

# European Intellectual Property Review

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## Table of Contents

### Opinion

EUROPEAN COPYRIGHT SOCIETY

#### **Trade Mark Protection of Public Domain Works: A Comment on the Request for an Advisory Opinion of the EFTA Court: Case E-05/16: Norwegian Board of Appeal for Industrial Property Rights—Appeal from the Municipality of Oslo** 535

This Opinion by the European Copyright Society (“ECS”) commented on a case that pended before the EFTA Court. The Opinion was drafted when the case was pending and was sent to the EFTA court before judgement. The judgment has now been handed down. According to the ECS, the registration of a work of authorship in which copyright protection has expired, especially one that has particular cultural and/or artistic significance, could create an undesirable overlap of protection which could disrupt the objectives and balance of copyright protection. It is arguable that a robust application of the basic principles of trade mark law should be sufficient to protect the public domain. However, there may also be reason to fear that courts may face difficulties in using these doctrines effectively and consistently, so that in certain cases it may turn out that resort to the absolute ground of public policy (art.3(1)(f) of the Trade Mark Directive 2008/95) may be required. Several factors could be used by courts to make this assessment. The exclusion of art.3(1)(e)(ii) and (iii) of the Trade Mark Directive applies to two-dimensional representations of three-dimensional works. The need to preserve competitors’ freedom to use a sign which is descriptive of common or standardised features of an article applies whether those features are described by language, by a three-dimensional shape or by the graphic representation of that shape.

### Articles

RIKARD MIKALSEN

#### **Offshore Patent Protection: The Geographical Scope of Coastal State Patents in the Exclusive Economic Zone and above the Continental Shelf** 543

The effect of national patent law in offshore coastal areas, particularly in relation to foreign ships, is analysed, and national positions for Norway, UK and US reviewed. Some national laws go beyond what is permitted under international law. An awareness of differences in patent scope of protection offshore between major coastal states is important for technology developers and operators.

DR TONY ROLLINS, NICOLA DAGG  
AND STEVEN BALDWIN

#### **The Definition of Product in the SPC Regulation: (Part 1 of 2) What’s in a Name?** 555

Anyone familiar with SPC law will know the importance of the definition of “product” for SPC purposes. “Product” is defined within art.1(b) of Regulation 469/2009 (the SPC Regulation) and plays a central role in the interpretation of that Regulation, in particular as regards the conditions for obtaining an SPC set out in art.3. This article examines how companies have approached the definition of product when applying for SPCs, how the understanding of this definition has developed since the SPC Regulation came into force, and how various courts within Europe (including the Court of Justice of the EU) have dealt with the definition of product. In addition, we provide some proposals for how the definition of product could be amended and a useful historical background to the definition of product in the SPC Regulation.

JOSHUA MARSHALL

#### **Aggravated or Exemplary Damages for Copyright Infringement?** 565

This article will critically evaluate the damages provisions relating to copyright infringement, specifically the award of additional damages under s.97(2) of the Copyright, Designs and Patents Act 1988. The UK courts have held that such awards are a measure of aggravated damages. This article will examine to what extent these additional awards are aggravated damages and, therefore, compensatory. It will be argued that such awards have a closer affinity to orthodox exemplary damages. The practical application by the UK courts reinforces this view.



## Second Medical Indications and the Swiss-Form Claim: Taming Frankenstein's Monster: Part 1—Solving One Problem Creates Another 574

Few patent claim formats present more interpretative difficulties than that of the so-called Swiss form. Taking shape as purpose-bound process claims, i.e. claims directed towards a manufacturing process applied for a particular end, the Swiss form was originally conceived as an attempt to navigate treacherous waters—waters bordered by two seemingly immutable prohibitions on patenting: the excluded, and the old. A jury-rigged solution to a thorny problem, the Swiss-form claim promised to extend patent law's incentives to the discovery of new and useful functions of existing medicaments: repurposing the old to create the new. For inventions known in other fields, inventions with no prior medicinal purpose, a solution had already been given in statute; art.54(5) of the European Patent Convention (EPC) 1973 allowed discovery of the first medical use of a known compound to be claimed as a purpose-bound product. Once, however, a first medical use for was known: that was it. Secondary indications, arguably no less beneficial than the first, were left out in the cold. The Swiss form was devised to bridge this gap: its purpose undoubtedly noble; its proposed effects glittering. However, this virtuous façade conceals a darker underbelly: an underbelly in which the text of the Convention was mutilated and warped, leaving knotty, perhaps intractable, problems in its wake. This then is the story of the Swiss form: of its birth, its execution and the more recent attempts to disentangle the legacy of its creation. The article is split into three parts, each dealing with specific elements of the issue under consideration. This, the first, deals with the adoption of the Swiss claim within the jurisprudence of the European Patent Office (EPO) and the problems associated with the manner in which the Enlarged Board of Appeal (EBA) of the EPO went about instigating protection for claims to new uses of existing medicaments. It considers the fundamental legitimacy of the format and the hiatus in its interpretation that has only recently been broken. In Part 2 we visit the specific issues raised by the regulation of the market for prescription medication in the UK. We also consider some patent law fundamentals that have a bearing on the issues that are picked up in Part 3, when we finally consider the litigation in *Warner Lambert v Actavis* in depth. Parts 2 and 3 will be published in the next two issues of E.I.P.R.

DR SINAN UTKU AND PROFESSOR  
ALAIN STROWEL

## Developments Regarding the Patentability of Computer-Implemented Inventions within the EU and the US: Part 2—Analysis of the Impact of the Patent Eligibility Rules For Computer-Implemented Inventions 582

This article initially examines the rules for subject-matter eligibility of computer-implemented (CI) inventions under the laws applied by the European Patent Office (EPO) and in the US. These rules impose material constraints on the CI inventions that are patentable in these jurisdictions. There do not appear to have been significant changes to the EPO criteria over the last few years; by contrast the interpretation and application of the US criteria have significantly changed during this period. The changes in the US criteria have led to a threshold for patentability of CI inventions that is more similar to that of the EPO's, especially compared with the situation in 2005 when the European Parliament rejected a draft directive relating to CI inventions. Patent quality, however, remains a concern in both jurisdictions. Patent troll activity in the US has increased dramatically, although recent legislative changes may temper this. Although patent troll activity is not yet a large concern in European jurisdictions, the establishment of a Europe-wide court system for patent litigations through the Unified Patent Court may change this. Additionally, this report summarises an empirical study of cloud computing patents that have been asserted in litigation. Using these asserted patents as a dataset, the report investigates, among other things, the relative number of EPO and US patent applications and patents in families of these patents. The detailed analysis of these issues remains outside the scope of the present report.

## Comments

JOHN GROOM, IONA SILVERMAN  
AND BIRGIT CLARK

## Still Lost in the Labyrinth? CJEU Rules in *Filmspeler* that Pre-Loading a Set-Top Box with Links to a Pirate Site is a Communication to the Public 591

The Court of Justice of the EU (CJEU) on 26 April 2017 handed down its eagerly awaited decision in *Filmspeler*. The CJEU held that the sale of a multimedia player (the "Filmspeler" box) which enables pirate content that is available on the internet to be viewed easily and for free on a television may constitute copyright infringement by amounting to "communication to the public" under art.3(1) InfoSoc Directive. Moreover, the CJEU held that the temporary copies of protected works made on the multimedia player when streaming content are not exempt from the reproduction right and interfered with the normal exploitation of those works: cf. art.5 InfoSoc Directive.

MICHAEL CONWAY

## High Court Finds No Trade Mark Infringement or Passing Off in *Argos Ltd v Argos Systems Inc* Internet Ads Dispute 594

In *Argos Ltd v Argos Systems Inc*, the High Court gave judgment on a trade mark and passing-off dispute between Argos UK Ltd, the well-known UK purveyor of household goods, and Argos Systems Inc, a US-based company specialising in CAD software for building design. The case was the first in the UK to consider the approach of *Interflora Inc v Marks and Spencer Plc (No.5)* in relation to keyword advertising in the context of Google ads displayed on third-party websites. The ruling by Richard Spearman QC that no trade mark infringement had occurred has important implications for trade mark owners wishing to take advantage of the marketing opportunities presented by internet advertising while at the same time ensuring that their intellectual property rights are protected.