

AIPPI members and non-members attended this event which was James Mellor QC's 'Jackanory' series of IP updates. Mr Mellor looked at trade marks, copyright and trade secrets/confidential information.

Trade Marks

Mr Mellor focused on recent case law. TOP Logistics and Others [2015] EUECJ C-379/14 confirms the principle from Zino Davidoff SA v A & G Imports Ltd [2002] ECJ C-414/99, that goods stored in a warehouse (in this case, Bacardi rum) constitute imported goods as soon as they leave the customs arrangement. Such importation deprives the trademark owner of the possibility of controlling the conditions of first marketing the product in the EEA, which can damage the value of the trademark. Examining Diageo Brands BV v. Simiramida-04 EOOD [2015] C-681/13) Mr Mellor drew attention to the CJEU's strict approach to countries refusing to enforce judgments from another member state on the grounds of public policy. Mr Mellor considered the publicity-friendly Société des Produits Nestlé SA v Cadbury UK Ltd [September 2015] C-215/14. He discussed how the Kit-Kat contains 3 essential features: one resulting from the nature of the goods themselves (the slab shape) and 2 which are necessary to obtain a technical result (shape and number of grooves). Mr Mellor said that essentially the case will not make the "assessment of distinctive character" any easier in trademark infringement disputes.

Mr Mellor then looked at the effects of co-existence in recent UK case law (IPC Media Ltd v Media 10 Ltd [2014] EWCA Civ 1439, J.W. Spear & Sons Ltd and others v Zynga Inc [2015] EWCA Civ 290 (the SCRABBLE/SCRAMBLE case), and Maier and another v ASOS Plc and another [2015] EWCA Civ 220). Namely, if there was confusion between two trademarks or the risk of it:

- it would have come to light, and
- the trademark owner would have reacted.

Looking at the SCRABBLE/SCRAMBLE case, Mr Mellor drew attention to the fact that the first court's refusal to find trademark infringement was significantly affected by the length of time within which the two games had knowingly co-existed in the market together. Notably, the action was only brought after Mattel lost out in its bid to market a physical version of Zynga's electronic Scramble game. Similarly in Assos v ASOS, ASOS successfully ran an own name defence, which was bolstered by the trademarks' 6 years of coexistence. As a rule of thumb, Mr Mellor found that the shorter the length of the coexistence, the wider the scale of the coexistence would need to be for it to be successfully relied upon. In contrast, Mr Mellor looked at the far higher threshold required to establish "peaceful co-existence" in OHIM proceedings, which to his knowledge has never yet succeeded as an argument at General Court or CJEU level.

Copyright

Mr Mellor examined a number of CJEU and UK cases. He reminded us of the guiding principle in Svensson and others v Retriever Sverige AB (Case C- 466/12) that "the provision on a website of clickable links to works freely available on another website does not constitute infringement", but predicted that the question of whether or not links make works available to a "new public" will continue to cause problems. Mr Mellor then turned to ITV v TVCatchUp [2013] (Case C-607/11) and the defence of "retransmission by cable" under section 73 CPDA and considered the questions which have been referred to the CJEU, centring around the meaning of "cable".

Mr Mellor told us to watch out for potential reform of UK Copyright legislation, following the consultation on repeal of section 73 CPDA. EU Reform is also on the cards in light of the Digital Single Market Strategy (May 2015) New Commission. Additionally, Mr Mellor flagged potential international reform as a result of the proposed WIPO Treaty on the Protection of Broadcasting Organisations, which will give "Rome +" protection.

Trade Secrets

Mr Mellor looked at the proposed new EU Directive on the protection of trade secrets and found the drafting problematic because of uncertainty and its insufficient protection of legitimate interests. Mr Mellor felt that the definition of "trade secret" was not bad, but predicted that it will signal the demise of a whole body of built-up "breach of confidence" UK case law.