

Nuno de Araújo Sousa e Silva

The Ownership Problems of Overlaps in European Intellectual Property



Nomos

MIPLC

Munich
**Intellectual
Property**
Law Center

Augsburg
München
Washington DC



MAX-PLANCK-GESELLSCHAFT

UNA
Universität
Augsburg
University

TUM
TECHNISCHE
UNIVERSITÄT
MÜNCHEN

**THE GEORGE
WASHINGTON
UNIVERSITY**
WASHINGTON, DC

MIPLC Studies

Edited by

Prof. Dr. Christoph Ann, LL.M. (Duke Univ.)
Technische Universität München

Prof. Robert Brauneis
The George Washington University Law School

Prof. Dr. Josef Drexler, LL.M. (Berkeley)
Max-Planck-Institut für Innovation und Wettbewerb

Prof. Dr. Michael Kort, University of Augsburg

Prof. Dr. Thomas M.J. Möllers
University of Augsburg

Prof. Dr. Dres. h.c. Joseph Straus,
Max Planck Institute for Intellectual Property and
Competition Law

Volume 8

Nuno de Araújo Sousa e Silva

The Ownership Problems of Overlaps in European Intellectual Property



Nomos

MIPLC

Munich
**Intellectual
Property**
Law Center

Augsburg
München
Washington DC

Die Deutsche Nationalbibliothek verzeichnet diese Publikation in der Deutschen Nationalbibliografie; detaillierte bibliografische Daten sind im Internet über <http://dnb.d-nb.de> abrufbar.

The Deutsche Nationalbibliothek lists this publication in the Deutsche Nationalbibliografie; detailed bibliographic data is available in the Internet at <http://dnb.d-nb.de>.

a.t.: Munich, Munich Intellectual Property Law Center, Thesis "Master of Laws in Intellectual Property and Competition Law (LL.M. IP)", 2013

ISBN 978-3-8487-1395-0

1. Auflage 2014

© Nomos Verlagsgesellschaft, Baden-Baden 2014. Printed in Germany. Alle Rechte, auch die des Nachdrucks von Auszügen, der fotomechanischen Wiedergabe und der Übersetzung, vorbehalten. Gedruckt auf alterungsbeständigem Papier.

This work is subject to copyright. All rights are reserved, whether the whole or part of the material is concerned, specifically those of translation, reprinting, re-use of illustrations, broadcasting, reproduction by photocopying machine or similar means, and storage in data banks. Under § 54 of the German Copyright Law where copies are made for other than private use a fee is payable to »Verwertungsgesellschaft Wort«, Munich.

Aos meus avós:
José e Cândida
Joaquim e Lurdes

Foreword

This small book is the result of a Master thesis written between July and early September 2013, minor corrections and updates having been made. Intellectual Property is indeed a fascinating subject, though an ever-changing one. It is my faint hope that the fundamental thoughts expressed here can still bear some validity and interest in the upcoming years. I would be glad to get any comments, suggestions or ideas by mail (nsousaesilva@gmail.com).

In the process of writing this thesis I have thoroughly benefited from the physical and human resources of the MIPLC. I am deeply indebted to all the people that with small or big comments and conversations have expanded my knowledge and perspectives on this and many other topics, not only related to Intellectual Property. I must specially mention Domink Niedersüss for his meticulous reading of my thesis followed by the proverbial G and T and the “three cool cats”: Paraskevi, Kothainaiki and Kalliopi.

I am also obliged to Professor Matthias Leistner for his careful, precious and ready guidance. I owe gratitude to my aunt Julie and uncle Luis Miguel for the generosity of an attentive reading of the final text.

I remain thankful to my parents in every breath I take.

Finally, I want to thank Rita for showing me that "like billowing clouds, like the incessant gurgle of the brook, the longing of the spirit can never be stilled" (Hildegard von Bingen).

Vila Nova de Gaia, 9th March 2014

Inhaltsverzeichnis

Acronyms and Abbreviations	11
Abstract	15
I – The legal framework of ownership and overlaps	17
A. Introduction: the problem	17
1. The phenomenon of overlaps	17
2. Why are split ownerships a problem?	22
3. Methodology	26
4. Sequence	28
B. The ownership of copyright	29
1. Author's rights vs. copyright	30
2. Special cases of ownership	32
a) Employee's creations	33
1. Work for hire	33
2. Presumed assignment or licence	34
b) Several authors	35
1. Joint Works	35
2. Connected works	36
3. Collective works	37
4. Copyright in cinematographic works	38
II – Cases of ownership problems of overlaps	40
A. The case of trade marks & designs	40
B. The case of trade marks & copyright	45
C. The case of registered designs & copyright	50
D. The case of databases: sui generis right & copyright	56
E. The case of software and computer implemented inventions	61
III – Possible solutions to the problem	65
A. The extent of the problem	65

B. A general solution?	66
1. Avoiding the problem	66
a) Avoiding overlaps?	66
b) Avoiding differences in ownership?	68
2. Prevalence	68
3. Contractual or quasi-contractual solutions	69
a) Implied licence	69
b) Abuse of rights	71
4. Expanding copyright-internal solutions by analogy	72
a) On Analogy	73
b) Connected works	76
c) Joint works	77
IV – Conclusion	79
Annex	81
Annex I: The interface of designs and copyright under Russian law	81
Annex II: Selected Legislative Provisions	84
Bibliography	105

Acronyms and Abbreviations

AIDA	Annali italiani del diritto d'autore, della cultura e dello spettacolo
AIPPI	International Association for the Protection of Industrial Property
art.	Article
BC	The Berne Convention for the Protection of Literary and Artistic Works
BoA	Board of Appeal of the OHIM
BGB	Bürgerliches Gesetzbuch (German Civil Code)
BGH	Bundesgerichtshof (German Federal Court of Justice)
CDPA	Copyright, Designs and Patents Act 1988 [United Kingdom]
CDR	Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs OJ L 3, 5.1.2002, p. 1–24
CPD	Directive 2009/24/EC of the European Parliament and of the Council of 23 April 2009 on the legal protection of computer programs (Codified version) OJ L 111, 5.5.2009 p.16–22
CJEU	Court of Justice of the European Union, formerly designated European Court of Justice.
CTM	Community Trade Mark
CTMR	Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark (codified version) OJ L78, 24.3.2009, p. 1–42
CRD	Community Registered Design
DatD	Directive 96/9/EC of the European Parliament and of the Council of 11 March 1996 on the legal protection of databases OJ L077, 27.3.1996, p.20–28
ed	editor
edn	edition
EE	Edward Elgar
EIPR	European Intellectual Property Review

Acronyms and Abbreviations

EPC	Convention on the Grant of European Patents (European Patent Convention)
ERPL	European Review of Private Law
fn	footnote
GC	General Court, formerly designated Court of First Instance
GIs	Geographical Indications
GRUR	Gewerblicher Rechtsschutz und Urheberrecht
GRUR Int	Gewerblicher Rechtsschutz und Urheberrecht Internationaler Teil
HLR	Harvard Law Review
ICESCR	International Covenant on Economic, Social and Cultural Rights (adopted 3 January 1976) 993 UNTS 3
IIC	International Review of Intellectual Property and Competition Law
IP	Intellectual Property
IPQ	Intellectual Property Quarterly
IPRs	Intellectual Property Rights
JIPITEC	Journal of Intellectual Property, Information Technology and E-Commerce Law
JIPLP	Journal of Intellectual Property Law and Practice
JIPR	Journal of Intellectual Property Rights
JWIP	Journal of World Intellectual Property
JZ	Juristen Zeitung
ItalCA	Legge sul diritto d'autore, Legge 22.4.1941 n° 633, G.U. 16.7.1941 (Italian Copyright Act)
n	note
OHIM	Organization for the Harmonization of the Internal Market
OJLS	Oxford Journal of Legal Studies
OUP	Oxford University Press
ÖUrHG	Bundesgesetz über das Urheberrecht an Werken der Literatur und der Kunst und über verwandte Schutzrechte (Urheberrechtsgesetz) 1936 (Austrian Copyright Act)

para(s)	paragraph(s)
PTCA	Código do Direito de Autor e dos Direitos Conexos, Decreto-Lei n.º 63/85, de 14 de Março (Portuguese Copyright Act)
RIDA	Revue Internationale du Droit d'Auteur
rn	randnummer
S	Section
TFEU	Consolidated version of Treaty on the Functioning of the European Union
TRIPS	Agreement on Trade-Related Aspects of Intellectual Property Rights, Marrakesh Agreement Establishing the World Trade Organization, Annex 1C
UNTS	United Nations Treaties Series
UrhG	Gesetz über Urheberrecht und verwandte Schutzrechte (Urheberrechtsgesetz) 1965 (German Copyright Act)
USC	The United States Code
WIPO	World Intellectual Property Organization
WIPR	World Intellectual Property Report
ZGE	Zeitschrift für Geistiges Eigentum
ZUM	Zeitschrift für Urheber- und Medienrecht
ZUM-RD	Zeitschrift für Urheber- und Medienrecht Rechtsprechungsdienst

Abstract

Due to a variety of factors, Intellectual Property rights are expanding and, as a result, overlapping more than ever before. This phenomenon poses a wide array of problems and challenges to a system which was initially devised as comprising a set of isolated compartments, each with its defined purpose, object, and specific set of rules. As no careful thought on the interaction of these rights in cases of overlapping protection seems to have been given by the legislators yet, the solutions to the arising questions are far from obvious or established.

Among the diverging rules between IPRs the ones concerning ownership and entitlement can easily lead to situations where different rights on the same object are owned by different persons. Thus the question emerges: what happens when two (or more) different people own different rights whose object is the same? How to solve the situation where objective cumulation is not mirrored by subjective cumulation?

If a professor creates an original database and is accordingly entitled to copyright and, her employer, the University has put substantial investment in its creation, owning the *sui generis* right therein, how can exploitation occur? What rules regulate the conflict between the creator of a logo and the company that registers and uses it as a trade mark?

These questions are analysed under European law, focusing on the existing corpus of EU primary and secondary legislation and jurisprudence. When the EU body of law provides no guidance or a national example is required, that analysis focuses on three countries: Germany, France and the UK, other jurisdictions being also considered.

The paper starts by describing the occurrence of overlaps and the dangers deriving from split ownership. A study of the diverging rules of copyright ownership is necessary in order to define some operative concepts. The issue is then considered in five specific cases of overlapping protection: trade marks and designs, trade marks and copyright, designs and copyright, database *sui generis* right and copyright and, finally, copyright and patents in the field of computer programs.

From the analysis of these cases some conclusion are drawn regarding the way legal rules answer to the split ownership problem and to what extent the existing approach is commendable.

The paper ponders and suggests some solutions to the problem, namely the convergence of ownership rules, the avoidance of overlaps *tout court*, the prevalence of the closest regime, abuse of rights, implied licences, and expanding copyright solutions by analogy. It is suggested that the latter is the best approach even though a combination of some of the mechanisms described is to be expected. It concludes by considering possible legislative intervention and the form it might take.