

Contego Intellectual Property

A quarterly update from Contego Intellectual Property of IP related news from the Great Britain, Ireland and Europe.

Our Expertise

- Trade Marks;
- Designs;
- Copyright;
- Confidential Information;
- Passing off;
- Trade Name Disputes;
- Competition;
- Exhaustion of Rights;
- Franchising;
- Freedom of Information;
- Domain Name Disputes;
- Anti-Counterfeiting;
- Data Protection;
- Image Rights;
- Database Rights.

Is your design cool?



The long running 'tablet computer' dispute between Samsung and Apple, recently found itself before the UK Patents County Court which delivered an unexpected jab at Samsung's tablet by saying that it was 'just not as cool' as Apple's "iPad" tablet computer.

The UK proceedings arose as a result of Samsung seeking a

declaration of non-infringement. Significantly, the Court held that the design of its tablet the majority of features in computer did not infringe the Apple's "iPad" tablet were not European (RCD) Registered Determined by function.

Design which Apple owns for the design of its "iPad" tablet While the court observed that there were a number of similarities between the design of Samsung's tablet and Apple's "iPad", it found that these Q.C undertook a three step analysis. He first had to satisfy existing design corpus and himself of the existing design should therefore be ignored.

In reaching his decision of non-infringement, Judge Birss of Samsung's tablet and Apple's "iPad", it found that these RCD were functional (a ground for invalidating an RCD). Thirdly, a different overall impression the Court had to consider produced on the informed user and therefore no infringement. that the design of Samsung's tablet computer produced on an informed user was different to that produced by Apple's "iPad" computer.

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Class headings in European (CTM) Trademark applications

The Court of Justice of the European Union (CJEU) has recently ruled that while the use of Nice classifications in Trademark applications are still permissible, any Trade Mark applicant or its attorney must indicate the goods and/or services claimed with sufficient "clarity and precision" in order to determine the scope of protection being sought.

The CJEU's [ruling](#) arose as a result of a reference to it by the Appointed Person (a person appointed under UK statute to

hear appeals from decisions of the Registrar of the UK Intellectual Property Office) in a case where the Chartered Institute of Patent Attorneys had applied to register IP TRANSLATOR as a Trade Mark under the class 41 heading of "educational services". The application received an objection that the mark was descriptive of "translation services", which were covered by the alphabetical list of services under the Class 41 heading.

As a result of the CJEU ruling, all

European Trade Mark Registries (including the European Trade Marks Office (OHIM)) will need to explain what they consider to be a sufficiently clear and precise goods and/or services description.

OHIM was quick off the block and notified CTM applicants that if they wish to use a class heading, as opposed to listing each good and service, they must affirm that the application is being made for all the goods and/or services included in the alphabetic list of each class filed.

Privilege against self incrimination where Intellectual Property involved

Those who are accused of misusing confidential information have no immunity from giving self incriminating evidence. This was so held by the English High Court in *Stephen John Coogan V Newsgroup Newspapers* EWCA Civ 48.

The case arose because of an allegation made by the well known English comedian Steve Coogan that his phone had been illegally tapped by Newsgroup Newspapers with the assistance of a private

investigator, Glenn Mulcaire. Mr Mulcaire refused to give evidence on the grounds that this would breach his right not to give self incriminating evidence. The Court held that because Mr Mulcaire had breached confidential information he had no immunity from giving self incriminating evidence.

This case is significant because for the first time there appears to be judicial recognition that confidential information is an Intellectual Property right.

The basis for the High Court's decision was a long standing prohibition under UK law of those accused of infringing any intellectual property rights from relying on the privilege against giving self incriminating evidence.

The statutory basis of immunity from giving self incriminating evidence where Intellectual Property is concerned is Section 72 of the Senior Courts Act, 1981. Section 72 (5) stipulates that 'intellectual property' means any "patent, trade mark,

technical or commercial information or other intellectual property right".

The decision of the High Court means that in cases where breach of confidential information is alleged, claimants could force defendants to give evidence.

Further clarification has come recently in UK Supreme Court decision in *Phillips v Mulcaire*, (2012), EWCA Civ 48 which held that only commercial confidential information is covered by Section 72.

Norwich Pharmacal Orders

In March 2012, the English High court in the case of *Golden Eye (International) Ltd and others v Telefonica UK Ltd* [2012] EWHC 723(Ch) (26 March 2012) ordered that the identity of 9,124 IP addresses of clients belonging to the Internet service provider Telefonica (better known in the UK as O2) be released to Golden Eye. The details of the IP addresses were required so that Golden Eye could pursue claims of copyright infringement against the holders of the IP addresses.

The order which Golden Eye was seeking is better known as a 'Norwich Pharmacal' order and the criteria for grant were laid down in the case of *Rugby Football Union v Viagogo Ltd*, namely:

1. That an arguable wrong had been committed against the claimant.
2. That the Defendant is involved in the arguable wrong.
3. That the Claimant is seeking redress for the wrong.
4. That the disclosure of

the information for which Claimant requires is necessary to pursue redress of the arguable wrong.

5. That the Court is satisfied that it should exercise its discretion in favour of granting relief.

In cases involving an application for an 'Norwich Pharmacal' order, the Court has to balance the rights of those seeking the order and those against which it is

directed. Factors that the Court would take into account would be the Defendant's interests in protecting their right to privacy and data protection.

The High Court was satisfied that the five criteria for the grant of a 'Norwich Pharmacal' order had been met. Significantly the Court believed that the Defendant was mixed up in the arguable wrong given that its clients had and were possibly still sharing copyrighted works through the Defendant's ISP.

European proposals to stub out tobacco brands on packaging



In 2010, the European Commission launched a public consultation process to

consider the possible amendment to existing legislation on the use of tobacco brands, i.e. the Tobacco Products Directive 2001/37/EC.

A contentious proposal was a move to require cigarette

companies to produce generic or plain packaging similar to that in Australia. Peter Lawrence, who was former head of the Trade Marks and Designs division of the United Kingdom Intellectual Property Office criticised the response of the UK government as part of the consultation process.

Mr Lawrence is reported to have stated that "plain packaging proposals would amount to the confiscation of Intellectual Property and would

damage business".

While the Irish government gave qualified approval to the proposals, difficulties may also arise in Ireland due to its strong Constitutional protection for property rights.

Trade Marks are recognised as rights of personal property under the Irish Trade Marks Act, 1996 and any move to force cigarette companies to remove their Trade Marks from packaging is bound to give rise

to constitutional challenges.

The proposal to introduce plain packaging appears to have been knocked on the head with the rejection by John Dalli, the European Commissioner for Health and Consumer Policy. He recently stated that such a proposal "would amount to an indirect legislative expropriation of private Intellectual Property and, as a consequence, lead to the extinction of their property rights".

Irish Copyright Review

On 9th May 2011, the Irish Minister for Jobs, Enterprise and Innovation announced the commencement of reforming Ireland's copyright law to maximize the potential of the digital industry in Ireland.

The Minister appointed Dr. Eoin O'Dell, leading Intellectual Property academic in Ireland to chair a Review committee which also includes Patricia McGovern, Head of the Intellectual Property Department at DFMG Solicitors and Professor Stephen William Hedley, Head of the Department of Law at UCC.

The primary copyright legislation in Ireland is the Copyright and Related Rights Act,

2000 and it is likely that it will be amended to take account of the findings of the Copyright Review.

The primary objective of the Review is to come up with reforms that have the purpose of promoting "innovation". In announcing the review the Minister was conscious that innovative digital companies believe that Ireland's current copyright legislation creates barriers to innovation and to the establishment of new business models. To rectify this, the Review has been asked to consider the possibility of Ireland moving towards the US style "Fair Use" doctrine.

The terms of reference of the Review are

quite limited and surprisingly do not extend to other forms of Intellectual Property that have an impact on innovation such as Designs and Patents. In contrast the recently published [Hargreaves Review](#) in the United Kingdom covers Copyright, Designs and Patents,

The Review received 180 submissions from interested parties and these can be viewed on its [website](#). Notable contributions came from Facebook®, Google®, Adobe® and Hewlett-Packard®

The Minister will review the submissions with a likely view to amending existing Copyright legislation.

About Us



David Kelly qualified as an English solicitor in 1990 and has been advising clients on Intellectual Property matters ever since.

He worked in the Intellectual Property group of a London 'silver' circle law firm for almost five years and managed its brands and designs protection practice for two and a half years before moving to a 'magic circle' law firm to advise its client's for eight years.

David has advised national and international businesses as well as individuals from a diverse range of industries, including automotive,

clothing, computer hardware and software, entertainment finance, food and drink, healthcare, hotels and luxury goods.



Niall Tierney has been providing Intellectual Property advice and assistance for over nineteen years. He became an Irish barrister in July 1993 and then qualified as an Irish Registered Trade Mark Agent in 1994.

Niall spent five years at a leading Intellectual Property law firm in Ireland before moving to London in 1998. He qualified as an English solicitor in 2002.

Niall has advised clients across a spectrum of sectors from food and fashion to information technology and pharmaceuticals and real estate. He regularly speaks and writes on a variety of Intellectual Property topics.

Niall was described in "Legal 500" as being a 'highly rated individual with a strong reputation'.

Contego Intellectual Property (Contego) is a wholly lawyer owned boutique legal practice based in London that specializes in providing advice and assistance in matters of British, Irish and European Soft IP law.

Contego was founded in 2009 by two highly qualified and experienced lawyers who, between them, have acted for and advised some of the world's leading companies in Intellectual Property matters and issues.

Contego combines its knowledge of the law, with years of experience and a no nonsense approach, to provide strategic, focused advice about freedom-to-use and own, ability to stop others imitating and how to achieve maximum value for key business assets like brands, designs, copyrights and related rights.

Contego is a strong advocate of 'Alternative Billing'. For further information about our fees and services, please email us at contego@contegoip.co.uk

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