RECENT DEVELOPMENTS IN INTELLECTUAL PROPERTY LAW

CPD Update

Siân Croxon and Richard Taylor, Partners, DLA Piper
22 October 2009
Today's update (Part 1)

- L'Oreal v Bellure
- Google Adwords
- Use
- Colour marks/Figurative marks
- Case round up
- Procedural points
L'Oreal v Bellure (1)

- Trade mark infringement claim under
  - s 10(1) TMA (Article 5(1) TMD)
  - s 10(3) TMA (Article 5(2) TMD)
- List of questions referred to ECJ re issue of infringement
L'Oreal v Bellure (2)

- Decision:
- Unfair advantage can be taken without need to show a likelihood of confusion or detriment
- Can have infringement in price/comparison lists even if essential function of mark not harmed
- Explicit or implicit use of a mark in comparative advertising in claim re imitation or replica goods prevented by the Comparative Advertising Directive
Last Minute v Virgin Holidays

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Offer ends 14 July 2009.
Dispute between French luxury goods companies (including Louis Vuitton) and Google

Complaint: Google broke law by accepting ads using a brand name without permission
22 September 2009, AG opinion:

- No infringement of luxury goods makers' trade marks when Google sells brand names as advertising keywords triggered by internet searches

- BUT, Google could be liable if brand owners could show that Google's ads damaged their trade marks. Therefore, could be liable for ad content

- No immunity as a neutral information vehicle because Google has "direct pecuniary interest"
- **Silberquelle GmbH v Maselli Strickmode GmbH (case 495/07)**
  - **ECJ, 15/01/09**
- Owned mark in Class 32 for non-alcoholic drinks
- Mark used on goods given away free to buyers of clothing (Class 25)
- Held: no genuine use of mark in respect of Class 32 goods
Caterpillar Inc v OHIM (case R1127 (2008-2), OHIM 2nd Board of Appeal, 20/11/08

BoA rejected application by Caterpillar to register yellow, black and white as a CTM

Representation accompanied by verbal and colour description = undermined to the graphical representation as a number of forms would fit the description

Important principle = representation must be complete, clear, precise and objective
- Thomas Rotter v OHIM (case T-449/07) CFI, 05/05/09
- Figurative mark of five sausages backed distinctive character under Art 7(1)(b) CTM Regs
- The average consumer would not associate the shape with that of a pretzel, but would see it as an arrangement of five sausages
Case round-up

- Intel Corp. Inc. v CPM UK Ltd (C-252/07), 27/11/08 - INTEL vs INTELMARK

- L'Oreal and others v eBay and others, ChD, 22/05/09 - eBay not liable for trade mark infringement for sale of infringing/counterfeit goods on website

- Interflora, Inc., Interflora British Unit v Marks and Spencer Plc, Flowers Direct Online Ltd, ChD, 22/05/09 - High Court referral to ECJ concerning M&S's use of "Interflora" (and variations) as Google Adwords
Opposition period reduced from 3 to 2 months
UK, Ireland, Portugal and Sweden opt out of national search system for CTM applications
Electronic filing of CTM applications
Electronic filing fee reduction of 40% approved
CFI refused to reinstate CTM where failure to renew was due to agent's error
Today's update (Part 2)

- IP agreements
- Patents, Copyright, Designs
- Internet
- Other ways of tackling IP disputes
  - Company names
  - IPO opinions
- Procedural developments & proposals
IP/IT Agreements

- **Copad v Christian Dior**
  - Direct action allowed for IPR infringement where a distribution agreement is breached

- **Crosstown Music v Rive Droite**
  - Contractual provision for automatic reversion of IPR upheld

- **Oxonica Energy Ltd v Neuftec Ltd**
  - Interpretation of patent & know-how licence, that royalties payable on all sales of a product, including where not patent protected

- **Cocoa Boy and Nescafe Man**
  - Clear your rights! (or make sure someone else has)

- **Fisher v Booker (Whiter Shade of Pale)**
  - No implied licence
- **Butlers & Ors v BBC Worldwide & Ors**
  - Termination on insolvency provision in IP licence contrary to public policy

- **Jacobsen v Katzer** (Court of Appeals for the US Federal Circuit)
  - Take care with open source!

- **Thorn Security v Siemens Schweitz**
  - Register transfers of patents, registered trade marks and registered designs
**Patents, Copyright and Designs**

- **Patents:** *Generics v Lundbeck*
  - Novelty, Inventive Step, Sufficiency, Patent! Do not measure the "contribution"

- **Patents:** *Folding Attic Stairs v The Loft Stairs Company; MMI Research v Cellixon; Hydrogen-absorbing composition/PRYSMIAN T/1464/05*
  - Avoid disclosure before the patent is filed

- **Copyright:** *Catcher in the Rye/Coming Through the Rye*
  - Taking characters and style can amount to an infringement

- **Copyright:** *Infopaq International A/S v DansKe Dagblades Forening*
  - Taking 11 words can amount to an infringement

- **Designs:** *Lucasfilm v Ainsworth (Star Wars)*
- *The Author of A Blog v Times Newspapers Ltd*
  - No privacy for pseudonymous bloggers

- Digital Britain/Loi Halopi
  - Three strikes and …

- *Gary Patchett and Anor v Swimming Pool & Allied Trades Assn*
  - Website owner did not owe duty of care to user (on the facts of the case)
Other ways of tackling IP issues

- Company names tribunal:
  - Coke Cola Limited (adjudication 0-318-08, the Cocoa-Cola Company)
  - Jewson (adjudication 0-186-09, Jewson Ltd)
Other ways of tackling IP issues

- IPO opinions: second request for an opinion allowed: Re EP(UK) 0605800/Isabellenhutte Heusler GmbH; IPO is entitled to consider both novelty and obviousness (Re EP (UK) 0742305/Don & Low Limited)

- *IPO opinions can be useful (and cheap!) in patent disputes. Also note their usefulness in contract drafting*
Procedural developments

- Fast-track IP litigation - from £15k to £25k
- Patents county court - proposals for reform
  - application of costs-benefit test for evidence
  - 1/2 day trials
  - scale costs recovery
- IPCUC - proposals to reduce patent and trade mark court costs to £50K
- Compulsory licences under the ECPC?
- Fast-track for community design application - 10 days - see oami.europa.eu/ows/rw/news/item824.en.do
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