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Letter to the editor

A reply by the Author to the Book Review by Charles Oppenheim Published in World Patent Information, 31(1), 2009, 66 of 'Understanding and Profiting from IP: A Guide for Practitioners and Analysts', by Deli Yang [13] Palgrave, 336pp., £58, Hardback. ISBN: 978 1 40399172 0 *

The reviewer, a professor in information science, has written a review on this book. The reviewer acknowledges that “there are indeed the elements of a worthwhile book for managers of intellectual property [IP] in this text”. What the reviewer has acknowledged is exactly what the author has intended to address: provide global managers with IP understanding. However, the author feels a response to the reviewer would aid the readers' understanding and clarify any confusion.

This response is thus structured under five headings. The first is to acknowledge with sincere gratitude the errors pointed out by the reviewer. Second, it is to discuss why no definitive answers can be given to some errors that the reviewer has addressed. Third, it is to highlight why some errors that the reviewer has identified are actually not. Next, the author compares the WPI review with the review conducted by the World Intellectual Property Organisation (WIPO). Finally, the author reflects on learning from both reviews.

1. Acknowledge the errors

The reviewer has identified URL – an extra ‘/’, typos and the definition issue of sole and exclusive licensing. The author sincerely appreciates the identification of these errors and has contacted the publisher to issue an erratum for future distribution of the book. She would also like to add for the benefit of the readers that sometimes, exclusive licensing may not be necessarily exclusive, as the licensor may reserve his/her rights to serve its existing customers directly. These are two confusing terms in licensing business. To clarify the matter, the author talked with Susan Singleton, who has been practising in the intellectual property law area since 1985 and a Committee member and former Chair of the Licensing Executives Society. “...In the EU, sole licensors of patent and knowhow have an obligation not to license other businesses to exploit the licensed technology in the licensed territory and exclusive licensors have an obligation not to exploit the licensed technology in the licensed territory himself/herself”. Given the confusion, licensors and licensees should use express words in the contract to explain what they exactly mean by sole or exclusive licensing.

2. Debate some points

2.1. Registered and unregistered trademarks; copyright and moral rights

The reviewer commented that the difference between registered and unregistered trademarks, and the copyright and moral rights is not made clear. The author appreciates the comment. However, as the book clearly points out that given the increasingly multi-dimensional nature, the discussions about IP scope in the book does not intend to be “exhaustive, but serves to emphasise the most common forms of IP in terms of concepts, duration of protection, conditions for authorization of rights and any relevant sub-categorization” [13], pp. 18–19). This means that if a reader intends to know these, they can find some published legal texts on IP, as this book is not an all-inclusive legal encyclopaedia. Moreover, unregistered marks are not commonly practiced nor recognised in many countries, such as China, Czech Republic, France, Italy and Portugal.

In textbooks, copyright and moral rights do have their separation [2]. However, WIPO considers ‘moral rights’ as one of the rights comprised within copyright [9]. The Trade-related aspect of IP Agreement (TRIPS) under the auspice of the World Trade Organisation (WTO) considers it “the right to claim authorship and to object to any derogatory action in relation to a work, which would be prejudicial to the author’s honour or reputation, or of the rights derived therefrom” [11]: Article 9). The WTO further explains that members do not have obligations in respect of the rights conferred under Article 6bis of that Convention, i.e. the moral rights [12].

2.2. Domain names

The reviewer points out that “domain names are protected by copyright when in fact they are covered by trade mark law”, but in reality the answer regarding domain name protection is not as straight forward as such. To clarify this matter, the author interviewed a WIPO specialist dealing with domains, who has been involved with several cross-country domain disputes: “The domain name protection would depend on the type of domain concerned... and the registration rules applied by the entities responsible for the domain in question.” This indicates that domain names are type of protection that is relatively new, and diverse in protection depending on the countries concerned. According to the final report of the *WIPO Internet Domain Name Process*, abusive domain name registration not only violates mark rights, but other IP rights. Therefore, “In this respect, the intersection of the domain names and the intellectual property system is but one example of a larger phenomenon: the intersection of a global medium in which traffic circulates without cognizance of borders with historical, territorially based systems that emanate from the sovereign authority of the territory” [8].

* Editor’s Note: As is normal practice, the reviewer was given the right of reply but declined to take up the offer. This correspondence is now closed.

2.3. Yahoo and Google competition

Picking on half a sentence invalidates the reviewer's critique. If the sentence on page 155 of the book was read carefully, it would not be difficult to understand why Yahoo competed with Google in IP, including buying Overture Services and Inktomi to strengthen its algorithmic search patents in 2002. Therefore, it was legitimate and meaningful to say so within the timeframe. Although at the time of writing this case, Yahoo and Google were head-to-head competitors for certain search technologies, Yahoo has gone through dramatic changes over the past years. Every reader knows that a published piece can never catch up with all the changes in the business world. Therefore, in the current understanding, if we change 'Yahoo is' to 'Yahoo was one of Google's key competitors in the IP competition...', it would reflect better the current situation between the two competitors.

2.4. Plagiarism

Here is the interesting topic that is always debated in the academic world. Unfortunately, there is not a standard 'plagiarism' definition, as different norms are commonplace. The author defines plagiarism as "using others' work as one's own without acknowledgement" [13] p. 253). This is certainly in line with the reviewer's definition that "plagiarism is copying someone else's work without attribution". The author further argues in the book that "As far as creative fiction writing is concerned...it should not be deemed plagiarism if the user's work has demonstrated creativity, in other words, adding value to a piece of copyrighted work." By reading this paragraph, the readers would find out that this argument is the main ground for *Da Vinci Code* publisher to win the case. This argument (please note that arguments are always open for debates) implies that ideas are not protected and it is in line with the Smithy Code judgment on the dispute between the authors of the *Holy Blood and the Holy Grail* and that of the *Da Vinci Code*: "...to enable a fair balance to be struck between protecting the rights of the author and allowing literary development" [5].

2.5. Patent bibliometrics and patent information

The author has made it clear what her book focuses on. In Chapter 7 (pages 150 and 151), the author did mention that patent bibliometrics need to be part of the managing IP process. It was not a passing mention, but an important managerial strategy, as part of competitive intelligence. Moreover, as mentioned earlier, this is not a book for IP information seeking, but a book targeting at international business (IB) practitioners and analysts. This means that IP managers need to know the importance of patent competitive intelligence, but detailed bibliometric actions should be taken by their subordinates, who tend to apply company-by-company cases to conduct the analysis.

3. Identify the points the reviewer has addressed as errors when they are not

3.1. This book is 'ambitious' to fill a particular void and it has achieved its ambition

This book indeed carries an 'ambitious' aim as the reviewer states, that is, to provide business practitioners and analysts with a guide on IP-related IB with four major aspects addressed: IP Fundamentals, IP environments, IP management and IP strategies. The

intention is clear, as the subtitle indicates that this is a 'guide', that is, a book for direction to provide readers a 'comprehensive' understanding and equip them with the analytical skills to make decisions as to carry out IP-related cross-border activities. The purpose was achieved through the discussions in the four broad fields mentioned above. Therefore, the reviewer's statement that the book 'fails to live up to its promise' does not do the book justice.

3.2. This book intends to address a dual audience and it has done so

Its intended readership is IP practitioners (creators, IP owners, business managers, research institutions and government organisations) and analysts (corporate researchers and academics). The book provides a "comprehensive understanding to assist them to manage cross-border IP activities and to bridge up the links between IP and IB..." If we divide IP activities into three stages – creation (e.g. R&D), protection (e.g. filing and granting) and exploitation, the emphasis of this book leans over to the third stage to serve IB activities. This was made clear in the book, as comparatively speaking, little attention in prior research was paid to the third stage in a comprehensive manner to address global managers.

3.3. Let's not 'judge' our readers' statistical ability

The reviewer has criticised that a general business reader would not understand statistical tests, but this does not do justice to our general business readers. First, the reviewer undermines the general business reader's intelligence, as if statistics are a sort of divine source of wisdom that is so beyond reach. In fact, majority of 'general business readers' (based on my interview experience with them) have Masters' degrees, such as, Master of Business Administration, and many have a doctorate, such as Doctor of Business Administration. These degree studies all require statistical background.

Second, the author has taken the audience into account so that the statistical discussions emphasise the findings rather than the procedure. That is why the section related to statistical discussions is called 'IP Facts' because they are related to some new findings that should be reported to our readers. This indicates that even if some readers do not understand the statistics, they can still understand the findings.

Third, these statistical facts need to be included because our readers, including IP analysts (e.g. academics) may want to explore and take some of the new findings to the next level of research. This has been one of the intentions of the author to provide the readers with some groundwork for further exploration.

3.4. Importance of content relevance

Is it wrong to include some materials that are drawn from research articles or thesis chapters? Is it wrong to have a curious mixture of general overview and scholarly material? The author believes that as long as the contents serve the purpose of the book, all these materials can be included. The reviewer made such a criticism because again he overlooked the fact that this is a 'guide' to address a 'dual audience'. Moreover, IP was discussed in an integrated manner in the book because in a business world, a product tends to have a mixture of IP embedded within it and one cannot isolate one IP right from another. Therefore, the reviewer should not worry about the author's lack of understanding about IP and it is a deliberate act to integrate the IP together to discuss a product – this is necessary when conducting analysis of IP-related businesses although this book has separately discussed the main types of IP in Chapter 2.

3.5. Disclosure and conditions for patentability

The reviewer has criticised the book not to emphasise the disclosure, but the book has made it clear on page 25 that “the mechanisms of IP application and registration serve to publish inventions and other creations into the public domain, stipulating the possibility of commercial exploitation under authorization/license”. In fact, the reviewer has confused himself and readers, as public disclosure of an invention is not a condition for monopoly, but part of an application and grant process that an applicant is obliged to follow. Inventors can still hold a monopoly by not filing patent protection through trade secret or knowhow protection. Besides, as mentioned in Section 3.2, ‘exploitation’ is the focus of the book, and ‘protection’ procedure is not delineated specifically, as there are books, patent attorneys, and patent office websites already available for the interested parties. Moreover, the nation-based nature of IP protection, as emphasised in the book, decides that the interested parties must consult individual countries for details of relevant protection information.

3.6. Time factor for IP rights

The reviewer criticises that “the author claims in two different places that IP rights are time-limited, even though she had already correctly noted that Trade Marks have a potentially indefinite lifetime”. The first ‘time-limited’ appears in Chapter 2 when the author presents one of the ‘four counter arguments’ against IP: “Second, the ‘limited right’ argument concerns the duration of IP rights, suggesting that the public interest is reflected by the fact that the monopoly IP rights are time-limited so that free exploration of the creations can take place once the protection expires.” (Page 26).

‘The limited right’ argument here intends to use duration to restrict monopoly, but certainly the restriction differs for different rights. This was made clear in Chapter 2 when different rights were discussed. For example, marks can be potentially indefinite only on condition that the quality of the mark is satisfactory to the authorising body, and related products quality is guaranteed, and the owner has the mark renewed. Therefore, such limits are understandable with conditions.

The second ‘time-limited’ appears in Chapter 7 when the author discusses *pre anti-generic* and *post anti-generic* tactics: “Post anti-generic tactics include substantially reducing the price of the IP product, and perhaps attracting consumers by packaging it with a time-limited contract.” (p. 153). The author believes that the quotation speaks itself and refers to a contract with a consumer. As a result, it invalidates the criticism by the reviewer.

3.7. ‘Applications for copyright protection’

Generally speaking, copyright is automatic, but some special copyright needs to go through the application process. Again, the reviewer neglects the nation-based nature of IP and the fact that this book looks at IP businesses internationally. For example, in China, software copyright holders are encouraged to apply for copyright protection at the Centre for Software Copyright Protection. This means that the owners need to go through the process of applications. Therefore, sometimes, it is correct to use the expression here not to confuse readers. Therefore, the reviewer’s view solely based on the understanding of the law of a particular country needs to be repositioned towards the international dimension.

3.8. IP protection and commercialisation of software

The reviewer criticises that ‘licensing deals to commercialise software are both simpler and cheaper’ are not explained as to

what and why. The sentence appears in a Closing Case in Chapter 4 (Page 87): This Closer looks at the arguments of those campaigners whose mission has been that software development should be protected by copyright rather than by patent. This case first discusses the protection of software under patent and copyright and the arguments of the supporters of patent protection of software. Major attention in this case then focuses on the arguments against patenting software. Finally, this case discusses open source software (OSS), and the efforts to make software a less strictly protected technology.

From the context of the book, it would not be difficult for readers to understand commercialising software through licensing under copyright is cheaper and simpler than under patents, as throughout the text, patents and copyrights of software protection are comparatively discussed. It is clearly delineated in the case that ‘software patents’ have both pros and cons. The author believes that software patents would hinder software technology dissemination due to five reasons given in the case: (1) Complexity of software patenting itself (e.g. software does not wear out); patentability issues; (2) danger of unfair competition; (3) easy to infringe; (4) slow to disseminate; and (5) inconsistency across countries in terms of software protection policy. This means the ‘what’ and ‘why’ factors are discussed in the book.

Moreover, the purpose of most closing cases is to throw up debates because many issues in IP, including software patents, are open for discussions. This approach was commended by WIPO as not giving ‘definitive judgement’.

I commend the reviewer’s suggestion that readers should read *Software and Patents in Europe* [14], as Yang’s book is not a specialist delineation on software patent, but one focusing on IP-related international business.

3.9. Microsoft does offer free copies of software nearer the end of its IP protection

I appreciate the reviewer’s concerns that Microsoft copyright for software won’t expire till the late 2020s. However, it should be noted that software can also be under patents, particularly in the case of Microsoft. Regardless of protection forms, Microsoft, as the owner, has freedom to distribute copies of software for free. What they distributed is the software products protected under their copyright/patent ownership, not the right(s) themselves.

3.10. The British library and copyrights

The reviewer states that “lodging a work with the British Library was true 100 years ago, but has long ceased to be a requirement for the purposes of copyright (although there is still a separate legal requirement for the deposit of published works at the British Library).” However, this statement was proved false by the British Library. The author interviewed the British Library Copyright Office (BLCO). Their response confirms the author’s understanding that

There is a legal requirement in copyright law for publishers to deposit a copy of all published items in the UK with the British Library. Up until 1911, this was called *Copyright Deposit* but is now called *Legal Deposit*.

The reviewer also criticizes that “‘Copyright’ owner Year must be clearly shown on published works’ has never been true”. For this point, the British Library Copyright Office quoted Padfield [4] that clarifies the above:

Copyright subsists automatically as soon as the work is created, but it is helpful nevertheless to make some statement about it and related rights. This is normal when a work is published,

but it is definitely advisable also with unpublished material when it is leaving the control of the author or being made available to the public, in order to remind the user and to establish ownership. This can most conveniently be done by using the © symbol, together with the year and the name of the copyright owner. Nothing more is needed for copyright.

3.11. *The inter-disciplinary nature of IP*

IP is getting more and more interdisciplinary and it is no exaggeration that it is becoming relevant to all walks of life and all subject fields, including 'library and information science', as the reviewer has correctly mentioned. However, the author cannot possibly exhaust all the fields and that is why she has not included 'library and information science'. Instead, after having given a few examples to demonstrate the interdisciplinary nature of IP, the book moves on to demonstrate that its purpose is to examine IP from a new disciplinary angle called Intellectual Property in International Business.

3.12. *Comparative studies of IP regimes in the US and China*

The purpose of conducting a comparative study of the IP regimes between the US and China in the book is to demonstrate in detail the nation-based nature of IP regimes and how an analysis is conducted to compare and contrast different countries to serve business purposes. This is particularly relevant for managers that conduct IB activities (between home and host countries) and for analysts that conduct research relevant to IP-related cross-border businesses. The comparative study allows the readers to understand how two countries' IP regimes can be analysed to find out the similarities and differences. Therefore, contrary to the reviewer's statement that "the level of detail presented is unlikely to be of interest to the target audience", the comparative study would draw interest to managers and analysts, who intend to conduct cross-border IP activities and research.

3.13. *'Benchmarking' versus 'reverse engineering'*

These two phrases have their differences in a way that reverse engineering puts great emphasis on the process of discovering a technological object by taking it apart so that a new object can be created without necessarily copying the original. For example, software engineers "reuse past development efforts in order to reduce maintenance expense and improve software flexibility" ([7], p. 42). Benchmarking is the "search for industry best practices that lead to superior performance" [1]. This means that successful benchmarking is related to the discovery of means and the process of goal achieving (op cit). This can be associated with costs, quality and technologies against competitors. When it comes to technological benchmarking, it overlaps with reverse engineering and this is exactly what the author and the quoted references in the book refer to.

3.14. *This book and other specialist books*

The reviewer's argument can be invalidated, as he compares this book with some other specialist books like Knight's patent strategy [3], and Smith and Parr's Valuation of IP and Intangible Assets [6]. If readers examine these three books carefully, there is no difficulty in finding out that these books target at entirely varied audience. Knight's patent strategy focuses on patent administration, that is, why and how an invention should be patented – patent applications and portfolios. Smith and Parr's book is a specialist book for IP valuation. Meanwhile, Yang's book focuses on IB man-

agers and analysts in the field of IP-related 'international business' to provide them with a 'comprehensive' understanding of IP in the world of business and how IP can serve the benefit of IB activities through their own assessments. Therefore, this book has no ambition to compete with the two books mentioned by the reviewer, but fills a void of IP studies from a new angle.

4. Compare this review to the WIPO review

World IP Organisation published a review three months after the book was in press. The review by this most authoritative organisation in IP can provide our audience with some opportunities to have a second thought about the review published in World Patent Information. The review by WIPO knows the focus of the book and outlines the contents of the book before making any comments: "The author has undertaken a formidable task with serious scholarship (viz. her copious references to other works) and analytical intent – no less than the whole socio-economic and political scope of IP in the national and international business context." [10]. WIPO also commended the author's caution about permitting 'definitive judgements', as not all IP issues are 'black and white' matters.

The author "has enlivened what could have been a dry, specialists-only book by including diagrams, statistics, and illuminating case studies". "IP Strategies is possibly the most advisory, and goes into the global commercialization of IP, considering matters such as marketing concerns, contracting and licensing IP, combating piracy and counterfeiting and using the most suitable partnerships to maximize benefits from IP. This is a well-researched and thought-provoking read for both the academic and business communities." [10]. The book review is available at http://www.wipo.int/wipo_magazine/en/2008/04/article_0013.html.

5. Reflect on learning when it comes to reviewing a book

Both WPI and WIPO reviews on the book allow the author to have a deep thought as to how a review on a book should be conducted and here are some transferable skills that the author would like to reflect on and share with our readers:

- Start a review with a book summary and its targeted audience, as readers are likely not to have read the book.
- Look at the overall picture: If not, a review can easily see 'trees' but 'woods'; When it means 'international', for example, other countries should be considered.
- Discuss both the strengths and weaknesses: all praise is unrealistic, as there are no perfect books; all criticism is inequitable to readers and author(s), as the targeted audience may have different views, and the authors' efforts should not be completely denied. Readers should be given opportunities to make their own judgements as to the worth of a book based on the strengths and weaknesses instead of being imposed on somebody else's view.
- Focus on the work itself instead of going beyond: A review should focus on what is already in the book rather than go beyond it telling readers what is missing unless there is something absolutely relevant and essential to the focus of the work and its audience.
- Use 'verbs' instead of 'adverbs' and 'adjectives' because the former speaks more powerful volumes than the latter in writing, which tends to lead to 'empty' claims.

In summary, this reply has acknowledged the reviewer on his corrections, debated on non-definitive points, and clarified the false statements, compared this review with the one by WIPO,

and reflected on what forms a good book review. The author as well as the readers should not be denigrated due to this review on a small part of the book, as the whole package of this book intends to help global managers and analysts engaging in IP-related IB activities.

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