CHOICE OF RESEARCH TOPICS IN THE FIELD OF INTELLECTUAL PROPERTY

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SUMMARY

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SOME REMARKS BASED ON EXPERIENCES WITHIN THE MAX PLANCK INSTITUTE FOR FOREIGN AND INTERNATIONAL PATENT, COPYRIGHT AND COMPETITION LAW, MUNICH

The choice of an interesting and promising research topic is the first and most important step in the research process, be it research in natural, social or legal science. Nobody will deny that. It is a waste of resources, indeed, to invest a lot of intellectual effort, time and money in a research project which has not been chosen with care and which reveals after one year or more to be a long resolved problem (ein alter Hut, snow from yesterday), or much too broad (a centennial project) or not well suited to the special skills and interests of the researcher. Unfortunately, these are not exceptional cases. If one compares the bit of time we normally take for choosing a research topic with the time necessary for bringing the project to a good end, then we have to admit that there is a striking misrelation. We at the Max Planck Institute have at least made this experience and we have tried to cope with the problem, notwithstanding the enormous difficulties necessarily linked with every kind of research planning.

Even a large research institute like ours with 40 to 50 staff members, about 20 full-time and 30 part-time employed, cannot take up every interesting topic within the large field of intellectual property and related fields. So one has to define areas of preference, select interesting individual research topics from those areas and set priorities. For that purpose we have adopted a flexible system of research planning in form of a list or research projects which are in progress, in preparation or planned for the next years. An English version of that list has been distributed to you. This list has been established some years ago and is reconsidered, modified and updated every year. If you would kindly look at this list you will first find under I to VII the different fields of intellectual property law which belong generally to the Institute's research activities: intellectual property in general,

patent law, copyright law, design law, trademark law, unfair competition law and, finally, antitrust law. Our research projects are listed in each of these sections and we have found it useful to distinguish between "fields of research" (Forschungsfelder), larger projects (B) and smaller projects (C).

Fields of research are problem areas in which we have a general and continuous interest (A), e.g. basic questions of industrial property and copyright (I 2), industrial property, copyright and free movement of goods in the EEC (I 6), inventions, patent protection and innovation (II 3), harmonization of unfair competition law in the Common Market (VI 1), unfair competition law and consumer protection (VI 2), impact of antitrust and European Community law on industrial property rights and copyright (VII 1) etc. We follow the developments in these fields very closely and take up specific problems if there is an actual interest to study it more closely.

Larger projects are those which are generally conducted by a team of several researchers or, more frequently, by several individual researchers, each of them working on a part or a specific aspect of the problem. Examples for those larger projects which generally take at least two up to five years are II 3b (patent protection in the field of biotechnology), II 4 (governmental patent policy), III 1 (copyright contract law), III 2 (copyright and new technologies) etc.

Smaller projects are those which can generally be handled by one individual researcher within reasonable time (up to two or three years), normally in form of a doctoral dissertation. One example is, for instance, II 7 (grace period and protection of inventions of exhibitions). I must, however, mention that only a small part of those smaller projects are listed here separately. Most of other smaller projects - I guess that 30 to 40 such projects are currently in progress at the Institute - form part of larger projects or belong to the broader "fields of research" which I have mentioned.

Our list may appear to you rather large and comprehensive. But it is far from covering all research topics within the field of intellectual property law which are worthwhile to study. We had to make a selection and you will detect that we have defined certain areas of preference or of emphasis (Schwerpunkte), for instance the significance of industrial property for developing countries, the European Patent law, patent and inventor's law in socialist countries, copyright and new techniques of information and documentation, harmonization of copyright law in the EC, the creation of a European trademark system, unfair competition and consumer protection, national and international protection of appellations of origin, to name only the most important areas to which we put special emphasis in our research efforts during a longer period of time.

But how do we select these areas and the larger and smaller projects which belong to these areas. This is more difficult to answer.

First I must tell you that we are free to select our research topics ourselves. The government from which the Institute gets its annual budget via our mother organization, the Max Planck Society, has no direct or indirect influence on the choice of our research topics, let alone on its results. We are also independent from industry or other private sources from which we get some additional money, not very much, for library and other general research expenses. We gladly accept that money but always without any obligation

as to spending it for a specific research project and with no influence whatsoever on its outcome. This independency is, I admit, a very happy situation. In contrast to other research institutes or individual researchers without a regular annual budget for research purposes we need not, fortunately, look for enterprises, ministries, agencies or organizations who are willing to finance a research project on a specific topic they are interested in. The percentage of these research projects commissioned by third parties (research made for hire) with all their attendant inconveniences (which I need not explain here) is therefore relatively small in our Institute. If we accept such a commission, for instance from the EC Commission or the Ministry of Justice, we do so only when it fits into our general research plan and coincides with our own scientific interests.

This freedom of choice is, in my view, a very important aspect for every scientific research. It allows and permits us, for instance, to engage in research projects which the government or industry of professional circles would not like to see tackled. We did that several times. So was our Ministry of Justice not very happy about our harsh criticism of the intended deletion of the grace period from German patent law; the German industry was not very fond of a study of the Institute evaluating the enormous amount of damages caused to the consuming public by misleading and other unfair advertising practices and, finally, the German press as well as the advertising agencies were not very satisfied to see an Institute's study published spelling out their liability for drafting and publishing unfair and, therefore, illegal advertisements.

This will not say, however, that we are continuously at odds with our government or the interested circles from industry or the Profession and that we select our research topics from the blue sky. The contrary is true. We not only welcome but even solicit informations and recommendations from the interested circles as to pertinent research topics which are of vital or actual interest for the administrators and users of the intellectual property system.

For that purpose, the directors of the Institute who are responsible for the choice, the content and the execution of our research program are assisted by a small advisory board consisting of four foreign scholars (including our next President, Bill Cornish and chaired by Professor Strömholm from Uppsala/Sweden). The advisory board is part of a larger body, the Institute's Kuratorium, consisting of about 20 representatives from the government, international organizations, industry and the academic community. Within these bodies, meeting annually, our research program is discussed, evaluated, modified and updated, as necessary. Before presenting a new research project to the advisory board and Kuratorium, the two Directors discuss the project between themselves and with their senior staff members from whom, by the way, many proposals for new projects come. The final decision, however, lies, according to the Statutes of the Max Planck Society, with the Institute's Director, and I am happy that we are two.

But what are the criteria for selecting a definite research topic from the broad spectrum of possible subjects?

The first and most important point is that you should not adopt a research topic without having a researcher who is capable and interested in pursuing the subject. It is rather easy to find an interesting topic to

justify its importance and to present it in a nice way, but it is not so easy, sometimes very difficult, to find the right person. If you find it very important and urgent to examine more closely the internal working of the Japanese patent system it is useless to put that topic on the list if you have nobody who understands Japanese. Fortunately I have such a staff member.

A second and really very important factor is, that the individual researcher is not only capable but takes a personal interest in the particular research topic and is sufficiently stimulated to bring it in due time to a good end. Since research work in the field of social and legal science at least is never adequately compensated, even not by a good salary, the prospect of qualifying for an academic degree, especially a doctorate, is, in my experience, still the best stimulant. It is for that very reason that we generally split larger research projects in several individual parts so that each researcher is responsible and gets the merits for its part and may present it, for instance, as his doctoral dissertation.

Another general criteria is that the research topic should not be ploughing old ground trying to solve problems which already have been resolved satisfactorily by the courts or by others. This will not say that the research topic should be absolutely new in the sense that nobody has studied it up to now. One and the same problem can fruitfully be approached by more than one person, namely from different aspects and view points. It happens to me rather frequently that one of my doctoral candidates comes to me, very excited, after having worked on a carefully chosen subject for 6 months and tells me that every effort has been wasted because another doctoral candidate in Switzerland or in France or in another German university is working on the same topic. My answer is always: Don't care about it and continue to work as before, namely independently from you competitors, and then a fine and interesting piece of work will be the outcome. In case of large projects duplication of work by different institutes should, however, be avoided as far as possible. This can be reached by regular reporting on research projects in process or in the planning stage. A better communication between the researchers all over the world which is one of the purposes of our Association may help to avoid such unnecessary waste of human resources.

An obvious condition is that the topic to be chosen is of theoretical and /or practical interest. Personally I don't like very much themes which present a purely scientific, academic interest with no impact on the law in practice. I have little understanding for a book of 600 pages demonstrating with much intellectual effort that a certain group of practical cases, for instance the protection of famous trademarks against dilution should better be decided applying Art. 826 instead of Art. 823 of the German Civil Code if the results are the same. In intellectual property law, theory and practice are so closely connected that you cannot fruitfully develop a new theory without having a close insight in the practical working of the intellectual property system. Research topics of a pure theoretical or even doctrinal character should therefore be condemned.

In evaluation of the practical interest one has also to consider whether the project is more or less urgent, for instance in view of a proposed revision of a national law or international convention. You cannot come out with a comprehensive study on the grace period if the decisions to adopt such a grace period in an international instrument have already been made in Geneva. In view of the rather hectic activities of national and international

legislatures most of all topics are, however, said to have that urgency. But it is not feasible to take up all these urgent topics simultaneously or to grant them highest priority. In these cases your own research capacity will dictate your limits.

A last point which I would like to mention are the individual capacities of the researcher. Since it is sometimes difficult to find a researcher who from his background, his knowledge and his special capacities is ideally suited to a particular topic, it is sometimes necessary to fit the topic to the person available. Let us suppose you have a comparative law study in mind on collecting societies and you find a young man or a young lady who has an interest in that topic. If he or she speaks German, English and French but not Dutch or Swedish you have to restrict that study to Germany, Austria and Switzerland, France and Belgium, the United States and UK (not to forget the small number of other English speaking countries). But you must exclude the Netherlands and Sweden even if the law in these countries may contain interesting solutions. If, by chance, the young man should have studied economics then it may be appropriate to redefine the project into a legal-economic analysis of the same topic.

In conclusion: the choice of research topics in intellectual property law is, as every free choice, difficult but not impossible. To make a good choice it is important to keep abreast of new developments in the field and to define areas of preference according to your own abilities and interests. You must further take into account your own research capacity and that of your collaborators and -- you must be flexible and not hesitate to modify, to restrict or to cancel a research project. And you must always have in mind that the most important factor in the research process is not the right topic but the right person

[Annex to follow]

ANNEX

MAX PLANCK INSTITUTE FOR FOREIGN AND INTERNATIONAL PATENT, COPYRIGHT AND COMPETITION LAW

Research projects planned and in progress as of January 1st, 1985

The research projects are characterized as follows:

(A) = Fields of research, continuously under study

(B) = Larger projects

(C) = Smaller projects, individual studies
According to their importance and other factors the following priorities are attached to the projects:

(1) = most urgent

(2) = urgent

(3) = less urgent

I. Projects covering more than one area of intellectual property law

1. Encyclopedia of Comparative Law, Vol. XIV "Copyright and Industrial Property". Contributions and editing (B) (1)

2. Basic issues of international industrial property and copyright (A)

a) General questions

b) Systematic analyses of the international conventions

aa) Berne Convention and Universal Copyright Convention

bb) Paris Convention and special agreements

3. Legal sources of industrial property law

a) Setting up of a comprehensive documentation of industrial property laws with the original texts and translations (A)

b) Editing of "Sources of International Uniform Law", Vols. III, IIIa: Law of Copyright, competition and industrial property (A)

4.	The significance of industrial property for developing countries with emphasis on patent, licensing, and antitrust problems of transfer of technology and the revision of international agreements, in particular the Paris Convention	(B)	(1)
5.	Industrial property and copyright in the Far East (Japan, China, etc.). Collection and analysis of legal texts and practices	(A)	
6.	Industrial property, copyright and free movement of goods in the EEC	(A)	

II. Patent Law

1.	European Patent Law	(B)	(1)
	a) Systematic comparative law analysis of the European Patent Conventions		
	b) Harmonization of national patent laws with European developments; relationship between European national laws		
	c) Documentation of case law and literature on European patent law		
2.	Patent and inventors' law in the socialist countries. Basic issues and legal developments	(A)	
3.	Inventive activity, patent protection and technological innovation: Studies regarding the economic and legal significance of patent and plant variety protection	(A)	
	a) Protection of scientific research results. Scientific-technical cooperation between universities, other research institutions and industry	(B)	(2)
	b) Patent protection and/or plant variety protection for inventions in the field of biotechnology	(B)	(1)
	c) The stimulation of rationalization and improvement proposals in the Federal Republic of Germany	(C)	(3)
4.	Government patent policy (patent and licensing problems within publicly funded research). Comparative study of policies and practices in the USA, France, United Kingdom, the Netherlands, Sweden and the Federal Republic of Germany	(B)	(1)

5.	Law and practice of patent licensing agreements. Collection of licensing agreements in use in legal practice, analysis and classification under patent, contract and antitrust law aspects	(C)	(3)
6.	Harmonization of the law of employee inventions	(B)	(3)
7.	Grace period and protection during exhibitions	(C)	(1)
8.	The role of utility model law as a complementary system of protection for inventions	(B)	(2)

III. Copyright

1.	The law of copyright contracts. Empirical and comparative law studies as a preliminary study in view of the envisaged statutory regulation of the law of copyright agreements	(B)	(1)
2.	Copyright problems caused by new methods and techniques of information and documatation, in particular questions of reprography	(B)	(1)
3.	Radio and television broadcasting, problems of retransmission by cable, community antennas, satellites, etc.; systems of individual electronic communication such as video text	(B)	(1)
4.	Harmonization of copyright law in the EEC	(B)	(1)
	a) Harmonization of copyright and neighbouring rights in general	(B)	(1)
	b) Freedom of establishment and of providing services in the area of radio and television	(B)	(1)
5.	Editing of an annotated collection of copyright law: updating and expansion of the collection "Sources of Copyright Law" by Schulze-Ulmer-Zweigert	(A)	
6.	Editing of a systematic commentary on German copyright law	(B)	(1)
7.	Comparative study of the law and practice of collecting societies	(B)	(2)

IV. Design Law

Analysis of the basic concepts and principles of design protection; comparative law study of new foreign legal

developments (Benelux, Nordic Countries, United Kingdom, Australia), in view of the revision of the German law and the harmonization of the design law in Europe.
In particular: (A)

a) Special forms of protection for industrial design

b) Problems of the employed designer

c) Creation of a European Design law

V. Trademark law

1. Creation of a European trademark law (B) (1)

a) Studies in relation to the proposal for a community trademark

b) Studies and proposals for harmonization of national trademark laws

c) Issues of particular importance:

Trademarks and free movement of goods

Trademark licenses and use by related companies

Recognition of prior rights in trademark proceedings. Individual and general public interests

Danger of confusion and similarity of goods

Extent of protection of unregistered marks

Relationship between trademark and unfair competition law

Relationship between the proposed community trademark system and the system of international registration of trademarks.

2. Function and significance of trademarks in the market economy. Trademarks and consumer protection (B) (1)

3. The requirement of use in trademark law and practice. Comparative law studies concerning the concept of use, other basic problems and the regulation of the use system in detail (C) (1)

4. Collective and certification trademarks as means of consumer information including questions of product liability. Comparative law and empirical studies with emphasis on the situation in France, the United States and Canada (B) (2)

5. Empirical and comparative law study of the trademark infringement proceedings in Germany and selected EEC countries (B) (2)

6. Trademark law problems of franchising agreements including problems of contract and antitrust law (B) (1)

VI. Unfair Competition Law

1. Harmonization of unfair competition law in the Common Market (A)

   a) Continuation of previous studies: Analysis of the legal situation in Denmark and Greece

   b) Updating of the comparative law volume and producing an English version

   c) Empirical and comparative law studies concerning the harmonization of the law of trade names

2. Unfair Competition Law and Consumer Protection (A)

   a) Developments in selected foreign countries (Australia, Belgium, Denmark, France, Great Britain, Italy, Canada, the Netherlands, Norway, Austria, Sweden, Switzerland, USA)

   b) Individual studies of the following topics:

      aa) Legal remedies and procedural problems: civil, criminal and administrative law sanctions, corrective advertising, arbitration

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