

European Intellectual Property Review

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Morality and all that Jazz: The Role of Moral Objections in Trade Mark Law—the US Supreme Court decision in *Matal v Tam* 145

Should a morally offensive word or phrase be eligible for protection as a trade mark? There are two schools of thought. Many feel that it should not. Why should a business be able to whip up controversy and clickbait by use of a legal system intended to protect good faith commercial activities? And why should the public be subjected to an onslaught of offensive material in advertising and on the high street? Others take a different view, saying that it is not the role of trade mark examiners to be arbiters of taste and decency. They are not trained for it and should not be required to act as gatekeepers in the realm of freedom of speech. The legal analysis of this question is controversial, and has taken different directions around the world. A recent US Supreme Court decision over the name of Asian American band “The Slants” has brought it into the limelight again. We compare that analysis with the EU position, and conclude that trade mark officials are not the right people to be controlling registration of offensive or disparaging terms.

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Digital Single Market (DSMD) and the accompanying Recital 38 are amongst the most controversial parts of the European Commission’s copyright reform package. Several Members States (Belgium, the Czech Republic, Finland, Hungary, Ireland, the Netherlands and Germany) have submitted questions seeking clarification on aspects that are essential to the guarantee of fundamental rights in the EU and to the future of the Internet as an open communication medium. The following recommendation urges European lawmakers—the Council and the Parliament alike—to consider these questions seriously. In the light of the jurisprudence of the Court of Justice, it offers guidelines and background information with regard to the issues raised by the Member States: the compatibility of the proposed new legislation with the Charter of Fundamental Rights, the relation with the safe harbour provisions in arts 14 and 15 of the E-Commerce Directive, the relation with the concept of communication to the public in art.3 of the Information Society Directive and the objective to compensate authors and performers for the use of their works and performances.

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Recent reports published in Sri Lankan newspapers suggest that local industries (particularly cinnamon producers) have raised concerns about the lack of a registration system for geographical indications (GIs) in Sri Lanka. They have even gone on to suggest that the failure on the part of Sri Lankan authorities and stakeholders to obtain protection of Sri Lankan GIs in other jurisdictions (and in particular the EU) is attributable to the lack of a domestic mechanism for the registration of GIs. Both local industries and academics have made reference to the Indian approach on the registration and protection of GIs and have called for the implementation of a similar system in Sri Lanka. It was in order to address this specific concern and plea that the Cabinet of Ministers by a decision made in October 2016 pledged to amend the Intellectual Property Act 2003 (IP Act), which governs the protection and enforcement of Intellectual Property Rights in Sri Lanka. Yet, contrary to expectations and adopting an approach that is much less comprehensive than the existing legislative approach in India, the proposed amendment to the IP Act merely introduces a single subsection to s.161 that deals with the protection of GIs. Against this backdrop, this article deals with the following points. First, it considers whether the current regime for the protection of GIs in Sri Lanka is sufficient in order to obtain the necessary legal protection for Sri Lankan GIs both locally and globally. Secondly, the article critically assesses the new amendment to the IP Act, comparing it with the Indian approach, in considering its practicality and utility. It is argued that the new amendment adds nothing to existing law.

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There have been a number of academic discussions over the copyright of genetic sequences since early 1970s and 1980s. While most have died down with time, the emergence of new technologies of collecting and exploiting samples, along with the developments in synthetic biology, offer new possibilities in developing treatments for diseases and perhaps even eliminating them. However, some of the traditional issues continue to govern life sciences and biotechnology which requires revisiting the copyright discussions by finding its relevance to the current scenario greater than before.

More than Meets the Eye: Expert Evidence Varies in Intellectual Property Infringement Cases 178

There are a number of differing expert-type issues arising in intellectual property infringement disputes. The expertise can vary significantly across the disciplines of trade marks, patents and copyright, as well as varying significantly within each of these separate disciplines. These are discussed in this article. While generally welcome, there has been some controversy in relation to trade mark experts. However, on closer examination this seems to be linked to the relatively confined issue of expert survey evidence. It does not extend to the many other issues upon which expertise can bring light and assistance to the court in trade mark cases. These expert distinctions are examined in the article, highlighting that there is more than meets the eye. Not only is expert evidence welcomed; even the controversy surrounding survey evidence is not a uniform criticism. Additionally, industrial and technological advances are likely to increase the need for more specialist experts.

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Book Reviews