

Intellectual Property News

Ground breaking decision rendered

Jurisprudence in favor of an unpublished literary and artistic work used against a design subsequently registered at the INPI by a third party

In addition to the ruling rendered in 1999 by the Court of Appeal of the United States of America's Federal Circuit of Courts in favor of copyright over patent; to the ruling rendered in Belgium in 1997 in favor of the copyright of Hergé's heirs over the unauthorized use of artistic drawings for commercial and industrial purposes; to the countless court cases won by Walt Disney Studio over the past several decades for similar wrongdoings (*i.e. plagiarism*), **and above all** to the international ruling rendered in 1987 in favor of French Professor Luc Montagnier's copyright over American Professor Robert Gallo's patent for the discovery of the AIDS virus; for the first time, a modest inventor has successfully used, in a court of law, an unpublished literary and artistic work (*created in 1994*) against the French equivalent of a Design Patent (U.S.) or Industrial Design (Canada) subsequently registered by a third party. This case confirms that a previously undisclosed creative work ~ *i.e. one that remained secret* ~ is nonetheless a legally valid anteriority (*i.e. prior art*) that can be used to annul a patent, subsequently registered by a third party on the same invention. The details of this case are quite revealing.

In 1994, a French "**creator**" (*i.e. an inventor turned "creator" through the authorship of a Work of the Mind*) included the original design of a particular style of street furniture, a container used in recycling, in an unpublished literary and artistic work (*a prototype version of the Intellectual Passport CB*) entitled "*Change the city*" (*Librairie bleue editions – library of inventions N° 2221 – Troyes – France*). In early 1997, one year after this innovative product had first been introduced to the market, a third party decided to replicate and market it. Unaware of the existence of the **creator's** literary and artistic work ~ *and doubtless influenced by his legal counsel* ~ the **self-appointed inventor** registered a "*model*" (*the European form of a Design Patent (U.S.) or Industrial Design (Canada)*) for this container on July 31st, 1997. Since no previous monopolistic title had ever been registered for this product at the "*INPI*" (*French equivalent of the U.S. Patent and Trademark Office*), the **self-appointed or so-called inventor** thought that he could safely claim monopolistic rights based on the unique aesthetic quality(ies) of the container... By the end of the year 2000, claiming that he was the true inventor, the copier/plagiarist initiated legal proceedings against the retail chains, namely, Slymag Super U, System U's Eastern Regional Head Office and Alliance Development Innovation, that were using the product as defined in the **creator's** original work. The true **creator** tried in vain to reach an out-of-court settlement with the **so-called "inventor"**. In December 2001, he requested the help of Michel Dubois. As acting editor, Mr Dubois then entered into correspondence with the **so-called inventor's** legal counsels in an attempt to resolve the issue. His approach was based on an existing strategy developed for this very purpose.

Having learned of the existence of the book, the **so-called inventor** requested that one of Europe's leading experts on Intellectual Property, Mr. Jacques Azéma (*professor at Lyons, France*), come to Paris to comment on the relevance of the **creator's** literary and artistic work, which the **true creator** had made available for viewing at his lawyer's office. Upon complying with this request, Mr. Azéma confirmed, without hesitation, that the **creative** work in question represented a legally valid anteriority (*i.e. prior art*) that could be used against the **so-called inventor's** subsequently registered title.

Disgruntled and unwilling to accept this opinion, the **so-called inventor** persisted in his claims, and brought the matter before Lyon's Tribunal of Commerce. On September 30th, 2003, after a single hearing and a six-month deliberation, the court ruled in favor of the **creator's** copyright and dismissed the **so-called inventor's** suit, on the grounds that his *registered design* or "*model*" (*bearing INPI N° 974631*) **lacked novelty**.

Undeterred, the **so-called inventor** appealed the judgment. On April 1st, 2004, the case was heard by Lyon's Court of Appeal; less than two months later, the appellate court upheld the verdict (**Court of Appeal of Lyon, May 27th, 2004 – R.G. 03/06633**), and thus confirmed the judgment rendered seven months earlier by the Tribunal of Commerce. In the end, justice was well served, at an affordable cost: one year of correspondence between Michel Dubois and the plagiarist's legal counsel, ten months for the ruling by the Tribunal of Commerce and seven months for the ruling by the Court of Appeal (*N.B. In each court, there was only one hearing*). This news should encourage inventors and owners of small, or medium-sized enterprises, few of whom have the financial means, time, or competence required to win a patent infringement suit.