

# European Intellectual Property Review

2016 Volume 38 Issue  
10

ISSN: 0142-0461

## Table of Contents

### Opinions

MARTIN KRETSCHMER, SÉVERINE  
DUSOLLIER, CHRISTOPHE GEIGER  
AND P. BERNT HUGENHOLTZ

#### **The European Commission's Public Consultation on the Role of Publishers in the Copyright Value Chain: A Response by the European Copyright Society 591**

The European Commission consulted between 23 March and 15 June 2016 on the role of publishers in the copyright value chain. This response by the European Copyright Society (1) analyses why an intervention creating a new neighbouring right for publishers is being considered in the wake of recent decisions by the CJEU in *Reprobel* (2015), and the German BGH (2016) in *Verlegeranteil*; (2) examines the rationale for neighbouring rights; (3) advises against double layering of rights; (4) assesses the implications of a neighbouring right for publishers for "open access" policies; and (5) identifies regulatory design flaws in the introduction of an ancillary right for press publishers in Germany (2013) and Spain (2014). In conclusion, it is argued that value generation in itself is not a good case for intellectual property protection, and that the onus of proof needs to lie with the proponents of a new right. They need to show what the costs are, who will carry them, and that the costs are necessary and proportionate; and to provide verifiable evidence.

HUGH DUNLOP

#### **What Now for the Unified Patents Court Following the Brexit Referendum? 595**

The Unified Patents Court is to be a new patents court for European patents and for new "unitary" European patents, established by agreement among 25 EU Member States including the UK. The Cameron Government was at the fore in pressing for the unitary patent and the new court. It was agreed by negotiation that a section of the Central Division of the new court would be in London. This is explicit in the Unified Patents Court Agreement. Now that the UK electorate have voted to leave the EU, a hiatus is created. The court cannot open for business without ratification by the UK, and the other participating states cannot bypass the UK while the UK remains a member of the EU. A burning question among IP practitioners in Europe is whether it might yet be politically possible for a new UK Government to proceed with the project and yet leave the EU. Surprisingly, this may not be such a major dichotomy.

### Articles

DR TESH W. DAGNE

#### **The Narrowing Transatlantic Divide: Geographical Indications in Canada's Trade Agreements 598**

This article evaluates the transatlantic differences over geographical indications (GIs). On the one hand, the EU pursues widespread protection of GIs as a key feature of its international and bilateral trade strategy. On the other hand, the US and Canada resist the EU's approach, opting for the status quo that views GIs as a part of the conventional trade mark law in their domestic law. This article argues that recent trade agreements have achieved a success that eluded parties holding differences along the transatlantic divide in international negotiations.

ANDREA ZAPPALAGLIO

#### **The Exhaustion of Trade Marks in the PRC compared with the US and EU Experience: A Dilemma that still Needs an Answer 610**

The present article focuses on the exhaustion of trade mark rights under Chinese law. It analyses the relevant law and case law, comparing and contrasting them with the European and US legislations. It concludes that the law of the PRC does not regulate clearly the parallel imports of trade marked goods, and argues that this gap must be filled by the law-maker as soon as possible.

ASST. PROF. DR. NOPPANUN  
SUPASIRIPONGCHAI

#### **The Development of the Copyright Exception in Thailand: Where has it Come from, Where is it now under the Thai Copyright Amendment Act 2015, and Where is it Heading? 620**

This article considers the past, present, and future development of copyright exceptions in Thailand. It indicates that several new exceptions were inserted into the Thai Copyright Act 1994 by two Copyright Amendment Acts in 2015, while WIPO Copyright Treaty and copyright provisions in the prospective FTAs with the EU and the US might play an important role in future development.

## Comments

MARTIN SCHAEFER

### **ISP Liability for Blocking Access to Third-Party Infringing Content** 633

In two judgments of 26 November 2015, the German Federal Supreme Court (BGH) ruled on the conditions associated with the obligation of internet service providers (ISPs) to block access to websites providing links to content that is predominantly illegal. The judgments pave the way for website blocking in Germany.

ANDREW HUTCHINSON AND DR  
JANET STRATH

### **Revocation of Cubist Patents for Obviousness: Strictly the Same Invention?** 638

Mr Justice Henry Carr, in the UK Patents Court, held that three European (UK) patents owned by the US biopharmaceutical company Cubist were invalid on grounds of obviousness. An array of legal issues arose, including the law of priority and the strictness of the legal test. In the latter respect, Carr J examined the "same invention" test under art.87(1) EPC and its growing prominence as a factor in the English law. In this case, the underlying facts provided an interesting comparative as the first priority document failed the test, whereas the second passed it. This comment considers the judgment and its implications.

JOHN A. TESSENHOHN

### **FRANK MIURA mauls FRANK MUELLER in Stunning Japan Trade Mark Mêlée** 644

In a surprising decision, the owner of a famous European luxury watch brand was handed an unexpected stunning trade mark defeat by the Intellectual Property High Court of Japan, which held that a junior trade mark registration FRANK MIURA was not confusingly similar with the iconic luxury watch brand FRANK MUELLER. The article will examine the Japanese courts' handling of such parody marks and also review the comparative law position of such parody marks in the EU and the US.

## Book Reviews

653