NEWSLETTER

JUNE 2018

ISSUE NO. 06

EUROPEAN INTELLECTUAL PROPERTY LAW

ABLE OF CONTENTS

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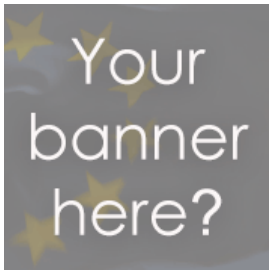

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MONTHLY CASE LAW OVERVIEW

Trade Mark Law

IP10130. Opinion AG CJEU on applicability of strict assessment criteria for distinctive character of signs that coincide with the appearance of the goods

Trade Mark Law. *Case C-26/17 P*. *Birkenstock v EUIPO. Appeal. Opinion AG Szpunar:* Opinion on the partial refusal of the pictured figurative mark of Birkenstock. The opinion is limited to the first part of the appeal, discussing mostly the criteria for the application of the strict requirements that are used in the assessment of distinctive character of signs that coincide with the appearance of the goods.
The AG considers that it is confirmed by the Court that case law regarding marks that coincide with the appearance of the goods, is applicable to marks that exist of patterns, but that the Court did not express itself explicitly on the degree of probability that needs to be determined to be able to regard a figurative mark consisting of a series of elements being repeated regularly as a surface pattern that coincided with the good.
The AG considers, following the General Court, that only when the use of a surface pattern with regard to the nature of the goods involved is unlikely, such a sign cannot be regarded as a surface pattern for the goods involved, causing that the case law developed with regard to three-dimensional marks that coincide with the appearance of the goods, is not applicable.

Use of applicant's first name does not constitute a due cause

IPPT20180530, CJEU, Tsujimoto v EUIPO

Trade Mark Law. General Court was fully entitled to conclude that word mark KENZO ESTATE of which registration was applied for was similar to the earlier word mark KENZO: mark applied for consists of earlier mark + element that lacks distinctiveness. Use of appellant's forename in mark applied for does not constitute a due cause: the weighing of the different interests involved cannot undermine the essential function of the earlier mark to guarantee the origin of the product.

The CJEU refers five 'Master' trade mark cases (L' Oréal) back to the General Court

IPPT20180530, CJEU, L'Oréal

Trade Mark Law. The CJEU refers five 'Master' trade mark cases (L' Oréal) back to the General Court: the General Court distorted the facts and arguments made by L' Oréal and infringed Article 8(1)(b) of the EU Trade Mark Regulation. The Judgement of the General Court, stating that that the most distinctive element of the trade mark is the element 'Masters', is ambiguous and incomplete, the General Court's reasoning was insufficient and lacked the support of case-law.. Furthermore, the General Court failed to provide adequate reasoning why it disregarded a comparison of all the distinctive characters of the conflicting trade marks in its likelihood of confusion analysis.

CJEU: Louboutin's red sole is a valid trade mark

IPPT20180612, CJEU, Louboutin v Van Haren

Trade Mark Law. Article 3 (1) (e) (iii) of Directive 2008/95 / EC of the European Parliament and of the Council of 22 October 2008 to approximate the laws of the Member States relating to trade marks must be interpreted as meaning that a sign consisting of a color

applied to the sole of a high-heeled shoe, as that at at issue in the main proceedings, does not consist exclusively of the 'shape' within the meaning of that provision.
(*Courtesy of Jesse Hofhuis, Hofhuis Alkema Groen and Thierry van Innis, Van Innis & Delarue*)

Copyright

IP10129. Opinion AG CJEU: No presumption of liability of holders of internet connection for copyright infringements
Copyright. IP enforcement. Case C-149/17: Bastei Lübbe v Strotzer. Opinion A-G Szpunar: Bastei Lübbe is a producer of phonograms and holder of the copyrights and neighbouring rights to the audio version of a book. This phonogram has been shared with an unlimited amount of users on 8 May 2010 via an internet site for file-sharing (peer-to-peer). An expert determined that the IP-address belongs to Strotzer. Bastei Lübbe summoned Strotzer to stop the infringement, but this did not have any result. Bastei Lübbe therefore brought an action before the Ambtsgericht München. Strotzer disputed that he infringed the copyrights himself and he stated that his internet connection was sufficiently secured. Strotzer also stated that his parents, living in the same house and having access to the same internet connection, but not having the file on their computer to the best of his knowledge or having knowledge of the existence of the file, let alone using file-sharing software, did not infringe the copy rights either. Besides, the computer would have been turned off at the time of the infringement. The Ambtsgericht München rejected the claims, because it could not be determined whether Strotzer had committed the infringement. The referring court, the Landgericht München, is inclided to hold Strotzer liable for the infringement, because it does not become clear from his statement that the copyright infringement would have been committed by a third party using the same connection, making it very likely that the infringement has been committed by Strotzer. The referring court, however, has some questions about the burden of proof regarding the infringement.
AG Szpunar proposes the CJEU answers the question keeping in mind the following. The AG holds that is should not be required of national law of Member States that a presumption of liability has to be implemented for copyright infringements committed via a certain connection. When national law has a presumption like this, it must be applied consistently to ensure the effectiveness of the protection. Rights to family life cannot be interpreted in a way that holders are practivally deprived of this to protect intellectual property rights.

Patent Law

SPC-holder authorised by Specific Mechanisms to oppose to parallel imports from new Member States where it was impossible to apply for an equivalent patent at the time of application
IPPT20180621, CJEU, Pfizer v Orifarm
Patent Law. Holder of an SPC issued in another Member State than the new Member States is authorised by the Specific Mechanisms to oppose the parallel importation of a medicinal product where the legal systems of those States did not yet provide for such a possibility at the time when the application for a basic patent was filed, with the result that it was impossible for the holder to obtain an equivalent patent and SPC. Specific mechanisms apply to the extension provided for in Article 36(1) of the Regulation on medicinal products for paediatric use.

Publication

IP10132. ECHR: Russia held to pay €12.500 in non-pecuniary damages for infringement of the right to freedom of expression of Russian journalist
ECHR, 9 May 2018, appl. No. 52273/07, Stomakhin v Russia
Publication. The European Court of Human Rights held that Russia violated Article 10 of the European Convention on Human Rights in the case brought before the Court by Russian journalist Boris Vladimirovisch Stomakhin.
[...]
The Russian authority failed, in this context, to demonstrate a pressing social need for some of the statements. For the statements that had justified terrorism, vilified Russian servicemen and praised Chechen leaders in their approval of violence, the statements had gone beyond the limits of acceptable criticism. The same goes for some of Stomakhin's criticism of Orthodox believers and ethnic Russians. However, the severity of the penalty was not proportionate to the legitimate aims pursued as the newspaper had a very low number of copies, Stomakhin had not been convicted of any similar offence before and the newspapers were only handed to those individuals who expressed their interest. Therefore the ECHR held that Russia violated the right to freedom of expression (Article 10 ECHR) and decided that Russia was to pay Stomakhin €12.500 in respect of non-pecuniary damages.

The administrator of a fan page on Facebook is jointly responsible for the processing of data
IPPT20180605, CJEU, Wirtschaftsakademie Schleswig-Holstein
Publication. The administrator of a fan page hosted on Facebook is responsible for the personal data of the visitors to its fan page: the fact that an administrator uses the platform provided by Facebook cannot exempt it from compliance with its obligations concerning the protection of personal data. Where an undertaking

established outside the European Union establishments in different Member States, the supervisory authority of a Member State is entitled to exercise powers with respect to an establishment situated in the territory of that Member State even if exclusive responsibility for collecting and processing personal data belongs to an establishment situated in another Member State. Where the supervisory authority of a Member State intends to exercise its powers with respect to an entity established in the territory of that Member State on the ground of infringements committed by a third party whose seat is in another Member State, that supervisory authority is competent to assess, independently of the supervisory authority of the other Member State, the lawfulness of the data processing and may exercise its powers of intervention with respect to the entity established in its territory without first calling on the supervisory authority of the other Member State to intervene.

Designation of origin

Association with a registered geographical indication not sufficient to establish 'indirect commercial use' or 'evocation' of this indication

IPPT20180607, CJEU, Scotch Whisky Association

Designation of origin. For the purpose of establishing that there is 'indirect commercial use' of a registered geographical indication, the disputed element must be used in a form that is either identical to that indication or phonetically and/or visually similar to it: not sufficient that that element is liable to evoke some kind of association with the indication concerned or the geographical area relating thereto. For the purpose of establishing that there is an 'evocation' of a registered geographical indication, the referring court is required to determine whether, when the consumer is confronted with the disputed designation, the image triggered directly in his mind is that of the product whose geographical indication is protected: account is not to be taken either of the context surrounding the disputed element or the fact that that element is accompanied by an indication of the true origin of the product concerned. For the purpose of establishing that there is a 'false or misleading indication', as prohibited by that provision, account is not be taken of the context in which the disputed element is used.

ITEMS

News

IP10128. Copyright rules for the digital environment: Council agrees its position

On the 25th of May the Council has given its vision about a proposal aimed at adapting EU copyright rules to the digital environment. "The main objective of the directive is to modernise the European copyright framework and adapt it to the requirements of the digital age. By contributing to the harmonisation of practises across member states, it will also increase legal certainty in the digital single market."

IP10131. European Parliament Committee on Legal Affairs approves uploadfilter

Press release: "The committee approved its position in a tight vote by 14 votes to 9, with 2 abstentions, and adopted by the same majority a decision to enter into negotiations with the Council, the other arm of the legislator.

Creators and news publishers must adapt to the new world of the internet as it works today. There are opportunities but there are also important drawbacks. Notably, news publishers and artists, especially the smaller ones, are not getting paid due to the practices of powerful online content-sharing platforms and news aggregators. This is wrong and we aim to redress it. The principle of fair pay for work done should apply to everyone, everywhere, whether in the physical or online world."

IP10133. Apple and Samsung settle patent infringement lawsuit in United States

CNN: "The two companies agreed to a settlement in the case, according to court documents filed Wednesday, but did not disclose the terms.

The settlement closes a dispute that started in 2011 when Apple accused Samsung (SSNLF) of "slavishly" copying the iPhone's design and software features. A jury awarded Apple (AAPL) $539 million in May, leaving Samsung with an outstanding balance of $140 million it owed Apple. It was not clear Wednesday how much more, if anything, Apple will receive.

Litigating the case cost the two world's two largest smartphone makers hundreds of millions of dollars and resulted in several rulings and appeals. In 2012, a jury ruled that Samsung must pay Apple more than $1 billion for copying various hardware and software features of the iPhone and iPad. A federal judge later reduced that penalty by $450 million."

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