HIGHLIGHTS AND PRACTICAL GUIDANCE FROM SOME OF THE PAST YEAR’S MOST REMARKABLE SOFT IP DEVELOPMENTS IN EUROPE

26 APRIL 2020
Redesigns and broadens concept of bad faith TM filings

Seeking too broad protection can be bad faith

**TO DO**

1. New applications: limit to really relevant G/S
2. Older marks: question need to renew for all G/S

Can “evergreening” to circumvent use obligation be bad faith? Pending Monopoly case (T-663/19) will bring guidance
COTY/AMAZON
C-567/18

ONLINE MARKETPLACES SAFE FROM TM INFRINGEMENT BUT…

• Google Adwords and L’Oréal/eBay revisited
• Mere storage of infringing goods ≠ TM infringement
• BUT:
  • Art. 14 E-Comm Directive (hosting exemption) and Art. 11 IP Enforcement Directive (injunctions against intermediaries)

**TODO** Invest in detecting and taking down infringements

• Liability for TM infringement still possible if third-party seller cannot be identified

**TODO** Be transparent on identity actual vendor behind product offerings
A REGISTERED DESIGNATION OF ORIGIN (PDO) MAY BE EVOKED THROUGH THE USE OF PURELY FIGURATIVE SIGNS

- This evocation may also happen where such figurative signs are used by a producer established in that region (and therefore not exempt from the obligation to refrain from using figurative elements which evoke the PDO)
  - The conceptual link must be sufficiently clear and direct

- Evocation may be assessed by reference to European consumers, meaning also specifically the consumers of a single Member State

Clearance of signs for PDO products should be done bearing the above in mind
Further harmonizes national copyright protection throughout the EU, may facilitate cross-border enforcement

Cumulation of design and copyright protection for applied arts/industrial design (f.i. household appliances, clothing, furniture…) is allowed

No other or higher threshold than “the author’s own intellectual creation”

Thus: Portuguese criterion of an “aesthetic effect” is incorrect; neither sufficient nor required

1. Consider enforcing copyrights EU-wide from one strategically chosen jurisdiction

2. Emphasize creative product design in design and marketing process: focus not only on technical or practical advantages. Designer statements may come in handy
• After Infopaq, another important case on the notion of “reproduction” in the field of copyright & neighbouring rights

• The use of a sound sample in a new work, modified to such a degree that the sample is unrecognisable to the ear in that new work, cannot be considered as a “reproduction”

*Article 2 of the InfoSoc Directive 2001/29*

**Samplimg: To Be or Not to Be a Reproduction**

When not unrecognisable, ask rightholder’s permission for the use of samples of preexisting works
Article 5 of the Information Directive (2001/29) contains a “closed” list of exceptions to copyright and neighbouring rights.

The balance between exclusive rights of rightholders and user rights is included IN the Directive.

Fundamental rights cannot justify further derogations from copyright and neighbouring rights.

Stick to the exceptions as set in the Directive and transposed by member states.
Some controversial rules enacted:

- Press publishers’ “neighboring” rights for online uses (Articles 15-16)
- The “Value Gap” provision (Article 17):
  - Liability by default of online content sharing service providers, as they perform an act of communication to the public when giving the public access to the works uploaded by its users
  - Liability can be avoided by obtaining a license or by reliance on article 17.4
In the absence of license, a 4 step process to avoid liability:

• Make “best efforts” to obtain authorization from rights holder
• Make “best efforts” to ensure unavailability of specific works identified by rights holders with “relevant and necessary information”
• Execute on notice & take down requests expeditiously
• “Notice & stay-down”: make “best efforts” to prevent future uploading of content subject of a notice & take down request

**DSM DIRECTIVE**

**ART. 17.4**

1. Design compliance strategies
2. Set out licensing programs
3. Prepare content management, monitoring and blocking technology