

## The European IP Bulletin

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## Hot Topics

### 1. NORWAY PROPOSES NEW DIGITAL COPYRIGHT LAW

The Government of Norway has recently proposed a new copyright law intended to bring Norway's law in line with the European Union rules. Although Norway is not part of the European Union (EU), it is bound by the latter's directives through the European Economic Area Agreement.

The proposed digital law, which could be in place by 1 July 2005, will make it illegal for Norwegian music fans to transfer music from one medium to another, or circumvent the anti-copying protection used in new CDs and DVDs. The provision of software or hardware which could be used to circumvent the anti-copying protection will also be illegal. The new law will, however, allow the users to overcome the security codes if the copying is for private use and involves the same format. In other words, users will be allowed to copy a disc onto another disc, but it seems doubtful they will in future be able to transfer their content from one format to another, for instance make copies from one's own CDs to an MP3 player. If acts which are currently allowed under private use which do not restrict the copying to one format, may become illegal. The proposal sets out fines and a maximum penalty of three years imprisonment for those caught under the new law.

The proposal comes in the wake of a ruling by a Norwegian Court acquitting a defendant accused of violating the laws by using the DeCSS program to overcome security codes on his DVDs. In that case, the Court held that the defendant was within his rights to make or use a tool to circumvent codes embedded within his property for private use.

The proposal has received mixed reactions from industry, users and some academics. It raises particular issues for users wishing to copy content which they have legally purchased from one format to another for their own personal use and is thus likely to face serious opposition.

### 2. THE GAME GROUP PLC V GARTH SUMPTER

On 18 January 2005, one of Nominet UK's Dispute Resolution Service Independent Experts gave his decision in the matter of The Game Group plc v Garth Sumpter.

The decision relates to a domain name dispute concerning the domain name "Game.co.uk". The issue for expert determination was whether a change of use by Garth Sumpter (the "Defendant") of the domain name Game.co.uk had become an abusive registration because it was being used in a manner which took unfair advantage of or was unfairly detrimental to The Game Group plc's rights. The issue in the case was a combination of paragraphs 1 and 2(a) of the Nominet registration policy, which set out the requirements for abusive registration.

The Game Group Plc, through various changes of name, had built up a very successful business, both in retail and over the internet, selling computer games and associated hardware. Its domain name was Game.net. The Game Group plc established that it had significant and sufficient goodwill in the domain name 'Game'.

Conversely, the Defendant's business was originally that of an IT management consultancy with particular emphasis on games software. It was effectively a B2B business. From time to time, there had been discussions between the parties about

the possibility of The Game Group plc buying the Defendant's domain name, but this came to nothing because the price requested was too high.

From about 2002, the Defendant changed the nature of its business from consultancy services to being an internet vendor of games software and hardware. Although it was only a small business, the expert found that there was sufficient evidence of confusion such that an English passing off action could probably be maintained. There was evidence of confusion both from the public (although limited) and from the trade, where a number of journalists picked up the wrong website when referring to the business of The Game Group plc.

Due to the large volume of trade which The Game Group plc had through its website Game.net, it was able to establish that it had rights in the domain name "Game" and that, as from 2002, the change of business of the Defendant had caused the registration to become abusive. One argument which the Defendant employed was that the name Game was generic. It was held that this was not so; it had become distinctive. Further, it was shown both by the earlier use as a consultancy and by independent use by a third party, HASBRO, who had the domain Game.com, that it was possible to use the name Game in a different way without creating confusion.

A further factor, although not conclusive, was that the Defendant had offered to sell the domain name Game.co.uk to The Game Group plc for a sum of money which was significantly larger than the acquisition cost. However, the argument that the Defendant's pricing of the website was in itself a matter which made the registration abusive was rejected because it had not been the Defendant's plan from the outset to sell the domain name. This was only something which developed over time.

One further matter which was taken into account was the failure of the Defendant to put its evidence under a declaration of truth. Although that was a procedural defect, the independent expert commented that this failure devalued the Defendant's evidence. However, at no time did he suggest that he was rejecting such evidence.

Accordingly, the independent expert required the Defendant to transfer the domain name Game.co.uk to The Game Group plc. An appeal is pending.

## Copyright

### 3. HARRY POTTER IN THE US ARMY

Representatives of Harry Potter author, JK Rowling, have been investigating a Harry Potter look-alike comic published by the US Army, featuring characters similar to those in the Harry Potter books and films.

The comic, which appeared in US Army magazine, *The Preventive Maintenance Monthly*, a US Army training manual, shows the regular hero of Preventive Maintenance, Sergeant Half-Mast, arriving at Mogmarts School of Magic, instead of Hogwarts School of Magic, and being greeted by a Professor Rumble-Doore, instead of Professor Dumbledore. The manual also features a Professor Snappy, whose drawing resembles actor Alan Rickman, who plays Professor Snape in the Harry Potter movies, and a band of students including Topper, who looks like Harry Potter, and a Miss Ranger (instead of Hermione Granger).

Neither JK Rowling nor her representatives were approached for permission. Both JK Rowling and Warner Bros have taken protection of their intellectual property rights very seriously. Indeed, there have been several earlier legal actions to protect copyrights in respect of the Harry Potter books and stories, including an action

against the New York Daily News for copyright infringement after the tabloid published excerpts of Rowling's fourth book, "Harry Potter and the Order of the Phoenix", and a Dutch Court decision, which prohibited the distribution of 7,000 copies of a book by Russian author, Dimitry Yemets, entitled "Tanya Grotter and the Magic Double Bass", which was held to infringe copyright in Rowling's first Harry Potter book, "Harry Potter and the Philosopher's Stone".

It remains to be seen whether the alleged infringement by the US Army magazine will be considered to be a parody, or plagiarism and unauthorised adaptation, which could violate applicable copyright and trade mark laws.

According to a US Army spokesman, each issue of the magazine is reviewed by the aviation and missile command legal office, which concluded that "there was nothing done that was impermissible, that the illustrations were clearly in the scope of parody and that, therefore, there was no need to seek permission from JK Rowling".

In the US, there is no specific legal provision concerning parody and the provisions of section 107 of the Copyright Act may apply, which provide that "the fair use of a copyright work [...] for purposes such as criticism [...] scholarship or research is not an infringement of copyright". In the UK, general principles concerning infringement and fair dealing will apply, and the general approach of the Court is usually to ascertain whether a substantial part of the plaintiff's work has been reproduced in the parody. However, the defendant would not be deemed not to be guilty of copyright infringement because his work is a parody, or because there has been skill and labour invested in making the parody. The plaintiff may claim that the making of the parody has infringed his moral rights of attribution and integrity, as well as infringing copyright.

#### **4. ITALIAN DJ RECEIVES RECORD FINE FOR MP3 PIRACY**

Italian authorities have shown their commitment to fighting the violation of copyright after the Italian Fiscal Police carried out a raid and seized a large quantity of material without the SIAE watermark (the identification tag used to recognise authorised copies of copyrighted material).

An investigation leading up to the raid had discovered that a DJ from Rome was using around 500 video clips and more than 2000 mp3 files during his performances in a club in Rieti. Subsequently, an administrative fine of €1.4m was imposed on him. The fine is the largest recorded penalty to be imposed on an individual for music piracy in an European jurisdiction.

The case is significant due to the magnitude of the sanction. The decision shows that the Italian legislature has chosen to adopt a stricter approach to the issue of illegal downloading and copying of musical content, and peer to peer related prosecutions against individuals are now an established reality not only in the US but also in Europe.

#### **5. NEW DVD ANTI-PIRACY MEASURES**

On 15 February 2005, Macrovision, the copy protection company, announced that it had devised a new anti-piracy measure to make it more difficult for DVDs to be copied. The new "RipGuard" protection will work by blocking programs that enable 'ripping' (copying) by making the program crash.

The illegal copying and distribution of DVDs has been a major problem for the film

industry since the current copy protection was hacked more than five years ago. It is estimated that between 20 to 30% of the DVD market is made up of pirated copies. This new technology aims to defeat the various forms of DVD piracy, which include the production and reduced price sale of hard copies, peer to peer file sharing via internet sites, and also the process of 'rent, rip and return'- where people would rent a DVD, copy it and then return the original, thus enabling them to reproduce the film on many occasions for considerable profit.

Macrovision has stated that this technology will thwart most, but not all, of the current DVD ripping programs used to pirate DVDs. Whilst these measures will obviously reduce the amount of illegal copying, it is possible that those who make a considerable profit from piracy, thereby affecting the revenue of the film industry, will merely seek out the devices which are unaffected by the protection and use these to continue their business.

Macrovision has said that RipGuard can be updated if hackers find a way around the new anti-copying measures. Time will tell how successful the measure is.

## Designs

### 6. DYSON VACUUMS UP THE SECONDARY MARKET

In the *Dyson v Qualtex* [2004] EWHC 2981 (Ch) decision of 21 December 2004, Mann J provided a useful review of the law of unregistered design right.

The action was a claim by Dyson for infringement of its unregistered design right which it claimed in respect of a number of parts for its vacuum cleaners, copies of which were made by Qualtex for use in Dyson vacuum cleaners. Qualtex was one of the UK's leading suppliers of spare parts for domestic appliances. It sought to defend its position by claiming that the parts could not be protected under the Copyright Designs and Patents Act 1988 (CDPA) as they were not original and they were commonplace. Qualtex also argued that the purpose of the 'must fit' and 'must match' exceptions was to protect spare parts manufacturers, and therefore the exceptions should be construed in its favour accordingly.

Mann J disagreed with the submissions put forward by Qualtex. He ruled that Qualtex had infringed the 14 unregistered design rights belonging to Dyson by copying each of the parts which were the subject of the action.

Mann J held that the wording of the 'must fit' exception did not have to be construed particularly narrowly or widely. It did not matter if there was more than one way of achieving the fit between the subject article and the one to which it is fitted: if the design chosen is a way of achieving that fit, then regardless of how many ways of achieving that fit are available, there is no design right in the connecting part. It was insufficient for a defendant to use the must fit exception successfully to argue that the design features of an article merely enabled it to be connected with another. It had to be proven that the features allowing the fit also allowed the article to perform its function.

Qualtex also argued that the design right protection had commenced on Dyson's marketing of a prototype. Section 216 of the CDPA sets the term of the design right at the lesser of 15 years from the end of the calendar year in which the design was first recorded in a design document or an article was first made to the design, whichever occurred first, or if articles made to the design are made available for sale or hire within five years from the end of that calendar year, 10 years from the end of the calendar year in which it first occurred.

Again, Mann disagreed. He accepted Dyson's argument that "making an article available" implied capability to satisfy orders from customers.

Finally, Qualtex argued that Dyson was estopped from asserting its rights since they had knowledge of the sales of the parts and had encouraged the continued sale by standing by and not taking action immediately.

Mann J held that mere acquiescence or inaction was no bar to Dyson maintaining breach of design right. Rather, knowledge must be actual knowledge at an appropriate corporate level. Qualtex had argued that the practice in the industry was to be aware of new suppliers of spare parts, but the facts showed knowledge at Dyson only at the level of a marketing account manager. Mann J considered that even if Dyson had objected, Qualtex would have continued to manufacture to force Dyson to take action, therefore no detriment flowed to Qualtex. Central to the facts of the case was Qualtex's claim that it was following the industry-recognised practice of 'testing the water' with the introduction of its rival parts on to the market. Mann J brushed this aside. Qualtex was merely trying to establish a new "estoppel by entrapment".

As a result, manufacturers considering the introduction of potentially infringing products onto a market must be aware of the extensive rights that might exist in spare parts and the precise duration of those rights.

## Patents

### 7. MAYNE PHARMA V PHARMACIA ITALIA

On the 17 February 2005, the Court of Appeal gave its judgment in *Mayne Pharma PTY Ltd v Pharmacia Italia SPA*, [2005] EWCA Civ 137.

In May 2004, Mayne Pharma commenced proceedings for a declaration of non-infringement of Pharmacia's UK patent, which was followed by a counterclaim for infringement. The judgment at first instance, given in November 2004, found that there was no infringement. That decision was appealed.

The case was one of the first (and the first in the Court of Appeal) to consider the issue of construction of patent claims following the House of Lords' judgment in *Kirin Amgen v Transkaryotic Therapies* [2004] UKHL 46 ("Amgen") in October 2004. Notably, it was agreed between the parties, consistent with Amgen, that the "protocol questions" set out in Improver would not assist in the construction of the patent. In this particular case, this meant considering how a claim requiring the absence of a particular step should be interpreted.

The invention related to a solution incorporating a widely used anti-tumour agent, Epirubicin hydrochloride. In prior art systems, it was conventional for Epirubicin hydrochloride to be supplied in ampoules in lyophilised (freeze dried) form which were subsequently made up into an injectable solution immediately prior to use. This was due to the instability of the drug in solution, but the process carried the serious danger of accidental contact for the healthcare professionals at the time of making up the solution. The invention provided a stable solution, which avoided any process of reconstitution and associated dangers.

The dispute centred on the interpretation of the first claim: "An injectable, ready-to-use, sterile [...] solution which has not been reconstituted from a lyophilisate...". The Mayne Pharma product was a ready-to-use solution which was prepared using material that had, as part of its history in the preceding steps, been subject to lyophilisation. Thus, was the use of a lyophilisate in an earlier stage of preparation

was sufficient to take Mayne Pharma's product outside the scope of the claim? Mayne Pharma relied on a subsequent process claim setting out that the formation of the solution should be with a non-lyophilised material, followed by some additional steps.

Lord Justice Jacob, referring to the principles of construction contained in article 69 of the European Patent Convention, held that the skilled person would understand that the invention was concerned with how to achieve a stable, ready-to-use solution that could do away with the previously essential step of lyophilisation. He would know that the solution, in accordance with the invention, had not been made by reconstitution ~~a~~ all (whether using a lyophilisate or not). Thus, the Mayne Pharma product fell within the claim when construed in a manner consistent with the inventor's purpose as disclosed in his specification. Lord Justice Jacob rejected the subsequent process claim argument as there was no nexus between the scope of the two claims that would suggest that the product claim was necessarily as narrow as the process claim. Pharmacia Italia's appeal was allowed.

This case is particularly significant from a practitioner's point of view as it proceeded by agreement under the streamlined procedure of the Patents Court to provide both a first instance judgment and an appeal judgment in the space of nine months. The fact that the only substantive dispute was one of construction meant that the case was particularly suitable for this procedure, in which there is limited provision for disclosure, expert evidence and cross examination. Given the comments of some of the judiciary in recent cases relating to the high cost and delays associated with patent litigation, it is likely that more and more cases are likely to follow this type of streamlined procedure.

## 8. OBVIOUS TO TRY? THINK AGAIN!

On 25 February 2005, the Court of Appeal pronounced its judgment in the case of *Saint Gobain PAM SA v Fusion Provida Limited & others*. [\[2005\] EWCA Civ 177](#).

The issue in the case was whether the European Patent granted to *Saint Gobain* was obvious, and therefore invalid in light of prior art.

The patent related to an external coating technique for buried iron-based pipes, which uses a zinc/aluminium alloy in the place of zinc, to enhance the life of buried pipes by several years as the coating limits the damage caused by diverse soil conditions. Fusion Provida argued that this was obvious on the basis of prior art described in an academic paper written by Johnsson in December 1998, entitled "Corrosion resistance coating of Al, Zn and their alloys", published before the priority date of patent.

The Court of Appeal highlighted the duties of an appellant court as laid down in *Biogen v Medeva* before agreeing with Justice Pumfrey's evaluation on the question of obviousness. In that case, it had been held that an appellate court should be very cautious in assessing a factual evaluation of the judge at first instance, since an assessment of obviousness was not a question of principle, but rather a matter of degree, and specific findings of fact in the judgment, even by the most competent judges, could be inherently incomplete statements of impression made on them by the primary evidence.

The Court of Appeal held that despite the fact that there existed a common general knowledge of the use of zinc/aluminium alloys in the place of zinc as an anti-corrosion coating for above-ground and marine pipes for years, no-one had tried it

on buried pipes. The reason was due to a different sort of damage suffered by buried pipes, namely the formation of white rust both under the outer layer and as a scab on damaged areas. The earlier paper by Johnsson was silent on the problems faced by buried pipes, and thus would not have encouraged a trial of such techniques by a person skilled in the art. Thus, viewed in the light of these historical considerations, the patent was far from being obvious.

The Court further stated that for an obviousness attack to succeed, the prior art should provide more than a mere possibility of inclusion of something within the research programme of a person skilled in the art. It should be more-or-less self-evident from the prior art that what is being tested ought to work and in assessing such a scenario, historical considerations cannot be left out and will form an integral part of the evaluation process. This reasoning appears more logical as it provides a better evaluation of prior art in the contextual framework rather than from an abstract viewpoint.

#### **9. CONSULTATION ON COMPULSORY LICENSING OF PHARMACEUTICAL PATENTS FOR EXPORT TO COUNTRIES WITH PUBLIC HEALTH PROBLEMS**

On 1 March 2005, the UK Patent Office sought to solicit views from interested parties on the European Commission's proposal COM(2004) 737 for a "Regulation on compulsory licensing of patents relating to manufacture of pharmaceutical products for export to countries with public health problems".

The draft Regulation proposed by the European Commission will allow EC-based generic manufacturers to produce generic versions of patented drugs for export to countries with insufficient manufacturing capacity. Under the World Trade Organisation (WTO) Trade Related aspects of Intellectual Property Agreement (TRIPS), developing countries unable to produce generic drugs locally find it difficult to import cheap medicines. This is because Article 31(f) of the agreement requires that compulsory licences are granted "predominantly for the supply of the domestic market".

The WTO Decision of the 30 August 2003 addressed this issue by allowing national authorities to grant compulsory licences for export to these developing countries. The European Commission's proposal is intended to create the regulatory framework for this system to operate in the European Union Member States, and therefore prevent distortion of competition which might arise through divergent national approaches and, in particular, prevent re-importation into the Community of goods produced under these compulsory licences. Therefore, the UK Patent Office is collecting the views of all interested parties on the aspects of the proposal, including the following:

- The licences will be based upon applications by those wishing to produce the pharmaceuticals, who must show clear evidence that they have received a specific request from an eligible country to supply a certain amount of the product required. In order to be eligible, a country must be a member of the WTO that either qualifies as a "least-developed" member, or has notified the Council for TRIPS of its intention to utilise this system.
- Applicants must prove that they have "made efforts to obtain authorisation from the right holder on reasonable commercial terms". National authorities are competent for determining the length of the "reasonable period of time" during which such efforts must be performed. Moreover, when a situation of national emergency has been declared by an importing WTO member, the period of time will be shortened. The competent authority will also fix an adequate

remuneration due to the right holder.

- The re-importation into the Community of products made under a compulsory licence is prohibited. The following anti-diversion measures are established: generics must be identified through peculiar labelling and packaging and, where feasible, without a significant impact on price, and the colour and the shape of the medicine must differ from the patented product.
- Finally, applicants are required to demonstrate that generic products are as safe and efficacious as those authorised for marketing in the Community. A proper scientific opinion procedure and derogations from data protection and caducity rules are provided.

The UK government has welcomed the draft Regulation and supports the speedy implementation of the proposal. It considers that an appropriate balance has been reached between the interests of right holders and the necessity of developing countries obtaining immediate access to essential medicines at affordable prices. Nevertheless, the effects of this proposal will depend on the commercial incentives for generic companies to exploit the opportunity it presents.

The deadline for responding to the UK Patent Office's consultation is 23 May 2005.

## Trade Marks

### 10. FETA CHEESE PROTECTION REACHES ECJ

The Danish and German Governments have mounted a challenge to the European Commission's decision to grant protected designation of origin status to feta cheese in an action before the ECJ.

Feta cheese was first produced in Greece thousands of years ago, and today Greece makes 115,000 tonnes of feta, much of which is destined for domestic consumption. However, the cheese is also produced outside Greece and Denmark is the second-largest European producer.

In 2002, the European Commission granted protected designation of origin status to the term "feta". This means that, from 2007, only Greek cheese producers will be able to call their products feta. The German and Danish governments have protested that feta is a generic designation without a convenient substitute term. They claim that feta does not refer to any specific geographical area and has been used outside Greece for many years.

The Danish Dairy Board has also highlighted the substantial cost of introducing a new name for the cheese that is currently known as feta. This concern has been echoed by Shepherd's Purse, Britain's only feta producer. Shepherd's Purse is particularly perturbed by the possible need to re-brand since it claims that the labels on its product make it clear that it is selling Yorkshire feta, not Greek feta.

The ECJ is expected to issue a judgment in the autumn of 2005. If the Danish and Greek governments are unsuccessful, non-Greek feta producers will have to find an alternative way of describing the feta-like qualities of their cheese to consumers. There is also the fear that a pro-Greek ECJ decision will result in producers of other cheese that was originally produced in a particular locality but currently produced throughout the EU, also seeking to obtain PDO protection.

### 11. UK TRADE MARK DECISION ON REGISTERING FAMOUS NAMES (LINKIN PARK) ON POSTERS

On 7 Feb 2005, Mr Richard Arnold QC dismissed the appeal made by Linkin Park LLC on registration of the trade mark LINKIN PARK in respect of “printed matter, posters and poster books” in Class 16 under section 3(1)(b) and (c) of the Trade Marks Act 1994.

The issue in dispute in the appeal was whether the Registry was correct in refusing the registration of the names of celebrities on goods such as posters. The hearing officer had held that LINKIN PARK (“the mark”) was the name of a music band and, as such, when used on a poster, it represented the characteristics of the goods and was insufficient to serve in trade to distinguish the goods. The earlier case law, *Doublemint* and *Postkantoor*, emphasised that a word must be refused registration under the provision if at least one of its possible meanings designates a characteristic of the goods or services concerned.

The applicant appealed that the hearing officer erred on four grounds:

1. LINKIN PARK was coined by the Group and was therefore an invented word;
2. Subject matter was not a “characteristic” of the Goods within the meaning of section 3(1)(c);
3. It was wrong to differentiate between goods such as posters and other goods; and
4. The decision was inconsistent with certain other registrations.

Mr. Arnold rejected the appeal on the following grounds:

- On the date of application, LINKIN PARK had already acquired a well established meaning in relation to the music band, therefore it was not meaningless. A mark which is distinctive for one class of goods may be descriptive in the other.
- It would be difficult for the traders to market the posters without using the mark. The correct test should be whether the mark sought to be registered is capable of being used descriptively.
- Although the relevant customer will be the fans of the group, the applicant failed to show evidence that upon registration of the mark, customers will expect the posters to be licensed by the group.

Although the applicant relied on the previous case of *Arsenal v Reed* in support of its claim, that decision concerned marks relating to sporting teams, while this decision created different considerations in respect of the names of performers or celebrities.

As the European Court of Justice has pointed out frequently, the essential function of a trademark is to enable consumers or end-users to identify the origin of the marketed goods or services without any possibility of confusion, and to be able to distinguish the goods or services from those having another origin. In this case the ECJ indicated that a famous name was likely to be perceived as merely descriptive of the subject matter such as a poster and could not be accepted by consumers as functioning as a trademark.

This case shows that the application of trade marks on different goods and services will not necessarily have the same result. It is imperative for future applicants to be careful when registering their marks to know the nature of the goods and services to which their marks ought to apply.

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