

## IP Case Law Conference

**1<sup>st</sup> day (May 7, 2018)**

08:30 09:00 **Registration and breakfast**

09:00 09:40 **Welcome** by Conference Master Scott Stanley, Lawyer in the Knowledge, Information & Support Service of the Boards of Appeal, EUIPO

### **Opening Statements by**

- António Campinos, Executive Director, EUIPO
- Marc Jaeger, President of the General Court of the European Union
- Pavel Svoboda, Member of the European Parliament, Chair of Legal Affairs Committee
- Freddy Drexler, Jurisconsult of the European Parliament

09:40 10:50 **1<sup>st</sup> Session**

### **Relationship Between Copyright, Trade Marks and Designs**

**Panel Leader:** Alina Trapova, Researcher and Intellectual Property Specialist, Bocconi University (Milan)

**Topic 1:** Registration of Public Domain Works as Trade Marks: Legitimate or Dysfunctional Accumulation?

Speaker: Marco Ricolfi, Professor of Intellectual Property Law, Turin University; Partner Studio Tosetto Weigmann e Associati

**Topic concept:** Can cultural works which enter the public domain be registered as trade marks upon expiration of copyright protection?

**Topic 2:** The Clash Between Trade Mark Law and the Copyright Defence of Parody

Speaker: Lionel Bently, Barrister and Professor of Intellectual Property Law, University of Cambridge

**Topic concept:** In Europe, parody is an exception to copyright infringement according to the Information Society Directive. Should a similar defence exist in the trade marks system and to what extent would it interfere with the rights of trade mark owners?

**Topic 3:** The Overlaps Between Design and Copyright Law

Speaker: Benoit Van Asbroeck, Partner, Bird & Bird LLP, Brussels

**Topic concept:** This topic examines the interplay between copyright and design law

in the European Union.

**Topic 4:** Copyright Ownership Information: the Roles of Public and Private Sector Databases – US Perspective

Speaker: Shira Perlmutter, Chief Policy Officer and Director for International Affairs, United States Patent and Trademark Office (USPTO)

**Topic concept:** The development of databases of copyright ownership information is increasingly important for licensing in the online environment. In the United States, the copyright registration and recordation systems have established a public database, including through making registration of U.S. works a prerequisite for filing a lawsuit. At the same time, various registries have been created by private parties in the United States and elsewhere. This topic will explore the relative advantages of the different types of databases, the role of standard identifiers and metadata, and the potential development of public-private partnerships.

**Topic 5:** “Public Order”

Speaker: Virginia Melgar, Member of the 5<sup>th</sup> Board of Appeal, EUIPO

**Topic concept:** Considerations of public policy and principles of morality may apply as grounds for refusal of the registration, as a trade mark, of cultural material belonging to the public domain. Public Domain material may be refused registration on the grounds of the Art.7(e)(iii) EUTMR.

10:50 11:20 **Discussion**

11:20 11:50 **Coffee Break**

11:50 13:00 **2<sup>nd</sup> Session**

**Boards of Appeal as Dispute Resolution Bodies**

**Panel Leader:** Ian S. Forrester, Judge of the General Court of the European Union

**Topic 1:** Effective Dispute Resolution at the EUIPO Boards of Appeal

Speaker: Sven Stürmann, Chairperson of the 2<sup>nd</sup> Board of Appeal, EUIPO

**Topic concept:** The acts adopted by the EU Agencies enjoy a double system of legal review: on the one hand, the Agencies' Boards of Appeal examine the compliance of internal decisions with the applicable rules, while on the other hand the Court of Justice reviews the decisions of the Boards of Appeal. In the light of the sheer number of appeals received by the EUIPO Boards of Appeal and the length of proceedings needed in order to obtain definitive resolution of a dispute, the Boards of Appeal have introduced an active case management project, which is focused on effective dispute resolution through streamlined and transparent processes and involves empowerment of the users.

**Topic 2: Deontology Code for the Boards of Appeal**

Speaker: Chris de Cooker, President of the Administrative Tribunal, North Atlantic Treaty Organization (NATO)

**Topic concept:** This topic presents the different codes of conduct in administrative tribunals and other deontological provisions such as rules on conflict of interest or recusals that could be applicable to the Boards of Appeal.

**Topic 3: Scope of Review of the National Boards of Appeal**

Speaker: Andrej Matijević, President of the Croatian Boards of Appeal

**Topic concept:** Despite significant harmonisation on issues of substantive IP law, differences still exist in the procedures used for resolving IP disputes, in particular on appeal. Some member states have created Boards of Appeal as a means of reviewing the legality of trade mark and designs decisions whereas others have not. Moreover, not all boards exercise the same scope of review, often diverging as regards the procedures followed before them. This topic focuses on the role and scope of review of Boards of Appeal from the perspective of one of the national Boards of Appeal.

**Topic 4: Scope of Review of the EUIPO Boards and the General Court: A Comparative Panorama**

Speaker: Stefan Martin, Member of the 2nd Board of Appeal, EUIPO

**Topic concept:** Both the EUIPO Boards of Appeal and the General Court exercise review functions vis-à-vis the lower decision-making instances. These review functions have many common aspects but there are also important differences, such as with respect to the treatment of new evidence, their scope to alter decisions or to replace the lower instances reasoning with their own. Whereas the doctrine of functional continuity applies between the instances of the EUIPO, the General Court's scope of review is more restricted. Recent decisions of the Court of Justice such as 'Laguiole' (C-598/14 P) have clarified the General Court's role vis-à-vis the Boards of Appeal. This topic compares the roles of these instances within the EU trade mark and design system.

**Topic 5: Trademark Trial and Appeal Board (TTAB) practice, review of examiner refusals and scope of review**

Speaker: Marc Bergsman, Judge at the TTAB

**Topic concept:** The work of the TTAB differs in a number of respects from that undertaken by the EUIPO Boards of Appeal. This presentation will provide an overview of the activities and review practices of the TTAB.

13:00 13:30 **Discussion**

13:30 15:00 **Networking lunch**

15:00 16:20 **3<sup>rd</sup> Session**

**Procedural Issues in Appeal Proceedings Before the General Court of the European Union**

**Panel Leader:** Emmanuel Coulon, Registrar of the General Court

**Topic 1:** Representation of a private party before the General Court

Speaker: Ionut Dragan, Administrator, Registry of the General Court

Topic concept: The notion of lawyer as a representative of a party before the General Court – Legal framework and case law

**Topic 2:** Admissibility of an application in IP cases (time-limit, locus standi, substantial formal requirements) before the General Court and appeals before the Court of Justice

Speaker: Natalie Schall, Administrator, Registry of the General Court

Topic concept: To avoid that an application in IP cases before the General Court and appeals before the Court of Justice are rejected as inadmissible, certain admissibility criteria must be satisfied. This topic presents some of the main admissibility criteria, such as time-limit, locus standi and substantial formal requirements.

**Topic 3:** The intervener in IP cases before the General Court and the Court of Justice

Speaker: Andrej Stec, Référendaire, General Court

Topic concept: Analysis of some practical issues linked to interventions in IP cases. Scope of an intervention. Possibilities to submit a cross-claim

**Topic 4:** Lodging of documents by e-Curia

Speaker: Joris Plingers, Administrator, Registry of the General Court

Topic concept: e-Curia is an application of the Court of Justice of the European Union that is intended for lawyers and agents of the Member States and of the institutions, bodies, offices and agencies of the European Union, and which allows the exchange of procedural documents with the Registries of the Court of Justice and the General Court, by exclusively electronic means. This topic intends to explain the request for access and the lodging of procedural document with this application.

**Topic 5:** Procedural aspects of the transfer of rights during an appeal proceeding before the General Court

Speaker: Katarzyna Pocheć-Pilipavicius, Référendaire, General Court

Topic concept: The topic discusses the formal requirements of an application for replacement of a party to the proceedings before the Board of Appeal in the proceedings before the General Court as well as the procedural rights and obligations of the successor to the right transferred.

**Topic 6:** Grounds of appeal against decisions of the Board of Appeal before the General Court (Article 72 of Regulation 2017/1001)

Speaker: Chloé Binet, Référendaire, General Court

**Topic concept:** According to Article 72 of Regulation 2017/1001, an action may be brought before the General Court against a decision of the Board of Appeal on grounds of lack of competence, infringement of an essential procedural requirement, infringement of the TFEU, infringement of the said Regulation or of any rule of law relating to their application or misuse of power. This topic provides examples of some of these grounds of appeal.

16:20 16:40 **Discussion**

16:40 17:00 **Coffee Break**

17:00 18:25 **4<sup>th</sup> Session**

### **Reconciling National and EU Trade Mark Systems**

**Panel Leader:** Gordon Humphreys, Chairperson of the 5<sup>th</sup> Board of Appeal

**Topic 1:** From “DHL” to “Kerrygold”, passing through “Combit”: where does the unitary character of the EUTM stand?

Speaker: Maria Eugénia Martins Ribeiro, Former Judge at the General Court of the European Union

**Topic concept:** The DHL and Combit cases brought an exception to considering the EU trade mark as full and enforceable right across the entire EU territory. How did the Kerrygold case impact the unity of assessment of the likelihood of confusion?

**Topic 2:** Initiatives for the Convergence of Trade Mark Practice

Speaker: João Negrão, Director of International Cooperation and Legal Affairs Department

**Topic concept:** The EUIPO Convergence Program links the Office with national offices and user associations in an effort to reach common ground in areas where IP Offices have different practices. Among others, its mission is to create common IT tools under the Cooperation Fund.

**Topic 3:** How and Whether Convergence Efforts Have Shaped the EUIPO's and National Offices' Practice

Speakers: Dimitris Botis, Deputy Director for Legal Affairs, ICLAD, EUIPO and Mikael Francke Ravn, Chief Legal Adviser, Danish Patent and Trademark Office

**Topic concept:** Analysis of the dynamics and the impact of the convergence initiatives on trade marks practice.

**Topic 4:** The Impact of National Judgments on Office and Court procedures:

Absolute Grounds, Inter Partes Proceedings and Res Judicata

Speaker: Philipp Von Kapff, Member of the 1<sup>st</sup> Board of Appeal, EUIPO

**Topic concept:** This topic analyses the impact of national judgments on EU case law, both of EUIPO and CJEU.

**Topic 5:** Non-traditional trademarks (NTTMs): A US perspective

Speaker: David Franklyn, Director of the McCarthy Institute for IP and Technology Law, University of San Francisco

**Topic concept:** The US has a number of years' experience with NTTMs. This experience means industry the other side of the Atlantic is more abreast of the developments that are taking place in this field and can make informed choices of when, what and how to register NTTMs.

**Topic 6:** The Impact of Elimination of Graphical Representation for Smell Marks: A Comparison Between the National and EU systems

Speaker: Valeria Falce, Professor of Economic Law at the European University of Rome and Member of the Italian Intellectual Property Board of Appeal

**Topic concept:** Are smells likely to overcome the non registrability objection in the present state of technology? The topic discusses the impact of the elimination of the graphic representation requirement on the registrability of smell marks in the EU.

18:25 18:45 **Discussion**

21:00 00:00 Official dinner with dinner speaker Martti Enäjärvi, Special Advisor, EUIPO

## 2<sup>nd</sup> day (May 8, 2018)

09:00 09:20 **Breakfast**

09:20 10:40 **5<sup>th</sup> Session**

### **EU Trade marks and Non-Registered Signs**

**Panel Leader:** Beate Schmidt, President of the German Federal Patent Court (Bundespatentgericht)

#### **Topic 1: Domain Names**

Speaker: Gareth Dickson, Partner, Commercial Disputes, Taylor Vinters

**Topic concept:** The courts have applied trade mark legislation to the domain name system in order to resolve emerging conflicts. However, there are considerable differences between those two systems. In particular, domain names are a global phenomenon, while trade marks are territorially limited rights that are subject to the national legislation of each state. Also, their registration systems differ considerably. What would be the most effective way to protect domain names? What are the relative advantages of attempting to register them as a trade mark or just as a domain name?

#### **Topic 2: Shop Signs and Company Names (French perspective)**

Speaker: Julien Canlorbe, Partner, Meridian Avocats

**Topic concept:** Company names, trade names, business names, corporate names are signs that are used as business identifiers as opposed to trade marks that identify goods or services produced or marketed by a particular undertaking. Pursuant to Article 8 of the Paris Convention, trade names benefit from protection without any registration requirement. Store or shop signs are signs that are typically fixed on a building to identify or locate a business. Pursuant to Article 8(4) EUTMR one of these signs can be invoked to oppose the registration of a younger mark. This topic will review the differences that exist between these signs and their respective requirement of use, which varies from mere first use in trade to use requiring recognition or reputation.

#### **Topic 3: The Business Identifiers (Unternehmenskennzeichen) Regime under German Law**

Speaker: Andrea Lensing-Kramer, Partner, Freshfields

**Topic concept:** The business identifiers (Unternehmenskennzeichen) regime under German law falls under the definition of 'other signs' under Article 8(4) EUTMR. Although rarely relied upon used before the EUIPO, it can effectively 'knock out' EUTM applications or registrations and can thus be a very powerful weapon in the litigator's arsenal. In addition, complex questions can also arise as to whether use as a business identifier constitutes use of a trade mark for the purposes of proving genuine use.

#### **Topic 4: Passing Off and Extended Passing Off**

Speaker: Sir Richard Arnold, Judge of the High Court of England and Wales

**Topic concept:** In the UK, the law of passing off states that "no trader is to pass off

his goods as those of another”. However, passing off is often described as a protean tort, as its traditional boundaries have been stretched to adapt to the needs of the contemporary market.

**Topic 5:** The Protection of Titles of Works (German perspective)

Speaker: Roland Kunze, Rechtsanwalt & Solicitor (England & Wales) at  
WürttembergKunze

**Topic concept:** Section 5(1) of the German Trade Mark Act provides that company symbols and titles of works shall enjoy protection as commercial designations. Pursuant to Section 5(3) of the act, titles of works are the names or special designations of printed publications, cinematographic works, musical works, dramatic works or other comparable works. According to settled German case law, “other comparable works” include, inter alia, titles of radio or television series, computer games and video games, and, in most cases, software. Under European law, these titles of works are national rights, which constitute “earlier rights” in the sense of Article 8(4) of the European Trade Mark Regulation. Thus, an opposition against an application or an application for declaration of invalidity against an existing trademark registration can be based on the title of work. This topic is about giving more information to the users of the word titles as protected by German law.

**Topic 6:** Personal Marks and Protection of One’s Persona – A US Perspective

Speaker: Susan J. Hightower, Judge at the TTAB

**Topic concept:** This topic gives an insight into the law of protection of one’s personal image and personal portrayal under US law and its interaction with trade marks

10:40 11:00 **Discussion**

11:00 11:30 **Coffee Break**

11:30 12:40 **6<sup>th</sup> Session**

**Designs**

**Panel Leader:** Graeme Dinwoodie, Global Professor of Intellectual Property Law,  
IIT Chicago-Kent College of Law

**Topic 1:** Saturation and Crowded Field: The Effect of Prior Designs in the Assessment of Similarity

Speaker: David Musker, Professor of International Design Law, Queen Mary University of London

**Topic concept:** The doctrine of the “crowded field” as a factor in the assessment of similarity between earlier and later designs through the case law of the 3rd Board of Appeal.

**Topic 2:** Freedom of the Designer

Speaker: David Stone, Partner, Allen & Overy and Research Fellow, Oxford

Intellectual Property Research Centre

**Topic concept:** The degree of freedom of the designer is a factor to be taken into consideration when assessing the individual character of a design. The 3rd Board of Appeal has greatly contributed to the development of the relevant case law.

**Topic 3:** Disclosure and New Technologies

Speaker: Henning Hartwig, Partner, Bardehle Pagenberg

**Topic concept:** Disclosure is one of the conditions that should be met in order to grant design protection to an article. Special scenarios of design disclosure have emerged due to the internet and new technologies. Can the appearance of an article in a YouTube video or in a Facebook profile stand as a proper disclosure?

**Topic 4:** Technical Function of a Design

Speaker: Elisabeth Fink, Member of the 3rd Board of Appeal, EUIPO, Judge at the German Federal Patent Court

**Topic concept:** Article 8(1) CDR provides that a Community design shall not subsist in features of appearance which are solely dictated by the technical function of the product. The recent preliminary ruling regarding the assessment of such technical function (C-395/16 DOCERAM) has important ramifications for the test to be applied by the Boards of Appeal and the evidence required in order to prove technical function.

**Topic 5:** The Legal Framework for European Cooperation in the field of Community Designs

Speaker: Mihály Ficsor, Deputy Director of European Cooperation Area, ICLAD, EUIPO

**Topic concept:** The Office's strategic plan 2020 ranks cooperation with the national IP Offices among its core tasks. Cooperation projects should serve the interests of the Union and the Member States.

12:40 13:10 **Discussion**

13:10 13:30 **Summary and closing remarks by**

- Théophile M. Margellos, President of the Boards of Appeal
- João Negrão, Director of ICLAD
- Ursula Schildt, Director of the Academy

13:30 15:00 **Networking Lunch**