurzynski*,¹³⁴ the Divisional Court considered the legislative history of the PHA and commented *obiter* that it 'was not intended by Parliament to embrace within the ambit of a criminal offence, conduct amounting to harassment directed to a limited company rather than to an individual human being'.¹³⁵ This was subsequently followed in *Daiichi Pharmaceuticals UK Ltd v. Stop Huntingdon Animal Cruelty*,¹³⁶ where Owen J held that 'the word "person" in section 1 of the Act does not on its proper construction embrace a corporate entity'.¹³⁷ Further, in *Majrowski v. Guy's and St Thomas's NHS Trust*¹³⁸ Auld LJ in the Court of Appeal referred to *Daiichi Pharmaceuticals* and *Dziurzynski's* and commented: 'The thrust of the Act is plain, namely to *protect individuals* from a course of conduct amounting to harassment, regardless of who causes it'.¹³⁹ In the House of Lords, Lord Nicholls felt able to conclude that, 'it is now tolerably clear that, *although the victim must be an individual*, the perpetrator may be a corporate body'.¹⁴⁰ The view that corporations may not be victims of harassment under the PHA makes sense, in light of the purpose of the statute and particularly when one considers that nature of the harm is 'alarming the person or causing them distress', that is, things that cannot be experienced by a corporate entity.

However, the inability to suffer injury to feelings or offence has not been the basis for discrimination between corporations and individuals in other areas of law,

129. *Thomas*, 93.

130. See, for example, *Smithkline Beecham Plc et al. v. Avery (representing Stop Huntingdon Animal Cruelty)* [2007] EWHC 948; *Huntingdon Life Sciences Group Plc v. Stop Huntingdon Animal Cruelty* [2007] EWHC 522; *RWE Npower Plc v. Carrol* [2007] EWHC 947.

131. [2007] 1 AC 224 ('*Majrowski*').

132. *Majrowski*, 231.

133. Arden, M, 'The Future of the Law of Privacy' (1998–1999) 9 *King's College Law Journal* 1, 8; and Neill, B, 'Privacy: A Challenge for the Next Century' in Markensinis (ed.), *Protecting Privacy* (Oxford: OUP, 1999), 1–28, 7–8.

134. [2002] EWHC 1380.

135. *DPP v. Dziurzynski* [2002] EWHC 1380, para. 33 per Rose LJ.

136. [2004] 1 WLR 1503.

137. *Daiichi Pharmaceuticals UK Ltd v. Stop Huntingdon Animal Cruelty* [2004] 1 WLR 1503, 1512. Followed in *EDO MBM Technology Ltd v. Campaign to Smash EDO* [2005] EWHC 837, para. 32.

138. [2005] QB 848.

139. *Majrowski v. Guy's and St Thomas's NHS Trust* [2005] QB 848, 870. (emphasis added)

140. *Majrowski*, 231. (emphasis added)

most notably defamation. In fact, the House of Lords in *Jameel v. Wall Street Journal Europe*¹⁴¹ recently upheld equivalent treatment of individuals and corporations when it comes to libel actions. In this case, the defendant newspaper had published an article in which the second claimant, a company incorporated in Saudi Arabia, was named as an organization that was being monitored by the Saudi Arabian Monetary Authority in a bid to prevent funds being channelled to terrorist organizations. At trial, before Eady J and a jury, verdicts were entered for the claimants and an appeal to the Court of Appeal was dismissed. Before the House of Lords, an issue arose as to whether a trading company, which conducts no business but which has a trading reputation in England and Wales, should be entitled to recover general damages for libel, in the absence of proving special damage. The House of Lords held that existing law supported the principle that a trading company with a trading reputation in England and Wales could recover general damages without proving special damage if the publication complained of has a tendency to damage it in the way of its business. However, in the light of developments in human rights law, the House went on to review the merits of the rule and a majority (Lord Hoffmann and Baroness Hale dissenting) decided to uphold it.

The majority of the law lords recognized that although corporations did *not* have feelings that could be injured, their reputation could nevertheless still be injured. Lord Bingham commented that:

There are of course many defamatory things which can be said about individuals (for example, about their sexual proclivities) which could not be said about corporations. But it is not at all hard to think of statements seriously injurious to the general commercial reputation of trading and charitable corporations: that an arms company has routinely bribed officials of foreign governments to secure contracts; that an oil company has wilfully and unnecessarily damaged the environment; that an international humanitarian agency has wrongfully succumbed to government pressure; that a retailer has knowingly exploited child labour; and so on.¹⁴²

Similarly, Lord Hope stated:

It is obvious, of course, that a trading company has no feelings which are capable of being injured. Trade is its business, and it is injury to its reputation in regard to its trade that is of the essence in its case. . . . This does not mean, however, that it can only be injured in a way that gives rise to loss which, because it can be calculated, has the character of special damage. What it means is that it must show that it is liable to be damaged in a way that affects its business as a trading company.¹⁴³

141. [2007] 1 AC 359 (*Jameel*).

142. *Jameel*, 375.

143. *Jameel*, 392.

Lord Scott opined that the arguments that corporations did not have feelings to hurt and could not feel shame missed the point, since it was ‘plain beyond argument that reputation is of importance to corporations’.¹⁴⁴

Thus, despite the inability of corporations to suffer injured feelings, the value of a company’s good name or reputation,¹⁴⁵ combined with the difficulties of proof that trading companies would encounter if they had to establish special damage,¹⁴⁶ led the majority to conclude that corporations should *not* be treated differently from individuals, so that libel is actionable *per se* for both.¹⁴⁷ As such, it may seem incongruous to argue that corporations are not entitled to privacy protection because of their juristic nature. However, this is not so if one *justifies* a right of privacy on the basis that it protects human autonomy, dignitary interests and the development of self-hood,¹⁴⁸ as opposed to reputation. Certainly, there is support for this justification of privacy in *obiter dicta* in *Campbell*¹⁴⁹ and also in academic writing.¹⁵⁰

However, this is only one view of the function of privacy and there are other possible, indeed plausible, views. Probably the strongest supporter of the concept of privacy embracing juristic entities is Professor Westin. In his book, *Privacy and*

144. *Jameel*, 398.

145. *Jameel*, 376 per Lord Bingham and 398 per Lord Scott.

146. *Jameel*, 376 per Lord Bingham and 394 per Lord Hope.

147. It should be noted, however, that Lord Hoffmann at 391, delivering a dissenting speech, favoured a special rule for corporations on the basis of their different nature: ‘In the case of an individual, his reputation is a part of his personality, the “immortal part” of himself and it is right that he should be entitled to vindicate his reputation and receive compensation for a slur upon it without proof of financial loss. But a commercial company has no soul and its reputation is no more than a commercial asset, something attached to its trading name which brings in customers. I see no reason why the rule which requires proof of damage to commercial assets in other torts, such as malicious falsehood, should not also apply to defamation.’ Baroness Hale at 411 also supported a rule of special damage for corporations, but for a different reason, namely, to ‘achieve a proper balance between the right of a company to protect its reputation and the right of the press to be critical of it’.

148. See Allen (1987), 614 and also Bok, Sissela, *Secrets* (Pantheon Books, New York, 1982), 141–142: ‘Neither the concept of privacy nor that of personal autonomy can, by itself, easily be expanded to fit both the individual entrepreneur and the large corporation.’

149. *Campbell*, 472 per Lord Hoffmann: ‘What human rights law has done is to identify private information as something worth protecting as an aspect of human autonomy and dignity’ and also at 473: ‘[the new approach to breach of confidence] focuses upon the protection of human autonomy and dignity – the right to control the dissemination of information about one’s private life and the right to the esteem and respect of other people.’ See also *Campbell*, 495 per Baroness Hale and *Douglas* (HL), para. 275 per Lord Walker. In the New Zealand context see *Hosking v. Runting*, per Tipping J at 58: ‘It is of the essence of the dignity and personal autonomy and well being of all human beings that some aspects of their lives should be able to remain private if they so wish.’

150. Fenwick and Phillipson, 662–666; Gavison, R, ‘Privacy and the Limits of Law’ (1980) 89 *Yale Law Journal* 421, 449–450; Nizer, Louis, ‘The Right of Privacy: A Half Century’s Developments’ (1941) 39 *Michigan Law Review* 526, 528; Nieuwenhuis, H, ‘The Core Business of Privacy Law: Protecting Autonomy’ in Ziegler, Katja S., *Human Rights and Private Law* (Oxford: Hart, 2007), 15–20; A. Westin, *Privacy and Freedom* (1967), 7. See also Whitman (2004), discussing this as a continental notion of privacy, as opposed to a US one.

Freedom,¹⁵¹ Professor Westin defines privacy as: ‘the claim of *individuals, groups, or institutions* to determine for themselves when, how, and to what extent information about them is communicated to others’.¹⁵² After describing the functions of individual privacy – personal autonomy, emotional release, self-evaluation and limited and protected communication¹⁵³ – Professor Westin goes on to identify several functions of organizational privacy, all of which may be considered utilitarian in nature. In terms of organizational autonomy, he argues that the ‘lack of privacy for certain core secrets can threaten the independence or autonomous life of an organization much as it does that of an individual’.¹⁵⁴ The commercial success of a business often depends on its trade secrets and government agencies have an interest in ensuring that diplomatic, military and economic secrets are not disclosed. Professor Westin also argues that organizations ‘need internal privacy to conduct their affairs without having to keep up a “public face”’.¹⁵⁵ Additionally, privacy is said to be crucial for enabling organizations to have evaluative periods for decision making, that is, by ensuring that the individuals within the organization can express their views freely and frankly. Finally, Professor Westin asserts that organizations need to be able to communicate in confidence with outside advisors and other organizations¹⁵⁶ and to be able to keep accumulated data about individuals secret so that further disclosure is made in the future.¹⁵⁷

Professor Stevenson has expressed doubts about Professor Westin’s analogy between individual and organizational privacy.¹⁵⁸ While accepting that ‘corporations do have legitimate interests in preserving some degree of secrecy with respect to their operations’ Professor Stevenson considers it ‘fallacious to assume that those interests are identical to or deserving of the same protection as the interests of living and breathing persons’.¹⁵⁹ What, then, are the legitimate interests of corporations in preserving the secrecy of their activities? Professor Stevenson argues that in respect of routine files containing personal information, there is a corporate interest in preserving the confidentiality of the information, so that customers are not lost or the ability to acquire such information in the future is not prejudiced.¹⁶⁰ Where the information relates to employees, the interest in preserving its secrecy is to ensure good labour relations. In respect of documents relating to decision making, he argues that it is crucial these are kept secret in order

151. Westin, Alan F., *Privacy and Freedom* (New York: Atheneum, 1967).

152. Westin (1967), 7. (emphasis added)

153. Westin (1967), 33–38.

154. Westin (1967), 43.

155. Westin (1967), 45.

156. Westin (1967), 49.

157. Westin (1967), 50.

158. Stevenson, Russell B., *Corporations and Information: Secrecy, Access and Disclosure* (John Hopkins University Press, Baltimore and London, 1980), 51.

159. Stevenson (1980), 51. Although he notes at 74 that in relation to small corporations it may be appropriate to draw this analogy.

160. Stevenson (1980), 70.

to promote an effective decision making process since, without confidentiality, participants in the decision making process may be unwilling to express candid, unorthodox or partially formed views. As such, corporations have a derivative interest in protecting such communications from general disclosure.¹⁶¹ In effect, the privacy interests of organizations identified by Professor Westin are similar to the legitimate interests of companies in preserving secrecy articulated by Professor Stevenson.

At this point, it seems appropriate to make two observations. The first is that the notions of organizational or corporate privacy can be seen as interchangeable with, or inextricably tied to, the notion of *secrecy*.¹⁶² The second is that while corporations have *legitimate interests* in protecting the 'privacy' or secrecy of information about their clients, employees, decision-making practices and commercial innovations and activities, these interests are concerned with the effective operation of a corporation and, so, are ultimately *economic* in nature. This is certainly the view taken by Professor Stevenson who argues that while:

disclosure of some types of corporate information does have privacy implications . . . these have nothing to do with 'corporate privacy'. Corporations often do have real economic interests in preserving the security of information about their customers or clients, but such interests are purely derivative.¹⁶³

If 'corporate privacy' ultimately serves an economic purpose this should not automatically disqualify corporations from a right of privacy, particularly when one considers the approach that has been taken by English courts to libel. However, if existing legal remedies satisfactorily protect the legitimate interests of a corporation then it is argued that recognizing a separate right of privacy for these entities is simply unnecessary. The adequacy of privacy protection for corporations is addressed in the next section.

V.B OTHER SATISFACTORY MEANS OF PROTECTING CORPORATE 'PRIVACY'

For the most part, corporations will have to rely on common law, rather than statutory, remedies to protect their privacy interests. This is because protection under the PHA is restricted to individuals and the Data Protection Directive¹⁶⁴

161. Stevenson (1980), 72–73.

162. See also Posner, Richard A., 'The Right Of Privacy' (1978) 12 *Georgia Law Review* 393, 410 where he discusses the protection of commercial privacy under trade secrets law and Scheppele, Kim Lane, *Legal Secrets: Equality and Efficiency in the Common Law* (University of Chicago Press, 1988), ch. 12 where she argues that US trade secrets law is the corporate version of a right of privacy.

163. Stevenson (1980), 75.

164. Directive 95/46/EC of the European Parliament and of the Council of 24 October 1995 on the protection of individuals with regard to the processing of personal data and on the free movement of such data ('Data Protection Directive').

explicitly provides that Member States ‘shall protect the fundamental rights and freedoms of *natural persons*, and in particular their right to privacy with respect to the processing of personal data’.¹⁶⁵ However, there is some statutory protection of privacy available to corporations and this comes in the form of the Directive on Privacy and Electronic Communications.¹⁶⁶ This Directive seeks to complement the Data Protection Directive, and states that Member States must provide protection of privacy with respect to the processing of personal data in the electronic communications sector¹⁶⁷ to both *natural persons* – referred to as users – and *legal persons* – referred to as subscribers.¹⁶⁸ The protection is of the ‘legitimate interests’ of legal persons who are subscribers to a publicly available electronic communications services in public communication networks in the Community, although, importantly, this does not entail an obligation on Member States to extend the protection under the Data Protection Directive to legal persons.¹⁶⁹

The Directive on Privacy and Electronic Communications, implemented in UK law via the Privacy and Electronic Communications (EC Directive) Regulations 2003,¹⁷⁰ covers a range of matters. For example, the provider of a publicly available electronic communications service must take appropriate technical and organizational measures to safeguard the security of its services.¹⁷¹ Further, they must ensure the confidentiality of communications and related traffic data via a public communications network and publicly available electronic communications services.¹⁷² There are also obligations concerning the erasure or anonymity of traffic data relating to subscribers and users processed and stored by the provider of a public communications network or publicly available communications service. Subscribers have the right to receive non-itemised bills;¹⁷³ the possibility of preventing caller identification;¹⁷⁴ the right to be informed, free of charge and before being included in a directory, of the purpose of the directory (whether electronic or hard copy) and the right to determine whether personal data are included in a public directory.¹⁷⁵ They may also prohibit use of automated calling systems for the purposes of direct marketing unless prior consent has been

165. Art. 1, Data Protection Directive. This is mirrored in the Data Protection Act 1998, where ‘data subject’ is defined in section 1(1) as an ‘individual who is the subject of personal data’ and ‘personal data’ is defined as data relating to a living individual.

166. Directive 2002/58/EC of the European Parliament and of the Council of 12 July 2002 concerning the processing of personal data and the protection of privacy in the electronic communications sector (‘Directive on privacy and electronic communications’).

167. Art. 1

168. Art. 1(2) and 2.

169. Recital 12.

170. SI 2003/2426, which came into force on 11 December 2003. These were amended by the Privacy and Electronic Communications (EC Directive) (Amendment) Regulations 2004 No. 1039.

171. Art. 4.

172. Art. 5.

173. Art. 7.

174. Art. 8.

175. Art. 12.

given.¹⁷⁶ Compensation may be sought against a person in contravention of the above requirements.¹⁷⁷ Further, the enforcement provisions of Part V of the Data Protection Act 1998 and Schedules 6 and 9 to that Act also apply.¹⁷⁸

Aside from this (limited) statutory protection of privacy, existing causes of action, namely, defamation, malicious falsehood, trespass and ‘traditional’ breach of confidence, are also available to a corporation.

Defamation refers to the torts of libel and slander and ‘is committed when the defendant publishes to a third person words or matter containing an untrue imputation against the reputation of the claimant’.¹⁷⁹ Statements will be defamatory where they tend to lower a person in the esteem of right thinking members of society.¹⁸⁰ In the case of libel, there is no need to show actual damage, nor lack of good faith.¹⁸¹ An important defense to an action for defamation is that of truth, that is, a plea of justification. Thus, the action only covers *false* statements of a defamatory nature. True statements are not prohibited and it is this aspect of the law of defamation that means a corporation’s privacy interests are not wholly protected.¹⁸² It would not enable a corporation to prevent, or claim damages for, publication of a true statement that is detrimental to its interests. For example, if confidential minutes of a Board meeting that discussed a sensitive matter – such as being taken over by another corporation or mass redundancy within the organization – were leaked and published, this would not be defamatory because the statements would not be false. Yet, disclosure of such information could be prejudicial to the interests of the company – either in terms of affecting its reputation or causing a decline in morale within the organization.¹⁸³

An action for malicious falsehood arises where a defendant publishes false statements directed at the claimant or his property or business.¹⁸⁴ The action differs from defamation in that the claimant has to prove the falsity of the statement,¹⁸⁵ the

176. Art. 13.

177. See SI 2003/2426, reg. 30.

178. See SI 2003/2426, reg. 31.

179. *Gatley on Libel and Slander* 10th ed. (Sweet & Maxwell, London, 2004) (‘Gatley’), para. 1.3. Libel applies if the publication is in permanent form, whereas slander applies if it is in transient form.

180. *Sim v. Stretch* (1936) 52 TLR 669 at 671 per Lord Atkin. Although Gatley, paras 1.5 and 2.1 comments that a satisfactory definition of defamation has not been agreed upon and refers to other formulations in the case law.

181. Gatley, para. 1.5.

182. Gatley, para. 1.67.

183. Another example is represented by the case of *Schering Chemicals Ltd v. Falkman Ltd* [1982] QB 1 where the plaintiff sought to restrain the disclosure of confidential information that they had supplied to the first and second defendants as part of a training programme for executives of the plaintiff to deal with the adverse publicity associated with a drug promoted by them. The plaintiff did not sue for defamation presumably because the confidential information was true. Yet further disclosure of the confidential information was considered highly damaging to the plaintiff (per Shaw LJ at 28 and Templeman LJ at 37) and an appeal against the grant of an injunction against the defendants was dismissed.

184. Gatley, para. 20.1.

185. Gatley, paras 11.2–11.3 and 20.5–20.6. Whereas, in defamation it is for the defendant to prove the truth of the statement.

defendant's malice¹⁸⁶ and also that the claimant has suffered actual loss.¹⁸⁷ As such, this is a more onerous cause of action for a corporation to establish. As with defamation, it suffers from the disadvantage that it does not cover true but damaging statements.

Trespass to land 'consists in any unjustifiable intrusion by one person upon land in possession of another'¹⁸⁸ and is actionable *per se*.¹⁸⁹ Trespass will provide protection against acts of industrial espionage that involve persons entering a corporation's premises or airspace¹⁹⁰ without authorization. It will also cover situations such as that in *Lenah* where a person surreptitiously enters the premises of a company and installs equipment to record the activities of the organization.¹⁹¹ However, *Lenah* also aptly illustrates the limits of the action for trespass, since in this case the party who was seeking to disclose the footage was *not* the trespasser, the actual trespasser being unknown. A majority of the High Court of Australia held that an injunction could not be granted against an innocent third party that received the 'fruits' of a trespass, *unless* there was an actionable cause of action against the third party,¹⁹² such as breach of confidence or infringement of privacy. The former could not be relied upon because, as conceded by the plaintiff, the operations at its processing facility were not secret and those persons who might see the operations were not subject to an obligation of confidence.¹⁹³ Further, there was no right of privacy under Australian law and, even if such a right were to be recognized, the Court doubted it would apply to corporate entities. Thus, trespass to land will not provide a remedy where the information obtained from unauthorized intrusion finds its way into the hands of an innocent third party and is not confidential.

What about the situation where a person who is lawfully on the premises carries out the surreptitious filming? This is what occurred in *BBC*¹⁹⁴ and also in *Service Corporation International Plc v. Channel Four Television Corporation*.¹⁹⁵ In the latter case, it was argued that by obtaining access to the premises

186. Gatley, paras 20.7–20.8.

187. Gatley, paras 20.10–20.11. This is so save in cases falling within provisions of section 3(1) of the Defamation Act 1952: see para. 20.13.

188. Clerk & Lindsell, para. 19-01.

189. Clerk & Lindsell, paras 19-08 and 19-09.

190. Trespass into a landowner's airspace is restricted to a height that is necessary for the ordinary use and enjoyment of the land and the structures upon it: see *Bernstein of Leigh v. Skyviews General Ltd* [1978] QB 479, 488.

191. According to Clerk & Lindsell, para. 19-02 it is a trespass to place anything on or in land in the possession of another.

192. *Lenah*, 229–230 per Gleeson J, 248 per Gummow and Hayne JJ and 232 per Gaudron J (in agreement with Gummow and Hayne JJ).

193. *Lenah*, 221, 223 & 224 per Gleeson J. Contrast the dissenting judgment of Callinan J at 320, which has been criticized by Heath (2002), 172–175. Some commentators have criticized the failure of the High Court to consider breach of confidence as an actionable cause of action: see *Taylor and Wright* (2002), 714–718 and *Horton* (2003).

194. The programme makers for the BBC secretly filmed transactions in Dixons stores, presumably posing as ordinary customers.

195. [1999] EMLR 83. In this case, a person employed by the second plaintiff as a trainee funeral director was in fact working undercover for the second defendant (who was making a

by a ruse (in order to undertake covert filming), the person involved was a trespasser *ab initio*. Lightman J did not come to a conclusion on this point because he held, following *Kaye v. Robertson*,¹⁹⁶ that it was not possible to restrain a person from profiting from their trespass (that is, by broadcasting the covertly taken footage).¹⁹⁷ Thus, while trespass will be useful in preventing acts of industrial espionage insofar as they involve entering a corporation's premises or airspace without permission, it will be of limited assistance when it comes to prohibiting the disclosure of information obtained during such an intrusion. For this, a corporation will have to rely on copyright law and breach of confidence.

Turning to the law of confidentiality, contractual and equitable obligations of confidence that are imposed on employees and former employees will be very helpful in protecting corporate 'privacy'.¹⁹⁸ More generally, breach of confidence, in its 'traditional' form, will be extremely useful in allowing a corporation to control the disclosure of information pertaining to it. This is provided the information is confidential, it has been obtained in a situation imposing an obligation of confidence, and there has been unauthorized use.¹⁹⁹ But even where confidential information is disclosed by third parties or strangers to a relationship of confidence there is ample authority under English law to support this type of disclosure being an actionable breach of confidence.²⁰⁰ As such, where acts of industrial espionage are concerned and there is an attempt subsequently to use or disclose the

documentary on funeral homes) and secretly filmed events at the funeral home. A similar situation arose in *Response Handling Ltd v. British Broadcasting Corporation* (Unreported, 3 April 2007) discussed in McInnes, R, 'Undercover Filming & Corporate Privacy: *Response Handling Ltd v. BBC*' (2007) 21 *Scots Law Times* 150.

196. [1990] FSR 62 at 69 per Glidewell LJ (Bingham LJ and Leggatt LJ in agreement).
197. *Service Corporation International Plc v. Channel Four Television Corporation* [1999] EMLR 83, 90.
198. See, e.g., *Response Handling Ltd v. British Broadcasting Corporation* (Unreported, 3 April 2007) discussed in McInnes (2007). Although note that the interim interdict was not granted by the Scottish Court of Session.
199. *Coco v. A N Clark (Engineers) Ltd* [1969] RPC 41 ('*Coco v. Clark*') at 47 per Megarry J, cited with approval in *A-G v. Guardian*, 268 per Lord Griffiths. See also *Douglas* (HL), paras 111–115 per Lord Hoffmann (discussing the application of the *Coco v. Clark* test by Lindsay J at first instance in *Douglas v. Hello! (No 3)* [2003] EMLR 31).
200. For third parties see *A-G v. Guardian*, 260 per Lord Keith and 268 per Lord Griffiths. For strangers see *A-G v. Guardian*, 281 per Lord Goff; *Creation Records Ltd v. News Group Newspapers Ltd* [1997] EMLR 444; *Francome v. Mirror Group Newspapers Ltd* [1984] 2 All ER 408 and *Hellewell v. The Chief Constable of Derbyshire* [1995] 1 WLR 804, 807; *Shelley Films Ltd v. Rex Features Ltd* [1994] EMLR 134. Under English law, knowledge of the confidential nature of information or of a confidential relationship can be enough to place a recipient of information under an obligation of confidentiality: see *A-G v. Guardian*, 281 per Lord Goff and *Douglas* (HL), para. 292 per Lord Walker, para. 307 per Baroness Hale and paras 114–115 per Lord Hoffman. In an Australian context, see *Franklin v. Giddins* [1978] Qd R 72. In Singapore, see *Vestwin Trading Pte v. Obegi Melissa* [2006] 3 Singapore Law Reports 573 where it was held that a person who finds an obviously confidential document thrown out in the rubbish can come under an obligation of confidence.

confidential information obtained, it is submitted that the existing law of confidence will provide an adequate remedy.²⁰¹

Problematic, however, will be situations where the information is *not confidential* but a corporation still wishes to control further publication. As I have argued elsewhere, ‘extended’ breach of confidence, which does *not* require that private information is *secret*, should *not* be extrapolated to commercial information so that a requirement of confidentiality or secrecy no longer applies. This is because it may be queried how an obligation of confidence attaches to commercial information that is no longer confidential. Further, such an approach would undermine the aims of patent law and hinder innovation and competition.²⁰² But what if the information that the corporation was seeking to protect could be characterized as ‘private’, instead of ‘commercial’? If so, arguably the principles of ‘extended’ breach of confidence *would* apply to it and the information could be protected even though it was no longer secret. This raises the vexed question of what exactly is meant by ‘private’ information when it comes to corporations.

Recalling the *obiter* comments of the Court of Appeal in *BBC*, it could be argued that the board meetings and correspondence of a corporation are private. Further, following the arguments of Professor Westin and Professor Stevenson discussed in the previous section, a company’s trade secrets, internal correspondence, confidential external communications, and accumulated client and employee data could be regarded as ‘private’. However, as was discussed in section II, it seems unlikely, given the law as it stands, that such information would satisfy the test of ‘reasonable expectation of privacy’. It is submitted that this should continue to be the case for two reasons. First, information that is said to relate to the ‘privacy’ of a corporation should be regarded as ‘private’ in the sense of being *secret* and adequate protection already exists under ‘traditional’ breach of confidence for secret (or confidential) information. Second, it seems that a corporation’s interest in classifying information as ‘private’ would be to protect information that is already in the public domain. To allow this to occur would undermine the balance that is achieved under ‘traditional’ breach of confidence when it comes to protecting commercial information. Thus, it seems preferable to regulate the ‘private’ information of corporations via ‘traditional’ breach of confidence as confidential commercial information.

201. In relation to the US, it has been argued that trade secrets law does not do enough to protect against industrial espionage and, as such, a corporate right of privacy should be introduced: Comment, ‘Corporate Privacy: A Remedy for the Victim of Industrial Espionage’ (1971) *Duke L. J.* 391, especially 413–416. However, it is important to note that the protection of trade secrets in the US, according to the Uniform Trade Secrets Act 1985 (‘UTSA’), which has been adopted in most states, is more limited than under the English law of confidence. This is because the definition of ‘trade secret’ requires that the information must be ‘subject to efforts that are reasonable under the circumstances to maintain its secrecy’ (s1(4), UTSA). Further, the law protects trade secrets against misappropriation which is defined to include acquisition by improper means: UTSA, s1(2)(ii)(A).

202. Aplin, T, ‘Commercial Confidences after the Human Rights Act’ (2007) 10 *EIPR* 411, 413–414.

VI. CONCLUSION

This article has argued that corporations should continue to be excluded from the protection of privacy available under ‘extended’ breach of confidence. This is supported by the weight of precedent in England and also other common law jurisdictions. Further, the ECtHR decision in *Societe Colas Est* does not compel English courts to recognize a tort of privacy for corporations or apply ‘extended’ breach of confidence to them, given existing legal remedies. There are also important policy objections to introducing a legal right to privacy for corporations. To the extent that personal autonomy and dignity represent the core function associated with privacy, corporate entities lack the requisite personality traits. Even assuming that privacy embraces other functions which pertain to corporate interests these are adequately protected by existing forms of legal protection, such as defamation, trespass and particularly ‘traditional’ breach of confidence. Finally, it is not justifiable to allow corporations to control information that is no longer ‘secret’ or ‘confidential’, on the basis of it being ‘private’, because this would enable them to have a monopoly over information, which in turn would conflict with the important aims of competition and innovation. Thus, when it comes to further developing ‘extended’ breach of confidence, or possibly recognizing a tort of misuse of private information, courts should be extremely wary of bringing juristic entities, such as corporations, under this banner of protection.

Part V

Patents and Human Rights

Chapter 20

Research on Human Embryos and Stem Cells: Weaving Ethical and Religious Concerns into the Framework of Patent Law in Malaysia

*Ida Madieha Bt. Abdul Ghani Azmi**

I. INTRODUCTION

As the biotech revolutions challenge many of the basic norms of ethics and morality, religious views are being sought to provide for a framework in which ethical determination can be made. Many of the reports sought consultation with religious groups among Christianity, Judaism and Islam for this. With more controversial inventions, such as embryonic stem cells, the need for legitimization and support from religious groups becomes more crucial.

In Malaysia, the recent incorporation of ‘ordre public and morality’ as a yardstick for the determination of patents, brings into question as to what extent can religious views, in particular Islam, being the official religion of the country, play a role in patent law. On this point, different views emerged in Europe, in which the ‘public and morality’ provision took its origin. One view is that this provision

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will only exclude inventions likely to induce riot or public disorder, or to lead to criminal or other generally offensive behaviour. Whilst the European Group on Ethics in Science and New Technologies (2000)¹ and (2002)² was of the view that such determination is left with national courts and patent offices. In which case, religious views would definitely play a role. In Malaysia, Islam being the religion of the Federation would surely be guiding principle in the patentability of biotechnological inventions.

Though the two jurisdictions is entirely different in terms of its legal history and religious heritage, this discussion is inevitable as experience from the UK and European in most instances have deep influence on the legal development in Malaysia.

It is thus, the objective of the paper to explore:

- (1) The relationship between ethics, morality and law in Islam;
- (2) The framework of ethical values and morality under the *Shariah*;
- (3) Lessons from the Koran on life forms that forms part of bioethics;
- (4) Islam and embryo research;
- (5) Malaysian practices on research on human embryo and stem cell research; and
- (6) The role that Islam can play in shedding some light on the ethical repercussions of recent advances on biotechnology in Malaysia.

II. MALAYSIA AND UK (AND EUROPE)

The current Malaysian Patent Act 1983 has traces of similarity with the UK Patent Act 1977 and the European Patent Convention. Many of the substantive provisions found in the later two legal instruments are found in the Malaysian Act. This is hardly surprising as the Malaysian Legal System as a whole was shaped by the British during the colonial times. Typical of any common law jurisdictions, cases decided in other common law countries are referred to, not necessarily as precedents, but as of persuasive value in court judgments as well as policy making. The developments in the UK and Europe, especially, in the area of intellectual property would be of relevance to Malaysia; including the debates on the role of ethics in patent law.

The incorporation of morality into the Patent law took place in 2000 as a result of TRIPS compliance, particularly Article 27 of the Agreement.³ Whilst Article 27

1. 'Ethical Aspects of Human Stem Cell Research and Uses', *European Group on Ethics in Science and New Technologies to the European Commission* on 14 November 2000, available at <http://ec.europa.eu/european_group_ethics/publications/docs/dp15rev_en.pdf>.

2. Opinion on the Ethical Aspects of Patenting Inventions Involving Human Stem Cells, Opinion No 16, available at <http://ec.europa.eu/european_group_ethics/publications/docs/avis16_complet_en.pdf>.

3. Art. 27 of the TRIPS Agreement as well, which reads:

Members may exclude from patentability inventions, the prevention within their territory of the commercial exploitation of which is necessary to protect *ordre public* or morality,

allows member countries to 'exclude from patentability inventions' inventions, the commercial exploitation of which would affect ordre public and morality'; the Malaysian policy makers decided to make it as a ground to refuse grant of invention rather.⁴ Thus, morality was added as a ground in which the patent office can refuse grant together with public order; instead of a ground of exclusion of patent rights. The European Directive on Biotechnological Patents instead took a different approach. Such inventions are considered to be unpatentable. The Directive took the position further by specifying two distinct tests to the morality exclusion as is made clear in Article 6 of the Directive.⁵ In addition, Article 5 devotes attention to the patentability of human body and bodily parts; something which others view to be unpatentable on ethics and morality grounds.⁶ In many ways, the European Directive morality provisions are more comprehensive and elaborate as that of the Malaysian provision. This is understandable as there has been no attempt in Malaysia to examine what would be the approach taken to ethical debates within patent system.

To that extent, the EPO practice would be of relevance to Malaysian patent office. The UK laws are of persuasive value and in many senses relevant to the

including to protect human, animal or plant life or health or to avoid serious prejudice to the environment, provided that such exclusion is not made merely because the exploitation is prohibited by their law.

4. S. 31(1) provides:

The grant of a patent shall not be refused and a patent shall not be invalidated on the ground that the performance of any act in respect of the claimed invention is prohibited by any law or regulation, except *where the performance of that act would be contrary to public order or morality*. Morality as a ground for the refusal of patents was included in 2000 via the Patents (Amendment) Act 2000.

5. Art. 6 reads:

1. Inventions shall be considered unpatentable where their commercial exploitation would be contrary to *ordre public* or morality; however, exploitation shall not be deemed to be so contrary merely because it is prohibited by law or regulation.
2. On the basis of paragraph 1, the following, in particular, shall be considered unpatentable:
 - (a) Processes for cloning human beings;
 - (b) Processes for modifying the germ line identity of human beings;
 - (c) Uses of human embryos for industrial or commercial purposes;
 - (d) Processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes.

6. Art. 5 reads:

1. The human body, at the various stages of its formation and development, and the simple discovery of one its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions.
2. An element isolated from the human body or otherwise produced by means of a technical process, including the sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element.
3. The industrial application of a sequence or a partial sequence of a gene must be disclosed in the patent application.

interpretation of Malaysian laws. Another important point is that Malaysia is a multiracial country⁷ and issues relating to ethics and morality are often coloured by divergent and competing religious influences.⁸ As far as the Muslim communities are concerned, since the advent of cloning, various *fatwa* committees, both at state and federal level have been engaged into studying the Muslim position to many of the emerging and complex issues in biotechnology and bio-medical advances. To that extent, this article would only devote to the position of ethics and morality in Islam.

III. IDENTIFYING NORMS OF ETHICS AND MORALITY

In Islam, ethics is not inseparable from law. In fact, in Islam any legislative prescription would have to be rooted on ethics and morality.⁹ Al Ghazali for example observes:

Practical science (*al ahkam al-amaliyyah*) includes morality, defining it as the knowledge of soul and its properties and moral traits. Ethics as such is a paramount practical science, for he cannot manage or direct his soul will be ill-equipped to manage the affairs of others.¹⁰

On the same line, al Qurtubi says: ‘the principles of ethics are the cornerstone of legislation in Islam’.¹¹

So deeply integrated is ethics into law that Muslim scholars warn against any attempt to distinguish the two. Al Qamihah observes: ‘the *Shari’ah* stands unique among other legal systems in overruling existence of any kind of duality between legal rule and ethical rule’. On the contrary, the notion of morality and ethics permeates and overwhelms its juridical rules. Accordingly, in the whole corpus of Islamic jurisprudence, the integration, fusion and co-existence of law and morality is so evident that even in legally non-binding instances, it is the moral duty to be obeyed.¹²

The Islamic term corresponding to conception of ethics and morality is ‘*ilm al akhlaq*’.¹³ It is divinely inspired and is an integral part of the *Shariah*.¹⁴ The main

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7. The major ethnic groups are Malays, Chinese and Indians; and not to forget the indigenous people.
 8. Islam is the official religion of the country, though there are also Buddhists, Hindus and Christians in the country.
 9. Sayed Sikandar Shah Haneef, *Ethics and Fiqh for Daily Life: an Islamic Outline*, International Islamic University Malaysia (2005).
 10. cited in *Sayed Sikandar Shah Haneef, ibid.* 42–43.
 11. cited in *Sayed Sikandar Shah Haneef, ibid.* 42–43.
 12. cited in *Sayed Sikandar Shah Haneef, ibid.* 42–43.
 13. *Al Akhlaq*, is derived from the root word *khulq*, which means to create, to shape and to give form. 31.
 14. *Shariah* literally means a waterhole, where animals gather daily to drink, or the straight path. From here it is understood that *Shariah* is the straight path that guides man to the true path of

source for moral and ethical conception would be the *Shariah*. In defining the threshold of acceptability of a certain conduct from the point of view of moral and ethics, the Islamic jurists would be referring to the primary sources of the *Shariah* that would be:

- (1) The Koran, or the Holy Book of Islam;
- (2) The Sunna, or the authentic Traditions of the Prophet;
- (3) The *Ijma*, or the consensus of opinion; and
- (4) The *Qiyas*, or judgment derived through juristic analogy.¹⁵

From these sources, we can see that beside the reliance on the divine sources, juristic opinion plays an essential role in developing new legal rules in order to keep in touch with modern reality. In this regards, the primary sources of ethical corpus is interwoven with literary and social more (*adab*), as well as a robust intellectual tradition of which al Tusi, Mishkawayh (932–1030), al Ghazali (1058–1111), Ibn Rushd (1126–89) and Fakhr al Din al Razi (1149–1209) are exemplars. Popular tales like ‘Kalila wa Dimna’, the ‘Maqamat of al Hariri’ and ‘Hayy Ibn Yaqzan’ and the informal codes of artisans, calligraphers, musician and painters are part and parcel of the Islamic ethical tradition.¹⁶

In relation to medical ethics, in determining ethical choices, the rights and responsibilities of the individual are intertwined with that of the ‘*ummah*’. In other words, these ethical choices should not be serving the individuals alone, or human alone but the entire cosmos. From the writings of traditional scholars on medical ethics, the practice of medicine – as art and science, was pursued with the fullest commitment to pursuing scientific accuracy and truth, coupled with a recognition of the purposive nature of that pursuit as an extension of man’s relationship with God.¹⁷ It is for these reasons that most traditional scholars trained in medicine would also be trained in law and theology so that the pursuit of science would not be divorced from religion.

The prominence given to ‘*akhlaq*’ (ethical values) could be seen in the construction of the physician’s Oath that put the welfare of the patient and the avoidance of harm at the forefront. From the Oath, values such as compassion, charity, wisdom and solidarity are seen as central to any pursuit of medicine and practice.

Whenever there is a conflict between religious tenets and scientific inquiry, the Muslim scientist would always ground his decision on *maslaha* (the larger public good). For example, when al Nafis had to decide whether cadaver dissection would offend what is considered as morally permissible, he found it justifiable to establish vital facts (like the heart’s ventricular structure) that made effective

Islam. In the legal context however, *Shariah* signifies the divinely ordained system of basic laws, values and principles enshrined in the Koran and the Sunna.

15. For a more detailed elaboration, see Said Ramadan, *Islamic Law: Its Scope and Equity* (1970); Mohammad Hashim Kamali, *Principles of Islamic Jurisprudence*, 2nd Revised edn, Ilmiah Publishers Sdn Bhd, Kuala Lumpur, 1998.

16. Amyn B. Sajjoo, *Muslim Ethics: Emerging Vistas*, I.B. Tauris Publishers, London, New York (2004), at 2 and 3.

17. *Ibid.*, 11.

treatment. This could in no way mean that there is an absolute or unqualified right to pursue anatomical curiosity regardless of results.¹⁸

The heavy reliance on the doctrine of *maslaha* in recent advances in biomedical issues is understandable bearing the need to arrive at a balanced approach. In this regard, considerable similarity between the utilitarian approach as exemplified by the Warnock Report,¹⁹ or by many contemporary literature²⁰ and the religiously based ethic of maximizing public benefit from biomedical interventions in Islam on the basis of *maslaha* and '*istihsan*' (equity) could be found.

IV. MASLAHA AND GENETIC RESEARCH

The *Shariah* in general has intended higher objectives (*Maqasid al Shari'ah*).²¹ This stems from the premise that the *Shariah* aims at preserving the order of the world and regulating the conduct of human beings in it by preventing them from inflicting corruption and destruction upon one another. This objective is achieved through prescribing what is good and beneficial (*masalih*) and warding off what is evil and harmful (*mafasid*).²² *Masalih* can be further divided into three kinds, according to their impact and necessity: *daruriyyah* (the essential), *hajiyyah* (complementary) and *tahsiniyyah* (the desirable or embellishments). *Daruriyyah* refers to things whose realization is essential for the community both collectively and individually. Al Ghazali in his book *al-Mustasfa*, Ibn al Hajib, al Qarafi and al Shatibi described the *daruri* category as consisting of the preservation and safeguarding (*hifz*) of religion (*din*), life (*nufus*), intellect (*uqul*), property (*amwal*), and lineage (*ansab*).²³

One of the higher objectives of the *Shariah* is the Protection of human life. The sanctity of human life must be respected regardless of religious affiliation, race, colour or ethnic grounds as is explicit in the Koran (*al Maidah* :35):

On that account: We ordained for the children of Israel that if any one slew a person (take away life) unless it be for murder or for spreading mischief in the

18. *Ibid.*

19. *Report of the Committee of Enquiry into Human Fertilisation and Embryology* (1984).

20. For an illustration of contemporary literature on the law and ethics of medical research, See Aurora Plomer, *The Law and Ethics of Medical Research: International Bioethics and Human Rights*, 2005, Cavendish Publishing, UK.

21. The *Maqasidi* approach thus does not confine its focus on the words and sentences of the text as opposed to the purposes and goals that are being upheld and advocated. It looks at the general philosophy and objectives underlying these injunctions, often beyond the particularities of the text. See Mohammad Hashim Kamali, *Principles of Islamic Jurisprudence*, Ilmiah Publishers Sdn. Bhd. Kuala Lumpur (1998). See also Imran Ahsan Khan Nyazee, *Theories of Islamic Law: the Methodology of Ijtihad*, the International Institute of Islamic Thought, Islamabad and Islamic Research Institute, Islamabad (1994).

22. Ibn Ashur, *Treatise on Maqasid al Shari'ah*, translated by Mohamed al Tahir ibn Ashur, IIT London, Washington (2006), 116.

23. *Ibid.* 118.

land, it would be as if he slew the whole people. And if anyone saved a life, it would be as if he saved life of the whole people.

Al Shatibi added that the preservation of these fundamental universals is achieved in two different ways: (1) by establishing and strengthening them, and (2) by averting all harm that might affect them.²⁴ Ibn Athur added that the preservation of human souls (*hifz al nufus*) means to protect human lives from being ruined either individually or collectively. This is because according to him, the society or the human world (*alam*) comprises the individuals of the human species and every single soul has its specific characteristics that are essential for the existence and survival of the human world.

The preservation of the intellect means the protection of people's minds from being affected by anything putting them in disorder. This is because any disorder of the intellect leads to serious corruption consisting of improper and perverted human conduct. The preservation of the property means protecting the wealth of the community being ruined and from shifting to the hands of the others without compensation. It also means protecting the different constituents of that wealth which is valued in the *Shariah* from being destroyed for no return. The preservation of lineage would refer to the preservation of descent or lineal identity (*nasab*), as neglecting these aspects results in the harmful consequences of the undermining of the social order and family breakdown.²⁵

Using the '*maqasidi*' approach, the position of research on human embryos sits within two of the objectives of the *Shariah*: the protection of life (*hifz al nafs*) and the preservation of lineage (*hifz al nasl*) – the second and third of the hierarchy of *maqasid*. If these two objectives can be respected, there is no moral objection against stem cell research. For example, if the research is not done with the end result of destroying life whilst at the same time not with the purpose of creating life, this would be permissible. In fact, this is the tenor of the argument by some Muslim scholars.

The position in relation to human cloning for reproductive purpose is a further testimony to this. The majority views that cloning for reproductive purpose would offend the sanctity of human life and should not be tolerated.²⁶ However in the context of stem cell research and many of other researches in this nascent

24. *Ibid.* 120.

25. *Ibid.* 121, 122.

26. See Majdah Zawawi, *Human Cloning: A Comparative Study of the Legal and Ethical Aspects of Reproductive Human Cloning*, IKIM (2001). See also the recommendation of the Islamic Organisation of Medical Sciences (IOMS) in the Ninth *Fiqh* Medical seminar; Islamic Organisation of Medical Sciences. The majority juristic opinion is that reproductive cloning is haram (not permissible) in all its details. Whilst a minority opinion considered it haram in a way to prevent a cause of harm (the necessity to refrain from causing harm to oneself and others). This latter juristic opinion keeps open the option of readdressing the issue should new information become available and approved by *Shariah*. The use of somatic cell nuclear transfer technology even between husband and wife was also not approved. See *Musa Nordin*, 'Islamic Medical Ethics Amidst Developing Technologies', at <www.fimaweb.net/main/medicalethics/islamicmedicalethicsamidstdevelopingbiotechnologies.doc>.

technology, other ethical and social concerns could also be raised such as equitable access to biomedical resources, the commercial interest in biomedical products and the like. Sajoo, thus raised the more fundamental question:

At a more fundamental level, one must ask whether genetic manipulation and control may impact the autonomous basis of the identity of humans as responsible for their fate, and as ends in themselves rather than as instruments for ends chosen by others. Could we in the process put the risk at the gamut of human responses that allows us to connect with other human beings as individuals and communities?²⁷

Unlike Sajoo who analyzed the position of stem cell research on a much broader analysis, most of the deliberation by Muslim scholars on the issue is focused on one single determination: that is, whether an early embryo is a person. In other words, the key debate centres on what amounts to 'life' in Islam; and this turns on how the Koran and the Sunna treats the position of human embryo.

V. LIMITS OF SCIENCE: BIOETHICS AND LESSONS FROM THE KORAN

The Koran contains several verses that describe the creation of the earth, universe and all living creatures as signs from which we can learn from and draw lessons.²⁸ One of the important messages that can be drawn from these verses is that the universe and the whole creation are created in the best proportion and balance which should not be disturbed.²⁹ It is also clear from the Koran that human do not

27. *Ibid.*, 16.

28. *Surah Yunus* 10: 6 reads: 'Verily, in the alternation of the night and the day, and in all that Allah hath created, in the heavens and the earth, are signs for those who fear Him'. See also *Surah al Baqarah*: 164:

Behold! In the creation of the heavens and the earth; in the alternation of the Night and the Day; In the sailing of the ships through the Ocean for the profit of mankind; In the rain which Allah sends down from the skies, and the life which He gives therewith; To an earth that is dead; In the beasts of all kinds that He scatters through the earth; in the change of the winds, and the clouds which they trail like their slaves between the sky and the earth – (Here) indeed are Signs for a people that are wise.

29. See *Surah al Nahl* 16: 3: 'He has created the heavens and the earth for just ends: Far is He above having the partners they ascribe to Him!'; *Surah al Rum* 30: 22: 'And among His signs is the creation of the heavens and the earth and the variations in your languages and your colours; verily in that are signs for those who know'; *Surah al Shura* 42: 29: 'And among His signs is the creation of the heavens and the earth, and the living creatures that He has scattered through them and He has power to gather them together when He wills'; *Surah al Jathiyah* 45: 22: 'Allah created the heavens and the earth for just ends, and in order that each soul may find the recompense of what it has earned, and none of them be wronged'; *Surah al Taghabun* 64: 3: 'He has created the heavens and the earth in just proportions, and has given you shape, and made you shapes beautiful; and to him is the final goal.'

have the power to create life³⁰ and that all the creations are signs of the powers as well as blessings of God.³¹

This is true to the Koranic pronouncement that the creation of man is considered to be the best³² and that other living creatures are created as sustenance for human.³³ However, man cannot simply act as he will as he is responsible to maintain the balance in which the whole universe is created.

Most Muslim scholars take recognition of the Koranic message and adopt an approach that resolves in the spirit of reconciliation between science and religion. The mainstream view among the scholars is that the door to scientific enquiry must not be closed but should be monitored according to religious dictates. The most important limit to scientific enquiry is that it must not bring about result that goes against God as the creator of creation.³⁴

Thus, in the views of Yusuf al Qardawi:

If it becomes possible through research to clone organs such as the heart, liver, kidneys or others which may benefit those who are in dire need of them, then this is permitted by religion and the researcher or scientist will receive the reward from Allah. This is because the research will confer benefit on humanity without loss to others or infringing upon them. Therapeutic cloning with this noble research pursuit is permissible and it is encouraged. In fact, in some circumstances, it may become mandatory to

30. See *Surah al Furqan* 25: 2:

He to whom belongs the dominion of the heavens and the earth; no son has He begotten, nor has He a partner in His dominion: It is He who created all things, and ordered them in due proportions. Yet have they taken besides Him, gods that can create nothing but are themselves created: that have no control or hurt or good to themselves; nor can they control death nor life nor resurrection.

31. *Surah al An'am* 6: 73: 'It is He who created the heavens and the earth in true (proportions): the day He saith, "Be," Behold! It is. His Word is the truth. His will be the dominion the day the trumpet will be blown. He knoweth the unseen as well as that which is open. For He is the wise, well-acquainted (with all things)'.

32. 'Man is created in the best of creation': *Surah al Tin* 95: 4

33. *Surah al Isra'* 17: 70: 'We have honoured the sons of Adam; provided them with transport on land and sea; given them for sustenance things good and pure; and conferred on them special favours, above a great part of our creation'. This concept known as *takhlif* essentially means that nature and all creations are for human, see also 15: 15–34.

34. *Surah Fatir* 35: 1: 'Praise be to Allah who created (out of nothing) the heavens and the earth who made the angels messengers with wings – two, or three, or four (Pairs): He adds to Creation as He pleases: for Allah has power over all things'; *Surah Al Ra'd* 13: 16:

'Say: "Who is the Lord and Sustainer of the heavens and the earth?" Say: "(It is) Allah." Say: "Do ye then take (For Worship) protectors other than Him, such as have no power either for good or for harm to themselves?" Say: "Are the blind equal with those who see? Or the depths of darkness equal with light?" Or do they assign to Allah partners who have created (anything) as He has created, so that the creation seemed to them similar? Say: "Allah is the creator of all things: He is the One, the Supreme and Irresistible."'

enhance this research in accordance with the need and man's research capability and accountability.³⁵

It should be clear however that the purpose of science should not just be for the sake of enquiry alone. Applying the concept of *Masalih mursalah* here, one of the lessons that can be drawn is that for any scientific enquiry, there should be clear indications that it would benefit mankind. Sardar, for example views that science and technology are related to a set of ten basic Islamic values, which include (*Tawhid*) unity of God (*ibadah*) worship and trusteeship (*khilafah*). Islam is opposed to the concept of science for science's sake.³⁶

VI. ISLAM AND EMBRYO RESEARCH

The main concern with human embryonic stem cell research is the destruction of embryo to harvest the stem cells. The permissibility of destroying embryos depends substantially on the ontological status of embryo in Islam. This issue has been explored by Mahdi Zahra and Shaniza Shafie in the context of pre-implantation of Genetic Diagnosis.³⁷ Central to the authors' analysis is the Koranic injunctions on development of embryo, among others (*Al Hajj*: 5):

O mankind! If you are in doubt about the Resurrection, then verily, We have created you from dust, then from a *Nutfah* (mixed drops of male and female sexual discharge), then from '*alaqah* (a slot or piece of thick, coagulated blood), then from a little lump of flesh – some formed and some unformed – that We may make it clear to you (Our Power and Ability to do what We will). And We cause whom We will to remain in the wombs for an appointed term, then We bring you out as infants.

This verse and other verses of the Koran reinforce the view that the embryos developed gradually in the mothers' wombs in various stages.³⁸ From the above

35. Yusuf Al-Qardawi. *Hadyul Islam Fatawi Mu'athirah*. Darul Qalam, Kuwait 2001. Translated by Gema Insani Press, October 2002, cited in *Musa Nordin, ibid*.

36. Pervez Hoodboy, *Islam and Science: Religious Orthodoxy and the Battle for Rationality*, S Abdul Majeed & Co (1992), Malaysia.

37. 'An Islamic Perspective on IVF and PGD, with particular reference to Zain Hashmi, and Other Similar Cases', *Arab Law Quarterly*, Vol. 20 Pt 2, 2006.

38. See also *Surah al Mu'minun* 23: 12–14:

Man We did create from a quintessence (of clay); Then We placed him as a drop of sperm in a place of rest, firmly fixed; Then We made the sperm into a clinging clot of blood; then of that clot We made a chewed lump; then We made out of that lump bones and clothed the bones with flesh; then We developed out of it another creature, So blessed be God, the Best to create!

Surah al Mu'min 40: 67:

It is He who has created you from dust then from a sperm drop, then from a leech-like clot, then does he get you out (into the light) as a child; then lets you (grow and) reach your age of full strength; then lets you become old, though of you there are some who die before – and lets you reach a Term appointed; in order that ye may learn wisdom;

ayah, Muslim scientists believe that the *nutfa* represents the blastocyst which embeds within the endometrium. The *alaqah* is described as the stage where it clings to the inner uterine wall like a leech. The *mudgha* is the stage where the chewed lump of flesh resembled accurately the appearances of the somites.³⁹

As the above view describes the gradual development of embryo within the mother's womb, the ensuing question is: At what stage exactly would the embryo be considered a human? On this, the main controversy with the use of embryonic stem cells revolves around the various questions about when life becomes a human life, namely:

- (1) Is an ovum and sperm a person?;
- (2) When do the products of conception become a person?;
- (3) Does a zygote have a full set of human rights?; and
- (4) Does the foetus have a soul?⁴⁰

Beside the above verse, three authentic Hadiths further reiterate the gradual development of embryo:

The creation of every one of you [mankind] is formed in the womb of his [/her] mother for forty days as a *nutfah* (mixed drops of male and female sexual discharge), then a *alaqah*' (clot or a piece of thick, coagulated blood) for similar period, then a *mudghah* (little lump of flesh) for a similar period, then to it an Angel is sent, the Angel blows *ruh* (spirit or soul or breath of life) in it.⁴¹

If forty-two nights have passed over the embryo, Allah sends an angel to it, who shapes it and creates its hearing, vision, flesh and bones. Then he [the angel] says, 'O Lord, is it male or female? And your Lord decides what he wills.'⁴²

Two women from Bani Hadhil had a fight; one of them threw a stone on the other and caused her to die together with the foetus in her womb. The dispute was brought before the Prophet (*pbuh*) Who ruled that the *diyyah* (blood money) for the foetus is *ghurrah* (1/20 of a normal *diyyah*) and a full *diyyah* for the woman to be paid by the tribe of the guilty woman.⁴³

Surah al Qiyamah 75: 36–40:

Does man think that He will be left uncontrolled (without purpose)? Was he not a drop of sperm emitted (in lowly form)? Then did he become a leech-like clot; then did (God) make and fashion him in due proportion. And of him He made two sexes, male and female. Has He not (the same) power to give life to the dead?;

Surah al Zumar 39: 6: 'He makes you in the wombs of your mothers, in stages, one after another'.

39. *Musa Nordin, ibid.*

40. *Musa Nordin, ibid.*

41. *Sahih al Bukhari, Kitab al Qadar; Sahih Muslim, Kitab al Qadar*; as translated by Mahdi Zahra and Shaniza Shafie, *ibid.*

42. *Sahih al Bukhari, Kitab al Qadar*; as translated by Mahdi Zahra and Shaniza Shafie, *ibid.*

43. *Sahih al Bukhari, Kitab al Tub; Sahih Muslim, Kitab al-Qasamah*, see also Al Zuhayli, Wahbah. Vol. 6, 362–363 as cited and translated by Mahdi Zahra and Shaniza Shafie, *ibid.*

Based on the three authentic Hadiths, three spectrums of opinion are formed:

- (1) The most strict view is that the embryo attains its 'human status' from the moment of conception. This view emerges from the Malikis and al Ghazali from the Shafi'i school;
- (2) The middle view is that the embryo attains its 'human status' only when the embryo starts to develop its human features such as eyes, ears, limbs, skin, flesh and bones. This view is the most popular view and is adhered by the Hanafis, Shafiis, Zahiris and some Hanbalis; and
- (3) The most liberal view is that the embryo attains its 'human status' only after ensoulment which takes place at the 120 days. Prior to the 120 days thus, the removal and destruction of the embryo would not entail any liability.

Yet in other verses of the Koran, the beginning of a human is described to be that of '*alaghah*'. In Chapter 23, verses 12–14 the Koran teaches:

We created (*khalaqna*) man of an extraction of clay, then we sent him, a drop in a safe lodging, then We created of the drop a clot, then we created of the clot a tissue, then We created of the tissue bones, then we covered the bones in flesh; thereafter We produced it as another creature. So blessed be God, the best of creators (*khaliqin*)!

This verse has been taken by some Muslim scholars as the earliest point in which an early embryo is considered to be beginning its life.⁴⁴ This was also the stand of the Malaysian Fatwa Council in its 2005 Fatwa.⁴⁵

The ensoulment process is clearly described in the *Quran* in *Surah 32: 9*: 'And breathe into him of His spirit'. Some scholars believe that ensoulment is the point in which the embryo is considered to be a human being, as far as legal capacity is concerned, albeit at an incomplete stage or known as *ahliyyah al naqisah*.⁴⁶ At this stage, the embryo does not have the legal capacity to exercise any rights but only to receive responsibility especially from the mother.

Thus ensoulment is an important stage where the embryo is recognized as having a legal status. Does that mean that prior to ensoulment, the embryo is totally devoid of recognition as human at all? Some contemporary scholars believe that the process of ensoulment is only a metaphysical concept. Even though ensoulment comes much later in the process of the development of the embryo, the embryo is

44. See Majdah Zawawi, *An Ethico Legal Analysis of Assisted Reproductive Technologies in Malaysia: Balancing Rights and Responsibilities*, PhD dissertation submitted to Ahmad Ibrahim Kulliyah of laws, International Islamic University Malaysia, (November 2006).

45. Majlis Fatwa Kebangsaan ke 66, 22 February 2005.

46. See Yassein Mohamad, 'Fitrah and its Bearing on Islamic Psychology', *The American Journal of Islamic Social Sciences*, Vol 12:1, (1995), 12 as cited in Majdah Zawawi, *An Ethico Legal Analysis of Assisted Reproductive Technologies in Malaysia: Balancing Rights and Responsibilities*, PhD dissertation submitted to Ahmad Ibrahim Kulliyah of Laws, International Islamic University Malaysia, (November 2006).

respected from the onset of fertilization and acquires consideration as a human foetus after implantation.⁴⁷

A middle view, which is the majority view, is that an embryo does not attain its human status at least until it starts to develop its human like physical attributes; to which the Hadith attributes this to occur at the fortieth day. Due to this, many Muslim scientists have accepted the view that the current practice in which embryo research is allowed up to fourteenth day from fertilization to be acceptable within *Shariah* perspective. At least three Islamic *Fiqh* (Jurisprudence) Councils have given permission for the use of the surplus embryos from IVF laboratories for ESC research.⁴⁸ However, most scholars believe that it is not permissible to consciously generate pre-embryos either by conventional IVF techniques or by Somatic Cell Nuclear Transfer (SCNT) for ESC research.

As early as the 1990s, the Muslim scholars have deliberated on the permissibility of research on human embryo. One such occasion is the First International Conference on Bioethics in the Muslim World held in Cairo from 10–13 December 1991. In the Conference the following practice guidelines may be summarized:

- (1) Cryopreserved pre-embryos may be used for research purposes with the free and informed consent of the couple;
- (2) Research conducted on pre-embryos is limited only to therapeutic research. Genetic analysis of pre-embryos to detect specific genetic disorders is permissible. Hence diagnostic aids should be provided for couples at high risk for selected inherited diseases. The treated embryo may only be implanted into the uterus of the wife who is the owner of the ova and only during the span of the marriage contract;
- (3) Any pre-embryos found to be genetically defective maybe rejected from transfer into the uterus after proper counselling by the physician;
- (4) Research aimed at changing the inherited characteristics of pre-embryos (for example, hair and eye colour, intelligence, height) including sex selection is forbidden;
- (5) Sex selection is however permitted if a particular sex predisposes to a serious genetic condition. One of the first couple to use the technique of sex selection was hoping to escape a neurologically debilitating disease known as x-linked hydrocephalus, which almost always affected boys. Embryonal sex selection would make possible the weeding out of other serious x-linked disorders including haemophilia, Duchenne muscular dystrophy and fragile X syndrome;
- (6) The free informed consent of the couple should be obtained prior to conducting any non-therapeutic research on the pre-embryos. These

47. *Musa Nordin, ibid.*

48. See the Council of Islamic *Fiqh* Academy of Muslim World League, 2003: 17th session in Makkah, 13–17 December; *Fiqh* Council of North America, International Institute of Islamic Thought, Graduate School of Islamic and Social Sciences, Islamic Institute news release 27 August 2001; and Aly A. Mishal, 'Stem cells: Controversies and Ethical Issues, Jordan Medical Journal', May 2001; 2001: 35(1) pp. 80–82; as cited in *Musa Nordin, ibid.*

- pre-embryos should not be implanted into the uterus of the wife or that of any other woman;
- (7) Research of a commercial nature or not related to the health of the mother or child is not allowed; and
 - (8) The research should be undertaken in accredited and reputable research facilities. The medical justification for the research proposal must be sound and scientific and conducted by a skilled and responsible researcher.⁴⁹

The recommendation of the 1991 Conference is, thus, a direct contrast to those arrived at in the 1990 *Majma' al Fiqh al Islami* meeting.⁵⁰ In this meeting, there was an express prohibition on the creation of embryos that would be more than what is safe for implantation into the womb at a single treatment.⁵¹ The Committee of Islamic Medical Science to the Islamic *Fiqh* Academy of Jordan in 1992⁵² also does not recommend the creation of extra embryos except in special circumstances. The Committee was of the view that in the instance of divorce/death, the embryos must be kept until end of storage period then allow to perish but no embryos may be intentionally discarded, destroyed or donated.

Another ground in which the Muslim scholars have based on to permit embryo research is by drawing a distinction between an in vivo embryos and in vitro embryos. The latter would only survive if it is implanted in a woman's womb and thus should not be treated the same as an embryo in a natural environment. The inviolability and sacredness of the former is not the same as the latter. Hence, if respect for a human embryo entails the avoidance of action which may results in the destruction of an embryo in a woman's womb, the position is not the same with the destruction of excess fertilized embryo.⁵³ This indicates, according to Siddiqi, that there is a distinction between potential life and actual life,⁵⁴ in these words:

The core question is whether an embryo, which is formed within a few days after an artificial fertilization and is not yet in the womb of its mother be considered a human being, with all the rights of a human being? . . . if these embryos were treated as full human, it would have been forbidden to produce

49. *Musa Nordin, ibid.*

50. 17th Meeting, 1990.

51. Cited by Umar ibn Muhammad ibn Ibrahim Ghanim, *Ahkam al Janin fi al Fiqh al Islami*, 2001; 'Dar al Andalus al Khadra', *Jaddah* 262.

52. In its 5th meeting 5 November-17 December 1992.

53. The ratio of the reasons making people liable to pay 'blood money' (*diyat*), if someone destroys a live embryo in the womb of a woman does not cover embryos produced in vitro and therefore provides further support to the permissibility of the use of human embryos produced using the in vitro techniques. Dr Seyyed Mohammad Fatemi, Dr Mirghasem Jafarzadeh and Dr Marefat Ghaffari, 'Muslim's view on the Moral Aspects of the Patentability of Human Embryos: Appraisal of *Shariah* with Special Reference to *Shi'i Fiqh*', available at <<http://ipgenetics.group.shef.ac.uk/workshopabstract.htm>>.

54. 'Embryo Reduction: Islamic View', Islamic Online Fatwa Bank, 14 July 2001, <www.islamonline.net>. See also Christl Dabu, 'Stem Cell Science Stirs Debates in Muslim World Too', <<http://csmonitor.com>>.

them in excess and destroy them later. No one treats them as humans. Destroying such embryos is not called and cannot be called abortion.⁵⁵

The distinction between in vivo embryos and in vitro embryos is further seen in the distinction between the accrual of legal capacity and rights over embryos as discussed earlier. Embryos are accorded with the right to live upon fertilization. It is accorded with *ahliyyah al wujub al naqisah* that is, incomplete legal capacity. In which the foetus enjoys principally two rights: the right to life and the right to inheritance but this right operates only once he/she is born.⁵⁶ The destruction of an in-vivo embryo also would mean amount to abortion which is prohibited by all Majority of the ulama in normal circumstances except if life of the mother is in danger.

Regardless of that, Muslim scholars believe that research on embryo should only be done in narrow and exceptional circumstances and on good grounds. Siddiqui views that the use of embryonic stem cells should be very heavily limited. In his opinion, the isolation of stem cells should only be allowed from frozen embryos that were created for the purpose of in vitro fertilization and would otherwise have been destroyed. Full consent of the donors must be obtained. Safeguards must also be created against monetary compensation to embryo donors and against the creation of embryos in excess of what is required for in vitro fertilization.

Gamal I. Serour opines that research on human embryos should be limited to therapeutic research. Research of a commercial nature or unrelated to the health of mother or child is not allowed. Cryopreserved pre-embryos may be used for research purposes with the free informed consent of the couple. Non-therapeutic research may be conducted on excess pre-embryos with the free informed consent of the couple, to improve the treatment of infertility, contraception, reproductive medicine, genetics, cancer, and embryology. These treated pre-embryos are not to be transferred to the uterus of the wife or that of any other woman. He frowned upon the creation of human embryo just for the purpose of research. He views that creating embryos solely for research purposes is not a reproductive liberty. It is an act of liberty in the use of one's reproductive capacity.⁵⁷

That is also the current thinking of the Malaysian National Committee on Human Cloning. The Committee in its deliberation recommends allowing the utilization of surplus IVF embryos for research but prohibits the creation of human embryos for research and SCNT for research and reproduction.⁵⁸

In contrast, some Muslim scientists are of the view that research on embryonic stem cells is permissible within ethically regulated environment. Abdulaziz

55. Dr Muzammil Siddiqi, 'An Islamic Perspective on Stem Cells Research', <<http://IslamiCity.com>>.

56. Yasien Mohamed, *Human Nature in Islam*, (1998), A.S. Nordeen, Malaysia, 125.

57. Gamal I. Serour: 'Reproductive Choice: A Muslim Perspective', *The Future of Human Reproduction: Ethics, Choice and Regulation* edited by John Harris and Soren Holm. Clarendon Press 1998, 191–202.

58. *Musa Nordin, ibid.*

Sachedina opines that the *Shariah* treats a second source of cells, those derived from foetal tissue following abortion, as analogically similar to cadaver donation for organ transplantation in order to save other lives, and hence, the use of cells from that source is permissible.⁵⁹

He concludes that:

1. The Koran and the Tradition regard the perceivable human life as possible at the later stages of the biological development of the embryo;
2. The foetus is accorded the status of a legal person only at the later stages of its development, when perceptible form and voluntary movement are demonstrated. Hence, in earlier stages, such as when it lodges itself in the uterus and begins its journey to personhood, the embryo cannot be considered as possessing moral status; and
3. The silence of the Koran over a criterion for moral status (that is, when the ensoulment occurs) of the foetus allows the jurists to make a distinction between a biological and a moral person, placing the later stage after, at least, the first trimester of pregnancy.

On the gradual formation of a human being, AbdulAziz Sachedina quoted two views from Muslim scholars:

Ibn Hajar al-Asqalani (d.1449) says:

The first organ that develops in a foetus is the stomach because it needs to feed itself by means of it. Alimentation has precedence over all other functions for in order of nature growth depends on nutrition. It does not need sensory perception or voluntary movement at this stage because it is like a plant. However, it is given sensation and volition when the soul (nafs) attaches itself to it.⁶⁰

Ibn al Qayyim, *Al Tibyan fi Aqşam al Qur'an* (Cairo, 1933, page 255):

Does an embryo move voluntarily or have sensation before the ensoulment? It is said that it grows and feeds like a plant. When ensoulment takes place voluntary movement and alimentation is added to it.⁶¹

Based on these two views, Sachedina's interpretation of Islam is that it permits the use of five-day-old blastocysts to produce embryonic stem cells.⁶²

59. Abdulaziz Sachedina, 'Testimony of Abdulaziz Sachedine, Ph.d, University of Virginia, Islamic Perspectives in Research with Human Embryonic Stem Cells', in Michael Ruse & Christopher A. Pynes (ed.) *The Stem Cell Controversy: Debating the Issues; Prometheus Books* (2006) New York.

60. Ibn Hajar al Asqalani, *Fath al Bari fi Sharh al Sahih al Bukhari, Kitab al Qadar*, 11: 482 quoted by Sachedina, 254.

61. Ibn al Qayyim, *al Tibyan fi aqşam al Qur'an* (Cairo, 1933), p. 255 as quoted by Sachedina, 256.

62. See LeRoy Walters, 'Human Embryonic Stem Cell Research: An Intercultural Perspective', in Michael Ruse & Christopher A. Pynes (ed.) *The Stem Cell Controversy: Debating the Issues*, Prometheus Books (2006) New York.

For obvious reasons, most Muslim scholars are not in favour of allowing the creation of embryos for the purpose of research and would limit the permissibility of research on excess embryos from IVF treatment.

Muslim scientists have explored the permissibility of such research at various international fora. One of it is a Workshop on Ethical Implications of Assisted Reproductive Techniques (ART) for the treatment of Infertility (Al Azhar, Cairo, 2000) that has accepted non-reproductive cloning to produce stem cells that would be of benefit to others. This opinion represents a major shift in the stand of Muslim scientists as far as genetics is concerned. In an earlier Symposium of Medical Jurisprudence held in Jeddah in 1987, it was recommended that left over embryos are not to be used but discarded. Usage of left over embryos for research would only be allowed if the parties agree but before they reach the fourteen days stage. The creation of embryos is strictly prohibited.

As in most other issues involving emerging medical technologies divergent views are common. As illustrated by Atigetchi,⁶³ Egypt is one such country. Whilst one renowned professor from Al Azhar University tolerates non-reproductive cloning and believes it right to use precious supernumerary embryos – but only within the first fourteen days – for research for the benefit of others instead of leaving them to die. On the other hand, the President of the Egyptian Medical Syndicate, oppose the usage of embryos for research, as the conceived being is already a human being. The divergent view points could well explain the differences in national countries approaches to stem cell research.⁶⁴

The Fatwa Committee of the Majlis Ugama Islam Singapura (Islamic Religious Council) concurs with the opinion of the Bioethics Advisory Committee to use stem cells from embryos below fourteen days for the purpose of research, which will benefit man-kind, is allowed in Islam. This is with the condition that it is not misused for the purposes of human reproductive cloning, which would result in contamination of progeny and the loss of human dignity.⁶⁵ In the deliberation of the Fatwa Committee, Islam does not place any judgement on an embryo, which is not fully formed. An embryo is only considered as a human life after it is four months old when the soul is introduced into the embryo. Thus, an embryo below four months, whether within or outside the womb, is considered as a living thing undergoing the growth process. However, it is not yet considered as the beginning of human life with the existence of a soul.⁶⁶

63. Dariusch Atigetchi, *Islamic Bioethics: Problems and Perspectives* (2007) Springer, 248.

64. As cited by Dariusch, *ibid.*, 248.

65. Singapore Bioethics Advisory Committee, *Ethical, Legal and Social Issues in Human Stem Cell Research, Reproductive and Therapeutic Cloning*, G-3-G-71.

66. The Committee formed its view based on the opinion of Dr Muhammad Sulaiman al-Asyqar, who is of the view that an embryo which is not formed or is not in a woman's womb, will not be placed any judgement on it. In his view: 'Islamic law does place any form of judgement on an embryo which is not formed. Verily, I have explained in detail my opinion during my forum discussion on birth. In that forum, decision had to be made that Islamic law does not place any judgement on a woman's fertilized egg except after it is in the womb. There is no judgement on it before it is in the womb. A similar opinion was given by the Fatwa Institution of Darul Ifta,

It is clear from the deliberation that differences of opinion on the permissibility of research on human embryos stem from differences in the interpretation of the Koranic *ayahs* and the Sunna. Such differences result in different national approaches and fatwa among Muslim countries. It is thus open for national countries to adopt a position more acceptable to the majority Muslim and religious authorities in their country. This could explain the stark contrast, for example, the liberal views of the Fatwa Authorities in Singapore as opposed to that of Malaysia.

VII. COMMERCIALIZATION OF HUMAN BODY AND HUMAN BODY PARTS

Another limit in which Muslim scientist would have to avoid is the religious proscription against the commercialization of human body and human body part. In an earlier work, it has been pointed out that the patenting of human body or parts of human body should not be allowed as it may offend the classical views on the commercialization of human body parts. This view is formed based on the viewpoint of several Muslim scholars who openly opposed any form of commercialization of the human body for fear that it would offend human dignity.

Al Marghenani states: 'it is not permitted to sell a human being's hair or utilize it in any way, because humans are highly dignified, therefore no part therefrom should be undignified or demeaned'.⁶⁷

Another important statement by a Muslim scholar is that of Al Kassani who says:

Human bones and hair should not be permitted to be sold, not because of their uncleanness (*nadjassatihi*), as such parts are to be determined to be clean in the Prophetic tradition, but out of respect for human organs; the demeaning of such human organs through their sale is a form of humilisation.⁶⁸

Al Kassani also prohibits the sale of maternal milk. He says: 'it is forbidden to sell a mother's milk, as it is part of the human body, and as such it is worthy of the highest respect and dignity, and it is not dignified or respectable to demean the human body by making it an object of selling and buying'.⁶⁹

Saudi Arabia, where, for as long as there is no soul in an embryo, the sperm and the egg are judged to be living things adapting to their specific conditions. They are considered as components of the fertilization process. They have not reached the stage of a complete human being.' See The Fatwa the Majlis Ugama Islam Singapura, Fatwa Committee Special Meeting, Thursday, 22 November 2001, 'Ethical, Legal and Social Issues in Human Stem Cell Research, Reproductive and Therapeutic Cloning', A Report From the Bioethics Advisory Committee, Singapore.

67. *Al Hidayati*, Part II, at 34, cited in Mohammad Naeem Yaseen, 'The Rulings for the Donation of Human Organs in the Light of Shar'ia Rules and Medical Facts', 5, Part 1, Feb., 1990, 49-87, at 51.

68. *Al Badai*, Part V, 142, cited in Yaseen, *ibid.* at 51.

69. *Al Badai*, Part 145, cited in Yaseen, *ibid.* at 51.

On the same token the patenting of human embryo should be viewed with caution for fear that the practice may encourage the commercialization of human embryo. On the other hand, there are some who view that whenever the public reason treats production of human embryos as an invention rather than the mere discovery, it can be a source of an economic right. Although it is correct that a human embryo is a live creation, which is capable of becoming a human being, there is no reason in *Shariah* to treat it as a human being. What is to be respected and protected is a human being and not a creation that is capable of becoming a human being?⁷⁰

Whatever the position taken, it remains to be questioned whether the patent office should take a different position than that of the religious authorities in relation to embryo research. Should the religious authorities allow such research, then correspondingly the same position should be taken by the patent office. Would the patenting of the result of the research be offending human dignity when in the first place the research was justified by the religious authorities. These issues require further deliberation by the Muslim scholars.

VIII. MALAYSIAN PRACTICES ON RESEARCH INVOLVING HUMAN EMBRYO AND STEM CELLS

In Malaysia, a Code of Practice was formulated to provide guidance physicians and hospitals involved in Assisted Reproductive Technologies (ART).⁷¹

Part IV(b) of the Guidelines is important as it relates to storage of gametes and embryos. According to this part, anyone consenting to the storage of their gametes or of embryos produced by them must:

- i) specify the maximum storage (maximum three years);
- ii) dispose of the gametes or embryos if they die or are incapable of varying or revoking their joint consent.

Emphasis is made for the attainment of consent from the couple undergoing the ART treatment concerning the storage and disposal of embryos or for research.⁷² A couple undergoing ART should be asked for instruction concerning the storage and disposal of embryos. Specific instruction must be obtained from the couple and informed consent duly obtained. It was further provided that no research or experimentation shall be performed on or using any human oocyte.⁷³

70. Dr Seyyed Mhammad Fatemi, Dr Mirghasem Jafarzadeh and Dr Marefat Ghaffari, 'Muslim's view on the Moral Aspects of the patentability of Human Embryos: Appraisal of Shariah with Special Reference to Shi'i Fiqh', available at <<http://ipgenethics.group.shef.ac.uk/workshopabstract.htm>>.

71. Ministry of Health, *Malaysian Code of Practice and Guidelines for Assisted Reproductive Techniques (ART) Centres*, 2002. See also the Malaysian Medical Council Guideline, *Assisted Reproduction*, 19 October 2005.

72. Para. 9 on 'Storage and Disposal of Gametes and Embryos'.

73. Para. 14 on 'Prohibited/Unacceptable Practices'.

Part V of the Guidelines meanwhile specifies that the termination and disposal of gametes and embryos must refer to the couple's written consent. In the absence of instructions, the embryos are then stored for a maximum period of three years before they are destroyed. If the couple consents to it, the Guideline also allows research on left over embryos provided that the research does not exceed the fourteen days requirement.

The Code of Practice acknowledges that human embryo is given special status. Hospitals and private healthcare are to decide carefully whether or not to dispose, how to dispose and whether to use it for research purposes. The Centre then should decide the culture period, the method that is to be used to terminate development and the procedure to ensure that embryos do not continue to develop after fourteen days or after the appearance of the primitive streak. The Code stipulates that all research must have license from the Ministry of Health. Licenses will only be granted for the following types of research projects:

- to promote advances in the treatment of infertility;
- to increase knowledge about causes of miscarriage;
- increase knowledge on causes of congenital disease;
- develop better contraceptives;
- develop methods for detecting presence of gene or chromosome abnormalities before implantation;
- increase knowledge about serious diseases; and
- to allow such knowledge to be applied in developing treatments for serious disease.

The Code of Practice contains several specific prohibitions.⁷⁴ First, the keeping or using an embryo after the fourteen day period or after the appearance of the primitive streak is not allowed. So is the placing an embryo in a non-human animal and replacing a nucleus of a cell of an embryo with a nucleus taken from the cell of another person, another embryo or a subsequent development of an embryo altering the genetic structure of any cell while it forms part of an embryo. It was also specifically mentioned that embryos that have been appropriated for research must not be used for any other purposes.⁷⁵

Recently, the Health Ministry introduced guidelines for stem cell research in Malaysia.⁷⁶ Among the policies is that the Ministry of Health will undertake to encourage and promote stem cell research in Malaysia. Second, all stem cell research must pass through an institutional review board and an institutional ethics committee to prevent unethical research and unethical use of stem cells. Third, research on stem cells derived from adult stem cells is allowed in accordance to existing guidelines. Fourth, the use of foetal tissues from legally performed termination of pregnancy is also allowed in accordance to existing guidelines. Fifth, the use of non-human stem cell lines is also allowed (mice and primates). Sixth, the

74. Para. 10.4 on 'Prohibitions'.

75. Para. 10.5.

76. 'National Organ, Tissue and Cell Transplantation Policy', Ministry of Health, June 2007.

use of embryonic stem cell lines (from sixty-four cell lines) for therapeutic purposes should be allowed. Seventh, the creation of embryos either from ART or SCNT specifically for the purpose of scientific research is presently prohibited.

The Health Ministry Guidelines was formulated taking into consideration of a national fatwa that has also been released on Therapeutic Human Cloning and Stem Cell Research in 2005.⁷⁷ The fatwa states:

- i) That therapeutic human cloning is permitted (*diharuskan*) if for – medical treatment – through the creation of certain cells or replacing damaged organs taking into account the limits permitted by the Syari'ah.
- ii) The use of embryos leftover from IVF for research purposes is permitted (*harus*) on two conditions:
 - (a) The couples had consented
 - (b) Before the embryo reaches the stage of '*alaqah*'.
- iii) Research on pre-embryo for purposes other than for therapeutic purposes is also permitted provided that –
 - (a) The couples consented
 - (b) The embryo is not implanted into any womb.
- iv) Research on pre-embryo to detect any predisposition to any genetic diseases for high risk couples is allowed and only embryos that were determined to be clear from any of such diseases could be implanted in the womb of the mother during the marital term.
- v) Any genetic treatment on pre-embryo to change the natural characteristics of the pre-embryo such as hair, hair colour, intelligence, height including sex determination is not allowed. However, sex determination is allowed if is linked to predisposition to fatal genetic diseases.
- vi) Any type of research for commercial gain or that which has no relation to the health of the mother or the fetus – is not permitted.
- vii) Research done must be –
 - a) Legal with a clear research proposal
 - b) For scientific purposes
 - c) Carried out by qualified research personnel who are trustworthy and responsible.
- viii) Sources of stem cell permitted –
 - (a) excess embryos (consent obtained from parents)
 - (b) aborted fetus as a result of natural abortion or from medical treatment that is allowed under the Shariah and is carried out with the consent of the family members; not from aborted fetus that is carried out deliberately without any causes accepted by the medical fraternity and Shariah.
- ix) Stem cell created from SCNT is not permitted based on *sadd al-zara'i* (blocking the means of evil).

77. Majlis Fatwa Kebangsaan ke 66; 22 February 2005.

With this fatwa, one could infer that there is no blanket approval for stem cell research as the Malay word '*diharuskan*' refers to *mubah* in Arabic which means: 'something which is permitted' and not: 'something which is promoted or encouraged'. Secondly, it would appear that research must be for therapeutic purposes only which must be on legitimate grounds and not for commercial purposes. Thirdly, the Malaysian Fatwa Council requires that such research must be legal and conducted in a responsible manner. However, the first statement allowing therapeutic cloning would have to be made more consistent with the last stand on the creation of stem cell through somatic cell nuclear transfer. If the latter practice is not allowed, the first statement in relation to the permissibility of therapeutic cloning would have to be clarified further.⁷⁸

IX. HOW TO MARRY PATENTS AND RELIGIOUS PERCEPTIONS OF ETHICS AND MORALITY?

As divided the European countries are when it comes to matters that relates to ethics and morality, the same position could be said of the Muslim community generally and Malaysia specifically. As a multiracial country, competing religious concerns could be the fabrics of today's discourse on ethical conceptions of biotechnological inventions. These issues are not easy to be resolved. Though the Patent Office could easily refer to the various fatwa issued by the Muslim religious authorities in Malaysia who have been quite active in engaging in public debates on the latest advances in biotechnology; representations from other religious groups should also be sought. This somehow does not ease the Patent Office in making their determination on ethical norms and conceptions of morality. The main concern would whether the patent office has the clout and the technical expertise to interpret what would be acceptable according to Islam, or for that matter, of the other religions existing in Malaysia.

Another important regulatory approval body is the Ministry of Health. The Ministry has been issuing Code of Practice and Guidelines applicable to the recent bio-medical advances, including Guidelines on Stem Cell Research.⁷⁹ Their guidelines on Stem Cell Research in Malaysia could be commended as they result from deliberation of committees comprising of members from different religious groups. These guidelines could be seen as adopting a rather strict approach to research on human embryos, despite the permissive tone of the National Fatwa Committee. The extraction of stem cells from embryos is currently not allowed, nor

78. These views are based on the presentation by the author and Majdah Zawawi entitled 'The Legal Position of Research on Human Embryo: A Comparative Study on Selected Jurisdictions' at the Workshop on Guidelines on Stem Cell Research and Transplant, Kementerian Kesihatan Malaysia Hyat Regency Hotel, 22 April 2007. According to a clarification from of the officers of the Malaysian Fatwa Council, the first statement in relation to therapeutic cloning was referring to the practice of PGD with particular reference to the case of Zain Hashmi.

79. Pekeliling Ketua Pengarah Kesihatan Bil 1/2006.

is embryonic stem cell therapy.⁸⁰ Whilst research involving stem cell lines is allowed if not encouraged,⁸¹ provided it complies with the existing International/National guidelines on ethical conduct of research.⁸² The importation of such tissues could only be made through institutions recognized by the Ministry of Health and in accordance to Guidelines on Importation and Exportation of Human Tissues and/or any Body Part.⁸³ In addition, the creation of embryos from either ART or SCNT specifically for the purpose of scientific research is presently prohibited. The strict approach culminates from the fact that currently research involving human embryos are simply not acceptable to the majority of the Malaysians; religion aside. With Malaysia earmarking biotechnology as priority areas, there may be a need for the setting up of a National Ethics Committee to serve as a platform in which complex and religiously sensitive moral issues could be debated. On this point, Malaysia has a lot to learn from the UK and the experience of the European Union.

80. See 9.6 National Organ, Tissue and Cell Transplantation Policy, Ministry of Health, June 2007.

81. See 15.1 National Organ, Tissue and Cell Transplantation Policy, Ministry of Health, June 2007.

82. See 15.2 National Organ, Tissue and Cell Transplantation Policy, Ministry of Health, June 2007.

83. See 11.2 National Organ, Tissue and Cell Transplantation Policy, Ministry of Health, June 2007.

Chapter 21

Human Rights Implications of Patenting Biotechnological Knowledge

*Jerzy Koopman**

I. INTRODUCTION: EMERGING TENSIONS BETWEEN LEGAL REGIMES

Nearly three decades ago, a large and diverse group of scientists, artists and businessmen expressed its concern about the workings of intellectual property law and its negative ‘effects on issues as disparate as scientific and artistic progress, biodiversity, access to information, and the cultures of indigenous and tribal peoples’¹ In the following years, intellectual property law, the associated rights, and the conduct of right holders started to be scrutinized from an unprecedented variety of pretexts and angles. Notions like distributive justice, cultural diversity, environmental

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1. Bellagio Declaration 1993. See J. Boyle, *Shamans, Software & Spleens. Law and the Construction of the Information Society* (Cambridge, Harvard University Press, 1997), 193 (entire Declaration included in Appendix B, 192–200). It is noted that the term ‘intellectual property law’ is rather imprecise. Intellectual property law incorporates many different legal regimes. Their communality is that they all apply to intangible legal objects, albeit with different origins, characters and features – and for different reasons and with different legal effects as well. The most important regimes of intellectual property law are copyright law, patent law – central to this article –, trademark law, industrial designs law, trade secrets and geographical indications and plant breeders’ rights. See e.g. K. Idris, *Intellectual Property – A Power Tool for Economic Growth* (WIPO, Geneva, 2003), 17 et seq.

sustainability, equity and the like arrived at the forefront of considerations about intellectual property. The same applies to the conduct and responsibilities of corporations, the predominant right holders in the contemporary knowledge-driven and globalizing economy. Corporations have become the 'global gatekeepers of the world's cultural heritage', including both various types of content (knowledge) and form (expression).² Corporate governance commenced to be a determinative factor in the thinking about intellectual property.³ Similarly, the increasingly central role of intellectual property regimes in international law, and its continuous expansive development, called attention to its interaction with other international legal regimes. It became clear that 'a fundamental tension is emerging between . . . IPR regimes in general . . . and prominent trends in . . . international law regimes'.⁴ The human rights law regime surely is the most prominent and weighty one among these regimes. At the turn of the millennium, the UN Sub-Commission on Human Rights even concluded that 'there are . . . conflicts between the intellectual property rights regime . . . and international human rights law'.⁵

This article focuses on these presumed conflicts with regard to one regime of intellectual property law, namely that pertaining to patents and in respect of the field of human activity that has collectively become known as the life sciences, and hinges on the application of biotechnology.⁶ It will show that patenting of biotechnological inventions may touch upon several interests, subject of human rights law instruments. Before these are inquired, however, the make-ups and workings of the legal regimes concerned are introduced. The diverging histories, goals and applicability of these regimes necessitates a brief description of their, so to say, essentials.⁷ These include their background, instruments, practicalities and authority and reach in the international legal framework (in paragraphs II and III below). Thereafter, the interests and human rights implicated by the patenting of biotechnological inventions are briefly outlined (in paragraphs IV and V). Subsequently, referenced 'conflicts' will

2. C. J. Hamelink, 'Human Rights for the Information Society' in *Communicating in an Information Society* (Geneva, UNRISD, 2003), 145.
3. Corporate governance is a hybrid concept that refers to, among other things, accountability, transparency, responsibility, sustainability of corporations and their activities in relation to corporate and outsider stakeholders.
4. P. Jaszi, *Rights in Basic Information: A General Perspective*. UNCTAD-ICTSD Dialogue on moving the pro-development IP agenda forward: Preserving public goods in health, education and learning, Bellagio, Italy, 2004, 1. At: <www.iprsonline.org/resources/humanrights.htm> (all websites referred to in this contribution were last accessed on 23 April 2008).
5. Resolution 2000/7. At: <www.unhcr.ch/Huridocda/Huridoca.nsf/0/c462b62cf8a07b13c12569700046704e?Opendocument>.
6. Biotechnology is defined here as the controlled modification and application of genetic and other biochemical compounds for, among other things, medical and agricultural purposes. This actually pertains to what may be called modern biotechnology, which emerged in the nineteenth century and was enhanced in the second half of the twentieth century. If one uses a broad definition of these technologies, they may have already been developed and applied by human beings in 8000 B.C., when crops and livestock were already cultivated. See Biotechnology Industry Organisation, *Guide to Biotechnology 2007* (Washington D.C. 2007), 6–15. Dependant on the context, in this article reference is made to 'the life sciences' and 'biotechnology'.
7. These regimes developed entirely independently. E.g. Ph. Cullet, *Intellectual Property Protection and Sustainable Development* (New Delhi, LexisNexis, 2005), 385.

be analyzed with regard to one specific interest – that of traditional knowledge holders. The manner in which the patenting of biotechnological inventions touches upon the interests of traditional knowledge holders – and thereby perhaps even violates their human rights – is one of the most eminent contemporary issues.⁸ It surely justifies tailored exploration. Therefore, the manners in which these interests may be affected by current patent practices are explained and contextualized (in paragraph VI). Thereafter, it is inquired whether patenting of biotechnological inventions derived from traditional knowledge steps upon human rights of traditional knowledge holders. This inquiry is tailored to (the application of) European patent law *vis á vis* some selective human rights (laws). Two particular issues will be explored. First, whether European patent law is at odds with human rights law for allowing patentees to make use of traditional knowledge against the wishes of the peoples that have developed it (in paragraph VII). Second, whether human rights laws are violated because traditional knowledge as such cannot be patented pursuant to European patent law (in paragraph VIII). This inquiry necessarily has an explorative nature, and the questions raised may ultimately outnumber the answers provided. This derives from the fact that the tensions between the two regimes, and the rights they convey, will show to be less clear-cut and to-point than suggested by the UN Sub-Commission on Human Rights' conclusion. It will be concluded that, whereas patenting may surely implicate human rights related to traditional knowledge and its holders, it is hard to conclude that those rights are truly and necessarily violated. This somewhat ambivalent conclusion partially relates to the distinctions between the make-up and goals of these regimes, which have evolved quite independently. This shows from the next paragraphs II and III, which introduce, respectively, the prime body of human rights – and intellectual property law – and patent law in particular.

II. HUMAN RIGHTS LAW

II.A CHARACTER AND RATIONALE

Human rights law may perhaps be considered the skeleton of the international legal order. This body of law, and the rights stipulated therein, emanates from specific

8. In my opinion, this issue is among the most eminent issues, because it has – unlike many of the other issues – not only initiated serious and structural academic attention, but has also spurred specific and systematic (inter)governmental action, such as undertaken in the World Intellectual Property Organization (WIPO) and the World Trade Organization, and has already led to legislative initiatives in a host of countries around the world. Respectively by the WIPO Intergovernmental Committee on Intellectual Property and Genetic Resources, Traditional Knowledge and Folklore (IGC), at <www.wipo.int/tk/en/>, and the TRIPS Council at <www.wto.org/english/tratop_e/TRIPS_e/art27_3b_e.htm>. Moreover, the traditional knowledge issue has already had concrete consequences for inventors and patentees. It led e.g. to very negative media coverage about a series of life science companies and to direct challenges to patents conveyed – some of which have resulted in revocations and thus loss of rights (e.g. the so-called Neem tree patent). This may not be surprising because, unlike the other issues that will be elaborated, the issue with regard to traditional knowledge directly bears upon the subject-matter of patent law, which is knowledge. One and other is extensively discussed in para. VI below.

political, cultural and social problems and developments in history. These include religious and ethnic rivalry, war, abuses of power, oppression and what have you. The formation of this body of law is, furthermore, extensively determined by the formation of the nation-state and the notion of legal centralism. Human rights law finds its core justification in morality, which is supposed to be adhered to universally, but was first legally expressed, codified and systemized in Western-Europe.⁹ It should safeguard all human beings against severe abuses by their rulers. Human rights so pertain to fundamental human interests. They are thus considered to be high priority norms. But not every individual interest justifies human rights protection; not every conflict between a constituent and his government needs to be protected by these norms, and thus can be conceived of from within the human rights perspective. Moreover, human rights are not absolute. Human rights should be ‘resistant to trade-offs, but not too resistant’.¹⁰ The enforcement of human rights among themselves is a matter of balancing.¹¹ Clearly, human rights should benefit individuals in their vertical power relation with public authorities – the state and its government. In terms of power, individuals are generally subordinate to governing authorities. Human rights impose obligations on governments, such as all public law. Unlike private law that governs relations among individuals themselves, and deals with their respective obligations and rights. Apart from where public or private law takes effect – that is in, respectively, the relation between the state

Nevertheless, it shows that the traditional knowledge issue may presently be most acute and concrete in respect of its challenges to patent law and the interests of the stake-holders involved.

9. Notions of human rights may have developed in various cultures and religions in various periods of time. They include Confucianism, Hinduism, Judaism, Christianity and Islam. Contemporary human rights law may originate in Western-Europe though. Its legal formation can be traced back to the Treaty of Westphalia (1648) that ended the rivalry between German Protestants and Roman Catholics. The Treaty included provisions that protected both types of believers in the states concerned. Both learned Catholics, such as the Spanish Suarez and Vitoria, and learned Protestants, such as the Dutch Grotius, introduced and concisely formulated essential ideas; such the idea to acknowledge certain overriding rights enjoyed by human beings across religious divides and national borders – international law. They based their ideas primarily in religious texts, such as the Old and New Testament, and thus attributed them to some sort of divine Godly order. Also later thinkers (such as Locke) derived human rights from divinity, but in Locke’s case it was not necessarily God, but ‘nature’. See Ch. Tomuschat, *Human Rights. Between Idealism and Realism* (Oxford, Oxford University Press, 2003), 6–23. On shared human rights notions among religions and cultures, see the contributions in M.J. Janis, C. Evans (eds), *Religion and International Law* (The Hague, Brill, 2004). It is emphasized that many controversies exist about human rights and human rights notions, among other things with regard to their pre-eminent status, their relation to morality and their universality. For purposes of this paragraph, these controversies are not elaborated. See e.g. Tomuschat, *ibid.*, 58; A. Heard, ‘Human Rights: Chimeras in Sheep’s Clothing?’ (working paper 1997), 1–19, at: <www.sfu.ca/~aheard/intro.html>; P.R. Baehr, ‘Universaliteit van Mensenrechten: Is Het, Kan Het, Moet Het?’ in *Grenzen aan Mensenrechten*, N.J.H. Huls (ed.) (Leiden, NCJM Boekerij, 1995), 45–56.
10. J. Griffin, ‘First Steps in an Account of Human Rights’ (2001) 9/3 *European Journal of Philosophy*, 306 et seq.
11. They are balanced according to the interests involved in concrete situations and pursuant to the importance attached to the one or the other right: M. Cranston, ‘Human rights, Real and Supposed’ in *Political Theory and the Rights of Man*, D.D. Raphael (ed.) (London, Macmillan, 1973), 43–52.

and the individual and among individuals – a profound difference between these bodies of law pertains to what they take effect for as well. Public law generally protects public and collective interests, whilst private law governs private and individual interests.¹² The origins, interests, and ways of public and private law are entirely different. The same necessarily applies to their terminologies.¹³

However, the so depicted principal distinction between public and private law may be less clear-cut than it appears. The collective ultimately is the sum of its parts – individuals. Through the protection of public interests, public law obviously also protects private ones. Conversely, private law also protects public interests, because it regulates relations among individuals in their private – commercial or other – endeavours. This intermingling of domains, and the underlying interests, is particularly evident in respect of the topic of this article, which ultimately deals with the manner in which human rights law (that is, public law) and patent law (or private law) apply to and affect similar interests. Because of the superiority generally attached to human rights law, it may be comprehensible that the interaction is not entirely mutual, but generally involves the insertion of the former laws – values and terminologies – into realms of private law.¹⁴ Hence, it should be

12. This shows from the ways of their effectuation and enforcement. The enforcement of private law is left to the discretion of the individual, whilst public law should be given hand and feet by virtue of the exclusive competencies and duties of the state. Although individuals must enforce their human rights *vis á vis* the state, only the state can provide for means to empower the individual to that extent, whilst it is itself forced to do so by yet again other states – the international community. A. Cassese, *International Law* (Oxford, Oxford University Press, 2004), 3–65; 229–244.
13. On the distinction between and characteristics of public and private law, which was first made in Roman law and is still commonly adhered to, see e.g. O.O. Cherednychenko, *Contract Law and the Protection of the Weaker Party* (Munich, Sellier, 2007), 23–32; D. Friedmann, D. Barak-Erez, ‘Introduction’ in *Human Rights in Private Law*, D. Friedmann, D. Barak-Erez (eds) (Antwerp, Intersentia, 2002), 1.
14. This process is generally referred to as the ‘constitutionalization of private law’ and is invoked by, among other things, new socio-economic and political challenges, including the alteration of modes of power attribution, thus changes in the formation of power relations. This includes those relations among individuals, states, international organizations and multinational corporations. The past decades show an increasing awareness of and appreciation for human rights concepts. They are fashionable, and sometimes it seems as if we expect them to safeguard any interest or even to solve every problem encountered. In respect of the manner in which human rights may be applicable and invoked in horizontal relations, four models are distinguished: The direct application model (mingling public and private law), the non-application model (entirely separating these bodies of law), the indirect application model (legislatively aligning private with public law, and using the latter as overall reference) and the judiciary model (court assessment to and application of public law in private law cases). See A. Barak, ‘Constitutional Human Rights and Private Law’ in *Human Rights in Private Law*, D. Friedmann, D. Barak-Erez (eds) (Antwerp, Intersentia, 2002), 13–42. With regard to the respective rights, one may observe a tendency of invocation of human rights in horizontal relations between individuals as well. Nevertheless, it seems clear that human rights may not be invoked as directly and unequivocally among individuals as against their states though. States remain the primary subjects of human rights law, and to the benefit of their constituents. No matter how important, this topic falls beyond the scope of this article, and is thus not extensively addressed. See *generally* Cherednychenko, *ibid.*, 3–10, 21–54; Tomuschat, *ibid.*, 320; Friedmann, Barak-Erez, *ibid.*, 3–4. In relation to the interests and rights that pertain to traditional knowledge, see para. VIII.B.4. below.

acknowledged that the dogmatic separation between public and private law may not be so strict in reality.

II.B DEVELOPMENT AND SYSTEM

The Universal Declaration of Human Rights (UDHR), promulgated in 1948 by the United Nations (UN) in direct reaction to the atrocities of the Second World War, is the prime and foremost human rights law instrument. The UDHR is a mere recommendation by the General Assembly of the UN. Therefore, it is not legally binding. However, it has served as the substantive template for all subsequently concluded – legally binding – human rights instruments.¹⁵ Article 1 contains the ideological and normative heart of all human rights: ‘All human beings are born free and equal in dignity and rights. They are endowed with reason and conscience and should act towards one another in a spirit of brotherhood’. Thereafter, the types of rights acknowledged may be distinguished, and respectively pertain to the fundamental freedoms (Articles 3 to 20), and the social, economic and cultural rights (Articles 22 to 27). The former are considered to entail the first generation, whereas the latter are deemed the second generation, of human rights. The clarity, practicality and concreteness of the rights declines the further one reads the UDHR. Reading the UDHR, one will also notice that the first articles are formulated in more absolute terms than the ones to follow, which generally seem to be more effort-oriented, and thus less unequivocally demanding to states.¹⁶

The commencement of the Cold War in the second half of the twentieth century, and the deep rivalry between communist and capitalist ideology, hampered the uniform development of human rights law on the basis of the UDHR. It was, however, advanced in Western Europe, united in the Council of Europe. The Council concluded the Convention for the Protection of Human Rights and Fundamental Freedoms (1950) (ECHR), which builds upon the UDHR.¹⁷ The ideological differences between the East and the West led to a divergent supra-regional implementation of the UDHR some time later. It was implemented in two instruments. The International Covenant of Civil and Political Rights (1966) (ICCPR) obliges states to refrain from interference with certain individual liberties, as suited the ideology

15. UDHR: UN General Assembly Resolution 217 A (III), 10 December 1948. In fact, the UDHR is often referred to as the ‘law of the United Nations’. Canadian HIV/AIDS Legal Network & AIDS Law Project, *TRIPS and Rights: International Human Rights Law, and the Interpretation of the WTO Agreement on Trade Related Aspects of Intellectual Property Rights* (2001), 8–9. At <www.aidslaw.ca>. The so-called core body of human rights treaties – also referred to as the Bill of Rights – and the subsequently developed overall regime of human rights law is available at <www2.ohchr.org/english/law/>.

16. One and other may be exemplified by Art. 28 of the UDHR, which provides a right to a sort of ‘utopia of heaven-like quality’ when it promulgates that ‘everyone is entitled to a social and international order in which the rights and freedoms set forth in this Declaration can be fully realized’. Tomuschat, *ibid.*, 29.

17. Cassese, *ibid.*, 354. See for the convention text: <<http://conventions.coe.int/treaty/en/treaties/html/005.htm>>.

of the West. It so mostly contains 'negative rights' that align with Articles 3 to 20 UDHR. The International Covenant on Economic, Social and Cultural Rights (1966) (ICESCR) obliges states to provide their constituents with certain living conditions – housing, education and so forth – and corresponded with the ideology of the East. It primarily contains 'positive rights', which align with Articles 22 to 27 UDHR.¹⁸ The ICCPR and ICESCR are part of a group of nine human rights treaties, which form the predominant body of human rights law.

However, since the second half of the twentieth century, an acceleration of the acknowledgment and specification of human rights in a host of binding and non-binding instruments (such as recommendations, declarations, guidelines and the like) is taking place. Human rights law extends into ever more diverse directions, applies to an increasing number of interests, and to the benefit of increasingly distinctively recognized groups of peoples. Hence, human rights instruments were particularly concluded in respect of the interests of indigenous peoples and minorities, migrants, women, children, older persons, and, particularly, in respect of issues such as discrimination, marriage, war and so forth.¹⁹ This proliferation actually led to what has been coined the third generation of human rights. These include the right to a clean environment and the right to development.²⁰ Proliferation of human rights does not necessarily mean that the rights so acknowledged may be easily enforceable. Hence, the enforceability of many of the human rights promulgated in the past decades, including environmental and minority ones, is rather problematic.²¹

II.C AUTHORITY AND REACH

It was already mentioned that human rights law is the backbone of the international legal order. Hence, human rights law ultimately enjoy supremacy over private law,

18. Stanford Encyclopedia of Philosophy, *Human Rights* (last revised on 29 July 2006) para. 5.1. at <<http://plato.stanford.edu/entries/rights-human/>>; Tomuschat, *ibid.*, 24–32.

19. The proliferation of human rights allegedly leads to inflation. For a critical account, see e.g. P. Cliteur, 'De Dreigende Proliferatie van de Mensenrechten' in *Grenzen aan Mensenrechten*, N.J.H. Huls (ed.) (Leiden, NJCM Boekerij, 1995), 7–32.

20. In respect of the right to a clean environment, see the Declaration adopted UN Conference on the Human Environment, 1972 (General Assembly Resolution 45/94, 14 December 1990): 'Man has the fundamental right to freedom, equality and adequate conditions of life, in an environment of a quality that permits a life of dignity and well-being.' It should be noted though, that this right was not implemented in later declarations, such as the Rio Declaration on Environment and Development (14 June 1992), and in the Convention on Biological Diversity (1993) (CBD), available at: <www.cbd.int/convention/convention.shtml>. For the right to development see General Assembly Resolution 41/128 of 4 December 1984: 'The right to development is an inalienable human right by virtue of which every human person and all peoples are entitled to participate in, contribute to, and enjoy economic, social, cultural and political development, in which all human rights and fundamental freedoms can be fully realized' See Tomuschat, *ibid.*, 48 et seq.; Stanford Encyclopedia of Philosophy, *ibid.*, para. 3.4. Particularly on the third generation of human rights, also called solidarity rights, see Cliteur, *ibid.*, 14.

21. Tomuschat, *ibid.*, 37–41; 46–51.

and the rights that may be conceived of within the latter body of law.²² As can already be derived from the aforementioned discussion of the ‘constitutionalization of private law’, this superiority does not necessarily imply that they can replace private law norms though.²³

Moreover, although human rights law has a superior legal status, which certainly overrides national jurisdiction and competency, its effectuation often depends on implementation by states. Human rights law depends on its integration into domestic law, and therefore on the cooperation by governments. Particularly for the need to balance powers among sovereign states, this implies in practice that governments have quite some margin of freedom in this regard. The fact that there are only a few centralized international bodies that enjoy exclusive competency as to the enforcement of human rights (law), tones down their actual reach, when compared to their high authority.²⁴ This applies to all types of human rights.²⁵ Particularly regional human rights instruments, such as the ECHR, may reach further in state-practice though, given the fact that they are often interlinked with advanced implementation, supervisory mechanism and judicial bodies. Particularly, the ECHR, and its European Court of Human Rights is considered to be very advanced and effective.²⁶

It is, furthermore, noted that the degree of enforceability of human rights is mostly determined by their conciseness. Hence, the clearer the duties are defined, the harder the law concerned and the stronger the rights conveyed. This pertains to

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22. Arts 55 and 56 of the UN Charter oblige Member States to take action and achieve – among other things – observance of human rights, whilst Art. 103 of the Charter provides that: ‘In the event of a conflict between the obligations of the Members of the United Nations under the present Charter and their obligations under any other international agreement, their obligation under the present Charter shall prevail’. This is also acknowledged in Art. 30(1) of the Vienna Convention on the Law of Treaties (1969), at: <http://untreaty.un.org/ilc/texts/instruments/english/conventions/1_1_1969.pdf>. States have acknowledged this position at numerous occasions thereafter, most notably in a host of international treaties and Declarations. See e.g. Canadian HIV/AIDS Legal Network & AIDS Law Project, *ibid.*, 30–41.
23. E.g. Cherednychenko, *ibid.*, 57–60.
24. Cassese, *ibid.*, 5–12; 166 et seq.; 212 et seq.
25. Some human rights may even enjoy ultimate authority within the international legal order. They may operate *erga omnes*. As such they are not merely imposable among states: Their implementation is integrally owed to the international community as a whole. They may, furthermore, be considered peremptory norms that contain inherent normative authority and value. As such no state can dispose of them at will. They belong to *jus cogens*. This may be concluded pursuant to holdings of the International Court of Justice, the practise of international criminal tribunals, and repeated state practice, i.e. that of their national courts. F. Francioni, *Genetic Resources, Biotechnology and Human Rights: The International Framework* (Florence, EUI Working Paper Law 17, 2006), 11–12. It is not entirely sure which human rights have reached that status though. Moreover, the effect of *jus cogens* is ambiguous. Will any implication of *jus cogens* immediately annul or modify the inconsistent (inter)national law? Has *jus cogens* authority to states only, or does it also apply to supra- and intergovernmental organizations (or institutions) such as the WTO, the EU and the European Patent Organization? How should they be invoked? G. Marceau, ‘WTO Dispute Settlement and Human Rights’ (2002) 4/3 *European Journal of International Law*, 67–70. At <www.ejil.org/journal/Vol13/No4/art1.pdf>.
26. Cassese, *ibid.*, 366.

their substance, possible restrictions, the holders (such as a group or individual), addressees (a state, for example) and types of implementation of the duties concerned. Overall one may observe that aforementioned negatively stated rights – for example in the ICCPR – are more compulsive than the positively formulated rights – such as in the ICESCR. Hence, many of the latter rights are not clearly and unambiguously interpretable, and provide for effort-oriented duties to states, for example to facilitate (access to) education, food and health. They are progressively formulated. Also, often the possible restrictions and types of implementation required are less clearly delineated when compared to the negative rights. Objections to giving these rights the same status relate to the fact that their implementation may be more or less feasible in developing countries and to the perception that they serve to enhance principal or secondary interests, the latter of which are not of the highest importance.²⁷ Whereas the ICCPR must be respected and enforceable per se and at all times, and the ICESCR merely calls upon states to make their best effort and expeditiously and effectively strive for the realization of the rights it sets forth, the UN considers both instruments of equal importance.²⁸ They are thus very authoritative. Relevant provisions of both instruments, and the ECHR as well, will be explored in relation to the topic at hand. However, prior to inquiring the human rights implications of patenting biotechnological inventions, it is worthwhile to focus on the basics and workings of European patent law.

III. EUROPEAN PATENT LAW

III.A CHARACTER AND RATIONALE

Patent law and human rights law developed independently, as was mentioned before. Obviously, this relates to the circumstances under, and reasons for, which these bodies of law formed over time. Unlike human rights law, patent law is generally not regarded to be rooted in morality, but in economic instrumentality. Human rights law clearly has a mere deontological justification, whilst the patent regime is simply justified by pointing at the positive consequences it brings about. It has consequentialist justifications.²⁹ The main one would be society's interest in the continuous attainment of all sorts of useful technological products and processes – in the field of medicine and healthcare, for example.

Underlying presumption is that it is neither easy nor cheap to invent. Hence, the initial deliverance of inventions is burdensome, and requires considerable investment. However, once they have been attained, the cost of reproduction for competitors is low – enabling them to free-ride on the efforts undertaken by the

27. Cranston, *ibid.*, 43–53. Stanford Encyclopedea of Philosophy, *ibid.*, para. 4.

28. Committee on Economic, Social and Cultural Rights, General comment 3, *The nature of States parties obligations* (UN doc. 14/12/90, 5th session 1990), at para. 9.

29. L.R. Helfer, 'Toward a Human Rights Framework for Intellectual Property' (2007) 40 *U.C. Davis Law Review*, 980.

initial inventor. The self-interested competitive market participant would want to minimize costs, and so not invest in R&D, but instead rely on others to do so and to make their invention public. Inventors could so be confronted with the situation that others reap what they have sown, which would cause them not to invest in R&D or not make their inventions public if they do so instead. Society would so lack knowledge of and insight into the state of technology and would miss out on all sorts of beneficial products and processes.³⁰ Supposedly, this is particularly the case with biotechnology, such as used to develop pharmaceuticals, since R&D is considered extremely expensive and risky in this field, whilst free-riding through reverse-engineering is rather simple and often incurs only a fraction of the costs made by the inventor. This would give the inventor/investor too little time to recoup the investments made, let alone make a little profit, absent a means to keep others from grabbing their invention.³¹ Patent law thus redirects this situation, by granting inventors a periodic property rights over their inventions, enabling them to exclusively commercialize them and earn back their R&D costs. Patent law so provides an incentive to invent and an incentive to disclose the outcomes of R&D. The initial inefficiency at the invention level is so replaced by an inefficiency at the production level – in economic terms, a monopoly for a certain period of time.³² Clearly, patent law provides a means to prevent unbeneficial, ‘abusive’ conduct – free-riding – by competitors, instead of equipping individuals and groups with rights to safeguard them from abusive behaviour by states. Patentees invoke their rights *vis-à-vis* infringers of their patents, thus in the horizontal relationship among actors in their private capacity, in contrast to human rights that are applicable in vertical power relations, and which should so in principal be invoked against states in their public capacity.

Throughout times claims have been made that the conveyance of exclusive rights to inventors is not merely economically wise, but fair too. Hence, in 1593,

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30. This is called the appropriability problem, which results in the under-accumulation of technology. See e.g. K.W. Dam, ‘The economic underpinnings of patent law’ *Journal of Legal Studies* (1994) 13/1, 247 et seq. and M. Lehmann, ‘Property and intellectual property – Property rights as restrictions on competition in furtherance of competition’ *International review of industrial property and copyright law* (1989) 20, 1 et seq. The appropriation function is one of the four generally accepted functions of property law. The other ones are the adjustive function, the planning function and the self-defence function – only the latter of which is directly relevant for the topic of this article, because property (i.e. intellectual properties) then serves ‘as a kind of self-defence mechanism for a group struggling to preserve its ways’ P. Drahos, *A Philosophy of Intellectual Property* (Aldershot, Ashgate, 1996), 125–130. It will show that this function, which goes hand in hand with the appropriate function of property, is predominantly relevant to traditional knowledge holders.
31. W. Cornish, D. Llewelyn, *Intellectual Property: Patents, Copyrights, Trademarks and Allied Rights* (London, Sweet & Maxwell, 2003), 826. The most commonly calculated cost for the development of a pharmaceutical invention amounts to about EUR 600 million. See e.g. Biotechnology Industry Organization, *Guide to biotechnology 2007* (Washington D.C., USA, 2007), 42; J.A. DiMassi, ‘The price of innovation: New estimates of drug development costs’ *Journal of Health Economics* (2003) 22, 166.
32. Dam, *ibid.*; Lehmann, *ibid.*. Extensively: R.A. Posner, *Economic analysis of law* (New York, Aspen Publishers, 1998).

Galileo Galilei requested the Republic of Venice to grant him a patent because ‘it does not suit me that the invention, which is my property and was created by me . . . should become the property of anyone’³³ This view was also embodied in the French patent statute of 1791, in which the first section provided among others that ‘new discoveries are the property of the author’ The ethicality of providing exclusive proprietary rights to inventors may be argued on the basis of legal philosophy as well. Particularly, Lockean and Hegelian views may bolster such claims. This may even result in claims that the possibility of acquiring patents may amount up to a human right.³⁴ These claims may appeal to many, particularly potential right holders. Nevertheless, it is generally acceded that they do not form the primary rationale for patent law.³⁵ However, whereas patent law may not find its prime justification in morality like human rights law does, it cannot be regarded as entirely neutral to morality either. ‘[P]roperty rules . . . are rooted in the fundamental morality of a given society’.³⁶ This also shows from the way patent law developed and from its contemporary system.

III.B DEVELOPMENT AND SYSTEM

The first statutory traces of a patent statute can be found in the late fifteenth century in the Republic of Venice.³⁷ In order to attract inventors to the Republic, the Venetian Senate Act of 1474 conveyed exclusive rights to their useful products for a period of ten years.³⁸ This statute already revealed the economic rationale discussed above, and was to a more or less extent the blueprint for many of the patent statutes legislated in many European states and their colonies, including the

33. P. Kurz, *Weltgeschichte des Erfindungsschutzes* (Munich, Carl Heymanns Verlag, KG, 2000), 65–70.

34. This issue is extensively addressed in para. VIII.B. below. The philosopher Nozick may be the most fierce proponent of a human right to private property, which he – briefly reiterated – finds the one and only human right in the initial ‘state of nature’. See R. Nozick, *Anarchy, State and Utopia* (London, Blackwell Publishing, 2001). A discussion of views pro- and contra a human right to property in general is set forth in e.g. J. Waldron, *The Right to Private Property* (Oxford, Clarendon Press, 1988). Waldron himself concludes that there should be no human right to private property. An intermediate opinion can be found in Th.R.G. Banning, *The Human right to property* (Antwerpen, Intersentia, 2002). After having discussed and analyzed the historical legislative processes and considerations in respect of human rights pertaining to property Banning concludes that there is a human right to property, albeit in close connection and balance with other human rights only.

35. K. Yelapaala, ‘Owning the secret of life: Biotechnology and property rights revisited’ (2000) 32 *McGeorge L. Rev.*, 111–203; Drahos (1996), *ibid.*, 50–53, 89–90.

36. Drahos (1996), *ibid.*, 15.

37. The concept may have been embraced before such time by the Sybarites (in the third century A.C.). J. Brinkhof, ‘Over Octrooirecht en Economie’ (1990) *Ars Aequi*, 193. It may also be traced back to the fourth century B.C. – to Aristotle, which refers to it in his work *Politics*. B. Bugbee, *The Genesis of American patent and Copyright Law* (Washington D.C., Public Affairs Press, 1967), 166.

38. Brinkhof (1990), *ibid.*

North-American ones, in the centuries thereafter.³⁹ These statutes contained, however, a variety of differences. They commenced to be harmonized upon industrialization in the nineteenth century. The Paris Industrial Property Union was concluded in 1883 and the predecessor of WIPO – *Bureau International des Unions pour la Protection de la Propriété Intellectuelle* – was instituted.⁴⁰ Protectionism among the patent states started to transform into a more liberal, international outlook on trade and knowledge exchange.⁴¹ On the international stage, the conclusion of the substantive patent law conventions of Strasbourg (1963) and the European Patent Convention (1973) comprised major steps forward.⁴² The EPC allows for the filing of a single patent application at the European Patent Office (EPO), and subsequent examination and conveyance thereof for all designated Member States. The EPO has an appeal system, which ultimately leads up to the Enlarged Board of Appeal. Patents should be nationally enforced upon infringers though.⁴³ Nevertheless, many national courts tend to adhere to the decisions of the EPO. Whereas the requirements for and exceptions from patentability of the EPC Member States are already to a large extent uniform, the EPC has thus a further harmonizing effect.⁴⁴

The EPC has partially determined the scenery of the contemporary global patent landscape too.⁴⁵ Patent law truly became part of the international legal framework upon the conclusion of the Agreement on Trade Related Aspects of Intellectual Property Rights (1994).⁴⁶ With the conclusion of TRIPS, governments

39. Kurz, *ibid.*, 18–396 (and specifically 295).

40. The Paris Convention is available at <www.wipo.int/treaties/en/index.html> The Paris Convention so set different novelty standards for patentability, lengths of patent validity, treatment of foreign patent applicants and so forth, as to take away some of national statutory differences.

41. Kurz, *ibid.*, 467–484.

42. The Strasbourg Patent Convention provided harmonized patentability requirements. It was ratified by thirteen European countries. At: <www.wipo.int/treaties/en/index.html> The Convention on the Grant of European Patents (1973) (EPC) provided for an additional patent granting system – in addition to the ones provided on the national state level. It built to a large extent on the Strasbourg Patent Convention. The so-called EPC 2000 Revisions took effect on 13 December 2007, and references to the EPC are made to the so applicable revised version. At: <[http://documents.epo.org/projects/babylon/eponet.nsf/0/E4F8409B2A99862FC125736B00374CEC/\\$File/EPC_13th_edition.pdf](http://documents.epo.org/projects/babylon/eponet.nsf/0/E4F8409B2A99862FC125736B00374CEC/$File/EPC_13th_edition.pdf)>.

43. It is noted that one cannot actually refer to one European patent law, since an EPC patent comprises a bundle of national patents. See Art.s 2(2) and 64(1) EPC. The requirements for patentability are set forth in the EPC, and some of the effects of conveyed patents too. Others may, however, be determined by national patent statutes.

44. Cornish, Llewelyn, *ibid.*, 121–130.

45. Idris, *ibid.*, 7–75; D. Matthews, *Globalising intellectual property rights* (London, Routledge, 2002), 35; D. Gervais, *The TRIPS agreement: Drafting history and analysis* (London, Sweet & Maxwell, 1998), 15. In a broader context that encounters, so to say, notions of culture and power, see Drahos (1996), *ibid.*, 13–118.

46. Agreement on Trade Related Aspects of Intellectual Property Rights (1994) (TRIPS): Marrakesh Agreement Establishing the World Trade Organization, Annex 1 C, Legal Instruments – Results of the Uruguay Round, available at <www.wto.org/english/docs_e/legal_e/final_e.htm>.

made clear that intellectual property law is predominantly trade-related.⁴⁷ For that purpose, TRIPS provides minimum standards for acquisition and enforcement of intellectual property rights.⁴⁸ The preamble confirms that ‘intellectual property rights are private rights’. TRIPS globalized intellectual property law regimes because they were inserted into the global regulative framework administered by the World Trade Organization (WTO). Globalization of the market economy requires global ‘defining and protecting [of] property rights; setting rules for exchanging those rights, establishing rules for entry into and exit out of productive activities; and promoting competition by overseeing market structure and behaviour and correcting market failures’.⁴⁹ The TRIPS does all this for intellectual property. It has extended a specific manner of conveyance of proprietary rights to inventions to about the entire world, that is, Member States of the WTO.⁵⁰

III.C AUTHORITY AND REACH

III.C.1 TRIPS

Within the international legal framework, the WTO agreements are unequivocally subordinated to the core body of human rights law.⁵¹ The WTO is not a member of the UN or its treaties though. Moreover, dispute panels and bodies have limited jurisdiction, which does not entail the assessment of human rights violations as

47. The Preamble of TRIPS makes this very clear when it sets forth that the goal is ‘to reduce distortions and impediments to international trade, and taking into account the need to promote effective and adequate protection of intellectual property rights, and to ensure that measures and procedures to enforce intellectual property rights do not themselves become barriers to legitimate trade’. At: <www.wto.org/english/tratop_e/TRIPS_e/t_agm1_e.htm>.

48. Including patents (Art. 27 TRIPS et seq.).

49. S. Flanders (ed.), *From plan to market: world development report 1996* (Oxford, Oxford University Press, 1996), 80, 88–109. The neo-liberal policies that feed this framework necessarily lead to an emphasis on the economic side of things. This approach roots in the belief that problems in non-economic domains – such as political, social, cultural and environmental domains – will only be solved upon economic development. See e.g. D. Held, A. McGrew, *The global transformations reader: an introduction to the globalization Debate* (Cambridge, Polity, 2003), 299–420.

50. Matthews, *ibid.* The WTO resides over more than 140 treaties in a variety of fields, including labour, finance and, as indicated, intellectual property. All of these treaties are interlinked with the two main WTO agreements, respectively the General Agreement on Tariffs and Trade (GATT) and the General Agreement on Trade in Services (GATS). See <www.wto.org/english/tratop_e/gatt_e/gatt_e.htm> and <www.wto.org/english/tratop_e/serv_e/serv_e.htm>. Moreover, the WTO Dispute Settlement Mechanism is incorporated and applicable to disputes arising out of the implementation of TRIPS (Arts 63 and 64 TRIPS). For the mechanism and decisions of the Dispute Settlement Body see <www.wto.org/english/tratop_e/dispu_e/dispu_e.htm>.

51. Reference is made once again to Art. 103 of the UN Charter that provides that: ‘In the event of a conflict between the obligations of the Members of the United Nations under the present Charter and their obligations under any other international agreement, their obligation under the present Charter shall prevail’. See previous para. II.

such. The jurisdiction and competency are defined pursuant to the WTO agreements, and contain specific rights and obligations, specific remedies and procedures. The restricted jurisdiction of the WTO Dispute Settlement System is countered by the fact that, according to many, WTO provisions cannot be overruled by situations and considerations belonging to another subsystem.⁵²

Compared to the authority of human rights law, the authority of TRIPS is limited. Nevertheless, its practical reach may be much greater than that of human rights law. Within the multilateral trading system, TRIPS is very authoritative. It is one of the constitutive agreements of the WTO.⁵³ Moreover, TRIPS has an extensive substantive reach. The minimum standards for protection and enforcement of intellectual property stipulated, combined with the trade sanctions that may be imposed for non-compliance, prevent too much resistance or deviation.⁵⁴

TRIPS takes account of interests that are not directly related to the acquisition and enforcement of intellectual property rights as well. Articles 7 and 8 acknowledge the interests of users of, for example, patented inventions and of protection and pursuance of public and social interests.⁵⁵ These provisions have been furthered in the main body of TRIPS too, resulting in a number of flexibilities and

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52. However, it some propose that if trade-related instruments and measures contain 'human rights elements', they may be adjudicated by the WTO bodies. Moreover, it is suggested that the WTO institutions should pursue to try and read their agreements – and thus state obligations and compliance – as to prevent any conflict with human rights law, or at least the portion of it that is *jus cogens*. Marceau, *ibid.*, 14, 22, 40–59, 73, 83 et seq. Also: F. Schorkopf, Ch. Walter, 'Elements of Constitutionalization: Multilevel Structures of Human Rights Protection in General International and WTO-Law' (2003) 12 *German Law Journal*, 1359–1374. Moreover, Art. XX of the GATT provides some general exceptions that may give the WTO panels and bodies leeway in respect of human rights issues. They pertain to the protection of, for example public morals; human, animal or plant life or health; national treasures of artistic, historic or archaeological value; and the conservation of exhaustible natural resources. Respectively clauses (a), (b), (f) and (g). At: <www.wto.org/english/docs_e/legal_e/gatt47_02_e.htm#Art.XX>. Some of these have also been incorporated in TRIPS, further discussed below.
53. Accession to TRIPS is a pre-requisite to membership of the WTO, which in turn is necessary to participate in the global market economy. Hence, it is practically impossible for any country in the world not to refrain from acceding to TRIPS. See *generally* on the workings of one and other WTO, *Understanding the World Trade Organization* (WTO, Geneva, 2007), 24 et seq. At: <www.wto.org/english/thewto_e/whatis_e/whatis_e.htm>.
54. WTO (2007), *ibid.*, 58–59.
55. Art. 7 stipulates that '[t]he protection and enforcement of intellectual property rights should contribute to the promotion of technological innovation and to the transfer and dissemination of technology, to the mutual advantage of producers and users of technological knowledge and in a manner conducive to social and economic welfare, and to a balance of rights and obligations'. Art. 8 (1) provides that 'Members may, in formulating or amending their laws and regulations, adopt measures necessary to protect public health and nutrition, and to promote the public interest in sectors of vital importance to their socio-economic and technological development, provided that such measures are consistent with the provisions of this Agreement', whilst clause (2) states that 'Appropriate measures, provided that they are consistent with the provisions of this Agreement, may be needed to prevent the abuse of intellectual property rights by right holders or the resort to practices which unreasonably restrain trade or adversely affect the international transfer of technology'.

exceptions.⁵⁶ Nevertheless, it can hardly be contested that TRIPS has effectively globalized intellectual property laws. Given the fact that the prescribed areas of intellectual property are so diverse – spanning all fields of intellectual property – TRIPS reaches not only beyond national and regional boundaries, but also spans many – if not most – areas of intellectual activity.⁵⁷ Said flexibilities within TRIPS do not significantly mitigate such, because they are deemed to be interpreted narrowly.⁵⁸

III.C.2 EPC

Alike the WTO, the European Patent Organization is neither a party to the UN nor to its treaties. It is not a member to any supranational organization, such as the EU or the WTO, and did it contract into any other convention such as the ECHR. The Preamble of the EPC does not mention human rights.⁵⁹ Of course the founding states of the European Patent Organization are bound by human rights law, but this does not reflect upon the latter institution. Moreover, their subjection to international adjudicating bodies, such as the European Court for Human Rights or WTO dispute panels and bodies, does not implicate the European Patent Organization either.⁶⁰

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56. TRIPS provides explicit exceptions to these standards for conveyance of patents. They relate to Art. XX GATT and pertain to 'ordre public' and morality and plants and animals; essentially biological processes for their production; and certain methods in medicine, including diagnostic ones. Art. 27(2) and (3) TRIPS. Exceptions to the rights of patentees may also be incorporated in national states, which may e.g. provide for a compulsory licensing mechanism. Arts 30 and 31 TRIPS. It, furthermore, provides a minimum framework for competition regulation, as to rebut anti-competitive practices by right holders and other market participants. Art. 40 TRIPS. Last, TRIPS includes transitional arrangements that delay the moment of imposition on developing and least-developed countries. Arts 65 and 66 TRIPS.
57. See e.g. Ch. May, *A Global Political Economy of Intellectual Property Rights. The New Enclosures?* (London, Routledge, 2002), 67–90; Matthews, *ibid.*, 108–122.
58. E.g., Gr. Dutfield, *Intellectual Property and the Life Science Industries. A Twentieth Century History* (Aldershot, Ashgate, 2003), 67 et seq. This is acknowledged by the TRIPS Council, which addresses the needs of diverse states and regions in this respect – for example as to public health, in the course of the Doha Development Agenda, which is not further addressed here. See: <www.wto.org/english/tratop_e/dda_e/dda_e.htm>. Of course, economic differences and dependencies among countries and the interconnection of TRIPS with a host of other trade-related topics and regulations, ultimately determine the freedoms and flexibilities of Member States in implementation. And then again, states frequently abuse their economic powers to further restrict the freedoms and flexibilities of weaker countries, for example by bilateral conclusion of so-called TRIPS-plus agreements. See e.g. <www.bilaterals.org/>.
59. The EPC is a special agreement pursuant to Art. 19 of the Paris Convention. Art. 19 of the Paris Convention provides: 'that the countries of the Union reserve the right to make separately between themselves special agreements for the protection of industrial property, in so far as these agreements do not contravene the provisions of this Convention'. The Paris Convention does not refer to human rights either though.
60. The EPO acknowledges this. See e.g. Cases G0002/02 and G0002/03, 26 April 2004 (*Priorities from India/ASTRAZENECA*): 'The European Patent Organisation as a public international organisation has an internal legal system of its own... The EPC provides an autonomous

Nevertheless, the EPO itself has stated at numerous occasions that it pursues to respect human rights.⁶¹ Moreover, it considers itself substantively bound by the Vienna Convention on the Law of Treaties, although it is not a party thereto.⁶² The EPO may, however, not easily give effect to its spontaneous submission to human rights law. The only provision in the EPC that may allow for consideration of the underlying interests and rights is Article 53(a) EPC that excludes inventions ‘whereof the commercial exploitation of which would be contrary to “ordre public” or morality’ from patentability.⁶³

The authority of the EPC itself is necessarily limited territorially, by and among its regional Member States.⁶⁴ The same necessarily applies to the patents conveyed. These are in fact national patents.⁶⁵ The substantive reach of this patent

legal system for the granting of European patents. In legal terms, neither the legislation of the Contracting States nor the international conventions signed by them are part of this autonomous legal system. Within the framework of the system established by the EPC, legislative power rests with the Contracting States alone and is exercised by either an inter-governmental conference . . . or the Administrative Council . . . The EPO is not itself party to the WTO and the TRIPS Agreement. Thus, the obligations deriving from the TRIPS Agreement do not bind the EPO directly but only such Contracting States of the EPC as are Members of the WTO and the TRIPS Agreement’ At 8.3. of the Reasons. This has been confirmed by the European Court of Human Rights as well. See collectively Case No. 38817/97, 9 September 1999 (*Lenzing v. United Kingdom*); Case No. 39025/97, 9 September 1999 (*Lenzing v. Germany*); Case No. 21090/92, 10 January 1994 (*Heinz v. the Contracting States party to the European Patent Convention insofar as they are High Contracting Parties to the European Convention on Human Rights*); and Case No. 13258/87, 9 February 1990 (*M v. Germany*). From these decisions it may be derived that the adjudicating bodies under the ECHR have no jurisdiction if a disputed decision is an independent one of an international organization that is not a party to the ECHR itself, since said bodies have no jurisdiction if the international organization is not a party to the ECHR. Of course, contracting parties may be collectively or individually liable for any violation of international organizations, such as the European Patent Organisation, and they may not evade their obligations through the establishment of such organizations. This important issue is not further explored in this article. For an extensive discussion of one and other, see e.g. M. Hirsch, *The Responsibility of International Organizations Toward Third Parties: Some Basic Principles* (Dordrecht, Martinus Nijhoff, 1995). For a reference to a more recent case concerning the European Patent Organization, see H.L. MacQueen, ‘Towards Utopia or Irreconcilable Tensions? Thoughts on Intellectual Property, Human Rights and Competition Law’ (2005) 2/4 *SCRIPT-ed*, 461–462.

61. See e.g. Case D 011/91, 14 September 1994, Headnote 1: ‘The European Convention for the Protection of Human Rights contains provisions which express general principles of law common to the member states of the European Patent Organisation. As such these provisions should be regarded as forming part of the legal system of this Organisation and should be observed by all its departments’.
62. See Case G0005/83, 5 December 1984 (*ESAI*). For the Vienna Convention see previous para. II.
63. This provision aligns with Art. XX(a) GATT, see previous para. III.C.1. and is addressed further below.
64. The region is Europe. The Preamble of the EPC reflects such: ‘The Contracting States, desiring to strengthen co-operation between the *States of Europe* in respect of the protection of inventions’ [Italics added]. Patents conveyed can only take effect in the (designated) Contracting states. See Art. 3 EPC. Currently, the EPO has 32 Member States. See <www.epo.org/about-us/epo/member-states.html#contracting>.
65. Art. 64(1) and (3) EPC.

regime is, however, determined by the application of the requirements for and exceptions from patentability. They delineate what is deemed patentable, and the knowledge incorporated into an invention is of course not bound by the jurisdictional restrictions of the EPC.

‘European patents shall be granted for any inventions, in all fields of technology, provided that they are new, involve an inventive step and are susceptible of industrial application.’⁶⁶ Moreover, ‘[a]n invention shall be considered to be new if it does not form part of the state of the art’, whereas the state of the art consists in everything made available to the public through written or oral description, by use, or in any other way, before the date of filing of the patent application.⁶⁷ Inventions are inventive if they are not obvious in view of the state of the art for the person skilled in that art.⁶⁸ An invention is industrially applicable if ‘it can be made or used in any kind of industry’.⁶⁹ Last, a European patent application must ‘disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art’.⁷⁰ A patent grants the patentee the right to exclude others from commercially using the patented invention during a period of twenty years.⁷¹ Conversely, the EPC contains certain exceptions from patentability. Insofar as relevant for the topic of this article, they include the stipulation that discoveries are not considered to be inventions, and are thus excluded from patentability.⁷² Moreover, European patents are not granted for inventions of which the commercial exploitation would be contrary to ‘ordre public’ or morality; plant or animal varieties or essentially biological processes for the production of plants or animals; and methods for treatment of the human or animal body by surgery or therapy and diagnostic methods practiced on the human or animal body, albeit with the exception of the substances used in these methods.⁷³ The collective application of the requirements and exceptions determines the actual reach of patent law – that is, what kind of knowledge may be exclusively commercialized.

The requirements for patentability are generally applied with leniency. Moreover, the application of the exceptions is restrictive.⁷⁴ This is particularly so when

66. Art. 52 (1) EPC. The requirement of an ‘inventive step’ may be referred to as ‘inventivity’ or ‘non-obviousness’ as well. Art. 52(1) EPC compares to Art. 27(1) TRIPS.

67. Art. 54 (1) and (2) EPC.

68. Art. 56 EPC.

69. Art. 57 EPC.

70. Art. 83 EPC, which compares to Art. 29 TRIPS.

71. Art. 63 (1) and 64 (1) EPC and – with regard to the rights conveyed see e.g. 53 (1) Dutch Patent Act 1995 (DPA); Ch. 9 of the German Patent Law 1998; Section 60 of the UK Patent Act 1977. Compares to Arts 28 and 33 TRIPS.

72. Art. 52(2)(a) EPC. An invention reveals a ‘*Lehre zum planmäßigen zielgerichteten Handeln*’ (‘A teaching for a planned and targeted action’) with ‘*Technizität*’ (‘technicality’). The technicality entails the control of the forces of nature. Discovery conversely only reveals what was already there; it lifts the veil over the existing – nature if you will – without comprising any further technical application. Cornish, Llewelyn (2003), *ibid.*, 208–209. Extensively: R. Kraßer, *Patentrecht. Ein Lehr- und Handbuch* (Munich, Verlag C.H. Beck, 2004), 119–184.

73. Art. 53 (a), (b) and (c) EPC. These provisions compare to Art. 27(2) and (3) TRIPS.

74. The Staff Union of the European Patent Office subscribes this conclusion: SUEPO, *Quality of Examination at the EPO* (Position Paper, cp04009e – ZB/04/04, 18.05.2004, 2004) at:

it concerns biotechnological inventions. Given the costs and risks associated with biotechnological R&D, and societies' wish to stimulate R&D in these areas, this may not be surprising. Throughout the history of any patent law patentable subject matter has always changed. It merely reflects the technological progress that took place.⁷⁵

As of the 1970s, practical applications for biotechnology were found, and inventions attained.⁷⁶ Hence, in that period of time, patent law started to apply to these types of inventions.⁷⁷ The inventions concerned were not considered to be so out of the ordinary that they could not in anyway be accommodated by existing law. For the patentability of some biotechnological inventions, such as genes and proteins, patent offices could for the most part adhere to standing practices pertaining to chemical compounds. Insofar as impossible to do so, legislators paved the way and adjusted or clarified some of the requirements of patentability to suit the particular characteristics of these inventions.⁷⁸ This has led to a flourishing practice to date.⁷⁹

<www.suepo.org/public/>. See also the recent report by the European Technology Assessment Group, *Policy Options for the Improvement of the European Patent System* (Copenhagen, Danish Board of Technology, 2007), 41–42, 51–52.

75. Perhaps it may even be a sign of success of the patent system. Idris, *ibid.*, 106 et seq.
76. The first practical application was a process for genetic modification. See J. Ruttan, *The Role of the Public Sector in Technology Development: Generalizations for General Purpose Technology* (Cambridge, Harvard University, Science, Technology and Innovation Discussion Paper no. 11, 2001), 11.
77. The first patent was conveyed in the USA. See e.g. R. P. Merges, J.F. Duffy, *Patent Law and Policy: Cases and Materials* (Newark, New Jersey, LexisNexis, 2002), 75 et seq. For the first developments in Western Europe – particularly (in the Member States) of the European Patent Convention – see e.g. W. Cornish, D. Llewelyn, *ibid.*, 137 et seq. For an overview see e.g. F-K Beier, R.S. Crespi, R.S., J. Straus, *Biotechnologie und patenschutz. Eine internationale Untersuchung der OECD* (VCH Verlagsgesellschaft, Weinheim, 1985).
78. For particular EU legislation to this extent see e.g. the European biotechnology directive – European Council Directive 98/44/EC, 1998 O.J. (L 213), 13–21 (the directive). At <http://eur-lex.europa.eu/LexUriServ/site/en/oj/1998/l_213/l_21319980730en00130021.pdf>. The directive must be implemented in the patent statutes of EU Member States and does as such not impose obligations on the European Patent Organization, which is an intergovernmental organization of (some) of these states, but is not itself a member of the EU. The directive only provided relatively minor adjustments, amendments and clarifications though. This is acknowledged in Recital 8 of the directive, which indicates that the ‘legal protection of biotechnological inventions does not necessitate the creation of a separate body of law’ but that the rules of national patent law need some adaptation in ‘certain specific respects’. It is important to observe that, whereas the European Patent Organization is not bound by the directive, the main body of the directive was implemented in the EPC anyhow, i.e. through inclusion in the Implementing Regulations. This was done pursuant to a decision of the Administrative Council of the EPO on 16 June 1999. OJ EPO (8, 9), 1999, 545–587. See rules 26–34 of the Implementing Regulations. It is noted that the Administrative Council is of course not a democratically constituted legislator.
79. Every year, more patents to biotechnological inventions are granted. It runs into the thousands every year. OECD, JPO, EPO, *Compendium of Patent Statistics 2007*, 22, 33. Patentable biotechnological inventions are among other things: Genes, partial DNA sequences, EST-s, SNP-s, promoters and enhancers, proteins, vectors, micro-organisms, cells, plant, animals,

To conclude this paragraph on patent law, it is noted that patent law, alike human rights law, was proliferated in the second half of the twentieth century.⁸⁰ Both the factual territorial (TRIPs) and substantive expansion – widening of patentable subject matter – of this regime’s reach, have given rise to controversy. The ‘global property epoch’ that we may have entered does not please everybody.⁸¹ It may result in an excessive proprietary enclosure, particularly also in the life sciences. This enclosure, which may have contributed to the perceived conflicts between patent law and human rights law, is discussed in the next paragraph.

IV. PROPRIETARY ENCLOSURE IN THE LIFE SCIENCES

Through the lenient and/or marginal application of the requirements for and exceptions from patentability, the EPO boosts the appropriation function of the patent regime (property). Supposedly, excessive power is conveyed to patentees.⁸² The pretext for conceiving of an enclosure is that there is something to enclose: The ‘intellectual commons’, a reservoir of knowledge from which all may draw.⁸³ The enclosure brought about by patent law then consists in the selective conveyance and enforcement of exclusive rights to knowledge taken – in fact used – from the imaginative reservoir. If the conditions by which patentable subject matter is delineated are not set or applied appropriately and with regard to both the individual and the public interests involved, more may be used and ‘proprietaryized’ than will ultimately be given back to society – through publication and ultimately lapse of the patent. Moreover, right holders may be identified wrongly.⁸⁴

Particularly with regard to the life sciences such effects may allegedly be observed. The workings of patent regimes are thus contested. Supposedly, patenting inventions in these areas may inhibit technological progress – the goal of the regime at hand – instead of stimulating it.⁸⁵ Conveyance of patents to essential

biotechnological processes. Nuffield Council on Bioethics, *The Ethics of Patenting DNA* (London 2002), 25. Compare rule 27 of the Implementing Regulations to the EPC: ‘Biotechnological inventions shall also be patentable if they concern: (a) biological material which is isolated from its natural environment or produced by means of a technical process even if it previously occurred in nature; (b) plants or animals if the technical feasibility of the invention is not confined to a particular plant or animal variety; (c) a microbiological or other technical process, or a product obtained by means of such a process other than a plant or animal variety.’

80. Helfer, *ibid.*, 973.

81. P. Drahos, ‘The Universality of Intellectual Property Rights: Origins and Development’, 27 (Paper for the WIPO Panel Discussion *Intellectual Property and Human Rights*, Geneva, 9 November 1998, at: <www.wipo.int/tk/en/hr/paneldiscussion/index.html>).

82. On the power of ‘abstract objects’ (intangibles, inventions) – and thus the power of the ones that hold exclusive rights to them such as patentees – see e.g. Drahos (1996), *ibid.*, 145–164.

83. On commons concepts see Drahos (1996), *ibid.*, 54–67.

84. May, *ibid.*, 91–126; V. Shiva, *Biopiracy. The Plunder of Nature and Knowledge* (Cambridge, South End Press 1997), 17; Drahos (1996), *ibid.*, 199–224.

85. The so-called tragedy of the anti-commons: M.A. Heller, R.S. Eisenberg, ‘Can patents deter innovation? The anticommmons in biomedical research.’ 1998 (280) *Science*, 698–701.

inventions in early stages of R&D, such as is often the case with genetic sequences and other biochemical compounds, may incur excessive proprietary power to one patentee. It mitigates follow-up activities, so inhibits further R&D, and therefore counters the goal of this regime. Because of the challenge this poses to the legitimacy of this legal regime, this issue rightly receives a lot of attention.⁸⁶

The feasibility of possible changes to patent law, as to rebut said workings, is necessarily conceived of from within the patent law perspective and so hinges on the nexus between technology and economic policy.⁸⁷ The means should always be evaluated in light of their ends.⁸⁸ Stake-holders allege that strong patent protection is a prerequisite for R&D and issue stark warnings: ‘No protection means no innovation’ and ‘no patents no cure!’⁸⁹ Others disagree and find that amendments to patent law as to restrict its proprietary workings would not necessarily negate technological progress.⁹⁰

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86. The term ‘legitimacy’ is important in the fields of philosophy, political science and law. A broad definition may refer to the legal competency and practical ability of public authorities to act, and the recognition and acceptance thereof by their constituents. See e.g. D.M. Bodansky, *Legitimacy in International Environmental Law* (University of Georgia School of Law, Research Paper Series 06–007, May 2006), 3–9. Legitimacy includes legality – but also social acceptance. See generally A.J. Hoekema, N.F. van Maanen, *Typen van Legaliteit* (Deventer, Kluwer, 2000). For an argument that referenced issue challenges the legitimacy of patent law, see J. Koopman, ‘*Octrooiëring van Biotechnologische Uitvindingen: Recht onder Vuur!*’ (Part I) (2005) 11; (Part II) (2005) 12 *Bijblad bij De Industriële Eigendom*, res 447–455; 503–512.
87. This was also the case in an earlier controversy about the establishment of patent law regimes, and which arose in the nineteenth century. See hereon the contributions in R. Towse, R. Holzhauser (eds), *The Economics of Intellectual Property Volume II* (Cheltenham, Edgar Elgar, 2002), 3–448.
88. The so-called Chicago school is at the forefront hereof. See e.g. W. M. Landes, R.A. Posner, *The Economic Structure of Intellectual Property Law* (Mass. Harvard University Press 2003), 294–333.
89. These statements were delivered (and continue to be made) by the European Federation of Pharmaceutical Industries and Associations (EFPIA). See <www.efpia.org>. Similar statements may be found in reports and on the websites of numerous stake-holders, such as the Biotechnology Industry Organization and the European Association for Bio-industries, at respectively <www.bio.org> and <www.europabio.org>. Of course, these statements may not be entirely inappropriate, albeit may appear exaggerative. As such they may reflect the (comprehensible) wish to strive for legislation that suits the particular (corporate) interests best. For an account of the strategies by which stake-holders strive for ever stronger patent protection, see Sh. Thaker, *The Criticality of Non-Market Strategies: The European Biotechnology Patents Directive* (Kellogg School of Management Biotechnology Papers), 1–16 at <www.kellogg.northwestern.edu/academic/biotech/faculty/articles/shail.pdf>.
90. Dutfield (2003), *ibid.*, 237–245. In a different context, the US Supreme Court also concluded this, when it considered the argument that governments should not stimulate biotechnological progress through the patent system: ‘The grant or denial of patents on micro-organisms is not likely to put an end to genetic research or to its attendant risks. The large amount of research that has already occurred when no researcher had sure knowledge that patent protection would be available suggests that legislative or judicial fiat as to patentability will not deter the scientific mind from probing into the unknown any more than Canute could command the tides. Whether respondent’s claims are patentable may determine whether research efforts are accelerated by the hope of reward or slowed by want of incentives, but that is all.’ *Diamond v. Chakrabarty*, 447 U.S. 303 (1980) at 317.

Most initiatives envisage minor amendments to the law and/or its application, possibly complemented by other measures.⁹¹

The topic of this article – the human rights implications of patenting knowledge – is closely related to referenced proprietary enclosure, albeit in a somewhat different fashion than set forth here. It seems that the workings of patent law in the field of the life sciences do not only affect the pace and direction of R&D, but also bear upon societal interests that override the direct confinements of economics and science. Indeed, ‘the part of economics that is independent of . . . social context is . . . small’.⁹² The social context of patenting biotechnological knowledge is discussed in the next paragraph.

V. SOCIAL ISSUES AND HUMAN RIGHTS IMPLICATIONS

V.A SOCIAL ISSUES

Patent law is increasingly scrutinized for its alleged anti-social workings and effects.⁹³ The initial social controversy, which aroused immediately after the first patents were granted for biotechnological inventions, turns on the ethical appropriateness of the so-called proprietarization of life forms such as animals, plants and micro-organisms (and their biochemical elements such as genetic sequences, proteins and other compounds). Another controversy addresses the exclusionary nature of patent rights and their impact on the accessibility of patented products such as pharmaceuticals (health), plants, seeds and life stock (food). Yet another controversy entails the patenting and further commercialization of human bodily materials. A further controversy addresses the occurrence of ‘bio-piracy’, which is allegedly committed through the patenting of biochemical

91. These measures may include increasing public funding for R&D or developing so-called open source models for access to and exploitation of inventions. It seems clear, however, that the determinative factors in and directions and actual outcomes of R&D that are affected by the patent regime need to be analysed further before many of these initiatives may be given legislative and practical effect. From a variety of perspectives on aspects of this issue, and with diverging conclusions, see e.g. G. Van Overwalle, ‘Reconciling Patent Policies with the University Mission’ (2006) 2 *Ethical Perspectives*, 231–247; S.J.R. Bostyn, *Patenting DNA Sequences (Polynucleotides) in the European Union: An evaluation* (European Commission, Luxemburg, 2004); J. Hope, *Open Source Biotechnology* (Boston, Thesis, MIT, 2004); Swiss Federal Institute of Intellectual Property, *Research and patenting in biotechnology. A survey in Switzerland* (Publication 1(12.03), 2003); Federal Trade Commission, *To Promote Innovation: The Proper Balance of Competition and Patent Law and Policy* (Washington D.C. 2003).

92. R.M. Solow, ‘How Did Economics Get That Way and What Way Did It Get?’ (1997) 126 *Daedalus*, 56.

93. It is noted that the term ‘social’ refers here to human societies and their make-up, among other things formed by relations and interactions between human beings, institutions and so forth. The term is not restricted to ‘the public’ as opposed to ‘the private’. In psychology, social behavior is characterized by regard for social and cultural norms and rules, balanced conduct, and consideration of others’ feelings and interest. ‘Anti-social’ is of course characterized by the opposite characteristics.

materials and the associated knowledge of traditional and local knowledge holding communities. In all of these controversies, it becomes clear that patent law may be a legal instrument that is precisely tailored to its economic goals, but has non-economic side-effects too. Conversely, its application and use with regard to biotechnological inventions has implications that extend far beyond such confinements, and well into the realm of human activity that, at face value, seems unrelated to technological R&D. Seemingly, its implications are felt and endured by many in day-to-day life. In view hereof, it may not be considered surprising that human rights law comes into the picture.

V.B 'PATENTING LIFE'

The 'patenting life debate', as it may be called, is perhaps most subsistent and widespread and turns on the inappropriateness of patenting both biochemical compounds and genetically modified organisms such as plants and animals.⁹⁴ These 'building blocks of life', and the organisms consisting of them, are often attributed to high powers such as Gods, and should thus principally not be tampered with let alone appropriated in whatever form or shape.⁹⁵ However, even without direct religious beliefs, the appropriateness of one another may be scrutinized. Some ethicists, philosophers and lawyers also doubt developments in the life sciences, and particularly the manner in which patent law is used to steer them.⁹⁶

The EPO has given significant attention to elements of this debate in the course of applying Article 53(a) EPC. Nevertheless, it has not held patents on the compounds concerned per se to fall within the scope of this provision.⁹⁷

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94. In the USA, a full-fledged discussion commenced upon conveyance of a patent to a biotechnological invention that consisted in a unicellular micro-organism (a variant of the bacterium *E.coli*). See *Diamond v. Chakrabarty* 447 U.S. 303 (1980). In Western Europe, the same occurred in 1984, when a patent application was filed for a transgenic mouse, which was ultimately in somewhat restricted form sustained in appeal. See Case T 315/03, 6 July 2004 (*Method for producing transgenic animals*) (also known as the Harvard Mouse Case).
95. Religious beliefs may lead to the strongest and most unequivocal rejection of biotechnology, and legal regimes such as patent law. See for example the call for a ban on 'patenting life' issued by eighty religious leaders on 18 May 1995: *Joint appeal against human and animal patenting* (Washington, DC, National Press Club, 1995). See furthermore e.g. N.M. de S. Cameron, J. Eareckson Tada, *How to be a Christian in a Brave New World* (Michigan, Zondervan Publishers, 2006), 137–188; J. Rifkin, *The Biotech Century* (New York, Tarcher/Penguin, 1998), 37–66; Shiva, *ibid.*, 4.
96. See e.g. Nuffield, *ibid.*, 74; A. Lever, 'Ethics and the Patenting of Human Genes' (2001) 1 *Journal of Philosophy, Science & Law*, 1–11; J.H. Fielder, 'Patenting Biotechnologies: Ethical and Philosophical Issues' (1997) 16/6 *Engineering in Medicine and Biology Magazine*, 118–120.
97. Illustrated by the line of reasoning of the Opposition Division of the EPO in a landmark decision on the patentability of human genetic sequences: 'Human tissue or other material, such as blood . . . has been widely used for many years as a source for useful products . . . Many life-saving substances . . . have been patented. Every evidence indicates that this practice is perfectly acceptable to . . . the vast majority of the public . . . It cannot be overemphasised that patents

The same applies to the organisms at hand, which in themselves may of course not be subjects of human rights law.⁹⁸ No matter the rather extensive attention given by

covering DNA . . . do not confer on their proprietors any rights whatever to individual human beings . . . No woman is affected in any way by the present patent – she is free to live her life as she wishes and has exactly the same right to self-determination as she had before the patent was granted. Furthermore, the exploitation of the invention does not involve dismemberment and piecemeal sale of women. The whole point about gene cloning is that the protein encoded by the cloned gene . . . is produced in a technical manner from unicellular hosts containing the corresponding DNA; there is therefore no need to use human beings as a source for the protein. The only stage at which a woman was involved was at the beginning of the making of the invention, as a (voluntary) source for the relaxin mRNA . . . the allegation that human life is being patented is unfounded. It is worth pointing out that DNA is not ‘life’, but a chemical substance . . . The patenting of a single human gene has nothing to do with the patenting of human life. Even if every gene in the human genome were cloned (and possibly patented), it would be impossible to reconstitute a human being from the sum of its genes’. The patent was therefore deemed not to offend morality and Art. 53(a) EPC that, as was mentioned before, excludes inventions whereof the commercialization would be contrary to morality or ordre public. Case V 0008/94, 8 December 1994 (*Relaxin*), at 6.3.1., 6.3.3., 6.3.4 and 6.6. of the Reasons (confirmed by the Boards of Appeal on 23 October 2002 in T 272/95). With regard to human material, rule 29 of the Implementing Regulations provides explicitly that: ‘(1) The human body, at the various stages of its formation and development, and the simple discovery of one of its elements, including the sequence or partial sequence of a gene, cannot constitute patentable inventions; (2) *An element isolated from the human body or otherwise produced by means of a technical process, including the sequence or partial sequence of a gene, may constitute a patentable invention, even if the structure of that element is identical to that of a natural element*’. It is mentioned that present R&D endeavors with stemcells – and particularly with totipotent stemcells that can produce any type of embryonic and extraembryonic cell – may challenge the clear-cut application of aforementioned case law and rules. The EPC allows for opposition until nine months after the publication of the patent. Anybody may oppose if ‘(a) the subject-matter of the European patent is not patentable under Arts 52 to 57; (b) the European patent does not disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art; (c)’ (Art.s 99 and 100 EPC).

98. For the manner in which the EPO applies Art. 53(a) EPC in respect of animals, see Case T 315/03 (referred to in para. V.B. above) which pertained, among other things, to transgenic mice. Both Art. 53(a) EPC and rule 28 of the Implementing Regulations were addressed extensively. Rule 23d(d) of the Implementing Regulations provides, insofar as relevant, that ‘Under Article 53(a) European patents shall not be granted in respect of biotechnological inventions which, in particular, concern the following: . . . (d) processes for modifying the genetic identity of animals which are likely to cause them suffering without any substantial medical benefit to man or animal, and also animals resulting from such processes’. This thus is a balancing test performed at the discretion of the EPO. See case T 315103: at 9.1–9.7.; 12.2.1.–2.2.4; 13.2.1.–13.2.4. of the Reasons. The EPO furthermore held that Art. 53(a) EPC includes the exclusions provided in rules 23(d) and (e) (see also previous note). But since these exceptions are not exhaustive, an assessment with regard to Art. 53(a) EPC may also be required if they do not apply. At 10.1. of the Reasons. The assessment made pertained to a variety of arguments why Art. 53(a) EPC would allegedly apply to the invention at hand. The EPO assessed, among other things, the presupposed negative impacts on the environment and evolution, the inappropriate consequences for the use of animals in R&D and trade, rules of foreign (case) law, and asserted public arousal known by polls. Respectively at 13.2.9; 13.2.11.; 13.2.12.; 13.2.16; 13.2.17; 13.2.19; and 13.2.20. of the Reasons. Nevertheless, it concluded that the invention concerned was not encompassed by Art. 53(a) EPC. At 13.2.21. of the Reasons.

the EPO to the appropriate assessment pursuant to, and the application of Article 53(a) EPC, it is clear that it does not easily conclude that the exploitation of an invention contravenes ordre public and morality. This may derive from the limitations inherent to patent law itself – what is actually patented and which rights are conveyed in relation thereto. Hence, the subject matter always is an invention – not any thing as such – and rights are limited both substantively and in time. Moreover, the EPO may not be the appropriate forum to make full-blown assessments and judgment calls, whilst the EPC may not provide the proper bases either to evaluate elusive concepts such as morality.⁹⁹ Nevertheless, the EPO recognizes and takes seriously the fact that patent law may touch upon complex ethical issues. In view of the directive, this was also acknowledged by the EU – thus not directly relevant for the EPO.¹⁰⁰

A different question would of course be whether the patenting life arguments may be relevant from a human rights perspective, and should so be assessed in such context by the EPO. Without exploring this issue extensively, it seems hard to relate the predominantly normatively and rather subjectively fed arguments in this debate to specific human rights. As the EPO has held, it just seems impossible – and awkward as well – to conclude that biochemical compounds constitute human life itself.¹⁰¹ Even if one finds R&D on and/or patenting and/or exploitation of these compounds inappropriate per se, human rights still do not seem to affect the merits of these opinions. No human right can be identified that principally and absolutely counters R&D and/or patenting and/or exploitation in this regard. Furthermore, no human right safeguards an interest not to be disagreed with. No human right is, furthermore, acknowledged to live in a world that refrains from embracing science and reductionism, from pursuing technological progress or from relying on the egocentric, competitive incentives of men or corporations for that matter. To conclude this imaginary shortlist of human rights that would bolster arguments against ‘patenting life’, no human right can be identified that counters the uncertainty and wiggling that may accompany regulating new areas of human activity, such as life sciences endeavours.¹⁰² This is different from the

99. See extensively on the EPO’s application of Art. 53(a) EPC O. Mills, *Biotechnological Inventions. Moral Restraints and Patent Law* (Aldershot, Ashgate, 2005).

100. This led to the establishment of the European Group on Ethics in Science and New Technologies, which studies and advices on these topics. See <http://ec.europa.eu/european_group_ethics/index_en.htm>.

101. At least insofar one limits the term ‘life’ to organisms and so accepts the conventionally embraced characteristics of life, i.e. homeostasis, organization, metabolism, growth, adaptation, response, reproduction. It is admitted that other definitions may be proposed too.

102. To the contrary, if states would principally refrain from instituting patent regimes and rendering them applicable to biotechnological inventions, existent human rights may be implicated, such as the human right to health and food (see para. 5.3. below). A broader controversy may arise, because a complete ban on patenting in these areas may negate other important human and societal interests, such as the cost- and time-effective advancement of medicine and agriculture. Patent prohibitions – without drastic measures as to provide for otherwise funded and stimulated R&D – will surely damage these interests.

issues addressed in the next paragraph, which do implicate human rights, and necessitate exploration as to the relation between the patent- and human rights law regimes.

V.C ISSUES THAT IMPLICATE HUMAN RIGHTS: FROM DIGNITY TO PIRACY

Patenting biochemical compounds, such as genes and other compounds, may allegedly induce direct human rights implications in the areas of health, food, culture, and the individual freedoms. Patents on pharmaceuticals, and on interrelated biotechnological inventions such as genes, may hamper access to medicines, and so the efforts of health-care workers and international authorities to prevent and/or mitigate epidemics such as HIV and to make R&D more efficient.¹⁰³ Patent rights may so touch upon the human right to health.¹⁰⁴ Likewise, patents on plants, seeds, life-stock, semen and so forth may affect the possibility of farmers to freely go about and do their agricultural business, such as the production of food. It may lead to a homogenization of the types of food produced and, furthermore, delineate access thereto, because it is selectively commercialized and distributed.¹⁰⁵ It may affect peoples'

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103. E.g. G. Van Overwalle (ed.), *Gene Patents and Public Health* (Brussel, Bruylant, 2007); *Report of the Commission on Intellectual Property Rights, Innovation and Public Health* (Geneva, WHO, 2006); M. Westerhaus, A. Castro, 'How do Intellectual Property Law and International Trade Agreements Affect Access to Antiretroviral Therapy?' (2006) 8 *PLOS Medicine*, 1230–1236; E. Noehrenberg, 'The Realities of TRIPS, Patents and Access to Medicines in Developing Countries' in *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy*, M.P. Pugatch (Cheltenham, Edward Elgar, 2006), 170 et seq.; World Health Organization, *Genetics, genomics and the patenting of DNA* (Human Genetics Programme, Chronic Diseases and Health Promotion, Geneva 2005), 48–51; C. Correa, *Integrating Public Health Concerns into Patent Legislation in Developing Countries* (Southcentre, Geneva, 2000), 6–8.
104. See Art. 25 UDHR; Arts 7, 11, and 12 ICESCR; Arts 10, 12 and 14 Convention on the Elimination of All Forms of Discrimination against Women (1979); Art. 5 Convention on the Elimination of All Forms of Racial Discrimination (1965). See for these human rights treaties: < www2.ohchr.org/english/law/>. See also Art. 3 of the Convention on Human Rights in Biomedicine (1997) (CHRB), available at: <<http://conventions.coe.int/Treaty/en/Treaties/Html/164.htm>>.
105. E.g. G.S. Kush, 'Biotechnology: Public-Private Partnerships and Intellectual Property Rights in the Context of Developing Countries' in *Biodiversity & the Law*, Ch. McManis (ed.) (London, Earthscan, 2007), 179–182; M. Blakeney, 'A Critical Analysis of the TRIPS Agreement' in *The Intellectual Property Debate: Perspectives from Law, Economics and Political Economy*, M.P. Pugatch (Cheltenham, Edward Elgar, 2006), 25–27; J. Straus, 'Genomics and the Food Industry: Outlook from an Intellectual Property Perspective' in *Intellectual Property in the New Millennium. Essays in Honor of William R. Cornish*, D. Vaver, L. Bently (eds) (Cambridge, Cambridge University Press, 2004), 126–135 M.R. Taylor, J. Cayford, *American Patent Policy, Biotechnology and African Agriculture* (Resources for the future, Washington D.C., 2003), 19–24, 47–55; A. Kimbrell, *Fatal Harvest. The Tragedy of Industrial Agriculture* (Island Press, 2002); C. Fowler, P. Mooney, *The Threatened Gene. Food, Politics and the Loss of Genetic Diversity* (Cambridge, Lutterworth Press 1990), 115–200.

human right to food.¹⁰⁶ Patenting of human bodily materials may lead to conflicts within families, ethnic populations and peoples about the appropriate competency in respect of these materials. It may so complicate social relations and even health care and R&D oriented work.¹⁰⁷ It may certainly implicate the individual freedoms (that is, self-possession) and the prime dignity of human beings.¹⁰⁸ The human right to consent to medical research emanates there from.¹⁰⁹ The same applies to the stipulation that the human body and its parts may, as such, not give rise to financial gain.¹¹⁰ To conclude this brief outline of issues raised by the patenting of biotechnological knowledge and that may have human rights implications, the important area of what is often called ‘biopiracy’ must be referred to. The commercial development of biological materials and the associated knowledge without consent of, and fair compensation to, the states and/or peoples in whose – respectively – national territory and/or cultural domain the materials and knowledge were originally acquired – may so implicate human rights law too. This is addressed in the following paragraph, which explores one element of the piracy issue – namely the appropriation of traditional knowledge through European patent law.

VI. APPROPRIATION OF TRADITIONAL KNOWLEDGE

VI.A TRADITIONAL MEDICAL KNOWLEDGE

A significant number of pharmaceuticals patented and commercialized by the pharmaceutical industry relates somehow to plant-derived compounds.¹¹¹ Many of these materials and (some of) their activities are found with the help of traditional knowledge holders. Many of whom can be found within indigenous

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106. Based on Art. 25(1) UDHR and explicitly vested in Art. 11(1) ICESCR and Arts 24 (1) and (1c) and 27 Convention on the Rights of the Child (1989).
107. E.g. Koopman (2005), *ibid.*, 503–504; G. Van Overwalle, *Study on the Patentability of Inventions Related to Human Stem Cell Research*, (Luxemburg, EGESNT, 2002); P. Sarcevic (et al) (eds), *Biomedicine, the Family and Human Rights* (Leiden, Brill, 2002), 3–54; Committee on Human Genome Diversity, *Evaluating Human Genetic Diversity* (Washington D.C., National Academy Press, 1997), 58–68. E.R. Gold, *Body Parts: Property Rights and the Ownership of Human Biological Materials* (Georgetown University Press, 1996).
108. Preamble and Art. 1 UDHR; preamble and Art. 1(1) ICESCR; preamble and Art. 1(1) ICCPR. These notions underlie and are central to all human rights. They require governments to abstain from actions that invade such freedom and dignity, such as is the case with slavery and torture. See e.g. Arts 4 and 5 UDHR; Arts 3 and 4 ECHR.
109. Art. 7 ICCPR; Arts 5 and 10 CHR.B.
110. Art. 21 CHR.B.
111. See e.g. R. Gupta et al, ‘Nature’s Medicines: Traditional Knowledge and Intellectual Property’ (2005) 2 *Current Drug Discovery Technologies*, 203–219; W.H. Lewis, M.P.F. Elvin-Lewis, *Medical botany. Plants affecting human health*. Wiley, London, 2003 and (various contributions in) N.R. Farnsworth et al (eds), *Intellectual Property Rights, Naturally Derived Bioactive Compounds and Resource Conservation* (London Elsevier Science, 1997) and M.J. Balick et al (eds), *Medicinal resources of the tropical forest. Biodiversity and its importance to human health* (New York, Columbia University Press, 1996).

communities.¹¹² Biotechnology offers new ‘ways to tap into natural diversity’ – and so invites the prospecting of materials *in vivo*, and for that purpose requires interconnecting with traditional knowledge holders.¹¹³

Traditional knowledge may be perceived as a particular kind of social knowledge.¹¹⁴ The traditionality of this knowledge is not determined by its antiquity. To the contrary, about eighty per cent of the world’s population primary health needs are met by traditional medicine, which continues to be developed on a daily basis. The traditionality is mostly determined by the way it is developed and applied.¹¹⁵ Hence, traditional knowledge is developed through hands-on experience (as opposed to clinical and empirical analyses), is intuitive rather than analytical, and it is based on diachronic rather than synchronic data.¹¹⁶ Although its development and application may be formalized to a certain extent, they are not institutionalized as known in most Western-European societies. Indigenous knowledge hinges on different paradigms – among which the concept of holism.¹¹⁷ This holistic view cannot but lead to the non-separation of different types of knowledge and manners of expressions (science, arts, spirituality, religion and so forth).¹¹⁸

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112. ‘Indigenous communities . . . are those which, having a historical continuity with pre-invasion and pre-colonial societies that developed on their territories . . . consider themselves distinct from other sectors of the societies now prevailing in those territories. They . . . are determined to preserve, develop and transmit to future generations . . . their own cultural patterns, social institutions and legal systems.’ J.R.M. Cobo, *The Study of the Problem of Discrimination against Indigenous Populations* (UN Document E/CN.4/Sub.2/1986/7/Add.4, 1993). For different definitions, see the reports of E. Daes (docs. E/CN.4/Sub.2/1993/28 a.f.) at: <www.ohchr.org/english/issues/indigenous/documents.htm>. Providing adequate definitions is problematic. See e.g. Li-ann Thio, *Managing Babel: The International Legal Protection of Minorities in the Twentieth Century* (Leiden, Martinus Nijhoff Publishing, 2005), 1–15. About 5,000 indigenous cultures exist to date. Many of them exist in developing countries, although they may also live in developed countries and regions, such as Western-Europe (particularly Scandinavia), the US, Canada, Australia, and New-Zealand.
113. On the tapping: BIO (2007), *ibid.*, 35. See for a strong call to collaborate with traditional knowledge holders e.g. R. Verpoorte, ‘Pharmacognosy in the new millennium: leadfinding and biotechnology’ (2000) 52/3 *Journal of Pharmacy and Pharmacology*, 253–262.
114. At least if one wishes to distinct it from other types of knowledge. In principal all knowledge may be social though. See e.g. P. Sillitoe, ‘What know natives? Local knowledge in development’ (1998) 6/2 *Social Anthropology*, 203–220; A. Agrawal,, ‘Dismantling the divide between indigenous and scientific knowledge’ (1995) 26 *Development and Change*, 413–439.
115. R.L. Barsh, ‘Indigenous knowledge and biodiversity in indigenous peoples, their environments and territories’ in *Cultural and spiritual values of biodiversity*, D.A. Posey (ed.) (Nairobi, IT/UNEP, 2000), 73–76.
116. M. Johnson, ‘Research on traditional environmental knowledge: Its development and its role’ in *Lore: Capturing Traditional Environmental Knowledge*, M. Johnson (ed.) (Ottawa, IDRC, 1992), 7–8.
117. The Gamilaraay (aboriginal) artist John Hunter expressed it like this: ‘My paintings reflect the land and the things that live on it, they are part of me as I am part of them. All things have a purpose and a right to exist and when the land becomes sick, we become sick. If living things are lost from our country, a part is lost’. Personal conversation between the author and Hunter about the latter’s painting *Bandarr* on 28 April 2004, Sidney, Australia.
118. ‘Unlike science, [traditional knowledge] does not oppose the rational and spiritual, not separate culture and nature. In indigenous societies, empirical knowledge intermingles with

It also exemplifies that traditional knowledge continues to be fed by local cultural traditions, whereas science and technology – the actual subject-matter of patent law – are often considered to be objective, culturally neutral, and thus universal.¹¹⁹ Because traditional knowledge is expressed in a cultural and not solely a technological context, it could very well be communicated by songs, poetry, dance, myths, plays and so forth. The overriding importance attached to traditional knowledge by its holders seems to be its cultural – not particularly its commercial – value. Obviously, this differs from science and technology, which are increasingly developed and enhanced through their commercialization – hence commercial value. Whereas the cultural context and manifestations of traditional knowledge do not necessarily reflect upon its quality and usefulness, they do render it extraordinary in regulatory terms, particularly insofar as it concerns patent law. The characteristics of this type of knowledge enable it to be appropriated by others. Patent law may be an important tool to that extent. Both the formulation and application of the requirements for and exceptions from patentability supposedly lead to conveyance to incorrect patents to incorrect right holders. This is addressed in the following paragraphs.

VI.B UNPATENTABILITY OF TRADITIONAL KNOWLEDGE

Pursuant to contemporary European patent law, traditional knowledge holders cannot protect their knowledge or its applications. The reasons therefore include the following. It is generally not considered to comprise an invention, but a discovery.¹²⁰ However, even if one could speak of an invention, such would not fulfill the other requirements for patentability. Pursuant to Article 54 (1) and (2) EPC, novelty is determined according to the state of the art, which comprises everything made available to the public in anyway before the filing of the patent application.¹²¹ A significant portion of the relevant traditional knowledge belongs to the state of the art though. Since this knowledge was developed and applied in a cultural context, it was often not deemed necessary to not communicate or

spiritual knowledge, and ecosystems and social ones are intertwined.’ UNESCO Report, *Cultural diversity. Common heritage, plural identities* (Paris, UNESCO, 2002) 75.

119. For a concise explanation of what is sometimes rendered modern as opposed to traditional science, and their interactions, see e.g. International Council for Science, *Report from the Study Group on Science and Traditional Knowledge* (2002), 1–16, via: <www.icsu.org >. See extensively J. Koopman, ‘Bumps and Bends in the Road to Intellectual Property for Traditional Knowledge. On Knowledge Models, Legal Orders and the Anti-Commons in Biotechnology’ in *Intellectual property law. Articles on crossing borders: Between traditional and actual*, F.W. Grosheide, J.J. Brinkhof (eds) (Antwerp, Intersentia, 2004), 251–262, 263–265.
120. Art. 53 (2) (a) EPC. This of course hinges on the EPO’s interpretation of the concepts ‘invention’ and ‘discovery’ and thus ultimately of ‘technicality’. See previous para. III.C.2.
121. This novelty standard is so indiscriminative to the origin of the knowledge assessed. It is an absolute, global standard of novelty. Other standards upheld in national patent statutes may be relative and national instead. See e.g. the US Patent Act – 35 U.S. Ch.102, from which it derives that not all foreign communications are included in the assessment of novelty.

apply it openly. Hence, it may very well be that a traditional healer did not keep the knowledge sufficiently secret pursuant to patent law standards.¹²² The fact that the traditional knowledge may not be easily accessible does not necessarily change its status for patent law purposes.¹²³ Even if this hurdle to patentability would be taken successfully, it is likely that the knowledge concerned does not fulfill the requirement of inventiveness Article 56 EPC states that an invention shall be considered inventive if it is not obvious to a person skilled in the art in view of the state of the art. It may very well be that an average pharmacologist or biochemist finds the activities of particular compounds used in traditional knowledge applications (such as an herbal composition of crude extracts or fluids) obvious. Obviously, the closeness of that application to the state of the art is of decisive importance. Here, the perspective differences between traditional knowledge and, for example, biochemical sciences are determinative. Analyses from within the latter discipline of the state of the art may result in clear-cut comprehension of (potential) workings of a compound, whilst insights from within the former perspectives may not entail the necessary biochemical structure – effect correlations.¹²⁴ An additional complexity for patenting traditional knowledge applications is caused by the disclosure requirement contained in Article 83 EPC.¹²⁵ It may be difficult to disclose traditional knowledge applications in a manner that would fulfill this requirement. Disclosure and sufficiency, essentially brought about by clarity and practicability of what is revealed, are highly technical conditions. They may relate neither to the ways in which traditional knowledge is commonly expressed nor to its characteristics.¹²⁶ Hence, the conclusion that traditional knowledge applications themselves

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122. It may be that he deliberately shared it with others within or outside the community or revealed it in the course of the application, i.e. in a healing ceremony. Conversely, companies (inventors and potential patent applicants) rigorously maintain secrecy during R&D. E.g. P. Drahos, J. Braithwaite, 'Intellectual property, corporate strategy, globalisation: TRIPS in context' (2002) 20 *Wisconsin. International Law Journal*, 451.
123. See extensively on novelty in respect of the (applications of) pharmaceutical compounds e.g. B. Domeij, *Pharmaceutical Patents in Europe* (The Hague, Kluwer Law International, 2000), 130–197.
124. See extensively Domeij, *ibid.*, 189–266.
125. It is remembered that a patent application must 'disclose the invention in a manner sufficiently clear and complete for it to be carried out by a person skilled in the art'.
126. The invention must coincide with one or more of the technological fields pursuant to the International Patent Classification categories. Traditional knowledge does not as such fit in. See the *WIPO Guide to the International Patent Classification System* (Geneva, 8th edn, 2006). Available at <www.wipo.int/classifications/ipc/en/other/guide/guide_ipc8.pdf>. The IPC is governed by the Special Union for the International Patent Classification, established pursuant to the Strasbourg Agreement Concerning the International Patent Classification (1971). The IPC distinguishes patent publications in categories, sections, classes, subclasses, groups and sub-groups, of which collectively there are about 69.000. To access a patent database, and to illustratively inquire the classification of patents/inventions go to: <<http://ep.espacenet.com>>. Moreover, the sufficiency condition requires that the invention can be reduced to practice without too much burden. The culturally determined, and so mixed, modes of expression of traditional knowledge holders – briefly said the idea of 'painting the cure' – do not correspond with the IPC and this condition. It is furthermore noted that many traditional knowledge applications are herbal in kind – herbal medicine – which is generally

are generally not considered to entail patentable subject matter pursuant to the EPC.¹²⁷

VI.C

APPROPRIATION BY OUTSIDERS' USE AND PATENTING

Inventions that derive from the use of traditional knowledge – in fact, any knowledge – may be patented if they fulfill the requirements set in the EPC. It is alleged that such knowledge may thereby be appropriated. Traditional knowledge may contribute to biotechnological R&D endeavours and thus relate to an invention coming forth there from by:

- generally pointing to a line of research that eventually leads to an invention (for example, traditional knowledge that a certain plant could be used to make a pleasant tasting beverage, which led researchers to investigate the medicinal properties of the plant);
- more directly pointing to the invention (for example, traditional knowledge that a plant has certain medicinal properties may lead researchers to explore other possible medicinal properties of active compounds in the plant);
- directly contributing to the invention (for example, traditional knowledge that a certain plant extract was effective in treating skin infections may have led researchers to conclude that active compounds in the plant were effective antibiotics);
- being part of the invention itself (for example, a traditional knowledge holder may have communicated to a researcher a new or undisclosed medicinal property of a plant extract, whereas this property is central to the invention).

Currently, none of these relations will have an unequivocal effect on the patentability of the invention so attained.¹²⁸ None of these uses of this knowledge will

not deemed reliable to that degree. G.L. Patrick, *An Introduction to Medicinal Chemistry* (Oxford, Oxford University Press, 2005), 183. On the disclosure requirement with regard to pharmaceuticals, see extensively Domeij, *ibid.*, 45–62.

127. See e.g. Koopman (2004), *ibid.*, 261–263. Gr. Dutfield, 'Protection Traditional Knowledge and Folklore' in *Intellectual Property Law. Articles on Cultural Expressions and Indigenous Knowledge*, F.W. Grosheide, J.J. Brinkhof (eds) (Antwerp, Intersentia, 2002), 79–80; G. Van Overwalle, 'Protection of Traditional Knowledge: A Critical Synthesis' in Grosheide, Brinkhof, *ibid.*, 255–256; Roht-Arriaza, N., 'Of seeds and Shamans: The appropriation of the scientific and technical knowledge of indigenous and local communities' in *Borrowed Power. Essays on Cultural Appropriation*, B. Ziff, P.V. Rao (eds) (New Brunswick, Rutgers University Press, 1997), 255–290.

128. WIPO IGC, *Technical study on disclosure requirements in patent systems related to genetic resources and traditional knowledge* (Geneva, WIPO, Study 3, 2004), 37. 'In each case, the invention may be viewed as being based on or developed from the access to the TK, but the nature of the obligation to disclose the TK may differ considerably. In the first case, the TK may be used as part of the descriptive background to the invention; in the second case, it could arguably form part of prior art that may be caught by obligations to disclose material prior art;

necessarily result in the unpatentability of the invention related thereto. The first category is, however, most removed from relevant patentable subject matter, because it amounts to mere facilitation, as opposed to invention – the act of inventing – which is recognized in European patent law. The inventions obtained through the traditional knowledge meant in categories (2) and (3) may be novel. But the directions of the traditional knowledge holders may affect their inventiveness. The knowledge meant in category (4) may implicate both novelty and inventiveness – arguably, the knowledge is paramount to the invention for which the patent application is filed. But it would all boil down to the substantive correspondence between the traditional knowledge and the subsequent invention, and the manner in which they are represented. Because of the difference modes of expression assessments in this respect are complicated though. It would not only require scientific and technological knowledge and capabilities – as would be common for the patent examiners at the EPO – but anthropological ones as well. The EPO’s attempt to substantively examine and ‘see through’ the descriptions in patent applications are also hampered by the fact that biotechnological inventions are a complex sum of disciplinary parts. Traditional knowledge may be a more or less direct part of that sum. Therefore, it is very well possible that there is a relevant relation between the use of traditional knowledge and the invention that goes unnoticed.¹²⁹

This is what initially happened when European patent 436 257 B1, which pertained to an agricultural method involving an extracted and purified oil from the Neem tree (*Azadirachtin indica*), was granted.¹³⁰ This invention (thus patent) related to non-novel traditional knowledge, which had been applied for hundreds of years in India, and that – for purpose of acquiring the patent – was ‘technisized’ by the patent applicant. However, the patent was opposed.¹³¹ It was subsequently revoked by the Opposition Division of the EPO on 13 February 2001. The invention lacked inventiveness.¹³² Hence, the stringent application of the inventiveness

in the third case, it might either be relevant prior art or arguably form part of the invention itself; in the last case, it might form part of the invention as claimed’.

129. The overall quality concerns about the manner in which the EPO applies the requirements for patentability, and the subsequent lowering of the thresholds, add to this possibility.
130. Thus this case was not concerned with the subject matter at the centre of this article – traditional medical knowledge.
131. As was mentioned before, the EPC provides grounds on the basis of and procedures through which patents can be contested and subsequently restricted to their actual novel and inventive elements or even revoked or annulled. See Art. 99 (opposition) and Art. 138 (revocation) EPC. On the basis of Art. 99 EPC, the International Federation of Organic Agriculture Movements (Germany); the Green Group in the European Parliament (Brussels); and the Research Foundation for Science, Technology, and Natural Resource Policy (New Delhi) collectively opposed to the patent at hand.
132. This decision was sustained on 8 March 2005 by the Technical Boards of Appeal of the EPO in Case T 416/01 (*Method for controlling fungi on plants by the aid of a hydrophobic extracted neem oil*). The purified concentrations of the Neem oil used by the patent applicant (US Thermo Trilogy Corporation) differed slightly from the concentrations used for the same purpose and that were contained in the prior art, and were thus novel (rendering the entire

requirement contained in Article 56 EPC – combined with correct assessment of the state of the art pursuant Article 54 EPC – may prevent appropriation of traditional knowledge at such. It must, however, be ascertained that large portions of the knowledge concerned are likely to be regarded more remote from the invention. The invention can then be patented, regardless of the previously applied traditional knowledge. In many situations, the knowledge is either physically or conceptually facilitative – respectively contributive to the prospecting of materials or to initial R&D therewith –, and so disregarded for patent law purposes. It is rather likely that many patented inventions relate to traditional knowledge in this fashion.¹³³ Looked at from a patent perspective, this is not at all problematic. The only leeway that may be found within the EPC of course pertains to the exclusion from patentability contained in Article 53(a) EPC. The EPO could, of course, assess whether the use of the knowledge concerned would render the publication or commercialization of the invention contrary to ‘ordre public’ or morality. Given the marginal application of this exclusion, it is not likely that this will be concluded though.¹³⁴

method employed novel). At 4.3. of the Reasons for the decision. However, such was not deemed inventive pursuant to Art. 56 EPC. At 4.4. of the Reasons.

133. The so-called Hoodia patent may be illustrative. In Case T 543/04, the invention consisted in the provision of appetite-suppressants. The invention was attained by use of an extract from the plant genus *Hoodia* for the manufacture of a pharmaceutical (6 and 7 of the Reasons). In respect of the prior art documents that pertained to descriptions of the use of the stems of the *Hoodia* cactus for the same purpose, the Boards of Appeal concluded that ‘a skilled person, knowing [the most relevant prior art document disclosing traditional knowledge] could not obviously derive [there from] that an extract of the plant could be used for the manufacture of an appetite-suppressant, anti-obesity medicament . . . a consumer eating the stems of the plant or sucking the sap . . . is not able to absorb a sufficient amount of the active moiety contained in an extract of the plant which is responsible for its appetite-suppressing activity . . . The Board is convinced . . . that the effect [described in the prior art document] . . . can be explained by the stomach-filling properties of the plant in question, which had been used as “bush-food” by the original inhabitants of the Kalahari desert . . . Thus when trying to [reach] the present invention, namely to provide an alternative appetite-suppressant . . . when compared to . . . [the one known in the prior art], the skilled person would not arrive at the subject-matter . . . in an obvious way’ (13–17 of the Reasons). See Case T 543/04, 27 January 2005 (*Pharmaceutical compositions having appetite suppressant activity*).
134. This may, however, be an interesting avenue to explore for traditional knowledge holders. Case T 315/03, discussed in para. V.B. before, may provide some general basis for such exploration. Relevant considerations of the Boards of Appeal may be that ‘[t]he concept of morality is related to the belief that some behaviour is right and acceptable whereas other behaviour is wrong, this belief being founded on the totality of the accepted norms which are deeply rooted in a particular culture. For the purposes of the EPC, the culture in question is the culture inherent in European society and civilisation. Accordingly, under Art. 53(a) EPC, inventions the exploitation of which is not in conformity with the conventionally-accepted standards of conduct pertaining to this culture are to be excluded from patentability as being contrary to morality’ At 6 of the Reasons. Of course, it may very well be that it does not concern norms of the European culture and civilisation here, let alone ones that are conventionally accepted. The EPO seems to be willing to take account of laws of other, and even non-European, countries though. See 13.2.16 of the Reasons, in which case law of the Canadian Supreme Court is assessed (but in this case held to be irrelevant). The fact that it was concluded

VI.D

TRADITIONAL KNOWLEDGE HOLDERS' WISHES AND HUMAN RIGHTS

Traditional knowledge holders frown upon this situation. Their cultural and economic position is aggravated because of the fact that their expressions – which are the vehicles of communication of knowledge – cannot be protected either by current intellectual property laws.¹³⁵ In the course of the WIPO IGC consultations, it has become clear that they wish to be regarded as the primary guardians of their culture. Therefore, they wish to have a possibility of offensive protection of the cultural expressions and the content; the right to authorize use of their knowledge; the right to benefit from authorized commercial use; and the right to prevent culturally offensive uses.¹³⁶ Whereas the workings of current intellectual property laws, including European patent law, negate these wishes, human rights law may require their fulfillment though. The human rights concerned are addressed in the following paragraphs.¹³⁷ First, the human rights that may counter appropriation by others are listed and analyzed in this context (paragraph VII). Second, the rights that may support acquisition of intellectual property rights by traditional knowledge holders themselves are set forth (paragraph VIII). One and other is of course intertwined. Only knowledge that is not subject of any proprietary right may be used by others at all times – appropriated as it is called in respect of traditional knowledge. It will thus show that the relevant human rights may overlap. They may be equally important for the self-defense and appropriative function of property.¹³⁸ Traditional knowledge holders encounter the lack of both. It is subsequently – and most importantly – explored whether the make-up and application of the EPC violate the two types of human rights identified.¹³⁹ This is done with regard to

in this case that 'little evidence was provided in support of the arguments based on treaties, legislation, political and religious beliefs, to the effect that animals should be protected and animal patenting should be forbidden' shows that the EPO is open to any argument relevant in this context, if well-grounded and proven. At 13.2.17 of the Reasons.

135. For example by copyright law (Art. 9 et seq. TRIPS). See e.g. J. Koopman, 'Meeting at and Passing by New Frontiers. Interfaces Between Cultural Heritage and Intellectual Property' in *Language Endangerment and Endangered Languages*, W.L. Wetzels (ed.) (Leiden, CNWS Publications, 2007), 66 et seq.; A. Lucas-Schloetter, 'Folklore' in Lewinski, *ibid.*, 259 et seq; Dutfield (2002), *ibid.*, 76–78, 81–83.
136. See previous para. I for the WIPO consultations. See for the wishes mentioned: WIPO IGC, *Elements of a sui generis system for Traditional Knowledge* (Geneva, WIPO/GRTKF/IC/4/3, 2002).
137. It is observed that this account is restricted to the body of human rights, set forth in para. II.B. Therefore, it does not include declarations, principles and other so-called soft-law instruments. Whereas these instruments may be important for political developments, they have no legal validity, and do not impose strong obligations on states, at this time. They include the UN Declaration on the Rights of Indigenous Peoples (A/RES/61/195, 13 September 2007). Moreover, other binding human rights instruments that address the particular interests of one or the other group of peoples – such as indigenous peoples – are not included in this exploration. One could think of e.g. the Indigenous and Tribal Peoples Convention (1989) (No. 169). Available at: <www2.ohchr.org/english/law/>.
138. See previous para. III.A. on the character and rationale of patent law.
139. 'Technically speaking, there is a conflict when two (or more) treaty instruments contain obligations which cannot be complied with simultaneously... Not every such divergence

knowledge that was not stringently held secret, but somehow communicated, as meant in Article 54 EPC.¹⁴⁰ As previously discussed, the EPO is not part of and subjected to the international human rights framework and its adjudicating bodies. To enable a substantive exploration of aforementioned question, this issue of jurisdiction and competency – and thus enforcement – is set aside. To conclude these introductory remarks, it is noted that the exploration at hand is predominantly tailored to the texts of the human rights provisions concerned.¹⁴¹

VII. HUMAN RIGHTS VIOLATIONS BY APPROPRIATION OF TRADITIONAL KNOWLEDGE?

VII.A RIGHTS AGAINST DEPRIVATION OF PROPERTY

Article 17(2) UDHR provides that ‘no one shall be arbitrarily deprived of his property’. Likewise, Article 1 of the first protocol to the ECHR provides that ‘every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions except in the public interest and subject to the conditions provided for by law and by the general principles of international law’. Traditional knowledge may be subject of these rights too, if it would be considered a ‘property’ or ‘possession’.¹⁴²

The ICCPR provides in Article 1 (1) that all peoples ‘have the right of self-determination. By virtue of that right they freely determine their political status and freely pursue their economic, social and cultural development’ and in clause (2) that all peoples may ‘for their own ends, freely dispose of their natural wealth and resources without prejudice to any obligations arising out of international economic co-operation, based upon the principle of mutual benefit, and international law. In no case may a people be deprived of its own means of subsistence’.¹⁴³ These varying human rights may appear to be countering the appropriative workings of the EPC.

constitutes a conflict, however... incompatibility of contents is an essential condition of conflict.’ W. Karl cited in Marceau, *ibid.*, 60.

140. The exploration may lead to different outcomes if the knowledge was held secret, and conveyed to outsiders under a secrecy agreement, which included a provision to the extent that no patents would be applied for any inventions deriving from the collaboration. In my opinion, this issue – which probably does not concern most traditional knowledge – demands separate attention though.
141. I find it of profound importance to focus on what is there, as to inquire what should and, equally important, could become. A legal analysis starts with existing law *Cf.* MacQueen, *ibid.*, 460–461.
142. This thus deals with traditional knowledge that *already* is a possession. Deprivation is not possible without possession. The next paragraph addresses the different question, namely whether traditional knowledge holders may have a human right to possess their knowledge in this way, which should be facilitated by property regimes, and which knowledge could so become their property. The latter question is tailored to the existing model provided by the EPC.
143. Art. 1(1) and (2) of the ICESCR provides similar rights. The wealth and resources concerned are generally considered to be tangible, i.e. not comprise knowledge as such. Traditional

VII.B

APPLICABILITY AND ISSUES

The most important issue in respect of Article 17(2) UDHR and Article 1 of the first protocol to the ECHR as bases against the appropriation of traditional knowledge through patenting may pertain to the meaning of the terms ‘property’ and ‘possession’. Clearly, aforementioned patenting of inventions somehow derived from traditional knowledge reveals a lack of (acknowledgement of) proprietary attribution of that knowledge. Alternatively, it may reveal the assumption that traditional knowledge holders did have proprietary-like rights, but that they have surrendered them by not maintaining secrecy, and thus having their knowledge communicated pursuant to Article 54 EPC.¹⁴⁴ It is, however, likely that the first situation occurs, and that the traditional knowledge that may be used in the attainment of an invention, which is later patented, is not considered subject of any property right. Recent case law of the European Court of Human Rights shows that the term ‘possessions’ is interpreted broadly, and may include intellectual property and the expectancy of acquiring such. However, at present the traditional knowledge concerned is not subject of any intellectual property regime – let alone the EPC – and it may so be seriously doubted whether its holders could ever have any expectancy of acquiring rights in relation thereto.¹⁴⁵

However, if one looks beyond the European confinements, the conclusions reached may be different and Article 17(2) UDHR and Article 1(2) ICCPR may be implicated. Traditional knowledge holders may enjoy unrecognized types of

knowledge used in biotechnological R&D is associated with biological resources. However, it is usually also contained in those resources, i.e. a plant that has been cultivated by traditional knowledge holders over lengthy periods of time. Hence, one could imagine that this provision may be invoked against appropriation per se.

144. This would correspond with Arts 1(2) of the ICCPR and ICESCR, since they have then ‘freely disposed of their natural wealth and resources’. The formulation of these human rights provision (‘their’) of course presupposes some proprietary right in those resources.

145. The Grand Chamber of the European Court for Human Rights has held that the concept of ‘possessions’ is independent from formal classification and that certain other rights and interests can also be regarded as ‘possessions’ as meant in article 1 the first protocol. Even a legitimate expectation of obtaining an asset may enjoy protection, if the interest amounts to a legal claim and there is a basis for the interest in national law. This is not so if there is a dispute about the correct interpretation and application of the law and the claim is subsequently rejected. European Court for Human Rights, 11 January 2007, Case No. 73049/1 (*Anheuser-Busch Inc. v. Portugal*), at 63, 64 and 65 of the Judgment. Substantively tailored to the EPC – once again setting aside matters of jurisdiction and competency – this means that it is unlikely that there’s a legitimate expectation of traditional knowledge holders in this regard, given the make-up of the EPC, and the manner in which the requirements for and exceptions from patentability in EC Member States are applied. As was mentioned before, traditional knowledge is generally expected to be unpatentable. The *Anheuser-Busch* case may offer an interesting substantive – but theoretical – avenue for exploration though, because it promulgates a rather expansive definition of ‘possessions’. Moreover, the European Court for Human Rights is rather active, and so continuously specifies the contents, conditions and reach of this provision. This stipulation and guidance is lacking in respect of other human rights involving property, some of which are discussed here. Banning, *ibid.*, 65.

‘properties’ in the knowledge and related material concerned, and may in fact not have decided to ‘freely dispose’ of these resources. Indeed

indigenous peoples possess their own locally specific systems of jurisprudence with regard to classification of knowledge, proper procedures for acquiring and sharing knowledge, and the nature of the rights and responsibilities that are attached to possessing knowledge.¹⁴⁶

Hence, it may very well be that proprietary-like rights existed pursuant to those local systems of jurisprudence, and that the patenting of biotechnological inventions somehow related to traditional knowledge thus steps upon said human rights. What may be considered communicated and so freely disposed of (that is, the non-novel knowledge used in the attainment of the invention) may in fact still have been subject of such proprietary-like right. This would then touch upon Articles 1(1) and (2) of the ICCPR. Perhaps communication knowledge does not imply surrendering any exclusive prerogative within the legal systems of traditional knowledge holders. Understanding local systems of jurisprudence – also referred to as customary law – may not be easy though.¹⁴⁷ Recognizing local laws may be even more complicated given the sheer numbers of cultures existent today. The lack of recognition given to these systems may relate to the challenges posed by legal pluralism, and the complexities associated with coherent and mutual integration of several legal orders, their procedural and substantive rules, and their effects. Legal centralism is the pretext in today’s world of nation states.¹⁴⁸ Particularly indigenous claims to group autonomy and their claims for proprietary rights over land and related resources challenge that pretext and, more fundamentally the primacy of the nation state.¹⁴⁹ This issue hinges primarily on the relative effect that is given to Article 1(1) ICCPR.¹⁵⁰

Another question pertains to the reach of, particularly, Articles 17(2) UDHR and 1 of the first protocol to the ECHR. Both contain a conditioned prohibition of

146. Barsh, *ibid.*, 73.

147. Translating from concept to concept may be difficult. This is a general problem encountered in comparative legal endeavours. Banning, *ibid.*, 21. See also K. Zweigert, H. Kötz, *An Introduction to Comparative Law* Oxford, Clarendon Press, 1998), 1–73. Particularly in respect of indigenous law, see e.g. E.A. Hoebel, *The Law of Primitive Man. A Study in Comparative Legal Dynamics* (Cambridge, Harvard University Press, 2006), 3–66.

148. J. Griffith, ‘What is Legal Pluralism?’ (1986) 24 *Journal of Legal Pluralism and Unofficial Law*, 377–401; S.E. Merry, ‘Resistance and the Cultural Power of Law’ *Law and Society Review* (1995) 29/1, 11–27.

149. J. Anaya, ‘Indigenous Peoples and International Law Issues’ (1998) 92 *Am. Soc’y Int’l L. Proc.*, 96 et seq. This conclusion may be nuanced by the fact that also indigenous groups wish to have a constructive relationship with the states in which they live. Government of Canada, *A Brave New World: Where Biotechnology and Human Rights Intersect* (2005), 7/23. At: <www.biostrategy.gc.ca/HumanRights/HumanRightsE/toc_e.html>.

150. Some so conclude that the ‘acceptance of the principle [of self-determination, i.e. Arts 1(1) and (2) of the ICCPR and ICESCR] into the realm of law has been selective and limited in many respects. In particular, current international law on self-determination is blind to the demands of ethnic groups and national, religious, cultural, or linguistic minorities’ Cassese, *ibid.*, 108.

‘deprivation’. One may doubt whether traditional knowledge holders can be deprived of their knowledge – which is of course not *taken*, as may be the case with tangibles. It is used for the attainment of an invention. It may be considered, worked, and combined with other knowledge, and then the *invention* is patented. The traditional knowledge holder is left with the same knowledge as before.¹⁵¹

A less substantive, but still elementary, problem is that Articles 17(2) UDHR and Article 1 of the first protocol to the ECHR apply to individuals, whereas traditional knowledge holders seem to consider prerogatives in respect of knowledge of a collective nature. Of course, in Articles 1(1) and (2) ICCPR and ICESCR reference is made to ‘peoples’. But even then, it is not clear whether this encompasses indigenous peoples or refers to the constituents of a state – let alone whether it applies to a ‘peoples’ of indigenous and non-indigenous traditional knowledge holders.¹⁵²

If one would conclude that the rights equally apply to individuals and to peoples, other difficulties arise. Absent formal representation, it may be hard to delineate the collective, let alone to distinguish it from other peoples. Whose rights should be acknowledged? Whose property or possession? Whose natural wealth and resources? Similar complexities appear in respect of the rights of the individual within a community and those of that community. Lack of insights in the applicable local legal systems, and the often shared and dispersed traditional knowledge and related materials among peoples and countries further complicate this matter.¹⁵³

The foregoing exploration seems to justify the conclusion that neither provision currently provides unambiguous human rights bases against the appropriation of communicated traditional knowledge by the patenting of biotechnological inventions pursuant to the EPC. Absent resolution of the issues set forth, it may

151. Even if one would favour a broad definition of deprivation – one that would align with the value associated with knowledge in the contemporary world –, and one would negate the fact that the lack of secrecy on the part of the traditional knowledge holder caused it to be public (hence non-novel), it should be assessed whether such was arbitrarily taken (Art. 17(2) UDHR) or done for the public interest and provided for by law and by the general principles of international law (Art. 1 first protocol to the ECHR). The main question may be whether the make-up and application of this patent system would be considered to promote such public interest, and whether the use of the traditional knowledge and the subsequent patenting occurred in compliance with national law and international law principles. Setting aside once again the fact that the EPC is not national law, and that it may be doubted whether the general principles of international law bind the European Patent Organization, one may focus on the meaning of the latter phrases. Pursuant to current European patent law, it is clear that the manner in which traditional knowledge may be appropriated aligns with the requirements of the EPC itself. It is, however, worthwhile to note that the reference to principles of international law was particularly included to safeguard the interests of foreigners (of contracting states), by guaranteeing compensation. If one accepts that traditional knowledge amounts to a ‘possession’, and that the patenting practise concerned amounts to ‘deprivation’ – both which could of course be contested on good grounds –, this interpretation could open up an interesting, albeit theoretical, line of thinking for traditional knowledge holders.

152. Government of Canada, *Ibid.*, 7/23.

153. In a human rights context see Government of Canada, *ibid.*, 7/24–25. In regard of appropriation of traditional knowledge by patenting, see Koopman (2004), *ibid.*, 270.

be hard to conclude that patenting pursuant to the requirements of the EPC violates referenced human rights – i.e. one cannot conclude that simultaneous application is impossible, and thus that there is a conflict as was previously defined in paragraph VI.D.

VII.C

RELATED INITIATIVE: DISCLOSURE REQUIREMENTS

To conclude this paragraph on human rights that may (not) be invoked to rebut the patenting of biotechnological inventions derived from traditional knowledge another initiative in this realm is briefly referred to. Based on the Convention on Biological Diversity (1993) (CBD) and the so-called Bonn Guidelines numerous countries have implemented or are implementing additional requirements in their patent statutes.¹⁵⁴ These pertain to the disclosure of the origin of genetic resources and/or traditional knowledge used in inventions. Disclosure may require revealing the origin only, or may demand proof of prior-informed-consent to utilization and/or patenting and benefit-sharing too.¹⁵⁵ Traditional knowledge holders' cultural and financial interest in their knowledge is recognized in Article 8(j) CBD.¹⁵⁶ This may thus give in to some of their wishes *vis á vis* inventors/patent applicants. However, it should be emphasized that the CBD is not a human rights treaty.¹⁵⁷ This also shows from the CBD itself. It conveys rights to states only.¹⁵⁸ Moreover, none of the aforementioned conditions have been implemented into the EPC. The European Patent Organization doesn't have to take up this task either, because it is not a party to the CBD.

154. For the CBD see <www.cbd.int/convention/convention.shtml>. For the Bonn Guidelines on Access to Genetic Resources and Fair and Equitable Sharing of the Benefits Arising out of their Utilization in 2002, see UNEP/CBD/COP/6/20 and COP Decision VI/24 at: <www.cbd.int/convention/decisions.shtml>. The state of several national initiatives can be inquired at: <www.biodiv.org/programmes/socio-eco/incentives/default.asp> and <www.cbd.int/reports/>.

155. European countries such as Denmark, Belgium, Norway and Switzerland (the latter two are not members of the EU) have implemented formal and marginal requirements in their statutes to this extent. They have based these requirements also on Recital 27 of the directive that sets forth that 'if an invention is based on biological material of plant or animal origin . . . the patent application should . . . include information on . . . origin of such material . . . whereas this is without prejudice to the processing of patent applications or the validity of rights arising from granted patents'. It is emphasized that Recital 27 of the directive has no formal legal validity, since it is not part of the body of the directive.

156. Art. 8(j) provides that governments shall 'respect, preserve and maintain knowledge . . . and practices of indigenous and local communities embodying traditional lifestyles relevant for the conservation and sustainable use of biological diversity . . . and encourage the equitable sharing of the benefits arising from the utilization of such knowledge'.

157. See previous para. II.B. on the third generation of human rights. Art. 8(j) CBD may of course be inspired by Art. 1(1) and (2) of the ICCPR.

158. See e.g. Arts 3 and 15(1), (3), (5) and (7) CBD. It is, however, noted that these initiatives align with recommendations of the UN Sub-Commission on Human Rights. See resolution 2000/7 at 12, previous para. I.

VIII. HUMAN RIGHTS VIOLATIONS BY THE UNPATENTABILITY OF TRADITIONAL KNOWLEDGE?

VIII.A ARTICLE 15(1)(c) ICESCR: ON 'AUTHORS' AND THEIR 'PRODUCTIONS'

The inquiry of this paragraph pertains to the question whether the commonly presumed unpatentability of traditional knowledge by anybody – and thus also by traditional knowledge holders themselves – would amount to a human rights violation. The human right that seems most applicable is contained in Article 15(1)(c) ICESCR.¹⁵⁹

Article 15 (1) ICESCR provides that the '[s]tates Parties to the present Covenant recognize the right of everyone: [c] [T]o benefit from the protection of the moral and material interests resulting from any scientific, literary or artistic production of which he is the author'. When reading the text, a definitional problem as to who the rights are bestowed upon may be observed. The right of individuals instead of groups is recognized. Once again, this may be problematic for traditional knowledge holders and their peoples.¹⁶⁰ Moreover, it appears from the outset that Article 15(1)(c) ICESCR refers to authors and not to inventors. Whereas the term 'scientific production' may arguably be related to patent law, this is of course not the case with the term 'author'. The ones that make inventions are inventors. It seems clear that this provision was drafted with authors and author's rights (or

159. This provision corresponds with Art. 27(2) UDHR. As to other possible human rights bases the following is noted. It is recalled that Art. 1 of the first protocol to the ECHR provides: 'Every natural or legal person is entitled to the peaceful enjoyment of his possessions. No one shall be deprived of his possessions'. Despite the broad understanding of the European Court for Human Rights of the term 'possessions', which sometimes may include possessions still to be acquired, it is assumed that it does not embrace traditional knowledge, since there is no right to be acquired, at least under current EPC standards, in relation to it. The difference pertains to current possessions, and possessions that may be acquired, if there is a human right that would eventually lead to a legal regime to that extent. Therefore, Art. 1 of the first protocol to the ECHR is not further explored here. Furthermore, Art. 17(1) UDHR provides that '(1) everyone has the right to own property alone as well as in association with others'. Clearly, this provision is formulated in an elusive and open-ended fashion. It is not specific to the model(s), subject-matter(s), goal(s), and does not mention any grounds for limitation or other elaboration. One may for example doubt whether the term 'property' is meant to include *private property rights*. Nevertheless, if one accepts that Art. 17(1) bestows a human right to property in this sense to individuals and groups, it could be asserted that it would so also embrace property to intangibles – such as traditional knowledge. This right to property is, alike most human rights, subjected to the internal domestic legal (and economic) regime. Banning, *ibid.*, 40. Of course, this does not, so to say, take governments of the hook, because 'everyone' (including the traditional knowledge holder) should be provided with a mode for protection. One may doubt the degree of activity required by states though. Banning, *ibid.*, 56. Of course, also with regard to Art. 17(1) UDHR, it must be noted that the European Patent Organisation arguably is, once again, not bound by the UDHR.

160. Government of Canada, *ibid.*, 7/21 and /22.

copyrights) in mind, instead of inventors and patent rights.¹⁶¹ Article 15(1)(c) seems rather elusive – alike many of the previously discussed human rights. It does not substantiate and specify.¹⁶² It is not concrete in terms of the contents of the right, but instead programmatic, gradualist and ambitious in respect of the underlying interest. For long, this has diminished its authority.¹⁶³

This is intended to change though. The UN Sub-Commission on Human Rights, which concluded in resolution 2000/7 that there are ‘conflicts between the intellectual property regime... and international human rights law’, also affirmed that the rights of Articles 27(2) UDHR and 15(1)(c) ICESCR are human rights.¹⁶⁴ It encouraged the Committee on Economic, Social and Cultural Rights (the Committee) to ‘clarify the relationship between intellectual property and human rights, including the drafting of a general comment on this subject’. The Committee took up the challenge and issued its General Comment no. 17, which sets forth its conception of the right concerned, and elaborates the relationship with intellectual property and its subject matters.¹⁶⁵ Although the Comment cannot give rise to state obligations, it offers guidance on the interpretation and implementation of Article 15(1)(c) ICESCR. Therefore, it is elaborated and commented in the next paragraph, insofar as relevant for the claim that the unpatentability of traditional knowledge may amount to a human rights violation.

VIII.B GENERAL COMMENT NO.17: CLARIFYING THE RIGHT

VIII.B.1 A Human Right to Proprietarise?

The Committee recalls the primacy of human rights law over other bodies of law.¹⁶⁶ More importantly for this substantive exploration is the Committee’s stipulation that the right recognized in Article 15(1)(c) is a human right, which derives

161. Cullet, *ibid.*, 402–403. It is remembered, however, that also the French Patent Act of 1791 referred to ‘authors’ instead of inventors.

162. Helfer, *ibid.*, 976.

163. Helfer, *ibid.*, 987.

164. At 1 of the resolution. Previous para. I.

165. Committee on Economic, Social and Cultural Rights, General Comment No. 17 (E/C.12/GC.17, 12 January 2006) (the Comment). In comparison, it shows that it extensively incorporates and elaborates on a discussion paper submitted to the Committee during the preparatory phase. See A.R. Chapman, *Approaching Intellectual Property as a Human Right: Obligations Related to Article 15(1)(c)* (E/C.12.2000/12, 3 October 2000). It is awkward that the Committee’s Comment primarily addresses clause (c) of Art. 15(1), instead of also focusing on clauses (a) and (b). This makes the Comment rather single-sided and ignores the importance attached to clauses (a) and (b) in relation to clause (c) when the provision was drafted. Cullet, *ibid.*, 406–7 (commenting on the 2004 draft of the Comment, which is to large extent similar to the Comment itself).

166. Comment at 37, and referring to Arts 55 and 56 of the UN Charter – addressed in previous para. II.C. As was mentioned before, this does not directly affect the EPC and the European Patent Organization.

from the dignity of all persons. It is fundamental, inalienable and universal, and belongs to individuals and groups.¹⁶⁷ Of course this sets the tone. But this tone does, so to say, not necessarily make any music, because the practical consequences of this primacy are not elaborated by the Committee – which is to be regretted for both formal and substantive reasons. Formally, given the aforementioned jurisdictional and competency issues with regard to the EPC and, for that matter, GATT and TRIPS. Substantively, for the reasons set forth hereafter and with specific regard to the respective paragraphs in the Comment.

The Committee favours an expansive understanding of Article 15(1)(c). It considers the term ‘scientific production’ to include scientific publications, innovations, including innovations and practices of indigenous and local communities (that is, traditional knowledge).¹⁶⁸ Likewise, the term ‘author’ may also mean ‘inventor’, as subject of European patent law. This may appear to resolve ambiguities about the contents and addressees of the human right concerned. It does not resolve them though. First, the broad understanding of Article 15(1)(c) does not show from the Committee’s further analyses, which seems to be made primarily from a author’s right (or copyright) perspective.¹⁶⁹ Moreover, and based on the formulation of Article 15(1)(c), the Committee concludes that the right does not apply to legal entities.¹⁷⁰ This is awkward for two reasons. First, the formulation of this right, insofar as it pertains to ‘everyone’ may equally not apply to groups, which are bestowed with it anyhow. Second, the exemption of legal entities from this human right does not suit the manner in which they are often already subjected

167. Comment at 1. Intellectual property rights, including patent rights, are conversely primarily economic in kind, are limited in time, and alienable.

168. Comment at 9.

169. For example, but not limitative: The Committee considers that the ‘moral interests’ pertain to the honour and reputation of ‘authors’. Whereas morality rights are central to European continental authors rights regimes (i.e. existent intellectual property regimes), the Committee deems the concept also applicable to inventors. This means that inventors are protected by Art. 15(1)(c) ICESCR (and Art. 27(2) UDHR) against, among other things, ‘modification’ of their inventions that are prejudicial to their honour and reputation. The practical implication of this conclusion by the Committee is that current patent law regimes must be abolished. Their goal is to stimulate technological progress by conveyance of exclusive rights in return for publication of information on the invention in the patent, so that others can use that information to develop further. This necessarily implies ‘modification’ of the invention – that is the aim of the system. Arguably, such ‘modifications’ may be prejudicial in the sense of Art. 15(1)(c), because they may, for example, entail improvements that would reveal that the initial invention contained some flaws or problems. Moreover, at 17 in the comment, it is set forth that the ‘material interest’ is restricted to the ones that are ‘directly’ generated by the invention. This does not necessarily correspond with the realities of R&D and commercialization of patents, which may take many years, involve many participants, may consist in a wide array of immediate and intermediate, direct and indirect, and primary and secondary material benefits. It may e.g. consist in private financing (venture capitalist, participation), subsidies, direct license royalties, indirect license royalties (e.g. dependant patents, contractual reach through arrangements), sales revenues, infringement damages, compensations for compulsory licenses granted etc.

170. Comment at 7.

to the human rights framework and also disregards their role in the attainment and exploitation of all sorts of ‘productions’.¹⁷¹

However, the Committee found a leeway for the aforementioned issues by indicating that the scope of Article 15 does not necessarily coincide with contemporary (inter)national intellectual property regimes and is, in fact, broader than these regimes.¹⁷² The manner in which states want to implement the right into their legislation not prescribed. Any way may be envisaged, including ones that diverge from TRIPS.¹⁷³ Therefore, current intellectual property regimes are not necessarily based on the human right at hand, and should not be equalled thereto.¹⁷⁴ The human right may encompass more. Therefore, the unpatentability of traditional knowledge may not necessarily violate the human right at hand. Other manners of implementation of Article 15(1)(c) may be conceived of. Perhaps preservation regimes will suffice to protect the moral interests of ‘authors’, whereas the material interest may be acknowledged through rewards, subsidies and so forth.¹⁷⁵ But it is noted that Article 15(1)(c) also allows for diversification of property models for the benefit of traditional knowledge holders who encounter appropriation of their knowledge. The formulation of states’ obligations in the Comment – which includes taking legislative and other measures to ensure the effective protection of the right contained in Article 15(1)(c) – certainly justifies the provision of some property-like right to traditional knowledge.¹⁷⁶

171. Helfer, *ibid.*, 993; Cullet, *ibid.*, 407. But see otherwise: Peter K. Yu, ‘Reconceptualizing Intellectual Property Interests in a Human Rights Framework’ (2007) 40 *U.C. Davis Law Review*, 1080.

172. Comment at 2.

173. Comment at 10. This does not necessarily conflict with TRIPS, which provides minimum standards in respect of the included forms of intellectual property, and so allows for the establishment of additional regimes.

174. Comment at 3.

175. Yu, *ibid.*, 1089.

176. Such as is developed by the WIPO IGC (refer to previous para. 1). Helfer, *ibid.*, 999–1000; Cullet, *ibid.*, 411. The IGC envisages a *sui generis* intellectual property regime for traditional knowledge holders. Its main characteristics would be as follows. The holistic character of traditional knowledge led the WIPO IGC to define the subject matter broadly. It pertains to ‘tradition-based literary, artistic or scientific works; performances; inventions; scientific discoveries; designs; marks, names and symbols; undisclosed information; and all other tradition-based innovations and creations resulting from intellectual activity in the industrial, scientific, literary or artistic fields... Categories of traditional knowledge could include: agricultural knowledge; scientific knowledge; technical knowledge; ecological knowledge; medicinal knowledge, including related medicines and remedies; biodiversity-related knowledge; “expressions of folklore” in the form of music, dance, song, handicrafts, designs, stories and artwork; elements of languages, such as names, geographical indications and symbols; and, movable cultural properties’. Traditional knowledge that is documented is eligible for protection. It is unimportant whether the knowledge is communicated (non-novel, in the public domain) or held secret. Rights are granted pursuant to the cultural association of a community. Rights should evolve parallel to the subject matter, which is also dynamic. Within the community, rights should be conveyed pursuant to community law. Right holders would have the right to prevent reproduction and fixation of literary and artistic expressions, and exploitation of technical elements. The regime would provide strong moral rights. Many of the problems to

This also includes measures to prevent third parties to interfere with the moral and material interests acknowledged in Article 15(1)(c).¹⁷⁷ The interests of inventors/patentees and traditional knowledge holders may directly conflict with one another, but the interests of both types of ‘authors’ must be safeguarded by states. One may wonder who is the third party here – and whether they will continue to exist given the expansive interpretation of Article 15(1)(c). How should states prevent what interference by and against whom?

Here one touches upon one of the most complicated consequences of the Committee’s expansive approach to this human right. Anyone – individual or group – may invoke the right generally in respect of any ‘production’. The direct implication of one and other of course is that also contemporary inventors/patentees may invoke this broad human right, as to further expand their (proprietary) interests in their patents, and related knowledge. They may pursue to do so against competitors within the bio-industry, but also against traditional knowledge holders themselves. It is likely that this broad understanding of Article 15(1)(c) ICESCR may turn out to enhance the proprietary enclosure in the life sciences – and equally well in other fields of human creativity and ingenuity. It may so not only be a dream for traditional knowledge holders, but for current patentees – and other holders of intellectual property – too. The dream may show to turn out in a nightmare though.¹⁷⁸

VIII.B.2 Particular Benefits to Indigenous Knowledge Holders

The preferences of – specifically – indigenous peoples must be reflected in implementing measures taken at the national level. This particularly includes their

be resolved before such regime could successfully be introduced relate to the issues identified in this exploration. They concern, among other things, the character of the knowledge, the identification of the ones entitled, the type of rights to be conveyed and the relation to other well-established legal regimes, including patent law, at the (inter)national level. See *generally* WIPO IGC, *The Protection of Traditional Knowledge. Revised Objects and Principles* (Geneva, WIPO/GRTKF/IC/9/5, 2006). A primary problem may be the overly expansive approach taken by both the Committee and the WIPO IGC. This will surely result in a further, possibly complete, proprietary enclosure in the life sciences – or drawn further, in any field of human activity that may deliver expression or knowledge. See extensively: Koopman (2004), *ibid.*, 267–278. The *sui generis* regime developed under the auspices of WIPO is not further discussed here, since it does not reflect upon the question whether human rights are violated by the unpatentability of traditional knowledge pursuant to European patent law as such.

177. Comment at 26, 28, and 39(a) and (b).

178. Cf. Helfer, *ibid.*, 994–995. Once again, it may be doubted whether such proliferation of rights will stimulate technological (or any kind) of progress, given the further restrictions it may impose on exchange among peoples. Koopman (2004), *ibid.*, 273 et seq. Some even point at the danger of erosion of the function of democracy by a rights culture. See A. Brown, ‘The Interface Between Intellectual Property, Competition and Human Rights’ at 16. At: <www.law.ed.ac.uk/ahrb/conference/background.asp>. Others do not fear these consequences too much. Based on the comment, they expect that not all aspects of, for example, patents can be conceived of as a human right – i.e. the ‘non-human-aspects’ would be detached from this approach. See Yu, *ibid.*, 1124–1133.

collective interest in and claims to knowledge; the prevention of unauthorized use by third parties and their interest in free, prior informed consent; and respect for their oral or other customary forms of transmission.¹⁷⁹ This surely bolsters the claims of indigenous traditional knowledge holders to their knowledge. It may, however, create new ambiguities with regard to non-indigenous traditional knowledge holders, whose social knowledge may reveal similar characteristics as indigenous knowledge. Moreover, one and other would not only be effectuated by the provision of a property-like right to traditional knowledge, but most certainly requires significant amendment of European patent law.¹⁸⁰

It all turns on whether the Committee considers the term 'use' to pertain to scientific or technological use in R&D, or whether it also includes patenting. If it includes patenting, Article 15(1)(c) prescribes that patent applicants have obtained prior-informed-consent. It remains, however, uncertain whether proof thereof should be given in the course of patent application – and whether it must be examined pursuant to Article 83 EPC – as envisaged in referenced initiatives to implement the CBD and Bonn Guidelines. One could imagine that this protective element may be given attention in non-patent legislation and institutions – such as biodiversity clearing house mechanism and the like. The consent requirement proposed by the Committee certainly reveals its expansive interpretation of Article 15(1)(c): Traditional knowledge holders should give free and prior-informed consent to the use of any kind of knowledge, no matter what its contents, its potential application, or its whereabouts (in the mind of a traditional healer, publicly shared within a community, in an anthropological study on a shelf in a library, or floating around in cyberspace on the world-wide-web). This may, conversely, bolster arguments by patentees that they should also give their free and prior-informed consent to the use of any kind of their knowledge, for example even after their patents have lapsed.¹⁸¹ It may be doubted whether this is envisaged by the Committee.

Another difficulty may be encountered in respect of the required respect for the customary forms of transmission may be complicated looked at from the EPC perspective. It seems to imply that the EPO must ensure that it includes all traditional knowledge – no matter how it is expressed – in its examination of patent applications. Moreover, the fact that the unpatentability of traditional knowledge relates, at least partially, to its expression – not strictly technologically formulated, but intertwined with artistic means, such as paintings – seems to violate this human right. A mistake, such as occurred in the initial grant of the Neem tree patent, then amounts up to a violation. Given the substantive and conceptual differences between traditional knowledge, and the knowledge typically relevant for the EPC and assessed by the EPO, one may wonder how this obligation must be

179. Comment at 32.

180. Once again, it is disregarded here that the EPC is not a national statute, and that the European Patent Organization is not subjected to the convention at hand.

181. This may perhaps even be required given the non-discrimination provisions. See the comment at 19–21.

given hand and feet within the European patent context. By appointing traditional knowledge holders as examiners in the EPO? Which traditional knowledge holders and according to what standards? Who is to translate? At the same time, the non-discrimination requirement should not be ignored.¹⁸² But it is clear that the EPC does not discriminate among peoples or cultures.¹⁸³ Aforementioned stipulation by the Committee will tremendously burden, perhaps even distort, the patent system. It may enhance concerns about the quality of the existing patent regime, and impede the EPO's efforts to improve its application of the EPC.

VIII.B.3 Restricting Patent Law but Expanding Inventors' Rights?

The Committee furthermore stipulates that inventions whereof the commercialization jeopardizes the full realization of human rights, such as pertaining to human dignity (thus also Article 15(1)(c) ICESCR), health and privacy, must be excluded from patentability.¹⁸⁴ The Committee seems to confuse commercialization with patenting. A patent does not always lead to commercialization, but may be helpful in the course thereof. Moreover, patenting – and commercialization – may not necessarily counter the realization of the rights concerned. It may even contribute thereto.¹⁸⁵

182. *Ibid.*

183. Anybody may apply for and be granted a patent, as long as the requirements are fulfilled. The fact that traditional knowledge is considered unpatentable, has nothing to do with the holders – i.e. the human beings and groups involved – but everything with the type of knowledge concerned. No distinction is made between the (un)patentability of the knowledge of an indigenous traditional healer from, let's say, India or the (un)patentability of the knowledge of my non-indigenous mother, who is knowledgeable of traditional Dutch herbal medicine. It certainly has nothing to do with preferences and the like for a certain type of culture, ethnicity, nationality or what have you. This principally shows from the absolute, global novelty standard applied pursuant to Art. 54 EPC.

184. Comment at 35.

185. Other problematic aspects of the Committee's suggestion to merely exclude inventions from patentability are as follows. First, the assessment of the use of traditional knowledge in the R&D of an invention is rather complex, given its typical appearances (the manners in which it is expressed), its open and dispersed communication over time and among cultures and countries, and the fact that it may have been a causal but indirect part of the biotechnological puzzle – the invention. Second, it is unlikely that commercialization of patents may jeopardize the full – if any – realization of human rights. For proportionality reasons, it should also not be ignored that there is quite some work to do with regard to, for example, basic health care (often not implicating the latest patented medicines, but medicines the patents of which have already expired) and sanitation. The same applies to governance and law (issues such as tyranny, oppression, corruption, nepotism, privacy etc.) in the world. Excluding patentable subject-matter does not solve these problems, because patenting did not primarily cause them. It may, however, be that patent law implicates certain human rights and under certain particular circumstances – outlined above in respect of traditional knowledge – may not entirely align with, or counter, them. This surely is a problem. However, given the legal issues and questions mentioned in these paragraphs in respect of among others Art. 15(1)(c) ICESCR, one may doubt whether excluding patentable subject-matter resolves anything. Last, the Committee's statement may be deemed radical and short-sighted too, because it presumes that the

It is, furthermore, remembered that the higher standard for protection – the application of the requirements for and exceptions from patentability – of the EPC is allowed.¹⁸⁶ It was already mentioned that the Committee does not equal current intellectual property regimes to the right acknowledged in Article 15(1)(c).¹⁸⁷ The human right may encompass more. Therefore, the unpatentability of traditional knowledge does not principally seem to conflict with Article 15(1)(c), which allows for other ways of protecting the rights of its holders. Problematic is, of course, that ‘authors’ in the sense of Article 15(1)(c) cannot be deprived of the broader standard of protection. This thus includes both current inventors/patentees, traditional knowledge holders and, for that matter, anyone who produces anything in the broad field encompassed by this provision. Whereas this interpretation may in general lead to a further proprietary enclosure of any knowledge, it may also throw up questions in respect of the patentability exclusions envisaged by the Committee. Does it mean that the narrow, tailored application of the EPC, and thus limited rights obtained to particular inventions, should be accompanied by additional protection for the parts of the ‘productions’ that are unpatentable pursuant to the patent regime? Does this require an extra proprietary-like regime, or the granting of other rewards, in relation to this unpatentable subject-matter? Given referenced non-discrimination provisions, the answer to these questions must be positive. Why should one distinguish between the protection of benefits associated with indigenous traditional knowledge and the protection of benefits related to other types of knowledge?

VIII.B.4 New Conflicts: Battles of Human Rights!

The Committee so creates somewhat of a catch-22 by taking such an expansive approach to Article 15(1)(c) ICESCR. If the Committee’s interpretation requires substantive amendment of (European) patent law in respect of the human rights of traditional knowledge holders, this may simultaneously violate others’ rights pursuant to Article 15(1)(c) (that is, the ones who currently patent).¹⁸⁸ This will lead to a

same technological progress will be attained anyhow – with or without patent law for certain fields of ingenuity. This may seriously be doubted. The Committee ignores the fact that R&D must be financed one way or the other. Radicalism and short-sight appears from the risk it is willing to take, when it advises outright exclusion from patentability, and thus accepts the chance that this will redirect and slow down R&D into complex, uncertain and expensive areas, such as in the life sciences, and possibly hamper the attainment of all sorts of important inventions, such as medicines. This would surely also implicate many of the human rights envisaged by the Committee. The Committee seems to simplify complex political, cultural, socio-economic, and ethical – and thus legal – problems, and thus expects to resolve them by changing one legal regime (intellectual property law or patent law) instead of integrating various interactive regimes in a careful and proportionate fashion.

186. Comment at 11.

187. Comment at 3.

188. It will most likely also counter TRIPS, which sets forth minimum standards for the acquisition of intellectual property.

human rights battle.¹⁸⁹ This is brought about by the complexity of conceiving of many of the interests pursued by and subjected to current intellectual property regimes (not these regimes or the rights they convey themselves) as a human right. Moreover, these battles of human rights may not only occur between, for example, current patentees and traditional knowledge holders. They will also take place among these groups. Hence, inventors/patentees may pursue to invoke Article 15(1)(c) in infringement cases against competitors and traditional knowledge holding communities may do the same if one or the other community pursues to collaborate with, for example, the pharmaceutical industry and seeks to derive benefits there from. Different traditional knowledge holders/communities, having the same or similar knowledge, may have competing interests and different views on the appropriate course of action in respect of their knowledge.¹⁹⁰ The same applies, of course, to the rights and interests of an individual traditional knowledge holder and his community. They may also become engaged in a human rights battle.¹⁹¹

As the Dutch expression goes, ‘the soup may not be eaten as hot as it is served’ though. The Committee acknowledges national discretion in respect of the precise application of Article 15(1)(c) ICSECR, dependant on its economic, social and cultural conditions.¹⁹² This will certainly enable countries to pursue to implement Article 15(1)(c) and acknowledge the human right to intellectual property for traditional knowledge holders in an integrative fashion, which does not lead to outright distortion of current models of intellectual property, such as patent law, and the interests they serve. Moreover, such approach – that may mean that current European patent law and its application will mostly upheld – does so not per se violate the human right concerned – i.e. simultaneous application is not impossible, as would be the case if there was a conflict as previously defined in paragraph VI.D.

IX. CONCLUDING REMARKS

It is clear that the substantive and territorial proliferation of both human rights law and European patent law – or intellectual property law generally – causes frictions between these legal regimes. They have emerged for different reasons and goals

189. Helfer, *ibid.*, 976. This refers back to the ‘constitutionalization of private law’ and the horizontal application of human rights among private actors. See previous para. II.A. This is not further explored here. See with regard to intellectual property holders particularly: Ch. Geiger, ‘Constitutionalising Intellectual Property Law? The Influence of Fundamental Rights on Intellectual Property in the European Union’ (2006) 4/37 *International Review of Intellectual Property and Competition Law*, 385 et seq.

190. Government of Canada, *ibid.*, 7/20; Koopman (2004), *ibid.*, 270.

191. Government of Canada, *ibid.*, 7/23.

192. The comment at 18 and 47. Therefore, all sorts of broadly formulated limitations to the implementation of Art. 15(1)(c) ICESCR are allowed. *Ibid.*, at 22–24. The Committee obliges countries, furthermore, to strike a balance between the rights of ‘authors’ and the public interest in access to their productions. Comment at 35. How this balance should be struck is, however, not indicated, and thus also left to the discretion of states.

and pursuant to divergent methods, concepts, and terminologies and, therefore, may be relied upon and applied in disparate contexts. They may, however, relate to similar substantive interests, such as the creation and use of knowledge by human beings. This is particularly clear in respect of the ultimate topic of this article – the patenting of biotechnological inventions partially derived from traditional knowledge. The apparent factual nexus provided by the substantive interest that is pursued by both regimes does not reflect upon any legal connection though. Conversely, the regimes at hand, and the rights they convey, are not mutually communicative. The, so to say, asymmetric workings of these regimes induce some to conclude that they are in outright conflict. These clashes then demand to be resolved.

The superior status of human rights law as opposed to any other law, including the European patent regime, may appear as a stronghold in the search for solutions. The ‘healing power’ of human rights and its authority easily lead to human rights talk, and a further proliferation of its regime.¹⁹³ If one is willing to accept that human rights, no matter how ambiguous as to their contents, should always outweigh any other right and the legal regime from which it comes forth, the solutions seem simple: Eradicate any possible divergence or impediment in the latter. Of course, this rather extravagant solution will inevitably require ‘throwing away the baby with the bathwater’, as the Dutch expression goes. It may not be the most appropriate manner to integrate diverse legal regimes – because the one will be absorbed or overthrown by the other.

If one alternatively acknowledges that different legal regimes, such as human rights law and patent law, may equally pursue beneficial goals, careful analysis of their features, workings and interactions is needed. Prior to the creation of new – or as seems to be the case in respect of the Committee’s comment, the further expansion of existing – rights, it may be worthwhile to critically compare, interrelate and contemplate the regimes and rights that are there but don’t correspond. The exploration undertaken in this article is meant to serve that goal.

It shows that there are elementary conceptual differences between the objects of the comparison – the regimes at hand – which are not easily aligned. Moreover, both technical-legal and substantive issues need to be resolved, before any integrative attempt can succeed. A fundamental problem may be that, whereas European patent law is subordinate to human rights law, it was never made-up to give particular effect to or concisely enforce the latter. This shows from the jurisdictional and competency ambiguities identified. Moreover, the entirely different make-up and ‘speech’ of both regimes, makes it hard to conclude that the patenting practices addressed – thus the EPC or the European Patent Organization for that matter – substantively violate human rights. Whereas it is clear that these practices implicate several human rights, it cannot be concluded that they necessarily and unambiguously bring about violations. Clearly, the appropriate and self-defense function of property – in this case provided by the patent

193. See R.J. Vincent, *Human rights and international relations* (Cambridge, Cambridge University Press, 1986), 111 et seq.

regime – cannot be enjoyed by traditional knowledge holders. This counters the applicable human rights, about other modes of implementation and protection that may be thought of. These implications, brought about by the alleged appropriation of modified traditional knowledge and the unpatentability thereof ‘as is’, may to some extent be resolved through current EPC provisions though. The novelty, inventiveness, and disclosure requirements, as well as the exception from patentability pursuant to violation of *ordre public* and morality, may provide some leeway. Admittedly, this may not support traditional knowledge holders’ wishes entirely, since most of their knowledge does not relate to the, so to say, concepts central to patent law at all. To conceive of traditional knowledge in a human rights context may of course – and in itself appropriately – incite us to vigorously search for additional solutions. These solutions may perhaps also be found within – and by adjustment of – the European patent regime, which is and should remain dynamic, alike any property model. Further integration with, for example, the ECHR and the ICESCR may be appropriate – and the endeavoured reach and application of the exception pertaining to *ordre public* and morality may be central hereto. However, the expansive approach to Article 15(1)(c) ICESCR taken by the Committee is unfeasible. It surely bypasses many of the conceptual, technical-legal and substantive issues identified with regard to the patenting of the biotechnological inventions concerned. These include the difficulty of aligning entirely normative concepts, such as embraced in human rights law, with predominantly instrumental concepts, such as central to patent law; the important role corporations play in R&D and the attainment of inventions; the diversity of types of knowledge and the cultures in which they originate; the variety of legal systems and approaches in this world and the complexity of aligning them with one another; the intricacy and multiplicity of the biotechnological puzzle; and, as to conclude this limitative list of problems, the ambivalent relations between – and various claims of – individuals, communities, and peoples contributing knowledge to that puzzle. Ignoring these problems by, as seems to be the case, tailoring referenced human right to the needs of particular groups, such as indigenous peoples, and accommodating it to safeguard their selective, acute interests may be tempting – as the Committee’s approach shows.

However, the exploration undertaken makes clear that this will certainly create new problems. These include an overly proprietary-like approach and outlook, which will certainly enhance the perceived and disfavoured enclosure of knowledge relevant for life sciences endeavours. It may, furthermore, incur battles among addressees of the same human right. Any ‘production’ – any kind of knowledge – relevant for biotechnological endeavours, no matter how remote and indirect, is subjected to the human right envisaged by the Committee. Any use thereof, for any purpose, may thus trigger fierce battles among the ones upon which this right is bestowed. It is not deemed likely that this will further anybody’s interest. Moreover, the specific rights envisaged to further indigenous interests, may be discriminatory to non-indigenous traditional knowledge holders, and holders of other types of knowledge as well. At least, insofar as it is practically feasible to distinguish between the origin and contents of knowledge publicly exchanged and shared among peoples around the world. Furthermore, any excessive interpretation

of Article 15(1)(c) ICESCR will most likely heavily burden, perhaps even distort, the European patent regime. Whereas the normative load of human rights law may seem to justify any mitigating effect on and restriction to any other legal regime, the ethical appropriateness of these effects may need to be scrutinized too. The European patent regime may contribute to the enhancement of some of the interests safeguarded by human rights too. One could think of accelerating R&D in the pharmaceutical field – thus health.

It is therefore suggested that the merits of the aforementioned conceptual, technical-legal and substantive problems are given further attention. Only if one focuses, one may see, start to comprehend, and eventually get constructive, feasible ideas. Any attempt to rebut the human rights implications of patenting biotechnological knowledge should commence there. This may subsequently lead to appropriate attempts to coherently integrate the regimes at hand – and thus truly safeguard the underlying interests that they may both relate to, which causes them to touch upon each other in the first place. It must so be concluded that we are currently only at the very beginning of our attempts to strive for integration of and balance between the regimes concerned, and cumulative protection of the interests at hand. But every beginning, even a slow and complex one, leads to an end. We should however, not be overly hasty and assertive as to reach quick solutions – as the Committee seems to have been. Such solutions may equally quickly lose their appeal and relevancy. ‘The proper preparation finishes half the job’, so the saying goes. Let’s get to it.

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ISBN 978-90-411-2653-5



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