

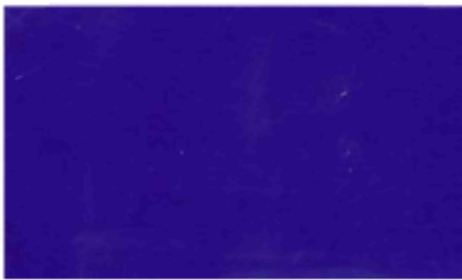
IP & Media Update Oct 2013

Royal Charter: Despite the Government making small further concessions, newspapers and other publishers are seeking an injunction to prevent the Government's plan for a new press regulation regime going before the Privy Council for sealing by the Queen tomorrow. They also filed for a Judicial Review of the rejection of their rival plan for a new press regulator on Monday. The test for Judicial Review is a high threshold, namely whether a decision is irrational. This is likely a precursor to a challenge to the ECHR, as the Times has threatened, as domestic remedies are to be exhausted before applying to that court. We participated in a panel discussion on the Charter at the NUJ conference on the Internet and the Law on Saturday at Goldsmiths University.

Trade Marks: Two recent cases concerned whether the trade marks were "a sign" capable of being registered as interpreted in the judgments of the CJEU.

In *Société des Produits Nestlé SA v. Cadbury UK Limited* [2012] EWHC 2637 (Ch) (*Cadbury*). The mark applied for was the following:

Mark



The description was as follows: "The colour purple (Pantone 2685C), as shown on the form of application, applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of the goods. The rectangle above is a purple block when reproduced in colour." The goods specified were to be for chocolate products in Class 30. Nestlé opposed the Application but lost and the Hearing Officer decided the mark could be registered for "*Chocolate in bar and tablet form; chocolate for eating; drinking chocolate; preparations for making drinking chocolate.*" The appeal turned on a consideration of 4 CJEU cases:

1. ***Libertel Groep BV v Benelux-Merkenbureau*** Case C-104/01 (whether a telecommunications company could register the colour orange as a trade mark) held that a colour *per se*, not spatially defined, is capable of being registered as a trade mark if it can satisfy three conditions: (i) be a sign; (ii) be capable of graphical representation; and (iii) be capable of distinguishing the goods or services of one undertaking from another. The court dismissed the argument of Advocate General Léger that colours should not be assigned for the exclusive use of certain economic operators and should remain available to everyone. The court's conclusion was that a colour sample does not on its own constitute a graphical representation but together with a description in words and a designation of the colour using an internationally recognised identification code (the Pantone reference in this case) may be considered to constitute a graphic representation.

2. ***Sieckmann v Deutsches Patent und Markenamt*** Case C-273/00 (the applicant had applied to register an "olfactory mark" --the smell of a compound called ethyl cinnamate) held it could not be represented graphically and the attempts to do so with a chemical formula, a deposit of a sample or a combination of those things did not satisfy the requirements—the criteria are a description clear, precise, self-contained, easily accessible, intelligible and objective.
3. ***Heidelberger Bauchemie*** Case C-49/02 (an application to register a combination of two colours (blue and yellow) "in every conceivable form") Advocate General Léger invited the CJEU to review *Libertel* but the court declined and held the mark could not be registered. The mere juxtaposition of two or more colours, without shape or contours, or a reference to two or more colours 'in every conceivable form', did not exhibit the qualities of precision and uniformity required. It would not permit the consumer to perceive and recall a particular combination, enabling him to repeat a purchase, any more than they would allow the competent authorities and economic operators to know the scope of the protection afforded to the proprietor of the trade mark.
4. ***Dyson v Registrar of Trade Marks*** Case C-321/03 (concerned an application to register the transparent collection chamber of a vacuum cleaner as a trade mark) held this did not satisfy the requirement of specificity since the mark could take on a multitude of different appearances and would give Dyson an unfair competitive advantage since it would prevent its competitors from selling vacuum cleaners having any kind of transparent collecting bin. The mark applied for was in fact just a property of the product concerned and not a sign.

Based on these cases, the court in *Cadbury* held that since single colours *per se* are capable of being signs, being represented graphically and capable of distinguishing, the colour purple (Pantone 2685C) applied to the whole visible surface, or being the predominant colour applied to the whole visible surface, of the packaging of chocolate, was capable of being a sign within Art. 2 of the Directive. The result was also based on the evidence (of acquired distinctiveness) that the public associated the colour purple itself with Cadbury's chocolate, and Cadbury was entitled to a registered trade mark for that colour on the relevant goods.

In *JW Spear & Son Ltd and Mattel Inc. & others v Zynga Inc: Court of Appeal, Civil Division: 4 October 2013*, Mattel owned a registered trademark (the Tile Mark) associated with the game 'scrabble'. The description of the mark was a three-dimensional ivory-coloured tile on the top surface of which was shown a letter of the Roman alphabet and a numeral in the range one to 10 in Class 9. Mattel alleged infringement of the tile mark by the defendant in connection with the exploitation of a digital game 'scramble' Zynga counterclaimed for revocation of the tile mark as it was not 'a sign' capable of graphic representation on account of the large variety of representations encompassed by it and successfully applied for summary judgment on the counterclaim. The appeal court found (1) that the Tile Mark was not "a sign" as required as it potentially covered many signs achievable by numerous permutations, presentations and combinations; and (2) there was no graphic representation of a sign that met the requirements of clarity, precision and objectivity citing the 4 CJEU cases above and *Cadbury*.

Online libel: The ECHR gave judgment in *Delfi as v. Estonia* (application no. [64569/09](#)). The applicant, a leading Estonian news portal, appealed a decision of the Estonian courts which upheld a complaint from an individual businessman about defamatory and insulting comments about him posted by users under a news item about his business. The comments were taken down immediately once the company was notified. However, the individual pursued the

applicant for damages in relation to the period of time before the comments were removed. The domestic court required the applicant to pay €320 (three hundred and twenty only), rejecting the applicant's Ecommerce Directive defence based on Takedown. The court found the site exercised too great a degree of control over comments on its website to avail itself of the defence. The ECHR upheld the decision and found no breach of Art. 10. It refused to consider the Ecommerce Directive. The decision has shocked many but the fact the defendant was a news organization in the real world may have influenced the court. When the Ecommerce Directive was first introduced there was doubt about whether newspaper sites should be entitled to the defence --on the basis that they should assume responsibility for all publications-- including readers' comments --just as they had always done when publishing letters to the editor. This underlies the restricted nature of the secondary responsibility defence in the UK 1996 Defamation Act with its exclusion of commercial publishers from secondary status. It is not a well-reasoned judgment but the fine was nominal.

Data Protection: On Friday, the UK managed to delay a new EU Data Protection Regulation (which was to be adopted before next May) until 2015. The draft aims to increase consistency and avoid local variation by further harmonisation and also update existing law. The draft contains the long awaited 'right to be forgotten,' clarification of the ability of data subjects to withdraw consent and other improved protections for individual privacy, including restrictions on transfers out of the EU which may require the express advance consent of both national data authorities and data subjects. See http://ec.europa.eu/justice/data-protection/document/review2012/com_2012_11_en.pdf . US tech companies have apparently lobbied hard against the regulation. The EU Parliament's Civil Liberties Committee (LIBE) had the week before approved a compromise set of amendments to the draft Regulation that moved the Parliament's position to the left based on fallout from the NSA scandal. The Committee will negotiate with the Council (consisting of the 28 EU member states) to find a common position. No doubt the UK and its allies hope that the current public interest in personal privacy will have subsided allowing it to further argue the case for the business community.

Copyright Infringement Online: In Case C 170/12 *Pinckney v KDG Mediatech AG* the CJEU upheld the decision of a French Court assuming jurisdiction over a copyright claim where the claimant alleged the respondent infringed his copyright by copying his songs onto CDs sold online by two UK companies. The claimant was able to purchase the CDs in France from an internet site accessible there. The respondent argued jurisdiction could only be established in the place of the defendant's domicile, Austria, or the courts of the place where the damage was caused and the alleged infringement committed—here in the UK. The CJEU held under Art 5(3) of the Brussels I Regulation, the respondent could be sued in the courts of the place where the harmful event occurred. That is either the place of the event giving rise to the damage or the place where the damage occurred (this can vary dependent on the right in issue and if the right is registered it will be the place of registration). The CJEU confirmed that in a copyright case, if the country protects the copyright, and the infringing copy was accessible within the jurisdiction then the courts of that country will have jurisdiction if first seized, although the claim will be limited to the damage arising in that jurisdiction. The court noted that in cases where personality and privacy rights are involved there is also a third basis of jurisdiction – namely a claimant's centre of interests following Case C161/10 *eDate Advertising GmbH v X and Olivier Martinez and Robert Martinez v MGN Limited*.