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JOB OFFERS AND ADVERTISEMENTS

MONTHLY CASE LAW OVERVIEW

Trade mark law

Sign that is represented by a colour drawing with defined contours cannot be registered as a colour mark

IPPT20190327, CJEU, Hartwall

Trade Mark Law. Classification given by the applicant when registering a sign as a "colour mark" or "figurative mark" is a relevant factor amongst others to establish whether that sign can constitute a trade mark under Article 2 of the Trade Mark Directive 2008 and whether this mark has distinctive character under Article 3(1)(b). Trade mark authority is obliged to carry out a concrete and global assessment of the distinctive character of the trade mark concerned: authority cannot refuse registration of a sign as a trade mark on the sole ground that that sign has not acquired distinctive character through use in relation to the goods or services claimed. Registration as a colour mark of a sign that is represented as a colour drawing with defined contours, but is described as a colour mark should be refused due to an inconsistency in the application for registration.

Request for a preliminary ruling concerning the three-dimensional trade mark

Case C-237/19: Request for a preliminary ruling from the Kúria (Hungary)

Trade Mark Law. "Gömböc has applied for registration of three-dimensional sign as a trade mark for decorative objects (umbrella and decorative objects made of glass and ceramics) and toys in Hungary at the Office for IE. The Office rejected this application on the basis of a ground for refusal in the Hungarian Trademark Law. Registration as a toy has been refused because the sign is a form that is considered necessary for the technical outcome of Gömböc, which would limit the freedom of choice of competitors. Regarding the trade mark as a decorative item, the Office states that decorative items are excluded from trademark registration if they consist solely of the shape, and the Gömböc derives its striking appearance from the design."

General Court EU confirms invalidity of the adidas EU trade mark which consists of three parallel stripes applied in any direction

IPPT20190619, General Court EU, Adidas v EUIPO

Trade Mark Law. [...]Finally, the General Court notes that EUIPO did not commit an error of assessment in finding that adidas had not proved that the mark at issue had been used throughout the territory of the European Union and that it had acquired, in the whole of that territory, distinctive character following the use which had been made of it. From the evidence produced by adidas, the only evidence which is, to some extent, relevant relates to only five Member States and cannot, in the present case, be extrapolated to the entire territory of the EU.

Trade mark VERMÖGENSMANUFAKTUR declared invalid in respect of all services in Classes 35 and 36

IPPT20190515, CJEU, VM Vermogens Management

Trade Mark Law. Argument that trade mark VERMÖGENSMANUFAKTUR (registered prior to IP-translator (**IPPT20120619**)) has been annulled only for services falling under the literal meaning of the headings of Classes 35 and 36 fails: the trade mark was protected in respect of all services in those classes and therefore annulled by the Board of Appeal in respect of all the services in Classes 35 and 36, statement of reasons GEU sufficient. Argument that the General Court held that the contested trade is devoid of distinctive character only because the expression Vermögensmanufaktur constitutes a laudatory reference is, is based on incorrect reading of the judgment under appeal. Arguments put forward by the appellant concerning the use of refused evidence by the Board of Appeal are inadmissible: arguments only concern repetition of arguments at first instance.

Copyright

Preliminary questions about the interpretation of the Rental Directive

Case C-265/19: Recorded Artists Actors Performers Limited v Phonographic Performance (Ireland) Limited *Copyright.* "Preliminary reference on the interpretation of Directive 2006/115/EC"

Preliminary questions:

"1. Is the obligation on a national court to interpret the Directive 2006/115 on rental right and lending right and on certain rights related to copyright in the field of intellectual property ("the Directive") in the light of the purpose and objective of the Rome Convention and/or the WPPT confined to concepts which are expressly referenced in the Directive, or does it, alternatively, extend to concepts which are only to be found in the two international agreements? In particular, to what extent must Article 8 of the Directive be interpreted in light of the requirement for "national treatment" under Article 4 of the WPPT?

2. Does a Member State have discretion to prescribe criteria for determining which performers qualify as "relevant performers" under Article 8 of the Directive? In particular, can a Member State restrict the right to share in equitable remuneration to circumstances where either (i) the performance takes place in a European Economic Area ("EEA") country, or (ii) the performers are domiciles or residents of an EEA country?

3. What discretion does a Member State enjoy in responding to a reservation entered by another Contracting Party under article 15(3) of the WPPT? In particular, is the Member State required to mirror precisely the terms of the reservation entered by the other Contracting Party? Is a Contracting Party required not to apply the 30-day rule in Article 5 of the Rome Convention to the extent that it may result in a producer from the reserving party receiving remuneration under Article 15(1) but not the performers of the same recording receiving remuneration? Alternatively, is the responding party entitled to provide rights to the nationals of the reserving party on a more generous basis than the reserving party has done, i.e. can the responding party provide rights which are not reciprocated by the reserving party?

4. Is it permissible in any circumstances to confine the right to equitable remuneration to the producers of a sound recording, i.e. to deny the right to the performers whose performances have been fixed in that sound recording?"

Patent law

Preliminary question about supplementary protection certificate

Case C-354/19: Novartis AG v Patent-och registreringsverket *Patent law:* "Request for preliminary ruling, on the interpretation of Article 3(c) of Regulation No 469/2009 and Article 3(2) of Regulation No 1610/96"

"1. Is the obligation on a national court to interpret the Directive 2006/115 on rental right and lending right and on certain rights related to copyright in the field of intellectual property ("the Directive") in the light of the purpose and objective of the Rome Convention and/or the WPPT

"In order to determine whether an SPC may be granted, it is necessary to apply Article 3(c) of Regulation No 469/2009 and Article 3(2) of Regulation No 1610/96. However, the interpretation of those provisions in a case such as the present appears unclear, particularly in view of the fact that the application of the provisions, in the understanding of the Patent- och marknadsöverdomstolen (Patent and Market Court of Appeal), has, in practice, been intended to stimulate research into new therapeutic uses of products already known. The Patent- och marknadsöverdomstolen therefore requests a reply to the following question."

Preliminary question:

"[…] In view of the fundamental purpose which the supplementary protection certificate for medicinal products is intended to fulfil, namely that of stimulating pharmaceutical research in the European Union, does Article 3(c) of Regulation No 469/2009, having regard to Article 3(2) of Regulation No 1610/96, preclude an applicant who has previously been granted a supplementary protection certificate in respect of a product protected by a basic patent in force in respect of the product per se, from being granted a supplementary protection certificate for a new use of the product in a case such as that at issue in the main proceedings in which the new use constitutes a new therapeutic indication which is specifically protected by a new basic patent?"

Design law

IP 10203*. *Community Design for fluid distribution equipment declared invalid

Design Law. The board finds that all those features are necessary for the technical solution to the question of how to fill a number of inflatable balloons at the same time. The fact that the design has a 'simple and clear appearance' similar to a 'flower and stem' due to the choice as to the length of the straws in relation to the length of the balloon and that the 'proportions of the design as a whole namely the length being about 18 times the width, giving the design a sleek and elegant appearance appealing to the user' does not change the fact that the visual aspect of the device is still the result of its technical function. The mere fact that a design alternative exists does not mean that a product's appearance has been dictated by anything other than technical considerations (IPPT2018030).

The Board therefore rules that all the essential features of the contested RCD have been chosen with a view to

designing a product that performs its function. None of those features has been chosen simply for the purpose of enhancing the product's visual appearance.
(*Courtesy of Gert-Jan van den Bergh en Auke van Hoek, Bergh Stoop & Sanders en Berber Brouwer, Brouwer & Law*)

Other

SkypeOut is an electronic communications service within the meaning of the Framework Directive
IPPT20190605, CJEU, Skype v IBPT
Electronic Communications Services. A VoIP service is an electronic communications service when the publisher is remunerated for the provision of this service and the provision is subject to an agreement between the providers of telecommunications services who are duly authorised to send and terminate calls to the PSTN.

ITEMS

News

IP10196. U.S. Trademark Office makes registering certain cannabis trademarks possible.
National Law Review: "On May 2, 2019, the United States Trademark Office issued new Examination Guidelines for goods and services associated with cannabis and cannabis-derived products and services legalized under the 2018 Farm Bill. This crack in the federal armor against the cannabis economy opens the door for the federal registration of trademark rights and is an important step toward normalizing the nation's laws governing cannabis and cannabis-related business activities in states where such products are legal.
[...]
Under the new Examination Guidelines, trademarks associated with non-ingestible cannabis and cannabis-related products having a tetrahydrocannabinol ("THC") content of no more than 0.3% on a dry weight basis are eligible for federal registration on the Principal Register maintained by the United States Trademark Office. Similarly, trademarks for services relating to non-ingestible cannabis and cannabis-related products (e.g., growing, cultivating, processing and/or dispensing services) having a THC content of 0.3% or below on a dry weight basis are likewise eligible for federal registration on the Principal Register. Permitting registration of these cannabis related trademarks will allow for businesses to both seek the advantages of federal trademark registration as well as seek enforcement of their trademark rights in U.S. Federal Courts across the country.

IP 10198. Music and movie works enjoy copyright protection for 50 years in Saudi Arabia
Zawya.com: "The approval of the Saudi Authority for Intellectual Property (SAIP) is a must to make any changes in folklore, which is considered to be a public property owned by the state.. The recently-approved rules and executive bylaws for the copyright protection law point out that music and movie works enjoy protection for 50 years, beginning with the first production of the work."

IP 10199. Niantic is suing an association of hackers that allegedly makes and distributes "hacked"versions of its game
businessinsider.nl: "Niantic, the creator of "Pokémon Go" and the forthcoming "Harry Potter: Wizards Unite," has filed suit against Global++, an "association of hackers" that allegedly makes and distributes "hacked" versions of its games. Those versions, which Niantic calls "hacked" and Global++ apparently calls "tweaks," give players what Niantic says is an unfair advantage – and infringes on Niantic's intellectual property, it alleges in the lawsuit."

IP 10200. Copyright dispute between Google and Genius about lyric scraping
Wired.com: "Over the weekend, the music annotation site Genius publicly accused search juggernaut Google of stealing its crowdsourced song transcripts and natively publishing them on its search pages in knowledge panels Google calls its "One Box." Doing so, Genius alleges, hurts Genius' bottom line by diverting traffic away from Genius in favor of keeping people on Google's monetized search page instead. As Genius sees it, this is an example not just of lyric lifting but of Google using its scale to unfairly home in on a smaller competitor's territory, which experts say could constitute a potential antitrust matter. Google strongly denies all of it, blaming a contractor for any similarity between its lyrics and Genius'.
[...]
Even if Genius has no copyright claim here, Google or its contractors copying from Genius still might be unfair from a competition standpoint. "It's still potentially an antitrust problem if Google is using its search monopoly to enter some unrelated market and tie that product to the search engine in a way that gives it a huge advantage over competitors," Bergmayer says.
[...]
The harm there is clear: Whether those lyrics are taken from Genius or not, by not sending people over to Genius, Genius loses out on the chance to get people more involved in their community and to sell ads against its traffic numbers."

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