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

*The sale of second-hand e-books through a website constitutes a communication to the public*

**[IPPT20191219, CJEU, NUV v Tom Kabinet](#)**

*Copyright.* The supply to the public by downloading, for permanent use, of an e-book is covered by the concept of ‘communication to the public’: from the explanatory memorandum of the Directive follows that the intention was that any communication to the public of a work, other than the distribution of physical copies of the work, should be covered not by the concept of ‘distribution to the public’, but by that of ‘communication to the public’. Usedsoft judgment - in which the CJEU held that exhaustion does not extend only to copies of computer programs on a physical medium - does not apply to e-books: an e-book is not a computer program, unlike the Software Directive 2009, the EU legislature did not desire assimilation of tangible and intangible copies of works protected for the purposes of the relevant provisions of the Copyright in Information Society Directive, the sale of a computer program on a material medium and the sale of a computer program by downloading from the internet are similar from an economic point of view. However, the supply of a book on a material medium and the

supply of an e-book cannot be considered equivalent from an economic and functional point of view, the fact that an e-book may form part of an e-book so as to enable it to be read cannot result in the application of software provisions. Subject to verification by rechtbank Den Haag (District Court, The Hague, Netherlands) must the making available of an e-book by Tom Kabinet be regarded as being communicated to a public: there is “communication” because the works are available to anyone who is registered and that these persons are being able to access the site from a place and at a time individually chosen by him or her, there is a “public” because the number of persons who may have access, at the same time or in succession, to the same work via that platform is substantial, there is a “new public” because a communication is made to a public that was not already taken into account by the copyright holders.

**Design law**

*Courts other than the Community design courts have jurisdiction in interim proceedings on Community designs*

**[IPPT20191121, CJEU, Spin Master](#)**

*Design Law. Private International Law.* Article 90(1) of the Community Designs Regulation provides that the courts of the Member States which have jurisdiction to order provisional or protective measures in respect of a national design shall also have jurisdiction to order such measures in respect of a Community design: use of the word ‘including’ confirms that it does not necessarily have to be a specialised court; legislator has made requirements of proximity and efficiency prevail over the objective of specialization.

**Trade Mark Law**

*CJEU: insufficient motivation concerns a procedural error that can lead to revocation of the decision of the Board of Appeal of EUIPO*

**[IPPT20191031, CJEU, Repower v EUIPO](#)**

*Trade Mark Law.* Appellant has sufficient interest in appeal: annulment of the contested revocation decision would be in the appellant’s favour. Error in law of General Court to base the revocation decision on the general principle of law that permits the revocation of unlawful administrative acts instead of Article 80(1) CTMR cannot lead to annulment of the judgement: operative part of the judgement under appeal is justified on other grounds.

*CJEU on lack of clarity and precision of the terms used to designate the goods and services and bad faith*

**[IPPT20200129, CJEU, Sky v SkyKick](#)**

*Trade mark law.* A Community trade mark or a national trade mark cannot be declared wholly or partially invalid on the ground that terms used to designate the goods and services in respect of which

that trade mark was registered lack clarity and precision: the lack of clarity and precision of the terms used to designate the goods and services covered by the registration of a Community trade mark is no part of the exhaustive list of the absolute grounds for invalidity, the lack of clarity and precision of the terms does not fall within the scope of the requirement of graphic representability and cannot be considered contrary to public policy. A trade mark application made without any intention to use the trade mark in relation to the goods and services covered by the registration constitutes bad faith if the applicant for registration of that mark had the intention either of undermining, in a manner inconsistent with honest practices, the interests of third parties, or of obtaining, without even targeting a specific third party, an exclusive right for purposes other than those falling within the functions of a trade mark: bad faith of the trade mark applicant cannot be presumed on the basis of the mere finding that, at the time of filing his or her application, the applicant had no economic activity corresponding to the goods and services referred to in that application. When the absence of the intention to use the trade mark in accordance with the essential functions of a trade mark concerns only certain goods or services referred to in the application for registration, that application constitutes bad faith only in so far as it relates to those goods or services.

#### Miscellaneous

##### *Foodstuffs from occupied territories may not carry the predicate 'from Israel'*

[IPPT20191112, CJEU, Organisation juive européenne v ministre de l'Économie](#)

*Consumer Law.* Foodstuffs originating in territories occupied by the State of Israel bear the indication of their territory of origin, accompanied, where those foodstuffs come from an Israeli settlement within that territory, by the indication of that provenance. It follows from Regulation No 1169/2011 (on the provision of food information to consumers) that the origin of a foodstuff must be indicated where failure might mislead consumers. It must be held that displaying, on foodstuffs such as those at issue in the main proceedings, the indication that the State of Israel is their 'country of origin', when those foodstuffs actually originate in one of the territories referred to in paragraph 33 above, would be liable to deceive consumers. The omission of the indication 'comes from an Israeli settlement' could suggest that that food has a place of provenance other than its true place of provenance. The fact that a foodstuff comes from a settlement in breach of the rules of humanitarian law, may influence the purchasing decisions of consumers on ethical reasons.

##### *Terms "aceto" and "balsamico" in PGI Aceto Balsamico di Modena are not protected*

[IPPT20191204, CJEU, Aceto Balsamico di Modena](#)  
*Protected designation of origin – Geographical Indication.*

The protection of the name 'Aceto Balsamico di Modena' does not extend to the use of the non-geographical terms of that name such as 'aceto' and 'balsamico' and 'aceto' and 'balsamico' are common terms.

The protection of the name 'Aceto Balsamico di Modena' does not extend to the use of the non-geographical terms of that name such as 'aceto' and 'balsamico' and 'aceto' and 'balsamico' are common terms.

[IP10238, Preliminary reference in relation to the interpretation of i.a. article 14 Enforcement Directive Litigation.](#) Preliminary questions:

"1. a) Is Article 14 of the Enforcement Directive to be interpreted as meaning that the provision covers necessary lawyers' fees as 'legal costs' or as 'other expenses' incurred by a holder of intellectual property rights within the meaning of Article 2 of the Enforcement Directive by virtue of the fact that he asserts, out of court, a right to apply for a prohibitory injunction against an infringer of those rights by way of a warning notice?

b) In the event that 1a) is answered in the negative: Is Article 13 of the Enforcement Directive to be interpreted as meaning that the provision covers the lawyers' fees referred to in 1a) in the form of damages?

2. a) Is EU law, particularly with regard to – Articles 3, 13 and 14 of the Enforcement Directive – Article 8 of the Copyright Directive, and – Article 7 of the Computer Program Directive to be interpreted as meaning that a holder of intellectual property rights within the meaning of Article 2 of the Enforcement Directive is in principle entitled to reimbursement of the full amount of the lawyers' fees referred to in 1a), or at least a reasonable and substantial proportion of those fees, even if – the alleged infringement has been committed by a natural person outside his trade or profession, and – a national provision provides, for such a case, that such lawyers' fees are generally recoverable only after the value in dispute has been reduced?

b) In the event that Question 2a) is answered in the affirmative: Is the EU law referred to in Question 2a) to be interpreted as meaning that an exception to the principle referred to in 2a), according to which the rightholder must be reimbursed the full amount of the lawyers' fees referred to in 1a), or at least a reasonable and substantial proportion of those fees, taking account of other factors (such as, for instance, how current the work is, the period of publication and the infringement by a natural person outside the interests of his trade or profession) is to be considered even if the infringement of intellectual property rights within the meaning of Article 2 of the Enforcement Directive consists in file sharing, that is to say making a work available to the

public by offering it for free download to all users on a freely accessible exchange platform that has no digital rights management?"

## ITEMS

### Publications

#### ***[IP10237. EUIPO Report about Online copyright infringement in the EU](#)***

Online copyright infringement in the European Union - Music, Films and TV (2017-2018), Trends and Drivers. From the executive summary: "The analysis is based on a rich set of data on access to pirated music, film and TV programmes in all 28 Member States, for the period January 2017 to September 2018. The data covers both fixed and mobile devices, as well as the main access methods: streaming, downloads, torrents and stream ripping.

The good news in this report is that digital piracy is declining, as shown in the figure below. Between 2017 and 2018, overall access to pirated content declined by 15 %. The decline was most pronounced in music, at 32 %, followed by film (19 %) and TV (8 %).

However, piracy remains a significant problem, more so in some Member States than in others. The average internet user in the EU accessed pirated content 9.7 times per month in 2018, ranging from almost 26 times per month in Latvia and Lithuania to less than 4 times per month in Finland."

#### ***[IP10239. WIPO has launched a public consultation process on artificial intelligence and intellectual property policy](#)***

*WIPO press release:* "The World Intellectual Property Organization (WIPO) today launched a public consultation process on artificial intelligence (AI) and intellectual property (IP) policy, inviting feedback on an issues paper designed to help define the most pressing questions likely to face IP policy makers as AI increases in importance.

Beginning December 13, 2019, WIPO published its issues paper with a call for comments from the widest-possible global audience. It is the latest step in WIPO's response to the ongoing interaction of AI with the IP system, including the use of AI applications in IP administration.

"Artificial intelligence is set to radically alter the way in which we work and live, with great potential to help us solve common global challenges, but it is also prompting policy questions and challenges," said WIPO Director General Francis Gurry."

## News

#### ***[IP10240. HGF Brand protection beyond Brexit report](#)***

"Since the UK voted to leave the EU in 2016's referendum, HGF has worked to ensure that Brexit will

just mean 'business as usual' for its clients. However, ongoing negotiations and unresolved political debate on the future status of the UK in its relationship with the EU has created an environment of uncertainty for business. We carried out a survey to better understand how prepared some of Europe's biggest companies are for life after Brexit, in terms of protecting their valuable IP rights and the brand equity this adds to their business. We consulted more than 120 companies, many of them world-leaders in their markets and industry sectors, with a specific focus on the UK, Germany, France, Spain, Switzerland and The Netherlands. Together they have annual revenues of hundreds of billions of pounds, are major employers, product innovators, economic drivers and exporters. By taking the temperature of their concerns, priorities, planning and preparations, areas of doubt and perceived opportunities, weaknesses and threats, we can make sure we continue to offer the dynamic intellectual property service that every innovative and competitive organisation needs. [...]

- Almost half of companies (46%) say they will change their brand protection strategy after the UK leaves the EU

- However, a third of companies (31%) still do not know how they will register trade marks after Brexit

- A third (33%) say Brexit will make brand protection harder

- 61% believe it is now important to have IP advisors based in multiple European jurisdictions, with 83% saying local knowledge is the key benefit"

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