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BOOK REVIEW

Neil Wilkof, Shamnad Basheer and Irene Calboli (eds): Overlapping Intellectual Property Rights

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Overlapping Intellectual Property Rights (2nd edn) provides an accurate overview of the existing overlaps in substantive scope and enforcement among IPRs, also going beyond the realm of IP law. The volume is structured in the following way. The first part is devoted to the investigation of a specific overlap among two selected exclusive rights, starting from a hypothetical situation. Per each pair of IPRs, the analysis is twofold, seeking to functionally compare the EU with the UK and US approaches, wrapping up with common conclusions at the end. Chapters 1 to 6 investigate rights overlapping with patents, Chapters 7 to 11 address overlaps concerning copyright, Chapters 12 to 18 delve into intersections with trademark rights, while Chapters 19 to 21 contain a miscellaneous of remaining overlaps. The second part is made of tables that allow the reader to grapple with the inhomogeneity in the way IPRs are differently framed in scope by national legislators.

Chapter 1 addresses *the overlap between utility patents and copyright* by focusing on computer software, one area where this overlap has a high commercial impact. Meyer underlines that business methods are in principle protectable under both copyright and patent law, leaving room for double protection. Many doctrines have been elaborated to distinguish between unprotectable ideas and expressions. Despite the differences among civil and common law countries, the scope of patent protection is held broader than copyright, thus the latter is frequently considered as a last resort. The chapter concludes on the pros and cons of enforcing copyright instead of patent rights. In the same fashion, while discussing *the interplay between patents and design rights*, Musker outlines the common practice of filing design rights as a backup where the patent is found invalid or expired. This is sometimes

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prevented thanks to judicial tools such as the post-expiry doctrine, anti-overlap provisions, priority rules and citation against either patents or designs.[1]

The lack of a uniform attitude reflects that there is no clear distinction in function between designs and patents, thus the distinctive traits of the two forms of protection are blurred. Instead, within *the interface between patents and trade secrets*, Bently and Aplin highlight that trade secrets can be claimed before the patent is published as a complementary form of protection or trade secrets are outright preferred to patents due to their undefined scope, informal and cheap nature, despite granting weaker protection.

Chapter 4 portrays the *overlap between plant variety protection* (PVP) *and utility patents*. As PVP does not give rise to the same level of exclusivity as patents, being subject to a broader list of exceptions (such as the "saved seed exemption"[2]), the interface PVP/patent might be problematic. Blocking problems may arise when patents prevent the development and commercialization of a new product, addressed at the EU level through experimental use provisions and cross-licensing mechanisms.[3]

The following chapter addresses *the relationship between utility models and patent protection*. Also here, utility models are held as a backup when obtaining an invention patent is too expensive, time-consuming, and difficult, relying on the circumstance that the standard for obviousness is lower for utility models and prior examination is excluded.[4] Then, *the intersection between patent protection and exclusivity regimes* for clinical trials data is examined. Market exclusivity regimes can be requested in tandem with the purpose of extending data protection unlimitedly. In particular, Curley and van den Horst flag as abusive dual market strategies based on the combined request to prolong the market exclusivity regime coupled with that of obtaining a Supplementary Protection Certificate (SPC).[5] The risk is to artificially associate the function of market exclusivity regimes with that of patent protection.

Chapter 7 delves into *the overlap between trademark and copyright*, with particular regard to US and UK law. An overlap materializes when a product can be protected through both copyright and trademark. When copyright expires, the trademark is still enforceable with regard to the label, the packaging and the appearance of the product. Isaac and Mende explain that these overlaps are frequent because copyright subject matter is progressively expanding, the limiting doctrines between the two rights have started converging and complementary trademark protection is often sought anti-competitively. Thus, both the Court of Justice of the European Union and UK courts have tentatively banned this twofold protection due to competition concerns.[6] The emphasis has been placed on the necessity of filing trademark applications in good faith, as well as on preserving copyright core

[1] pp. 36–41.

[2] p. 98.

[3] pp. 115 *et seq.*

[4] p. 129.

[5] pp. 149 *et seq.*

[6] pp. 181 *et seq.*

function of rewarding the author's intellectual creation through the lens of the "skill and labor" doctrine. In this sense, filing a trademark application in relation to a copyrighted work amounts to an irrebuttable presumption of bad faith.

Chapter 8 is devoted to *the interface between design and copyright*. The issue is to determine whether works of applied art are mandatorily to be protected under industrial design or copyright can be exercised as well. After an overview of the legal landscape under international IP law, Ricketson and Suthersanen illustrate three judicial approaches: full cumulative (France), partial cumulative (Germany pre-2013 and UK) and no cumulative protection at all (US).[7] At the end, possible solutions to the overlap are provided, such as including the notion of "works of applied art" within the umbrella of "literary works" (proposal one), freeing cumulative protection (proposal two) or adopting a mixed approach.

Interestingly, Chapter 9 analyzes *the overlapping protection of copyright, rights of publicity and personality rights*. The quandary arises if someone reuses a photograph or drawing of another person and the same would like to control such reuse and its impact on her reputation and honor. In the lack of an agreement, it is controversial whether personality rights act as a limit to reuse or licensing of the copyright over such photo or drawing. In the US, the conflict between personality rights (right of publicity) and copyright is solved in a way that works reflecting the identity or persona of the author are outright excluded from copyright subject-matter and prohibition of reuse is not generally considered in contrast with freedom of speech (First Amendment). Rather, in the UK, the right of publicity does not exist, but the same level of protection is granted through the doctrine of "passing off". Instead, in the EU, the crux of the matter rests on whether a public interest in disseminating personal information exists and is capable of outweighing copyright.

Chapter 10 addresses *overlapping rights on databases*. In the EU, the Database Directive displays a bifurcated approach, under which original databases are protected through copyright while non-original databases are protectable through sui generis rights. Yet the Directive has been applied fragmentedly across EU and national courts delivered contradictory readings of its definitions. In line with it, the EU Commission found that the scope of the *sui generis* right is controversial, carrying with it the risk of extending protection to data as such.[8] Additionally, unfair competition doctrines and licensing terms can also act as barriers to reuse. Although US law does not envisage a *sui generis* right-type protection for non-original databases, the same level of exclusivity with regard to database contents is achieved through other means like breach of contract, hot-news misappropriation, trespass to chattels or other federal law claims.[9] Despite the divergences, EU and US legal frameworks both confer a high level of protection to database contents, with the risk of paralyzing secondary innovation due to the lack of certainty as to whether mere facts and data should be protected.

Chapter 11 deals with the *overlaps between moral and economic rights*. The interplay between the two rights varies from the EU, where moral rights gain a lot of

[7] pp. 238 *et seq*.

[8] p. 289.

[9] pp. 295 *et seq*.

importance, to the US, where, instead, they are systematically underpinned. The case study of the chapter is taken from a Canadian judgement,[10] illustrating that the author can also decide to file a complaint against the unauthorized reproduction of his works in order to avoid damages to his reputation instead of claiming an infringement of economic rights. Yet the circumstance that the author lost the suit shows the difficulty in substantiating a complaint on moral rights. Without an explicit prohibition in copyright statutory law to make subsequent uses of a lawful reproduction is in fact difficult for the author to win in court if an infringement of economic rights cannot be concomitantly found. Furthermore, the core and role of moral rights under the various copyright traditions varies consistently, also leading to balancing exercises with opposed outcomes in case law.

Chapter 12 investigates *the relationship between the common law action of "passing off" and remedies offered by trademark law* with a strong focus on UK law, illustrating the convergences and emphasizing their complementary role. The same function-based comparative approach has been endorsed in Chapter 13, which explores *the overlaps among trade dress, designs and trademarks*, with particular regard to US and UK law.

Chapter 14 focuses on *the overlapping protection between geographical indications (GIs) and trademarks*, both animated by the goal to discourage unfair competition, sharing a "functional equivalence".[11] This blurs the distinctions among the two rights and increases the risk of overlap. As summarized in the concluding remarks, cumulative protection can be partial or total according to what legal status and regime has been adopted for GIs. In this respect, EU and US legislators have embraced opposite directions.

Chapter 15 discusses *conflicts in the enforcement between domain names and trademarks*. These conflicts may emerge in the case of cybersquatting, i.e. bad faith-driven registration of domain names which resemble someone else's trademark. As domain names do not fit into trademark law and rationale, new remedies flourished, further complicating the legal scenario. In addition, privacy concerns facilitate misuse of domain name registration, because the identity of the registerer remains unknown.

Chapter 16 explores the interface between *trademarks and publicity rights*, mainly focusing on UK and US law. The two rights share many commonalities in structure and rationale, as they can both be exercised in order to protect a person's commercial identity. Yet these claims can be outweighed by defenses grounded in free speech. In this respect, the Chapter delves into the First Amendment-test applied to determine the outcome of the balancing exercise, drawing examples from US case law. In this sense, Welkowitz seems to suggest that a judicial approach based on trademark dilution might have more chances to succeed than one relying on publicity rights.

Chapter 17 investigates *the intersection between unfair competition and trademark infringement claims*. In fact, it is possible for a third party to use a

[10] Canadian Supreme Court, *Théberge v. Galerie d'Art du Petit Champlain inc.* [2002] 2 SCR 336. The full text of the decision is available at https://scc-csc.lexum.com/scc-csc/scc-csc/en/1973/1/document.do.

[11] p. 379.

trademark in a way incompatible with competition law, thus the investment function is adversely affected. In addition, it may also occur that also the trademark's function of indicating origin is adversely affected by using trademarks as ad-words or keywords for the purpose of causing consumer deception, with the effect of infringing unfair competition law. Nordemann and Aaaron-Stelluto mostly consider EU (and German) law with few references to US law. If in the EU trademark law and unfair competition law are separate and sometimes complementary, trademark law is rather considered as a subset of unfair competition law in the US. The case of comparative advertising is held as an example of potential conflict between the goals of unfair competition law and trademark law.

In Chapter 18 Calboli delves into the overlaps *among certification or collective marks and trademarks or service marks*. The author points to the fact that this kind of overlap differs from others addressed in the book. In this case, rather than displaying an abusive intent, the combined use of multiple IPRs might have a beneficial effect on transparency by communicating to the consumer complementary information.

Chapter 19 summarizes the delicate *balance between competition law and IPRs*, with the aim of establishing whether competition law remedies can act as external limits to IP exclusivity. Looking at the goals and inherent conflicts of the two bodies of law from an economic-oriented perspective, Vinje and van Rooijen continue with a detailed overview of the refusal-to-deal judiciary under both EU and US law, also tackling anti-competitive misconduct involving standard-essential-patents (SEPs) on FRAND terms.

Chapter 20 focuses on the tensions between *trade secrets and privacy*. First, it points to the concept of secrecy, which may fulfil both the data protection and the trade secrets law standard. Then, Becker provides some examples of overlap, concentrating on data protection law provisions (Arts. 15 and 20 GDPR) which try to address the interface with trade secrets. Finally, the book concludes with a full chapter dedicated to the *overlap between IP and traditional knowledge*.

As hinted at above, this book contains an excellent comparative analysis of overlaps in and outside IP. It contains thought-provoking contributions, paramount in giving insights on how to address overlaps by endorsing a practical and insider-like approach to the problem. The authors brilliantly classify the most frequent overlaps, as well as noteworthy lawmaking and judicial approaches. In this sense, this volume inserts a high number of signposts in areas of IP lawmaking and enforcement where protection risks being problematically manifold, increasing uncertainty and posing the risk of over-enforcement. Without taking a univocal stance on how to address the quandary from a systematic perspective, some authors go so far as to propose or highlight the existing or potential fact-specific solutions. In other cases, overlaps are not considered aprioristically problematic and even held beneficial from a consumer-oriented perspective. While describing the overlaps, the authors portray the convergence in function of many IPRs, which leads to

juxtapositions in remedies and raises the question of whether and how to align them effectively. This sets the milestone for massive future research. In this light, this volume can be seen as both a fruitful guidance for practitioners dealing with overlaps and a comprehensive textbook for researchers handling functional equivalences among IPRs.

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