

# Table of Contents

## Volume 1

### CHAPTER 1 INTELLECTUAL PROPERTY: THE LAW OF RIGHTS IN ACTIVITIES

- § 1.01 Intellectual property
- § 1.01[1] Intellectual property rights as “activity rights”
- § 1.01[2] Analysis of the benefit of an intellectual property right
- § 1.02 The early histories of intellectual property rights
- § 1.02[1] Copyrights
- § 1.02[1][a] The impact of the invention of printing
- § 1.02[1][b] The interplay of copyright and unfair competition
- § 1.02[2] Patents
- § 1.02[2][a] Qualifying as a grantee
- § 1.02[2][b] Early patents and politics
- § 1.02[3] The burgeoning of intellectual property
- § 1.03 The rights
- § 1.03[1] Patents
- § 1.03[2] Trade Secrets
- § 1.03[3] Copyrights, related rights, database rights
- § 1.03[3][a] Copyright
- § 1.03[3][b] Related Rights
- § 1.03[3][c] Database Rights
- § 1.03[4] Designs
- § 1.03[5] Rights in performances
- § 1.03[6] Registered and un-registered trade marks
- § 1.04 Transactions in respect of Intellectual Property
- § 1.04[1] Assignments
- § 1.04[2] Licences
- § 1.04[3] Mortgages
- § 1.04[4] Charges
- § 1.05 The Interplay and Evolution of Intellectual Property Rights and International Trade
  - § 1.05[1] The United Kingdom’s Exit from the European Union
  - § 1.05[2] The UK National Security and Investment Act 2021
- § 1.06 Antitrust and intellectual property
  - § 1.06[1] Sources of antitrust law
  - § 1.06[2] Antitrust principles and intellectual property
  - § 1.06[2][a] Intellectual Property Rights and Exclusivity

## FORMS AND AGREEMENTS

- § 1.06[2][b] Intellectual Property Rights and Other Restraints
- § 1.06[3] Severance
- § 1.06[4] The Public Interest
- § 1.06[5] Common law antitrust principles applied to intellectual property
  - § 1.06[5][a] The interests of the owners
  - § 1.06[5][b] The interests of the licensees
  - § 1.06[5][c] The interests of the public
  - § 1.06[5][d] The eleven principles
- § 1.07 Principle 1 - Limit of the right by subject matter, territory and time
  - § 1.07[1] Legality of licence limitations
  - § 1.07[1][a] Licensor's right to determine the scope of the licence
  - § 1.07[1][b] Anticompetitive behaviour intended to damage the inventor's interests
  - § 1.07[1][c] Territorial extensions
  - § 1.07[1][d] Territorial limitations; market sharing
  - § 1.07[1][e] Durational extensions
  - § 1.07[1][f] Product extensions; non-infringing licensee
- § 1.08 Principle 2 - Limit of the right to the primary act of exploitation
  - § 1.08[1] Exhaustion of rights - controlling parallel imports
- § 1.09 Principle 3 - Right to divide the right horizontally, vertically, by time and territory
  - § 1.09[1] Divisibility of intellectual property rights
  - § 1.09[1][a] Analysis of grant
  - § 1.09[1][b] Abstract rights and Material Manifestations
  - § 1.09[1][c] Limited licence when title has passed
  - § 1.09[1][d] Price fixing
  - § 1.09[1][e] Field of use restrictions
- § 1.10 Principle 4 - Improvements belong to the deviser or the improver
  - § 1.10[1] Grant backs
  - § 1.10[2] Improvement clubs
- § 1.11 Principle 5 - Licensor may not impose unwanted facilities on the licensee
  - § 1.11[1] Unwanted facilities and complex apparatus
- § 1.12 Principle 6 - Licensee can demand competitive advantage
  - § 1.12[1] Obtain supplies from the licensor
  - § 1.12[2] Right to repair a proprietary article
  - § 1.12[3] Franchising spare parts
  - § 1.12[4] Label licensing
- § 1.13 Principle 7 - A licence shall not contain covetous obligations alien to the right
  - § 1.13[1] Obtain supplies from the licensor
  - § 1.13[2] Right to repair a proprietary article
  - § 1.13[3] Franchising spare parts
  - § 1.13[4] Label licensing

## TABLE OF CONTENTS

- § 1.13[5] Covetous obligations under US law of patent misuse and antitrust
- § 1.13[5][a] Activities Not Amounting to Misuse
- § 1.13[6] Covetous obligations in copyright licences may amount to copyright misuse and an antitrust violation
- § 1.14 Principle 8 - Validity of the rights is fundamental
- § 1.14[1] Public Interest Paramount in Suits to Enforce Patent
- § 1.14[2] No challenge clauses and estoppel
- § 1.14[2][a] Licensee Challenging Validity Need Not Withhold Royalty Payments
- § 1.14[2][b] No Right to Require Licensor to Accept Royalties Paid into Escrow
- § 1.14[2][c] Consent Decree Forecloses Suits Charging Invalidity or Infringement
- § 1.14[2][d] Other Situations Involving Estoppel and Invalidity
- § 1.14[2][e] Implied Estoppel
- § 1.14[3] Fraud on the Patent Office
- § 1.15 Principle 9 - Undue concentration of rights may convert a beneficial monopoly into an unacceptable one
- § 1.15[1] Patent exploitation policy
- § 1.15[2] Cross-licensing and patent pools
- § 1.16 Principle 10 - Exclusivity is justified where there is a reasonable effort to exploit for the benefit of the relevant public
- § 1.16[1] Position of exclusive licensees
- § 1.16[2] Compulsory exploitation of intellectual property
- § 1.17 Principle 11 - Impact upon foreign trade and domestic imports may justify protective provisions
- § 1.17[1] Extra-Territorial Jurisdiction
- § 1.17[2] “Long arm” Statutes
- § 1.17[2][a] Not Necessarily Applied Internationally
- § 1.17[3] Protection of intellectual property rights relating to goods in transit
- § 1.17[4] Parallel imports
- § 1.17[5] International Organisations and Agreements - The TRIPS Agreement
- § 1.18 Patents and Concentration Through Merger

## PRECEDENTS

- Precedent 1A Saving Clause for Restrictive Covenant
- Precedent 1B Improvements “Club”
- Precedent 1C Right to Opt Out of “Club”
- Precedent 1D Simple Form
- Precedent 1E Duty to Disclose but No Right to Use Improvements
- Precedent 1F Limited Obligation to Disclose Improvements

## FORMS AND AGREEMENTS

- Precedent 1G Improvements “Think Tank”
- Precedent 1H Allocation of Payments to Patent Portfolio and to Know-how
- Precedent 1J Exclusions Clauses
- Precedent 1K Indemnity Against Non-compliance with Local Laws
- Precedent 1L Non-competitive Clause
- Precedent 1M Reduction in Royalties on Account of Infringement
- Precedent 1N Declaration That There Are No Restrictions on Licensee Other Than Those Herein Arising Out of the Patent
- Precedent 1P Termination Clause When Licensee Is Subsidized

## EXTRACTS FROM DECISIONS

- Extract 1A Champagne Heidsieck et Cie v. Buxton
- Extract 1B Lear, Inc. v. Adkins
- Extract 1C Thorsten Nordenfelt (Pauper) v. Maxim Nordenfelt Guns & Ammunition Co.
- Extract 1D Fuel Economy Co. v. Murray

## CHAPTER 2 INTELLECTUAL PROPERTY LICENSING—COMPETITION AND ANTITRUST PRINCIPLES IN THE UNITED STATES, THE UNITED KINGDOM AND THE EUROPEAN UNION

- § 2.01 Philosophical and Economic Roots of Antitrust/Competition Law
- § 2.02 Historical development and evolution of Antitrust/Competition Law
- § 2.03 Challenges for Antitrust law of Intellectual Property and Technological Advance
- § 2.04 The American Anti-Trust Framework
- § 2.04[1] The Acts
- § 2.04[2] The Agencies
- § 2.04[3] The Guidelines
- § 2.05 The Sherman Act
- § 2.05[1] Sherman Act, § 1—Contracts, Combinations, and Conspiracies in Restraint of Trade
- § 2.05[2] Sherman Act, § 2—Monopolization, Attempted Monopolization, and Conspiracies to Monopolize
- § 2.06 The Clayton Act
- § 2.06[1] Clayton Act, § 2—Price Discrimination
- § 2.06[2] Clayton Act, § 3—Tying and Other Conditioning
- § 2.06[3] Clayton Act, § 7—Stock and Asset Acquisitions
- § 2.07 The Federal Trade Commission Act
- § 2.07[1] The Federal Trade Commission Act, § 5—Unfair Methods of Competition Unlawful

## TABLE OF CONTENTS

- § 2.08 U.S. Antitrust law and Intellectual Property Agreements
- § 2.09 U.S. Antitrust Guidelines
- § 2.09[1] U.S. Department of Justice and F.T.C. Antitrust Guidelines for the “Licensing” of Intellectual Property
- § 2.09[1][a] “Licensing” includes licences, cross-licences and transfers
- § 2.09[1][b] Procompetitive benefits of licensing
- § 2.09[1][c] Antitrust concerns and modes of analysis
- § 2.09[1][d] Goods Markets
- § 2.09[1][e] Technology Markets
- § 2.09[1][f] Research and Development Markets
- § 2.09[1][g] Framework for evaluating licensing restraints
- § 2.09[1][h] Rule of Reason evaluation of licensing arrangements
- § 2.09[1][i] Exclusivity
- § 2.09[1][j] Efficiencies and Justifications
- § 2.09[1][k] Antitrust “safety zone” provisions
- § 2.09[1][l] Application of general principles
- § 2.09[1][m] Horizontal Restraints
- § 2.09[1][n] Resale Price Maintenance
- § 2.09[1][o] Tying/Bundling Arrangements
- § 2.09[1][p] Cross-licensing and pooling arrangements
- § 2.09[1][q] Exclusive dealing
- § 2.09[1][r] Grant-backs
- § 2.09[1][s] Acquisition of intellectual property rights
- § 2.09[1][t] Enforcement of invalid intellectual property rights
- § 2.09[2] U.S. Dept. of Justice and F.T.C. Anti-trust Guidelines for Collaborations Amongst Competitors
- § 2.09[3] U.S. Department of Justice and F.T.C. Anti-trust Guidelines for International Enforcement and Cooperation (“International Guidelines”)
- § 2.09[4] U.S. Department of Justice and F.T.C. Merger Guidelines
- § 2.10 The U.S. Approach to Competition Law and Agreements concerning I.P. rights
- § 2.11 U.S. Competition Law, Particular Intellectual Property Rights and Pre-emption
- § 2.11[1] Patents
- § 2.11[2] Trade Secrets
- § 2.11[3] Combined or Hybrid Patent and Trade Secret Agreements
- § 2.11[4] Copyright
- § 2.11[5] Trade marks
- § 2.12 U.S. Competition Law, Specific Restrictions
- § 2.12[1] Product price restrictions
- § 2.12[2] Territorial restrictions

## FORMS AND AGREEMENTS

- § 2.12[3] Quantity, Field of Use and Exclusive Dealing Restrictions
- § 2.12[4] Tying restrictions
- § 2.12[5] Pooling and Bundling
- § 2.12[6] Grant-back
- § 2.13 Developing U.S. Antitrust Issues
- § 2.13[1] U.S. Non-geographical Approach to First Sale Exhaustion
- § 2.13[2] Standards—Essential Patents and F/RAND Licensing
- § 2.13[3] Product Migration or “Hopping”
- § 2.13[4] Reverse Payment Settlement Agreements
- § 2.13[5] Exercise of Internet/e-commerce Might
- § 2.14 U.S. & E.U. Co-operation on Antitrust Issues
- § 2.15 Introduction to EU & UK Competition Law
- § 2.16 EU & UK Institutional Framework
- § 2.16[1] The European Commission and the Council of the EU
- § 2.16[2] The European General Court and the Court of Justice
- § 2.16[3] UK Institutions
  - § 2.16[3][a] The Competition and Markets Authority
  - § 2.16[3][b] The Competition Appeal Tribunal
  - § 2.16[3][c] Cooperation between UKIPO and CMA
  - § 2.16[3][d] Cooperation between UKICO and CMA
- § 2.16[4] Relationship between EU Institutions and Member State Institutions and Courts.
- § 2.16[5] European Economic Area (EEA)
- § 2.17 EU Legislative Framework
- § 2.17[1] Provisions establishing / regulating competition policy
- § 2.17[1][a] Article 101 TFEU—Restrictive or Distorting Agreements
- § 2.17[1][b] Article 102 TFEU—Abuse of a Dominant Position
- § 2.17[1][c] Block Exemptions and Guidelines
- § 2.17[1][c][i] Technology Transfer: Regulation 316/2014 (TTBER)
- § 2.17[1][c][ii] Vertical agreements in the EU: Regulation 2022/720
- § 2.17[1][c][iii] R&D Agreements: Regulation 2023/1066
- § 2.17[1][c][iv] Specialisation Agreements: Regulation 2023/1067
- § 2.17[2] Provisions establishing the free movement of goods
- § 2.17[2][a] Article 34: quantitative import restrictions
- § 2.17[2][b] Article 35: quantitative export restrictions
- § 2.17[2][c] Article 36: IPR exception
- § 2.17[3] Provisions establishing the free movement of services
- § 2.17[4] Implementing Provisions
- § 2.17[4][a] Administration and Enforcement: Regulation 1/2003

## TABLE OF CONTENTS

§ 2.17[4][b]	Conduct of Proceedings: Regulation 773/2004
§ 2.17[5]	Co-operation Between EU and US
§ 2.17[5][a]	1991 Cooperation Agreement
§ 2.17[5][b]	1998 EU/US Positive Comity Agreement
§ 2.17[6]	UK Competition Law Provisions
§ 2.17[6][a]	UK Competition Act 1998—Overview
§ 2.17[6][b]	Agreements—The Chapter I prohibition
§ 2.17[6][c]	Retained EU Block Exemptions in the UK
§ 2.17[6][d]	UK Block Exemption Orders
§ 2.17[6][d][i]	Vertical Agreements in the UK: 2022 VABEO 516
§ 2.17[6][d][ii]	R&D Agreements in the UK: 2022 R&DABEO 1271
§ 2.17[6][d][iii]	Specialisation Agreements in the UK: 2022 SpecialisationABEO 1272
§ 2.17[6][e]	Abuse of Dominant Position—The Chapter II Prohibition
§ 2.17[6][f]	Enterprise and Regulatory Reform Act 2013
§ 2.17[6][g]	The Digital Markets, Competition and Consumers Act 2024
§ 2.17[7]	The Changing Relationship between EU Competition Law and UK Competition Law
§ 2.18	Applying EU & UK Competition Law to Agreements
§ 2.18[1]	The EU Objective of Single Market Integration
§ 2.18[2]	The Balance between IPRs and Competition Law
§ 2.18[3]	What constitutes a Transfer of Rights
§ 2.18[4]	The Application of Article 101 to Agreements
§ 2.18[4][a]	The Impact on Competition
§ 2.18[4][b]	The Object of the Agreement
§ 2.18[4][c]	The Effect of the Agreement
§ 2.18[4][d]	Article 101(1) Infringed: apply Article 101(3)
§ 2.19	EU & UK Law as it applies to Particular Rights
§ 2.19[1]	Patents and Know How
§ 2.19[1][a]	Technology Transfer Block Exemption Regulation (TTBER)
§ 2.19[1][a][i]	Definition of Know How
§ 2.19[1][a][ii]	Standard Essential Patents
§ 2.19[1][a][iii]	Patent Pools
§ 2.19[2]	Trademarks
§ 2.19[2][a]	Technology Transfer Block Exemption Regulation (TTBER)
§ 2.19[2][b]	Vertical Agreements Regulation
§ 2.19[2][b][i]	Caselaw
§ 2.19[2][c]	Trade Mark Delimitation Agreements
§ 2.19[2][c][i]	Caselaw
§ 2.19[3]	Copyright (Non-software), Performance Rights and Related Rights

## FORMS AND AGREEMENTS

- § 2.19[3][a] Non-software copyright licences
- § 2.19[3][b] Performance Rights and Related Rights
- § 2.19[3][c] Collective Licensing of Copyright
- § 2.19[4] Plant Varieties Rights
- § 2.19[5] Exhaustion of IPRs and the EU-UK Withdrawal Agreement
- § 2.20 EU and UK Competition Law as it applies to Particular Clauses and Restraints
  - § 2.20[1] Territorial Sales Restrictions
  - § 2.20[1][a] Agreements between Competitors
  - § 2.20[1][b] Agreements between non Competitors
  - § 2.20[1][c] Passive Sales Restrictions
  - § 2.20[2] Field of Use Restrictions
  - § 2.20[2][a] Technology Transfer Block Exemption Regulation (TTBER)
    - § 2.20[2][a][i] Competitors and Non-Competitors
    - § 2.20[2][a][ii] Reservation of Product or Technical Field
    - § 2.20[2][a][iii] Output restriction
    - § 2.20[3] Output restrictions
    - § 2.20[3][a] Agreements between Competitors
    - § 2.20[3][b] Agreements between Non-Competitors
    - § 2.20[3][c] Caselaw
    - § 2.20[4] Tying/Bundling
  - § 2.20[4][a] Technology Transfer Block Exemption Regulation (TTBER)
  - § 2.20[4][b] Vertical Agreements Regulation 2022/720
  - § 2.20[4][c] Article 102
  - § 2.20[4][c][i] Caselaw
  - § 2.20[4][d] UK Competition Act 1998
  - § 2.20[4][d][i] Caselaw
  - § 2.20[5] Non Compete Obligations
  - § 2.20[6] Improvements and Grant Backs
    - § 2.20[6][a] Exclusive Grant Backs
    - § 2.20[6][b] Non-exclusive Grant Backs
  - § 2.20[7] Royalties
  - § 2.20[8] No Challenge Clauses and Termination
  - § 2.20[9] The EU Prohibition against unjustified geo-blocking
  - § 2.20[10] Pay for Delay
- § 2.21 Technology Pools and FRAND licensing
  - § 2.21[1] Technology Pools
  - § 2.21[2] Copyright Pools and Collective Rights Management
  - § 2.21[3] Settlement Agreements
    - § 2.21[3][a] Licensing
    - § 2.21[3][b] Cross licensing
    - § 2.21[3][c] Non-challenge clauses

## TABLE OF CONTENTS

### **PRECEDENTS**

- Precedent 2A Machinery Technology Agreement for Use in E.C.
- Precedent 2B Engineering Designs Supply Agreement for Use in E.C.
- Precedent 2C Field-of-Use Licence Agreement
- Precedent 2D Suggested Form of Notice of Limitation of Licence to Prevent Importation into the EU/EEA

### **EXTRACTS FROM DECISIONS**

- Extract 2A Sirena S.r.L. v. EDA S.r.L.
- Extract 2B Deutsche Gramophon v. Metro S.B. Grossmarkte GmbH
- Extract 2C Hoffmann-LaRoche v. Centrafarm V.G.
- Extract 2D Merck & Co. Inc. v. Stephanus Exler
- Extract 2E Association des Ouvriers en Instruments de Precision (A.O.I.P.) v. Beyrard
- Extract 2F H. Vaessen B.V. v. Moris
- Extract 2G Pfizer Inc. v. Eurim-Pharm GmbH
- Extract 2H L.C. Nungesser K.G. & Kurt Eisele v. Commission of European Communities
- Extract 2J Volvo AB v. Erik Veng (U.K.) Ltd.
- Extract 2K Radio Telefis Eireann and Independent Television Publications Limited v. E.C. Commission (Intellectual Property Owners Inc. intervening) (Magill TV Guide intervening)
- Extract 2L Bristol-Myers Squibb v. Paranova; Eurim-Pharm v. Beiersdorf; MPA Pharma v. Rhone-Poulenc
- Extract 2M Boehringer Ingelheim KG v. Swingward Limited

### **CHAPTER 3 PATENTS FOR INVENTIONS**

- § 3.01 Patents and Inventions
- § 3.01[1] Inventions, Rights Arising from Inventions and Applications
- § 3.01[2] Patentability
- § 3.01[3] Date of Patent and Duration
- § 3.01[4] Property in Patents
- § 3.01[5] Scope of Protection
- § 3.01[6] Supplementary Protection Certificates
- § 3.01[6][a] EU-UK Withdrawal Agreement and SPCs
- § 3.02 Rights to Apply for and be Granted a Patent
- § 3.02[1] Joint Inventors and Owners
- § 3.02[1][a] Co-ownership
- § 3.02[1][b] Agreements between Co-owners
- § 3.02[1][c] Pre-emptive Rights

## FORMS AND AGREEMENTS

- § 3.03 Employees Inventions Patents and Ownership
  - § 3.03[1] Provisions of UK Patents Act 1977
  - § 3.03[2] Compensation for Employees in the UK
  - § 3.03[3] US law and Shop Right
- § 3.04 Transactions Relating to Patents and Applications
- § 3.05 Pre-contractual enquiries, covenants and warranties.
- § 3.05[1] Title and authority to contract
- § 3.05[2] Validity
- § 3.05[3] Implied Covenants and Warranties
- § 3.06 Assignment or Licence
  - § 3.06[1] Assignments
  - § 3.06[2] Licences and Sub-Licences
  - § 3.06[3] Exclusive, Sole, Non-Exclusive, Simple
  - § 3.06[3][a] Exclusive Licences in the UK
  - § 3.06[3][b] Exclusive Licences in the US
- § 3.07 Specific Licensing Issues
  - § 3.07[1] Royalties
  - § 3.07[2] Exhaustion and Field of Use/Customer Restrictions
  - § 3.07[3] Grant of Licence and Sub-licences
  - § 3.07[4] Territory
  - § 3.07[5] Term
  - § 3.07[6] Best Endeavours
  - § 3.07[7] Most Favoured Licensee/Nation
  - § 3.07[8] Improvements
  - § 3.07[9] Grantbacks
  - § 3.07[10] Cross-Licensing and Pooling
  - § 3.07[11] Price Fixing
  - § 3.07[12] Misuse, Tying and Exclusive Dealing
  - § 3.07[13] No-challenge clauses
  - § 3.07[14] Termination
  - § 3.07[15] Non-Assignment, Lapse and Abandonment
  - § 3.07[16] Right to re-assignment on non-payment
  - § 3.07[17] Jurisdiction Clauses
  - § 3.07[18] Infringement, Right/Obligation to Enforce
  - § 3.07[19] Jurisdiction Clauses
- § 3.08 Implied Licences & Terms
- § 3.09 Effects of Bankruptcy
- § 3.10 Compulsory Licences, Licences of Right and UK Patents Act 1977
  - § 3.11 FRAND and Standard(s) Essential Patents
  - § 3.11[1] Introduction
  - § 3.11[2] ETSI and the *Unwired* case
  - § 3.11[3] General FRAND issues
  - § 3.11[3][a] SEPs: what is “Essential”?
  - § 3.11[3][b] Negotiating in a FRAND way

## TABLE OF CONTENTS

- § 3.11[3][c] Effect of undertaking to take a licence of FRAND terms
  - § 3.11[3][c][i] Licence and/or Defence to Injunction
  - § 3.11[3][c][ii] Defence to Injunction on Competition Grounds
  - § 3.11[4] Particular FRAND Licence Terms
  - § 3.11[4][a] Royalties
    - § 3.11[4][a][i] General Principles
    - § 3.11[4][a][ii] Portfolios: Comparable Licences & Royalty Burden
    - § 3.11[4][a][iii] Ex ante value
    - § 3.11[4][a][iv] Royalty Floor
    - § 3.11[4][a][v] Net Selling Price
    - § 3.11[4][a][vi] Combination Products, Sale Price and Royalties
    - § 3.11[4][a][vii] Royalties payable on sale
    - § 3.11[4][a][viii] Payment Terms & Reporting
    - § 3.11[4][a][ix] Adding or Removing SEPs. Redesignation of Markets
    - § 3.11[4][a][x] SEP/IPR valuation principles in EU Communication on SEPs
  - § 3.11[4][b] Territory
  - § 3.11[4][c] Scope of Licence
  - § 3.11[4][d] Bundling
  - § 3.11[4][e] Confidentiality of Licence settled by Court
  - § 3.11[4][f] Record keeping, access to records and audit costs
  - § 3.11[4][g] Term
  - § 3.11[4][h] Lessor Indemnities on Transfer of Rights to Third Party
  - § 3.11[4][i] Exclusive Jurisdiction
  - § 3.11[5] The European Commission Communication on SEP licensing
- § 3.12 The Impact of Competition law

## PRECEDENTS

- Precedent 3A Technology Agreement
- Precedent 3B Grant of Exclusive Patent Licence Under U.K. Master Patent(s)
- Precedent 3C Non-exclusive Patent Licence
- Precedent 3D Patents Sublicence
- Precedent 3E Patent Rights Agreement Transferring Right to Apply for Patents
- Precedent 3F Employee's Invention Vesting Instrument
- Precedent 3G Agreement for Manufacturer to Acquire All Rights in Invention and Prototype Model and to Finance Development of Project with View to Marketing

## FORMS AND AGREEMENTS

Precedent 3H	Agreement for Exploitation of Invention with Option of Patent Licence and Provision in Case of Refusal of Grant, etc.
Precedent 3J	Invention Development and Licensee Agreement (Including Consultancy Provisions)
Precedent 3K	Assignment to Third Party of Share in Joint Patent Application
Precedent 3L	Assignment of a Patent and Share in Joint Patent
Precedent 3M	Assignment of Patents and Application for Patent
Precedent 3N	Supplemental Confirmatory Patent Assignment
Precedent 3P	Assignment of a Patent and Applications by Company in Liquidation Distributing Assets in Specie
Precedent 3Q	Assignment of Patent by Wholly Owned Subsidiary Company (in Voluntary Liquidation) to Parent Company
Precedent 3R	Assent by Trustee Company to Foreign Beneficiaries Deriving Title Under Foreign Will
Precedent 3S	Express Covenants for Title
Precedent 3T	Formal Non-exclusive Licence
Precedent 3U	Agreement Relating to Patent Application and Share of Profits
Precedent 3V	Assignment of Rights in Invention
Precedent 3W	Exclusive Patent Licence Agreement (Short Form)
Precedent 3X	Assignment of Patent Application (Reserving Licence)
Precedent 3Y	Clause in Service Agreement for Person Working in U.K.
Precedent 3Z	Alternative Clause in Service Agreement
Precedent 3AA	Contract for Purchase of Patent Applications
Precedent 3BB	Contract of Option to Acquire Patent
Precedent 3CC	Manufacturing Sub-contract of Patented and Trade Marked Article
Precedent 3DD	Employees's Invention Agreement
Precedent 3EE	Letter Prior to Disclosure (Alternative Form)
Precedent 3FF	Letter from Inventor Offering Invention
Precedent 3GG	Power of Attorney in Patent Licensing Agreement
Precedent 3HH	Agreement for Assignment of Patents and Trade Marks Supplemental to Purchase of Business
Precedent 3JJ	Pre-emption Provisions Among Joint Owners of Patents

## TABLE OF CONTENTS

Precedent 3KK Pre-emption Provisions Where Shares to Be Held in Equal Undivided Shares  
Precedent 3LL Mortgage of Patent (Traditional Style) and Securing Further Advances

## EXTRACTS FROM DECISIONS

Extract 3A Martin-Baker Aircraft Co. v. Canadian Flight Equipment  
Extract 3B Microbeads A.G. & Alfred Ehrismann A.G. v. Vinhurst Road Markings Ltd.  
Extract 3C Guyot v. Thomson  
Extract 3D Tweedale v. Howard & Bullough, Ltd.  
Extract 3E S.A. des Manufactures de Glaces v. Tilghman's Patent Sand Blast Co.  
Extract 3F Betts v. Willmott  
Extract 3G International Nickel Co. v. Ford Motor Co. & Caswell Motor Co.  
Extract 3H Huntoon Co. v. Kolynos, Inc.  
Extract 3J Water Technologies Corp. v. Calco, Ltd.  
Extract 3K United Wire Limited v. Screen Repair Services (Scotland) Ltd. & Ors.  
Extract 3L Spring Form Inc. v. Toy Brokers Ltd. [2002] F.S.R.

17

## CHAPTER 4 TRADE SECRETS, CONFIDENTIAL INFORMATION AND PROPRIETARY INFORMATION

- § 4.01 Introduction
- § 4.01[1] Protectable Information: History, Nomenclature and Ambit
  - § 4.01[1][a] United Kingdom
  - § 4.01[1][b] United States
  - § 4.01[1][c] European Union
- § 4.01[2] Terminology and Protectable Information
- § 4.02 The Legal Frameworks for Protection and for Exploitation
  - § 4.02[1] European Union
  - § 4.02[1][a] National Law
  - § 4.02[1][b] Regulation of Competition
  - § 4.02[1][c] Unfair Competition
  - § 4.02[1][d] EU Directive 2016/943 for the protection of Trade Secrets
- § 4.02[2] United Kingdom
  - § 4.02[2][a] The Law and Equity
  - § 4.02[2][b] Contract
  - § 4.02[2][c] Property
  - § 4.02[2][d] Tortious Interference with Contractual Rights

## FORMS AND AGREEMENTS

- § 4.02[2][e] UK Implementation of EU Directive 2016/943
- § 4.02[3] United States
- § 4.02[3][a] Trade Secrets
- § 4.02[3][b] The Defend Trade Secrets Act
- § 4.02[3][c] Breach of Confidence
- § 4.03 Protectable Information and other Intellectual Property Rights
  - § 4.03[1] Protectable Information and Patents
  - § 4.03[1][a] Keeping the Invention Secret
  - § 4.03[1][b] The Impact of a Patent Application
  - § 4.03[1][c] Non Pre-emption of US State Trade Secrets Law by US Patent Law
  - § 4.03[1][d] Non-Pre-emption of US State Trade Secrets Law by US Copyright Law
  - § 4.03[2] Protectable Information and Copyright/Design Right
  - § 4.03[3] Protectable Information and Trade Marks—Franchising
- § 4.04 Assignment
  - § 4.04[1] United Kingdom
  - § 4.04[1][a] Assignability
  - § 4.04[1][b] Transfer
  - § 4.04[1][c] Formalities
  - § 4.04[2] United States
  - § 4.04[2][a] Assignability
  - § 4.04[2][b] Transfer
  - § 4.04[2][c] Formalities
- § 4.05 Licensing
  - § 4.05[1] Basis for Licensing
  - § 4.05[1][a] United Kingdom
  - § 4.05[1][b] United States
  - § 4.05[2] European Union—Technology Transfer Agreements
- § 4.06 Particular Terms and Issues
  - § 4.06[1] Hybrids and Post Patent Expiry Payments
  - § 4.06[1][a] United States
  - § 4.06[1][b] European Union and the United Kingdom
  - § 4.06[2] Effect of Incorporation by Individual
  - § 4.06[3] Employee Assignments of Non-patentable “Inventions”
  - § 4.06[4] Transfer of Employee Obligations on Acquisition of Company
  - § 4.06[5] Effect of Entry of Information into Public Domain
  - § 4.06[6] Burden of Proof of Breach by Licensee
  - § 4.06[7] Territorial Limits
  - § 4.06[7][a] Europe (and the United Kingdom)
  - § 4.06[7][b] United States
  - § 4.06[8] Confidentiality Clubs and External Eyes Only Provisions
- § 4.07 Term and Termination

## TABLE OF CONTENTS

- § 4.08 Competition/Antitrust Considerations
- § 4.08[1] European Union
- § 4.08[2] United Kingdom
- § 4.08[3] United States

## PRECEDENTS

- Precedent 4A "Black Box" Agreement for Disclosure of Method of Manufacture Which Is Unpatentable
- Precedent 4B Secret Process Agreement
- Precedent 4C Turnkey Contract
- Precedent 4D Turnkey Supplemental Agreement
- Precedent 4E Performance Bond
- Precedent 4F Machinery Know-how Agreement
- Precedent 4G Research Technology Access Agreement
- Precedent 4H Process Plant Agreement
- Precedent 4J Contractor's Confidentiality Agreement
- Precedent 4K Letter Prior to Disclosure of Invention/Design/Proposal
- Precedent 4L Undertakings for Disclosure of an Idea the Subject of Pending Patent Applications

## EXTRACTS FROM DECISIONS

- Extract 4A Ansell Rubber Co. v. Allied Rubber Indus.
- Extract 4B Saltman Eng'g Co. v. Campbell Eng'g Co.
- Extract 4C Seager v. Copydex Ltd.
- Extract 4D Prince Mfg. Inc. v. Automatic Partner
- Extract 4E Faccenda Chicken Ltd. v. Fowler
- Extract 4F FSS Travel & Leisure Sys. Ltd. v. Johnson & anor.
- Extract 4G Douglas v. Hello! Ltd.

## CHAPTER 5 COPYRIGHT, DESIGNS, PERFORMANCES AND RELATED PROTECTABLE RIGHTS

### § 5A COPYRIGHT, RELATED RIGHTS AND THE DATABASE RIGHT

- § 5A.01 Introduction
- § 5A.02 Scope of Copyright, Related Rights and the Database Right and Their Protection
  - § 5A.02[1] Scope of Copyright
  - § 5A.02[2] Scope of Protection by Copyright
  - § 5A.02[3] Scope of Related Rights and Artists Resale Rights
  - § 5A.02[4] Scope of Protection by Related Rights
  - § 5A.02[5] Scope of the Database Right
  - § 5A.02[6] Scope of Protection by the Database Right

## FORMS AND AGREEMENTS

- § 5A.02[6][a] The EU-UK Withdrawal Agreement and Continued Database Protection
- § 5A.03 Extent and Duration of Protection Afforded by Copyright, Related Rights and the Database Right
  - § 5A.03[1] Extent of Copyright Protection
  - § 5A.03[2] Duration of Copyright Protection
  - § 5A.03[3] Extent of Related Right Protection
  - § 5A.03[4] Duration of Related Right Protection
  - § 5A.03[5] Extent of the Database Right
  - § 5A.03[6] Duration of Database Right Protection
  - § 5A.03[7] The EU-UK Withdrawal Agreement and Continued Protection of Database Right
- § 5A.04 Authorship and Ownership
  - § 5A.04[1] Single Author
  - § 5A.04[2] Joint Authors
  - § 5A.04[2A] Works of Co-authorship
  - § 5A.04[3] Employed Author
  - § 5A.04[4] Commissioned Author
  - § 5A.04[5] Owner
  - § 5A.04[6] Authorship, Ownership and the Database Right
- § 5A.05 Originality
  - § 5A.05[1] Originality Necessary for Certain Copyrights to Subsist
  - § 5A.05[2] Simple Forms
  - § 5A.05[3] Original Copies and Derivative Works
  - § 5A.05[4] Originality and the Database Right
- § 5A.06 Transferring Title to Copyright
  - § 5A.06[1] Assignment
  - § 5A.06[2] Assignment of Future Copyright
  - § 5A.06[3] Assignment and Licence
  - § 5A.06[4] Title on death and by bequest
  - § 5A.06[5] Transferring Title to Database Right
  - § 5A.06[6] Operation of Law
- § 5A.07 Licensing Copyright
  - § 5A.07[1] Express Licences
    - § 5A.07[1][a] Sole Licences
    - § 5A.07[1][b] Exclusive Licences
  - § 5A.07[2] Implied Licences
    - § 5A.07[2][a] General
    - § 5A.07[2][b] Repair and Reverse Engineering
    - § 5A.07[2][c] Notional Royalty Rate
  - § 5A.07[3] Miscellaneous Contractual Matters
    - § 5A.07[3][a] Exploiting Previously Unknown Formats
    - § 5A.07[3][b] Industry Practices
    - § 5A.07[3][c] Post Contractual Term Implied Terms and Limits
    - § 5A.07[3][d] Software as Goods

## TABLE OF CONTENTS

- § 5A.07[4] Licensing Database Right
- § 5A.07[5] Licensing Schemes and Bodies
- § 5A.07[6] Orphan works
- § 5A.07[7] The EU Collective Management and Multi-Territorial Licensing Directive
- § 5A.07[8] The EU Copyright and Related Rights in the Digital Single Market Directive
- § 5A.08 Reciprocal Protection of Copyright in the United States
  - § 5A.08[1] The Copyright Act of 1909
  - § 5A.08[2] Works of Non-U.S. Origin – Pre-1978
  - § 5A.08[3] Universal Copyright Convention
  - § 5A.08[4] The Copyright Act of 1976
  - § 5A.08[5] The Berne Convention Implementation Act (1988)
  - § 5A.08[6] Protection of U.S. Works in the U.K.
  - § 5A.08[6][a] Publication Prior to 1 March 1989
  - § 5A.08[6][b] Publication from 1 March 1989
  - § 5A.08[6][c] Retroactivity
- § 5A.09 European Copyright Harmonisation and Initiatives
- § 5A.10 Copyright Misuse

## § 5B COPYRIGHT, COMPUTING, THE INTERNET, DIGITAL CONTENT AND THE DIGITAL ECONOMY

- § 5B.01 Computer Software/Digital Content—A Special Case
- § 5B.02 Computer Software
  - § 5B.02[1] Protection
  - § 5B.02[2] Expression/Idea Dichotomy
  - § 5B.02[3] Translation
  - § 5B.02[4] Operating Systems/Bootstrap ROMs
  - § 5B.02[5] Semiconductor Topographies—Mask Works
  - § 5B.02[6] European Harmonisation
  - § 5B.02[7] EU Law and Software Licensing
  - § 5B.02[8] Protection of Databases
  - § 5B.02[9] Copyright Misuse Effected by Licensing
- § 5B.03 Exploiting Computer Software
  - § 5B.03[1] Conventional Licensing
  - § 5B.03[2] Shrink-wrap, Click-wrap and Browse-wrap Agreements
  - § 5B.03[3] Transferability/Indirect Use
  - § 5B.03[4] Void Terms and Conditions Relating to Computer Software and Databases
- § 5B.03[5] Open Source Software
- § 5B.03[6] Cloud Computing
- § 5B.04 Internet Service Providers
  - § 5B.04[1] Transitory Communications

## FORMS AND AGREEMENTS

- § 5B.04[2] System Caching
- § 5B.04[3] Information Residing on Systems or Networks at the Direction of Users and Information Location Tools

### § 5C DESIGNS

- § 5C.01 The Anomalous Position of the Protection of Designs
- § 5C.02 The UK Scheme for the Protection of Designs
- § 5C.02[1] Unregistered Design Right
  - § 5C.02[1][a] Definition and Scope of Protection
  - § 5C.02[1][b] Categories Excluded From Unregistered Design Right Protection
  - § 5C.02[1][c] Subsistence and Qualification
  - § 5C.02[1][d] Definition of Designer
  - § 5C.02[1][e] Ownership
  - § 5C.02[1][f] Duration of Right
  - § 5C.02[1][g] Threats
  - § 5C.02[1][h] Kits
  - § 5C.02[1][i] Semiconductor Topographies
  - § 5C.02[1][j] Assemblies, Matching Sets and Designer's Intention
  - § 5C.02[1][k] Interaction of Unregistered Design Right and Copyright
  - § 5C.02[1][l] Exceptions
- § 5C.02[2] Assignments and Licences of Unregistered Design Right
  - § 5C.02[2][a] Statutory Provisions
    - § 5C.02[2][a][i] Assignments and Licences
    - § 5C.02[2][a][ii] Exclusive Licences
    - § 5C.02[2][a][iii] Licences of Right
    - § 5C.02[2][a][iv] Unregistered Design Right and Registered Designs
  - § 5C.02[2][b] Implications of the 1988 Act
    - § 5C.02[2][b][i] Introduction
    - § 5C.02[2][b][ii] Commissioned Works, Employers and Ownership
    - § 5C.02[2][b][iii] Design Right is Less Valuable than Copyright
    - § 5C.02[2][b][iv] Warranties Relating to the Designer's Intentions
    - § 5C.02[2][b][v] Increased Importance of Housekeeping
    - § 5C.02[2][b][vi] Warranties as to Originality
    - § 5C.02[2][b][vii] Assignment of Future Rights
    - § 5C.02[2][b][viii] Assistance of Designer in Proceedings
    - § 5C.02[2][b][ix] Notices
  - § 5C.02[3] Registered Design Right
    - § 5C.02[3][a] Introduction

## TABLE OF CONTENTS

- § 5C.02[3][b] Ownership
- § 5C.02[3][c] Computer Generated Designs
- § 5C.02[3][d] Duration
- § 5C.02[3][e] Notices
- § 5C.02[3][f] Scope of Rights Conferred
- § 5C.02[3][g] Exhaustion
- § 5C.02[3][h] Threats
- § 5C.02[3][i] European Harmonisation of Designs and Co-existence with Other Rights
- § 5C.02[3][j] U.K. Accession to the Hague Agreement on International Registration
- § 5C.02[4] Assignments and Licences of Registered Design Right
- § 5C.02[4][a] Assignments
- § 5C.02[4][b] Licences
- § 5C.03 The EU System for the Protection of Designs
- § 5C.03[1] Unregistered Community Design Right
- § 5C.03[1][a] The EU-UK Withdrawal Agreement and Continued Protection for UCDR
- § 5C.03[2] Registered European Union/Community Design Right
- § 5C.03[3] Assignments and Licences of European Union/Community Designs
- § 5C.03[3][a] The EU-UK Withdrawal Agreement and Continued Protection for RCDR
- § 5C.04 The Hague Agreement on International Deposit of Industrial Designs

## **§ 5D BROADCASTING AND RIGHTS IN PERFORMANCES**

- § 5D.01 Introduction
- § 5D.01[1] Broadcasts
- § 5D.01[2] Rights in Performances and Associated Rights
- § 5D.01[2][a] Non-Property Rights
- § 5D.01[2][b] Property Rights
- § 5D.01[2][c] Recording Rights
- § 5D.02 Extent and Duration of Protection
- § 5D.03 Ownership
- § 5D.03[1] Broadcasts
- § 5D.03[2] Rights in Performances and Associated Rights
- § 5D.03[2][a] Non-Property Rights
- § 5D.03[2][b] Property Rights
- § 5D.03[2][c] Recording Rights
- § 5D.04 Transferring Title
- § 5D.04[1] Broadcasts
- § 5D.04[2] Rights in Performances and Associated Rights
- § 5D.04[2][a] Non-Property Rights

## FORMS AND AGREEMENTS

- § 5D.04[2][b] Property Rights
- § 5D.04[2][c] Recording Rights
- § 5D.05 Licensing
- § 5D.05[1] Broadcasts
- § 5D.05[2] Rights in Performances and Associated Rights
- § 5D.05[2][a] Non-Property Rights
- § 5D.05[2][b] Property Rights
- § 5D.05[2][c] Recording Rights
- § 5D.05[3] Orphan works
- § 5D.06 Moral Rights in Performances
- § 5D.07 The EU Scheme for Collective Rights Management
- § 5D.08 The EU Exercise of Copyright and Related Rights in Online Transmissions Etc Directive

### PRECEDENTS

- Precedent 5A Assignment of Copyright in Literary Work
- Precedent 5B Assignment of Design Application
- Precedent 5C Assignment of Unregistered Design Right in a Design (and Right to Design Documents Embodying)
- Precedent 5D Copyright Licence of Right
- Precedent 5E Licence Under Registered Design Owned by Designers, with Client Sharing in Royalties
- Precedent 5F Copyright and Trade Mark Licence
- Precedent 5G Basic Copyright and Database Licence for Limited Use of a Database of Householders Listed by Income
- Precedent 5H Basic Non-exclusive Copyright Licence with Right to Sue
- Precedent 5J UK Unregistered Design Rights Licence of Rights
- Precedent 5K [Reserved]
- Precedent 5L Computer Program Licence
- Precedent 5M Computer Program Library Supply Agreement
- Precedent 5N Program Writing Contract
- Precedent 5P Deed of Novation
- Precedent 5Q [Reserved]
- Precedent 5R Microfiche Publishing Agreement
- Precedent 5S Notice on Drawing
- Precedent 5T Technical Publishing Agreement
- Precedent 5U [Reserved]
- Precedent 5V Computer Program Agreement
- Precedent 5W Notice and Disclaimer
- Precedent 5X Automatically Screened Notice on Loading Computer Program
- Precedent 5Y Author's Copyright Licence Clause

## TABLE OF CONTENTS

Precedent 5Z	Source Code Escrow
Precedent 5AA	Simple Shrink Wrap Licence
Precedent 5BB	Software Licence
Precedent 5CC	Simple Grant of Exclusive Right to Take Action Against Peer to Peer Infringers

## EXTRACTS FROM DECISIONS

Extract 5A	Baker v. Selden
Extract 5B	Kenrick & Co. v. Lawrence & Co.
Extract 5C	Lotus Development Corporation v. Paperback Software International & Anor.
Extract 5D	George Hensher, Ltd. v. Restawhile
Extract 5E	Lincoln Industries, Ltd. v. Wham-O Manufacturing Co.
Extract 5F	J&S Davis (Holdings), Ltd. v. Wright Health Group, Ltd.
Extract 5G	Synercom Technology, Inc. v. University Computing Co.
Extract 5H	Roger Bance and Anr's Licence of Right (Copyright) Application

# Volume 2

## CHAPTER 6 TRADE MARKS AND GOODWILL

§ 6.01	The Nature and Function of Trademarks
§ 6.01[1]	History of Functions
§ 6.01[1][a]	Source
§ 6.01[1][b]	Quality
§ 6.01[1][c]	The Mark as an asset of the proprietor
§ 6.01[2]	Harmonisation in the EU
§ 6.02	Statutory Framework for Licensing
§ 6.02[1]	In the EU
§ 6.02[1][a]	Directives 89/104, 2008/95 and 2015/2436
§ 6.02[1][b]	Community/European Trade Marks
§ 6.02[1][c]	United Kingdom
§ 6.02[2]	United States
§ 6.02[2][a]	Lanham Act
§ 6.02[2][a][i]	Background to the Lanham Act
§ 6.02[2][b]	Concept of a Related Company
§ 6.02[2][b][i]	Wholly Owned Related Companies
§ 6.02[2][b][ii]	Common Stockholders, Directors or Officers
§ 6.02[2][b][iii]	Sister Corporations
§ 6.02[2][b][iv]	Licensee and Franchisees
§ 6.03	What is Registrable as a Trade Mark

## FORMS AND AGREEMENTS

- § 6.03[1] EU and United Kingdom
- § 6.03[2] United States
- § 6.03[3] Collective Marks
- § 6.03[3][a] Collective Marks in the EU and United Kingdom
- § 6.03[3][b] Collective marks in the U.S.
- § 6.03[3][c] The EU Collective Mark
- § 6.03[4] Certification Marks
- § 6.03[4][a] Certification Marks in the EU and United Kingdom
- § 6.03[4][b] Certification Marks in the United States
- § 6.04 Extent of protection conferred by a Trademark
- § 6.04[1] EU and United Kingdom
- § 6.04[1][a] The EU-UK Withdrawal Agreement and Continued Protection for EUTMs
- § 6.04[2] United States
- § 6.04[3] WIPO International Trade Mark System
- § 6.05 Assignment of Trademarks
- § 6.05[1] Assignment vs. Licence
- § 6.05[2] Goodwill
- § 6.05[3] Assignment
- § 6.05[3][a] EU and United Kingdom
- § 6.05[3][b] United States
- § 6.05[3][c] European/Community Trade Marks
- § 6.05[4] Formalities
- § 6.05[4][a] EU and United Kingdom
- § 6.05[4][b] United States
- § 6.05[4][c] EU/Community Trade Marks
- § 6.06 Licensing Trademarks
- § 6.06[1] Formalities
- § 6.06[2] Quality Control
- § 6.06[3] Assignment with licence back
- § 6.06[4] Exclusive Licences
- § 6.06[5] Implied Licences
- § 6.06[6] Merchandising
- § 6.06[7] Licensee's use of Bankrupt Debtor's Trademarks
- § 6.07 Parallel Imports, Gray Goods and Exhaustion of Rights.
- § 6.07[1] Parallel Importation and Exhaustion of Rights in the EU
- § 6.07[1][a] EU-UK Withdrawal Agreement and Recognition of Exhaustion of Rights
- § 6.07[2] United States
- § 6.08 Particular Terms and Issues
- § 6.08[1] No Challenge Clauses and Licensee Estoppel
- § 6.08[2] Delimitation Agreements
- § 6.08[3] Use by Third Party Manufacturer
- § 6.08[4] Distributors
- § 6.08[4][a] Alteration, Exhaustion and First Sale

## TABLE OF CONTENTS

- § 6.08[4][b] Advertising
- § 6.08[4][c] Application of Distributors Mark
- § 6.08[4][d] Dealers Rights to Mark
- § 6.08[4][e] Services Agreement
- § 6.08[5] Right to take action against third parties
- § 6.08[6] Approval
- § 6.09 Term and termination
- § 6.10 Competition, Anti-trust and Unfair Competition Law
- § 6.10[1] Europe
- § 6.10[2] U.K. Competition Law
- § 6.10[3] United States Anti-Trust/Unfair Competition Law

## PRECEDENTS

- Precedent 6A Assignment of Registered Trade Mark with/ without Goodwill with/without an Existing Licensee
- Precedent 6B Assignment of Registered Trade Marks and Applications Covering Various Countries
- Precedent 6C Assignment of Trade Mark Application with/ without Goodwill
- Precedent 6D Assignment of Common Law Trade Mark with the Benefit of an Application for Registration with the Business in which the Trade Mark has been used and Accrued Goodwill
- Precedent 6E Assignment of Goodwill of Business with Unregistered Trade Marks
- Precedent 6F Trade Mark Licence without Right to Sublicense
- Precedent 6G Simple Form Trade Mark Licence
- Precedent 6H Trade Mark Licence with Right to Sublicense
- Precedent 6I [Reserved]
- Precedent 6J Multiple Trade Mark Licensing Agreement, with Agency Agreement and Marketing Subcontract
- Precedent 6K Technical Aid and Trade Mark Agreement
- Precedent 6L Trade Mark and Non-exclusive Technical Assistance Agreement
- Precedent 6M Agreement Between Importer and Producer For Joint Rights in Trade Mark
- Precedent 6N Inquiries Before Contract to Purchase Registered Trade Mark or Application
- Precedent 6P [Reserved]
- Precedent 6Q [Reserved]
- Precedent 6R [Reserved]

## CHAPTER 7 MULTIMEDIA, ENTERTAINMENT AND ELECTRONIC DISTRIBUTION

- § 7.01 Introduction
- § 7.02 Core Property Rights
- § 7.02[1] Copyright
- § 7.02[2] Trade Marks
- § 7.02[3] Patents
- § 7.02[4] Rights in Databases
- § 7.02[5] Trade Secrets/Confidentiality
- § 7.02[6] European Design Rights
- § 7.03 Personal Rights
- § 7.03[1] Moral Rights
- § 7.03[1][a] Introduction
- § 7.03[1][b] Right to Be Identified as Author or Director
  - § 7.03[1][b][i] Definition
  - § 7.03[1][b][ii] Right Must Be Asserted
  - § 7.03[1][b][iii] Exceptions to the Right
- § 7.03[1][c] Right to Object to Derogatory Treatment
  - § 7.03[1][c][i] Definition
  - § 7.03[1][c][ii] Exceptions to the Right
  - § 7.03[1][c][iii] Secondary Infringement
- § 7.03[1][d] False Attribution of Work
- § 7.03[1][e] Right to Privacy of Photographs and Films
- § 7.03[1][f] Duration of Rights
- § 7.03[1][g] Consent and Waiver of Rights
- § 7.03[2] Performer's Property and non-Property Rights
- § 7.03[3] Collective Agreements and Collecting Societies
- § 7.03[4] Rights of Personality
  - § 7.03[4][a] Introduction
  - § 7.03[4][b] Fictional Characters and Character Merchandising
  - § 7.03[4][c] Rights Arising From Reputation: Sponsoring and Endorsing
  - § 7.03[4][d] Merchandising
  - § 7.03[4][e] Use of Company Name
  - § 7.03[5] Data Protection and Information Privacy
  - § 7.03[6] Image Rights
- § 7.04 Rights in Formats
- § 7.05 Licensing and its Developments
  - § 7.05[1] Licensing, Collecting Societies and Collective Management Organisations
  - § 7.05[2] Existing Agreements: New Channels and Formats
  - § 7.05[3] Moral Rights
  - § 7.05[4] The Copyright Tribunal
  - § 7.05[5] The Music Industry
  - § 7.05[5][a] United States

## TABLE OF CONTENTS

- § 7.05[5][b] United Kingdom and European Union
- § 7.05[6] Online Uses of Protected Content and Hyperlinking
- § 7.06 Distribution Media, Modes and Legislation
- § 7.06[1] Physical Media, Supply and Consumer Legislation
- § 7.06[2] On-line Supply, Digital Content, Supply and Consumer Legislation
- § 7.06[3] EU Digital Single Market Legislation
- § 7.07 End User Considerations and Restrictions
- § 7.08 Liability and Jurisdictional Issues on the Internet

## PRECEDENTS

- Precedent 7A Option to Acquire Film, Multimedia, and Associated Rights in a Novel
- Precedent 7B Agreement to Employ Script Writer
- Precedent 7C Endorsement Agreement
- Precedent 7D Authorisation by Artist of Use of His Name and Likeness
- Precedent 7E Endorsement Agency Agreement
- Precedent 7F Assignment of Film, Multimedia and Associated Rights in a Novel with Right of Reassignment
- Precedent 7G Assignment of Literary Copyright with Liberty to Make Changes, and as to Credits
- Precedent 7H Documentary Film Agreement
- Precedent 7J Television Script Contract
- Precedent 7K Film Library Supply and Producer Agreement
- Precedent 7L Film Music Contract
- Precedent 7M Advertising Contract (Reserving Copyright)
- Precedent 7N Book Publishing Agreement
- Precedent 7P Contribution Agreement for Video Clip to On-line Service
- Precedent 7Q Digitisation and On-line Archiving Agreement
- Precedent 7R Subscriber Access Agreement

## EXTRACTS FROM DECISIONS

- Extract 7A Henderson & Anor. v. Radio Corp. Pty. Ltd.

## CHAPTER 8 MARKETING, DISTRIBUTION AND RELATED AGREEMENTS

- § 8.01 Marketing Provisions in Relation to Intellectual Property Rights
- § 8.02 Marketing & Distribution Agreements
- § 8.02[1] Exclusive Distribution/Selective Distribution & Agency Agreements
- § 8.02[1][a] Vertical Agreements in the EU: 2022 Regulation 2022/720

FORMS AND AGREEMENTS

- § 8.02[1][b] Vertical Agreements in the UK: 2022 VABEO SI  
516
- § 8.02[2] Franchising Agreements
- § 8.02[2][a] U.S. Regulation of Franchising
- § 8.02[2][b] U.S. Anti-Trust Law and Franchising
- § 8.02[2][b][i] Per se Violations
- § 8.02[2][b][ii] Tying and restrictive covenants
- § 8.02[2][b][iii] Distinction Between Business Systems and Systems for Trade Marked Goods
- § 8.02[2][c] E.U./U.K. Franchising
- § 8.02[3] Ownership of Goodwill in Foreign Market
- § 8.03 Uncommon Forms of Marketing Agreement/Relationship
- § 8.03[1] Limited Partnerships
- § 8.03[2] Co-operatives
- § 8.04 Offending Against Article 101 of the TFEU/Chapter I of the Competition Act 1998
- § 8.04[1] General
- § 8.04[1][a] Multiply-Used Standard Agreements
- § 8.04[1][b] Adjusting Behaviour at the Request of a Competing Undertaking
- § 8.04[2] Fixing Purchase or Sale Prices
- § 8.04[3] Limiting or Controlling Markets, Technical Development or Investment
- § 8.04[3][a] Restrictions on Parallel Imports
- § 8.04[3][b] Promoting Exports
- § 8.04[4] Sharing Markets or Sources of Supply
- § 8.04[5] Applying Dissimilar Conditions to Equivalent Transactions Causing Competitive Disadvantage
- § 8.04[6] Imposing Supplementary Obligations Unconnected with the Contract
- § 8.04[7] Miscellaneous
- § 8.04[7][a] Non-genuine “Fair Trading Agreement”
- § 8.04[7][b] Obligation to Grant Dealership
- § 8.04[7][c] Obligation Not to Copy Spare Parts
- § 8.04[7][d] Protection of Principals and Agents
- § 8.04[7][e] Non-genuine Assignment of Trade Marks to Distributors
- § 8.05 Offending Against Article 102 of the TFEU/Chapter II of the Competition Act 1998
- § 8.06 Local Restrictions as Measures “Having Equivalent Effect” to Prohibition within Articles 34-36 of the TFEU
- § 8.06[1] Unique Local Regulations
- § 8.06[2] Protection Against Unfair Competition
- § 8.06[3] Consumer Protection
- § 8.06[4] Local Rules in Interstate Conflicts

## TABLE OF CONTENTS

### **PRECEDENTS**

- Precedent 8A Agency Agreement
- Precedent 8B Agent Holding Goods on Consignment
- Precedent 8C Exclusive Distributorship
- Precedent 8D Distributorship Agreement with Option to Manufacture
- Precedent 8E Merchandising Agreement
- Precedent 8F List Rental Agreement: General Hire—Mailing by Hirer
- Precedent 8G Franchise Agreement
- Precedent 8H Distribution Agreement—EC
- Precedent 8I Enquiries Before Contract by Proposed Franchisee
- Precedent 8J Franchise Agreement
- Precedent 8K Bonding of Franchisees

### **EXTRACTS FROM DECISIONS**

- Extract 8A Musik Vertrieb Membran GmbH & K-Tel Int'l v. GEMA
- Extract 8B Re Agreement of A. Raymond & Co.
- Extract 8C Re Agreements of Davidson Rubber Co.
- Extract 8D Dansk Supermarked A/S v. Imerco A/S
- Extract 8E Industrie Diensten Groep B.V. v. J.A. Beele
- Extract 8F [Reserved]
- Extract 8G Pronuptia de Paris GmbH v. Pronuptia de Paris Irmgard Schillgallis
- Extract 8H Acme Circus Operating Co. v. Kuperstock

## **CHAPTER 9 CONTRACTUAL ISSUES AND TERMS RELATING TO INTELLECTUAL PROPERTY**

- § 9.01 Contractual Issues and Intellectual Property Rights Transactions
- § 9.02 Some U.K. Statutes Affecting Contractual Transactions
- § 9.02[1] Implied Covenants Under English Statutes
- § 9.02[2] UK Consumer Contracts
- § 9.03 Licence Agreements
- § 9.04 Duration of Contracts
- § 9.05 Attornment Clauses
- § 9.06 Severability of Contracts
- § 9.07 Monetary Judgments in International Disputes
- § 9.08 Residual Rights After Termination
- § 9.09 Right to Inspect Books During Agreement Period
- § 9.10 Best Endeavours Clauses
- § 9.11 Recitals and Operative Clauses
- § 9.12 Party Insolvency, termination etc., and the Corporate Insolvency and Governance Act 2020

## FORMS AND AGREEMENTS

- § 9.13 Breach
- § 9.14 Proper Law of Contract
- § 9.15 Choice of Forum
- § 9.16 Communication of Acceptance
- § 9.17 Goods Supplied and Held on Trust
- § 9.18 Charges on Intellectual Property
- § 9.19 Torts Relating to Contract
- § 9.20 Limitation of Liability
- § 9.21 Force Majeure Clauses
- § 9.22 Reservation of Rights Clauses
- § 9.23 Right of Third Parties
- § 9.24 Definition of a “business”
- § 9.25 Entire Agreement
- § 9.26 Indemnity against third party rights infringement
- § 9.26[1] Indemnities against third party rights infringement
- § 9.26[2] Liability of licensee to third party for acts of sub-licensee
- § 9.27 Right to re-assignment on non-payment
- § 9.28 Digital Signatures
- § 9.29 Assignment of Contractual Claim
- § 9.30 Penalty Clauses
- § 9.31 Implied Terms
- § 9.32 Good Faith
- § 9.33 Non Assignment or Transfer

## PRECEDENTS

- Precedent 9A [Reserved]
- Precedent 9AB Clause Expressly Excluding Enforcement by Third Parties
- Precedent 9B [Reserved]
- Precedent 9C Consultancy Agreement
- Precedent 9D Express Covenants for Title
- Precedent 9E [Reserved]
- Precedent 9F [Reserved]
- Precedent 9G [Reserved]
- Precedent 9J Clause Intended to Cover Severability of Comprehensive Agreement
- Precedent 9K Development Contract
- Precedent 9L Tools Supply Agreement
- Precedent 9M [Reserved]
- Precedent 9N [Reserved]
- Precedent 9P Indemnity Against Third Party Claims
- Precedent 9Q [Reserved]
- Precedent 9R [Reserved]

## TABLE OF CONTENTS

Precedent 9S	Clause in “Take-over” Contract Relating to Trade Marks
Precedent 9T	[Reserved]
Precedent 9U	Revision of Royalty
Precedent 9V	[Reserved]
Precedent 9W	[Reserved]
Precedent 9Y	Clauses for Contract Conditions
Precedent 9Z	Guarantee of Goods
Precedent 9AA	Retention of Title (“Romalpa”) Clause

## EXTRACTS FROM DECISIONS

Extract 9A Feist v. Société Intercommunal Belge d'Electricité

Extract 9B Treseder-Griffin & Anor. v. Cooperative Ins. Soc'y Ltd.

Extract 9C Terrell v. Mabie Todd & Co.

Extract 9D Aluminium Industrie Vaassen B.V. v. Romalpa Aluminium Ltd.

## CHAPTER 10 ARBITRATION

- § 10.01 What is Arbitration
- § 10.02 Why use Arbitration
- § 10.03 Scope and Limitations of this Chapter and of “Future” dispute clauses
- § 10.04 Arbitrability of Intellectual Property Rights per se
- § 10.05 Arbitrability of Agreements relating to Intellectual Property
- § 10.06 International Arbitration
- § 10.06[1] The UNCITRAL Model Law on International Arbitration
  - § 10.06[1][a] The Model Law is not a Convention
  - § 10.06[1][b] Types of Adoption of the Model Law
  - § 10.06[1][c] Extent of Adoption of the Model Law
  - § 10.06[1][d] Scope of the Model Law
  - § 10.07 Referral to Major Arbitration Institutions
  - § 10.08 The Law of Arbitration in England & Wales
  - § 10.08[1] The Arbitration Act 1996 (as amended)
  - § 10.08[1][a] Scheme of the Act
  - § 10.08[1][b] Mandatory and Non-Mandatory Provisions
  - § 10.08[1][c] Drafting considerations of non-mandatory provisions
  - § 10.08[1][d] The Arbitration Agreement
  - § 10.08[1][e] Arbitration Agreement must be “in writing”
  - § 10.08[1][f] Separability of Arbitration Agreement
  - § 10.08[1][g] Which matters are referable to arbitration under the agreement

## FORMS AND AGREEMENTS

- § 10.08[1][h] Enforcement of the Arbitral Award
- § 10.08[2] Recognition of Foreign Awards - the New York Convention
- § 10.09 Application of E.U. Competition law by Arbitral Tribunal
- § 10.10 Arbitration for Franchising
- § 10.11 Escalating ADR Clauses
- § 10.12 US Arbitration law
- § 10.12[1] The Federal Arbitration Act
- § 10.12[2] Courts in Favour of Arbitration
- § 10.12[3] State Law and Federal Law
- § 10.12[4] Enforcement of International and “Non-domestic” Arbitral Awards
- § 10.12[4][a] The New York Convention
- § 10.12[4][b] Limited Enquiry as to Arbitration
- § 10.12[4][c] Awards made in US can be “Non-domestic”
- § 10.12[5] Scope of the Arbitration Agreement
- § 10.12[5][a] Challenging the Arbitrator’s Authority to make the Award
- § 10.12[5][b] Freedom of Parties to Contractually Expand Court’s Review Powers
- § 10.12[5][c] Third Parties to Agreement containing arbitration clause
- § 10.12[6] Conflict of Forum Selection and Arbitration Clauses
- § 10.12[7] Application of Anti-trust rules by Arbitral Tribunal
- § 10.12[8] Patent Arbitration

## PRECEDENTS

- Precedent 10A Institutional Clauses
- Precedent 10B Simple Form Appointing Sole Arbitrator - Arbitration Act 1996
- Precedent 10C Long Form Appointing Two Arbitrators and a Chairman - Arbitration Act 1996
- Precedent 10D Simple form excluding punitive damages - Federal Arbitration Act
- Precedent 10E Alternative referral clause excluding intellectual property rights from arbitration
- Precedent 10F ADR then Arbitration with Optional Referral to Expert, Leading Counsel or Court
- Precedent 10G Separate Provision for Appointment of Arbitrator
- Precedent 10H Notice to Determine Dispute
- Precedent 10J Appointment of Joint Arbitrators
- Precedent 10K Arbitration a Condition to Legal Proceedings (*Scott v. Avery* clause)

## TABLE OF CONTENTS

Precedent 10L Arbitrator Appointed by Local Chamber of Commerce

### **EXTRACTS FROM RULES OF ARBITRATION INSTITUTIONS**

- Extract 10A Rules of Arbitration of the International Chamber of Commerce (In force as from 1 January 2012)
- Extract 10B Rules of Commercial Arbitration of American Arbitration Association
- Extract 10C Rules of Patent Arbitration of American Arbitration Association
- Extract 10D Rules of London Court of International Arbitration
- Extract 10E Rules of Arbitration of World Intellectual Property Organisation
- Extract 10F Procedures for Large, Complex Commercial Disputes of American Arbitration Association

### **CHAPTER 11 TAXATION AND INTELLECTUAL PROPERTY**

- § 11.01 Taxation and Intellectual Property Generally
- § 11.02 Taxation Legislation and Authorities
- § 11.03 Entities
- § 11.04 Characterising the Nature of Transactions and Payments
- § 11.05 Characterising Intellectual Property Rights and Transactions for Tax Purposes
- § 11.05[1] Intellectual Property
- § 11.05[2] Transactions
- § 11.06 Kinds of Taxes
- § 11.06[1] Income
- § 11.06[2] Capital
- § 11.06[3] Corporate/Corporation Tax
- § 11.06[3][a] Innovation/Patent Box Regimes
- § 11.06[3][b] EU and UK Digital Services Taxes
- § 11.06[4] Sales Tax/Value Added Tax
- § 11.06[4][a] Value Added Tax and Intellectual Property
- § 11.06[5] Stamp Duty
- § 11.07 International Transactions
- § 11.07[1] Double Taxation Provisions
- § 11.07[2] Withholding Tax

### **PRECEDENTS**

- Precedent 11A Deduction of Tax by UK Entity
- Precedent 11B Addition of Value Added Tax to Payment

## CHAPTER 12 OWNERSHIP, TRANSFER AND DISTRIBUTION OF TECHNOLOGY AND INTELLECTUAL PROPERTY RIGHTS

- § 12.01 Shared and Transferred Technologies & Techniques
  - § 12.01[1] Introduction
  - § 12.01[2] Technology Transfer in Context
  - § 12.01[3] Planning for Technology Transfer
- § 12.02 Co-operation and Technology Transfer in Industry
  - § 12.02[1] Categorising Kinds of Co-operation
  - § 12.02[2] The History of the European Categorisation
  - § 12.02[2][a] Technology Transfer Agreements
  - § 12.02[2][b] Joint-Venture Agreements
  - § 12.02[2][c] Research & Development Agreements
  - § 12.02[2][d] Specialisation Agreements
  - § 12.02[2][e] Technology Pools
  - § 12.02[3] Consortia
- § 12.03 Co-operation and Technology Transfer involving Universities
  - § 12.03[1] Background
  - § 12.03[2] Approaches
  - § 12.03[3] Main Issues and Basic Structures in Collaboration
  - § 12.03[4] Strategic Issues
  - § 12.03[5] Sponsoring Student Research (UK Example)
  - § 12.03[5][a] Commencement and Date
  - § 12.03[5][b] Parties
  - § 12.03[5][c] Recitals
  - § 12.03[5][d] The Project (Clauses 1-3)
  - § 12.03[5][e] Contributions by the Company (Clauses 4-6)
  - § 12.03[5][f] Progress (Clauses 7-9)
  - § 12.03[5][g] Confidentiality (Clauses 10-15)
  - § 12.03[5][h] Inventions and Discoveries (Clauses 16-17)
  - § 12.03[5][i] Exploitation (Clauses 18-20)
  - § 12.03[5][j] “Boilerplate” Clauses (Clauses 21-26)
- § 12.04 The Nature of the Underlying Rights involved in Technology Transfer
  - § 12.05 Transactions involving Underlying Intangible Rights
  - § 12.05[1] Transfers
  - § 12.05[2] Charges
  - § 12.05[3] Licences
  - § 12.05[4] Derivative Action by Shareholder or Director
- § 12.06 International Technology Control
  - § 12.06[1] United Kingdom
  - § 12.06[2] Europe
  - § 12.06[3] United States
  - § 12.06[4] US-UK Treaty

## TABLE OF CONTENTS

### **PRECEDENTS**

- Precedent 12A Assignment of Chose in Action
- Precedent 12B Charge on Chose in Action
- Precedent 12C Assignment of Benefit on Contract by Way of Mortgage
- Precedent 12D Assignment by Way of Mortgage of Moneys Due Under Contract for Present Advance
- Precedent 12E [Reserved]
- Precedent 12F [Reserved]
- Precedent 12G Project Funding Agreement
- Precedent 12H [Reserved]
- Precedent 12J Agreement Between Inventor and Manufacturer Jointly to Exploit Invention as Co-owners
- Precedent 12K Three-Party Toll-Payment Manufacturing Agreement
- Precedent 12L Commercial Research and Development Agreement
- Precedent 12M Joint Venture Agreement
- Precedent 12N Joint Venture Agreement: Additional Clause When Parties Are Mutually Competitive
- Precedent 12P University Research Sponsored by Industry
- Precedent 12Q Charge over Copyright Work
- Precedent 12R Director's Service Agreement with Company

### **EXTRACT FROM DECISION**

- Extract 12A Mareva Compania Naviera S.A. v. International Bulkcarriers S.A. ("The Mareva")

## **CHAPTER 13 PLANT VARIETIES AND BIOTECHNOLOGY**

- § 13.01 Principle of Plant Variety Protection
- § 13.02 Types of Protection
- § 13.03 Rights Available in the United States
- § 13.03[1] Patents
- § 13.03[2] Plant Varieties Protection
- § 13.03[3] Protection for Developments in Biotechnology
- § 13.03[4] Multiple Claims
- § 13.03[5] Overlap Between Patents and Breeders' Rights
- § 13.03[6] Future Developments Needed for Alternative Uses to Which Products of Plant Varieties Can Be Applied
- § 13.04 Rights Available in the United Kingdom
- § 13.04[1] Patents for Plant Varieties
- § 13.04[2] Plant Breeders' Rights
- § 13.04[2][a] Persons Entitled to Apply
- § 13.04[2][b] Nature of the Rights Conferred

## FORMS AND AGREEMENTS

- § 13.04[2][c] Infringement
- § 13.04[2][d] Exemptions
- § 13.04[2][e] Duration of Rights
- § 13.04[2][f] Sale of Rights
- § 13.04[2][g] Naming of Varieties
- § 13.04[2][h] Licensing and Compulsory Licenses
- § 13.04[2][i] Annulment, Cancellation and Suspension
- § 13.04[2][j] The Plant Varieties and Seeds Tribunal
- § 13.04[2][k] European Harmonisation and EU Exit
- § 13.04[2][l] EU Competition Law and Plant Varieties Rights
- § 13.04[3] Biotechnology
- § 13.04[3][a] Patents
- § 13.04[3][b] Licensing
- § 13.04[3][c] Compulsory and Cross-Licensing
- § 13.05 European Protection
- § 13.05[1] The EU-UK Withdrawal Agreement and Continued Protection for CPVRs

## PRECEDENTS

- Precedent 13A Plant Variety Licence
- Precedent 13B Plant Experiments Agreement
- Precedent 13C Tissue Culture Research Project

## EXTRACTS FROM DECISIONS

- Extract 13A Re Wheat Variety "Cama"
- Extract 13B Yoder Bros., Inc. v. California-Florida Plant Corp.
- Extract 13C Diamond v. Chakrabarty
- Extract 13D Royon v. Meilland

## SECTION ONE UNITED KINGDOM

### APPENDIX 1A STATUTE OF MONOPOLIES 1623

### APPENDIX 1B GRANT OF LETTERS PATENT

### APPENDIX 1C PATENTS ACT 1977

### APPENDIX 1D [RESERVED]

### APPENDIX 1K COPYRIGHT, DESIGNS AND PATENTS ACT 1988

### APPENDIX 1L INTELLECTUAL PROPERTY ACT 2014

TABLE OF CONTENTS

**APPENDIX 1M [RESERVED]**

**APPENDIX 1N REGISTERED DESIGNS ACT 1949**

**Volume 3**

**APPENDIX 1P CONSUMER RIGHTS ACT 2015**

**APPENDIX 1Q TRADE MARKS ACT 1994**

**APPENDIX 1R DIGITAL MARKETS, COMPETITION  
AND CONSUMER ACT 2024**

**APPENDIX 1S LAW OF PROPERTY ACT 1925, LAW  
OF PROPERTY (MISCELLANEOUS PROVISIONS)  
ACT 1994 (IMPLIED COVENANTS PROVISIONS) AND  
LAW OF PROPERTY (MISCELLANEOUS  
PROVISIONS) ACT 1989 (DEEDS AND THEIR  
EXECUTION)**

- (1) Law of Property Act 1925 (Implied Covenants Provisions—  
Now Repealed)
- (2) Law of Property (Miscellaneous Provisions) Act 1994  
(Implied Covenants Provisions)
- (3) Law of Property (Miscellaneous Provisions) Act 1989 (Deeds  
and their execution)

**APPENDIX 1T DURATION OF COPYRIGHT AND  
RIGHTS IN PERFORMANCES REGULATIONS 1995**

**APPENDIX 1U UNFAIR CONTRACT TERMS ACT  
1977**

**APPENDIX 1V COPYRIGHT AND RELATED RIGHTS  
REGULATIONS 1996**

**APPENDIX 1W COPYRIGHT AND RIGHTS IN  
DATABASES REGULATIONS 1997**

**APPENDIX 1Y PLANT VARIETIES ACT 1997**

**APPENDIX 1Z THE COMPETITION ACT 1998**

1Z(1) Competition Act 1998 (Vertical Agreements Block  
Exemption Order) 2022

1Z(A1) Vertical Agreements Block Exemption Order Guidelines  
July 2022 (CMA 166)

FORMS AND AGREEMENTS

- 1Z(A2) Guidance on the application of the Chapter I prohibition in the Competition Act 1998 to horizontal agreements
- 1Z(2) Competition Act 1998 (Research and Development Agreements Block Exemption) Order 2022
- 1Z(3) Competition Act 1988 (Specialisation Agreements Block Exemption) Order 2022

**APPENDIX 1AA EXTRACTS FROM THE ENTERPRISE ACT 2002**

**APPENDIX 1AB EXTRACTS FROM THE ENTERPRISE AND REGULATORY REFORM ACT 2013**

**SECTION TWO UNITED STATES**

**APPENDIX 2A SHERMAN ACT (AS AMENDED)**

**APPENDIX 2B CLAYTON ACT (AS AMENDED)**

**APPENDIX 2B(1) FEDERAL TRADE COMMISSION ACT (AS AMENDED)**

**APPENDIX 2C PATENT LAW (EXTRACTS)**

**APPENDIX 2D TRADEMARK LAW (EXTRACTS)**

- (1) Extracts from U.S. Trademark Law, 15 U.S.C. §§ 1051-1127 [Lanham Act §§ 1-50]
- (2) Trademark Dilution Revision Act of 2006

**APPENDIX 2E COPYRIGHT LAW**

**APPENDIX 2F [RESERVED]**

**APPENDIX 2G USPTO TRADEMARK EXAMINATION OF DOMAIN NAMES**

**APPENDIX 2H USPTO IDENTIFICATION AND CLASSIFICATION OF CERTAIN COMPUTER RELATED GOODS AND SERVICES**

**APPENDIX 2I [RESERVED]**

TABLE OF CONTENTS

**APPENDIX 2I(1) GENERAL INFORMATION ABOUT  
35 U.S.C. 161 PLANT PATENTS**

**APPENDIX 2J ANTITRUST GUIDELINES FOR THE  
LICENSING OF INTELLECTUAL PROPERTY**

**APPENDIX 2J(1) ANTITRUST GUIDELINES FOR  
COLLABORATIONS AMONG COMPETITORS**

**APPENDIX 2J(2) ANTITRUST GUIDELINES FOR  
INTERNATIONAL ENFORCEMENT AND  
COOPERATION**

**APPENDIX 2J(3) MERGER GUIDELINES**

**APPENDIX 2K DEFEND TRADE SECRETS ACT 2016**

**Volume 4**

**SECTION THREE EUROPEAN UNION**

**APPENDIX 3A TREATIES AND AGREEMENTS**

- (1) Extracts from the Treaty on the Functioning of the EU, Articles 30-37, 101-102 and 345
- (2) Extracts from the EU - UK Withdrawal Agreement, Articles 2, 54-61 and 126
- (3) Extracts from the approved draft text of the EU-UK Trade and Cooperation Agreement, Articles DIGIT 1-17 and IP1-57

**APPENDIX 3B REGULATIONS ISSUED BY THE  
EC/EU**

- 3B(1) Regulation 17/62 (6 Feb 1962)
- 3B(2) Regulation 19/65 (2 March 1965)
- 3B(3) Regulation 1/2003 (16 December 2003)
- 3B(4) Regulation 773/2004 (7 April 2004)(Relating to the conduct of proceedings by the Commission pursuant to Articles 81 and 82 of the EC Treaty)
- 3B(5) Regulation 330/2010 (Application of Article 101(3) of the Treaty on the Functioning of the European Union to Vertical Agreements)
- 3B(5A) Commission Regulation (EU) 2022/720 (10 May 2022) on the application of Article 101(3) of the TFEU to categories of vertical agreement and concerted practices

## FORMS AND AGREEMENTS

3B(6) Commission Regulation (EU) 2023/1067 (1 June 2023) on the application of Article 101(3) of the TFEU to certain categories of specialisation agreements

3B(7) Commission Regulation (EU) 2023/1066 (1 June 2023) on the application of Article 101(3) of the TFEU to certain categories of research and development agreements

3B(8) Regulation 316/2014 (21 March 2014) (Application of Article 101(3) of the Treaty on the Functioning of the European Union to Certain Categories of Technology Transfer Agreements)

3B(9) Regulation 240/96 (31 January 1996)

3B(10) [Reserved]

3B(11) Council Regulation (EC) No 40/94 of 20 December 1993 on the Community trade mark

3B(12) Regulation 207/2009 (26 February 2009) on the Community Trade Mark

3B(12A) Regulation 2017/1001 (14 June 2017) on the European Union trade mark (codification)

3B(13) Regulation 6/2002 (12 December 2001) on Community Designs

3B(13A) Regulation 2024/2822 (23 October 2024) on European Designs

3B(14) Regulation 2100/94 (27 July 1994) on Community plant variety rights

3B(15) Regulation 1257/2012 (17 December 2012) on implementing enhanced cooperation in the area of the creation of unitary patent protection

3B(16) Regulation 511/2014 (16 April 2014) on compliance measures for users from the Nagoya Protocol on access to genetic resources and the fair and equitable sharing of benefits arising from their utilisation in the Union

3B(17) Regulation 593/2008 (17 June 2008) on the law applicable to contractual obligations (Rome I)

3B(18) Regulation 864/2007 (11 July 2007) on the law applicable to non-contractual obligations (Rome II)

3B(19) Regulation 910/2014 (23 July 2014) on electronic identification and trust services in the internal market and repealing Directive 1999/93/EC

3B(20) Regulation 2017/1128 (14 June 2017) on cross-border portability of online content services in the internal market

3B(21) Regulation 2018/302 (28 February 2018) on addressing unjustified geo-blocking and other forms of discrimination based on customers' nationality, place of residence or place of establishment within the internal market

TABLE OF CONTENTS

**APPENDIX 3C ANNOUNCEMENTS AND NOTICES  
OF THE E.E.C.**

- 3C(1) [Reserved]
- 3C(2) [Reserved]
- 3C(3) Commission Notice on Agreements of Minor Importance which do not appreciably restrict competition under Article 101(1) TFEU (30 August 2014)
- 3C(4) Commission Guidelines on restrictions of competition “by object” for the purposes of defining which agreements may benefit from the “De Minimis” Notice (25 June 2014)
- 3C(5) [Reserved]
- 3C(6) Commission Guidelines on Vertical Restraints (30 June 2022)
- 3C(7) Commission Guidelines on the applicability of Article 101(3) of the Treaty on the Functioning of the European Union to horizontal co-operation agreements (14 June 2023)
- 3C(8) Commission Guidance on Enforcement Priorities in Applying Article 82 of the EC Treaty to Abusive Exclusionary Conduct by Dominant Undertakings (24 February 2009)
- 3C(8A) Commission Communication and Annex of Amendments to the Commission Guidance on enforcement priorities in applying Article 82 of the EC Treaty to Abusive Exclusionary Conduct by Dominant Undertakings (27 March 2023)
- 3C(9) Commission Notice on the definition of “relevant market” for the purposes of Community competition law (9 December 1997)
- 3C(10) Commission Communication: Guidelines on the application of Article 101 of the TFEU to technology transfer agreements (28 March 2014)
- 3C(11) Commission Notice on certain articles of Directive 98/44/EC of the European Parliament and Council on the legal protection of biotechnological inventions (8 November 2016)
- 3C(12) Commission Communication to the Parliament Council and European Economic and Social Committee setting out the EU approach to Standard Essential Patents (29 November 2017)
- 3C(13) Council Notice on the Agreement on a Unified Patent Court (20 June 2013)

## APPENDIX 3D DIRECTIVES OF THE E.E.C.

3D(1) Directive 89/194/EEC First Council Directive to approximate the laws of the Member States relating to trade marks (21 December 1988)

3D(1A) Directive 2008/95/EC of the European Parliament and Council to approximate the laws of the Member States relating to trade marks (codified) (22 October 2008)

3D(1B) Directive (EU) 2015/2436 of the European Parliament and Council to approximate the laws of the Member States relating to trade marks (recast) (16 December 2014)

3D(2) Directive 98/44/EC of the European Parliament and Council on the legal protection of biotechnological inventions (6 July 1998)

3D(3) Directive 91/250/EEC of the Council on the legal protection of computer programs (14 May 1991) (repealed) (14 May 1991)

3D(4) Directive 86/653/EEC of the Council on the Coordination of laws of Member States relating to self-employed commercial agents (18 December 1986)

3D(4A) Directive 92/100/EEC of the Council on rental right and lending right and on certain rights related to copyright in the field of intellectual property (19 November 1992)

3D(4B) Directive 93/83/EEC of the Council on coordination of certain rules concerning copyright and rights related to copyright applicable to satellite broadcasting and cable retransmission (27 September 1993)

3D(4C) Directive (EU) 2019/789 of the European Parliament and Council laying down of rules on the exercise of copyright and related rights applicable to certain online transmissions of broadcasting organisations and retransmission of television and radio programmes and amending Council Directive 93/83/EEC (17 April 2019)

3D(5) Council Directive on Harmonizing the Term of Protection of Copyright and Certain Related Rights (29 October 1993)

3D(6) Databases: Directive on the Legal Protection of Databases (11 March 1996)

3D(7) Designs: Directive on the Legal Protection of Designs (13 October 1998)

3D(7A) Designs: Directive (EU) 2024/2823 (23 October 2024) on the Legal Protection of Designs (recast)

3D(8) Directive on the Harmonisation of Certain Aspects of

## TABLE OF CONTENTS

	Copyright and Related Rights in the Information Society (22 May 2001)
3D(9)	Directive on the Resale Right for the Benefit of the Author of an Original Work of Art (27 September 2001)
3D(9A)	Directive 2006/115/EC of the European Parliament and of the Council on the Rental Right and Lending Right and on Certain Rights Related to Copyright in the Field of Intellectual Property (12 December 2006)
3D(9B)	Directive 2006/116/EC of the European Parliament and of the Council on the Term of Protection of Copyright and Certain Related Rights (12 December 2006)
3D(10)	Directive 2009/24/EC on the Legal Protection of Computer Programs (23 April 2009)
3D(10A)	Directive 2011/77/EU of the European Parliament and of the Council amending Directive 2006/116/EC on the term of protection of Copyright and Certain Related Rights (27 September 2011)
3D(11)	Directive 2012/28/EU on certain permitted uses of orphan works (25 April 2012)
3D(11A)	Directive 2014/26/EU of the European Parliament and of the Council on the Collective Management of Copyright and Related Rights and Multi-Territorial Licensing of Rights in Musical Works for Online Use in the Internal Market (26 February 2014)
3D(12)	Directive (EU) 2016/943 of the European Parliament and Council on the protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure (8 June 2016)
3D(13)	Directive (EU) 2019/790 of the European Parliament and Council on copyright and related rights in the Digital Single Market and amending Directives 96/9/EC and 2001/29/EC (17 April 2019)

## SECTION FOUR INTERNATIONAL CONVENTIONS AND AGREEMENTS

### APPENDIX 4A LIST OF INTERNATIONAL CONVENTIONS ON INTELLECTUAL PROPERTY

### APPENDIX 4B BERNE COPYRIGHT CONVENTION (PARIS REVISION, 1971)

### APPENDIX 4C UNIVERSAL COPYRIGHT CONVENTION (PARIS REVISION, 1971)

FORMS AND AGREEMENTS

**APPENDIX 4D INTERNATIONAL CONVENTION FOR  
THE PROTECTION OF NEW VARIETIES OF PLANTS  
(UPOV)**

**APPENDIX 4E COMPETITION LAWS CO-  
OPERATION AGREEMENT 1991 (EEC-USA)**

**APPENDIX 4F TRIPS AGREEMENT**

**APPENDIX 4G CONVENTION ON THE  
RECOGNITION AND ENFORCEMENT OF FOREIGN  
ARBITRAL AWARDS, 1958**

**APPENDIX 4H EUROPEAN PATENT CONVENTION  
2000**

**APPENDIX 4I WIPO AGREEMENTS AND PROTOCOL**

- (1) Madrid Agreement Concerning the International Registration of Marks of 14 April 1891 (as amended)
- (2) Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, adopted on 27 June 1989 (as amended)

**SECTION FIVE UNITED NATIONS**

**APPENDIX 5A [RESERVED]**

**SECTION SIX RULES OF ARBITRATION**

**APPENDIX 6A UNCITRAL MODEL LAW ON  
INTERNATIONAL COMMERCIAL ARBITRATION  
(1985)**

**APPENDIX 6B UK ARBITRATION ACT 1996 (AS  
AMENDED BY ARBITRATION ACT 2025)  
(EXTRACTS)UK ARBITRATION ACT 1996 (AS  
AMENDED BY ARBITRATION ACT 2025) (EXTRACTS)**

**APPENDIX 6C THE FEDERAL ARBITRATION ACT**

**APPENDIX 6D THE UNIFORM ARBITRATION ACT  
1950**

**APPENDIX 6E VOLUNTARY ARBITRATION OF  
PATENT MATTERS**

TABLE OF CONTENTS

**Table of Laws and Rules**

**Table of Cases**

**Index**