IP & Media News

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Our newsletter on recent developments

Trademarks

On July 10, 2014 the Court of Justice of the European Union (the "CJEU") issued its decision in In Case C-421/13 *Apple Inc. v. Deutsches Patent und Markenamt* and recognized the possibility to register a three-dimensional representation of the design and layout of a retail store as a trade mark. The trademarks are a three-dimensional representation of the front and inside of an Apple store registered in association with services within class 35 which includes "retail store services featuring computers, computer software, computer peripherals, mobile phones, consumer electronics and related accessories and demonstrations of products relating thereto." This was the mark:

Apple's application under the Madrid agreement for an international registration when considered by Germany, failed on the basis that consumers would not see the marks as an indication or badge of the commercial origin of the products sold therein. Apple appealed to the *Bundespatentgericht,* which then requested the CJEU's help to interpret Articles 2 and 3 of Directive 2008/95/EC (the Directive). The CJEU noted that in order to be capable of constituting a trade mark for the purposes of art. 2 of the Directive, the subject-matter of any application for registration had to satisfy three conditions: it must be a sign; that sign must be capable of graphic representation and the sign had to be capable of distinguishing the 'goods' or 'services' of one undertaking from those of other undertakings (citing Libertel, C-104/01 [23]; Heidelberger Bauchemie, C-49/02, [22]; and, Dyson, C-321/03 [28]. Designs were among the categories of signs capable of graphic representation so that the mark sought, which depicts the layout of a retail store by means of an integral collection of lines, curves and shapes, could constitute a trade mark provided that it was capable of distinguishing the products or services of one undertaking from those of other undertakings. That requirement could be met if the layout of the retail outlet departs significantly from the norm or customs of the economic sector concerned. As to whether the mark had a distinctive character for the purposes of art. 3(1)(b) of the Directive in relation to the products or services for which registration is sought, with the exception of art. 3(1)(e) (signs for f the shape of the goods) art. 3(1) makes no distinction between different categories of trade mark. Finally, art. 2, does not preclude the registration of a sign for services which

are connected with the goods of the applicant for registration (if none of the grounds for refusing registration in the Directive apply) for example as here, services in such stores, i.e. demonstrations of the products displayed.

Data protection for media

The UK ICO released guidance on Data Protection for the media. It reviews the Section 32 exemption for journalism. The exemption has four elements; the processing must be for journalism, for publication and with reasonable belief that it is in the public interest and compliance is incompatible. The ICO counsels that media compliance with the industry codes (Editors', Ofcom and BBC) will usually also satisfy the ICO. Its discussion of the public interest factor is interesting and recognises proportionality must be at the heart of its application to any particular publication/intrusion. Organisations must be able to show appropriate decision making processes and policies for the exercise of editorial judgment on public interest and that it was considered at the relevant time and there is a cogent argument. Audit trails and papered decisions will be advisable for sensitive stories/data gathering. The ICO makes clear that if the code owner/regulator finds compliance, it would rarely take a different view. The guidance is less helpful on the 55 offence of knowingly or recklessly obtaining or disclosing information without the consent of the data controller responsible and obtaining information by deception. While there is a general public interest defence, a specific exemption for journalists never came into force. Despite the topicality, the ICO says only *" we recognise the important role that undercover investigations and unauthorised leaks can play in major public interest stories."* Which is no guidance at all. The failure to fairly define the defence and the vague and subjective standards involved leave the media in a familiar invidious position.

We earlier reported the case of *Steinmetz v Global Witness* (individuals named by Global Witness in its reporting on Guinean corruption allegations made subject access requests to obtain personal data about them held by Global Witness --which relied on the Section 32 exemption for journalism and refused). High Court proceedings followed but the case has now been stayed pending the ICO/Information Rights Tribunals which have jurisdiction.

Press Regulation Copyright

IPSO, the new independent Press Standards Organisation, took up its role as press regulator on 8th September. The new regulator will oversee editorial standards for the majority of national, regional, local and trade publications (but not the FT, the Guardian or the Independent. It administers the same code (the Editors' Code) as it's much maligned predecessor, the PCC, and its Chairman, Sir Alan Moses accepted it does not comply with the recommendations of the Leveson Report. However he assured the public that it will be independent of industry. The FT appointed its own editorial complaints commissioner in lieu of joining. The Guardian said it would wait and see how IPSO evolved and rely on its own internal complaints

system. We looked at the Government's proposed Charter system (ignored by industry in favour of IPSO) in our update of 5 April 2013. IPSO adopts many of those key features such as the power to direct apologies/remedial action by publishers and impose fines of up to £1m and enhanced investigation powers. Publishers who join approved regulators (such as IPSO) can avoid exemplary damages and adverse costs consequences in the courts in claims against them for libel, privacy and breach of confidence and harassment under the Crime and Courts Act 2013.

Copyright

On September 3, 2014, the CJEU issued a judgment in response to a request from the *Hof van Beroep te Brussel* for a preliminary ruling on the scope of the exception for "parody" art. 5(3)(k) (an optional exemption from the menu of permitted exemptions) of the Directive 2001/29/EC, the Information Society Directive. The case concerned the use by a member of a Flemish political party on the cover of a political calendar of a drawing resembling a famous comic book with a political message but without the rightholders' consent. The ECJ held that 'parody' for the directive must be regarded as an autonomous harmonised concept of EU law, interpreted uniformly throughout the EU. It found the essential characteristics of a parody are, "*first, to evoke an existing work while being noticeably different from it, and, secondly, to constitute an expression of humor or mockery*". Belgian national law and its limitations and criteria thereunder, were of no relevance. However, it was for Member States' courts to strike a fair balance between the authors' rights and interests, and the parodist's (as required by art.5 (5) of the same directive, incorporating the values of the Berne three step test) under all circumstances of the case, including if the parody conveys a discriminatory message which has the effect of associating the protected work with such a message.

The UK adopted a new fair dealing exemption for parody and for quotation in The Copyright and Rights in Performances (Quotation and Parody) Regulations 2014 (SI 2014/2356) coming into force on 1 October 2014. The moral rights regime was not consequently amended. The IPO undertook very extensive research and commissioned empirical, economic and comparative legal studies in relation to these new exemptions.

We specialize in intellectual property and media law services and litigation and advisory work.

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