

LEGAL IMPLICATIONS OF INTERPRETATION OF THE APPLIED INVENTION AS ENGINEERING CONCRETE OPERA

Lecturer **Raul Sorin FÂNTÂNĂ**¹

Abstract

The work is a study of the important implications of engineering interpretation of protection corroboration, reduced in time and conditioned by the payment of patent related fees, with the longer lasting and free of tax conditioning provided by copyright to any opera, technical creation included. The theme is based on the conclusions of some expert reports on intellectual/industrial property, managerial and unethical behavior observation and damage value, and proposes a systemic, realistic and organic approach of the two laws from the perspective of the patrimonial rights of the holder.

Keywords: *technical expert report, intellectual-industrial property, technical work, technical jurisprudence*

JEL Classification: K41, L15, O34

1. Introduction

The importance of property, in general and of intellectual property, in special, was and still is a source of numerous works the majority of which address topics mainly from the field of the Law. This is partly justified: case studies have always been and still are sources of law in all the states that are using the common-law system but, at the same time, they are valid assessment models for the cases of the Roman-Germanic system. There is an obvious tendency to close the gap between the common-law system – based on precedents and the wider system of the European Roman Civil Law system in which the abstract judgment prevails. The EU has regulated contracts which originate in the *common law*, such as: the franchise contract, the leasing contract and the factoring contract.

In the field of intellectual property protection, with reference mainly to the elements common to the legislation specific of copyright, patent protection respectively, position that were somewhat different at the beginning of the 20th century have suffered deep changes even though either system tried and continue to defend certain interpretation and allocation differences of certain sub-domains of the intellectual property.

In an article published in 1989², the authors noted that "although there are valuable introductory works on the enforcement of the copyright legislation in economy (as distinct forms of the Copyright Law), no work examines copyright as a whole presenting the evolution and the major doctrines of the legislation from the point of view of economic sciences".

In another work, published in 1991, the authors highlight the fact that, at the time, although the economists had written works on the intellectual property, the impact of economics was little in this area as compared with their input in matters regarding taxation and antitrust activities. In the same work, with reference to the protection and costs of generating a new idea and innovative activity, the authors approached both the copyright which extends to works derived from an initial work and the rights arising from the protection granted by patenting. In the attempt to draw a parallel between the copyright granted protection and the patent granted protection, the authors – representatives of the way of thinking of the specific historical time – "demonstrate" that it is impossible to draw a parallel between the two types of protection in the sense that they cannot be intertwined because "...patents refer to applying an idea in the shape of a machine, method or

¹ Raul Sorin Fântână - Christian University "Dimitrie Cantemir" of Bucharest, Faculty of Economic Sciences of Braşov, raul_fantana@yahoo.com

² Landes, M.W., Posner, A.R., An Economic Analysis of Copyright Law, The Journal of Legal Studies, JSTOR, Vol.18, No.2 (June, 1989), pp.325-363.

object. By contrast, and in opposition within the idea, the copyright is assumed to be referring to the way of expression only.”³

Considering that the protection given under the copyright law, as the protection of the registered industrial design, generally confers an exclusive usage right, the exercise of the said right can constitute a monopoly as regards all the usage rights of the copyright holder. In practice, this means that it is almost impossible to market spares specific of a vehicle brand without a license given by the intellectual property right holder. Thus, by diminishing the intensity of the competition and notwithstanding the adverse effect on the growth of the welfare of the consumer - a paramount objective of the European legislation with regard to competition - the copyright holder enjoys the benefits of a monopoly allowing for high prices to be maintained. But, there is no doubt that if the copyright holder failed to obtain the exclusive right to use his work, the very essence of copyright would be lost. Acknowledging this dilemma, counsel General Jacobs pinpointed that, in his opinion, in the matter of Oscar Bronner⁴, the exclusive intellectual property rights conferred by law for a limited period of time represent an incentive for research and development.

In the matter MAXICAR, EUCJ separated the subsistence of an exclusive right from its exercise. Moreover, it stipulated that “the mere fact of ensuring the benefit of a lawfully provided for exclusive right which permits to prevent the manufacturing and marketing of protected products by unauthorized third parties, cannot be construed as an abusive method to eliminate competition”.⁵ However, EUCJ also sustained that “the exercise of the exclusive right can be prohibited under Article 86 if it engenders certain abusive conducts from enterprises holding a dominant position.”

After 1990, the globalisation of the commercial activity also impacted the law systems. Although the majority of the states were WIPO members many did not accept the mainly theoretical system of rules. However, we should bear in mind that in Romania, Decree No.321 of 1956 on the copyright, stipulated under Article 9 that the object of the copyright includes “... all intellectual creation works in literary, artistic, scientific fields irrespective of contents and form of expression and irrespective of their value and destination ... with regard to any branch of science”⁶. But, what in our opinion offered a distinct note from the practice described above in USA and other Western countries, were the provisions under Article 2: “... the copyright is born the moment when the work comes in the form of a manuscript, sketch, theme. Painting or any other material form which is more than an expression.

In a more recent work, the author highlights the influence the concomitant evolution of Law and Economics had and still has on doctrine, the accent of the economic analysis of intellectual property shifting to more material and more easy to manage matters of the structure and fabric of the complicated model of common law and of statutory doctrines, of the judicial institutions and business practices with regard to intellectual property.

In the same work, the author states the opinion⁷ according to which: „The ideas which are left unprotected by the Patent Law tend to be those generated by the fundamental research; in the spirit of the patent law ideas are not perceived as useful things. An objection to the creation of property rights in connection with such ideas (it is also, an objection to the protection of the expressive “idea” through the copyright law) lies in the frequently encountered difficulty to trace an idea within a certain product or process. Another objection arises from the fact that patents constitute a poor method to encouraging fundamental research because, by definition, such a research has no immediate commercial application and, therefore lacks any seductive effect on the private investors, given, especially, the low number of such investors.”

³ Idem, p.12 (Engl.: “...patents attach to the application of an idea in the form of a machine, method, or matter. In contrast, copyright is said to attach only the expression, as distinguished from the idea.”)

⁴Idem, apud Case C-7/97 Oscar Bronner GmbH & Co v Mediaprint Zeitungs- und Zeitschriftenverlag GmbH & Co. KG and others [1979] ECR I-07791, Opinion of AG Jacobs par 62. See also 2009/C 45/02. 75.

⁵ Idem, apud Case 53/87 Maxicar and others vs. Régie nationale des usines Renault [1988] ECR I-06039 paras 15-16.

⁶ See also Copyright Decree No.321 of 1956 whereby the right of the employee inventor over his/her work recognised in theory; in fact the employees were totally unaware of the existence of the said Decree.

⁷ Idem, p.65

We cannot accept such an assumption with pretensions of rule. Us, those who are specialised in engineering and with a couple of inventions of our own, when reading these opinions we cannot help to experience the feeling that the author does not come from or does not know at least in a tangential way, the problems related to the technical and engineering fields, as well as to the medical, pharmaceutical, applied physics fields, etc.

Should we consider only the electronic field where tenths of inventions occur daily, we can easily conclude that is not at random that the inventors are not dreamers that come up with difficult to implement ideas. The implementation of many inventions takes place on the manufacturing line where the technical solution is refined. The vast majority of the patent invention applications are sent to the national patent registration offices after they are already introduced in practice. The transfer of licensing contracts from the inventor employee to the employer, the negotiation of the contractual price, etc., is finalized on the way. The reason for which the preparation of a patent application needs time is that it has to contain possible, less performing variants as well as possible variants that are currently impossible to apply; all these to avoid parallel inventions which, if applied by the competition, could smother by specialized marketing procedures the prior solution.

Essentially, with the exception of the fundamental research, the commercial application with on the go recovery of the invention application costs must be performed before the issuance of the patent which can take 2 – 3 years, and sometimes even more.

2. Comparison between the copyright law (LDA) and the invention patent law (LBI)

The comparison of the concepts defining the Romanian “copyright law”⁸, on the one hand, and of the “patented invention law”⁹ on the other, we can note that:

- i) The “originality” of the work is equivalent to the “inventive newness” (newness and inventiveness);
- ii) Neither LDA (Art.9) nor LBI (Art.7) provide for the protection of scientific theories, mathematical theories and of concepts, in general.

It is interesting to note the fact that by the provisions under Art. 9¹⁰, LBI acknowledges that in order to assess the newness of an invention the knowledge accessible to the public by a written or verbal description shall be also taken into consideration or in any other way until the invention patent application is submitted, i.e. through the existence of the copyright of a material product.

In exchange, LDA does not protect the inventions included in a work (Art.9).

Therefore:

- 1) The converse is not valid as long as the law does not provide so:
- 2) The implications for a) the intellectual property right, b) patrimonial rights and c) the protection period, all with regard to the patented and actually manufactured products as well as to the patented and actually used procedures, are different from those provided for under LBI;
- 3) The provisions under art.33, 1st paragraph, letter f corroborated with the provisions under Art.40, 3rd paragraph must be reviewed and reinterpreted.

By corroborating the LDA with the LBI texts we can voice the following lemma:

Since LDA protects the work no matter what their actual expression form is¹¹, and LBI, which imposes that when submitted the patent application must contain the drawings referred to in the description or under claims¹² but without giving and size values¹³, it results that: i) in principle,

⁸ Law No. 8 of March 14 1996 with regard to copyright and related rights Official Gazette No. 60 of March 26 1996

⁹ Law No. 64 of October 11 1991 with regard to the invention patents, Official gazette No.613 of August 19 2014

¹⁰ Law No.8 din 1996 /A rt.9: (1) An invention is new if not included in the current state of the technique.. (2) The current state of the technique contains all the knowledge accessible to the public through a written or verbal description, by use or otherwise until a patent application is submitted (...)

¹¹ Idem, art.24

¹² Law No. 64 of October 11 1991, Art.13

¹³ Decision No. 547 of May 21 2008 for the approval of the Regulations for the enforcement of Patent Law No. 64/1991, Official Gazette No. 456 of May 18 2008, Art.19 and Art.20, paragraph.13.

the invention refers to a possible infinity of technical solutions and ii) each actual materialisation of an invention is protected under LDA.

Therefore, Art.33, 1st paragraph, letter f) shall read as follows:

”The followings shall not be construed as violation of the rights under Art. 31 and 32:

(...) f) the use in good faith of or the good and reliable measures taken to use an invention by third parties during the time interval between the loss of rights of the patent holder and the revalidation of the patent. In such a case, the invention can be used by that person in the volume existing on the date the revalidation announcement is published, and the usage right cannot be transferred but together with the patrimony of the person using the invention or with a fraction of the assets that are affected by the exploitation of the invention. ***The use in good faith of the invention shall be construed as the manufacturing of certain new technical variants of the product and/or the use of the procedure without breaching other intellectual property rights of the inventor, such as a copyright for the actual technical work.***”

The necessity of such a content for LBI is given by the new interpretations of the copyright law in relation with the functional, technical articles and products. Yolanda Eminescu, one of the widely known Romanian and international specialists in the field of copyright, former professor at the Sorbonne University in Paris asserted: ”...we shall evoke only a few issues which became actual in our Law system [author’s note: the Romanian Law] with the conviction that the copyright has been much more impacted by the development of spread techniques than by the today’s development of the creation techniques. The majority of these issues have been solved, as shown below, by the new copyright Law enforced in 1996 which observes the European model. A first issue would be the expansion of the scope of the work covered by judicial protection (generating a new copyright). The technological work, the synthetic work, the permutation novel, the computer graphics question the very definition of the protected work.”¹⁴

As regards the intellectual property rights, the copyright represents a reasonable protection means even if the protection given by copyright to the functional articles is atypical.¹⁵

The Russian Federation Law provides that ”the copyright covers the scientific, literary and artistic work which result from a creative activity as well as parts thereof (titles included) and which meet the originality criteria. Therefore the logos, labels, trade marks and three dimensional objects, which are the result of a creative activity, benefit by right from copyright protection. Are left outside the protection given by the copyright law: official documents (laws, court decisions etc.) as well as any translation thereof; coats of arms and official signs (flags, heraldic signs, decorations, emblems and other similar official items); artistic folklore work; official communications regarding events and facts that destined for information”¹⁶.

We are going to exemplify, step by step, the thinking, design, variant 1 production, patenting, variant 2 production stages, variant n... production stages considering that at this moment the “self threading screw” does not exist.

A 50 mm long and 5 mm in diameter screw is designed at moment T1. The functional drawing, technical execution project for item SA-50x5 is protected by Law No.8/1996.

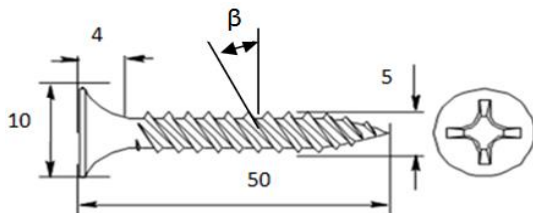


Fig.1. Execution drawing of the first sample of “Self-threading screw”. Dimensions are indicated. It can refer only to the L x D x dk x k / 50 x 5 x 10 x 4 dimension combination. We have here a technical work. It is protected under Law No.8/1996

¹⁴ Eminescu, Y., *Dreptul de autor. Legea nr.8 din 14 martie 1996 comentată*, Lumina Lex, Bucharest, 1997, pp.10-11.

¹⁵ Sulyok, Márton Péter, Copyright in motor vehicle spare parts from competition law perspective, VIII. évfolyam | Vol. VIII. Journal of Legal and Political Sciences, HU ISSN 1789-0446, University of Szeged, Vol. VIII, No. 3/2014, Doctoral School of Law and Political Sciences, pp.2.

¹⁶ *Intellectual property, a business instrument for small and medium enterprises. A Guide for the leather industry, (Ghid pentru Industria pielăriei)*, Oficiul de Stat pentru Invenții și Mărci, OSIM, Bucharest, 2010, ref. to Part IV-of the Russian federation Civil Code (230-FZ) in force since January 01 2008, superseding the Copyright and Related Rights Law (No. 5351-I din 09.07.1993 with the amendments of July 20 2004), pp.150.

Moment T2 – Based on the dimensional execution drawing (Fig. 1) 10 pieces of SA 50x5 screws are manufactured in the workshop. They are going to be used to assembly two boards of wood and it is found out that the chamfering needs deepening and the screw pitch β needs increasing.

Moment T3 – The patent application is filled in complete with the self-threading screw drawing which offers only the general information required for the description of the technical elements L, D, dk si k. The claims (for exemplification purposes) refers to “a screw characterised by the fact that, in order to assure a quick threading, pitch β has a higher value than in the case of the fastening screws, but small enough to prevent unscrewing”.

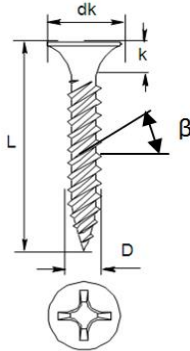


Fig.2. Explanatory drawing for the invention of “Self-threading screw”. No dimensions are given in accordance with the lawful provisions. It can refer to any combination of dimensions L x D x dk x k.

LBI protects ALL the possible technical solutions claiming the invention of a «self-threading» screw (Fig. 2). But, any variant actually generated is protected (technical drawing, actual component part) under LDA.

After a while, based on a second SA 25x6 drawing a self-threading screw is devised with, obviously, different dimensions.. The design, drawing, technical project, for item SA 25x6, which is an actually materialised variant of the product patented under LBI is also protected under LDA.

If a third SA 80x8 screw is designed, we would have a third project, with different dimensions than the two prior screws and so on (Fig. 3). This new execution drawing, technical design for item SA 80x8 is too protected under LBI and LDA.

If the taxes for upholding the patent are not paid the inventor loses all rights. But the designed/manufactured variants, i.e. those with a certified date marked on the drawing, remain protected under LDA throughout the entire life of the author plus 70 years after his/her demise.

Moreover, the technical work remains subject to the provisions under LDA as far as the derived work is concerned, thus granting the holder/author throughout his/her entire life plus 70 years after his /her demise his/her legal successors an exclusive right to decide who, where and how the technical work can be used.

From a patrimonial point of view , the interpretation of the two corroborated laws brings about substantial benefits to the author of the invention by turning it to value either through his/her own production means or through transfer of rights on grounds of a non-exclusive transfer agreement.¹⁷

At the same time, it limits or even completely prevents the unauthorized production of derivative products.



Fig.3. Types of self-threading screws

¹⁷ <http://www.utilul.ro/suruburi/suruburi-metal-sau-tabla/suruburi-gips-carton/p18> (consulted on 20 October, 2015)

To promote a resilient but totally justified thinking necessary when judging possible situations focussed on the assessment of copyrights, patrimonial rights, damages caused to the author of technical work by unauthorised use, we think that it is necessary that the legislation be construed or modified in full harmony with reality.

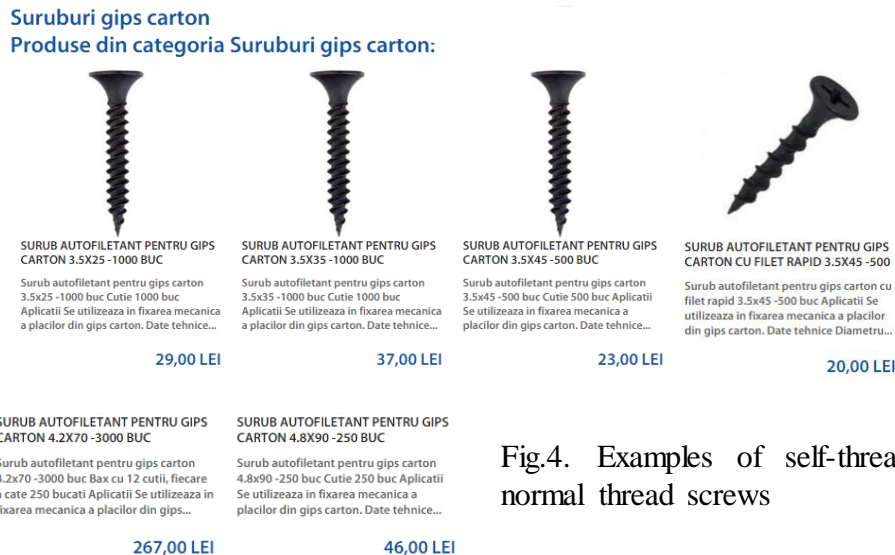


Fig.4. Examples of self-threading, quick or normal thread screws

The interference between sciences which brings about undisputable technical and social benefits should be understood and implemented in the Law system.

Examples of engineering applications in the field of architecture can also be taken: quasi-engineering architectural constructions (e.g. the Eiffel Tower, the maritime container dwellings¹⁸, overhung garages).

If the architectural designs are protected under LDA, where is the limit in the case of engineering projects? How did he dare, Anghel Saligny, the famous engineer, construct the bridge at Cernavoda?

3. Conclusions

The author of this work had been involved in tenths of expertise cases in the field of intellectual/industrial property. Some of them needed an assessment of the damages caused to the inventors by the employing companies which were recipients of the invention as transferees. Companies have stopped paying the upholding fees, the inventors have lost their rights and the employer benefited by the use of the technical materialisation without paying a dime to the inventor employees justifying their acts by the fact that the invention was no longer protected. The court admitted the conclusion of the expert who defended copyright of the inventors over all the solutions implemented in the production process and for which the execution plans still bore the signatures of the inventors who were also the authors of the design plans. During the procedure of appeal one of the inventors died whereas the second one lost all interest in the case. Therefore, the Court ruled in favour to the appellants.

¹⁸ <http://casepractice.ro/case-din-containere-maritime-cele-mai-bune/> (consulted on 20 October, 2015)

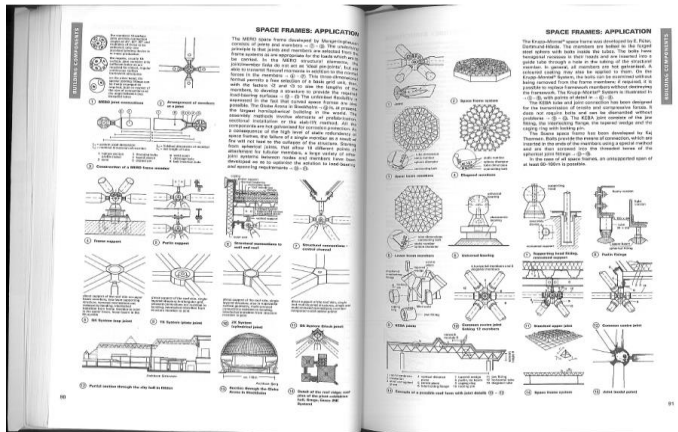


Fig.5. Examples of architectural works of pure engineering conception taken from fundamental architectural works: couplings and joints used in civil construction works.

On the other hand, the very nature of expertise of the author of this work led him to establish contacts with specialists in the architecture field. By way of consequence, the author was forced to assess situations which imposed the interpretation of data collected from fundamental works of the theory of architecture¹⁹ which contained architecture designs of quasi pure engineering conception.²⁰ (fig.5, fig.6, fig.7).

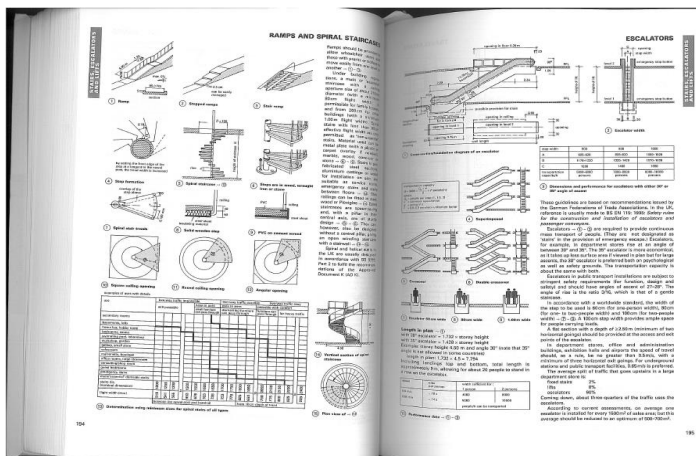


Fig.6. Examples of architectural works of pure engineering conception taken from fundamental architectural works: spiral stair design

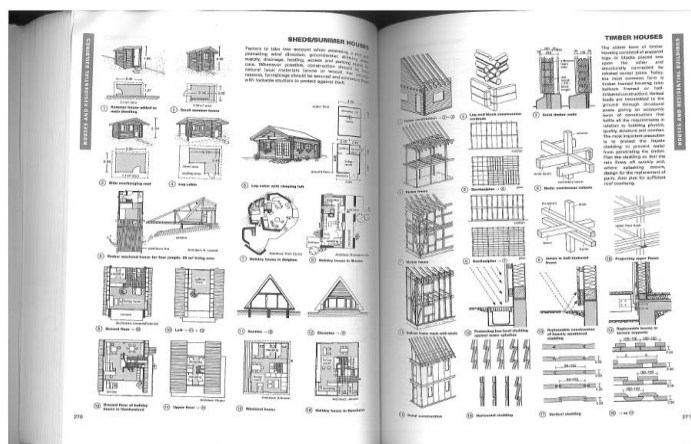


Fig.7. Examples of architectural works of pure engineering conception taken from fundamental architectural works: cottage and summer house design.

¹⁹ Neufert E., Neufert P., *Architects' Data, Third Edition*, Blackwell Science, Blackwell Publishing, 2006, UK, pp.90-91.
²⁰ *Ibidem*, pp.90-91, 194-195.

All the examples above support the necessity of legislative changes in favour to the authors of works – as suggested, concomitantly with the strengthening of the collaboration between the law specialist - be it judge or counsel, and the judicial technical expert.

In fact, the organisation of an international conference of multivalent specificity, such as Business Law Conference, Bucharest, Romania, demonstrates the mutual interest of the specialists in law, engineering and economy in laying the bases for a collaboration that would benefit the complex judicial act.

Bibliography

1. Besen, S.M., Raskind, J.L., *An Introduction to the Law and Economics of Intellectual Property*, `The Journal of Economic Perspectives`, Vol.5, No.1, (Winter 1991)
2. Eminescu, Y., *Dreptul de autor. Legea nr.8 din 14 martie 1996 comentată*, Lumina Lex, Bucharest, 1997
3. Landes, M.W., Posner, A.R., *An Economic Analysis of Copyright Law*, `The Journal of Legal Studies`, JSTOR, Vol.18, No.2 (June, 1989)
4. Neufert E., Neufert P., *Architects' Data*, third edition, Blackwell Science, Blackwell Publishing, 2006, UK
5. Posner A. Richard, *Intellectual Property: The Law and Economics Approach*, `Journal of Economic Perspectives`, Volume 19, Number 2, Spring 2005
6. *Proprietatea Intelectuală, instrument de afaceri pentru IMM-uri Ghid pentru Industria pielăriei, Oficiul de Stat pentru Invenții și Mărci*, OSIM, Bucharest, 2010.
7. Civil Code of the Russian Federation (230-FZ) entered into force on 01.01.2008 which replaced Law on Copyright and Related Rights (Nr.5351-I from 09.07.1993 to 20.07.2004 amended)
8. Law No. 64 of 11 October 1991 on patents, Official Gazette no. 613 of 19 August 2014 updated republished
9. Law No. 8 of 14 March 1996 on Copyright and Related Rights, Official Gazette no. 60 of 26 March 1996 (updated)
10. Resolution no. 547 of 21 May 2008 approving the Regulation implementing Law no. 64/1991 on patents, Official Gazette no. 456 of May 18, 2008
11. Decree no. 321 of 18 June 1956 on copyright, issued by the State Council, published in the Official Gazette, 18 of June 27, 1956.