

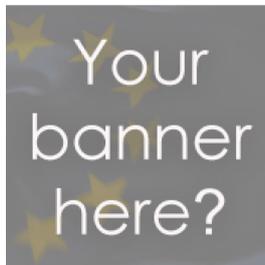
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**MONTHLY CASE LAW OVERVIEW****Trade Mark Law**

***IPPT20180124. CJEU: the evidence submitted for the first time before the EUIPO Board of Appeal did not come too late in all circumstances***

*Trade Mark Law. Court of Justice EU, 24 January 2018, EUIPO v European Food:* The General Court correctly held that, in the context of the invalidity proceedings based on the absolute ground for refusal, the EUIPO Board of Appeal should not, in all circumstances, rule that the that evidence submitted for the first time before the Board of Appeal must be

regarded as belated: it follows from case law that no reason of principle opposes to this.

***IP 10100. Louboutin cannot benefit from the introduction of the 'position' mark into EU law***

*Trade Mark Law. Case C-163/16 Louboutin v Van Haren. Conclusion A-G Szpunar:* Additional conclusion following the reopened oral hearing in case Louboutin v van Haren. A reopening was called for after questions were raised by the Ninth Chamber about EU trade mark law.

From the press release: "In his additional Opinion following the reopening of the oral procedure,<sup>2</sup> Advocate General Maciej Szpunar maintains his view that the prohibition set out in the trade mark directive is capable of applying to a sign combining colour and shape. Accordingly, he proposes that the Court's answer should be that the grounds on which registration of a mark may be refused or declared invalid are capable of being applied to a sign consisting of the shape of the goods, and seeking protection for a certain colour.

The Advocate General also considers that the introduction of the concept of a 'position' mark into EU law (see Article 3 EU Trade Mark Implementing Regulation) is not liable to qualify his considerations concerning the applicability of the ground for refusal or invalidity (laid down in the EU trade mark directive) to a sign such as that at issue.

The A-G takes the view that the reasons for the amendments introduced by the new directive (strengthening the trade mark proprietor's monopoly and restricting third party rights) cannot easily be applied to the grounds for refusal or invalidity.

With regard to the classification of the mark, the Advocate General points out that it is to be assessed whether the registration of that sign would not run counter to the general interest in not unduly restricting the availability of the characteristics represented by that sign for other operators offering for sale goods or services of the same type."

***IP 10106. Preliminary questions about registration of a fabric pattern as trademark***

*Trade Mark Law. Case C-21/18 Textilis. Request for a preliminary ruling. Patent- och marknadsöverdomstolen (Sweden). Unofficial translation:* "1. Must Article 4 of Regulation (EU) 2015/2424 of the European Parliament and of the Council of 16 December 2015 amending Regulation (EC) No 207/2009 on the Community trade mark, [and of Regulation (EC) No 2868/95 on the implementation of Council Regulation (EC) No 40/94 on the Community trade mark, and repealing Commission Regulation (EC) No 2869/95 on the harmonization of laws applicable to the Office for Harmonization within

the internal market (trade marks and designs)), thus interpreting that Article 7 (1) (e) (iii) applies in the new wording to a judicial assessment of nullity [in accordance with 52 (1) (a) of Regulation No 207/2009] which takes place after the amendment enters into force, namely after 23 March 2016, even if the procedure concerns an annulment and that procedure has started before that date and therefore pertains to a mark before that date is registered?

2. Must Article 7 (1) (e) (iii) of Regulation No 207/2009, in the applicable version, be interpreted as meaning that a sign consisting of the two-dimensional representation of a two-dimensional product falls within the scope, for example a fabric decorated with the sign in question?

3. If Question 2 is answered in the affirmative, according to which criteria must the words 'signs consisting exclusively of the shape (or any other characteristic which) give substantial value to the goods' in Article 7 (1) (e), (iii) of Regulation No 207/2009 be interpreted in a situation where the registration covers a wide range of goods classes and goods and in which the sign can be affixed to the goods in various ways? Should the assessment be made on the basis of more objective / general criteria, for example based on what the brand looks like and how it can be applied to different types of goods, that is, without taking into account the way in which the trademark owner possibly de facto signs the mark or intends to apply to different goods?"

#### Other

**IP 10096. EUIPO: likelihood of confusion between word marks "RUBY" and "RUBY FIRES" for heating apparatus**

Trade Mark Law. Board of Appeal EUIPO, 21 december 2017, Ruby Decor v Essege: The goods for which the mark 'RUBY FIRES' is registered are similar to an average degree or identical to the goods for which the earlier mark is registered. The goods in Class 6 are parts of 'fireplaces' or 'heating apparatus' and the goods in Class 11 fall under the broad category of 'heating apparatus'. The goods in Class 19 are used to build 'fireplaces'. According to the Board of Appeal, 'RUBY' is the dominant element of the contested mark. It follows from this, that the conflicting signs are visually and aurally highly similar. Part of the public will perceive the term 'RUBY' as a dark red jewel, as something that is dark red in colour or as a female name, according to the Collins English Dictionary. Another part of the public may not associate the term with any meaning or concept. Therefore, the conceptual comparison is either identical or it remains neutral.

The Board of Appeal considers for the likelihood of confusion that the goods at issue target both the general public and professionals and that the relevant territory is the Benelux. In view of the partial identity and partial similarity of the conflicting goods, and the high

visual and aural similarity of the signs, a likelihood of confusion between the marks for all goods can be found according to the Board. Since the signs only differ in the descriptive element 'FIRES', the public could be led to believe that the goods in question come from the same undertaking or economically-linked undertakings.

**IP 10097. ECHR: fining a clothing company for its advertising campaign with Jesus and Maria breached its freedom of expression**

Advertising Law. ECHR, 30 January 2018, appl. No. 69317/14, SEKMADIENIS LTD. v. LITHUANIA: Sekmadienis Ltd. ran an advertisement campaign for clothing with models and captions referring to Jesus and Maria. The company was given a fine for offending against public morals. Sekmadienis Ltd. lodged an application with the ECHR. They argued that the fine violated their freedom of expression as protected by art. 10 ECHR. The Court finds that, despite the broader margin of appreciation given the commercial nature of the advertisements, the advertisements were not offensive, and did not incite hatred. Nor had the domestic authorities provided sufficient justifications for why such use of religious symbols had been contrary to public morals. Accordingly, the domestic authorities failed to strike a fair balance between, on the one hand, the protection of public morals and the rights of religious people, and, on the other hand, the applicant company's right to freedom of expression.

**IP 10101. Opinion AG CJEU: Clarification of the application of Specific Mechanism.**

Patent Law. SPC. Case C-681/16. Pfizer Ireland Pharmaceuticals v Orifarm., Opinion AG E. Tanchev: The plaintiff was the registered holder of an SPC protecting the protein Etanercept. Etanercept is an active substance of the drug Enbrel® that the plaintiff produces and markets in Germany. The German Patent and Trade Mark Office granted to the plaintiff a 'paediatric extension' of the SPC by which the protection was extended and expired on 1 August 2015. Since 2012, the defendant had informed the plaintiff of its intention to carry out parallel imports from Estonia and Latvia and – from February 2015 - also from Bulgaria, the Czech Republic, Hungary, Poland, Rumania, Slovakia and Slovenia. The plaintiff repeatedly objected to this. In April 2015, the plaintiff discovered that packages of Enbrel, which had been produced for Poland, Slovenia and Lithuania and Croatia, all of which identified the defendant as the parallel importer, were available on the German market. Therefore, the plaintiff filed suit with the referring court, the Landgericht Düsseldorf, for infringement of its SPC. The defendant argued that he lawfully acquired Enbrel in the new member states, so that the SPC rights were exhausted. The plaintiff, however, pleads that the SPC rights weren't exhausted, because of the exception in the Act of Accession of the

new member States, referred to under the term of ‘Specific Mechanism’. The referring court asks the Court to clarify the scope of application of the Specific Mechanism in the present case where an SPC as such was available in the Accession State at the relevant time but the requisite basic patent did not exist (first question) and whether it makes a difference if the basic patent could have been obtained in the Accession State by the time of publication of the German patent application (second question). With its third and fourth questions, the Landgericht Düsseldorf queries whether and to what extent the Specific Mechanism applies to the paediatric extension, which is not expressly mentioned in the wording of the Acts of Accession.

***IP 10102. Preliminary questions: bad faith when applying to register a trade mark without any intention to use it?***

*Trade Mark Law. England and Wales High Court (Chancery Division), 23 January 2018, Sky v Skykick, [2018] EWHC 155 (Ch):* Sky is the registered proprietor of a number of EU trade marks “SKY”, among which two figurative marks. Sky contends that Skykick have infringed these EU trade marks. Skykick denies infringement and issued a counterclaim for a declaration invalidly of the trade marks on the grounds that the specifications of goods and services lack clarity. Skykick refers to the judgment of the CJEU in case CIPA v Registrar (IPPT20120619). The court wonders whether a lack of clarity and precision of the specification can be asserted as a ground of invalidity and if the answer is yes, if a term such as “computer software” is lacking in sufficient clarity or precision. The court also wonders whether it constitutes bad faith to apply to register a trade mark without any intention to use it in relation to the specified goods or services.

***IP 10107. Preliminary questions about obligation of host-service to prevent further violations after violating personality rights***

*Privacy. Case C-18/18. Request for a preliminary ruling. Oberster Gerichtshof (Austria). Unofficial translation:* “Preliminary questions:

1. Does Article 15 (1) of Directive 2000/31 / EC of the European Parliament and of the Council of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the internal market (“Directive on electronic commerce”) generally preclude one of the obligations of a host service provider mentioned below which has not acted promptly to remove the illegal information, which obligation is not only to provide that illegal information within the meaning of Article 14 (1) (a) of the Directive, but also other verbatimly identical information: a.a. worldwide, a.b. in the Member State concerned, a.c. of the relevant user worldwide, or a.d. of the relevant user in the Member State concerned?
2. Insofar as question 1 is answered in the negative: does this always also apply to identical information?

3. Does this also apply to identical information as soon as the operator has become aware of this circumstance?”

***IP 10108. Opinion AG CJEU on geographical indications for Whisky***

*Geographical Indications. Case C-44/17 The Scotch Whisky Association. Preliminary questions. Landgericht Hamburg (Germany). Opinion A-G Saugmandsgaard Øe. From the press release:* “Advocate General Saugmandsgaard Øe issues his opinion on the interpretation of EU law provisions relating to geographical indications for spirit drinks in the context of a dispute concerning a German whisky named ‘Glen Buchenbach’.

First, the Advocate General states that a registered geographical indication is only subject to prohibited ‘indirect use’ if the disputed denomination is identical or phonetically and/or visually similar to the indication in question. Therefore, it is not sufficient that that designation is liable to evoke in the relevant public some kind of association of ideas with the indication or the relevant geographical area.

Second, the Advocate General considers that the disputed denomination does not necessarily require phonetic and visual similarity with the registered geographic indication in order for it to constitute an unlawful ‘evocation’ of that indication. However, it is not sufficient that the designation is liable to evoke in the relevant public some kind of association of ideas with the protected indication or the relevant geographical area. In the absence of phonetic and visual similarity, it is necessary to take account of the conceptual proximity existing, if it be the case, between the indication in question and the disputed designation, in so far as that proximity is of such a nature as to lead the consumer to have in mind, as reference image, the product whose indication is protected. It is therefore solely for the Landgericht Hamburg to determine whether, in the present case, when the average European consumer is confronted with a comparable product bearing the designation ‘Glen’, the image triggered directly in his mind is that of ‘Scotch Whisky’.

Third, the Advocate General states that for the purposes of establishing the existence of a ‘false or misleading indication liable to convey a false impression as to [the] origin’ of the relevant product, it is also not necessary to take account of additional information found alongside the sign at issue in the description, presentation or labelling of the product, in particular with regard to its true origin.”

## ITEMS

### News

***IP 10099. UnitedCorp seeks injunctive relief from Instagram for patent infringement***

World Intellectual Property Review: “Miami-based UnitedCorp has taken on photo-sharing platform Instagram in a patent infringement lawsuit filed at the Federal Court of Canada. According to an announcement released on Friday, February 2, UnitedCorp owns Canadian patent number 2,887,596, called “User content sharing system and method with automated external content integration”. The patent covers a system for sharing digital content, such as photographs, which lets the users apply the geographical location where the image was taken. For example, if the user is in Toronto and takes a picture of the city, they will have the option of including a footer informing people where they are.”

**IP 10098. Trade secrets trial between Waymo and Uber regarding self-driving cars starts today**

*Financial Times*: “The high-profile lawsuit between Uber and autonomous driving rival Waymo will go to trial this week following a nearly year-long battle of theft allegations involving encrypted texts, untraceable phones and secret meetings.[...]

Waymo has accused Uber of stealing eight trade secrets that relate to the design of a type of sensor called Lidar that is used in self-driving cars, and the jury trial will begin Feb 5. Waymo, which is owned by Alphabet, alleges that its former employee Anthony Levandowski downloaded Lidar designs before quitting Waymo to launch his own company, an autonomous trucking group called Otto. Just six months after leaving Waymo, Mr Levandowski, who by that point had become very friendly with Uber chief executive Travis Kalanick, sold Otto to Uber for about \$680m and became the head of Uber’s self-driving car project.”

**IP 10103. Menno Heerma van Voss sets up KEENON**

*From the press release*: “KEENON opened recently its doors. The firm advises and litigates on intellectual property, marketing, ICT, privacy and e-commerce matters.

With KEENON Menno sets up an office that suits his clients and him perfectly. An office that combines knowledge, experience with clearness and passion. Passion for both law and branding, design, marketing, innovation and privacy.

Menno: With Keenon I can shape and express client’s needs and my passion. [...]

**IP 10104. Deloitte launches Patent Reports**

*Deloitte press release*: “As from today, DeloitteSmartReports.com is also offering patent benchmark reports. The reports are created by using artificial intelligence to analyze over 70 million patents filed by 268.000 businesses worldwide. Next-generation analytics allows us to benchmark your business against its competitors and observe innovation in your industry.

[...]

The patent range at DeloitteSmartReports.com consists of two types of reports: Company vs. Industry and Company vs. Peers reports, where your company will be benchmarked against your industry or a selected group of peers respectively. The reports are designed to save you time as you will only read about the patents that affect your business and benchmarking group directly.”

**IP 10105. Council authorises ratification Marrakesh Treaty on access to published works for blind and visually impaired persons**

*Press release Council of the EU*: “The Council today adopted a decision approving the conclusion of the Marrakesh Treaty to facilitate access to published works for persons who are blind, visually impaired, or otherwise print disabled.

The Marrakesh Treaty establishes a set of international rules which ensure that there are limitations or exceptions to copyright rules for the benefit of people who are blind, visually impaired or otherwise print-disabled.

[...]

On 13 September 2017, the Council adopted implementing legislation to introduce into EU law the new mandatory exception to copyright rules, in line with the Marrakesh Treaty. This will allow beneficiary persons and organisations to make copies of works in accessible formats, and to disseminate them across the EU and in third countries which are party to the Treaty.”

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