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Case Law Update: The United States and Europe

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EU Trademark Law

EU Trademark Law

EU General Court Case T-65/20 – “Kneissl Holding”

- **Key Facts**
  - KNEISSL EU trademark i.a. registered in class 10 for bags and in class 25 for apparel.
  - A third party applied to revoke the trademark due to non-use after the 5-year period had elapsed. The EUIPO revoked the registration. The owner of the KNEISSL trademark sued the EUIPO arguing sufficient genuine use.

EU Trademark Law

EU General Court Case T-65/20 – “Kneissl Holding”

- Key Facts
- **Key Legal Findings**
  - General Court upheld revocation. Proof of genuine use requires that the documents are specific (turnover statistics must identify products; product images must show dates, etc.). Selling of only some goods (class 10: 33 sporting bags; class 25: 1 leather jacket) not sufficient. The smaller the number of products sold - the higher the requirements to prove genuine use.
  - **Requirements to prove genuine use in the EU remain high and strict: Detailed and specific evidence needed. “BIG MAC” is still alive.**

EU Trademark Law



CJEU Case C-607/19 – "Husqvarna/Lidl" (3D mark: "sprinklers for irrigation")

- **Key Facts**
  - Court claim **for revocation of a trademark** due to non-use for a **continuous five-year period**.
  - Question: **Which is the relevant date** to determine if the five-year **period has elapsed** – the (court) filing date or the date of the closing of the court level (last hearing)?

EU Trademark Law



CJEU Case C-607/19 – "Husqvarna/Lidl" (3D mark: "sprinklers for irrigation")

- **Key Facts**
  - Court claim **for revocation of a trademark** due to non-use for a **continuous five-year period**.
  - Question: **Which is the relevant date** to determine if the five-year **period has elapsed** – the filing date or the date of the closing of the court level (last hearing)?
- **Key Legal Findings**
  - The relevant date for five-year-period is the **(court) filing** of the revocation claim.

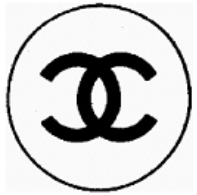
EU Trademark Law

EU General Court Case T-44/20 – “Chanel/HUAWEI Technologies”

- **Key Facts**
  - Chanel (perfumes, cosmetics, clothes) brought claims to court against HUAWEI Technologies (computer hardware) due to alleged trademark infringements by the HUAWEI logo. Sufficient similarity between the logos?



(HUAWEI)



(Chanel)

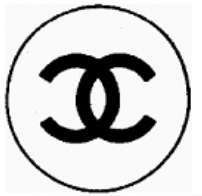
EU Trademark Law

EU General Court Case T-44/20 – “Chanel/HUAWEI Technologies”

- Key Facts
- **Key Legal Findings**
  - **Sufficient similarity between the logos denied.**
  - **Visual, phonetic, conceptual similarity** to be assessed.
  - Possible rotation of the trademarks even in practical use is not relevant. **Only the registered form counts.**
  - **Phonetic:** HUAWEI = two “U”s; Chanel = two “C”s.
  - **Visual:** Chanel’s mark has more rounded curves, thicker lines and a horizontal orientation while HUAWEI’s is vertical.



(HUAWEI)



(Chanel)

EU Trademark Law





CJEU Case C-783/19 – "Comité Interprofessionnel du Vin de Champagne (CIVC)/GB"

- **Key Facts**
  - Legal Background: **protection of designation of origin (PDO)** similar to trademark protection in EU law.
  - Example: **CHAMPAGNE for sparkling wine** from the Champagne area.
  - Spanish restaurant used the sign **"CHAMPANILLO"** to promote its **tapas bar restaurants**.
  - Infringement?

EU Trademark Law





CJEU Case C-783/19 – "CIVIC/GB"

- Key Facts
- **Key Legal Findings**
  - **Infringement** of protected designation of origin not only when the sign is used for goods, but also if the sign is used **for services** (e.g. the operation of a tapas bar restaurant)
  - Used sign (= CHAMPAGNILLO) does not have to be identical or similar to the protected designation of origin (= CHAMPAGNE). **Sufficient: intellectual association** with the protected designation of origin, e.g. due to phonetic or visual similarity.

EU Trademark Law

CJEU Case C-466/20 – “HEITEC/HEITECH”

- **Key Facts**
  - EU trademark law: **forfeiture** of all trademark related claims **five years after knowledge** of the infringement when no sufficient action is taken.
  - Trademark proprietor (HEITEC) **gains knowledge** of (infringing) use of the younger trademark HIGHTECH PROMOTION on **May 6, 2009**.
  - Outside court cease-and-desist letter in 2009, court action filed on December 15, 2012. Different formal mistakes in statement of claim that delayed the service of the writ, **effective service on May 16, 2014**.

EU Trademark Law

CJEU Case C-466/20 – "HEITEC/HEITECH"

- Key Facts
- **Key Legal Findings**
  - **Outside court cease-and-desist letter is not sufficient** to interrupt the five year-period relevant for the forfeiture of trademark related claims.
  - **You need to file court action to avoid forfeiture.**
  - Filing court action against the infringement may also **not be sufficient if formal mistakes that impede the service of the writ** and mistakes are fixed after five-year period has passed.

US Trademark Law

US Trademark Law

Meenaxi Enter., Inc. v. Coca-Cola Co., 38 F.4th 1067, 1069 (Fed. Cir. 2022)

- Does a strong trademark in one country retain its strength in a different country where the mark is not registered to that same owner?

Hermes Int'l v. Rothschild, No. 22-CV-384 (JSR), 2022 WL 1564597 (S.D.N.Y. May 18, 2022)

- Can NFTs have first amendment protection under *Rogers v. Grimaldi* test as artistic expression?



MetaBirkins

MetaBirkins is a collection of 100 unique NFTs created with faux fur in a range contemporary color and graphic executions.

Creator Mason Rothschild began working on MetaBirkins shortly after the success of Baby Birkin, a one-of-one, NFT covered by Forbes and Vogue that sold at auction for 5.5 ETH. In response to the community demand, Rothschild developed a new series, this time inspired by the acceleration of fashion's "fur free" initiatives and embrace of alternative textiles.

MetaBirkins is now available for purchase on LooksRare.

Buy on LooksRare

Read

Basic.Space
Vogue Business
Complex
Highsnobiety
HYPEBAE
Input Mag

Follow

Discord
Instagram
Twitter

Press

Preview
Inquire

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US Trademark Law

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Vans, Inc. v. MSCHF Prod. Studio, Inc., No. 22CV2156WFKRML (E.D.N.Y. Apr. 29, 2022)

- Does the Roger v. Grimaldi case only apply to traditional expressive works and not to ordinary consumer products? Can shoes be "artistically expressive" works?



© Vans



© MSCHF

US Trademark Law

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1-800 Contacts v. Warby Parker, No. 1:21-cv-06966-PKC (S.D.N.Y. June 27, 2022)

- Can keyword search terms infringe trademarks by causing a likelihood of confusion as to registered trademarks with the similar or same words?

Ezaki Glico Kabushiki Kaisha v. Lotte Int'l Am. Corp., 986 F.3d 250, 255 (3d Cir.), *as amended* (Mar. 10, 2021), *cert. denied sub nom. Kaisha v. Lotte Int'l Am. Corp.*, 142 S. Ct. 420 (2021), *reh'g denied*, 142 S. Ct. 1402, 212 L. Ed. 2d 345 (2022)

- Lanham Act does not protect product features that are "useful."



© Ezaki Glico



© Lotte

EU Design Law

EU Design Law

Two types of EU design protection:

- **Registered design (EUIPO).** Priority date from filing with EUIPO. **Maximum** term of protection **25 years**.

- **Unregistered design.** Priority from the date on which the design was first made available to the public within the EU. Term of protection **3 years** from this date.

EU Design Law

CJEU Case C-123/20 – "Ferrari/Mansory Design [Front Kit]"

- **Key Facts**
  - Ferrari FFX K images disclosed in 2014 press release. In infringement case (see pictures right), Ferrari claims **unregistered design** protection for "**V" on the hood.**
  - *(Art. 11 EU Community Design Regulation)*



EU Design Law

CJEU Case C-123/20 – "Ferrari/Mansory Design [Front Kit]"

- Key Facts
  - Ferrari FFX K images disclosed in 2014 press release. In infringement case (see pictures right), Ferrari claims **unregistered design** protection for "**V" on the hood.**
  - *(Art. 11 EU Community Design Regulation)*



- **Key Legal Findings**
  - Making available to the public of images of a product as a whole **entails** the design of **a part of that product** (e.g., the "V" on the hood of a car), provided that the appearance of that part is **clearly identifiable. Protection as unregistered design for that part: YES.**

Outlook: EU Design Law

CJEU case 472/21 (pending) – “Sattelunterseite [bottom of the saddle]”

- **Key Facts**
  - **Design registration** for bottom of a bicycle saddle **revoked**, argument: not visible when used as intended.
  - Design must be visible during the intended use of the respective product. (Art. 3 (3) EU Design-Directive)



Outlook: EU Design Law

CJEU case 472/21 (pending) – "Sattelunterseite [bottom of the saddle]"

- Key Facts
  - **Design registration** for bottom of a bicycle saddle **revoked**, argument: not visible when used as intended.
  - Design must be visible during the intended use of the respective product. (Art. 3 (3) EU Design-Directive)



- **Key Legal Question**

  Is the objective **possibility of design visibility** (when product is installed) **sufficient?** For example: Bike is turned upside down to swap tires. Or is it necessary that the design is **visible during normal use?** And what characterizes normal use?

US Copyright Law

US Copyright Law

Andy Warhol Found. for Visual Arts, Inc. v. Goldsmith, 11 F.4th 26, 34 (2d Cir. 2021), *cert. granted*, 142 S. Ct. 1412 (2022)

- When is a work transformative enough to qualify for protection under copyright law?

Unicolors, Inc. v. H&M Hennes & Mauritz, L. P., 142 S. Ct. 941, 944 (2022)

- Can inadvertent errors be the basis for challenging copyright registrations?

Miramax, LLC v. Quentin Tarantino and Visiona Romantica, Inc., Case No. 2:21-cv-08979 (C.D. Cal.)

- *Can Miramax film studio block Quentin Tarantino's sales of NFTs of the Pulp Fiction scenes/screenplay which are said to be based on the screenplay?*

Miramax, LLC v. Quentin Tarantino and Visiona Romantica, Inc., Case No. 2:21-cv-08979 (C.D. Cal.)

- Under the agreements, Tarantino granted to Miramax **"all rights (including all copyrights and trademarks) in and to the Film (and all elements thereof in all stages of development and production) now or hereafter known including without limitation the right to distribute the Film in all media now or hereafter known (theatrical, non-theatrical, all forms of television, home video, etc.)…"**

- The agreements granted Tarantino **reserved rights to "soundtrack album, music publishing, live performance, print publication (including without limitation screenplay publication, 'making of' books, comic books and novelization, in audio and electronic formats as well, as applicable), interactive media, theatrical and television sequel and remake rights, and television series and spinoff rights."**

EU Copyright Law

EU Copyright Law





CJEU Case C-401/19 – "Poland/European Parliament and Council of the EU"
(The upload filter case)

- **Key Facts**
  - New EU DSM Copyright Directive (2019/790) took effect in April 2019. EU Member States need to include into their copyright law that online content-sharing service providers (e.g., **YouTube, TikTok,** …) are in general **(also) liable for copyright infringing uploads** by platform users.
    (Art. 17 DSM Copyright Directive)

EU Copyright Law





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    (Art. 17 DSM Copyright Directive)
  - **Liability privilege** possible for the providers, but they need to inter alia apply **upload filters** that prevent copyright infringing uploads.
  - Poland brings invalidity proceedings before the CJEU, arguing a breach of the EU Charter of Fundamental Rights through **danger of overblocking** of (legal) parodies, criticism, quotations, etc.

EU Copyright Law





CJEU Case C-401/19 – "Poland/European Parliament and Council of the EU" (The upload filter case)

- Key Facts
- **Key Legal Findings**
  - CJEU found that duty to apply upload filters **does not violate fundamental rights** like freedom of speech and information rights of platform users.
  - Nevertheless: National parliaments need to implement **safeguards** to ensure that legal content such as parodies, criticism, quotations can be shared through the platform by users, **overblocking** must be prevented with proportionate means.

EU Copyright Law

CJEU Case C-13/20 – "Top System SA/Etat belge"

- **Key Facts**
  - **EU Copyright Software Directive: Decompilation** of software expressly **only allowed for providing interoperability** with other software applications. But other processing of software allowed for **error correction**.
  - Top System had developed a software and licensed it to Belgian government. **The Belgian government had decompiled the software for error correction.**
  - Top System filed damage claims, arguing that Belgian Government had **decompiled the software for other purposes than interoperability** and therefore infringed its copyright.

EU Copyright Law

CJEU Case C-13/20 – “Top System SA/Etat belge”

- Key Facts
- **Key Legal Findings**
  - Broad interpretation: **Decompilation also allowed for error correction.**
  - When decompiling software for error correction, the usual requirements for decompiling software (when providing interoperability) must not be met.
  - Limit: Decompilation only to the extend **necessary** for error correction, also **contractual duties** must be obeyed.

US Patent – Executive Agencies

US Patent – Executive Agencies (1/2)

US Patent and Trademark Office ("USPTO")

- December 6, 2021 "***Draft Policy Statement on*** *Licensing Negotiations and Remedies for* ***Standard Essential Patents*** *Subject to Voluntary F/RAND Commitments"*
- **USPTO Director** finally confirmed.
- USPTO's "***Interim Procedure for Discretionary Denials*** *in AIA Post-Grant Proceedings with Parallel District Court Litigation"*
- USPTO **withdraws from the "*2019 Policy Statement on*** *Licensing Negotiations and Remedies for* ***Standard Essential Patents*** *Subject to Voluntary F/RAND Commitments"* and states that it is no longer in the business of issuing SEP policy statements.
- **USPTO and WIPO agree** to undertake joint efforts to facilitate the resolution of disputes related to standard essential patents.
- USPTO's "**Request for Public Input on Patent Eligibility Guidance**"
- USPTO's "**Request for Comments on Director Review, Precedential Opinion Panel Review, and Internal Circulation and Review of Patent Trial and Appeal Board Decisions."**

US Patent – Executive Agencies (2/2)

Office of the United States Trade Representative

- WTO COVID-19 waiver
- WTO complaint against China

Department of Justice

- December 6, 2021 "***Draft Policy Statement on*** *Licensing Negotiations and Remedies for Standard Essential Patents Subject to Voluntary F/RAND Commitments*"

US International Trade Commission

(INVT SPE LLC v. International Trade Commission, appeal from Investigation No. 337-TA-1138)

- Device claims require capability to perform the claimed functions (and not actual operation), but such capability must be proven.

EU Patent Law

Unified Patent Court ("UPC")

- "[A]n international court set up by participating EU Member States to deal with the infringement and validity of both Unitary Patents and European patents"*
  - EPO Unitary Patents can cover up to 25 EU Member States by submitting a single request
  - "17 countries will be covered by the Unitary Patent when the system starts"*
  - Can enforce European patents from multiple Member States in a single court action
- Still have the choice of using the corresponding national courts to enforce the patent
- Expected to open in second half of 2022*
  - Some estimate 2023
- Multiple locations anticipated
- UPC is hiring judges but positions have not yet been publicly announced

*https://www.epo.org/applying/european/unitary.html

EU Patent Law

CJEU Case C-44/21 – "Phoenix Contact/Harting"

- **Key Facts**
  - Phoenix Contact seeks **preliminary injunction (PI) before German court due to patent infringement**. Germany follows **bifurcation system**: Infringement and validity of patent are decided by different courts.
  - German (infringement) court took the view that **to issue the PI**, **a first-instance decision confirming the validity of the patent** in opposition or invalidity proceedings by the validity court **would be necessary**, even though the infringement court did not doubt the validity of the patent.
  - Is this in line with the EU Enforcement Directive 2004/29 which guarantees possibility to issue PI?

EU Patent Law

CJEU Case C-44/21 – "Phoenix Contact/Harting"

- Key Facts
- **Key Legal Findings**
  - **First-instance decision confirming the validity** of the patent **not necessary for a PI** against patent infringement. If the court hearing the application for PI does not have concerns against the validity of the patent, granting of PI should be possible.
  - *"…(T)here must be effective legal remedies designed to prevent, terminate or rectify any infringement of an existing intellectual property right…"*

    "…intended …to ensure a high, equivalent and homogeneous level of protection…"

US Patent Law

US Patent Law – Judicial – District Courts

In re Juniper Networks, Inc., 14 F. 4th 1313 (Fed. Cir. 2021)

- Federal Circuit issued *writ of mandamus* forcing transfer from W.D. Tex to N.D. Cal.

Order reinforcing random assignment of W.D. Texas cases

- All patent cases filed in the Waco Division of the Western District of Texas (W.D. Tex.) are to be randomly assigned among 12 judges.

Ericsson v. Apple, (E.D. Tex. And W.D. Tex. + ITC, etc.)

- 5G warfare

US Patent Law – Judicial – Federal Circuit

Koninklijke Philips N.V. v. Thales DIS AIS USA LLC, Case No. 21-2106 (Fed. Cir. 2022)

- Speculative harm is not enough to warrant a preliminary injunction

Amgen Inc. v. Sanofi, Aventisub LLC, 987 F.3d 1080 (Fed. Cir. 2021)

- Whether section 112 enablement is a question of fact to be determined by the jury *and* whether enablement requires teaching those skilled in the art how to "make and use" the invention, or whether it requires enabling skilled artisans "to reach the full scope of claimed embodiments" without undue experimentation.

California Inst. of Tech. v. Broadcom Ltd., 25 F.4th 976 (Fed. Cir. 2022)

- Federal Circuit rejected a "two-tiered" damages theory for applying different royalty rates for the same product at different levels of the supply chain and formally overruled *Shaw Indus. Group v. Automated Creel Sys., Inc., No. 15-1116 (Fed. Cir. 2016)* regarding estoppel in *inter partes* review proceedings.

Apple Inc. v. Qualcomm Inc., 992 F.3d 1378 (Fed. Cir. 2021), *cert. denied*, 142 S. Ct. 2868 (2022)

- Applicant-admitted prior art (AAPA) does not qualify as "patents or printed publications" on which an *inter partes* review at the PTAB may be based, but it is still admissible to prove facts relevant to an obviousness analysis.

US Patent Law – Judicial – Supreme Court

Am. Axle & Mfg., Inc. v. Neapco Holdings LLC, 967 F.3d 1285 (Fed. Cir. 2020), *cert. denied*, 142 S. Ct. 2902 (2022)

- U.S. Supreme Court denied review of subject-matter eligibility jurisprudence

In re PersonalWeb Techs. LLC, 961 F.3d 1365 (Fed. Cir. 2020), *cert. denied sub nom. PersonalWeb Techs., LLC v. Patreon, Inc.*, 142 S. Ct. 2707 (2022)

- Patent-specific preclusion principles still apply

SRI Int'l, Inc. v. Cisco Sys., Inc., 14 F.4th 1323 (Fed. Cir. 2021), *cert. denied*, 142 S. Ct. 2732 (2022)

- U.S. Supreme Court leaves Federal Circuit's *Halo* clarification in place. "Wanton, malicious, and bad-faith behavior" applied to enhanced damages and not to findings of willful infringement which requires deliberate and intentional infringement.

Thanks!



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