

Liability of an online marketplace

Liability of an online marketplace for copyright infringements: Dutch appeals court applies the ECJ *L'Oréal/eBay* judgment.

(Article by Micheline Don and Emma de Groot, NautaDutilh, Amsterdam, Netherlands)

Neurim judgment of European Court of Justice liberalises SPC system

In case C-130/11 *Neurim Pharmaceuticals*, the Court of Justice of the European Union (the "CJEU", Europe's highest court), following a reference from the Court of Appeal of England & Wales, issued an eagerly anticipated judgment concerning the availability of supplementary protection certificates (SPCs). SPCs are European intellectual property rights that provide extended protection to patent holders following regulatory delays for medicinal and plant protection products. The *Neurim* judgment has a liberalising effect on SPC law and presents new opportunities for extending patents through SPC filings, although the question as to precisely how widely the *Neurim* ruling should be applied is likely to be explored in future disputes.

(Article by Edward Oates, Carpmaels & Ransford, London, United Kingdom)

"Austin used in 1833 & ever since" trademark deemed misleading in Switzerland for goods not originating from the United States

On 31 July 2012, the Swiss Federal Administrative Court (the "Court") upheld a decision to refuse the registration in Switzerland of the "Austin used in 1833 & ever since" trademark in relation with industrial explosives (class 13), on the ground that it was misleading for goods not originating from the USA (Case B-6402/2011).

(Article by Thomas Widmer, LALIVE, Geneva, Switzerland)

A new copyright work plan for educational purposes at WIPO

On July 25th, 2012, the 24th Session of the Standing Committee on Copyright and Related Rights (SCCR), held at WIPO Headquarters in Geneva, Switzerland, was concluded. The SCCR-members agreed on a comprehensive work plan for the next three years to further discuss steps towards an international approach regarding the following subjects: limitations and exceptions for visually impaired persons and persons with print disabilities (scheduled for 2013); protection of Broadcasting Organizations (2014); limitations and exceptions for libraries and archives (2014); and, limitations and exceptions for education and research institutions (2015). No agreement has yet been reached regarding the appropriate legal instrument.

(Article by Matthias Gottschalk, Secretary, Copyright Committee (Q226), Zürich, Switzerland)

Transitioning from Inter Partes Reexamination (IPX) to Inter Partes Review (IPR) Under the AIA: Highlights of the USPTO IPR Final Rules

The new *Inter Partes Review* provision of the America Invents Act becomes effective September 16, 2012, applying to patents issued before, on, or after said date. The USPTO recently published final rules for these proceedings, including setting an IPR petition filing fee of \$27,200 for up to the first 20 claims. The threshold for institution of IPR proceedings will be establishment of a "reasonable likelihood that the petitioner would prevail with respect to at least one of the claims challenged in the petition," requiring a showing that the claims lack novelty or are obvious over patents or printed publications only.

(Article by Anne L. St. Martin, Oblon, Spivak, McClelland, Maier & Neustadt, LLP, Alexandria, U.S.)

Feedback **The AIPPI Yearbook 2011 has been published.**

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(AIPPI General Secretariat)

Any comments you have as members are invited and welcomed. Please let us have your input on this e-News or on anything relating to AIPPI by e-mail to enews@aippi.org.

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“Austin used in 1833 & ever since” trademark deemed misleading in Switzerland for goods not originating from the United States

Thomas Widmer, LALIVE, Geneva, Switzerland

The US-based “Austin Powder” company sought to register in Switzerland the following trademark in relation with, inter alia, industrial explosives: https://www.aippi.org/enews/2012/edition26/images/Thomas_Widmer.jpg

This trademark, which had been accepted by the US Patent and Trademark Office (USPTO) as well as by the EU’s Office of Harmonization for the Internal Market (OHIM), was rejected by the Court for the following reasons:

First, the Court considered that, as a rule, when a trademark comprises a geographical place, it causes the consumers to believe that the products commercialised under that trademark originate from the country to which it refers. In other words, a geographic place is considered as an indication of source.

Second, when a term can be understood both as a geographical place and as (for instance) a first or family name, it has to be determined which meaning is predominant. If there is no predominant meaning and the term remains equivocal, there exists a risk that consumers will understand the term as an indication of source.

By way of example, the Court considered in a previous decision that “Victoria” referred predominantly to a first or family name, and not to the Canadian city of the same name (Cases B-6562/2008 and B-3381/2010). In another case, “Louis Boston” was also found by the Court to refer predominantly to a first or family name and not to the US city since the first name “Louis” preceded the term “Boston” (Case B-6222/09). Similarly, the device trademark “Phoenix” accompanied by the image of a bird would be considered to refer predominantly to the mythical bird and not to the homonym US city (example given by the Swiss Institute of Intellectual Property).

In the case at hand, the Court held that, in the absence of a clear indication in the trademark at issue that “Austin” referred to a family name and not to the capital of the US State of Texas, there exists a risk that consumers might believe that the industrial explosives originate from the US.

Third, the argument that said industrial explosives are purchased by specialists who are familiar with the “Austin Powder” company and, thus, are aware that “Austin” refers to a patronymic and not to a geographical place would, in the Court’s view, only have been relevant had the trademark at stake been filed as a trademark having acquired a secondary meaning (in French, a “*marque imposée*”), which was not the case here.

Fourth, the Court held that “Austin” did not fall under the exceptions provided for by Swiss case law according to which a geographical place is not considered as an indication of source if, for instance, it has a purely symbolic character (such as “Etna” [an Italian volcano] for bunsen burners [Case 117 II 321] or “Alaska” for menthol cigarettes [Case 4A.5/94]), or if it refers to a place from which the goods manifestly cannot originate (such as “Mont-Blanc” [the highest mountain in the Alps] for pens [Case MA-AA 09-12/05, *in Sic!* 2007, 211]).

As regards the latter exception, the Court ruled *in casu* that it was not inconceivable that the average consumer would assume that industrial explosives originate from Austin, Texas, even though this was unlikely for certain specialists in the field, as there are no significant resources to be mined in the region.

As a consequence of the above, the Court confirmed the Swiss Institute of Intellectual Property’s decision that the litigated trademark could only be registered in Switzerland if it was limited to *industrial explosives originating from the US* – which was not the case.

In this respect, the Court, regrettably, did not explicitly consider the appellant’s argument that such a limitation could not be applied as it would be unclear how and under which law the notion of “originating from the US” would be interpreted.

The Court’s decision is not final as it can still be appealed to the Swiss Supreme Court.



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