

# Index

---

- adjudication, legal  
  *see also* decision making, judicial;  
  discretion, judicial  
  binding precedents *see* binding precedents  
  coexistence of rule-like and standard-based solutions 26  
  context 28–9  
  creation of law by courts 30  
  deductive reasoning by courts 31  
  earlier binding precedents 25–6  
  equity, role of 26, 72  
  establishment of facts 31  
  and form 25–88  
  inductive reasoning of courts 26, 64–5, 67, 107  
  injunctive relief *see* injunctions  
  judicial discretion 25, 35  
  legal directions, wording of 32, 40  
  obviousness test, inventions 25, 34  
  passing off, tort of 25  
  prior art 34, 35, 37, 55, 56, 60  
  rules *see* rule-bound decisions  
  standards *see* standard-bound decisions  
  statutory provisions, effects 31–2
- Aldous, Sir William 56, 57, 79, 80, 81, 113, 114, 129, 135, 140, 173, 225
- altruism  
  commitment to 181  
  and individualism 16–17, 180, 182, 185, 189–92, 203, 204, 213, 217, 232, 249, 252–4, 256  
  standard-bound decisions 13, 203
- America Invents Act (AIA) 91  
  pre-AIA US priority system 98, 99
- anachronism 47, 48, 51, 291
- appellate courts  
  copying of work, in copyright law 42–3  
  law-making an acknowledged role of 107  
  lower court's decision based on error of principle 42, 43
- Apple Computer 236–7
- appropriation theory 284
- arbitrary decisions 109, 111, 118
- architecture 213
- Arrow, K 258
- Atkinson, John (Baron) 194–5
- Ayres, I 260, 273–5
- balance of convenience test 84, 85
- balance of probabilities test 2, 31
- Barron, Anne 285
- Bently, L 100, 118, 120, 149, 160, 161–2, 178, 213
- bias, decision making 6–7  
  *see also* prejudices  
  arbitrary decisions 109, 111, 118  
  avoiding perceptions of 91, 105–24  
  coherence requirement 114–15  
  hypothetical and extreme examples 115–16  
  instances of 109  
  morality issues 111–24  
  'ordre public', contrary to 117, 119, 120, 121  
  risk 6, 91–2, 111
- binding precedents  
  *see also* adjudication, legal; decision making, judicial; discretion, judicial  
  classical trinity (principles of law binding present and future courts) 49, 53

- classification decisions 64
- decision making, judicial 59
- earlier 25–6
- ex ante* versus *ex post* decision making 93
- flexibility of standards 47
- guidance of future decisions 48
- BioIndustry Association, case law 108, 265, 266
- Bochnovic, John 152–6, 158, 159
- ‘bright line’ test 3, 4, 151, 221
- Brimelow, Alison (EPO President) 144
- Burrell, R 28
  
- Castells, Manuel 253
- cDNA fragments, case law 119
- celebrity endorsement 52, 53
- celebrity merchandising 53
- Christie, Andrew 33
- classical trinity (principles of law binding present and future courts) 49, 53
- coherence requirement, judicial decision making 44, 45
- morality issues, and bias 114–15
- Colomer, Ruiz-Jarabo 115
- colour, registration as a trade mark 27–8
- compensation, entitlement of employee inventors to 38–9, 41
- compilations 10, 162–4, 193, 195, 196, 198
- computer programs 7, 164, 165
- confidentiality, breach of 76
- confusion, likelihood of in trade mark cases 6, 101, 102, 103
- consequential reasoning 106
- constructive trusts 74
- context, importance in legal adjudication 28–9
- Convention on the Grant of European Patents *see* European Patent Convention (EPC)
- copying of work 10, 18, 42–3, 167, 195 *see also* copyright; skill, labour and judgement
  - electronic 180, 183
  - and infringement 148, 212, 219
  - music 193, 194, 200, 204
  - negligence 43
  - and originality 163, 198, 199–200
  - paintings 201, 202–3
  - part of a work 148, 167, 218
  - photographs 201–2
  - proof of 213
  - protection against 216
  - significant characteristics 236
  - skill, labour and judgement 193, 194, 198, 201
  - subconscious 20
  - unaltered 211
  - wholesale 216
  - work which is itself copied 10, 148
- copyright 9–10, 12–13, 14, 19–21, 192–223
  - artistic work 201, 202–3, 210
  - classification of works, proposal for abolition 33
  - compilations 10, 162–4, 193, 195, 196, 198
  - copying of work *see* copying of work
  - denial of 195–6
  - established characters 44–5
  - ‘Europeanization’ of UK copyright law 217
  - examination 271–2
  - ideas versus expression 190, 208, 212–14
  - Information Society Directive 165, 168, 191, 205, 217, 220, 221, 222
  - infringement claims 41, 54, 148, 167, 193, 204–17, 219
  - and internet 182–3
  - literary, dramatic, musical and artistic works: originality requirement 160
  - morality issues, and bias 111–13
  - originality condition *see* originality condition, copyright
  - partial taking 10, 14, 37, 59, 72, 93, 165, 167, 168, 217, 219
  - piracy 183
  - protectable subject matter, defining boundaries of 27, 147–8, 160–70, 176

- reproduction right 217
- risk 215, 216, 221
- rule-bound decisions 148, 219, 222–3, 248
- skill, labour and judgement, originality 161–3, 166, 193, 194, 196–9
- statutory defences based on ‘fair dealing’ 39
- subsistence and infringement 27, 169, 269
- substantial taking 13, 72, 169, 190, 206, 211, 213, 221
- traditional UK law 160
- UK approach to categorization 167
- Cornish, W 74, 82, 84, 153, 155, 161, 223, 230, 266, 271
- Court of Justice of the European Union (CJEU) 14, 33, 93, 175, 217, 263–4
- European integration, harmonization and form 143, 144
- ex ante* versus *ex post* decision making 100, 101, 103
- trade marks 235, 240, 241, 244, 248
- courts
  - creation of law by 30, 107
  - disagreements between EPC and UK courts 130
  - inductive reasoning of 26, 64–5, 67, 107
  - whether EPO decisions binding on UK courts 130
- Creative Commons organization 184
- critical legal studies movement 40–41
- damages, entitlement of owners to claim 75, 83
- decision making, judicial
  - see also* adjudication, legal; bias, decision making; discretion, judicial; rule-bound decisions; standard-bound decisions
  - arbitrary decisions 109, 111, 118
  - assessment and weighing of relevant factors 37, 39
  - attempts by EPO to disguise 137
  - binding precedents 59
  - containing rulings in points of law versus propositions of good sense 63
  - deductive reasoning by courts 31
  - distribution pattern 29
  - ex ante* versus *ex post* 92–105, 224
  - facts *see* facts, judicial decision-making
  - faith in decision making of experts 118
  - flexibility in 27, 32
  - founding of decision on an error of principle 42, 43
  - guidance of future decisions 48
  - inductive reasoning by courts 26, 64–5, 67, 107
  - prejudices, perceptions of 91
  - principled decisions 55, 59
  - rules or standards 26–7
- deductive reasoning by courts 31
- Demsetz, Harold 261–2
- digitization 7, 183
- Dinwoodie, Graeme 251
- Diplock, William John Kenneth (Baron) 15, 48, 49, 50, 59–61, 84, 92, 223, 225, 226
- discoveries, exclusion from patentable subject matter 70
- discretion, judicial 25
  - concepts/definitions 41–2
  - explanative 48
  - findings of primary fact 42
  - of future decision makers 48
  - infringement of copyright 54
  - purpose of legal provision, clarity of 36
  - rules versus standards debate 36, 37
  - strong versus weak sense 35
- Diver, Colin 31
- Drahos, Peter 54, 149, 177, 178, 206, 215, 229, 283, 285, 288
- Drassinower, Abraham 290
- duties, creation of scheme 29
- Dworkin, Ronald 30–31, 35, 38, 40, 41, 267

- electronic communications 182
- employee inventors, entitlement to
  - compensation 38–9, 41
- Endicott, T 46, 54
- EPC *see* European Patent Convention (EPC)
- EPO Boards 124, 127
  - see also* European Patent Office (EPO)
  - Boards of Appeal 8, 128, 129, 138, 145
    - Enlarged Board of Appeal 96, 139, 144, 145
    - Technical Board of Appeal (TBA) 68–9, 120, 140
- equity
  - duality between law, and 74, 86
  - as instrument of justice 84
  - recourse to 5
  - role in legal adjudication 26, 72
- European Commission, Green Paper (1997) 142
- European Court of Justice *see* Court of Justice of the European Union (CJEU)
- European Patent Convention (EPC) 7, 8
  - core purpose 127, 138
  - disagreements with UK courts 130 and European Union 127
  - harmonization attempts 135
  - invention to have been made available to the public 173
  - inventions and moral issues 117
  - member states 125, 130
  - patentable subject matter under 29, 67–8
- European Patent Office (EPO) 7, 29, 272, 273
  - see also* inventions; patents
  - Administrative Council 141
  - ‘any hardware approach’ 132, 133–4
  - attempts to disguise decision making 137
  - Boards *see* EPO Boards
  - decisions of, whether binding at national level 130
  - Examining Division 68
  - law-making power 67
  - morality issues, and bias 117
  - Opposition Division 119–20, 122–3
  - primary responsibility 140
  - problem and solution approach 152
  - Technical Board of Appeal (TBA) 131, 132
- European Union (EU) 14
  - first-to-file approach 91, 98
  - harmonization mechanisms 127
  - impact of UK’s probable exit from 29, 221
  - institutions 142
  - integration and harmonization 91, 125–46
  - member states 160
  - originality condition, copyright 220, 221
  - patent system 29, 137–8
- ex ante* versus *ex post* decision making
  - 91, 92–105, 224
  - trade marks 99–105
- experimentation, inventions 59, 60, 62
- facts, judicial decision making
  - assessment of 35–6
  - discovery of 36
  - establishment of 31
  - finding of specific fact versus inference from facts specifically found 36
  - findings of primary fact 42
  - hearing of appeals, errors of principle 42, 43
  - inventions 34
  - person skilled in the relevant art 56
- fairness
  - adoption of relevant factors 41
  - application by judges 6, 71
  - copyright statutory defences based on ‘fair dealing’ 39
  - employee inventors’ entitlement to compensation 38–9, 41
  - fair dealing, publication of private memoranda 45
  - and obviousness 44
  - principles laying beyond legal provision 43–4

- trade marks 247–8
- ubiquity of term, in English law 44
- filtration processes, case law 60
- final injunctions 78–9, 80, 81–2
- flexibility
  - injunctions 4–5
  - judicial discretion and legal standards 27, 32, 45, 47
  - passing off, tort of 48–9
  - value in 3
- flocculating agents, case law 60, 61
- Fox, H 154–5
- Fry Committee 271
  
- Gangjee, Dev 251
- Gerhardt, Deborah 256
- glutamine synthetase inhibitors, plant
  - cells resistant to 123
- goodwill 50, 53, 65, 66
- Gratwick, S 153, 154
- Griffiths, Andrew 158, 263, 264
- Griffiths, Jonathan 206–7
  
- H2-preprorelaxin, case law 119
- Handler, M 28
- Hargreaves Review (2011) 182, 214
- harmonization and integration,
  - European 125–46
    - adoption of rules and standards at supra-national level 7, 125–6
  - Biotechnology Directive example 127
  - codification 125–6
  - harmonization goal as overriding objective 138
  - originality test 165
  - and UK Court of Appeal 128
- Hepatitis C virus (HCV), case law 80
- Heydon, JD 44
- Hoffmann, Leonard Hubert (Baron) 15, 34, 37, 38, 42, 43, 54–5, 63, 128, 130, 150, 152, 156, 159, 168, 172, 173, 205–7, 211, 216, 217, 220, 248
- Hohfeld, Wesley 29–30, 105, 215
- Holmes, Oliver Wendell 203
- Hughes, Justin 197, 207, 231, 283, 284
  
- ideas versus expression 190, 208, 212–14
- identity 11, 17, 192, 206, 253
  - defined 253
  - double 239, 241, 246
  - individual 123, 253
  - trade marks 10, 149, 175, 191, 239, 240, 241, 244, 248, 251, 254, 256, 282
- individualism 12, 181
  - and altruism 16–17, 180, 182, 185, 189–92, 203, 204, 213, 217, 232, 249, 252–4, 256
  - economic 186, 187
  - Kantian 287–9
  - liberal 23, 283, 286, 288
  - and patents 191
  - political 188
  - and rules 188, 189, 203
  - and trade marks 191
- inductive reasoning of courts 26, 64–5, 67, 107
- inflexibility
  - see also* flexibility
  - non-express trusts 72
  - and requirement regarding harm 72
  - of rules 46–7, 71
- infringement claims 27
  - copyright 41, 54, 148, 167, 193, 204–17, 219
  - counter-claims 170
  - declarations of non-infringement of copyright 169
  - national courts, decisions of 29
  - partial taking 167
  - relative infrequency of actions 268
  - termination of infringement 84
  - tests determining 28
  - trade marks 101–3, 238–9
- injunctions 4–5, 26
  - final 78–9, 80, 81–2
  - interim 5, 84, 85–6, 87
  - post-expiry 77, 82
  - reasonableness 77
  - springboard 75–8
  - transaction costs 83
  - UK compared to US 80–81
- intellectual property (IP) law

- see also* copyright; inventions;  
 patents; trade marks  
 creation of scheme of duties as  
 opposed to rights 29  
 damages, entitlement of owners to  
 claim 75, 83  
 description of colour by reference to  
 (trade marks) 27–8  
 economic justifications underpinning  
 46  
 enforcement 74–5  
 intangible abstract objects of IPRs 54  
 no rivalry in the consumption of  
 intellectual goods 179  
 public power of intellectual property  
 11  
 rights and remedies of owners 74  
 rules, infrequently encountered 19  
 shareability of information 180  
 terminology 27  
 Intellectual Property Office, UK, Trade  
 Marks Manual 115  
 interim injunctions 5, 84, 85–6, 87  
 internet 182–3  
 interpersonal/social dimension 178–  
 256  
 and rivalry 179  
 inventions  
*see also* patents; priority dates,  
 patents/inventions  
 compensation, entitlement of  
 employee to 38–9, 41  
 concept of invention 135, 151  
 degree of novelty or difference from  
 the prior art 159  
 exclusions 135  
 experimentation, product of 59, 60,  
 62  
 fair share of benefit, employee  
 inventions 38–9  
 industrially applicable condition 151  
 inventive step requirement 34, 59–60,  
 97, 151, 153, 159, 160, 166  
 morality issues, and bias 117  
 novelty requirement 34, 35  
 obviousness test *see* obviousness test,  
 inventions  
 prior art *see* prior art  
 requirement of inventiveness 153  
 simple facts 34  
 software-implemented, patentability  
 130, 132  
 and state of the art 33  
 technical character 131, 135, 136–7,  
 139  
 tests 153  
 whether patentable under the terms of  
 the EPC 29  
 Jacob, Sir Robert Raphael Hayim  
 ‘Robin’ 32, 56, 61–3, 70, 103, 128,  
 129, 133, 138, 139, 145, 161, 195,  
 199, 212, 219, 223, 245  
 judicial activism, limits 187–8  
 judicial discretion *see* discretion,  
 judicial  
 justifications underpinning intellectual  
 property law 257–92  
 economic 18, 46  
 research and development (R&D),  
 investment in 21, 258–61  
 theories 267  
 trade marks 262–3  
 Kamien, M 258  
 Kant, Immanuel 23, 190, 284–9  
 individualism 287–9  
 Kelman, Mark 188–9  
 Kennedy, Duncan 12, 35–6, 40, 180–82,  
 185–9, 253, 286–8  
 Kitchen, Sir David James 264  
 Klemperer, P 260, 273–5  
 Knight, Frank 259  
 Kozinski, Alex 233–4  
 Laddie, Sir Hugh Ian Lang 53, 62  
 laissez-faire theory 186  
 Lalande, Michel-Richard de 162, 193,  
 194, 199  
 Landes, W 82, 201, 206–7, 211, 229,  
 230, 257, 261–5, 271  
 legal directions  
 content and scope 47  
 extraction for an earlier decision 47  
 morality conditions 111

- personal convictions, figuring in  
     decision making process 91  
 standards, framed as 93  
 wording of 32, 40
- legislation  
   bias, avoiding perceptions of in  
     decision making 91, 105–24  
   creation of law by courts 30, 107  
   defined 32  
   European integration and  
     harmonization 91, 125–46  
   *ex ante* versus *ex post* decision  
     making 91, 92–105  
   legislative power and harmonization  
     89–146  
   limits on law-making powers 89  
   past decisions, unavailability of  
     107–8  
   patent law 58–9
- Lemley, Mark 269, 272, 273, 274, 275
- Lewison, Kim Martin Jordan 102–3
- licences, compulsory 80–81
- likelihood of confusion, trade marks 6,  
   101, 102, 103
- literary works, originality 193, 200, 207
- Llewellyn, Karl 125–6
- Locke, John 283, 284
- luxury goods 254–5
- MacCormick, Neil 31, 32, 48, 63–4
- Machlup, Fritz 291
- MacMillan, Hugh (Baron) 196
- Mansfield, E 258
- Mansfield, William Murray  
   (eighteenth-century judge) 228
- Medicines Patent Pool (MPP) 184
- Merges, Robert 262, 272, 283, 284–9  
   *Justifying Intellectual Property* 23
- misrepresentation 49–51  
   *see also* passing off, tort of  
   deceptive 51, 52  
   material 50  
   reappraisal of notion 52  
   reliance upon 50
- monopoly-profit-incentive thesis 267,  
   281
- morality issues, and bias 111–24
- copyright 111–13  
 impartiality of judge 114  
 patents 117–18  
 surveys and opinion polls 121–2  
 trade marks 114–15
- Munich Diplomatic Conference (2000)  
   69, 137, 141, 143
- music, copying of 193, 194, 200, 204
- Neuberger, David Edmond (Baron) 28,  
   65, 67, 78–80, 90, 108, 125,  
   129–30
- novelty requirement, inventions 34, 35
- protectable subject matter, defining  
   boundaries of 151, 159
- tests 151
- obiter dicta* 47
- obviousness test, inventions 25, 34, 42,  
   63, 223, 224, 227  
   *see also* inventions  
   *ex ante* versus *ex post* decision  
     making 94  
   and fairness 44  
   harmonization and integration,  
     European 140  
   ‘obvious to try’ test 60, 61, 62, 64  
   protectable subject matter, defining  
     boundaries of 152–3, 154–5  
   requirement of non-obviousness 157
- Office for Harmonisation in the Internal  
   Market (OHIM) 279  
   Boards of Appeal 116, 117  
   Guidelines 115
- Oliver, Peter Raymond (Baron) 36, 49,  
   50, 53, 65, 157, 159, 163, 198–201
- open access movement 183
- opinion polls 121–2
- ‘ordre public’, patents contrary to 117,  
   119, 120, 121
- originality condition, copyright 148,  
   160–68, 190, 192, 270  
   *see also* copyright  
   computer programs 164, 165  
   and copying 163, 198, 199–200  
   creativity 195  
   databases 165

- dispensing with 168
  - European law 220, 221
  - Information Society Directive 165
  - literary works 193, 200, 207
  - meaning 205
  - photographs 164, 165
  - 'rule-like' nature 169
  - skill, labour and judgement 161–3, 166, 193, 194, 196–9, 201
  - UK test 165
- Palmer, Tom 291
- Parker, Hubert Lister (Baron) 35, 50
- partial taking, copyright 10, 14, 37, 59, 72, 93, 165, 167, 168, 217, 219
- passing off, tort of 25
- see also* misrepresentation
  - Australian law 66
  - celebrity endorsement 52, 53
  - classical trinity 49, 53
  - common law nature 48–9
  - goodwill 50, 53
  - 'Jif Lemon' case 49, 53
  - misrepresentation 49–51
  - name choices and packaging, similarities in 51
  - own-brand products 51, 52
  - proof of relevant commercial activity 66
  - public perception 51
  - trade mark registration system 100
- Patent Office *see* European Patent Office (EPO)
- patents 14–16, 223–32
- see also* European Patent Convention (EPC); European Patent Office (EPO); inventions; novelty requirement, inventions; prior art; priority dates, patents/inventions
  - competitiveness of particular firm 58
  - concept of patentability 117
  - established characters 44–5
  - European system 29, 137–8
  - examination of applications in the UK 153
  - exclusion of discoveries from patentable subject matter 70
  - first-to-file approach 91, 98
  - goal of stimulating innovative activity 57
  - grant of letters patent 155
  - impact of UK's probable exit from the EU 29
  - and individualism 191
  - insular nature of law 118
  - in terrorem* effect of bad patents 274
  - interpretation problems versus classification 64
  - inventive concept 55
  - legislation 58–9
  - morality issues, and bias 117–18
  - 'obvious to try' test 60, 61, 62, 64
  - 'ordre public', contrary to 117, 119, 120, 121
  - person skilled in the relevant art 55, 56, 57, 59
  - post-grant matters, unitary patents 29
  - prejudices 56, 57
  - priority in patent claims 91
  - protectable subject matter, defining boundaries of 27, 147, 150–60, 170–74, 176
  - as registered rights 150–51
  - royalty payments 275
  - rule-based nature of substantive examination, in Europe 136–7
  - rule-bound decisions 136, 270
  - software-implemented inventions, patentability 130
  - statutory provisions 55
  - substantive examination, European 136, 137
  - unitary 29
  - US system 80–81, 269
  - validity 174
- Patents Convention *see* European Patent Convention (EPC)
- Penner, James 231
- Philips, Jeremy 264
- pipe corrosion, case law 60–61
- piracy 183
- plant biotechnology, case law 122, 124



- policies
  - justification of judicial decisions 45
  - principles compared 40
  - weight dimension 40–41
- Posner, R 82, 201, 206–7, 211, 229, 230, 257, 261–5, 271
- post-expiry injunctions 77, 82
- Pound, Roscoe 46
- precedent doctrine *see* binding precedents
- prejudices
  - see also* bias, decision making
  - absence of rules 91
  - patent law 56, 57
- Prescott, Peter (QC) 68, 69, 133, 134, 136
- principles
  - errors of principle, judicial decision-making 42, 43
  - justification of judicial decisions 45
  - policies compared 40
  - principled decisions 55
  - weight dimension 40–41
- prior art 20–22, 126, 132, 153, 158, 170–72, 271–3, 277, 278
  - see also* inventions; novelty requirement; patents
- devices 152
- documents 60
- ex ante* versus *ex post* decision making 97
- legal adjudication 34, 35, 37, 55, 56, 60
- and novelty 151, 159
- priority dates, patents/inventions 36, 56, 157, 173, 174, 273
  - see also* inventions; patents
  - date of filing of application 95
  - default position 95
  - earlier relevant applications 95, 96
  - establishing priority 97
  - ex ante* versus *ex post* decision making 94, 95, 97
  - interpersonal/social dimension 224–6, 229
  - and Paris Convention 96
  - ‘poisonous priority’ 96
  - rule-based determination 97, 268
  - and TRIPS Agreement 96
  - in United States 98
- progressive model of property rights 261–2
- promotional goodwill 53
- protectable subject matter, defining
  - boundaries of 147–77
  - copyright 27, 147–8, 160–70, 176
  - formal examinations 150
  - obscurity 136
  - patents 27, 147, 150–60, 170–74, 176
  - registration systems 150
  - tangible property 149
  - trade marks 27, 148–9, 174–6
- public interest test, compulsory licences 80–81
- Pumfrey, Nicholas Richard 68, 70, 130, 156, 209, 212, 213
- reasonableness, injunctive relief 77
- research and development (R&D) 21, 258–61
  - uncertainty 258, 259
- Rich, Giles 276, 277, 278
- rights
  - allocation at work 72–3
  - creation of scheme of duties as opposed to 29
  - ownership, law relating to 72–3
  - tests determining claims to 28
- risk 18, 21, 22, 28, 59, 62, 67, 106, 121, 143, 145–6, 232
  - bias 6, 91–2, 111
  - copyright law 215, 216, 221
  - deliberate taking of 85–6
  - justifications underpinning intellectual property law 260, 271, 273, 275–7, 280, 284
  - risk adverse individuals 58, 149, 272
  - versus uncertainty 259
- rule-bound decisions 25
  - see also* adjudication, legal; legislation; standard-bound decisions

- absolute precision in drafting,
  - impossibility of 33
- adoption of general rules at
  - supra-national level 7, 125–6
- and arbitrary decisions 109
- bias, avoiding perceptions of 106–7
- choice between rules and no rules 89, 91
- clarity and predictability
  - characteristics 26–7, 36, 45, 136
- and codification 125–6
- coexistence of rules with standards 26
- comparison of rules with principles
  - and policies 40
- comparison of rules with standards 2, 26–7, 35–6, 37, 45, 92
- concepts 30–31
- copyright 148, 219, 222–3, 248
- deliberate taking of risk 85–6
- ex ante* versus *ex post* decision making 94
- formulation of the rule as a rule 32
- ideal rules 30, 90, 136
- impossibility of perfect rules 90
- individualism 188, 189, 203
- inflexibility of 46–7, 71
- infrequent occurrence of rules in intellectual property law 19
- interim injunctions 84, 85–6, 87
- inventions 151
- legislative provisions formulated as rules 32–3
- limits on law-making powers 89
- originality condition, copyright 148
- over- or under-inclusiveness as to purpose 46
- patents 136, 270
- prejudice, in absence of rules 91
- priority dates 96, 97, 268
- recognition of rule as binding by courts 32
- rules versus standards debate 1, 26, 30–31, 35–6, 46, 91, 185
- source of binding rules 32
- trade marks 248
- undesirable outcomes 47
- Schlag, Pierre 26
- Schwartz, N 258
- Senftleben, M 241
- Shapiro, C 272
- Sherman, B 100, 118, 120, 149, 160, 161–2, 178, 213
- similarity test
  - copyright 167
  - trade marks 6, 11, 101–3, 175, 176, 244
- skill, labour and judgement 161–3, 166, 196–9
  - copying of work 193, 194, 198, 201
  - copyright infringement 206–7
- Social Darwinism 187
- social psychology studies 182
- software-implemented inventions,
  - patentability 130, 132
- Spence, M 46, 54
- Spencer, Herbert 276
- springboard injunctions 75–8
- standard-bound decisions
  - see also* adjudication, legal; bias, decision making; rules administration costs, increasing 46
  - adoption of standard at supra-national level 7, 125
  - altruism 13, 203
  - assessment of confusion, in trade mark cases 101
  - assessment of facts 35–6
  - and codification 125
  - coexistence of standards with rules 26
  - coherence requirement 44, 45
  - comparison of standards with factors 38
  - comparison of standards with rules 2, 27, 35–6, 37, 45, 92
  - discretion, exercise of 36
  - economic efficiency 93
  - efficiency considerations 46
  - errors of principle, appealing of decisions 42, 43
  - ex ante* versus *ex post* decision making 93, 94
  - flexibility and dynamism requirements 27, 45, 47
  - and foresight 5–6

- foresight requirement 105
- interim injunctions 84, 85–6, 87
- legal directions framed as 93
- limits on law-making powers 89
- negligence 42
- principles 40
- priority in patent claims 91
- reference by appellate courts to standards 42
- rules versus standards debate 1, 26, 30–31, 35–6, 46, 84, 91, 185
- uncertainty up to point when decision made 150
- standards of conduct 72
- state of the art, inventions 33, 34
- statutory provisions
  - effect on legal adjudication 31–2
  - imprecise language 32–3
- substantial taking, copyright 13, 72, 169, 190, 206, 211, 213, 221
- Sunstein, Cass 1, 30, 32, 33, 35, 37–41, 46, 47, 71, 86, 89, 92, 106, 125, 182
- Supreme Court, UK 65, 108
- surveys 121–2
  
- technical character, patents/inventions 131, 135, 136–7, 139
- territory, right of property owners to exclude others from 29–30
- Trade Mark Register 279, 280
- trade marks 10–11, 17–18, 22, 232–56
  - brand extension 237–8
  - colour, registration as a trade mark 27–8
  - Commission reform proposals 246
  - double identity 239
  - established characters 44–5
  - ex ante* versus *ex post* decision making 99–105
  - exclusive rights provided to owners 17
  - fair competition 247–8
  - form and substance, correspondence between 191
  - functions 244–5, 250–51
  - graphic representation requirement 28
  - grounds for refusing registration 27, 100, 101, 104–5, 175
  - identity 10, 149, 175, 191, 239, 240, 241, 244, 248, 251, 254, 256, 282
  - and individualism 191
  - information systems and networking 252–3
  - informed choice 255
  - infringement claims 101–3, 238–9
  - keywords 242
  - likelihood of confusion 6, 101, 102, 103
  - luxury goods 254–5
  - morality issues, and bias 114–15
  - network effects 280
  - owners' rights versus claimed rights to free use 235–6
  - protectable subject matter, defining boundaries of 27, 148–9, 174–6
  - public policy, contrary to 116
  - registration system 27, 100–101
  - rule-bound decisions 248
  - similarity test 6, 11, 101–3, 103, 175, 176, 244
  - Soviet Union, representation of the coat of arms 116
  - sports clubs and associations 236–7, 240
  - statutory defences to infringement claims 238–9
  - ubiquitous nature of 233
- trusts, non-express 72
  
- uncertainty 46, 54, 67, 82, 84, 150, 259–62, 269, 274–8
  - patents or inventions 152, 153, 273, 278
  - reducing 19, 21, 22, 265, 266, 267
  - research and development (R&D) 258, 259
  - and rights 262
  - versus risk 259
  - validity 266, 273, 278
- unconscionability 4, 72, 74

- United States
- America Invents Act (AIA) 91, 98
  - compared to United Kingdom
    - 80–81
  - first-to-invent scheme, priority determination 91
  - patents 80–81, 269
  - priority dates, patents/inventions 98
- Vaver, David 80, 265
- Wagner, S 258
- Waldron, Jeremy 197, 215
- Wendell Holmes, Oliver 203
- White, Alan 223
- Younger, Judge 111–13