Overview of European Union Trade Mark and Copyright

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Colin Sawdy
csawdy@eapdlaw.com
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Trade Marks
Trade Marks - Origins

- Proprietary marks:
  - Traders applied marks to goods to indicate ownership
  - Prevented theft, enabled recovery of goods
- Medieval Guilds:
  - Trade organisations controlling production of certain goods / provision of certain services
  - Ensured goods were of satisfactory quality
  - Marks applied to goods to identify source of unsatisfactory goods
- Industrial Revolution:
  - Factories applied marks to manufactured goods
  - Purchasers relied on signs to indicate source of goods
- 20th Century:
  - Marks become assets and acquire advertising quality

Legal Protection of Trade Marks

- 16th Century: courts protect marks at request of traders
- Common Law Courts enforced actions for deceit
- Courts of Chancery allowed actions for passing off to protect goodwill from misrepresentation
- Trade Marks Act 1875: system for registration implemented
- Trade Marks Act 1938, 1994
- EU Trade Marks Directive 1996
Modern Statutory Regimes

- National Law:
  - Trade Marks Act 1994
  - Statutory Instruments

Advantages of registration

- Proof of ownership
- Notice to world
- Protection of mark – litigation requirement
- Enforcement benefits
- Business asset – personal property right
- Licence, assign, mortgage
Types of Trade Marks

♦ Trade marks:
  ♦ Word marks
  ♦ Device marks
  ♦ Non-conventional marks (colours, sounds, smells)
  ♦ Slogans
  ♦ Shapes
♦ Registered trade marks
♦ Common law unregistered trade marks

Trade Mark Definitions

♦ Article 2 Trade Marks Directive:
  ♦ A trade mark may consist of any signs capable of being represented graphically particularly
    ♦ words, including personal names
    ♦ designs
    ♦ letters
    ♦ numerals
    ♦ the shape of goods or of their packaging
  ♦ provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings
♦ Scope of protection:
  ♦ Identical / confusingly similar later third party marks
  ♦ Specification of goods and services
  ♦ Defensive registrations
Trade Mark Searches

- Objective is to clear mark for use and registration
- Search for prior registrations, prior applications, prior use
- National applications: prior national rights
- Community trade marks: prior CTMs and prior national rights in all Member States
- Also clear mark on absolute grounds: assess whether mark is distinctive and non-descriptive

Initial Considerations

- Geographic scope of protection – where to file?
  - United Kingdom: Trade Marks Registry
  - European Union: OHIM
  - Madrid Protocol / Agreement: WIPO
- Pre-filing checks and considerations:
  - Clearance search
  - Industry awareness
  - Actual and intended use of mark
  - Ownership
  - Priority claims
  - Specification of goods and services
Initial Considerations

- Community Trade Marks
  - 1 registration protects mark in 27 Member States
  - First to file system
  - Actual use / intent to use not relevant
  - Broader specifications tolerated
  - Absolute grounds examination only
  - No relative grounds examination

What can be registered?

- Absolute grounds prohibitions:
  - does not conform to requirements
  - devoid of distinctive character
  - descriptive - designates the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service
  - customary in language or in trade
  - shape necessary to obtain a technical result
  - contrary to public policy or morality
  - national emblems
- Acquired distinctiveness:
  - Overcome non-distinctive / descriptive objection through submission of evidence of use over a number of years
What can be registered?

- Is it a trade mark?
- Is it distinctive?
- Is it descriptive?
- Is it generic?
- Does it offend?
- Conflicts with earlier rights?

Examination of Application

- Admissibility check
- Absolute grounds check:
  - Descriptiveness objections
  - Distinctiveness objections
- Specification examination:
  - Eliminating vagueness
  - No use requirements
  - Relative grounds check
    - Not in OHIM or UKIPO
Publication and Opposition Actions

- 3 month publication period for Community trade marks
- Provides notice to the world

Purpose of opposition:
- Prevent registration of identical / similar marks
- Ensure distinctiveness of own marks

Advantages of opposition proceedings:
- Cost
- Speed

Grounds for Opposition

- Article 8(1)(a) CTMR:
  - Identity
  - Marks are identical
  - Goods and/or services are identical
- Article 8(1)(b) CTMR:
  - Likelihood of confusion
  - Marks are similar
  - Goods and/or services are similar
- Article 8(5) CTMR:
  - Reputation
  - Use of applicant's mark would take unfair advantage or cause detriment to the earlier mark's repute or distinctive character
Grounds for Opposition

- Article 8(4):
  - National law remedies for unregistered signs used in the course of trade of more than mere local significance
  - UK: passing off
  - Goodwill, misrepresentation, damage
- Article 8(3):
  - Filing by agent without proprietor’s consent
  - Unusual claim

Opposition Procedure

- Notice of Opposition:
  - State application mark, prior rights, claims
- Cooling Off Period:
  - 24 months to allow settlement negotiations
  - Joint consent of parties required
  - Can opt out at any time
- Suspension of proceedings:
  - 1 year suspension to facilitate settlement
  - Joint request of parties required
- Submission of Observations:
  - Legal arguments in support of claims
  - Witness statements + evidence
Opposition Actions

- Vast majority of actions are settled
- Settlement:
  - Withdrawal of application mark
  - Withdrawal of opposition action
  - Letter of undertaking
  - Co-existence agreement
  - Provision of undertakings
  - Limitations and restrictions to specification

Opposition Procedure

- Community Trade Marks:
  - OHIM issues decision
  - Appeals:
    - Board of Appeal
    - General Court
    - Court of Justice of the European Union
- United Kingdom Trade Marks:
  - Trade Marks Registry issues decision
  - Appeals:
    - Appointed Person
    - High Court
    - Court of Appeal
    - Referral to Court of Justice of the European Union
Registration

♦ Mark registered for ten years
♦ Renew every ten years forever
♦ Must use mark as registered
♦ Allowed to use ® symbol
♦ Presumption of validity
♦ Valuable corporate asset

Revocation and Invalidity Actions

♦ Cancellation actions against registered marks
♦ Revocation Actions:
  ♦ Mark not used for five years post registration
  ♦ Mark not used for any five year period after registration
♦ Invalidity Actions:
  ♦ Mark should not be registered on absolute grounds (descriptive, non-distinctive)
  ♦ Mark should not be registered on relative grounds (likelihood of confusion, detriment to reputation)
  ♦ Bad faith
Trade Mark Litigation

- Enforce registered trade mark rights against unauthorised use in civil courts
- Litigation claims:
  - Use of an identical sign for identical goods / services
  - Use of an identical sign for similar goods / services that creates a likelihood of confusion
  - Use of a similar sign for identical / similar goods / services that creates a likelihood of confusion
  - Use of an identical / similar sign to a registered mark with reputation that:
    - Takes unfair advantage of repute of earlier mark
    - Causes detriment to distinctive character or reputation of earlier mark

Jurisdiction and Venue

- National Rights:
  - Sue in Member State where mark is registered
- Community Trade Marks:
  - Article 95 Community Trade Mark Courts:
    - Member States designate national courts to operate as Community Trade Mark Courts
    - Sue in relevant national court
    - United Kingdom: High Court, Patents County Court, Court of Appeal
  - Article 96 Jurisdiction:
    - Community Trade Mark Courts have exclusive jurisdiction over:
      - Infringement actions
      - Declarations of non-infringement
      - Counterclaims for revocation and declarations of invalidity
Jurisdiction and Venue

♦ Article 97 Jurisdiction:
  ♦ Defendant’s Member State
  ♦ Plaintiff’s Member State
  ♦ Spain
  ♦ Where infringement occurred

♦ Article 99: CTM is presumed valid – must challenge by way of invalidity action / counterclaim

♦ Remedies:
  ♦ Injunction
  ♦ National law remedies: damages, delivery up, destruction

Trade Mark Litigation

♦ Defences:
  ♦ Honest use to identify registrant’s goods / services
  ♦ Defendant owns a UK registration
  ♦ Use of own name / address
  ♦ Claimant’s mark is descriptive
  ♦ Claimant’s mark indicates characteristics / intended purpose of goods / services
  ♦ Defendant’s mark is an unregistered earlier right used in a locality
  ♦ Consent given to Defendant to use mark
  ♦ Acquiescence by claimant
  ♦ General defences: laches, estoppel, unclean hands, etc
  ♦ Counterclaims: invalid claimant registration

♦ Remedies:
  ♦ Damages, injunctions, account of profits, etc
  ♦ Delivery up, removal of Defendant’s sign, destruction of Defendant’s goods
Unregistered Trade Mark Infringement

♦ National law remedies
♦ United Kingdom: the law of passing off
♦ Elements of claim:
  ♦ (1) Claimant’s goods or services have acquired a **goodwill or reputation** in the market and are known by some distinguishing feature
  ♦ (2) There is a **misrepresentation** by the Defendant (whether or not intentional) leading or likely to lead the public to believe that goods or services offered by the Defendant are goods or services of the Claimant; and
  ♦ (3) The Claimant has suffered or is likely to suffer **damage** as a result of the erroneous belief induced by the Defendant’s misrepresentation
♦ Must submit evidence to establish goodwill

Anti-Counterfeiting

♦ Customs
  ♦ Council Regulation 1383/2003
  ♦ Register IP rights with Customs throughout EU
  ♦ Enforce destruction of counterfeit goods by way of administrative or court actions

♦ Trading Standards
  ♦ Section 92 Trade Marks Act (UK)
  ♦ Local authorities seize counterfeit goods
  ♦ Liaise with trading standards who pursue criminal actions against counterfeiters and secure destruction of goods
Domain Names

- Function of Domain Names
  - Access to web page / contract with service provider
  - Trade mark / indication of origin of goods and services
- Domain Name Protection
  - Domain name registration
  - Trade mark registration
- Domain Names as IP Rights
  - Assignable
  - Enforceable if operate as a trade mark
- Domain Name Disputes
  - Uniform Domain Name Dispute Resolution Procedure (.com)
  - Dispute Resolution Service (.uk)

Copyright
Copyright – Origins in the United Kingdom

- 1710 Statute of Anne:
  - First copyright statute in world
  - Protected books
- 19th Century copyright statutes
- Copyright 1911:
  - Recognised literary, dramatic, musical, artistic works
- Copyright Act 1956:
  - Expanded to recognise sound recordings, films, broadcasts
- Copyright, Designs and Patents Act 1988:
  - Copyright, performer’s rights, unregistered design right, etc

Copyright in the European Union

- Primarily a national law right
- Some EU-wide protection:
  - Term Directive 2006
  - Rental Right Directive 2006
  - Enforcement Directive 2004
  - Information Society Directive 2001
  - Resale Directive 2001
  - E-Commerce Directive 2000
  - Database Directive 1996
  - Cable and Satellite Directive 1993
  - Semiconductors Directive 1987
Copyright Overview

- Property right that subsists in works identified in CDPA 1988
- 3 types of copyright exist:
  - Copyright to protect authors
  - Moral rights
  - Rights in performances
- Right to control exploitation of work in which right subsists
- Exists in expression of an idea in material form - no copyright in an intangible idea
- No formalities required – eg no registration
- International protection – Berne Copyright Convention & Universal Copyright Convention give reciprocal copyright protection under foreign domestic law

Subject Matter

- Copyright can only subsist in original:
  - Literary works – written, spoken, sung; tables, compilations, computer programs, databases
  - Dramatic works – dance, mime
  - Musical works – music exclusive of words & action; separate copyright in music, lyrics, recording
  - Artistic works – graphic works, photographs, architecture, works of artistic craftsmanship
  - Sound recordings
  - Films
  - Broadcasts
  - Typographical arrangements of published editions
Conditions for Protection

♦ Work falls within statutory definition
♦ Work must be recorded in **material form**
♦ Work must be **original**:
  ♦ Author must have exercised the **requisite labour, skill or effort** in producing work
  ♦ Only for literary, dramatic, musical and artistic works
  ♦ Does not cover entrepreneurial works (sound recordings, films, broadcasts, cable, typographical arrangements)
♦ Work not excluded from protection on **public policy** grounds
♦ Work sufficiently connected with UK for UK law protection – or qualify under Berne Convention

Ownership

♦ Author:
  ♦ Person who creates literary, dramatic, musical or artistic work
  ♦ Author for entrepreneurial works is person who made work possible
♦ Sound recordings – Producer
♦ Films – Producer & Principal Director
♦ Broadcasts – Author, ie person who makes original broadcast, not person relaying broadcast
♦ Typographical Arrangement – Publisher
Ownership

♦ Joint authorship:
  ♦ Work produced by collaboration of 2 or more authors in which contribution of each author is not distinct from that of other author / authors
  ♦ 1. Each of the authors contributed to making of work
  ♦ 2. Work produced through a process of “collaboration”
  ♦ 3. Respective contributions not “distinct” or separate

♦ Work for Hire Doctrine:
  ♦ In absence of agreement to the contrary, where a LDMA or film is made in the course of employment then employer is first owner of copyright
  ♦ 1. Work was made by an employee
  ♦ 2. Work was made during course of employment
  ♦ 3. No agreement to contrary
  ♦ Otherwise author is an independent contractor

Term

♦ Literary, dramatic, musical and artistic works: life in being of author (“LIB”) + 70 years
♦ Sound recordings: 50 years from making
♦ Films: LIB + 70 years
♦ Broadcasts: 50 years from making broadcast
♦ Typographical arrangement: 25 years from publication
♦ Industrially produced designs: 25 years from marketing
♦ Computer generated works: 50 years from making
♦ Foreign works: whichever law (UK or foreign) is shorter
Exclusive Rights

- Section 16 CDPA:
  - Reproduction right (make copies)
  - Distribution right (issue copies to public)
  - Rental or lending right (rent / lend to public)
  - Public performance right (perform, show or play to public)
  - Communicate work to public (broadcast / on demand service)
  - Right of adaptation (make an adaptation or do any of above acts to an adaptation)

Primary Infringement

- Sources of law:
  - Section 17: copying
  - Section 18: issue of copies to public
  - Section 18A: rental or lending to public
  - Section 19: performance, showing, playing to public
  - Section 20: communication to public
  - Section 21: adaptation
- Key considerations:
  - Work is protected in copyright
  - Act is one of primary or secondary infringement
  - No defences apply
  - No consents / licences given
Primary Infringement

♦ Sufficient objective similarity:
  ♦ restricted act applies to \textit{whole work} or \textit{substantial part} of it
  ♦ Infringing work must in some real sense represent claimant’s work
♦ Causal connection:
  ♦ Must show that unauthorised person who committed alleged infringement had \textit{access} to original work
  ♦ Copying must be proved to avoid claim of independent creation

Secondary Infringement

♦ Sources of law:
  ♦ Section 22: importing an infringing copy
  ♦ Section 23: possessing / dealing with an infringing copy
  ♦ Section 24: providing means to make infringing copy
  ♦ Section 25: permitting use of premises for infringing performance
  ♦ Section 26: provision of apparatus for infringing performance
♦ Actual or constructive knowledge is required
Copyright Litigation

- Who may sue:
  - Original owner of copyright
  - Assignee of copyright
  - Exclusive licensee of copyright

- Liability for Infringement:
  - Person who does any of restricted acts without consent
  - Person who authorises others to do restricted acts without consent
  - Person who commits act of secondary infringement with knowledge without consent

- Remedies:
  - Damages, account of profits, injunctions, etc
  - Delivery up of infringing articles

Moral Rights

- Protects non-pecuniary / non-economic interests
- Moral rights:
  - Right of attribution
  - Right of integrity
  - Right to object to false attribution
  - Right of privacy in photographs
- Infringement of a moral right is actionable as a breach of statutory duty
- Moral rights last in work for same length of time as copyright
- False attribution only lasts for life in being + 20 years
- Protects authors rights but some limitation on entrepreneurs
Defences and Permitted Acts

♦ Independent creation
♦ Absence of copyright in claimant’s work
♦ No substantial similarity between works
♦ Fair Dealing Exceptions:
  ♦ Research or private study
  ♦ Criticism or review
  ♦ Reporting current events
♦ Fair dealing factors: amount of work used, status of work reproduced, purpose for copying
♦ Other defences:
  ♦ Making of temporary copies
  ♦ Incidental inclusion
  ♦ Representation of artistic works in public place
  ♦ Time shifting for recording programmes

Defences and Permitted Acts

♦ Limitation of Protection under Section 51 CDPA 1988:
  ♦ No copyright infringement by making article from non-artistic design document
  ♦ ie making an industrial product from a blueprint is not copyright infringement, such as exhaust pipes
  ♦ Immunity from copyright liability if blueprint is a design document and articles are made to the design
  ♦ No copyright claim but a design claim
♦ Limitation of Protection under Section 52 CDPA 1988:
  ♦ 25 year copyright term for artistic works which are basis for designs that are put into mass production
  ♦ Prevent copyright allowing longer protection than for industrial designs (25 year registration)
  ♦ Claimant’s work out of copyright
Anti-Circumvention Devices

- CDPA protects copy-protected forms of works; typically electronic formats
- **Section 296:**
  - Circumvention of technical devices applied to computer programs
  - Circumvention of technological measures other than computer programs
  - Making / trading a device to circumvent copy protection / info re same
  - D must know / have reason to believe device / info will make infringing copies

Commercialisation of Copyright

- Assignment
  - Transfer of ownership
  - Must be in writing and signed by rights holder
  - Oral assignment is ineffective at law
  - Prospective copyright owner (often the author) can make assignments of future copyright
  - Can limit assignment to specific rights, particular territories and formats
- Licence:
  - Retain ownership and grant permission to use
  - Exclusive license must be in writing and signed by rights holder – gives right to sue
Commercialisation of Copyright

♦ Collecting Societies:
  ♦ Handle management and enforcement of rights
  ♦ Administer rights for benefit of authors – collects royalties
  ♦ Safeguard members’ professional interests – sues infringers
  ♦ Act on members’ behalf re use of their works by issuing licences

ANY QUESTIONS?