

MACFARLANES

LOGOS AND NO-GOS



BEST OF 2012

In this briefing, we provide our round-up of the key IP developments during 2012, focusing on trade marks, copyright, databases, designs, breach of confidence and general practice points.

DESIGNS

Samsung Electronics (UK) Limited v Apple Inc [2012] EWCA Civ 1339

Apple fails to convince the Court of Appeal that Samsung's Galaxy Tablets infringe its "cooler" iPad registered design and is ordered to publish a link to the Court of Appeal's judgment and a notice summarising the case on its UK website.

Samsung applied for a declaration that its three Galaxy Tablets did not infringe Apple's iPad registered designs. Apple counterclaimed for registered design infringement. The Court of Appeal (upholding the High Court's decision) held that the Galaxy Tablets did not infringe and produced a different overall impression on the informed user.

Further, the High Court had ordered that Apple publish a copy of its judgment and a summary of the outcome on Apple's website, which order Apple asked to be delayed pending its appeal on the High Court's infringement finding. The Court of Appeal had no sympathy for Apple by the time the case came before it: there was real uncertainty in the market regarding whether or not the Tablets infringed Apple's designs, owing to the confusion arising out of a German pan-European injunction granted in Apple's favour and publicity issued by Apple itself. Therefore, a notice and link to the judgment on Apple's website for 6 months was "necessary" in the Court of Appeal's eyes.

TRADE MARKS

Specsavers International Healthcare Ltd & Ors v Asda Stores Ltd [2012] EWCA Civ 24 [\[click here for previous Logos and No-gos\]](#)

The Court of Appeal holds that Asda's optician marketing straplines took unfair advantage of Specsavers' word mark.

The Court of Appeal held that Asda's two straplines for its optician services ("Be a real spec saver" and "Spec Savings at Asda") took unfair advantage of Specsavers' registered mark. There was, however, no likelihood of confusion. Asda's disclosure, which was examined by the High Court, revealed a clear intention to target Specsavers' marketing and its own marketing straplines therefore took unfair advantage of Specsavers' mark.

Separately, the Court of Appeal has sought guidance from the CJEU regarding: (a) the importance that should be attached to the colour of a trade mark, which although registered without any colour limitation, has become synonymous with that mark, when assessing public confusion and unfair advantage; and (b) whether a graphic device mark can be revoked for non-use if it has been used in conjunction with a word mark.

The "IP Translator" Case (aka Chartered Institute of Patent Attorneys; Case C-307/10)

The CJEU's decision leads to a change to trade mark applications.

The CJEU handed down its preliminary ruling in June to clarify to what extent goods or services covered by a trade mark application need to be identified in order for that application to be valid under the Trade Mark Directive.

The Chartered Institute of Patent Attorneys (CIPA) had applied to register the mark "IP TRANSLATOR" for the general indications of the class heading of Class 41. The application was rejected as the Registrar had interpreted, as guided by the President of OHIM's 4/03 Communication, the application as being for all services in Class 41, which services included translation services. The mark was therefore held to be non-distinctive and descriptive.

CIPA appealed to the Appointed Person, who subsequently referred the matter to the CJEU. The CJEU specified that applications for registrations must identify the goods or services with sufficient clarity and precision, and identify whether protection is sought for all goods or services covered by a specific class heading or only specific goods or services, in which case those goods or services must be identified.

A new e-filing system has been set up to cover new applications for all goods and services covered by a specific class, and Communication 4/03 has been repealed and replaced with Communication 2/12 that echoes the CJEU's guidance.

Leno Merken BV v Hagelkruis Beheer BV (Case C-149/11) [\[click here for previous Logos and No-gos\]](#)

The CJEU fails to clarify whether "use" in one Member State can constitute "genuine use in the Community" of a trade mark across the EU for the purposes of the Trade Mark Regulation.

The CJEU failed to clarify in how many Member States "genuine use" has to be provided by the trade mark proprietor. However, it did confirm that: (a) territorial boundaries are not a relevant consideration when analysing "genuine use in the Community";

and (b) it is up to the referring courts to assess on a case by case basis whether there has been “genuine use” across the EU by considering: (i) the characteristics of the market; (ii) the nature of the goods or services; (iii) the extent of use; and (iv) the frequency / regularity of use. The CJEU’s slightly flimsy conclusion reflects the difficulty it had in reconciling the EU’s aim of achieving a single internal market against the reality that the EU is still fragmented by language, national boundaries and limitations in EU-wide infrastructure.

Starbucks (UK) Ltd v British Sky Broadcasting Group Plc & Others [2012] EWHC 1842 (Ch)

[\[click here for previous Logos and No-gos\]](#)

The High Court holds that companies should not try to obtain un-registrable trade marks by hiding behind fig leaves of embellishment to the mark.

The Starbucks Group (which is unrelated to the coffee company and which provides internet television and mobile services both outside and within the UK) applied to the High Court for an injunction and a speedy trial to decide whether Sky’s use of “NOW” in relation to the provision of television services (NOW TV) infringed the Starbucks Group’s earlier figurative Community Trade Mark comprising the word “now” in lower-case letters with six fine lines arranged in a star or sun shape emanating from the central “o” (CTM). Sky had already applied to OHIM to invalidate the CTM and had sought a stay of the English proceedings, which had been rejected.

The High Court held that the Starbucks Group’s CTM was invalid because it consisted exclusively of signs or indications which may serve to designate characteristics of the goods or services it was providing, and the average consumer would understand “NOW” as a description of the characteristic of the Starbucks Group television service. If the figurative elements of the registration mean that the mark did not consist exclusively of the unregistrable word NOW, the figurative elements did not add anything, and the CTM would be devoid of distinctive character.

Marks & Spencer Plc v Interflora Inc & another [2012] EWCA Civ 1501 [\[click here for previous Logos and No-gos\]](#)

The Court of Appeal holds in M & S’ favour that survey evidence is inadmissible unless it adds “real value”.

The Court of Appeal held that the relevant question regarding confusion was whether or not an internet user would (or would not) perceive that M & S and Interflora were independent. Since the judge was a potential buyer of the goods in question, he would be able to step into the shoes of a user and make up his own mind. Consequently, survey evidence from users was not required. In respect of what adds “real value”, the Court held that survey evidence was not inadmissible as a matter of law in infringement cases, however it identified only a very limited number of situations in which such evidence would be of “real use”. Unless you can fall within one of those exceptions, your survey evidence will not provide any real use to the Court. In respect of the Court’s discretion to permit survey evidence, it held that a Court must be satisfied that survey evidence is valuable and then that its likely use justifies the costs involved.

Most parties, like Interflora, will now have to abandon survey evidence and hope that the judge’s evaluation of the reasonably well-informed and reasonably observant internet user lives up to their expectations.

COPYRIGHT

Temple Island Collections Limited v New English Teas Limited and another [2012] EWPC 1

The Patents County Court finds that even images of the most iconic of scenes can give rise to copyright. If you use a similar effect in your composition, and the result looks substantially the same as another image, you could be infringing someone else’s copyright.

Temple Island successfully sued for copyright infringement of its photograph of a red Routemaster bus against a monochrome backdrop of Westminster Bridge and the Houses of Parliament. The Routemaster photograph attracted copyright due to its visual composition and subsequent manipulation using computer software, which together resulted in the creation of an original visual work. New English Teas was unable to convince the Court that its image (of a red Routemaster bus against a monochrome backdrop of Westminster Bridge and the Houses of Parliament) came from a source other than Temple Island’s own work.

DATABASE RIGHT

Football Dataco Ltd & Ors v Sportradar GmbH & Sportradar AG (Case C-173/11)

The CJEU holds that re-utilisation of data takes place in a particular Member State where there is evidence to show that the performer of the re-utilisation intends to target the public in that Member State.

Dataco organises the English and Scottish Leagues and claimed to have a sui generis right in its 'Football Live' database. Sportradar (a German-Swiss Group) provides UK football results and statistics live via the internet targeted at, amongst others, UK customers. Dataco claimed that Sportradar had infringed its database right by copying Football Live's data, which data was then transmitted to members of the UK public.

The CJEU, upon reference from the Court of Appeal, concluded that Article 7 of the Database Directive must be interpreted as meaning that the sending by a person through a web server in Member State A of data uploaded by that person from a database protected by the sui generis right, to the computer of a person in Member State B (at that person's request) for the purpose of displaying it on that person's screen and storing it in their computer memory constitutes, an act of "re-utilisation" of the data by the person sending it.

The CJEU held that "re-utilisation" will take place in Member State B where there is evidence of intention on the part of the person performing the act to target members of the public in Member State B. This is for the national court to assess but the CJEU indicated that relevant evidence in this case could include the fact that: (a) data sent to UK users included English football data; (b) Sportradar granted rights to companies offering betting services in the UK; and (c) the data was sent in English.

BREACH OF CONFIDENCE

Force India Formula One Team v 1Malaysia Racing Team & Others [2012] EQHC 616

The High Court holds that a breach of confidence claim is unlikely to succeed where information has been handed to third party contractors or employees, which information has become either part of the skill, knowledge and experience of the individuals concerned or is publicly accessible.

The High Court found that Aerolab and Fondmetal Technologies (two defendants) had breached obligations of confidence to Force India with respect to information relating to F1 car designs. The judge held that, to prove breach of confidence, a claimant company must first establish that the information in question is in fact confidential and not publicly accessible or part of the skill, knowledge and experience of the individuals concerned; any features that are readily ascertainable from public sources are unlikely to be considered confidential, whereas features such as specific manufacturing information and dimensions that can only be discovered by a process of reverse engineering are more likely to be considered confidential.

PRIVILEGE AGAINST SELF-INCRIMINATION

Philips v Mulcaire [2012] UKSC 28

[\[click here for previous Logos and No-gos\]](#)

The Supreme Court finds that the meaning of "intellectual property" in the Senior Courts Act 1981 (which contains exceptions to the common law privilege against self-incrimination) does not include confidential personal information.

The Supreme Court analysed the definition of "intellectual property" in section 72(5) of the 1981 Act, which refers to "technical or commercial information" and noted that this definition does not refer to "confidential information" and that not all technical or commercial information is confidential (and not all confidential information is technical or commercial). Although this analysis was not needed on the facts of the case, it clarifies that confidential personal information does not fall within "technical and commercial information" under section 72(5) and so it is not considered intellectual property in this context. As a result, a defendant in proceedings for infringing purely personal confidential information can rely on privilege against self-incrimination, whereas he cannot if the information is of a commercial nature.

PRIZE DRAWS AND COMPETITIONS

Purely Creative Ltd & Ors v Office of Fair Trading (Case C-428/11)

The CJEU holds that where a consumer is led to believe that he has won, or will win, a prize, a promoter cannot make him pay any fees.

The CJEU has ruled that promoters of competitions and prize draws cannot require entrants to pay to: (a) find out if they have won a prize; (b) claim the prize; or (c) take possession of a prize. Telling a consumer that he has won something but then requiring any kind of payment from him creates a false impression, distorts the true meaning of a "prize" (even if the cost is de minimis and there is an alternative free route) and is in breach of the European Unfair Commercial Practices Directive. The ruling confirms the objective of the Directive by ensuring a high level of consumer protection.

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