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COLIN E. MANNING

Registration of Marks Containing Emoji 619

As emoji are increasingly used in electronic communication, it is only a matter of time before applications are submitted to register trade marks containing them. However, it is not clear whether such marks should be considered word marks or figurative marks. The assessment of the absolute and relative grounds for refusal under arts 7 and 8 respectively are more complex for emoji marks than they first appear. Current EUIPO guidelines appear to require that such emoji marks be assessed as figurative marks. But this requirement fails to appreciate the subtleties and complexities of how emoji are used and perceived by the relevant public. The choice has an impact on the assessment of the registrability of marks, especially on relative grounds.

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EMMANUEL SALAMI

Patent Protection and Plant Variety Rights for Plant Related Inventions in the EU and Selected Jurisdictions 630

Intellectual property protection serves a wide range of functions, prominent among which is the encouragement of the creativity of inventors. Plant patents and plant variety rights have been developed for plant related inventions in order to achieve similar effects. This article aims at carrying out a comparative analysis of the intellectual property law protection for plants and plant related inventions in the EU, US, China, South Africa, and within the (proposed) legal framework of the African Regional Intellectual Property Organization (ARIPO), while also making recommendations where necessary.

KEVIN T. O'SULLIVAN

Industry Strategy for the Enforcement of Copyright Online: A Spectre of Private Regulation for the EU? 641

This article will argue that recent US litigation in *BMG v Cox* (2018), and *Sony v UPC in Ireland* (2016), may point to a new entertainment industry strategy pursuing private regulation for copyright enforcement online. Assuming this to be the case, it will weigh that strategy's prospects for success relative to internet subscriber rights under the EU legal framework.

ALPANA ROY AND ALTHAF
MARSOOF

The Brave New World of ICANN's "New gTLDs": An Overview 649

Since October 2013, the global body which regulates the internet—the Internet Corporation for Assigned Names and Numbers (ICANN)—has introduced, or “delegated”, into the internet 1,230 new generic top-level domain names or “new gTLDs”. This relatively new development has effectively heralded a new phase for the internet, whereby previously locked-up domain name territory is now being made available for corporations and organisations. With the maturing of the internet, domain names—and indeed, domain names as a new legal field—have attracted significant academic commentary. However, there has been almost no academic analysis of the new gTLDs to date. The purpose of this article is to redress that deficiency and provide a thorough investigation into ICANN's new gTLD programme, including its distinctive features, the benefits and challenges of acquiring new gTLDs, and the dispute settlement procedures in place for this newest entry into the domain name space.

ZHIHONG DENG AND ETHAN MA

Discovery in US Intellectual Property Litigation: Common Issues and Best Practice 659

The discovery process encompasses an essential part of any intellectual property litigation in the US. It is a litigation process through which parties in litigation can request and obtain from opposing parties information and documents relevant to the issues in a lawsuit, and now it has become more complex with the increase in volume of electronic information. Without a sufficient understanding of the normal rules and protocols of document discovery in the US, discovery will be both time consuming and costly. This article aims to provide a general introduction to the definition, development history and function of the discovery process; to analyse common issues encountered by companies in this process; and, finally, to provide our best practice suggestions.

Comments

MATTEO MANCINELLA

The Visual, the Phonetic and the Famous: Trade Mark Similarity in the Wake of *Messi v EUIPO* 665

In *Messi v EUIPO*, the General Court of the EU stated that the signs at issue, “Messi” and “Massi”, are visually and phonetically similar, as ruled by the First Board of Appeal. However, the General Court concluded that EUIPO erred in considering that Messi’s reputation is limited only to that part of the public with an interest in football and sport in general. In fact, Messi is a well-known public figure who appears regularly on television and whose name is often in the papers. Thus, this case demonstrates the influence of notoriety on the strength of a trade mark.

JOHN HULL

Aiming for “Jackpot Damages” in a Breach of Confidence Case: *Marathon Asset Management LLP v Seddon* 668

If the aim of damages is to put a claimant into a position it would have been in had a contract been properly performed, then evidence of loss flowing from the breach is required. In a breach of confidence case—*Marathon Asset Management v Seddon*—the claimant could demonstrate no loss to its business, nor gain to ex-employees who had copied confidential information in breach of contract. But was the claimant nonetheless entitled to “*Wrotham Park* damages” to compensate it for the loss of a fee it would (however hypothetically) have negotiated with the employees to consent to their unlawful activities? The basis on which *Wrotham Park* damages may be available has never been clear. The *Marathon* case and the more recent Supreme Court decision in *Morris-Garner v One Step (Support)*—a landmark case on the law of damages generally—are considered to see whether they bring any clarity to the question.

JOHN A. TESSENSOHN

Ultraman Vanquished Aston Martin and Bentley: Japanese Trade Mark Opposition and Invalidation Outcomes and Trends 675

The article will explore an interesting trade mark opposition decision which demonstrates that the outsized reputation and fame of the opponents’ senior marks per se neither enhances nor reduces the likelihood of confusion in Japan, but rather the factual determination and judgment of the similarity examination of the conflicting marks is the main driver of success in contentious trade mark proceedings. The article will also explore the procedural pitfalls, strategic shortcomings and 17 years of statistical data regarding Japan’s trade mark opposition system and several instructive Japanese appellate invalidation decisions that will demonstrate why brand owners will be better served by using its invalidation appeal system to police competitors’ trade marks in the world’s third largest economy, Japan.

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