McDermott Will & Emery

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ADVERTISING & MARKETING

Film and Video: Implementing Byron Review Recommendations

The UK Committee of Advertising Practice (CAP) and the Broadcast Committee of Advertising Practice (BCAP) have issued Guidance on Advertisements for Video Games and Films. The Guidance is in line with the recommendations made in the Byron Review to help ensure advertisements for video games and films remain responsible and that children are protected from potentially harmful or distressing content.

THE GUIDANCE

The guidance is split into separate issues:

- Content and context: The communications medium (*e.g.*, publication or channel) should be considered when placing an advertisement.
- Age-rated products: Advertisements should be suitable for the medium in which they appear, which is not necessarily reflected by a film or game age rating.
- Time of broadcast: Advertisements should be suitable for the intended audience, based on both the audience figures for broadcast times and the content of the programmes around which it is broadcast.
- Condoning or glorifying violence: Such advertisement content should be avoided.
- The depiction of fighting: Video games and films may involve fighting, which might be reflected in advertisements. Scenes of graphic or realistic violence should be used with caution.
- The realism of violence: Realistic human characters involved in graphic, brutal or sustained violence could be deemed totally unacceptable, regardless of when they are broadcast.
- Graphic depictions of violence: Care should be taken to avoid such depictions (realistic or stylised) in untargeted media such as posters. Consideration should be given to exactly where an advertisement will be placed.
- Violent acts: Care should be taken when implying that a violent act has taken place or is about to take place, even if it is not actually shown.
- Direct or implied violence: Care should be taken with radio advertisements, as the sounds of people in pain, fear or suffering can distress listeners, especially children.
- Shocking images: The use of shocking images in any medium to draw attention to a product should be avoided.
- Guns and weapons: Careful consideration should be given to their depiction.
- The use of nudity: Some nudity is considered to be acceptable if it is directly relevant to the product being advertised. But it is likely to be considered unacceptable if the images are graphic or not relevant to the product or service being advertised. Special care should be taken when using nudity in untargeted media, such as posters, which could be seen by children or by those likely to be offended.
- The use of explicit sexual images and innuendo: Special care should be taken.
- References to drugs: Extreme caution should be exercised to avoid being socially irresponsible or condoning drug use.
- The use of non-game footage: Care should be taken to avoid misleading consumers if an advertisement includes images or sounds that are not representative of actual gameplay.

DATA PROTECTION

Trade Union Blacklists: Ian Kerr Fined and Draft Regulations Published

Ian Kerr, the man behind the company that maintained a blacklist which allowed prospective employers in the construction industry to discriminate against trade union activists, has been fined £5,000 for breach of the Data Protection Act (DPA) 1998. The fine, which has been described as "totally inadequate" by Trades Union Congress (TUC) General Secretary Brendan Barber, provides little or no deterrent for compilers of such lists. However, the Department for Business Innovation & Skills (BIS) has published a consultation paper—The Blacklisting of Trade Unionists: Consultation on Revised Draft Regulations—setting out the UK

Government's proposals to introduce new regulations outlawing the compilation, dissemination and use of trade union blacklists.

BACKGROUND

In 2008, the Information Commissioner's Office (ICO) conducted an investigation into Mr Kerr's company, which revealed that for over 15 years Mr Kerr had been running a database of construction workers containing sensitive personal data, such as individuals' trade union activity, which subscriber firms could consult before deciding whether to offer an individual employment (see Issue 59 of the *European IP Bulletin* (April 2009), pages 9 and 10). In the Information Commissioner's view, Mr Kerr contravened the First Data Protection Principle. However, there are no punishments available for breaches of the data protection Principles, which is why the ICO chose only to prosecute Mr Kerr for failure to notify as a data controller.

Mr Kerr was duly prosecuted, fined £5,000 and ordered to pay £1,187.20 costs. The ICO has also now served Enforcement Notices on 17 construction firms that subscribed to Mr Kerr's database. Formal enforcement action will follow shortly, subject to any representations made by the companies.

DRAFT REGULATIONS

In light of this case, the Government is revisiting a decision taken in 2003 not to legislate against blacklisting.

The BIS consultation seeks views on draft Regulations, which are based on proposals contained in the 2002/2003 consultation on the Employment Relations Act, that would outlaw the compilation, dissemination and use of blacklists of trade unionists and make it unlawful for organisations to refuse employment, to dismiss an employee or otherwise cause detriment to a worker for a reason related to a blacklist. The Regulations would also make it unlawful for an employment agency to refuse a service to a worker for a reason related to a blacklist. Employment tribunals will be empowered to hear complaints about alleged breaches of the Regulations and award remedies based on existing trade union law. As an alternative, the courts will be able to hear complaints from any persons that they have suffered loss or potential loss because of a prohibited blacklisting activity. The Regulations have been drafted in a way that covers both direct and indirect use of trade union blacklists.

Individuals will be entitled to seek compensation through an employment tribunal or the courts. Trade Unions will also, in certain circumstances, be able to take enforcement action, for example against a compiler of a blacklist, in a county court, whilst supporting applications to the tribunal by its members against employers for using the same blacklist. However, individuals will not be able to use the tribunal route to obtain an order requiring the closure of a blacklist or restraining a user from accessing such a list.

COMMENT

The penalty imposed on Mr Kerr reflects the fact that the ICO has limited options for dealing with DPA breaches. The ICO will, however, have the power to impose financial penalties where the DPA has been breached knowingly or recklessly under new Section 55A DPA, which comes into force in April 2009. The type of conduct engaged in by Mr Kerr and some construction firms is likely to incur much heavier fines in future. As for the new Regulations, their scope does not extend beyond trade union blacklists. The power to deal with blacklisting based on other types of data therefore remains constrained.

COMMUNICATIONS & NEW MEDIA

Privacy Impact Assessments After Phorm

The UK Information Commissioner's Office (ICO) has published an updated handbook for Privacy Impact Assessments (PIAs). PIAs are designed to help organisations address any risks to personal privacy before implementing new initiatives and technologies and to ensure that privacy safeguards are built into systems at the outset.

THE PIA HANDBOOK

The ICO published the original version of the PIA Handbook in December 2007 as a response to the loss by HM Revenue & Customs (HMRC) in October 2007 of two CD-ROMs containing 25 million data subjects' unencrypted personal data.

Version 2 of the PIA Handbook sets out the PIA process, PIA screening questions enabling an organisation to decide whether a full-scale PIA should be conducted, a Data Protection Act compliance checklist, an e-Privacy Regulations compliance checklist and privacy strategies.

According to the ICO, the key benefits of a PIA are: identifying and managing risks, avoiding unnecessary costs, avoiding the introduction of inadequate solutions too late in a scheme's development, avoiding loss of trust and reputational damage, the opportunity to inform and seek feedback from stakeholders and meeting and exceeding legal requirements.

The Handbook fleshes out these benefits and lays out the end results of an effective PIA. It concludes by drawing organisations' attention to two sets of privacy risks that a well-structured and implemented PIA can overcome: "Risks to the individual" and "Risks to the organisation".

PHORM

The case involving Phorm, a digital technology company owning behavioural tracking software (Webwise) that anonymously monitors internet users' behaviour as they go from site to site so that advertising companies can better target

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adverts, highlights a potential drawback to PIAs. Webwise tracks internet users' browsing history by assigning an anonymous Unique Identifier (UID) to each user while they are browsing and recording a UID's behaviour on each site by using a duplicate cookie to track user behaviour across the Internet.

In 2006, BT's trial of Phorm's software, launched without informing internet users that they were being monitored, faced objections from campaigners and Members of Parliament on the basis that internet users do not expect to have their movements monitored to enable advertisers to hone their campaigns. Phorm responded that it had commissioned an independent data protection and privacy consultant to carry out a PIA on Webwise, which concluded that Phorm's technology offers a high standard of privacy and data protection.

The ICO commented that the purpose of a PIA is to assess the privacy implications of, for example, new technological systems of processing personal data (such as Phorm's). New technological methods of processing personal data obtained *via* the internet are highly likely to process IP addresses. However, the European Commission, the Working Party, the United Kingdom and other RU Member States disagree currently as to whether IP addresses constitute personal data.

Furthermore, PIAs cannot assess whether a new technological system is in compliance with a Member State's data protection law where that Member State has failed to implement correctly, or monitor, the original EU directive. The European Commission is currently suing the United Kingdom for failing to implement EU data protection law correctly and is citing Phorm as an example of the United Kingdom's failure.

The Commission and the Working Party take the view that, because it is difficult to differentiate between dynamic and static IP addresses and because static IP addresses can become personal data, internet service providers should treat all IP addresses as if they were personal data and should not process such data without the consent of the individuals concerned. Conversely, the German and French courts take the view that just because IP addresses can be personal data should not force organisations to treat all IP addresses as if they were personal data. Phorm argued that it does not process IP addresses. However, it is arguable that UIDs are a Phorm-specific variant of IP addresses—allowing Phorm to track users' behaviour across the internet—posing the same dilemma as IP addresses with regard to whether such "anonymised" number sequences are personal data.

Phorm envisaged their duplicate cookie use as an opt-out. Cookies are site-specific software that allow a website owner to track a user's behaviour on his site. Under the e-Privacy Regulations, cookies are an "opt-out": websites can assign them to users provided each user is given a clear method of rejecting them. However, in a statement issued in April 2008, the ICO commented that Phorm's software must be "opt-in" to comply with data protection law; users must consent specifically to use of such duplicate cookies. Phorm's PIA flagged this ("Best privacy practice would normally be [opt-in]") but perhaps did not stress the point sufficiently.

EUROPEAN COMMISSION SUES THE UNITED KINGDOM

On 14 April 2009, the European Commission announced that it had commenced an infringement challenge against the United Kingdom over privacy and personal data protection in response to complaints by UK internet users and extensive communication with UK authorities about the use of Phorm's behavioural advertising technology.

The Commission stated that there are "several problems" with the United Kingdom's implementation of EU e-privacy and personal data protection rules relating to the confidentiality of communications and prohibiting interception and surveillance without the user's consent. Article 5 of the e-Privacy Directive (2002/58/EC) requires Members States to "prohibit listening, tapping, storage or other kinds of interception or surveillance of communications and related traffic data by persons other than users, without the consent of the users concerned."

COMMENT

The recent controversy over Phorm's software shows that the value of PIAs may be somewhat limited for businesses at the cutting edge of the advertising and communications industries, particularly where the key data protection policy makers (the ICO, the European Commission, and the Article 29 Working Party) disagree on the scope of data protection law and what data is covered, or, in the case of the United Kingdom, where the Government has allegedly failed to implement data protection law correctly.

COMMERCIAL

EU Consumer Rights Reform: UK Policy

A few days after it unveiled its consumer protection White Paper on 2 July 2009 setting out, among other things, proposals for a Consumer Rights Bill, the Department for Business Innovation & Skills published the UK Government's response to the Consultation Document on the EU Proposals for a Consumer Rights Directive. While the Government welcomes reform of the EU consumer protection framework, it makes clear that there are key proposals that it will vehemently resist, as they will erode significantly the rights and protections of the UK consumer.

BACKGROUND

On 10 November 2008 the Department for Business, Enterprise & Regulatory Reform (BERR) published a Consultation on EU Proposals for a Consumer Rights Directive. BERR is seeking views on the European Commission's proposal for a Directive aimed at overhauling and upgrading the existing EU consumer rights regime and at removing the inconsistencies caused by the "minimum requirement" approach to harmonisation under current consumer directives by providing for a fully harmonised regime under umbrella legislation.

More recently, the Government published its consumer protection White Paper, A Better Deal for Consumers: Delivering Real Help Now and Change for the Future which, among other things, discussed the introduction of a Consumer Rights Bill. As the form of that legislation will be shaped by the reforms under the Commission's Directive, the Government's response document published a few days later indicates that the United Kingdom will do its level best to ensure that it is not forced to introduce a bill that in any way diminishes traditional UK consumer protections.

DISTANCE SELLING

In the response document, the Government says that it is "generally happy" with the information requirements in Article 9 of the proposed Directive. It nevertheless expresses concern that the application of the Directive's information requirements in specific areas, particularly financial services, will mean a reduction in consumer protection.

First, the Government is concerned that there is no explicit requirement that information on the right of withdrawal be prominent within the information supplied. The Government believes that this requirement is essential to ensuring that consumers are adequately informed of their cancellation rights. It also considers that there is a strong case for amending the information requirements to require traders to inform consumers who will bear the cost of returning goods in the event of withdrawal. The Directive provides that consumers will bear this cost unless otherwise agreed.

The Government, nevertheless, supports the extension of the withdrawal period to 14 days. The Government suggests that this change is appropriate as part of the package of measures designed to balance the rights and responsibilities of consumers and traders.

The response document also refers to the new provision under the Directive proposing that traders may make a deduction for diminished value of returned goods where that decrease in value is as a result of the consumer handling the goods other than is necessary to ascertain their nature and functioning. The Government harbours concerns about how this provision will operate in practice and sees it as an area that could result in disputes between traders and consumers.

SALE OF GOODS

The Government opposes strongly the removal of the right to reject faulty goods and is "actively seeking an amendment to the Directive" to ensure this right is retained. The Government will also seek an amendment to give the consumer rather than the trader the choice of remedies (repair, replacement, refund).

The Government will also be seeking greater flexibility in relation to the period during which the trader is liable for faults that existed at the time of delivery. The Directive proposes a two year period, while the Government suggests that for complex and expensive products such as cars, it is not unreasonable that where faults appear after two years and it can be proved that the fault existed at the time of sale, the trader should be liable.

UK Definition of Commercial Agent

In *Sagal (trading as Bunz UK) v Atelier Bunz GmbH* [2009] EWCA Civ 700, the Court of Appeal of England and Wales has confirmed that the Commercial Agents Directive 86/653/EEC (the Directive) does not apply to agents who make their own contracts with their customers.

BACKGROUND

The agent and Claimant in this case was Mr Sagal. The alleged principal and Defendant was Bunz, a German company that designs and manufactures jewellery. The parties agreed that Mr Sagal would be the sole UK agent for Bunz. By July 2002, Mr Sagal had launched himself under the trade name "Bunz UK".

Bunz UK took orders from customers, sending out confirmation of purchase orders in its own name. It would then place a purchase order on the Defendant which would invoice Bunz UK at a 20 per cent discount on Bunz's wholesale prices. Bunz UK invoiced its customers requesting direct payment.

On the evidence, the judge in the lower court decided that Mr Sagal had no authority from the Defendant to negotiate or contract on its behalf.

COURT OF APPEAL DECISION

Lord Justice Longmore, giving the lead judgment, turned to the definition of "commercial agent" in Article 1(2) of the Directive:

For the purposes of this Directive "commercial agent" shall mean a self-employed intermediary who has continuing authority to negotiate the sale or the purchase of goods on behalf of another person, hereinafter called "the principal", or to negotiate and conclude such transactions on behalf of and in the name of the principal.

Dismissing the appeal, Longmore LJ considered the limbs of the definition. The first limb envisaged that the agent did not have authority to contract on his principal's behalf but only had authority to negotiate terms. The second limb envisaged that, if the principal did want to make a contract with the customer, the contract would be made directly between the customer and the principal, in the name of the principal. It did not envisage that

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the agent would enter into a contract in his own name with the customer.

COMMENT

Longmore LJ has simplified the lower court's task in determining whether an agent is a commercial agent under the Directive. He also emphasised that the court will be reluctant to find a commercial agency where the principal's name does not appear on the face of the contract. He endorsed the words of the judge of the lower court who said that where the picture presented by the documents was clear, witness evidence about the parties' relationships "was not going to change that clear picture".

Unfair Terms in UK Consumer Contracts

In *The Office of Fair Trading v Foxtons Ltd* [2009] EWHC 1681 (Ch), Mr Justice Mann ruled that the ongoing commission clauses in Foxtons' standard lettings contract with consumer landlords breached the Unfair Terms in Consumer Contracts Regulations 1999 (the Regulations).

The High Court of England and Wales considered terms requiring landlords to pay an 11 per cent renewal commission when the tenant continued to occupy the property after the initial tenancy period expired. This was applicable even if Foxtons played no part in persuading the tenant to stay and did not collect rent or manage the property.

The Court considered whether the terms were expressed in plain and intelligible language and whether they were core terms. Subject to those considerations, it considered whether they satisfied requirement of fairness as set out in the Regulations.

The Court found that, at the stage when the agreement would be signed, the focus would be on getting a tenant found, checked and engaged and it was likely that the consumer would be focusing on that initial term of the engagement. The judge doubted whether the consumer would look to renewal at that stage. Foxtons' publicity material focused almost exclusively on that initial stage of the business relationship. In the Court's view, this was unlikely to engender realisation or acceptance that the renewal commission was part of the core bargain.

In any event, even if the renewal commission might otherwise have been part of the core bargain, in the Court's view it did not escape the fairness consideration because the terms were not written in plain and intelligible language. In particular, Clause 2.14.3 of Foxtons' original terms provided that:

Renewal commission…will also become due where the incoming tenant is a person, company or other entity associated or connected with the original tenant…

In the Court's view, the words "associated" and "connected" would "puzzle even lawyers".

In its revised terms, Foxtons had replaced those words with the expression "nominee", which the Court also considered insufficiently plain or intelligible.

The commission amounts in question were held to be significant and operated adversely to the client the more time went on. Commensurate services were not provided and that, in the Court's view, combined with other factors, gave rise to a significant imbalance.

While a consumer would expect a lot of detail in the "small print", in the Court's view the whole point of "small print" is that it contains things which are not of every day concern to the consumer. The consumer would not expect important obligations of this nature to be buried in small print, with no prior flagging, notice or discussion. This, in the judge's view, was not a fair way to bring the point to the attention of the consumer.

COPYRIGHT

Statutory Damages: Foreign Works and the U.S. Live Broadcast Exemption

In a class action led by the Football Association Premier League (FAPL) and U.S. music publishers Bourne against YouTube and its owners Google (*The FAPL v YouTube Inc.* (US District Court Southern District of New York)) filed on 4 May 2007, a U.S. District Court judge held that, because the FAPL did not register its broadcasts of Premier League matches with the US Copyright Office, it cannot claim statutory damages under the US Copyright Act against YouTube in respect of allegedly copyright infringing material uploaded by users to the video sharing site. The only circumstances in which a claim would have been possible are that, only in relation to live broadcasts, the FAPL gave YouTube 48 hours notice of potential infringement.

STATUTORY DAMAGES

Section 412 of the U.S. Copyright Act prohibits recovery of statutory damages for any work unless the work has been registered before the infringement commenced or within three months of first publication. The FAPL did not register its work. According to YouTube, the FAPL was not therefore entitled to claim statutory damages as its broadcasts were unregistered foreign works. The FAPL's response was that they were entitled to seek statutory damages because all foreign works, as a matter of law, are exempt from any registration requirements under the Act.

U.S. District Judge Louis L Stanton rejected the FAPL's contention and found that section 412 had no exception excusing foreign works from its mandate. It required registration to obtain statutory damages for both domestic and foreign work.

LIVE BROADCAST EXEMPTION

Under Section 411(c) of the Act there is a "live broadcast" exemption. Under this, the copyright owner of a foreign work consisting of sounds, images, or both, the first fixation of which is made simultaneously with the transmission, may obtain statutory damages without registering the work if the copyright owner serves an "Advance Notice of Potential Infringement" on the prospective infringer at least 48 hours before the work is transmitted. Among other things, the Advance Notice must identify clearly each work at issue by title, as well as the date, specific time and expected duration of the intended first transmission of each work, the source of the intended first transmission and the copyright owner of each work. It must also include a description of the relevant activities of the potential infringer which would, if carried out, result in an infringement of the copyright.

The FAPL's evidence showed that it had sent more than 344 Advance Notices by email no less than 48 hours in advance of the live broadcasts of Premier League matches. Statutory damages of up to U.S.$150,000 for each infringement under the Act will be available to the FAPL for infringements of such live broadcasts if liability is established ultimately. Where infringement relates to broadcasts not covered by Advance Notices, damages would be limited to actual loss.

COMMENT

The implications for non-U.S. copyright owners is that they must ensure that either they register the copyright in their works in the U.S. within three months of publication, or, where the work is a live broadcast, that a timely and well drafted "Advance Notice of Potential Infringement" is sent. Failure to do this will limit the range of remedies available to the copyright owners should they need to enforce their rights in the United States.

DESIGNS

Commissioned Community Design: Ownership

In *Fundación Española para la Innovación de la Artesanía v Cul de Sac Espacio Creativo SL and Acierta Product & Position SA* C 32/08 2 July 2009 (unreported), the European Court of Justice (ECJ) has ruled that a person who commissions a design does not acquire the rights in it by virtue of the commission and that those rights remain with the designer unless they are assigned by contract.

BACKGROUND

The Fundación Española para la Innovación de la Artesanía (FEIA) instigated a project called "D'Artes" and appointed AC&G SA to organise the project. AC&G entered into an agreement with Cul de Sac Espacio Creativo SL under which Cul de Sac would develop a design and provide technical assistance to craftsmen under the D'Artes project. Cul de Sac designed a series of cuckoo clocks, which were manufactured by Verónica Palomares and marketed as the "Santamaria Collection". Ms Palomares was not employed by Cul de Sac or AC&G.

Cul de Sac subsequently released a series of cuckoo clocks which it called the "Timeless Collection" together with Acierta Product & Position SA. FEIA considered that the Timeless clocks were a copy of the Santamaria Collection.

FEIA claimed to own unregistered Community design rights in the Santamaria Collection by virtue of its sponsorship and financing of the D'Artes project and the assignment to it by AC&G of the exclusive rights to exploit the products produced as a result of that project. FEIA sued Cul de Sac and Acierta for infringement of the Community designs and for unfair competition.

The Alicante Court held that FEIA could only assert ownership of the Community design if AC&G, which purported to assign such rights to FEIA, had owned the right to those designs by virtue of commissioning them. It referred preliminary questions to the European Court of Justice asking if

1. Article 14(3) of the Community Designs Regulation (6/2002/EC) applied also to Community designs that were produced as a result of a commission and therefore fell outside the employment relationship.

2. Article 14(1) of the Regulation meant that a Community design vested in a designer unless it was assigned by way of contract to someone else.

DECISION

The ECJ held that it was clear that under Article 14(1), the right to a Community design vested in the designer or his successor in title unless that design was created by an employee in the execution of his duties or following the instructions given by his employer. In that case, the design was owned by the employer under Article 14(3).

The ECJ rejected FEIA's submissions that the terms "employer" and "employee" should be interpreted broadly in order to apply also to commissioned designs.

As to the meaning of the phrase "successor in title" in Article 14(1) the ECJ rejected FEIA's submission that the phrase should be given an interpretation broad enough to encompass the various possible means of acquiring a right according to the laws of the Member States.

Accordingly, the ECJ held that Article 14(3) did not extend to Community designs that have been produced as a result of a commission and that Article 14(1) must be interpreted as meaning that the right to the Community design vests in the designer, unless it has been assigned by way of contract to his successor in title.

COUNTERFEITING & PIRACY

EU Customs Action: International Marks

In *Zino Davidoff SA v Bundesfinanzdirektion Südost* C-302/08 2 July 2009 (unreported) the European Court of Justice (ECJ) ruled that a Madrid Protocol mark designating the Community has the same effect as a Community trade mark (CTM) for the purposes of Article 5(4) of the Customs Regulation (1383/2003/EC). The case was referred by a German court relating to the use of Madrid Protocol trade marks as part of the brand owner's arsenal against the importation of infringing goods into the European Community,

BACKGROUND

Davidoff lodged an application with the German customs authorities under Article 5(4) for the border seizure of goods that it suspected infringed 12 of its trade marks, registered internationally under the provisions of the Madrid Protocol. German customs dismissed the application, stating that Regulation 1383/03 related only to CTMs and not to Madrid Protocol marks. Davidoff appealed to the Finanzgericht München, which took the view that Article 5(4) applied equally to Madrid Protocol marks since, by virtue of Article 146 of the Community Trade Mark Regulation (40/94/EC), an internationally registered trade mark that designates the European Community has the same effect as a CTM. Nonetheless, the Finanzgericht München decided to refer the question to the ECJ.

DECISION

The ECJ noted that the Customs Regulation was adopted prior to the accession of the European Community to the Madrid Protocol. However, it found that Article 4(1) of the Madrid Protocol provided that the protection of the mark in each of the contracting states or regions designated by the holder of that mark was to be the same as if the mark had been deposited direct with the intellectual property office of that state or region.

In the light of recitals 1, 6 and 8 of Regulation 1992/2003/EC (which provides for the accession of the Community to the Madrid Protocol), Article 146(2) of the Community Trade Mark Regulation provides that the international registration of a trade mark designating the European Community is to have the same effect as the registration of a mark as a CTM.

Article 5(4) of the Customs Regulation expressly allows only "the right-holder of a Community trade mark", in the context of an application to intervene, to secure, in addition to action by the customs authorities of the Member State in which it is lodged, action by the customs authorities of one or more other Member States.

However, following the assimilation into CTMs of internationally registered trade marks, it must necessarily be accepted that, in conformity with the Community legislature's intention in acceding to the Protocol, the application of Article 5(4) of the Customs Regulation may also be requested by the holder of an internationally registered trade mark.

Therefore, Article 5(4) of the Customs Regulation, in conjunction with Article 146 of the Community Trade Mark Regulation, must be interpreted as allowing the holder of an internationally registered trade mark to secure action by the customs authorities of one or more other Member States, besides that of the Member State in which it is lodged, just like the proprietor of a CTM.

CONFIDENTIALITY

Necessary Quality of Confidence

INTRODUCTION

In *JN Dairies Ltd v Johal Dairies Ltd* [2009] EWHC 1331 (Ch) HHJ David Cooke held that information contained in invoices stolen from the Claimant's warehouse had the necessary quality of confidence for the Claimant to bring an action against its competitor.

C was a wholesale dairy supplying small shops; D1 was in the same business; D2 was an ex-delivery driver of C. It was alleged that D2 had stolen invoices from C's warehouse and passed them on to D1, who then used this information to try to undercut C's prices and take C's customers. D1 denied the allegations and denied liability as the information was not in itself confidential in a commercial sense, or of any value; and/or the prices charged to any particular customer could be easily ascertained simply by asking the customer.

D1 further relied upon *Faccenda Chicken v Fowler* [1987] 1 Ch 117 and the proposition that information that an employee must treat as confidential while employed, but which once learned remains in the employee's head because of his own skill and knowledge, is information that he cannot be restrained from using after his employment ends. D2 did not contest the proceedings.

DECISION

The judge was satisfied that D2 had stolen the invoices and passed them to D1, who then made use of the information to approach and negotiate with C's customers. He was also satisfied that the information in the invoices was of considerable commercial value and possessed the necessary degree of confidentiality. It was not in the public domain, and was ascertainable only from C's records, the knowledge of its employees, or from the customers themselves. Insofar as it was known to C's employees, it was information that it would be in breach of their duty of good faith to their employer to disclose.

The relative ease by which the information could be obtained by legitimate means might be relevant for springboard cases, but it was not in itself a reason for concluding that the information was not at all confidential to begin with.

It was clear that D2 knew that it was C's commercially valuable information when he stole it and that he had no right to obtain it or to pass it on to anyone without C's authority. That was sufficient to impose a duty of confidentiality on D1. When D2 gave D1 the invoices, D1 knew its confidential nature and the circumstances in which it had been obtained. This was sufficient to impose the same duty of confidentiality on D1.

There was no defence under *Faccenda Chicken*; there was no suggestion that D2 had memorised the information contained in the invoices.

COMMENT

The case is a classic example of its kind and demonstrates the potential limitations of arguments based on information retained in an employee's head as part of his skill and knowledge.

TRADE MARKS

Film Titles: Passing Off and Well Known Marks

In BL O-173-09 Fabergé Ltd's application (Danjaq LLC's opposition) 23 June 2009, a hearing officer of the UK Intellectual Property Office rejected an opposition brought by the owners of the rights in the Bond films, Danjaq LLC, against Fabergé's application of 24 March 2005, to register FROM RUSSIA WITH LOVE in relation to watches and jewellery. Danjaq had opposed registration under Section 5(2)(a) Section 5(3) and Section 5(4)(a) of the Trade Marks Act 1994 (the Act).

Although Danjaq is the co-owner of copyright in 21 of the James Bond films, it only sought trade mark protection for the titles of the Bond films (for a wide range of goods) on 29 December 2005 (post Fabergé's application). The only registered trade mark of relevance to the opposition was Danjaq's Community trade Mark (CTM) 004333308 FROM RUSSIA WITH LOVE, registered in relation to computer games, software and related items.

SECTION 5(4)(A): PASSING OFF

Goodwill for Danjaq's production and distribution business was found to be associated with both the James Bond name and the titles of the individual films. In relation to other goods/services, due mainly to the evidence (or lack thereof) before the hearing officer, goodwill was found only to extend to licensing use in relation to watches. There was evidence to show sales of Swatch watches within the United Kingdom bearing the mark FROM RUSSIA WITH LOVE before the date of Fabergé's application, but for other goods under consideration there were no specific UK sales figures.

When addressing misrepresentation, the hearing officer found that, although the words could be descriptive, the common reaction when encountering the sign FROM RUSSIA WITH LOVE would be as a reference to the film. However, he also found that a reference to the film is not the same as the sign representing to the public that the goods are licensed.

The hearing officer noted that the Swatch watches were marketed in conjunction with other Bond signage. For those members of the public who were aware of these watches, there would be no belief that use of FROM RUSSIA WITH LOVE absent such additional signage would indicate licensing from Danjaq. Members of the public unaware of the Swatch watches would know that the film FROM RUSSIA WITH LOVE was an old film and it may appear strange that film merchandising was still being produced. There would again be no indication of licensing from Danjaq and no misrepresentation.

SECTION 5(2)(A): EARLIER MARK

Relying upon their earlier CTM, Danjaq opposed registration under Section (2)(a). The hearing officer quickly dismissed this attack because "from an initial analysis [he could] see no similarity between the goods at issue. The nature, purpose and method of use are all different." In response to the argument that any degree of similarity was good enough, the hearing officer stated that this was no more than clutching at straws.

SECTION 5(2)(A): WELL KNOWN MARK UNDER THE PARIS CONVENTION

The hearing officer was of the opinion that he only needed to address this matter in relation to watches. This ground failed as the volume of sales were found to be too low.

SECTION 5(3): REPUTATION

The hearing officer also dismissed this swiftly. There was no evidence of use of Danjaq's CTM in relation to the goods for which it was registered until after the date of Fabergé's application. The mark therefore could not have a reputation for such goods at the material date.

COMMENT

What is clear is that Danjaq shot themselves in the foot by failing to provide details of sales of many of the goods they were trying to rely upon and, for those that they did, by failing to separate data relating to UK sales from worldwide sales. Their consumer survey evidence was entirely disregarded, as they gave no evidence about the methodology of the survey itself. However, by far the greatest obstacle in Danjaq's path was the fact that they had not sought adequate protection for their valuable intellectual property.

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Film Titles: Trade Mark Function

In *Danjaq LLC v OHIM* T-435/05 30 June 2009 (unreported) the Court of First Instance (CFI) upheld a decision of the Board of Appeal of Office of Harmonization for the Internal Market (OHIM) that a film title is an indicator of artistic, but not commercial, origin and, as such, is not a trade mark.

BACKGROUND

In June 2001, Mission Productions Gesellschaft für Film-, Fernseh- und Veranstaltungsproduktion filed a trade mark application with OHIM for the word mark Dr. No for a wide range of goods.

Danjaq LLC, which owns the intellectual property associated with James Bond, filed an opposition based on its earlier, allegedly well known, unregistered marks Dr. No and Dr. NO based on their use in the course of trade on films, DVDs and associated merchandise. OHIM rejected the opposition and an appeal to OHIM's Board of Appeal was dismissed. Danjaq appealed to the CFI

DECISION

In assessing whether the unregistered marks Dr. No and Dr. NO were well known trade marks, the CFI considered whether these marks had been used by Danjaq prior to the date of Mission Production's application. The Court found that they had not:

… the signs … do not indicate the commercial origin of the films, but rather their artistic origin. For the average consumer, the signs in question, affixed to the covers of the video cassettes or to the DVDs, help to distinguish that film from other films in the 'James Bond' series. The commercial origin of the film is indicated by other signs, such as '007' or 'James Bond' …

The CFI applied the same logic to Dr. No merchandise.

It followed that the signs could not be well known marks within the meaning of Article 8(2)(c) of Regulation No 40/94 and Article 6 bis of the Paris Convention. It was therefore not necessary to determine whether or not there was any likelihood of confusion.

Danjaq also argued that the signs Dr. No and Dr. NO are protected, as distinctive titles of a film pursuant to Article 8(4) of the Regulation and under national laws of Member States that protect the titles of artistic works against the use of a subsequent mark. Sweden and Germany were identified as Member States conferring such protection. However, the Court determined that Danjaq had failed to establish the use of the title of the film Dr. No in the course of trade in Germany and Sweden before the date of Mission Production's application, which could, according to the Court, have been done "without too much difficulty".

The action was therefore dismissed in its entirety.

Technical Marks: "Relevant Public"

In *ERNI Electronics GmbH v OHIM* T-132/08 11 June 2009 (unreported) the Court of First Instance (CFI) upheld a decision of the Fourth Board of Appeal of the Office of Harmonization for the Internal Market (OHIM)l that the word mark MAXIBRIDGE could not be registered as a trade mark for electrical connectors, on the basis that the mark was descriptive and lacked distinctive character.

BACKGROUND

ERNI Electronics GmbH applied to register as a Community trade mark (CTM) the word sign MAXIBRIDGE for "apparatus and instruments for conducting, switching, transforming, accumulating, regulating or controlling electricity" in Class 9 and "rubber insulating materials for power lines, electric switches and connectors" in Class 17.

The OHIM examiner rejected the application on the basis that the mark was descriptive under Article 7(1)(c) of the Community Trade Mark Regulation (40/94/EC) and lacked distinctive character under Article 7(1)(b). OHIM's Fourth Board of Appeal upheld that decision. ERNI Electronics appealed to the CFI.

DECISION

The CFI explained that to be judged descriptive, a trade mark needed to have a sufficiently direct and concrete link with the goods applied for. When considering the descriptive character of a mark made up of a combination of words, as well as considering these elements, it would be necessary to have regard to the impact of the mark as a whole on the relevant public. In this case, the relevant public consisted of specialists in electrical and electronic equipment as well as average consumers who had at least a basic knowledge of such products.

More specifically, following *Citicorp v OHIM* [2005] T 320/03 ERC II-3411, the CFI decided that, bearing in mind that the mark contained two English words, the relevant public would be English speaking, or people with at least a sufficient knowledge of the English language so as to understand the relevant words.

The CFI also stressed the fact that a mark would be rejected if, in at least in one of its potential meanings, it described one of the product's characteristics. Accordingly, the CFI concluded that the term "bridge" was descriptive of one characteristic of the relevant products and the second word, "maxi", only served to embellish that first word by suggesting its importance.

Dismissing as irrelevant the further argument that the mark had already been successfully registered in the United States, the CFI reiterated that the Community trade mark regime was self-contained, independent and designed for the purposes of a specific legal order (see *Messe Munchen v OHIM* (electronica) [2000] T-32/00 ERC II-3829).

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COMMENT

Once more we have a mark for technical goods failing on the basis of descriptiveness. The application was up against a relevant public that is not only tech-savvy, but whose language would be sufficiently technical to encompass a term common in the industry and not only expressed in one of the main Community languages ("bridge") but in translation standard in other main Community languages (the French term "ponter", for example).

PATENTS

Court Of Appeal Upholds SPC On Enantiomer Of Known Racemate

In Generics (UK) Ltd v Daiichi Pharmaceutical Co Ltd [2009] EWCA Civ 646 (2 July 2009), the Court of Appeal has upheld a decision of the Patents Court confirming the validity of a patent and accompanying supplementary protection certificate to an enantiomer of a known racemate.

At first instance, Mr Justice Kitchin concluded that the patent was valid over the cited prior art, and that the SPC was validly granted. He concluded that the patent was inventive over common general knowledge, as knowledge of racemate did not mean that use of only one of the constituent enantiomers was obvious, particularly where that individual enantiomer showed greater efficacy than the racemate, of which the skilled addressee would not have been aware. He also concluded that the skilled addressee of the patent reading the cited prior art would have considered it worthwhile exploring whether the racemate, ofloxacin could be resolved into its constituent enantiomers, and it would not have been obvious that this would be a fruitful exercise. On the SPC, he held that a marketing authorisation for ofloxacin could not be considered as authorisation to market levofloxacin, its negative enantiomer. Since it had required invention to produce levofloxacin, and marketing authorisation was not granted for levofloxacin until 11 years after the patent had been granted, it was just for the defendant to be granted an SPC in respect of that delay. The claimant appealed.

COURT OF APPEAL DECISION

The Court of Appeal upheld the judge's decision in full. It held that Kitchin J's reasoning on the cited prior art was a perfect example of a judge carrying out the balancing task of forming an overall value judgment, and so could not be faulted. As Lord Justice Jacob giving the lead judgment put it: "Only a curmudgeon would say that there is no invention here".

The Court of Appeal also agreed with the approach taken by the judge on the SPC. This case was one in which the underlying research had led to what was effectively a new medicine. The claimant's argument that ofloxacin should be regarded as no more than levofloxacin with an impurity was also rejected. Neither patent law nor the law controlling the marketing of medicines regarded it as such, and there was no reason why the law on SPCs should be different. The claimant sought to rely on case law from numerous non-EU jurisdictions in support of this contention, which was rejected as being concerned with different statutory language, views of the facts and policies.

Obviousness: Commercial Success

In *Aerotel Ltd v Wavecrest Group Enterprises Ltd* [2009] EWCA Civ 408, the Court of Appeal of England and Wales dismissed an appeal from a decision at the High Court in relation to Aerotel's UK patent GB 2171877 (the patent). The patent was also the subject of the *Aerotel/Macrossan* judgment of the Court of Appeal in 2006, the leading case on the patentability of computer-related inventions.

BACKGROUND

Aerotel sued Wavecrest for infringement of the patent, which claimed a method of making pre-paid telephone calls from any telephone, plus the related hardware. Wavecrest counterclaimed for revocation of the patent on various grounds, including lack of patentable subject matter, a lack of novelty and obviousness over numerous prior art citations, and also on insufficiency.

FIRST INSTANCE

At first instance, HHJ Fysh considered that he was not bound by the previous Court of Appeal decision upholding the validity of the patent, owing to the absence of the prior art cited by Wavecrest.

The judge held that the patent was rendered obvious by such systems and that claimed commercial success was of very little importance and could not save the patent. Aerotel appealed against the finding of obviousness.

COURT OF APPEAL

In the Court of Appeal, Aerotel argued that a strong indication of its inventiveness was that the patent had been so commercially successful. However, in this case Jacob LJ found against Aerotel on this point, for two principal reasons.

The first of these was that, whilst Aerotel could point to a number of licences to the patent, these had been obtained as a result of litigation and the threat of litigation in the United States. The judge was of the view that this was unimpressive, as at least from the mid 1990s the U.S. patent litigation scene had become immensely pro-plaintiff and there was no reason to suppose that third parties took licences from Aerotel other than to avoid the considerable risk in not doing so.

The second reason was that, although there was an increasing market in pre-payment telephone cards in the years following the grant of the patent, Aerotel had failed to prove that this was due to the invention claimed in the patent. There were a number of other factors that may have been at work such as the invention could not be used without a tone dialling telephone and such phones were not in widespread use in the United Kingdom at the time. Further, the actual cost of telephone calls had fallen so that the amount of prepayment required to make a worthwhile call had also fallen.

Whilst there may not have been any pre-pay systems on the market at the priority date of the patent (and accordingly the patent was not anticipated by the prior art), the skilled addressee would in all likelihood consider the use of pre-payment because any transaction can only run on credit or pre-payment.

The Court of Appeal therefore found that the first instance judge made no errors of principle and dismissed the appeal accordingly.

COMMENT

It is rare, in the United Kingdom at least, for an argument of commercial success to save what would otherwise seem to be an obvious patent. A patentee must show that the commercial success was itself due to the technical merits of that invention. This will always be a difficult hurdle to overcome, but particularly so in cases such as this where the patent's claimed success is to due to its aggressive enforcement before the courts.

Scope of Know-How and Patent Rights Licences in the United Kingdom

In *Oxonica Energy Ltd v Neuftec Ltd* [2009] EWCA Civ 668, the Court of Appeal of England and Wales upheld a judgment of the High Court. It was found that a licensee under a patent and know-how licence could not use the licensed know-how disclosed to it to develop and sell products outside the jurisdiction of the licence without incurring liability to pay royalties to the licensor. In reaching this conclusion, a distinction was made between what was licensed and what was royalty-bearing.

BACKGROUND

Neuftec invented a fuel additive that improved fuel efficiency and reduced emissions. It filed an application for a patent under the Patent Cooperation Treaty (PCT), which it then licensed to Oxonica. In time, patents were granted under the PCT application, many of which were narrower in scope than the original application as a result of prior art in the individual territories.

Oxonica developed a commercial product based on Neuftec's technology, which it called Envirox. Envirox fell within the claims of the European patents and Oxonica paid royalties to Neuftec. Oxonica then informed Neuftec that it had developed a new product, Envirox 2, which did not fall within the scope of the European patents and that it did not propose to pay royalties to Neuftec on the Turkish sales of Envirox 2.

The agreements between Neuftec and Oxonica stated that a royalty was payable on any product "falling within the scope of claims in the Licensed Application or Licensed Patent." "Licensed Application" meant the PCT application and certain related applications; "Licensed Patent" was defined as "any patent issuing from the Licensed Application thereof as well as foreign counterparts and reissues thereof".

FIRST INSTANCE

In the High Court, the judge held that any product covered by the claims of the PCT application was a product falling within the scope of "claims in the Licensed Application or Licensed Patent." This interpretation meant that Oxonica was liable for royalties on sales of Envirox 2.

Oxonica appealed, arguing that the correct interpretation of the provision was that when and if the PCT application was superseded by a national application, it was the claims of that application that determined whether or not royalties were payable. Once that national application matured into a granted patent, it was the claims of the patent as granted that determined the royalty position. In other words, the position in any country within Oxonica's territory would change over time.

Neuftec put forward yet another interpretation, which was that the phrase "Licensed Application or Licensed Patent" signified alternatives, such that royalties were payable on any product within the meaning of either "Licensed Application" or "Licensed Patent".

COURT OF APPEAL DECISION

The Court of Appeal upheld the decision of the High Court, finding that Oxonica's interpretation of the agreements overlooked the fact that the licence was a patent and know-how licence and that "it offended one's business sense" to say that Oxonica were to get free use of the know-how in every country where there was to be no patent or a restricted patent. The Court of Appeal acknowledged that in such a country third parties would be free to compete with the licensee but held that the payment in this country was in respect of the "flying start" which the know-how gave to the licensee. Competitors, on the other hand, would have to commence their research and development from scratch.

ENTERTAINMENT & MEDIA

Privacy: UK Press Use of Material Posted on Social Networking Sites

The UK Press Complaints Commission (PCC) has upheld a complaint regarding the use by newspapers of material that has been uploaded by members of the public on social networking sites. The PCC adjudication against the *Scottish Sunday*

Express (22 June 2009) demonstrates the Commission's position on the circumstances regarding the acceptable publication of information taken from such websites.

THE ARTICLE

The article, headlined "Anniversary Shame of Dunblane Survivors", reported that the survivors of the Dunblane shooting in 1996 had "shamed" the memory of the deceased with "foul-mouthed boasts about sex, brawls and drink-fuelled antics" posted on their social networking sites.

THE COMPLAINT

The Complainants, parents of the Dunblane survivors, said that the coverage had seriously affected their sons by criticising them and unnecessarily drawing attention to them as Dunblane survivors, including by publishing photographs of them when they had been shielded previously from public view. They stated that the article constituted a serious intrusion into their private lives.

RESPONSE

The *Scottish Sunday Express* argued that the information had been publicly accessible on social networking sites and the identities of the individuals were well known, as they had been named at the time of the shooting. Nonetheless, it did recognise that the tone of the coverage was ill-judged and unjustified and published a lengthy apology.

DECISION

The Commission said that it can be acceptable in some circumstances for the press to publish information taken from social networking sites. It stressed, however, that this is normally when the individuals concerned have come to public attention as a result of their own actions, or are otherwise relevant to an incident currently in the news when they may expect to be the subject of some media scrutiny.

In this case, the Commission stated that, while the boys' identities appeared to have been made public in 1996, they had since been brought up away from the media spotlight. The Commission noted that they were not public figures in any meaningful sense and that the newsworthy event that they had been involved in had happened 13 years previously.

The Commission noted that even if the images were available freely online, the way they were used, when there was no particular reason for the boys to be in the news, represented a fundamental failure to respect their private lives. As such, the Commission concluded that publication was in breach of Clause 3 (Privacy) of the Editors' Code of Practice. It added that although the editor had taken steps to resolve the complaint, and published an apology, the breach of the Code was so serious that no apology could remedy it.

COMMENT

As far as the Commission was concerned, the publication in the *Scottish Sunday Express* represented a serious error of judgement. For editors to avoid such damning censure from the PCC, it is essential that they recognise that strict privacy rules extend to publishing material uploaded by members of the public on social networking sites.

DOMAIN NAMES

Parody, Political Speech and Bad Faith

In *Sutherland Institute v Continuative LLC* WIPO D2009-0693 (10 July 2009) sole World Intellectual Property Organization (WIPO) panellist Frederick M Abbott refused to find bad faith in the use by a group of gay activists of a domain name identical to the service mark of a "conservative think tank" on a parody site. The facts of the dispute did not fall within the non-exhaustive list of circumstances that constitute bad faith under the Uniform Domain-Name Dispute-Resolution Policy (UDRP) and the panellist was reluctant to add to that list in a dispute involving two U.S. parties and a question of political speech which was protected by constitution in the United States.

BACKGROUND

The Complainant, Sutherland, is a non-profit organisation that describes itself as "a conservative public policy think tank committed to shaping Utah Law and policy based on a core set of governing principles".

Sutherland was incorporated in 1994 in Utah and had no registered trade marks but, in 1999, it established a website at www.sutherlandinstitute.org, which it had since maintained. It also claimed federal common law service mark rights in the words SUTHERLAND INSTITUTE.

In February 2009, apparently after a public debate in which the president of the Sutherland Institute, Paul Mero, clashed with member of the public, Nick West, the respondent Continuative (whose administrative contact was Mr West) set up a parody website at www.sutherlandinstitute.com. It had a green background instead of blue, but otherwise mirrored the look and feel of the Sutherland website, including replicating Sutherland's service mark. Continuative included two disclaimers, one of which was a simple statement that it was not affiliated with, endorsed or sponsored by the Sutherland Institute and another that stated specifically that it was a parody.

THE COMPLAINT

Sutherland issued a domain name complaint under the UDRP, alleging that Continuative lacked rights or legitimate interests in the disputed domain name in that it had not used the domain name for a *bona fide* offering of goods or services prior to notice of a dispute. Sutherland claimed that the website was intended to mislead the public and so distinguished its complaint from those under the UDRP which had allowed the use of third party trade marks in identical domain names for the purpose of criticism. Continuative did not file a response.

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THE DECISION

Mr Abbott concluded that Sutherland had established rights in the service mark SUTHERLAND INSTITUTE and that the disputed domain name was identical to its mark. He also concluded that Continuative had not made legitimate non-commercial use of the domain name because of the extent to which the domain name and its website were designed to induce internet user confusion.

However, the Sutherland Institute failed to convince Mr Abbott of the bad faith in Continuative's behaviour. He concluded that, because this proceeding involved political speech, which was strongly protected in the U.S. Constitution, the panel would not, in proceedings involving two U.S. parties, attempt to identify bad faith elements that were not specifically enumerated in the UDRP. He went on to state that, if the right of political speech was to be interfered with based on the incorporation of Sutherland's trade mark in Continuative's domain name, it was preferable that a federal or state court should make that application of the concept of bad faith. Accordingly, he did not order transfer of the domain name.

COMMENT

Treatment of free speech and parody sites has been the subject of much discussion at WIPO, which sees a difference in the way that U.S. and non-U.S. panellists have decided cases involving freedom of speech. This gives rise to questions about the extent to which the UDRP should be influenced by national laws. The panellist in this case was clearly of the view that detailed issues under the U.S. Constitution are beyond the scope of the UDRP.

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