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JOB OFFERS AND ADVERTISEMENTS**MONTHLY CASE LAW OVERVIEW****Copyright**

IP 10219, *A-G Szpunar: supply of e-books is not covered by the distribution right but by the right of communication to the public*

Copyright. Opinion of advocate-general Szpunar regarding NUV/Tom Kabinet ([C-263/18](#)).

The referring court has asked the Court four questions concerning whether the supply of e-books by downloading online for permanent use is covered by the right of distribution within the meaning of Article 4 of Directive 2001/29, whether that right is exhausted by such a supply made with the author's consent, and whether the acts of reproduction necessary for the subsequent transfer of an e-book acquired in that way are lawful.

Furthermore, a number of the parties which have lodged observations in the present case, are of the view that the scope of the questions should be widened to include whether the acts in question are covered by the right of communication to the public, as provided for in Article 3 of Directive 2001/29. According to the A-G, these questions must all be analysed together, because they form inseparable parts of a single complex question: must the supply to users of protected works by downloading be considered to be covered by the distribution right, with the effect that that right is

exhausted by the original supply made with the author's consent? In particular, the classification of those acts as coming within the right of communication to the public precludes their coming within the right of distribution and vice versa.

The A-G concludes that arguments, of both a legal and a teleological nature, are in favour of recognition of the rule of exhaustion of the distribution right with respect to works supplied by downloading for permanent use. In particular, the permanent possession by the user of a copy of such a work shows the similarity of that mode of supply with the distribution of tangible copies. However, the A-G is of the view that, as EU law now stands, the arguments to the contrary should prevail. For that reason, the A-G proposes that the following answer shall be given to the questions for a preliminary ruling:

"Article 3(1) and Article 4 of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society must be interpreted as meaning that the supply of e-books by downloading online for permanent use is not covered by the distribution right within the meaning of Article 4 of that directive but is covered by the right of communication to the public within the meaning of Article 3(1) of that directive."

Preliminary questions about whether downloading and simultaneously uploading a torrent is a communication to the public

Copyright. Case C-597/19: *M.I.C.M. v BVBA Telenet. Preliminary questions Ondernemingsrechtbank Antwerpen – Belgium*.

"1(a) Can the downloading of a file via a peer-to-peer network and the simultaneous provision for uploading of parts ('pieces') thereof (which may be very fragmentary as compared to the whole) ('seeding') be regarded as a communication to the public within the meaning of Article 3(1) of Directive 2001/29, even if the individual pieces as such are unusable? If so,

(b) is there a de minimis threshold above which the seeding of those pieces would constitute a communication to the public?

(c) is the fact that seeding can take place automatically (as a result of the torrent client's settings), and thus without the user's knowledge, relevant?

2(a) Can a person who is the contractual holder of the copyright (or related rights), but does not himself exploit those rights and merely claims damages from alleged infringers - and whose economic business model thus depends on the existence of piracy, not on combating it - enjoy the same rights as those conferred by Chapter II of Directive 2004/48 on authors or licence holders who do exploit copyright in the normal way?

(b) How can the licence holder in that case have suffered 'prejudice' (within the meaning of Article 13 of Directive 2004/48) as a result of the infringement?

Are the specific circumstances set out in questions 1 and 2 relevant when assessing the correct balance to be struck between, on the one hand, the enforcement of intellectual property rights and, on the other, the rights and freedoms safeguarded by the Charter, such as respect for private life and protection of personal data, in particular in the context of the assessment of proportionality?

Is, in all those circumstances, the systematic registration and general further processing of the IP-addresses of a ‘swarm’ of ‘seeders’ (by the licence holder himself, and by a third party on his behalf) legitimate under the General Data Protection Regulation, and specifically under Article 6(1)(f) thereof?”

National provision prohibiting Google from using press snippets is not applicable without prior notification to the Commission

[IPPT20190912, CJEU, VG Media v Google](#)

Copyright. A German provision prohibiting internet search engines from using newspaper or magazine snippets without the publisher’s authorisation must be disregarded in the absence of its prior notification to the Commission: that provision constitutes a rule on information society services and, therefore, a ‘technical regulation’ the draft of which is subject to prior notification to the Commission.

No copyright protection for designs that merely produce an aesthetic effect

[IPPT20190912, CJEU, Cofemel v G-Star Raw](#)

Copyright, Design Law. Copyright protection may not be granted to designs on the sole ground that, over and above their practical purpose, they produce a specific aesthetic effect: designs must constitute the expression of original works if they are to qualify for such protection.

IP10233. Preliminary questions on whether a court is to be regarded as falling within the scope of the term ‘public’

[Case C-637/19. BY. Preliminary questions Svea Hovrätt – Sweden.](#)

Copyright. Preliminary questions. “1. Does the term ‘public’ in Articles 3(1) and 4(1) of Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society have a uniform meaning?

2. If question 1 is answered in the affirmative, is a court to be regarded as falling within the scope of the term ‘public’ within the meaning of those provisions?

3. If question 1 is answered in the negative:

a) In the event of communication of a protected work to a court, can that court fall within the scope of the term ‘public’?

b) In the event of distribution of a protected work to a court, can that court fall within the scope of the term ‘public’?

4. Does the fact that national legislation lays down a general principle of access to public documents in accordance with which any person who makes a request can access procedural documents transmitted to a court, except where they contain confidential information, affect the assessment of whether transmission to a court of a protected work amounts to a ‘communication to the public’ or a ‘distribution to the public’?”

Read [more](#).

Trade mark law

Place infringement online advertisements can also be the place where the target audience is located

[IPPT20190905, CJEU, AMS Neve v Heritage Audio](#)

Trade mark law, Private International law. In the event of an alleged infringement through online advertising, the proprietor of a EU trade mark may bring an infringement action against a third party before the national trade mark court where the target audience of the infringing online advertisement is located.

CJEU about bad faith

[IPPT20190912, CJEU, Koton v EUIPO](#)

Trade Mark Law. Bad faith (article 52(1) under b) CTMR (former)): when one has the intention of undermining, in a manner inconsistent with honest practices, the interests of third parties, or with the intention of obtaining an exclusive right for purposes other than those falling within the functions of a trade mark, in particular the essential function of indicating origin. No requirement that earlier trade mark is registered for the same of similar goods or services. Where at the time of application for the contested mark, third party was using, in at least one Member State, a sign identical with, or similar to that mark, the existence of a likelihood of confusion does not have to be established. The existence a likelihood of confusion is only one relevant factor among other for the existence of bad faith. Where there is an absence of any likelihood of confusion or similarity, other factual circumstances can constitute indicia establishing the bad faith of the applicant.

CJEU on examination of distinctive character of a mark applied for, which has not yet been used

[IPPT20190912, CJEU, Darferdas](#)

Trade Mark Law. In examining the distinctive character of a sign in respect of which registration as a trade mark is sought, all the relevant facts and circumstances must be taken into account, including all the likely types of use of the mark applied for. In the absence of other indications to the types of use, the customs in the economic sector concerned that can be practically significant must be taken into account. Uses, whilst being conceivable in that economic sector, that are not practically significant and therefore seem unlikely must be qualified as irrelevant. Approach from paragraph 55 of the Deichmann case remains relevant only in those

cases where it appears that solely one type of use is practically significant in the economic sector concerned.

IP10231. A-G CJEU: trade mark may not be declared invalid on the sole ground that the specification of goods and services lack sufficient clarity and precision
Case C-371-18 Sky v Skykick. Opinion A-G Tanchev.

Trade Mark Law. 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. The A-G proposes that the Court should answer the questions as follows:

“(1) A registered EU trade mark or national trade mark may not be declared wholly or partially invalid on the sole ground that some or all of the terms in the specification of goods and services lack sufficient clarity and precision. A lack of clarity and precision in the specification of goods and services may nevertheless be taken into account when assessing the scope of protection to be given to such a registration.

(2) However, the requirement of clarity and precision may be covered by the ground for refusal or invalidity of marks which are contrary to public policy, as laid down in Article 3(1)(f) of First Council Directive 89/104 of 21 December 1988 to approximate the laws of the Member States relating to trade marks and Article 7(1)(f) of Council Regulation No 40/94 of 20 December 1993 on the Community trade mark, in so far as registration of a trade mark for ‘computer software’ is unjustified and contrary to the public interest. A term such as ‘computer software’ is too general and covers goods and services which are too variable to be compatible with the trade mark’s function as an indication of origin for that term to be sufficiently clear and precise to enable the competent authorities and third parties to determine on the basis of that term alone the extent of the protection conferred by the trade mark.

(3) In certain circumstances, applying for registration of a trade mark without any intention to use it in connection with the specified goods or services may constitute an element of bad faith, in particular where the sole objective of the applicant is to prevent a third party from entering the market, including where there is evidence of an abusive filing strategy, which it is for the referring court to ascertain.

(4) In the light of Article 13 of Directive 89/104 and Article 51(3) of Regulation No 40/94, where the ground for invalidity exists in respect of only some of the goods or services for which the trade mark is registered, the trade mark is to be declared invalid as regards those goods or services only.

(5) Section 32(3) of the United Kingdom Trade Mark Act 1994 is compatible with Directive 89/104 provided that it is not the sole basis for a finding of bad faith.”

Litigation

CJEU about the concept of “appropriate compensation” in the Enforcement Directive after unjustified interim measures

IPPT20190912, CJEU, Bayer v Richter Gedeon

Litigation. Concept of “appropriate compensation” must be given an independent and uniform interpretation: When the terms of a provision of EU law makes no express reference to the law of the Member States its meaning and scope must normally be given an independent and uniform interpretation throughout the European Union. Meaning of the concept of “appropriate”: justified in the light of the specific circumstances. While the exercise of their authority to grant such compensation is strictly subject to the preconditions under which either the provisional measures must have been repealed or ceased to be applicable because of any action or omission on the part of the applicant, or it must subsequently be found that there is no infringement or threat of infringement of an intellectual property right, the fact that those conditions are satisfied in a specific case does not mean that the competent national courts will automatically and in any event be obliged to order the applicant to provide compensation. Article 9(7) of the Enforcement Directive must be interpreted as not precluding national legislation which provides that a party – even though the patent on the basis of which those had been requested and granted has subsequently been found to be invalid - shall not be compensated for losses which he has suffered due to his not having acted as may generally be expected in order to avoid or mitigate his loss, to the extent that that legislation permits the court to take due account of all the objective circumstances of the case.

ITEMS

Agenda

IP10225. Eindhoven will host the DesignEuropa Awards on 20 October 2020

EUIPO: “The next edition of **DesignEuropa Awards** will be held in **Eindhoven on 20 October 2020**.

Organised by the European Union Intellectual Property Office, the DesignEuropa Awards have become a fixture on the international industrial design calendar.

Now in their third edition, the DesignEuropa Awards honour great design brought to the market with the

protection of the [Registered Community Design](#) (RCD), a unitary intellectual property right valid across the EU.

Eindhoven is known across the world both as the **design capital of the Netherlands** and as an international hub for creative and intellectual property-intensive excellence.

The DesignEuropa Awards ceremony will be held during [Dutch Design Week Eindhoven](#) 2020 (DDW). Organised by the Dutch Design Foundation, DDW is the **largest design event** in Northern Europe and presents work and concepts from more than 2,600 designers to over 350,000 visitors annually.

In collaboration with the [Dutch Ministry of Economic Affairs and Climate Policy](#) and the [Benelux Office for Intellectual Property](#), DesignEuropa 2020 will be a unique opportunity for participants and stakeholders to learn about the latest trends in design innovation and intellectual property for creators and entrepreneurs.

The **call for entries** for DesignEuropa 2020, accessible through EUIPO's website, will start on **21 October, 2019.**

Read the full article [here](#).

Read the press release [here](#).

News

[IP10218. Copyright Landscape could change because of battle between Mercedes-Benz and Street Artists](#)

Hollywoodreporter.com: "A lawsuit involving a series of Detroit murals may define how much protection artists have if their work is in plain sight on the exterior of a building. [...]"

The luxury automaker in March sued four artists who saw a series of G Class truck Instagram ads that showed their work in the background and sent threat letters in response. Mercedes is asking the court for a declaration that it isn't copyright infringement either because the photos were a fair use of the art or because such a claim is precluded by the Architectural Works Copyright Protection Act, a 1990 law that effectively limits copyright claims involving architecture to the functional design of the structure. [...]"

[IP10220. The Māori Council threatened Air New Zealand with boycott for attempting to trademark 'Kia Ora' logo](#)

CNN: "Air New Zealand's attempts to trademark a logo of a common Māori greeting has sparked anger and threats of a boycott from the Māori community.

The Māori phrase "kia ora," which translates literally as "be well," is widely used across the country to mean "hello."

Air New Zealand said that it wanted to trademark a logo of the phrase, which is also the name of its inflight magazine.

Matthew Tukaki, a spokesman for the The Māori Council, called the "harebrained" idea "an absolute disgrace" in a video statement posted online.

Tukaki, executive chairman for the council, said that Air New Zealand routinely "culturally misappropriate not only our symbols but now also our language," noting that the move also came during Māori Language Week. [...]"

"I'm prepared to walk into the court and make a point if I need to," he added.

In a statement sent to CNN, Air New Zealand said it wanted to trademark the logo, and not the phrase itself. [...]"

[IP10221. The Ohio State University's trademark registration of 'the' refused](#)

NBC News: "Federal regulators on Wednesday rejected Ohio State University in its bid to trademark "the" in front of OSU's name, saying such protection just isn't necessary.

The school in Columbus has aggressively marketed itself with the three-letter word, with Buckeyes sports organizations insisting on being addressed as teams from "the Ohio State University."

OSU last month asked the U.S. Patent and Trademark Office to make the single word "the" an exclusive Buckeyes right for use on T-shirts and baseball caps and hats.

"Registration is refused because the applied-for mark as used on the specimen of record is merely a decorative or ornamental feature of applicant's clothing and, thus, does not function as a trademark to indicate the source of applicant's clothing and to identify and distinguish applicant's clothing from others," according to Tara L. Bhupathi, the examining attorney who handled the case. The "the" moniker has long rankled sports fans and journalists, who've called it "pompous and stupid," "ridiculous" and "arrogant."

Partisans, including the university, point out that "the" is part of its name under state law.

The school said it will consider all avenues of appeal.

"We are reviewing our options and have six months to respond," OSU spokesman Benjamin Johnson said Wednesday afternoon."

[IP10222. The liability and obligations of intermediary strongly providers in the European Union](#)

IPR Enforcement Case-Law Collection - The liability and obligations of intermediary service providers in the European Union - Augustus 2019

"[...] This case-law collection provides an overview of the latest developments in this fast evolving area and of the main conclusions of selected cases including decisions of the Court of Justice of the European Union and of national courts issued between 2016 and the beginning of 2019.

Online sales are not limited to the large well-known online marketplaces but are increasingly being used by small and medium-sized firms via websites or mobile apps. The latest statistics from Eurostat show that during 2017, 42 % of large enterprises in the EU, 28 % of

medium-sized enterprises and 17 % of small enterprises engaged in e-sales.

In addition to legitimate transactions, there is a dark side, with some websites or online marketplaces being used to sell counterfeit goods or as the source of illegal downloads of music, videos or games.

The EUIPO's collaboration with intermediaries in addressing IP rights infringements has been intensified and this is one of the growing areas of work of the Observatory. An expert group on cooperation with intermediaries has been set up and the Office plans to work more closely with e-commerce platforms.

By bringing together these case-law decisions in a single report, the EUIPO hopes to make them more accessible and cast further light on the rights and obligations of the intermediaries that are increasingly being used by European consumers and businesses of all sizes."

[IP10223. EPO-EUIPO study: Intellectual property rights strongly benefit the European economy](#)

EUIPO press release: "Intellectual property rights strongly benefit the European economy, EPO-EUIPO study finds [...]"

Industries that make intensive use of intellectual property rights (IPRs) such as patents, trademarks, industrial designs and copyright generate 45% of GDP (EUR 6.6 trillion) in the EU annually and account for 63 million jobs (29% of all jobs). A further 21 million people are employed in sectors that supply these industries with goods and services. These are among the findings of a joint report released today by the European Patent Office (EPO) and the European Union Intellectual Property Office (EUIPO) which analyses the importance of IPRs for the EU economy between 2014 and 2016.

In the period under review, employment in IPR-intensive industries grew by 1.3 million jobs compared with 2011-13, while total employment in the EU declined slightly. The value added per employee in these industries is higher than in the rest of the economy. Accordingly, IPR-intensive industries pay significantly higher wages: on average 47% more than other sectors, with the figure rising to 72% for patent-intensive industries. [...]"

The report is the third in a series that tracks the contribution of industries making an above-average use of trade marks, designs, patents, copyright, geographical indications and plant variety rights to economic growth and employment in the EU.

IPR-intensive industries also account for most of the EU's trade in goods and services with the other regions of the world (81%). The EU as a whole had an overall trade surplus in IPR-intensive industries of approximately EUR 182 billion in 2016, counterbalancing a small deficit in non-IPR intensive trade. [...]"

Read the executive summary of the report [here](#).

Read the full report [here](#).

Read the full press release [here](#).

[IP10226. BOIP and Darts-ip develop tool to improve searching figurative trademarks](#)

BOIP press release: "BOIP drastically improves searching figurative trademarks in its trademark register through a collaboration with Darts-ip.

This innovative tool uses artificial intelligence to enable anyone to simply upload an image and search the entire register for identical or similar trademarks. It will be possible to search not only Benelux trademarks but also EU trademarks and international trademarks valid in the Benelux.

The tool will be incorporated in the register in the coming weeks by BOIP, with the assistance of Darts-ip. It is expected that it will go live in November."

Read the full press release [here](#).

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