

# Index

---

- academic research *see* research,  
academic
- accidental genius 169, 172–4
- accidental inventor 11, 164, 185
- Ace Insurance Ltd v Trifunovski* 181
- Acharya, V. 470
- Act on Employees' Inventions 119, 192,  
195, 212
- Aeronautical Research Laboratories  
134–5
- Aetna-Standard Engineering Co. v.  
Rowland* 202, 206
- agency-theoretical approach 465–6
- Agreement on Trade-Related  
Intellectual Property Rights  
345–6, 351
- AIPPI *see* Association Internationale  
pour la Protection de la Propriété  
Intellectuelle
- Alexander, R. 176
- Alfred E. Mann Institute 66–7
- Almunia, J. 303
- Amaco Australian Pty Ltd v Rocca Bros  
Metal Engineering Co Pty Ltd* 322
- Amalal Corporation Ltd v Maruha  
Corporation* 33
- AMD 289
- American Law Institute 216, 391–2
- Anderman, S. 157
- anti-competitive agreements 13, 220,  
240, 300
- antitrust 241, 258–9, 262–4, 271, 281,  
284–5, 288, 459
- Anton Piller KG v Manufacturing  
Processes Ltd* 336
- Anton Piller order 333, 336, 349–50
- Aoki, M. 460–461, 463
- Apple 227, 291
- Apple Computer Inc v Computer Edge  
Pty Ltd* 252
- appropriation rule 444–5
- Arklow Investments Ltd v Maclean*  
27–9, 33
- Armour, J. 468–9
- Arnold, Justice 357
- Arrow, K.J. 13, 255, 284
- Aspen Highlands Skiing Corp v Aspen  
Skiing Co* 262
- Associated Foreign Exchange Ltd v  
International Foreign Exchange  
(UK) Ltd* 356
- Association Internationale pour la  
Protection de la Propriété  
Intellectuelle 124
- Association of University Technology  
Managers 56, 63, 428–9
- AstraZeneca v European Commission*  
295
- AT&T 223
- Atari Games Corp. v Nintendo of  
America, Inc* 258
- Atlantic Philanthropies 415
- Austral Ships Pty Ltd v Damien Smith*  
170
- Austin, R. 450
- Australia 5–6, 37, 268–82, 324, 409,  
414–15
- breach of confidence 7
- business method 250
- collective agreement 167
- Competition and Consumer Act 239,  
261, 263
- competition law 238, 260
- competition restraint 366, 368
- Competition Tribunal 273
- contract law 177
- contract of employment 168–72

- courts 29, 178, 258, 321, 327, 448, 451  
     Court of Appeal 179, 181, 327  
     Federal Court 9, 75, 169, 181, 326  
     High Court 167, 180, 453  
     Supreme Court 79, 371, 373, 375  
 employee or contractor 11  
 Fair Work 165–6  
 fiduciary law 30  
     government 415  
     law 140, 444  
     manufacturing rights 135  
     monopoly 260  
     National Health and Medical Research Council 78  
     New South Wales 376–7  
     ownership 79, 164  
     patent law 47–9  
     protection 25  
     Reserve Bank of Australia 133  
     secret profit 452  
     statistical survey 367  
     tort 248  
     Trade Practices Act 35  
     universities 44, 49–50, 74–90  
 Australian Competition and Consumer Commission 280–281  
 Australian Consumer Law 22, 24, 27, 35–6  
 Australian Copyright Act 252  
 Australian Law Reform Commission 74  
 Australian Patent Office 170, 176  
 Australian Research Council 78  
 Australian Review of the Innovation System 183  
 Australian Vice-Chancellors' Committee 77  
 Austria 188, 196  
  
 Baker, J. 12  
*Balston Ltd v Headline Filters Ltd* 357  
 banking 458, 462, 468  
 bankruptcy 468–9, 471  
 Banks Committee 104  
*Banks v. Unisys Corp* 205  
*Banner Homes Plc v Luff Development Ltd* 34  
 Baumol, W. 268, 278  
  
 Bayh-Dole Act 44, 47, 49, 52–69, 76, 418–25, 427, 429  
*Bearing Point Australia Pty Ltd v Hillard* 371  
 Belgium 192–3, 195  
 Bell Laboratories 223  
 benefit sharing 138  
*Best Practices for the Licensing of Genomics Inventions* 427  
*BGC Capital Markets (Switzerland) LLC v Rees* 361  
*Bilski v Kappos* 251  
 biomedical research 429–30  
 biotechnology 60–61, 63, 66, 76, 407–8, 421, 427  
*Birdanco Nominees Pty Ltd v Money* 179, 327  
 BIS 4–5  
 black box recorder 134–5  
*Blackmagic Design Pty Ltd v Overliese* 326, 377–8  
*Blackpool & Fylde Aero Club Ltd v Blackpool Borough Council* 32  
 block exemption 239  
 Block Exemption Regulation 300–311  
*Board of Trustees of Leland Stanford Junior University v Roche Molecular Systems Inc* 47, 59, 67, 69  
*Boardman v Phipps* 448  
 Boyer, H. 60–61  
*BP Refinery (Westernport) Pty Ltd v Hastings Shire Council* 179  
 Bramwell, Lord Justice 150  
 breach of confidence 7, 22, 26, 28, 30, 33, 36, 83, 247, 327, 333, 352, 358, 373  
 breach of fiduciary duty *see* fiduciary duty  
*Brewer Street Investments Ltd v Barclays Woollen Co Ltd* 32  
 Breyer, Justice 59  
*Briggs v. R.R. Donnelly & Sons* 203  
*Bristol-Myers Squibb Co v FH Faulding & Co Ltd* 260  
 British Petroleum 57  
 Bromberg, Justice 182–3  
 bundling 288–90

- Bush, V. 52–3, 57, 64  
 business information *see* information, business  
 business-university collaboration 410–412, 414
- California 398  
 California Institute for Quantitative Biosciences 66  
 California Labor Code 204  
*Campbell Soup Co. v. ConAgra, Inc* 202  
 Canada 444, 451  
*Canadian Aero Services v O'Malley* 443, 447  
 Canadian Supreme Court 445, 451  
 cancer 427  
 Cancer Research UK 415  
 Cardozo, Justice 450  
*Carflow Products (UK) Ltd v Linwood Securities (Birmingham) Ltd* 29  
 cascading clause 375  
*CCOM Pty Ltd v Jiejing Pty Ltd* 251  
 Centers for Disease Control and Prevention 420  
 Centre for Business Research 470–471, 477  
 Chadwick, Lord Justice 34  
*Chan v Zacharia* 30  
*Chirnside v Fay* 33  
*Chrysler Motors Corp v Auto Body Panels of Ohio, Inc* 258  
 citation rates 61  
*City of Cocoa v. Leffler* 206  
 civil law 474, 476  
 Clayton Act 240, 280  
 Coca Cola 445  
*Coco v A N Clark (Engineers) Ltd* 22, 245, 334, 356  
 Cohen, S. 60–61  
 Cohen, W.M 61  
 collaboration 14, 17, 20–37, 55–6, 83, 97, 117, 183, 301  
 collaborative work 11  
*Collag Corp v Merck & Co Inc* 154  
 collective agreements 136, 154, 156–7, 161, 165, 167  
 Collins, H. 151  
*Commercial Plastics v Vincent* 154  
 Commonwealth 14, 16, 446–7, 451, 455  
 Commonwealth Scientific and Industrial Research Organisation 166  
 Community Patent Green Paper 188–9  
 Competition and Consumer Act 261, 265, 270–272  
 Competition Appeals Tribunal 261  
 Competition Commission 260–261  
 competition law 5–6, 12–14, 108, 237–42, 244, 253–4, 258, 261, 269–87, 290, 296–7  
 competition restraint 324–5, 345, 365  
 compulsory licensing *see* licensing  
 computer 286  
   code 254  
   manufacturers 258  
   program 124, 249, 252, 265  
   software 288–92  
   source code 289  
   surveillance 318–19  
   technology 142, 216, 257, 287  
 confidential information 7, 347–61  
   breach 22–9, 83  
   duty of fidelity 177  
   implied terms 158–60  
   litigation 316–23  
   non-compete 381, 384–5, 392–3  
   protection 365–6, 370–373, 376, 379  
   Restatement 217  
   restraint devices 330–342  
 confidentiality 161, 331–3, 335–40, 343, 345, 353–4, 365, 372, 374, 396  
   agreement 342, 367–8, 373  
   clause 10, 16, 319, 326  
   implied obligation 158, 334, 356, 366  
   provision 338  
 conflict rule 444–5, 448, 451–2  
 constitutional law 108  
 constructive trust 22, 33  
 continuous improvement 226  
 contract law 114, 246, 382  
   Australia 177  
   Europe 359  
   non-compete 382, 388  
   United States 199

- contract of employment 5, 10–11, 15–16, 137–9, 145–58, 188–97
  - academic 80–84, 87–8, 90
  - academic employees 48
  - accidental genius 173–4
  - Australia 167–72
  - breach 175, 191
  - common law 143–4
  - competition restraint 321
  - confidentiality 339–40, 343
  - confidentiality clause 319
  - confidentiality policy 368–70
  - copyright 95
  - cross-border 359–60
  - disclosure 325
  - duty of trust 327–8
  - employment law 164
  - Europe 197
  - express assignment 209
  - express terms 165, 173
  - fear of dispute 121
  - France 192
  - garden leave 370–371, 376
  - hired-to-invent 210–11
  - implied term 79, 176, 178, 181, 327
  - implied-in-fact 205
  - IP statute 77
  - jurisdiction 360–361
  - labour regulation index 471
  - legal status 184
  - limitations 161
  - minimal provisions 124
  - non-compete 381, 388–9
  - oral agreement 142
  - out of date 141
  - private time 171–2
  - restraint 259, 321
  - restraint clause 324, 328
  - restrictive clause 323
  - social problems 106
  - specific performance 371–2
  - teachers 96–7
  - trade secrets 338
  - workplace policy 325, 336, 338, 340, 343, 368–9
- contractors *see* independent contractor
- copyright 7, 9, 49, 93–100, 245–6, 252, 258
  - competition law 285–6, 292
  - compulsory licensing 260–261
  - course materials 77
  - infringement 160
  - knowledge transfer 407
  - limitations 252
  - patent misuse 264–5
  - restraint clause 328
  - sharing 222
  - song 223
  - trade secrets 394
  - unregistrable works 438
- Copyright, Designs and Patents Act 144, 146, 148, 155, 159, 260
- Copyright Act 94, 147, 258, 260
- Cornish, W. 146, 157
- corporate consent 454–5
- corporate governance 5–6, 14, 17, 443–78
- corporate opportunities rule 444–5, 449, 451–2
- Counties Manukau Pacific Trust v Manukau City Council* 33
- Courier Pete Pty Ltd v Metroll Queensland Pty Ltd* 174
- Creative Commons licenses 407
- creditor protection 463, 468–73
- creditor protection index 471
- Cumming, D. 468–9
- Cyber-Ark survey 316, 334
- Cyprotex Discovery Ltd v University of Sheffield* 154
- Dam, K. 254
- Data General Corp v Grumman Systems Support Corp* 258
- Davall and Sons 134–5
- David Leigh Wake v Soniclean Pty Ltd* 184
- De Long Corp. v. Lucas* 201
- De Maudsley v Palumbo* 23–4, 28
- de Vrey, R.W. 353
- Deed of Release 325
- Denmark 188, 196, 359
- Denning, Lord Justice 95, 162, 341
- Deshpande Center for Technological Innovation 66
- Dessemontet, F. 351

- Desyllas, P. 466
- determination of exceptional circumstances 422–3
- Development of Inventions Act 95, 107
- Diamond v Chakrabarty* 57
- director's duty 443–6
- dismissal *see* employment termination
- Disney 227
- dispute settlement 113, 123, 134, 144, 161
- distribution 43
- Dorr-Oliver, Inc. v. United States* 201–2
- drawings 170–171, 206
- Drucker, P. 226–7
- drugs *see* pharmaceuticals
- DuPont 221–2
- duty of fidelity 87, 158, 176–7, 191, 246, 372
- duty to invent 10, 15, 82–3, 87, 89, 141, 169, 174, 176
- Dyer, A.R. 98
- dynamic efficiency 12, 238–41
- Eastern Gas Board 447–8
- e-commerce 79
- Economic Espionage Act 331
- Edisonia v. Forse* 211
- EdSonic Pty Ltd v Cassidy* 168–70
- education 43, 82, 87, 339, 413, 458–9
- educational course materials 169
- Edwards, J. 133
- efficiency 237, 253, 271, 275, 281
- allocative 272, 274
- dynamic 12, 237–41, 272–4, 278, 280
- productive 274
- technical 272
- EK Nominees Pty Ltd v Woolworths Ltd* 24
- Electrolux v Hudson* 155
- Electronic Monitoring and Surveillance Survey* 317
- Emmanuel, E. 218
- Employee Involvement Association 228
- employee mobility 142, 214–17, 220–223, 230
- employee suggestion systems *see* suggestion systems
- employment contract *see* contract of employment
- employment law 8–12, 133–46, 456, 461, 469
- Australia 164
- control 151
- garden leave 341
- legal principles 75
- limitations 184–5
- Restatement of Employment Law 216–20, 391–2
- United States 199–213
- see also* labour law
- employment protection 465, 469, 477
- Employment Rights Act 146
- employment termination 339–42, 370–373
- deed of release 325
- dismissal 175, 191
- duty if confidence 358
- garden leave 365
- hired-to-invent 206–7
- Japan 121
- non-compete 381
- patent rights 173
- restraint clause 376
- restraint of trade 323
- trailer clause 202, 209
- Energy Biosciences Institute 56
- England and Wales Courts *see* United Kingdom, courts
- enterprise agreement 166–7
- equal treatment 118, 346
- equitable estoppel 22, 24, 27, 33, 35–6, 208
- equity 10, 14, 247
- essential facilities' doctrine 261–2
- estoppel *see* equitable estoppel
- ETH Technologies v Rytium* 356
- Europe 2020 Strategy 189
- European Charter and Treaty on European Union 108
- European Commission 46, 120
- computer technology 287
- cooperation on IP 189
- Green Paper on the Community Patent 116
- parallel trade 294

- research and development
  - agreements 300–303, 305, 311
- Single Market for Intellectual Property Rights* 346, 353
- trade secrets 326, 351, 362
- European Convention on Human Rights 107–8
- European Council 189
- European Court of Justice 218, 263, 292, 294–6
- European Parliament 120, 189
- European Patent Convention 112–13, 124
- European Union 6, 46, 48–9, 111, 114, 127, 188–90, 239, 263, 288–9, 301–3, 306, 311, 323, 345, 351, 358, 434
  - Anton Piller order 350
  - competition law 238, 286
  - consumer welfare 12
  - contractual claims 360
  - contractual obligations 359
  - exemption process 281
  - harmonization 112
  - legislation 119
  - patent extension 295
  - pharmaceuticals 293
  - reward system 197–8
  - Rome II Regulation 361–2
  - Trademark Directive 122
- Evening Standard Ltd v Henderson* 342
- Evershed, Lord 95–6
- exclusive exploitation 311
- exclusive rights 54, 61–3, 193, 248, 295, 319, 408, 422, 438
- Export Control Bill 108
- express assignment 89, 200, 203, 205, 209–10
  - future improvement clause 201
  - future invention clause 200, 204
  - specific purpose requirement 206
  - trailer clause 201–2
- express clause 179, 319–20
- express confidentiality agreements 7
- express contracts 47, 246
- express terms 15–17, 35, 80, 88, 144, 147, 153, 165, 169, 172–3, 185–6
- extramural grantee practices 428
- Faccenda Chicken Ltd v Fowler* 320, 339, 357–8
- faculty ownership 66–7
- Fagerberg, J. 459
- Fair Work Act 165, 167
- Fair Work Australia 137, 166
- Falce, V. 352
- Fama, E. 464
- Federal Court, Australia 169, 173
- Federal Employees' Incentive Awards Act 225
- Federal Screw Works v. Interface Sys., Inc* 202
- Federal Technology Transfer Act 420–421
- Federal Trade Commission 383, 393
- Ferrari 331
- fiduciary duty 18, 29–32, 75, 358, 377–8, 443–8, 450, 452, 454
  - breach 22, 26–8, 36, 84
  - law 33, 35
  - relationship 35
- Finland 188
  - trade secrets 353
- firm invention 142, 191–2, 194
- First Conference v Bracchi* 333, 359
- Flannigan, R. 358
- Food and Drug Administration 420, 430
- Forse, W. 211
- France 115, 188, 191–2, 195–6, 476
  - civil law 460
  - contract of employment 194
  - remuneration supplémentaire 194
  - trade secrets 353
- Francklyn v. Guilford Packing Co* 208–9
- Fraser v Thames Television Ltd* 22, 24
- French, Justice 62, 85–6
- funding agencies 422–4
- Furman, J. 458
- future improvement clause 201, 209
- future invention clause 200, 204, 210
- garden leave 341–3, 369–71, 375–6
- Gas Tool Patents Corp. v. Mould* 201
- gene patents 63, 67
- General Electric 225
- General Motors 331
- genes 427

- Genes and Ingenuity* 74  
 genetic diagnostic 61  
 Germany 192, 194, 196–7, 210, 461, 476  
     Act on Employees' Inventions 119, 192, 195, 212  
     civil law 460  
     reward system 195  
     trade secrets 353  
 Ghidini, G. 352  
*Gibson Motorsport Merchandise Pty Ltd v Forbes* 31–2  
 Gilson, R. 397  
 GlaxoSmithKline 294  
 Google 287  
 Goulding, Justice 357  
 governance indicators 459  
 government subsidies 458  
*Grant v Commissioner of Patents* 249, 251  
*Greater Glasgow Health Board's Application* 82, 100–101, 146  
*Griffiths & Beerens Pty Ltd v Duggan* 454  
*GTI Corp. v. Calhoun* 202  
 Guth, C. 445  
*Guth v Loft, Inc* 445  
*Guth v. Minnesota Mining & Mfg. Co* 205  
  
 Halligan, M. 342–3  
*Hanna v OAMPS Insurance Brokers Ltd* 375  
*Hapgood v. Hewitt* 219  
 hardcore restrictions 308–10  
 Hargreaves, I. 45  
 Harhoff, D. 125  
 harmonization 116, 120–121, 126–7, 189, 346–7  
*Harris' Patent* 99–101, 211  
 Hellermann Electric 99  
 hired-to-invent 204–7, 210, 219  
*Hivac v Park Royal* 356  
*Hoffman-La Roche v Commission* 289  
 Hoisl, K. 125  
 holdover clause *see* trailer clause  
*Hollis v Vabu Pty Ltd* 181  
 Horizontal Guidelines 304–7  
  
*Hospital Products Ltd v United States Surgical Corp* 453  
 hostile takeover 464  
 House of Lords 29, 108, 147, 447, 451, 454  
 Hovencamp, H. 12  
 Hughes, A. 466  
 human rights 108  
 Hungary 188  
  
 IBM 287–90  
 implied duty 175  
 implied obligation 158, 334, 356  
 implied term 15, 75, 137, 168, 171, 327  
     academic contracts 79–86, 90  
     common law 147  
     confidentiality 158–61  
     limitations 144–5  
*IMS Health GMBH v NDC Health* 291–2  
 independent contractor 136–8, 180–181, 184  
*Independent Service Organizations Antitrust Litigation* 264  
 India 210  
*Motilal Padampat Sugar Mills Ltd v State of Uttar Pradesh* 24  
 outside employee duty 211  
*Industrial Development v Cooley* 447, 450  
 information 214–16  
     business 242, 244–9, 259, 265, 317, 320, 333, 353  
     code 250, 289–90  
     companies 226–7  
     misappropriation 315  
     precompetitive 68  
     proprietary 220  
     secret 15, 204, 259  
     *see also* confidential information  
*Ingersoll-Rand Co. v. Ciavatta* 202–3  
 injunction 247, 324, 331, 348–50, 371–2, 391, 395  
 insolvency 462  
 Intel 287, 289  
 intellectual property 7, 9, 436  
     business information 242  
     codes 113

- employee generated 230
- employee rights 47
- employment-related 99
- law 41, 108, 120, 122, 146, 268
- legislation 44, 49
- licensing 301
- management 434–40
- policy 75, 79–80, 84
- post-employment 215
- protection 246–8, 252, 255, 258, 459
  - research and development 256
- rights 76, 117, 127, 223, 279, 310, 458
  - assignment 408
  - enforcement 349, 351
  - faculty ownership 66–7
  - infringement 346, 351
  - monopoly 292
  - protection 286
  - single market 119
  - software 290
  - United States 199
- rights exploitation 8, 42
- rights share 86
- statute 81
- trade secrets 326
- Intellectual Property Regulation 80
- interim injunction 349
- International Wood Processors v Power Dry, Inc* 258
- Internet 228, 354, 356
- Internet Explorer 290
- Ireland 195
- Irish Sugar v Commission* 289
- Italy 6, 142, 188, 191–7, 352
  
- J. Walter Thompson 223
- Jack, Justice 361
- Jacob, Lord Justice 100, 107, 152, 160
- Japan 60, 115, 121, 225–6, 461
- Jensen, M. 464
- JN Dairies v Johal Dairies and Singh* 332
- John Alexander's Clubs Pty Ltd v White City Tennis Club Ltd* 22
- Johns Hopkins University 63
- joint exploitation 160, 303, 305–9
- joint ownership 78, 114, 436–8
- joint venture 21, 23, 27, 30–31, 33, 185, 238–9, 257
  - Bayh-Dole Act 56
  - company 34
- Kaizen Teian 226
- knowledge management 227–9
- Kodak 222–3, 231
- Kohler, G. 60–61
- Kolodjashni v Lion Nathan T/A James Boag and Son Brewing Pty Ltd* 171–2
  
- La Forest, Justice 29, 33
- La Porta, R. 462, 471, 474, 476
- labour law 6, 8–12, 127, 133–43, 161, 470
  - agency-theoretical approach 465
  - Australia 164, 185–6, 268–9
  - European Union 111, 114, 120–124, 188, 195
  - see also* employment law
- labour regulation index 471
- Lac Minerals Ltd v International Corona Resources Ltd* 29, 33
- ladder clause 471
- Lambert, R.A. 414
- Lambert Review of Business-University Collaboration* 410, 414
- Lancashire Fires Ltd v S.A. Lyons & Co Ltd* 357
- Landmark Brickwork v Sutcliffe* 335
- Lando Commission 359
- Lasercomb America Inc v Reynolds* 265
- Lazonick, W. 457, 465
- Lee v Futurist Developments Ltd* 451
- Lee v Lee's Air Farming Ltd* 153
- legal title 77, 85
- Lemley, M. 351–2
- licensing 53–6, 418–22, 428, 434–40
  - agreement 60, 159–60, 422
  - assignment 211
  - Block Exemption Regulation 310
  - collaboration agreements 301
  - competition 269
  - compulsory 260–261, 289–91
  - discouragement 253
  - exclusive 63, 67, 308–9, 426–8



- follow-on opportunities 256
- multiple 62
- non-exclusive 62, 78, 199, 426–7
- patent misuse 265
- policy 17, 426
- price fixing 309
- royalty sharing 49
- shop right 212
- software 292
- technology transfer 61–7, 407–8, 411–13
- universities 428, 434–40
- LIFFE Administration & Management v Pavel Pinkava, De Novo Markets Ltd* 102, 104, 107, 159–60, 173
- Lisbon Treaty 120
- Littlewoods Organisation Ltd v Harris* 341
- Lockheed 227
- Loft Inc. 445–6
- Longmore, Lord Justice 102
- Lumley v Wagner* 371
- Luxottica Retail Australia v Grant* 317
  
- M Witmark & Sons v Jensen* 265
- Machlup, F. 68–9
- Mammalian Gene Collection 423
- Market Definition Notice 307
- market power 13, 16, 239, 242, 244, 254, 263, 272–4, 277, 279, 307
- marketing 4–5, 41–3
- Marlov Pty Ltd v Murat Col* 321
- Mason, Justice 453
- Massachusetts Institute of Technology 66
- material transfer agreements 61, 65, 424
- MCI Communications Corp v American Telephone and Telegraph Co.* 262
- McKinsey Consulting Group 227
- McLaren case 331–2
- McLelland, Justice 376
- medical ethics 98
- medicine 98, 106
  - licensed 63
  - personalised 62, 67
- Megarry, Justice 245
- Meinhard v Salmon* 450
- Mendoza, Advocate General 124
- merger 13, 240–242, 260, 266, 272, 280, 470
- Merges, R.P. 45, 67
- Merton, R.K. 54, 67
- Metroll Queensland Pty Ltd 174
- Microsoft 287, 289, 292
  - antitrust 288
- Microsoft Corp v Commission of the European Communities* 263
- Microsoft Corp v United States* 240, 258–9, 274, 276, 279–80, 297
- Millar, R. 374
- Miller, Baroness 108
- Milstein, C. 60–61
- Mines de Potasse d'Alsace* case 361
- misappropriation 14, 20–37, 395–6, 439
  - Anton Piller order 349
  - commercial information 245
  - examples 331–4
  - legal devices 315–16
  - trade secrets 216, 221, 247, 330, 335
  - TRIPs
- mobility 142
- Monash University 6, 87
- monopoly 8, 240, 248–9, 253–5, 257, 260, 262, 278–9, 285
- Monotti, A.L. 44
- Moore, Justice 168–9
- Morris, Lord Justice 96
- Mummery, Justice 97
- Murray, F. 61
- Murray v Yorkshire Fund Managers Ltd* 29
- Mutuality of Obligation 149–50
- Myriad Genetics 427
  
- National Academies of Science 61, 64
- National Association of Suggestion Systems 225
- National Cash Register Company 223
- National Center for Advancing Translational Sciences 68
- National Conference of Commissioners on Uniform State Laws 248
- National Employment Standards 167
- National Health and Medical Research Council 78
- National Health Service 297, 415

- National Human Genome Research Institute 423
- National Institutes of Health 17, 63, 68, 410, 413–15, 418–31
- National Principles of IP Management* 49, 78–9
- National Research Development Corporation v Commissioner of Patents* 249
- National Surgical Pty Ltd v McPhee* 317–18
- Natural Extracts Pty Ltd v Stotter* 452
- NESTA 4
- Netherlands 188, 192, 225, 353
- Nettle, Justice 79, 81
- New Britain Machine Co. v. Yeo* 201
- New Zealand 28, 32–3
- Noah v Shuba* 97
- non-compete 381–98
  - agreement 201–3, 216–18, 220, 230
  - contract of employment 388
  - covenant 381
  - geographical restriction 385–8
  - injunction 391
  - law 381–93
  - restraint of trade 390
  - statutory exception 397
  - time limits 384–5
  - trade secrets 394
- non-disclosure agreement 222, 339
- non-exclusive licensing *see* licensing
- non-fiduciary relationship 31–2
- Nordenfelt v Nordenfelt* 354
- Nordenfelt v The Maxim Nordenfelt Guns and Ammunition Co Ltd* 155, 322
- Norway 188
- NT Power Generation Pty Ltd v Power and Water Authority* 263
- OAMPS Insurance Brokers Ltd v Peter Hanna* 375
- occasional invention 142, 191–2
- Ocular Sciences Ltd v Aspect Vision Care Ltd* 336
- Office of Fair Trading 297
- Office of Technology Transfer 420
- On Call Interpreters and Translators Agency Pty Ltd v Commissioner of Taxation* 182
- Open Access Policy 424–5
- Organization for Economic Co-operation and Development 4, 409, 413
- Orton v Melman* 376–7
- O’Sullivan, M. 457, 465
- P & B Engineering Ltd and Anor v Peterson and Anor* 323
- Pallant v Morgan* 22, 33
- Pancreas Technologies Pty Ltd v The State of Queensland* 437
- parallel trade 293
- Paris Convention for the Protection of Industrial Property 46, 112, 124
- patent 7–9, 15, 46–9, 245–50
  - accidental genius 173–5
  - applications 184, 200, 206, 429
  - assignment 222
  - Bayh-Dole Act 52–69
  - black box case study 135
  - Block Exemption Regulation 310
  - business method 107, 250
  - competition law 285
  - employee generated 148, 150, 219
  - employee inventions 92–5
    - academic 74–90
    - contract limitations 144–8, 153–61
    - European Union 111–27
  - entitlement 328
  - European Patent Convention 113
  - extension 295–6
  - infringement 59, 208
  - intramural 426
  - license assignment 211
  - misuse 264–5
  - monopoly 260
  - National Institutes of Health 427–9
  - pharmaceuticals 293–7
  - policy 428
  - public sector research 408–12
  - researcher 196
  - rights 61, 165, 294
  - shop right 212
  - technology transfer 43–5, 420–421

- UK universities 436–9
- see also* patent law; patentability
- Patent and Trademark Amendments Act 419
- Patent Cooperation Treaty 112, 124
- patent law 26, 41–2, 47, 86, 89, 94, 111–12, 123, 188, 199, 248, 412
- Patent Office 99
- patent pools 67–8
- patentability 50, 60, 83, 224, 248–50, 252, 260
- Patents Act (1949) 147
- Patents Act (1970) 210
- Patents Act (1977) 47–8, 92, 144–6, 148, 152–4, 156, 159, 161, 210, 260, 437
- Patents Act (1990) 75, 88–9, 261, 437
- Patents Act, Australia 81, 248
- Paterson Institute for Cancer Research 415
- Pearson, Lord Justice 154
- Pembroke, Justice 375, 377
- Pepsi-Cola Corporation 446
- Perram, Justice 181–2
- Peso Silver Mines Ltd (NPL) v Cropper* 451
- Peters, T. 227
- pharmaceuticals 63, 175, 184, 294–7, 421, 430
  - parallel trade 293
- plant variety right 119
- Poland 188
- political indicators 459
- Porter, M.E. 458
- Portugal 188
- Posner, R. 258
- post-employment 165
  - competition 142, 214–15
  - inventions 200–202
  - restraints 10
- price theory 277–8
- Principles of European Contract Law* 359
- Printers and Finishers Ltd v Holloway* 335
- private capacity 446–8, 451
- private time 171–2
- Privy Council 25, 28
- procurement policies 458
- product registration 294–5
- profit sharing 43
- promissory estoppel 32
- public benefit 239, 281
- Public Health Laboratory Service 97
- public sector research 9, 15, 42–5, 407–16
- publicly funded research 74, 86, 196–7, 414, 429, 458
- QBE Management Services v Dymoke* 335
- Queensland 415
- Queensland Co-operative Milling Association Ltd 277
- Radio Telefis Eireann v Independent Television Publications Ltd* 263
- Ramsey Butchering Services Pty Ltd v Blackadder* 370
- Rand McNally Company 222
- Ready Mixed Concrete Ltd v Minister of Pensions* 149
- recession 4
- Reckitt Benckiser 297
- Reed Business Information v Seymour* 323
- Regal Hastings Ltd v Gulliver* 447, 451, 454
- Regulation on Community Designs 124
- Reiss Engineering 99
- remuneration 113–14, 118, 123, 127, 137, 194–5, 197
- research 244, 427
  - academic 47–50, 74–90, 99–100, 196, 409–12, 428–9, 434
  - Bayh-Dole Act 52–69
  - biomedical 423, 426, 429
  - dissemination 408
  - employees 117
  - grants 423
  - institutions 413
  - pharmaceuticals 293
  - technology transfer 424
  - United States government 53
  - see also* public sector research
- research and development 303, 466

- agreements 299–307, 311
- grants 458
- investment 468
- paid for 309
- Research Councils UK 45, 414
- researchers 10, 74, 95, 103
- Reserve Bank of Australia 133
- Restatement of Contracts 383
- Restatement of Employment Law 216–19, 230, 391–2
- Restatement of Torts 247–8
- Restatement of Unfair Competition 247
- restraint clause 154–6, 166, 179, 259, 317, 319, 322–8, 354, 368, 373–7
  - see also* contract of employment
- restraint of trade 88, 239, 269, 319–24, 354, 357, 372–3, 376–9, 383, 390
- Restraint of Trade Act 319, 376
- restrictive covenants 136, 142, 179, 259, 322, 336, 341, 343, 354, 356, 465
- Review of Intellectual Property and Growth* 45
- reward system 193–5
- Robb v Green* 358–9
- Roberts, Justice 59
- Rogers, F. 218
- Roskill, Justice 447–8, 450
- Ross and Anor v IccTV* 322–3
- Russell, Lord 447, 451
- Rutland Fund Management 26
- Sabemo Pty Ltd v North Sydney Municipal Council* 32
- sacking *see* employment termination
- Sales, Justice 27
- Schumpeter, J. 13, 255, 276, 278, 284, 456, 458
- SCM Corp. v Xerox Corp* 258
- scope of employment 141–2
- Scotland 352
- Scott, J. 458
- Screwpile Engineering Pty Ltd v Manning* 317, 324
- S.E.A. Food International Pty Ltd v Lam* 449
- Seager v Copydex Ltd* 349
- secret profits rule 444–5, 452–3
- secret protection 25, 49, 87
- Secretary of State for Employment v Associated Society of Locomotive Engineers and Firemen* 177
- Secretary's Advisory Committee on Genetics, Health and Society 61–2
- Sectrack NV v Satamatics Limited* 350
- service invention 112, 114, 125, 191, 193–4
- Seven Network (Operations) Ltd v Warburton (No 2) (Seven Network)* 375–7
- shareholder protection index 471, 473
- shareholders 33, 151, 153, 445, 454, 460–4
- Sherman Act 239, 262, 264, 285
- shop rights 8, 139–40, 207–9, 211–12
- Silicon Valley 142, 216–17, 230, 397
- Single Market Act 189
- Single Market for Intellectual Property Rights* 346, 353
- social welfare 12, 53–4, 60, 244, 253
- Sot. Lelos kai Sia EE and others v GlaxoSmithKline* 294
- Spain 188, 191, 194
- Spencer Industries Pty Limited v Collins* 173
- Spender, Justice 174
- Srholec, M. 459
- Staeng Ltd's Patents* 99–101, 211
- Standard Parts Co. v. Peck* 205
- Stanford University 60
- start-up companies 45
- State Street Bank & Trust Co. v Signature Financial Group Inc* 249–52
- statutory duty 18
- Stephenson Jordan & Harrison Ltd v MacDonald & Evans* 95–7, 100, 146–7
- Sterling Engineering Co Ltd v Patchett* 81, 147, 153
- Stevens and Gray v Brodribb Sawmilling Co Pty Ltd* 180
- Stevenson-Wylder Technology Innovation Act 420
- Straus, J. 116
- suggestion systems 223–9
- super injunction 348

- supplementary protection certificate
  - 295–6
- Sweden 115, 195
- Sweeney v Boylan Nominee Pty Ltd* 181
- Swift Technology v Mulcahy* 356
- Switzerland 361
  
- Talbot v General Television Corporation Pty Ltd* 22, 24
- tax incentives 458
- taxation 3, 53, 180–182
- teaching materials 96, 169
- technology transfer 52–69, 408–15, 418–31
  - Block Exemption Regulation 310
  - guidance 423–4
  - intramural 428
  - law 425
  - laws 421
  - offices 56–8, 63, 65–7, 69, 420–421, 427–8
  - public sector research 42–5, 49
- Technology Transfer Block Exemption 352
- Teets v Chromalloy Gas Turbine Corp* 205–6
- termination of employment *see*
  - employment termination
- TFS Derivatives Ltd v Morgan* 319–20
- The Royal Children's Hospital v Robert Alexander* 176
- Thomas, Justice 28–9, 33
- Thomas v Farr Plc* 323
- Thursby, J.G. 57
- Thursby, M.C. 57
- tort 247
- Trade Practices Act, Australia 22, 24, 35
- Trade Practices Commission v Ansett Transport* 279
- trade restraint *see* restraint of trade
- trade secrets 222, 244–8, 338–53, 357, 384, 392–6
  - business information 244
  - confidentiality clause 319–20
  - duty of fidelity 177
  - after employment 372
  - invention without use 204
  - legal devices 315–16
  - litigation 347, 394
  - misappropriation 335
  - misappropriation case studies 330–334
  - non-contractual claims 361–2
  - Restatement 217, 220–221
  - Rome II Regulation 362
  - Silicon Valley 230
  - United States law 216
- Trade Secrets Handbook, The* 338
- trade unions 157, 165
- trademark 7, 119, 122, 218, 222, 367, 440
- Trademark Directive 122
- trading system 102
- trailer clause 201–4, 209
- transfer of rights 124
- Translational Research Institute 415
- Treaty on the Functioning of the
  - European Union 120, 239, 285–6, 300–301, 304–8, 311
  - exception 302
- TRIPs 345–6, 351
- Tullett Prebon (Australia) Pty Ltd v Purcell* 376
- tying 288–90
  
- Ultraframe UK Ltd v Fielding* 146, 149
- Uniform Trade Secrets Act 248, 394–6
- Unilever v Shanks* 94, 152
- United Dominions Corporation Ltd v Brian Pty Ltd* 30
- United Kingdom 6, 11, 45, 115, 324, 327
  - 1911 Copyright Act 94
  - 1956 Copyright Act 95
  - Annual Innovation Report 4
  - Attorney-General v Blake* 27
  - Baird Textiles Holdings Ltd v Marks and Spencer Plc* 24
  - breach of confidence 7
  - Cobbe v Yeoman's Row Management Ltd* 24
  - Copyright, Designs and Patents Act 144
  - courts 150
    - Appeal 95, 101, 323
    - Chancery Division 347–8, 451

- Commercial Court 347
- Court of Appeal 29, 34, 104, 149, 152, 159, 357
- Queen's Bench Division 347
- Department for Business Innovation and Skills 4
- deregistration 297
- employee inventions 82
- High Court 347
- hired-to-invent 211
- law 140
- McLaren case 331
- outside employee duty 211
- patent 92
- Patent Office 99
- patentability 251
- Patents Act 47–8, 92, 144–8, 152–6, 159, 161, 210, 260
- trade secrets 353
- universities 5
  - licensing 434–40
- United Shoe Mach. Co. v. La Chappelle* 202
- United States 6, 8, 11, 16–17, 52–69, 199–213, 278–80, 414–31
  - antitrust 264, 271, 281
  - California Labor Code 204
  - compensation 47–9
  - competition law 238
  - consumer welfare 12
  - corporate opportunities rule 445–6
  - Department of Health and Human Services 418
  - employment law 199–213
  - essential facilities' doctrine 261
  - Federal Trade Commission 383, 393
  - government policy 14
  - Hoffman v Red Owl Stores Inc* 24
  - law 444
  - legislation 42–4, 419
  - Merger Guidelines 240–241
  - Microsoft* cases 288, 297
  - misappropriation 331
  - non-compete 323, 381–98
  - outside employee duty 211
  - Patent and Trademark Office 251–2, 264
  - patent law 47
    - patentability 250–251
    - Restatement (Second) of Contracts 383
    - Restatement of Employment Law 219–20
    - Sherman Act 285
    - shop rights 139–40, 212
    - Supreme Court 47, 57, 59, 218–19, 221, 251, 384
    - tort 247–8
    - trade secrets 7
    - Treasury 56
    - universities 76
    - workplace knowledge 216
- United States of America v Microsoft Corporation* 288
- Universal Biological Material Transfer Agreement 424
- universities 42–50, 409–16, 425
  - 1977 Patents Acts 104–5, 108
  - Block Exemption Regulation 307–8
  - employee invention rights 74–90
  - inventors reward 196
  - licensing 434–40
  - National Institutes of Health 426–9
  - non-employees 184–5
  - patent application 56
  - research and development 53–69, 95
  - revenue 61
  - technology transfer 419–21
  - university Acts 87–9
  - University of California 57, 65–6
  - University of Chicago 222
  - University of Illinois 57
  - University of Melbourne 86, 88
  - University of Michigan 223
  - University of Nottingham v Fishel* 158
  - University of Southern California 66
  - University of Western Australia v Gray* 6, 9, 47–8, 50, 74–90, 104, 106, 153, 169–70, 174, 176, 179, 268–70
  - Unkovic, D. 338
  - upstream research 52–4, 57, 61, 63
- venture capital 20–21, 25–6, 408, 414, 458–9, 464, 466, 468

- Verco v Rutland Fund Management Ltd* 25–8
- Verizon Communications, Inc v Law Offices of Curtis V Trinko, LLP* 263
- Vestergaard v Bestnet Europe Limited* 333–4, 348, 356–7, 359, 362
- Victoria University of Technology v Wilson* 79–81, 168, 171
- Villinger, B. 116
- Vladimer Batov v Invensys Rail Pty Ltd* 328
- volunteers 184–5
- VW – Lopez case* 331–2
- Wadlow, C. 362
- Waller, Lord Justice 150
- Waltons Stores (Interstate) Ltd v Maher* 32
- Warman International Ltd v Dwyer* 453
- Warren, D. 134–5
- Wedderburn, Lord 161
- Welcome Real-Time SA v Catuity Inc.* 250
- West Midlands Gas Board 447–8
- Westinghouse 223
- Whitford Committee 96–8
- WHPT Housing Association v Secretary of State for Social Services* 149
- Williams, H.L. 62
- Windows 288–90
- Wisconsin Power & Light 224
- Wommack v. Durham Pecan Co., Inc* 209
- Woolworths Ltd v Olson* 317
- workplace knowledge 214–17, 220–225, 230
- workplace policy 178–9, 319, 325, 330, 336–43
- workplace secrets *see* trade secrets
- World Trade Organization 345
- Wright, Lord 452
- Xerox 264
- Yewens v Noakes* 150

