IP & Media News

Our newsletter on recent developments
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Google Cases

In *Equustek v Google 2017 SCC 34*, the Supreme Court of Canada upheld a worldwide interim injunction forcing Google to delist indexing and search of a determined and persistent infringer of the claimant's Intellectual Property and confidential information which had moved abroad to defeat Canadian judgments and jurisdiction. The decision drew on the established jurisprudence from worldwide freezing orders and Norwich (disclosure of identity) orders for the principle that provided there is *in-personam* (personal jurisdiction) over the innocent third party and their assistance is necessary to prevent wrong-doing (here flouting court orders), an order could be made. Google was within the territorial jurisdiction of the Canadian courts due to its local advertising and search and so the courts had *in-personam* jurisdiction. Google had argued that any order should be limited to Canada, but the court held the order could be worldwide based on the law on worldwide freezing orders but invited Google to make a showing that the law differed nationally elsewhere. The court considered the Max Mosley cases in France (also about worldwide delisting) and the Google Spain (right to be forgotten) case, *Google v Gonzales* C-131/12 as well as recent blocking orders made in the UK. The *CNIL* (French data protection authority) v *Google* case, is currently pending before the CJEU on similar issues. Google has already acted to restrain the enforcement of the Canadian court order in the US, seeking a declaratory judgement and injunction against enforcement in the US courts, based on comity, public policy and the First Amendment and failure to balance public interest as well as local injunction standards. Interestingly, the Canadian court did not find that Freedom of Expression was engaged in an unlawful sale of goods, where no monitoring or filtering was ordered.

The Higher Regional Court of Munich issued a “Staydown” injunction against Google in Case 18 W826/17 where Google had already been ordered to remove highly defamatory statements about a company on the grounds of accuracy and where Google had delisted from search but included a notice to that effect and a link to the takedown request on the Lumen (formerly Chilling Effects) website. This topic has rarely been examined before but Google's practice of removal, only to publish the same material elsewhere, is obviously problematic—even if Google does it for reasons of transparency. Issues related to online archives are difficult and there are conflicting authorities in English law also.

Trade marks

In *Jadebay Ltd & Others v Clarke-Coles Ltd (t/a Feel Good UK Ltd)* [2017] EWHC 1400, the defendant used a listing created by the claimant on Amazon (with its unique sales no. and EU bar code) to sell similar flagpoles. The listing said by “Design Elements” and this was the claimant's trade mark. The sales made by the defendant under the listing therefore made use of the trade mark and were infringing. The court found likelihood of confusion even though it

accepted there would be few repeat sales/buyers to be confused. The defendant had under-cut the claimant and enjoyed priority as the default seller for Amazon—thus the litigation.

In *Apple Inc. v Arcadia* [2017] EWHC 440 (Ch), Apple tried to register the mark iwatch in classes 9 (software, devices, cameras, computers and wireless devices) and 14 (timepieces, bracelets and accessories). It was opposed by Arcadia (Topshop) on absolute grounds (lack of distinctiveness and descriptiveness) and by Swatch AG on relative grounds (its own earlier swatch marks). Before the Hearing Officer in the Opposition proceedings, Arcadia succeeded in relation to software, computers and hardware and the application could only proceed in relation to security devices, computer peripherals and accessories and Swatch also succeeded on its relative grounds. Apple appealed to the High Court without success. Apple argued that iwatch had “acquired” distinctiveness due to its use of its many different “i” marks such as iPhone, iPod, iTunes, iPad. The court disagreed that a consumer would see that as a distinctive badge of trade origin designating goods originating from Apple –rather it was a descriptive term –and it cited the BBC iPlayer by way of example.

In *BMW v Technosport* [2017] EWCA Civ 779, the court revisited issues of descriptive use and nominal use and the extent to which such use can be made by resellers and repairers who are not part of the official distribution or other sales network. The use made by *Technosport* went beyond that necessary to convey information about repairs and parts and crossed the line into infringement. The seminal case is *BMW v Deenick*, Case C-63/97, where the use was no more than necessary and was not infringing. Similar issues arose in *Coty v Parfümerie Akzente GmbH*, Case C 230/16, where the issue was whether a contractual prohibition on authorised dealers making use of Amazon and Ebay and other platforms for online perfume sales was anti-competitive and so contrary to art. 101 TFEU and the block exemption. The court's decision is still pending but the Attorney General felt the restriction was proportionate as sales on the authorised reseller's own websites were permitted (subject to conditions) and therefore the restriction was not a blanket one and the items were luxury goods, such that restrictions were necessary for maintaining the prestige and image of the trade mark and the goods.

Readers will know that the new Community Trade Marks Regulation 2015/2436 came into force on 23 March 2016 (and applies directly to EU trade marks, previously known as CTMs)). The parallel new Trade Mark Directive (harmonising the law on national marks) 2015/2436 UK allows member states three years time to transpose it. We are yet to know what will happen given Brexit but it seems unlikely that the UK would fail to transpose. One of the key differences already is the fact that the 'own name' defence has gone for companies with EUTMs but appears to remain for UK marks, a reference being denied on the point in *Sky v Skykick UK Ltd.* [2017] EWHC.

Privacy

IPSO, the (unrecognized) standards body (of choice) has made two of its first decisions on privacy-both against the Daily Mail. Prince Harry succeeded in a complaint against the Mailonline about photographs of him and his girlfriend on a private Caribbean beach. There was no attempt by the Mail to argue any public interest, only rather woolly points on mistake about the status of the beach etc. On the other hand, the Beckhams failed in their complaint about the publication of photographs of their new country home, despite the fact that the location of it could be determined when aggregated with other information in the public domain. It was argued that the

safety of their children was a valid basis to uphold the complaint but the argument failed—possibly due in part to the extensive Beckham family social media usage.

In *PNM v Times Newspapers Ltd* [2017] UKSC 49, the claimant had been arrested but never charged in connection with sexual offences and was later named as arrested in open court on the trial of a third party. He sought to prevent the Times reporting this under cover of privilege and open justice but the majority of the court found the paper had the right to report it and had he wanted to protect his anonymity, he should have made sure he obtained a court order prior to being named in open court. Note that in reporting criminal cases, increasingly the safe approach is not to name until charge unless the police have named. Once there has been an arrest, a matter is active for contempt and so care is required not to imply guilt. Once charged, the CPS has already formed a view on identification and the strength of the prosecution case. Further, once the police name a suspect, their statement can be reported by the media under statutory qualified privilege (a defence to libel which can be an issue on an acquittal).

Copyright

In *Ziggo* Case C610/15, the Dutch Supreme Court referred to the CJEU, questions about whether a site (the Pirate Bay) makes a communication of works to the public where it indexes torrent files of copyright protected works –so that those works can be located and downloaded by users, although the site does not contain the works themselves. The CJEU in Ziggo found that TPB site could infringe where the operators play an essential role in making the works available and managing the platform and where the public was new (not contemplated by the rightsholder) and there was notice and so knowledge and a profit motive or commercial purpose. Overall, it is a very similar decision to the *Newbinz* cases and builds on earlier cases such as *GS Media* Case C- 150/16 ((linking is not infringing if there is no new public even if the original linked to was infringing --provided there is no knowledge and no profit motive—see our earlier updates).

Human Rights & FOE

The Council of Europe has released a very useful handbook on Human Rights and Freedom of Expression, with a comprehensive survey of current case law under art. 10 ECHR. There is a very good summary of the special role of the media as the watchdog of democracy and the similar status enjoyed by the NGOs at pages 83 onwards. See http://www.coe.int/en/web/help/-/new-council-of-europe-handbook-on-freedom-of-expression

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