

Case Law Laboratory

Alicante, 12 June 2017



Case Law Laboratory

Monday, 12th June

08:30 **Registration and breakfast**

09:00 – 09:30 **Introduction and presentation of the Case Law Laboratory by João Negro, Director International Cooperation and Legal Affairs Department, Théophile Margellos, President of the Boards of Appeal and Ursula Schildt, Director of the Academy**

09:30 – 11:00 **Parallel working groups: Topics 1 and 2**

Topic 1 – Non-traditional trade marks

As of 1 October 2017, the requirement of graphic representation will be removed. At first sight this is a bonanza for non-traditional marks. Nevertheless, just what this will mean in practice is still somewhat of an unknown quantity. The non-graphic representation needs to comply with the Sieckmann criteria by being clear, precise, self-contained, easily accessible, intelligible, durable and objective. That will undoubtedly continue to be a challenge for some unconventional signs such as smell marks in the current state of technology. In addition, the newly revamped version of Article 7(1)(e) EUTMR presents a further hurdle for non-traditional marks where they relate to 'other characteristics' of the goods. Yet, some forms of non-traditional marks are likely to prosper under the new regime. The EUIPO already accepts MP3 files for sound marks and service marks are totally unaffected by Article 7(1)(e). While EUIPO's Boards of Appeal previously refused MGM's roar of a lion and Tarzan's yell, these signs have long existed the other side of the Atlantic. The Madrid Protocol means that these signs, when used for services, could be the subject of a valid extension to the EU. This workshop will look at the opportunities that the abolition of graphic representation offers, including overlap with copyright and with discussion on potentially thorny issues such as retail services, priorities and proof of use.

EUIPO panellists:

Mr. Gordon Humphreys, Chairperson of the 5th Board of Appeal

Mr. Arnaud Folliard-Monguiral, Team leader, Litigation, International Cooperation and Legal Affairs Department

External panellists:

Mr. Eli Salis, Partner in Disain IP

Dr. Ralf Sieckmann, Partner in Cohausz Hannig Borkowski Wißgott GbR

Ms. Maria Eugenia Martins de Nazaré Ribeiro, Former Judge at the General Court of the European Union

Topic 2 – Functional trade marks and designs

Both the European Union Trade Mark Regulation and the Community Design Regulation include a prohibition against registering trade marks or designs which are comprised of functional characteristics.

This workshop seeks to explore the intricacies of the prohibition itself when viewed in the context of the differing legal frameworks in which it is expressed, for example by a comparative analysis of its purpose and application. Is that prohibition, for all intents and purposes, the same concept merely implemented in two different pieces of legislation or is there a difference? Are the same purposes pursued in differing permutations in the context of the trade mark and design regulations respectively? And what are the differences (if any) in the underlying interests which define the specific application of that prohibition in the context of trade marks and designs? And finally can jurisprudence regarding trade marks be used analogously to interpret the prohibition within the context of designs and vice versa?

EUIPO panellists:

Ms. Elisabeth Fink, Member of the 3rd and 4th Board of Appeal

Mr. Stephan Hanne, Legal Affairs, International Cooperation and Legal Affairs Department

External panellists:

Mr. Mikael Francke Ravn, Chief Legal Adviser in Danish Patent and Trademark Office

Prof. Dr. Dr. h.c. Annette Kur, Senior Research Fellow and Head of Unit in Max-Planck-Institut für Innovation und Wettbewerb

Mr. Andrea de Gaspari, Partner in De Gaspari Osgnach S.R.L.

11:00 – 11:30 **Coffee Break**

11:30 – 13:00 **Parallel working groups: Topics 3 and 4**

Topic 3 – Disclosure of designs

The issue of disclosure is crucial in design conflicts. Nowadays, establishing disclosure of prior designs is increasingly becoming more related to the Internet and new technologies, which means that litigants rely more and more on Internet printouts, digital pictures, and other similar documentation. The constantly changing and dynamic nature of online content creates challenges in the dating of evidence. Parties are therefore increasingly turning to printouts from the 'Wayback machine' and other Internet archives or repositories. Nevertheless, the law has some difficulty in reconciling, on the one hand, the possibility of using Internet and new technologies for proving disclosure with, on the other hand, the general principle of legal certainty, particularly as regards the date of disclosure and its territorial scope. The divergences in national practice have been considered sufficiently important for the EUIPO and National Offices to have recently included this topic as a dedicated Convergence Programme project. However, in the absence of a common practice, the workshop will bring together multi-jurisdictional experts from within the EUIPO, national IP offices and private practice to examine the challenges faced and consider what solutions could be brought forward.

EUIPO panellists:

Mr. Harri Salmi, Member of the 2nd and 3rd Board of Appeal

Mr Declan Finlay, Seconded National Expert, International Cooperation and Legal Affairs Department

External panellists:

Mr. Shane Smyth, Partner in FRKelly

Avv. Niccolò Ferretti, Partner in Nunziante Magrone Law Firm

Topic 4 – National law rights in the context of Article 8(4) EUTMR

Although less frequently invoked as basis of an opposition or invalidity request, non-registered rights protected by national law in conjunction with Arts 8(4) and 53(2) EUTMR can constitute the only available remedy available to economic operators wishing to protect their acquired earlier rights against conflicting subsequent EU trade marks. Notwithstanding its significance, key questions of this specific field of trade mark law still remain to be clarified. These include the requirements of (i) substantiation before the EUIPO, (ii) use (in particular the relationship between the standards set by EU law and by the applicable national law), (iii) ownership, (iv) the right to prohibit use (and/or registration?) of a subsequent trade mark, as well as (v) the scope of protection afforded by different non-registered rights.

EUIPO panellists:

Mr. Philipp von Kapff, Member of the 1st Board of Appeal

Mr. Dominik Hanf, Legal Affairs Area, International Cooperation and Legal Affairs Department

External panellists:

Ms. Verena von Bomhard, Partner in Bomhard IP

Mr. Imre Gonda, Head of IP Department in Gedeon Richter Plc.

13:00 – 14:30

Lunch

Plenary Sessions

14:30 – 14:50 **Presentation of results and conclusions of Topic 1**

14:50 – 15:10 **Discussion**

15:10 – 15:30 **Presentation of results and conclusions of Topic 2**

15:30 – 15:50 **Discussion**

15:50 – 16:10 **Coffee Break**

16:10 – 16:30 **Presentation of results and conclusions of Topic 2**

16:30 – 15:50 **Discussion**

16:50 – 17:10 **Presentation of results and conclusions of Topic 2**

17:10 – 17:30 **Discussion**

17:30 – 17:40 **Closing remarks**

17:40 **Cocktail**
