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Editorial

After the great success of the previous edition, I am delighted to welcome you to the second edition of the Intellectual Property Magazine, created thanks to contributions of our colleagues from the Italian, Polish, Spanish, UK and French offices of DWF.

In this edition you will find many articles covering the most recent and interesting legislative and case law issues related to trademarks, patents and copyright matters. These are approached from the varying perspectives of our contributors from different jurisdictions, as confirmation of the international presence and capabilities in IP matters of the International IP network of DWF. Our aim is to keep up with the most recent and relevant developments, including in new technologies, which have impacted and are impacting on the IP sector.

Among the contributors to this edition, I am pleased to mention in particular Stéphanie Berland, who has recently joined the IP team of the Paris office, offering her deep and recognized experience in all the main topics in the IT and IP sectors, garnered during her previous experience in recognized IP boutiques and, moreover, as legal director in a major French audiovisual group.

I trust you will find the articles in this second edition of the Intellectual Property Magazine of interest and will serve to stimulate discussion and greater analysis within our international Group. The purpose of the Magazine is, in fact, to create a place for sharing with our clients and other readers in order to foster discussion on the most recent development affecting the IP world. I therefore invite you, also on behalf of the other contributors to the second edition, to contact us, share your observations on the articles, and let us know of any questions or topics that you would like to see addressed in the next edition of the IP Magazine.

Enjoy reading and thank you for your valued and essential support.



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EU

EU: Clarification of the nature and purpose of the services included in Class 35 – Judgment of the General Court of the European Union of 4 September 2024, T-73/23

A judgment issued by the General Court of the European Union on 4 September 2024 in the case of Tertianum AG v EUIPO – DPF AG has clarified the scope of Class 35 of the Nice Classification, which includes the following services in particular: “Advertising; business management, organization and administration; office functions”.

In this case, the Swiss company Tertianum, which offers home services - medicalised or otherwise - for the elderly, filed an opposition against an application to register an international trade mark designating the European Union similar to its own, and covering in particular the following services in class 35: “Business management, business consulting and administration, personnel consultancy, advertising and marketing”. With regard to the earlier mark, the services covered in class 35 are as follows: “Business and commercial management of establishments, namely management of institutions in the health and care sectors, in particular for retirement homes”.

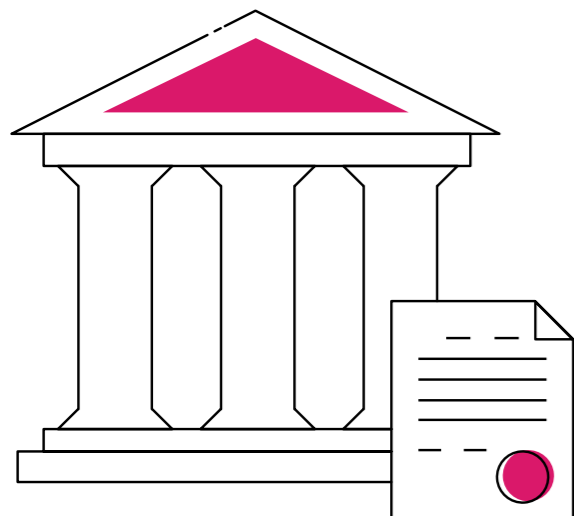
The EUIPO and the Board of Appeal rejected the opposition on the grounds that there was no evidence of genuine use of the earlier mark for the services included in class 35 since Tertianum had only provided evidence of use of the earlier mark for services revolving around retirement homes and provided to the residents of these establishments.

The case was then brought before the General Court of the European Union.

Agreeing with the Board of Appeal, the Court of First Instance held that the list of services included in Class 35 should be interpreted literally and that “the services covered by the earlier mark in Class 35, as “management services”, are not directed at end consumers but at undertakings which operate retirement homes”.

Be careful, therefore, in your choice of wording: Class 35 services should not be chosen to cover the corporate purpose of a company, but to refer to services provided to businesses.

Source:
https://curia.europa.eu/juris/document/document_print.jsf?mode=lst&pageIndex=0&docid=289771&part=1&doclang=EN&text=&dir=&occ=first&id=3503558



EU: The BIG MAC trademark case. The importance of proof of use in light of EU decision no. T-58/23 issued by the General Court of the European Union

On June 5, 2024, the General Court of the European Union issued a decision in Case T-58/23 involving the European Union trademark “BIG MAC” filed by the well-known American multinational McDonald’s International Property Company, Ltd. (“**McDonald’s**”).

After seven years of battle, the European General Court (“**General Court**”) partially revoked McDonald’s “BIG MAC” trade mark in the EU case (Supermac’s (Holdings) Ltd v EUIPO (Case T 58/23)).

The Dispute

McDonald’s International Property Co. Ltd is the owner of the EU trade mark “BIG MAC” no. 62638, registered on April 1, 1996 for goods and services in Classes 29, 30 and 42.

In 2014, the Irish fast food chain Supermac’s (Holdings) Ltd (“**Supermac’s**”) filed a trade mark application “**SUPERMAC’S**” before the European Union Intellectual Property Office (“**EUIPO**”), covering, among other products, hamburgers.

McDonald’s filed an opposition against the above said trademark application on the grounds of a likelihood of confusion with its trademark “BIG MAC”.

On April 11, 2017, Supermac’s filed an action before EUIPO for revocation for non-use against the registration for “BIG MAC” upon which McDonald’s opposition was based, claiming that it had not been put to genuine use for the claimed goods and services.

McDonald’s was therefore required to prove – under penalty of revocation of its trademark – “genuine” use of the sign in the five years preceding the filing of the action for revocation, by producing evidentiary material in accordance with EUIPO’s provisions.

EUIPO’s decision upheld the application for revocation, finding that the proof of use of the trademark “BIG MAC” was insufficient and entirely revoking the trademark “BIG MAC” (see Cancellation No 14 788 C).

McDonald’s filed an appeal against the decision and the Board of Appeal (“**BoA**”) submitted further evidence of use of the “BIG MAC” trade mark in Germany, France and the UK. Upon appeal, the BoA partially annulled EUIPO’s first instance decision and found that McDonald’s established “genuine” use for the following goods and services: “foods prepared from meat and poultry products, meat

sandwiches, chicken sandwiches” in Class 29; “edible sandwiches, meat sandwiches, chicken sandwiches” in Class 30 and “services rendered or associated with operating restaurants and other establishments or facilities engaged in providing food and drink prepared for consumption and for drive-through facilities; preparation of carry-out food” in Class 42.

Supermac’s started an action before the General Court against the BoA’s decision with the exception of “meat sandwiches”, with the effect to substantially accepting the “genuine” use of the trade mark “BIG MAC” found by the BoA for “meat sandwiches”.

The General Court’s decision

The General Court ruled on the case, altering the BoA’s decision and further limiting the protection of the “BIG MAC” trade mark, having found that there was no proof of use of the trade mark for “chicken sandwiches” in Classes 29 and 30, “foods prepared from poultry products” in Class 29 and for the services in Class 42.

In particular, with reference to “chicken sandwiches” and “foods prepared from poultry products” the General Court found that the evidence provided by McDonald’s did not show the extent of use, in particular the volume of sales, the length of the period of use and the frequency of use. Therefore, the judges held that McDonald’s did not establish genuine use for “chicken sandwiches” and, as a consequence, for “foods prepared from poultry products”.

With reference to “foods prepared from meat products” and “edible sandwiches” the question Supermac’s raised was whether this constituted use for the broader category of “foods prepared from meat products”.

The General Court recalled consistent case law on the principle of partial use. If a trade mark has been registered for a category of goods or services which is sufficiently broad to be divided into independent subcategories, genuine use in relation to part of those goods or services affords protection only for the subcategory or subcategories to which the goods or services belong. If, however, the goods or services are already defined so precisely and narrowly that it is not possible to subdivide them, then genuine use of the mark for those goods or services covers the entire category.

In light of the above, the judges concluded that “food prepared from meat products” constituted a sufficiently coherent category, which could not be divided further. Therefore, McDonald’s genuine use of the “BIG MAC” trade mark for “meat sandwiches” also constituted genuine use for “foods prepared from meat products”. The Court applied the same reasoning to “edible sandwiches” for which the “BIG MAC” trade mark was and remains registered.

Conclusions

The above said decision is particularly relevant since it highlights that the need to prove “genuine” use for all the goods designated by a trade mark is not affected by the notoriety of a trade mark such as the one characterizing the trade mark “BIG MAG” in dispute.

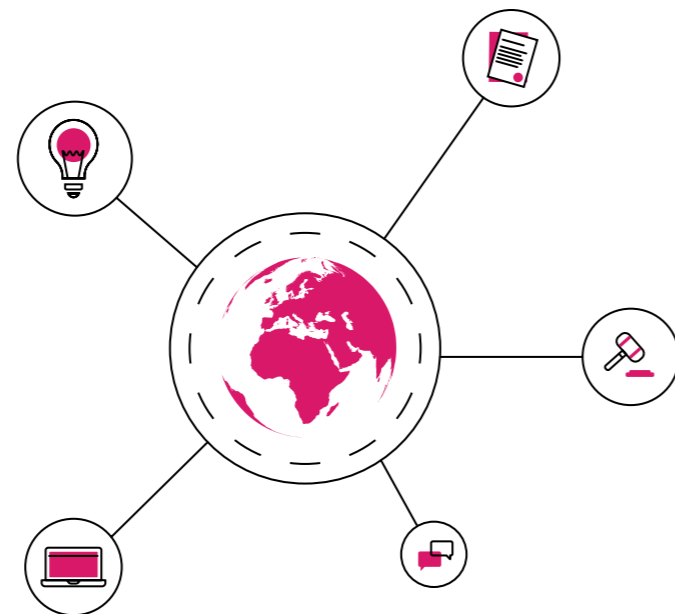
This decision somewhat promotes the practice of applying for broader trade mark specifications, which may afford greater flexibility for new product variations (i.e., “meat sandwiches” rather than “beef” or “chicken” burgers) – but that of course needs to be balanced with avoiding overly broad specifications which may attract a finding of bad faith.

Therefore, it goes without saying that it is extremely important for any trade mark, even a well-known one, to pay attention to the evidence at one’s disposal with reference to any goods or services designated by that trade mark.

Moreover, the above mentioned decision underlined also the need for trademark owners not to neglect the importance of periodically collecting evidence related to the use of their trade mark, perhaps creating an internal archive to be updated periodically, where they can collect and store material that is useful for this purpose.

In a nutshell, the above mentioned decision drew attention to the following important points on “genuine” use:

- indicators and evidence of use must establish the place, time, extent and nature of use of the trade mark through the submission of supporting documents and items such as packages, labels, price lists, catalogues, invoices, photographs, newspaper advertisements and statements in writing;
- the “genuine” use of a trade mark occurs where the mark is used in accordance with its essential function;
- when assessing “genuine” use, all facts and circumstances relevant to establishing whether the commercial use of the mark in the course of trade is “real”;
- “genuine” use is not based on presumptions, but on solid and objective evidence of actual and sufficient use of the trade mark on the market concerned;
- to show extent of use, the commercial volume of the overall use, as well as of the length of the period during which the mark was used and the frequency of use must be considered.



Case Law

EU: Porsche – the sound of acceleration. Lack of distinctive character as an obstacle in registration of a sound mark – decision of the Fifth Board of Appeal of 20 June 2024, R 1900/2023-5

Lack of distinctive character is one of the absolute grounds for refusal and a reason of non-registrability of a trade mark, according to Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark (“EUTMR”). The distinctiveness of a trade mark requires particular consideration when it comes to sound marks.

In its decision of 20 June 2024 – the Fifth Board of Appeal of EUIPO confirmed the refusal of registration of a sound mark consisting of the accelerating sound of an engine.

By way of an application of 18 November 2022 the applicant – Dr. Ing. h.c. F. Porsche Aktiengesellschaft (“Porsche”), applied for registration of the sound mark, with a total of 16 seconds.

The first four seconds are silent. They are followed by an electronically generated sequence of sounds that intensify progressively. The last three seconds are again practically silent (euipo.europa.eu/trademark/sound/EM500000018795489). The sound resembled that of a vehicle’s engine, starting from a standstill. It was then supposed to mimic the internal combustion of an engine until it reaches the desired speed, becoming quieter after reaching such. The protection was claimed for goods and services in Classes: 9, 12, 28 and 41 (digital goods, vehicles and their parts, toy cars and digital services).

By the decision of 25 August 2023, the examiner refused the application pursuant to Article 7(1)(b) EUTMR, i.e. lack of distinctive character, for all the goods and services covered by the application. The examiner pointed out that the sound in question was simple and short and therefore not perceived as a musical composition. Furthermore, the sound was not able to indicate the origin of the goods and services, as it did not contain any memorable elements enabling the consumer to associate the goods and services with certain commercial origin. The sound was claimed to be so basic, that it would have little or no impact on the consumer, as its overall effect remains just the sound of an accelerating engine, incapable of communicating the content of a trade mark.

On 6 September 2023 Porsche filed an appeal against the refusal, contesting its grounds. The appellant claimed that the sequence of tones is memorable and suitable for serving as an indication of commercial origin. Porsche pointed out

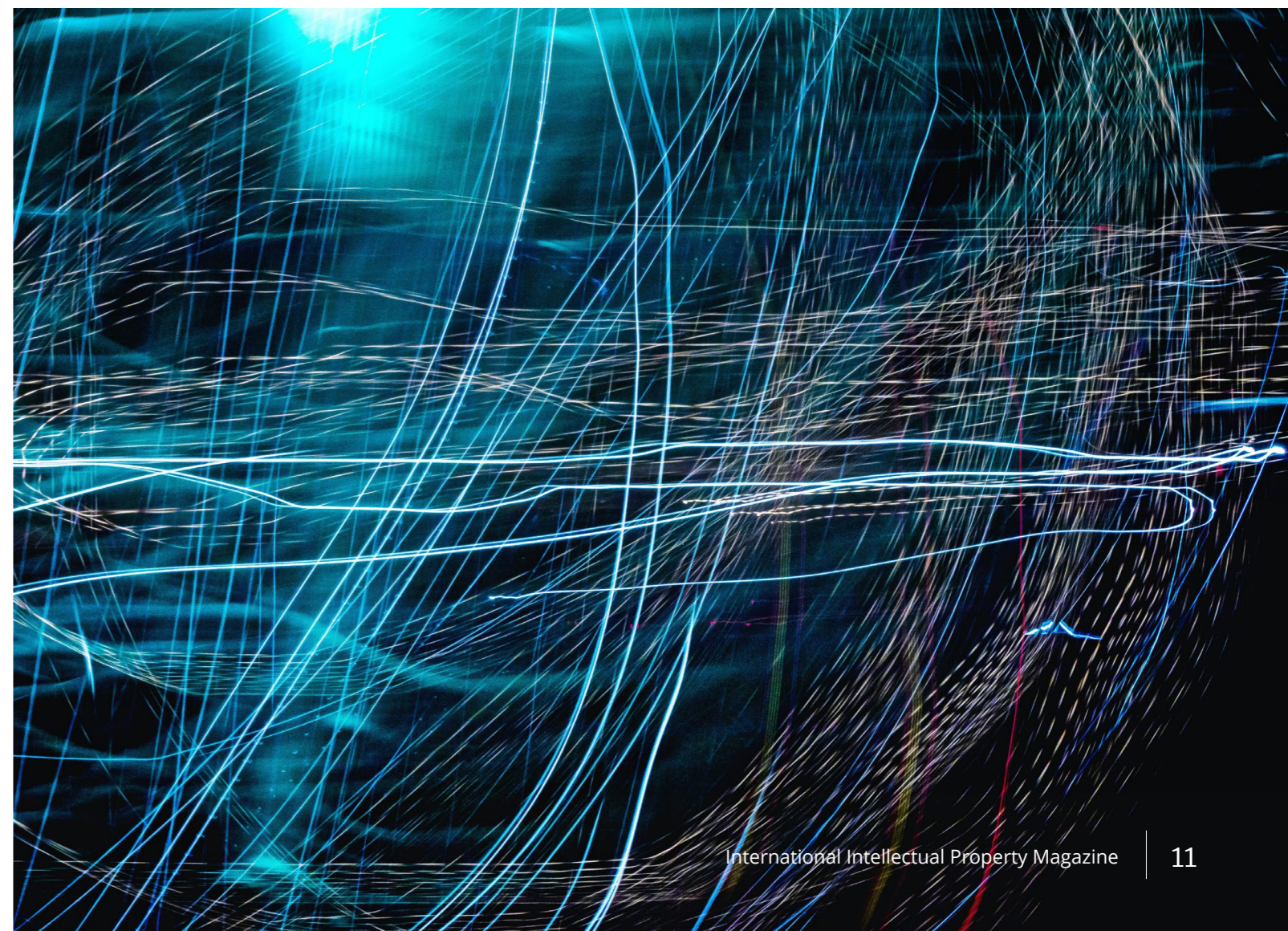
that the tone in question was a sequence of sounds that was especially composed and artificially produced as a trade mark, and – in contrast to the examiner’s argument – it was not a sound ‘naturally’ produced by the engines themselves. The appellant indicated that the sound cannot be typical for the good and/or service if it is not even realistic. According to the appellant, the sequence of notes in question was not similar to the sound of an internal combustion engine. Additionally, in appellant’s opinion, the specificity of electric vehicles (the sounds are to ensure safety on the road, since such vehicles are very quiet) entails that the public is particularly aware and sensitized to the use of sounds as trade marks. For such public, the sound trade mark applied to the electric vehicle indicates a particular brand, because the manufacturers must use their own and original sounds for recognition of their products.

On 20 June 2024, the Board of Appeal (“BoA”) dismissed the appeal filed by Porsche, confirming the refusal of the application on the ground of lack of distinctive character of the sound mark. According to Article 7(1)(b) of EUTMR, which was a legal basis of refusal, trade marks which are devoid of any distinctive character shall not be registered. Distinctive character, as established in case law, means that a trade mark is capable of identifying the goods and services in respect of which registration is made, as originating from a particular brand and consequently – distinguishing the goods and services from ones having different commercial origin and influencing a purchase decision on the basis of previous experience and individual connotations with a particular brand. The BoA pointed out that although the criteria for assessing distinctive character are the same for all types of trade marks, for some categories of trade marks it might be more difficult to prove the distinctiveness. The sound mark must enable the targeted consumer to recognize it and understand it – not only as a functional element but as a trade mark identifying the commercial origin.

The BoA later explained that the distinctive character of a trade mark must be assessed in the light of goods and services for which the registration is sought and the perception of the relevant targeted public. The goods and services in classes 9, 12, 29 and 41 appeal both to the general public and professionals, which is why the level of attention will be average to above average. However, as underlined in BoA’s argumentation – the level of attention cannot have a decisive effect on the decision as to the distinctive character of the trade mark. Due to the type of the mark, all consumers within the EU are taken into account for an assessment of distinctiveness, as the sound in question did not contain any text elements.

The BoA concluded, that the sign applied for was simple and banal, having no recognition value that could lead to recognition of the origin of the goods and services covered. The sign, in connection with the Classes applied for, was considered by the BoA as representing only characteristic of vehicles, i.e., the acceleration of speed until the desired one is reached, having no significant independence from the goods and services. Therefore, the sound mark in question was devoid of any distinctive character, which must have led to its un-registrability, pursuant to Article 7(1)(b) of EUTMR. The BoA also pointed out the separation between national regimes and the autonomous EU trade mark system, as the identical trade mark was successfully registered in Germany before.

The ruling of the Board of Appeal is a meaningful voice in continuous discussion on the degree of distinctiveness to be met by the sound to be registered as a EUTM. The future of the registrations of such trade marks especially in the electric car industry is in any case controversial, taking into account previous successful registrations of similar sounds as trade marks (see: <https://euipo.europa.eu/eSearch/#details/trademarks/018424124>).



EU: EU trademark – application for the EU figurative mark MIT FREUDE NASCHEN! – Absolute ground for refusal – Lack of distinctive character

On September 4, 2024, the Court of First Instance (Seventh Chamber) issued a judgement in case T-568/23. On the basis of Article 263 TFEU, August Storck KG challenged the decision of the Fifth Board of Appeal of the European Union Intellectual Property Office (EUIPO) of July 3, 2023.

The origin of this case dates back to July 8, when the plaintiff filed an application for registration of a figurative mark (the visible red letters “MIT FREUDE NASCHEN!” on a yellow rectangular background). For this mark, the appropriate class was to be Class 30 of the Nice Agreement (i.e., sweets).



The examiner refused the registration of the mark, citing Article 7(1)(b) read in conjunction with Article 7(2) of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trademark, and an appeal against this decision was lodged with EUIPO.

The Board of Appeal dismissed the complaint, as the applied mark did not exhibit distinctive character; that is, the mark did not specify the goods to which it referred and would generally be perceived as merely a laudatory reference to the goods.

August Storck raised two grounds: the Board of Appeal failed to comply with the obligation to state reasons and thus acted contrary to the aforementioned Article 7(1)(b) of Regulation 2017/1001.

First of all, the Court addressed the second plea of the plaintiff in its ruling, namely the plea of error in the application of Article 7(1)(b) of Regulation 2017/1001. This provision contains a requirement for identifying goods as originating from a specific undertaking. Importantly, the plaintiff did not address the Board of Appeal's assessment regarding the general perception of this mark by German-speaking individuals, and thus confirmed the perception of this mark as an advertising statement.

When assessing all elements of the applied mark, taking into account the color scheme and the font used, the Board of Appeal determined that the mark lacks distinctive character. The plaintiff disagreed, arguing that the mark features a specially applied color contrast and a distinctive font that confer upon it a distinctive character. As established by the Board of Appeal and confirmed by the Court, the verbal elements, color scheme, font style and figurative elements do not possess distinctive character but are commonly used elements in advertising, stylized but not original, or merely decorative.

In light of the above, the Court deemed the mark devoid of distinctive character and rejected the second plea.

In the second place, the Court addressed the first ground of the plaintiff, namely that the Board of Appeal failed to provide reasons for the contested decision, specifically by not assessing the distinctive character of the figurative elements and the color contrast (red and yellow), as well as not referencing previous EUIPO decisions or case law. The Board of Appeal also stated that there was no evidence of use of the mark. EUIPO has an obligation to justify all its decisions clearly and specifically. The Court found that the Board of Appeal, by examining the character of the figurative and color elements, justified its decision in a manner understandable to the appellant and being legally sound. Additionally, EUIPO has a substantial body of case law indicating that there is no requirement to address all raised arguments, and the legality of decisions is assessed based on Regulation 2017/1001.

Considering the above, the Court rejected the first plea and dismissed the action in its entirety.

EU: The role of freedom of expression in trade mark proceedings based on recent case law – 16/05/2024 R.260/2021–G COVIDIOT (fig.)

On 16 May 2024 the Grand Board of Appeal ('Grand Board') of the European Union Intellectual Property Office ('EUIPO') issued a decision, in which it dismissed the appeal in proceedings concerning European Union trade mark application no. 18288813 for the figurative trade mark 'COVIDIOT'. The Grand Board's decision is indicative of a deeper dive into balancing freedom of expression with public policy and accepted principles of morality, as well as strengthening the interpretation of the judiciary as showcased in the 27/02/2020, C-240/18 P, 'Fack Ju Göhte' and other established case law. The Grand Board in this decision examined, inter alia, the principles of the European Union ('EU') taking into consideration freedom of expression and freedom of the arts, under, respectively, Articles 11 and 13 Charter of Fundamental Rights of the European Union, as well as the core values stemming from the Treaty on the EU.

The application was filed on 12 August 2020 for the figurative trade mark 'COVIDIOT' for the following goods and services: class 6: metal clips, class 9: computer gaming software; mobile apps, class 28: board games; toys. The applicant indicated colors of the figurative trade mark as the following: yellow, gold, black, blue, white and red with a graphic representation of a 'jester hat'.

In September of the same year the examiner objected to the application based on Article 7(1)(f) (being contrary to public policy or accepted principles of morality) and Article 7(1)(b) (lack of distinctive character) of EU Regulation no. 2017/1001 ('EUTMR'). The Applicant appealed and the case was referred to the Grand Board due to its legal complexity and the issue of the fundamental rights in scope of article 7(1)(f) at hand. Third parties were invited to file observations, and INTA (International Trademark Association) did so based on article 37 (6) of the European Union trade mark delegated regulation (EUTDR).

The observation outlined that the following issues should be taken into a consideration during the process of analysis of this case: (i) deeper verification of the perception of the mark as adverse to accepted principles of morality, (ii) establishing whether the majority of the relevant public would consider the mark to be against accepted principles of morality, (iii) broadly speaking, balance the freedom of expression of the applicant with the principles stemming from accepted principles of morality.

The Grand Board in its decision undertook meticulous analysis of the following issues: principles of accepted morality, relevant public, territory and date of the

assessment. It also applied guidance issued in 27/02/2020, C-240/18 P, 'Fack Ju Göhte' case, as well as mentioned recently and settled case law regarding the refusal of registration in respect to the trade marks 'PABLO ESCOBAR' (17/04/2024, T-255/23, Pablo Escobar, EU:T:2024:240) and 'LA MAFIA' (15/03/2018, T-1/17, La Mafia SE SIENTA A LA MESA (fig.), EU:T:2018:146).

The Grand Board highlighted that the refusal based on Article 7(1)(f) EUTMR does not require for the use of a trade mark to be prohibited under national laws or regulations on combating hate speech. The Grand Board stated that provision's rationale is that trade mark registration should not be granted for signs that are contrary to the public policy or moral standards. A sign is contrary to 'accepted principles of morality' if it is perceived by the relevant public as contrary to the fundamental moral values and standards to which a society adheres at a given time. In that case, it is not sufficient for the sign concerned to be regarded as being in bad taste, but it must be an affront to accepted principles of morality.

Whether 'principles of morality' are 'accepted' or not, should be determined according to the social consensus prevailing in that society. In determining objectively what that society considers to be morally acceptable, due account is to be taken of the social context and the circumstances of the part of the Union concerned, including, where appropriate, the cultural, religious or philosophical diversities that characterize that society.

The decision states that the relevant public was assessed in the present case as the consumers targeted by the goods and services, as well as others who may encounter the sign in daily life, considering the viewpoint of a reasonable person with average sensitivity and tolerance. This does not necessarily mean (as the INTA suggested in its observation) that such perception should be represented by the majority.

As to the territory, the reference place for evaluation must be within the EU, and in accordance with article 7(2) EUTMR a trade mark must be refused if the obstacle exists at least in part of the EU. The contested decision was based on the perception of the German- and English-speaking public, even though the term may also be found in other languages, due to the widespread use of both components of the name, either directly or with linguistic adaptations.

The Grand Board affirmed that the only relevant date for the purposes of the assessment of the applicability of Article 7(1)(f) and whether the applied for marks offend the accepted principles of morality is the date of filing, contrary to the applicant's argumentation stated in his observations, which noted that the assessment should be made at the time of the decision.

The Grand Board outlined that the trade mark applied for consists of the word element 'COVIDIOT' on a yellow, rectangular label with three figures, inclined in different directions and arranged like a jester's hat. The word element 'IDIOT' is highlighted in bold. Subsequently, in the further part of the decision, the examination of the origin of the words which compose trade mark 'COVID', and 'IDIOT' was conducted. The Grand Board highlighted that 'COVID' derives from the English abbreviation of the 'coronavirus disease' and it went on to describe the scale and consequences of the pandemic, as well as the strict rules which were imposed within EU countries and all over the world to combat the disease and to keep citizens safe. The Grand Board noted that the application was filed in the middle of the pandemic. Meaning of the word 'IDIOT' was outlined as a derogatory term and widely understood across the EU due to similar meaning in several languages. As the next step, the Grand Board assessed the definition and perception of the word 'COVIDIOT' stating that it means individuals who were not following pandemic safety measures imposed by governments at the time of the pandemic. Such use was also noted in the media, however, not as part of the commercial environment.

The Grand Board found that the combination of the word 'COVID' and 'IDIOT' used in the context for such goods as games, trivializes and ridicules the pandemic.

According to the Grand Board, it creates the impression that the pandemic is something to take lightly and have a laugh about, which can lead to trivializing its deadly and devastating impact. The contested mark is therefore likely to shock or offend not only the victims of that pandemic and their families, but also any person who, on EU territory, encounters that mark and has average sensitivity and tolerance thresholds.

The Grand Board analyzed in the present case the applicant's fundamental rights such as freedom of expression and freedom of art. It was found that freedom of holding and expressing opinions is subject to exceptions, which must have a legal basis (Article 7 (1)(f) EUTMR meets that requirement) and must be proportionate, i.e., must be necessary and aim to protect specific general interests (such as the prevention of disorder or crime, for the protection of health or morals). In the case at hand, the examination relied on the protection of the well-being of citizens, their economic interests, solidarity and mutual respect, and those of life and health.

The Grand Board examined the categorization of expression of an opinion according to the importance of its content, to determine the extent of the protection granted, and it stated that this model puts commercial expression at a lower level than political forms of expression. The fact that a trade mark applied for may contain political content does not entitle it to greater protection as far as freedom of expression is concerned, because a trade mark is not essential to the expression of that political opinion. The registration of an opinion as a trade mark does not bring any advantage to political debate.

As to the freedom of arts, the Grand Board assessed that in this case not any figurative trade mark with a provocative term is art or satire. The simple figurative sign applied for outside of any context, does not reach the threshold of art. The applicant never substantiated that the trade mark was meant to be art and there is nothing to indicate that the public perceives the contested sign as art, and as such it does not meet the scope of protection under Article 13 of the Charter.

The Grand Board also conducted analysis regarding another basis of the refusal – Article 7 (1)(b) EUTMR – lack of distinctive character. The decision reaffirmed the view settled in the case law stating that for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the goods in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish those goods from those of other undertakings. It was further stressed that relevant consumers recognize the meaning of the word 'covidiot' exclusively as a term coinciding with a historical, social and political event, thus it will not facilitate a perception of a trade mark as an indication of goods and services.

Sources:

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Ewelina Madej

EU: The role of freedom of expression in trade mark proceedings (decision of the Grand Board of 16 May 2024 in case R 260/2021-G) – commentary

The case R 260/2021-G involved an appeal concerning EU trade mark application No 18 288 813 by Matthias Zirnsack. The application sought to register the figurative mark "COVIDIOT" for goods in Classes 6, 9, and 28, including metal clips, computer gaming software, mobile apps, board games and toys.



The examiner objected to the application under Article 7(1) (f) EU Trade Mark Regulation (EUTMR), stating that the trade mark violated accepted principles of morality. The term "COVIDIOT" was considered an insult likely to offend the sense of decency of the fair and just-minded.

The objection highlighted that the term discredits people who do not believe in the measures implemented by governments during the COVID-19 pandemic, such as social lockdowns or mandatory masking .

The applicant argued that the trade mark examination should balance the alleged defamatory content with the freedom of expression and freedom of art. The examination should not serve to merely censure 'bad taste'.

The applicant intended to use the trade mark for a game where "COVIDIOT" refers to the protagonists against whom players compete. The use of the sign in connection with a game was deemed socially appropriate. The applicant also stated that the figurative elements in colour clearly allude ironically to 'covidiot'. Art and opinion may be ironic and are protected by freedom of expression and freedom of art.

The Grand Board upheld the examiner's objection, stating that the term "COVIDIOT" is contrary to the accepted principles of morality. The decision emphasised that the term is an insult and likely to offend the sense of decency.

The Grand Board acknowledged the importance of freedom of expression but concluded that the term "COVIDIOT" in the context of the goods applied for was not socially appropriate.

"The word combination of 'Covid' and 'Idiot' is understood in German and English, among other languages. The term is an insult which is likely to offend the sense of decency of the fair and just-minded".

"The trade mark examination of accepted principles of morality must balance the alleged defamatory content with the freedom of expression and the freedom of art. The examination of absolute grounds shall not serve to merely censure bad taste".

The Grand Board's decision in case R 260/2021-G reaffirms the importance of maintaining accepted principles of morality in trade mark applications while balancing fundamental rights such as freedom of expression. The application for the trade mark "COVIDIOT" was ultimately rejected due to its offensive nature.

The above described decision built upon the Court of Justice's statement in "Fack Ju Göhte" court's case (C-240/18 P in the judgment as of 27 February 2020). The main issue was the refusal to register the word sign "Fack Ju Göhte" as an EU trade mark. The refusal was also based on Article 7(1)(f) of Regulation (EC) No 207/2009, which states that trademarks contrary to public policy or accepted principles of morality shall not be registered. The Court found that the General Court had correctly applied the law and that the mark "Fack Ju Göhte" was indeed contrary to accepted principles of morality and thus could not be registered as an EU trade mark.

Source:

<https://www.euipo.europa.eu/>

EU: Interpretation of the term “communication to the public” under Article 3(1) of Directive 2001/29 – based on a judgment of the Court of Justice of the European Union (Case C-135/23).

The reference for a preliminary ruling concerns the interpretation of Article 3(1) of Directive 2001/29/EC, which harmonizes aspects of copyright in the ‘information society’. The request arises out of a dispute between the copyright collecting society GEMA and the manager of an apartment building (GL). The dispute concerns copyright infringement by GL, which provided residents with television sets with indoor antennas for the reception of television signals and the distribution of programs, including music.

The Potsdam Local Court, which is handling the case, raised doubts about whether GL’s action constitutes “communication to the public” under Article 3(1) of Directive 2001/29. Previous case law, including the SGAE ruling (C-306/05) and the Organismos Sillogikis Diacheirisis Dimiourgon ruling (C-136/09), suggests that providing TV sets connected to a central antenna in a hotel qualifies as “communication to the public”. However, the court noted that in the Stim and SAMI ruling (C-753/18), providing radio receivers in rental cars was not considered as such.

The key issue in this case is whether the provision of TVs with indoor antennas, without a central signal distribution system, amounts to “communication to the public”.

The Court established two key criteria for “communication to the public”: (1) an act of communication, and (2) communication to the public. These criteria are assessed individually and in relation to one another. Importantly, the user must play an active role, deliberately intervening to receive access to protected works, particularly if their intervention is profit-driven. Broadcast availability and the potential profit motive are essential components in making this distinction.

The Court, drawing upon established case law, concluded that providing equipment such as a radio receiver in rental vehicles or background music systems does not constitute an “act of communication” under Article 3(1) of Directive 2001/29. These cases are considered as the “provision of physical facilities” rather than active communication to the public. However, the Court ruled that when operators of establishments such as hotels or bars intentionally transmit protected works, such as through television or radio sets, they are performing acts of “communication to the public”. This applies regardless of how the signal is transmitted.

In this case, the apartment building operator provides tenants with TVs equipped with indoor antennas that can receive signals and broadcast music without additional intervention. The Court noted that this intervention is deliberate, as it enables access to broadcasts during the rental period, making it an “act of communication to the public”. The service enhances the value of the apartments, potentially influencing rental prices or occupancy, which supports its profit-driven nature.

To qualify as “communication to the public” under Article 3(1) of Directive 2001/29, two conditions must be met: the protected works must be communicated to the “public”, and the communication must involve a “new public”.

The term “public” refers to an indeterminate and sizable group of potential recipients. The Court emphasized that the operator of a rented apartment building who provides tenants with TVs and indoor antennas, allowing them to access broadcasts without further intervention, may be seen as communicating to a “new public” provided that the apartments are rented on a short-term basis, such as tourist accommodation. This is because short-term tenants, such as hotel guests, constitute an indeterminate group not initially considered by copyright holders when authorizing broadcasts. However, if the apartments are rented to long-term residents, those tenants do not qualify as a “new public”. Consequently, whether the tenants are classified as a “new public” depends on the nature of the tenancy.

Considering the above points, the response to the question submitted for a preliminary ruling is that Article 3(1) of Directive 2001/29 should be interpreted to mean that the term “communication to the public”, as used in this provision, includes the intentional provision by the operator of a rented apartment building of television sets with an indoor antenna that can receive signals and enable broadcasts without additional intervention, as long as the tenants of those apartments can be considered as a “new public”.

UK: Court of Appeal clarifies the criteria for patentability of AI inventions in the UK

In a significant and highly anticipated judgment, the Court of Appeal in *Comptroller-General of Patents, Designs and Trade Marks v Emotional Perception AI Ltd* [2024] EWHC Civ 825 overturned the first instance decision of the High Court, and upheld the finding of the UK Intellectual Property Office (UKIPO) Hearing Officer on the patentability of an AI related invention.

Background

Emotional Perception AI Ltd applied for a UK patent which claimed a system for providing improved media recommendations to users using a trained artificial neural network (ANN). The recommendations are sent to a user by way of a message and a file. The system is commonly used for music websites particularly where a user may be interested in receiving music similar to another track in their playlist.

In its broadest sense, the ANN is trained in a manner to enable identification of semantically similar tracks (i.e. those that evoke a similar emotional response). This is by taking into account natural language descriptions of a music file as well as its physical properties based on human perceptions and descriptions.

Whilst the UKIPO Hearing Officer accepted that this represented a significant improvement of the identified prior art, it refused Emotional Perception’s patent application on the basis that the AI system fell within the “*program for a computer*” exclusion under s1(2)(c) of the Patents Act 1977, and did not produce a technical contribution to the state of the art. Emotional Perception appealed the Hearing Officer’s decision to the High Court.

In the first decision before the UK courts to consider the application of the “*program for a computer*” exclusion to the patentability of an AI related invention, the High Court overturned the UKIPO decision, and concluded that an invention involving an ANN is not a “*program for a computer*” under UK law and should, in effect be treated as a piece of hardware. It held that s1(2)(c) of the Patents Act 1977 ought not to be invoked, either because the invention as claimed was not a “*computer program as such*”, or if it was, because the invention as claimed demonstrated a technical effect.

Following the High Court judgment, the UKIPO reacted quickly and issued statutory guidance for examining patent applications relating to inventions involving ANNs, confirming that UK examiners would not “*object to inventions involving ANNs under the program for a computer*” exclusion under s1(2)(c) of the Patents Act 1977.

The High Court decision was appealed by the Comptroller-General to the Court of Appeal, who reversed the decision again in line with the view of the UKIPO Hearing Officer.

Court of Appeal Decision

The first point the Court of Appeal had to determine was whether Emotional Perception’s ANN fell within the definition of a “*computer program*” under s1(2)(c) of the Patents Act 1977. Birss LJ stated that a computer program could be defined as “a set of instructions for a computer to do something”, with a computer defined as “*a machine which processes information*”.

Emotional Perception argued that a computer program takes the form of serial, logical ‘if-then’ type statements defined by a human programmer, which define exactly what it is that the programmed computer does, and therefore the weights and biases of an ANN were not a computer program.

The Court of Appeal however rejected this argument and applying its definition of “*computer program*” and “*computer*” found that an ANN is “clearly a computer – it is a machine for processing information” regardless of how it is implemented.

It went on to determine that Emotional Perception’s ANN based music recommendation tool was a set of instructions for a computer to do something, and therefore was a computer program that fell under the exclusion at s.1(2)(c) of the Patents Act 1977.

Having found that Emotional Perception's ANN was a computer program, the Court of Appeal then had to consider whether it made a technical contribution which therefore made it patentable.

In considering technical contribution, the Court of Appeal found that the process of training the ANN was *"in effect, part of the creation of the program"* and therefore did not form part of the technical contribution. The output of the ANN, which was the provision of sending a recommendation message file to a user device, was simply *"the presentation of information"* which was also not patentable under another exclusion at s.1(2)(d) of the Patents Act 1977 unless it went further and involved a technical contribution. The Court found that the improvement of the file recommendation was based on semantic cognitive or aesthetic qualities rather than technical ones. The output therefore could not be held to turn the claimed invention into a system which produces a technical effect outside the excluded subject matter, and therefore was not patentable.

The future for the patentability of AI inventions in the UK

The UK courts who have for decades grappled with the complexities of computer implemented inventions, are now also having to consider AI related inventions. The High Court decision last year was expected to lead to a significant liberalisation to the patentability of AI related inventions in the UK with the UKIPO guidance issued after the decision signalling that patents for AI related inventions may be more amenable at the UKIPO, thereby making the UK an attractive place for filing and enforcing AI patents. The reversal of the decision by the Court of Appeal, has however ended this short period of divergence in the UK from the approach taken by the European Patent Office.

Following the Court of Appeal decision, the UKIPO suspended the previous guidance it issued on the examination of AI related patent applications. It went on to issue new **guidance** in July 2024 which made it clear that examiners should assess ANN-implemented inventions in the same way as other computer implemented invention for the purposes of s.1(2)(c) of the Patents Act 1977. This means that ANN-implemented inventions will only be patentable if they overcome the high hurdle of demonstrating that they make a *"technical contribution"*.

Emotional Perception has indicated that it intends to appeal the decision to the Supreme Court. It will be interesting to see whether the rapid development of AI related inventions and ANNs will ultimately result in a divergence of approach to the patentability of AI inventions in different jurisdictions, resulting in some jurisdictions being more attractive than others to seek and enforce patent protection.

Aleksandra Powichrowska

EU: EUIPO's appeal in the Basmati case: May an Opponent still demand invalidation of the Board of Appeal's decision dismissing the opposition by the General Court when the previous right relied upon as the basis of that opposition ceases to be protected? (C 801/21 EUIPO v. Indo European Foods Ltd).

On June 20, 2024, the Court of Justice of the European Union handed down a long-awaited ruling in EUIPO v. Indo European Foods (C-801/21 P), an appeal, brought against the General Court's judgement in Indo European Foods v. EUIPO (T-342/20, 'judgment under appeal'). Fundamentally, the case considers the consequences of Brexit on trademark proceedings before the General Court.

The question arises as to whether an owner's prior right is valid during the Board of Appeal (BoA) stage, it will still be considered to have relevance in commencing proceedings before the General Court even if the right ceases to exist at a later stage? Does the Brexit Withdrawal Agreement retroactively invalidate a prior non-registered right in the UK, treating it as if it had never existed?

In June 2017, Mr Chakari filed an application before the EUIPO for registration of an EU trademark for a figurative sign. Registration was sought in respect of goods made of rice, in accordance with Classes 30 and 31 of the Nice Agreement.

In October 2017, Indo European Foods Ltd ('Indo') filed a notice of opposition to registration of the trademark. The opposition was based on the ground of extended passing off of the non-registered mark BASMATI in Article 8(4) of Regulation 2017/1001.

Both the Opposition Division and Board of Appeal (BoA) of the EUIPO, rejected the opposition, concluding that Indo had not sufficiently demonstrated that the requirements of Article 8(4) of Regulation No. 207/2009 would be met.

In 2020 Indo filed an appeal to the General Court. The important information is the fact that during the course of the appeal, the transition period under the Brexit Withdrawal Agreement ended.

The EUIPO indicated that Indo could no longer invoke the earlier British trademark due to the end of the transition period. According to the EUIPO:

1. the opposition had become irrelevant, and
2. Indo had no interest in initiating the proceedings.

The appeal by Indo was upheld by the General Court on October 6, 2021, which annulled the Board of Appeal's decision. Despite the expiration of the transition period, in the General Court's view, there was still a purpose and interest in the appeal, given that Indo's prior right was valid at the time of the BoA's decision. Notably, EUIPO did not challenge the validity of Indo's prior right at the BoA stage, nevertheless, in EUIPO's view Indo lost its interest after the expiration of the transitional period, and the General Court should have adjudicated the matter.

The annulment of the BoA's decision led to an appeal by the EUIPO to the CJEU.

In this case, the Advocate General Maciej Szpunar issued an opinion in which he agreed with the BoA, which said that the court was right to find that Indo had a continuing interest, taking into account that Indo's prior right was valid at the time of the BoA decision. In the AG's view, the General Court was correct to hold that Indo had a continuing interest given that Indo's prior right was valid when the BoA issued its decision. It was also pointed out that there was nothing in the Brexit Withdrawal Agreement leading to the conclusion that the UK's earlier rights should be treated as never having existed.

The validity of Indo's prior right at the BoA stage was not challenged on appeal. However, EUIPO argued that the General Court Instance should not have ruled on the case because Indo no longer had an interest after the expiration of the transition period. EUIPO divided its arguments into three parts:

1. the General Court mistakenly conflated the issue of whether the transition period could impact the validity of the Board of Appeal's decision with the need for an ongoing interest in pursuing legal action;
2. the General Court's decision overlooked key aspects of EU trade mark law, including the principle of territory and the core function of trademarks;
3. the General Court's errors placed a requirement on the EUIPO to ignore the legal consequences of the end of the transition period.

The appeal was dismissed by the CJEU, which concluded that:

1. the action's purpose remained intact;
2. Indo depends on an infringement of Art. 8(4) EUTMR by the BoA rejecting its opposition; and
3. the decision made by the BoA negatively impacted Indo's economic interest (without specifying what this interest would be).

The above arguments, in the opinion of the judges, were sufficient to recognize that Indo still had an interest in the proceedings.

EUIPO's arguments such as the special nature of opposition proceedings, the essential function of the trademark, the principles of territoriality and the unitary nature of the EU trademark were considered irrelevant. The interest in the proceedings should not be evaluated solely based on the legal interests safeguarded by the EUTMR, nor should it be determined only by the potential for a conflict to arise.

The CJEU dismissed the EUIPO's position that, should Indo's opposition succeed, the contested mark could be transformed into national applications across all remaining EU Member States.

The judges ruled that the General Court's motives were implicit and deemed it adequate to allow the parties to understand the causes for the judgment, and provide the Court with sufficient information to exercise its review powers.

Emmanuel Durand and Benjamin Templé

FR: Combatting ambush marketing: focus on the 2024 Olympic and Paralympic Games

As the most widely broadcast sporting event in the world, attracting billions of viewers, the Olympic and Paralympic Games are a commercial godsend for any company wishing to promote its products, brand and activities to the general public. It is therefore extremely tempting for a given company, wishing to increase its exposure, without cost, to associate itself, in one way or another, with this global event. The fight against ambush marketing is one of the priorities of the Paris Organizing Committee for the 2024 Olympic and Paralympic Games, fully aware of the need to preserve the integrity of the Olympic and Paralympic "brand", as well as the interests of official partners and licensees having contributed to financing a significant part of these Games.

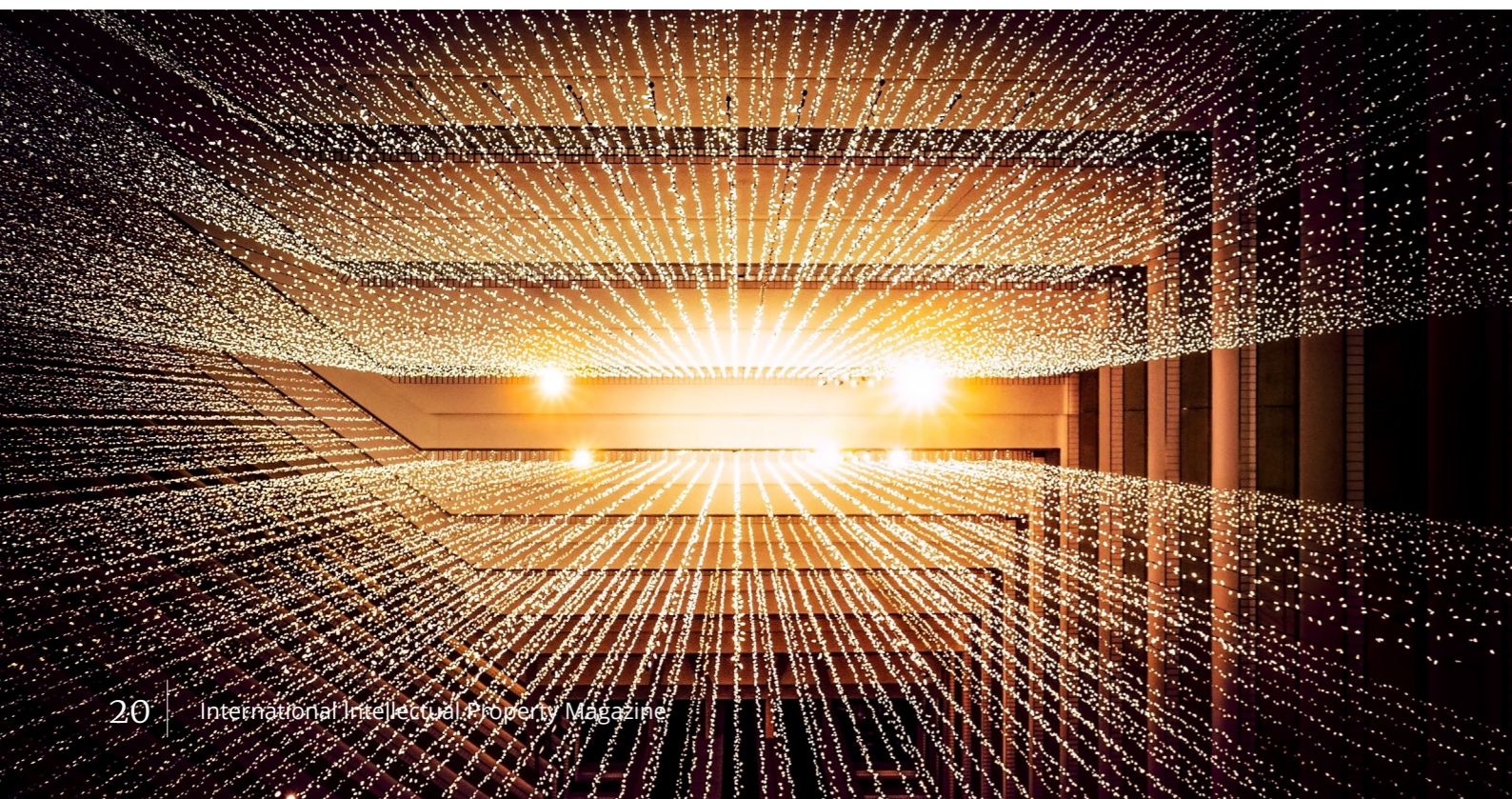
To grasp the concept of ambush marketing, it is essential to bear in mind that certain elements benefit from particular protection designed to prevent any use not previously authorized by the Olympic and Paralympic bodies, by third parties. As such, the International Olympic Committee (IOC) and the International Paralympic Committee (IPC) hold exclusive rights over Olympic and Paralympic properties (symbol, motto, flag, anthem, designations, emblems, flame and torch, etc.). Both the IOC and the IPC rely on the National Olympic Committees (NOCs) to guarantee and ensure the protection of these Olympic and Paralympic properties in their respective countries. During the Olympic and Paralympic period however, the Organizing Committee (i.e., for the Paris 2024 Games, the 2024 Organizing Committee for the Olympic and Paralympic Games (hereinafter "PARIS 2024")) is responsible for protecting all Olympic and Paralympic properties in the host country, the IOC and the IPC remaining responsible for such protection outside of the host country. The Organizing Committee is also, for the Games it is in charge of organizing, the owner of several trade marks and designs (by way of example, PARIS 2024 holds protection over the "Paris 2024" trade mark, the "Games Wide Open" slogan and the official mascots called Phryges).

For the Paris 2024 Games, the Olympic and Paralympic properties, as well as the trade marks and designs owned by PARIS 2024, benefited from classical protection under the provisions of the French Intellectual Property Code (copyright, trade mark and design rights). They were also protected by special provisions set out in articles L. 141-5 and L. 141-7 of the French Sport Code, which prohibit the simple act of "register as a trade mark, reproduce, imitate, affix, remove or modify" certain Olympic and Paralympic properties listed in these two articles.

The guiding principle in terms of commercial communication linked to the Olympic and Paralympic Games is therefore simple: a company will not be able to legally reproduce the Olympic and Paralympic properties or, more broadly, associate its image with this major sporting event without the authorization of the Organizing Committee and the payment of substantial financial consideration via the conclusion of a sponsorship, partnership or licensing contract.

This principle, which at first sight appear as a major restriction on companies' freedom of communication, is however perfectly understandable in that it enables the protection of the rights associated with the Olympic and Paralympic Games and guarantees, furthermore, the preservation of the investments made by the Games' official partners, which, it should be remembered, secure the staging of the Games.

Any behaviour inconsistent with the above-mentioned principle - consisting of a given company associating itself directly or indirectly with the Olympic and Paralympic Games, in order to benefit from the notoriety of this event, without at the same time paying sponsorship fees to the Organizing Committee - must be defined as ambush marketing. The French case law has defined this type of conduct, which in practice can be assimilated to a form of unfair competition/parasitism, in the following terms: "an advertising strategy put in place by a company in order to associate its commercial image with that of an event, and thus to benefit from the media impact of the said event, without paying the related rights and without having obtained prior authorization from the event organizer" (Paris Court of appeal, June 18, 2018, n° 17/12912).



Ambush marketing can take different forms. The most commonly used method consists of entities wishing to increase their exposure during this global event, in organizing an advertising campaign alluding more or less explicitly to the Games, or directly reproducing or imitating a brand and/or a logo belonging to the Olympic and Paralympic institutions. Other marketing methods are also regularly employed, such as the organization of promotional game contests linked to the Games, communications on social media, or the promotion of a company's brand or products during marketing operations carried out directly within the sports venues in which the Games take place.

In order to protect the investments made by official partners and licensees, PARIS 2024 has drawn up a genuine plan aimed at eradicating, to the extent possible, all forms of ambush marketing. PARIS 2024 has implemented a particularly robust monitoring system, with a dedicated team within the Organizing Committee, backed by external service providers and AI, carrying out a daily scan of the Web in order to flush out any companies wishing to promote their brand or products without the prior approval of the Olympic and Paralympic bodies. PARIS 2024 has also deployed agents directly in the field to combat brand intrusions into Olympic and Paralympic venues.

As pointed out by its General Counsel Mr Romain Voillemot, PARIS 2024 - intransigent with regard to major groups perfectly aware of the rules in force and yet engaging in ambush marketing practices - has adopted a more nuanced attitude with regard to smaller entities, often ill-informed, offering them a grace period and support to ensure compliance.

Like their predecessors during previous editions of the Olympic and Paralympic Games, proponents of the Olympic and Paralympic movement have used the various legal tools at their disposal - notably the provisions of the French Intellectual Property Code in relation to counterfeiting, the provisions of articles L. 141-5 and L. 141-7 of the French Sport Code mentioned at the beginning of this article, as well as the provisions of article 1240 of the French Civil Code (governing tortious liability) enabling the apprehension of acts of unfair competition or parasitism, including ambush marketing - in order to obtain the cessation of ambush marketing practices and the conviction of offending companies to pay damages.

As with all major sporting events, the 2024 Games have revealed (once again) that if acts of identical reproduction of Olympic and Paralympic properties, the more or less crude adaptations of these elements and unobvious strategies of association with the Games are apprehended, the same cannot be said of the more sophisticated strategies implemented by certain companies, openly flirting with the red line. This cat-and-mouse game brought to light several instances, during the period of the Games, during which people were notably able to spot advertising for Heinz Ketchup, including a woman crunching a red lid like a medal, or an advertising campaign for a French brand, Intersport, based on five different types of posters displayed in the Paris subway, where we could see a swimsuit of the brand and its price associated with the following slogan: *"Pour éviter les bouchons cet été, passez par la Seine"* ("To avoid traffic jams this summer, take the Seine").

Stéphanie Berland

EU: Protection of 3D trademarks: clarification from the General Court of the European Union

The General Court of the EU, June 26, 2024, T-260/23, Volvo Personvagnar AB / EUIPO

The question of the protection afforded to three-dimensional trademarks registered for shapes of goods is becoming clearer as the decisions handed down by the European Court of First Instance become more detailed.

In the present case, Volvo filed an EU trademark application in 2021 for a three-dimensional sign depicting, from three different angles, a car's front headlight, with a shape tapering to the right and incorporating a clear, geometric LED graphic design resembling a horizontal Y.



This sign had been registered in particular for "lighting devices and reflectors for vehicle lighting; headlights for vehicles" in class 11 and for "vehicles and means of transport" in class 12.

The EUIPO examiner and the Board of Appeal successively refused registration on the ground that the sign lacked the minimum distinctive character required by Article 7(1)(b) EUMR. Volvo lodged an appeal.

On June 26, 2024, the General Court of the European Union annulled the rejection of the trademark application stating that *"the headlights in question differ significantly from other headlight designs"* and that the three-dimensional trademark is indeed distinctive.

The Court first recalls the criteria for assessing the distinctive character of three-dimensional trademarks when they consist of the shape of the product itself. These criteria are not different from those applicable to other categories of trademarks. But they do differ in that *"the perception of the relevant public is not necessarily the same"*, because *"average consumers are not in the habit of presuming the origin of goods on the basis of their shape or that of their packaging, in the absence of any graphic or textual element"*. It points out *"only a trade mark which deviates significantly from the norm or customary practice in the sector and is therefore capable of fulfilling its essential function of origin is not devoid of distinctive character"*.

In the light of these principles, the Court analyzed the particular shape of the headlight applied for. It determined that the horizontal Y shape is neither common nor typical for products in the automotive industry. Additionally, this distinctive appearance gives the headlight a sufficiently marked form, allowing it to stand out from other front LED headlights on the market. Finally, the overall aesthetic result is likely to capture the attention of the relevant public. More broadly, the Court held that headlights have become distinctive as essential elements of a vehicle's appearance, allowing consumers to differentiate between models from various manufacturers. *"The design of front headlights is important for emphasizing the commercial origin [...] they can be recognized from a greater distance, in daylight and darkness,"* the Court stated. Thus, the Court annulled the decision to refuse the registration of the three-dimensional trademark, considering it to have the minimum required level of distinctiveness under Article 7(1)(b) of Regulation 2017/1001. EU trademark law thus protects Volvo's headlight design.

ES: Recent case law developments in Spain: Trade mark infringement in the Inditex vs. Buongiorno case

Introduction

In trade mark law, the protection of well-known brands is one of the fundamental pillars to ensure fair competition in the market and safeguard intellectual property rights. The case between Inditex S.A. (“Inditex”), owner of the trade mark ZARA, and Buongiorno Myalert S.A. (“Buongiorno”), a telecommunications services company, is a relevant example of how conflicts regarding the unauthorized use of a well-known brand are resolved. This article examines the Supreme Court’s ruling in this dispute, analysing its implications for both trade mark doctrine and legal practice.

Background of the case

The origin of the conflict was a promotional campaign launched by Buongiorno in 2010, in which it offered the chance to win a “ZARA gift card” worth EUR 1,000 as a prize in a draw for new subscribers to its multimedia messaging service named “Club Blinko”. After clicking on a banner to access the prize draw, on the next screen the subscriber was shown the ZARA brand in a rectangle, similar to the design of gift cards. Inditex, the owner of the well-known trade mark ZARA, filed a lawsuit claiming that the use of its brand in this promotion infringed their exclusive rights.

On 15 March 2016, Commercial Court No. 2 of Madrid ruled against Inditex, arguing that Buongiorno had not infringed the trade mark ZARA. On 18 May 2018, the Provincial Court of Madrid dismissed Inditex’s appeal and confirmed the decision issued in the first instance, reaffirming that the trade mark ZARA had not been infringed, since although Buongiorno had made active use, in the course of trade, of the trade mark ZARA to promote their own services, such use did not affect any of the functions of the trade mark and did not damage its reputation.

Key legal aspects

The rights discussed in this case are focused on the protection of the well-known trade mark ZARA and the scope of Inditex’s exclusive right to prevent its unauthorized use by a third party. The key points of the dispute revolved around two aspects: whether Buongiorno’s use of the ZARA brand infringed Inditex’s rights, or whether such use fell under any of the limitations provided by the Spanish Trade Mark Law for the lawful use of a third-party’s trade mark.

- Inditex’s Arguments: The plaintiff argued that the use of the trade mark ZARA as part of the “Club Blinko” promotional campaign constituted an infringement of their exclusive trade mark rights, since Buongiorno used a well-known trade mark without authorization in order to take unfair advantage of its reputation.
- Buongiorno’s Arguments: The defendant argued that use of the trade mark ZARA did not create market confusion or affect the brand’s reputation. According to Buongiorno, the draw simply offered ZARA-branded products as prizes, thus no infringement occurred.

Reference for a preliminary ruling and ECJ judgment

Inditex filed an extraordinary appeal for procedural infringement and a cassation appeal before the Supreme Court against the judgment rendered in the second instance. The Supreme Court decided to stay the proceedings and sent a request for a preliminary ruling to the Court of Justice of the European Union (“ECJ”). The preliminary question focused on clarifying whether use of the trade mark ZARA by Buongiorno, despite being considered, *per se*, an infringement of Inditex’s rights, may be however covered by the limitation provided for in Article 37(1)(c) of the Spanish Trade Mark Law.

In its previous version, corresponding to the transposition of Directive 89/104 (which was repealed and replaced by Directive 2008/95, although the wording of the relevant provision was not amended), Article 37(1)(c) stated the following:

“The right conferred by the trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade, the elements stated below, provided that such use is in accordance with honest practices in industrial or commercial matters:

(...)

(c) the trade mark, where it is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.”

In the Supreme Court’s view, Buongiorno’s conduct could align more with the current wording of Article 37(1)(c), corresponding to the transposition of Directive 2015/2436, which reads as follows:

“A trade mark shall not entitle the proprietor to prohibit a third party from using, in the course of trade:

(...)

(c) the trade mark for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark, in particular, where the use of the trade mark is necessary to indicate the intended purpose of a product or service, in particular as accessories or spare parts.”

The ECJ, in its judgement of 11 January 2024 (Case C-361/22), clarified that the previous wording of Article 37(1)(c) covered the use of the trade mark in the course of trade by a third party exclusively for the purpose of identifying or referring to goods or services as those of the proprietor of that trade mark “only when such use of the trade mark is necessary to indicate the intended purpose of a product marketed by that third party or of a service offered by that party”. The ECJ stated that the Supreme Court should determine, taking into account all the circumstances of the case, whether use of the trade mark ZARA by Buongiorno was necessary to indicate the intended purpose of a service which Buongiorno offered and, as appropriate, whether such use was made in accordance with honest practices in industrial or commercial matters.

In contrast, according to the ECJ, the new wording of Article 37(1)(c) (derived from Directive 2015/2436), allows greater flexibility in the use of third-party trade marks, and a use that could be prohibited under Directive 2008/95 now constitutes one of the situations of “lawful use which the proprietor of a trade mark cannot oppose” under Directive 2015/2436.

Supreme Court judgment

Following the ECJ’s response, on 10 April 2024 the Supreme Court ruled against Buongiorno. The Court stated that Buongiorno had used the trade mark ZARA, which is undoubtedly well-known in Spain, without authorization to promote their own services (and not those of Inditex), thus riding on the coattails of the brand’s reputation. According to the Supreme Court, the only doubt was whether Buongiorno’s use of the trade mark ZARA was covered by Article 37(1)(c) of the Spanish Trade Mark Law.

The Supreme Court, applying the ECJ ruling, based its judgment on the previous wording of Article 37(1)(c), which established a more restrictive regulation and was applicable *ratione temporis* at the time of the facts in the main proceedings. This version only allowed the use of a third-party trade mark if it was “*necessary to indicate the intended purpose of a product or service.*” In the case of Buongiorno, it was not demonstrated that use of the trade mark ZARA complied with this requirement, as it did not involve accessories, spare parts, or other products with a functional link to the trade mark owner, but a service provided by Buongiorno itself.

The Supreme Court concluded that Buongiorno could not rely on the limitation to trade mark rights introduced by the subsequent Directive 2015/2436, which broadens the scope of referential use. Therefore, the Supreme Court decided that Buongiorno’s use of the ZARA brand in the promotion constituted a trade mark infringement, since it was not justified by the need to indicate the intended purpose of a service offered by Buongiorno.

Impact and repercussions

With the new wording of Article 37(1)(c) of the Spanish Trade Mark Law, there is now an opening for a broader interpretation of use of trade marks by third parties. In contrast to the previous version, which required that use of the trade mark be “*necessary to indicate the intended purpose of a product or service*”, the current wording introduces a more general interpretation, allowing reference to a trade mark even in contexts where there is no direct link to the goods or services of the trade mark owner.

This change provides flexibility for third parties who use third-party trade marks referentially, which could result in more companies taking advantage of this provision to use well-known trade marks in their promotions or complementary products. However, it also raises the risk of an increase in disputes, as trade mark owners may interpret these actions as an attempt to take advantage of the reputation of their trade marks without authorization, thereby expanding the scope for future legal conflicts.

This more forgiving approach requires courts to take a careful approach, balancing the interests of trade mark protection against legitimate uses that third parties may make under the current interpretation of Article 37(1)(c) of the Spanish Trade Mark Law.



Legal Developments

Oskar Tułodziecki

PL: Recent changes in the Polish Copyright and Related Rights Act

On 20 September 2024, new provisions of the Copyright and Related Rights Act came into force in Poland. This substantial round of amendments covers, among others, the following topics:

Definition of broadcasting supplemented by 'direct injection'

It has been observed that when a broadcasting entity does not deliver its channel directly to the public but instead the channel is delivered only to distributors, such as cable or satellite operators, it is difficult to properly classify such activity. From a broadcaster's perspective, this does not constitute regular broadcasting, because only distributors of signals are recipients of the channel. From the cable and satellite operator's side, this is not typical retransmission activity because the "transmission" component is absent. That is why the concept of 'direct injection' has been developed. However, it is not obvious whether the Polish implementation has genuinely simplified the situation of market players. In particular, they are afraid that both tv broadcasters and retransmission operators will have to clear their activities with collective management organisations. If such is the case, the Directive's purpose will not be achieved.

New regime of responsibility for online platforms

This is a long-awaited change that should hopefully make platform operators accountable for infringement cases. After a controversial decision of the CJEU in the YouTube case, it is even more important that the new regulation will bring order to the field of large-scale exploitation of copyright protected content. How in practice these new provisions will work remains to be seen.

Extension of collection societies' intervention with respect to all types of retransmission

When the Copyright Act was enacted three decades ago technology was very different, and radio and television retransmission was limited to cable. With the passage of time, new forms of retransmission emerged. The law did not, however, follow technological progress. As a result, especially satellite retransmission remained unregulated, causing uncertainties. A new definition of retransmission is now technology-neutral and the legal situation of all players engaged in retransmission activity should be identical.

TDM exception for heritage and educational establishments

The above entities have been given a right to reproduce works for the purpose of exploring texts and data. These activities must be limited to their scientific purpose and cannot be connected with the achievement of any direct or indirect commercial advantage.

General TDM exception

Under the amended Copyright Act, it will also be permitted to explore works that have been disseminated for the purpose of text and data exploration. However, right holders have an opt-out right which means that should they exercise this right, the works covered by the opt-out will not be covered by this type of exception. It remains to be seen how exactly the system of opt-outs will work. During the legislative discussions, creative industries were particularly concerned that this new type of exception may be used for feeding AI with protected content.

Broadening the citation exception for educational establishments

The right of citation has been substantially broadened. Educational establishments are now allowed to use protected copyright content for the purpose of their activities. The scope has been defined very broadly. They are allowed to use smaller works in their entirety as well as up to 25% of works of a more substantial size, provided that the use will occur on the premises of these establishments or in a safe online environment. Such use must not have any commercial purpose.

New regime for out-of-commerce works

Out-of-commerce works will be regulated differently than before. Poland had its own provisions relating to these types of works, but they had to be modified for alignment with the DSM Directive.

New provisions relating to contracts with authors and their remuneration

In the above field, the legislators decided to intervene substantially in the freedom of contract principle. Assuming that the author is always a “weaker party” to contracts such as license or assignment, there are now several provisions that are aimed at strengthening authors’ position vis-à-vis producers, publishers and distributors. Both assignments of rights and license agreements will now cover only those modes of exploitation which are specifically named in the contract. Statutory guidelines contained in the amended provisions state that authors’ remuneration must be appropriate, relevant to the scope of the rights granted and advantages derived from the exploitation of the work. Authors will have a right to apply to courts for an increase in their remuneration if its original amount was “disproportionately low in relation to the advantages derived by the assignee or licensee. Authors will enjoy the right of information relating to revenue generated to their works. Authors have been granted a statutory right to revoke or withdraw from agreements, or to modify such agreement to a non-exclusive license, should their works be blocked and not exploited by publishers, producers or distributors.

Audiovisual authors’ additional remuneration extended to VoD and retransmission

Art. 70 of the Copyright Act provided for statutory remuneration (equitable or proportional) for audiovisual authors and performers, for certain types of exploitation of audiovisual works, including cinema exhibition, broadcasting and home entertainment, etc. This remuneration must be paid through competent collective management organisations. With the passage of time, certain fields such as home video have become less commercially relevant. On the other hand, streaming has emerged as a new and significant form of reaching film audiences. For this reason, the scope of the above provision has been broadened by adding on-demand services and retransmission. This was by far the most disputed provision from among the entire set of the Copyright Act’s amendments. While collection societies, in particular, heavily lobbied for the proposed extension, producers and online operators pointed at several reasons why Art. 70 in its current form should not be broadened in its scope. However, a PR campaign of authors’ organization was very successful, and finally remuneration for audiovisual authors has been extended to new fields. It remains to be seen how the overall system will work, especially in light of the most recent decision of the Supreme Court relating to the relationship between cinema exhibitors and collection societies, as regulated by Art. 70. There is no doubt that this decision may have a serious impact on VoD as well.

Mediation by the Copyright Law Commission in VoD licensing disputes

The Copyright Law Commission, whose members comprise a group of arbitrators who may be appointed to decide on collection societies’ tariffs, has gained a new competence. Namely, parties that negotiate an agreement relating to publicly making available an audiovisual work may apply to the Copyright Law Commission for mediation, choosing one of the members as a mediator. This new provision is quite vague, and it is presently difficult to foresee if it will have any real significance. The main problem that appears is that not only must the negotiating parties be interested in the mediation, but they would have to be in agreement in relation to the choice a particular arbitrator.

Compulsory remuneration for artists for on-line exploitation

The second most disputed provision in this legislative round was the introduction of the right of artistic performers to equitable remuneration for online exploitation of their performances. However, unlike in the above discussed scheme for remuneration for audiovisual authors and performers, there is no compulsory intervention of collection societies, which means that flexibility will exist and the possibility for various players (artists, platforms and publishers) to make contractual arrangements which will hopefully be satisfactory to all parties involved in online distribution of music.

New right for publishers and journalists for on-line exploitation of content

In line with the DSM Directive, publishers will now enjoy a new type of related right, namely a right in press publication. This right should be significant and play a role in publishers’ efforts to participate in dissemination of their content by online platforms. Interestingly, authors of articles will be entitled to 50% of the publishers’ revenue, leaving the other half to the publishers themselves. This right expires at the end of the year that follows the year of publication. In connection therewith, publishers will have a right to request current information and the right to audit relevant platforms’ records. The Office of Electronic Communication (“OEC”) will have a strong and vital role in the context of determination of the contractual relationship between publishers and platforms. Firstly, mediation may be conducted under the auspices of Chairperson of the above Office. Secondly, should all efforts to reach an agreement with a platform prove fruitless, it will be possible to apply to the Chairperson of the OEC for determination of the remuneration due to the publishers.

These all are far-reaching and very significant changes, to which all participants in content marked as creative will have to adapt.

Olivia O’Kane

IE: Navigating the New Landscape of Online Safety and Liability for Tech CEOs and Senior Officers

In an era where digital interactions are integral to daily life, we are seeing a shift towards increased accountability being held against Tech companies and in certain instances, CEOs and senior officers. In the UK a significant step forward has been taken affecting this development with the introduction of the Online Safety Act 2023. The legislation aims to make internet services safer for individuals in the UK, granting authorities to the Office of Communications (Ofcom) to enforce appropriate and proportionate penalties for offences committed. Notably, the Act includes a specific provision for Senior Managers’ liability in information offences.

In the Republic of Ireland (“ROI”), the introduction of the Harassment, Harmful Communications and Related Offences Act 2020 demonstrates an approach toward holding CEOs and senior officers personally accountable for offences committed under their watch. This can result in imprisonment or fines, depending on the severity of the offence. The Online Safety and Media Regulation Act 2022 further enforces online safety codes, carrying fines for both individuals and providers.

The ROI is also subject to Regulation (EU) 2922/2065, also known as the Digital Services Act 9 (“DSA”), in which very large online platforms (“VLOPs”) are to take actions to mitigate risks associated with their services such as adapting their methods of moderation and their algorithmic systems.

Blocking order injunctions have become a crucial tool in combating intellectual property rights infringements. These orders may for example, require internet service providers (ISPs) to block access to websites hosting infringing material. A notable case in this realm is *Columbia Pictures Industries Inc v British Telecommunications Plc* [2021] EWHC 3438 (Ch), where the court found that the telecommunication provider was aware of the infringement and required them to block access to the infringing websites.

The Norwich Pharmacal Order (“NPO”), established in the House of Lords’ decision in *Norwich Pharmacal v Commissioners of Customs & Excise* [1974] UKHL 6, is another critical legal tool employed in the UK and in Ireland. It is typically used as a way to obtain a court order against a third party in order to obtain personal data and information that could lead to the identification of wrongdoers, providing a mechanism for claimants to obtain information necessary to pursue legal action.

In the realm of cryptocurrency, in the UK the 2023 Crypto Open Patent Alliance case has garnered significant attention, with the primary issue being the ‘identity issue’, questioning whether Dr Craig Wright was the pseudonymous “Satoshi Nakamoto”, the creator of Bitcoin. The potential implications of this case on the future assertion of IP rights to Bitcoin and its underlying technology were vast. However, the ruling highlighted the importance of the NPO in identifying wrongdoers and obtaining necessary information, in this case finding that Dr Wright could not be identified as the creator of Bitcoin.

Globally, the movement towards director and officer liability is gaining momentum. In Brazil, X (formerly known as Twitter) closed its office due to a censorship row involving CEO Elon Musk, with a Supreme Court Judge ordering the blocking of accounts accused of spreading disinformation. In France, the Chief Executive of Telegram was recently arrested for allowing alleged criminal activity on the app. Telegram has previously denied having insufficient methods of moderation. In the USA, Mark Zuckerberg, CEO of Meta, faced a Senate hearing in January 2024 where he apologised to bereaved parents who cited his companies as directly contributing to their children’s exploitation online and in some cases, death. Zuckerberg was joined by CEOs from TikTok, X and Snap to face calls from government representatives for better action in ensuring child safety online. In the UK Molly Russell inquest into the suicide of a teenage girl, the coroner held inter alia: “I recommend that consideration is given by the Government to reviewing the provision of internet platforms to children, with reference to harmful on-line content, separate platforms for adults and children, verification of age before joining the platform, provision of age specific content, the use of algorithms to provide content, the use of advertising and parental guardian or carer control including access to material viewed by a child, and retention of material viewed by a child. I recommend that consideration is given to the setting up of an independent regulatory body to monitor on-line platform content...”.

This trend towards increased accountability for platforms and its senior officers and directors is evident across Europe, Latin America and North America. For tech companies in the UK and ROI, this evolving legal landscape underscores the importance of proactive compliance and robust governance. As the law continues to develop, particularly under the DSA, the establishment of new precedents seems not a question of if, but when.

PL: Summary of significant case law regarding claims for information vis-à-vis intermediaries in relation to IP infringements.

Provisions on the right of information awarded to IP proprietors as per Directive 2004/48/EC on the enforcement of intellectual property rights (also known as the Enforcement Directive) were already implemented into the Polish legal system earlier; however on July 1, 2020, significant amendments to the Polish statutory provisions regulating the right of information entered into force. As legal commentators summarize, the reason for making these changes was that the previous placing and wording of the provisions in the Polish legal system resulted in lack of precision and systemic unification. The past implementation was therefore assessed as dysfunctional. In the course of legislative works, emphasis was placed on balancing the position of the entity obliged to deliver the information and the position of the IP rightholder. To that end, while obtaining certain information relating to infringement of IP rights is often necessary before the actual assertion of claims in court proceedings, the information granted should be used for the purpose of seeking a civil remedy for infringement rather than for any other purposes.

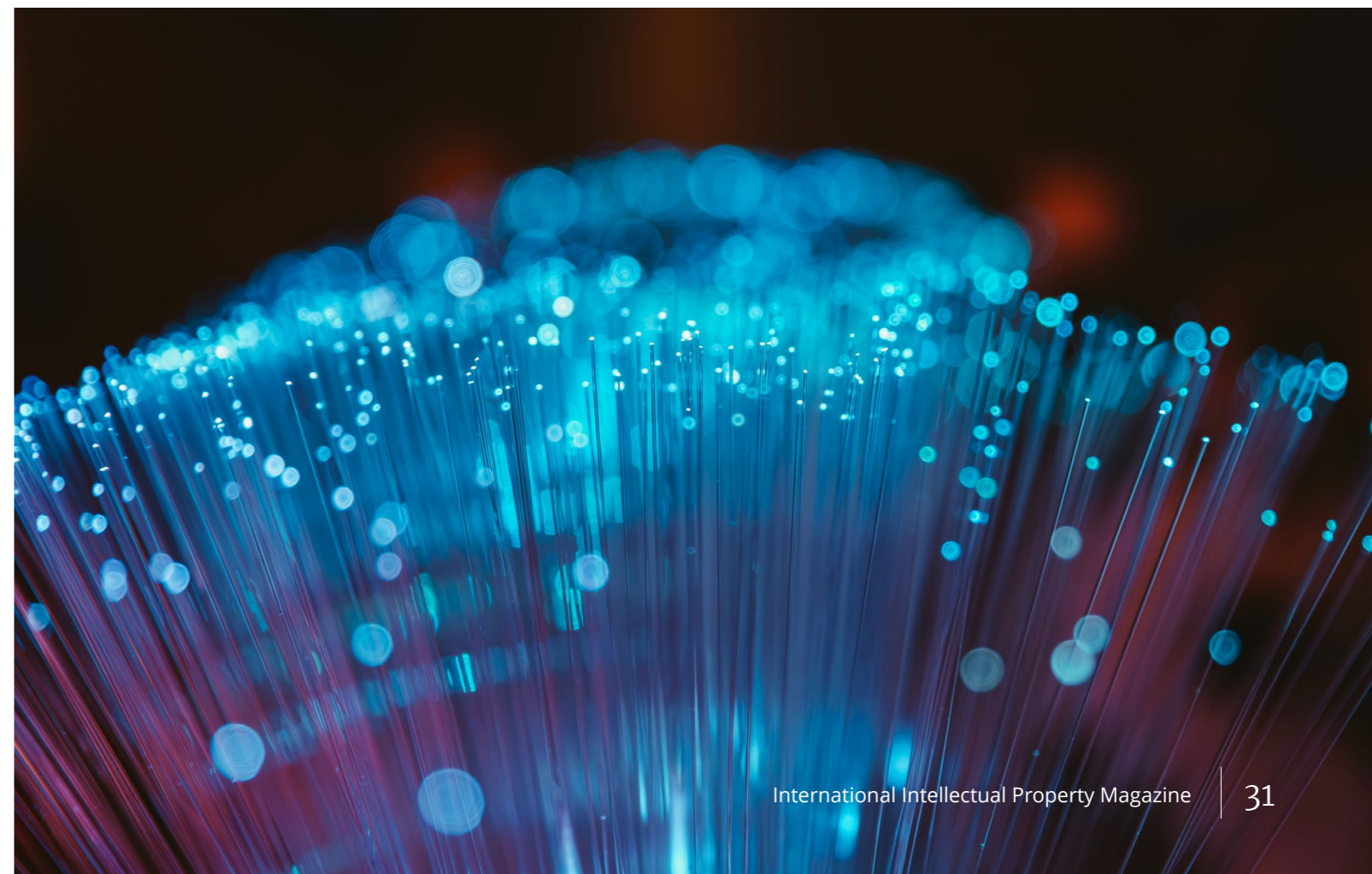
Introduction of the new provisions was interlinked with the commencement of operations of special IP courts in Poland. As some time has passed since the enactment of the new provisions and creation of these IP courts, it is worth looking into the current case law.

An interesting discussion in the case law should be mentioned in relation to telecommunication services providers. In its resolution of 3 February 2023, the Circuit Court in Warsaw, IP division, confirmed that it is possible to request that telecommunication service providers whose services have been used to infringe IP rights deliver the required information (XII GWo 267/22). Although the telecommunication service provider has attempted to exempt itself from this mechanism by citing provisions on telecommunications secrecy, the court concluded that the right to request information in cases of IP rights' infringements overrides general provisions regarding telecommunications secrecy. The telecommunications services provider's representative claimed that there are no legal grounds for releasing the operator from secrecy in case of providing services used for IP rights' infringement, as this is not stipulated in the Telecommunications Act. However, the court strongly disagreed with such interpretation, as the very Telecommunications Act

predicts that a release from telecommunications secrecy is possible if "separate provisions" allow for that. According to the court, the provisions of the Code of the Civil Procedure relating to the right of information in IP infringement cases are such "separate provisions" within the meaning of the Telecommunications Act. The court, at the same time, also outlined the rules on the use of information by the requesting rightholder, emphasizing that the information cannot be used in any other way than in a civil case before a Polish court with respect to copyright infringement. At the same time, an important conclusion of the court is that "there are no indications that the Polish legislator intended to make the Telecommunications Act a shield protecting perpetrators of infringements of intellectual property rights." The court also emphasized that there is no need to evidence the infringement in the event of requesting information - it is sufficient to demonstrate its probability.

What is also interesting in the above-mentioned judgement is that the court issued an obligation for the telecommunications services operator to deliver information about the name, surname, personal identification number and domicile of the persons who at the given time used, in order to infringe copyright, an internet connection which had been assigned at that time the IP address and port in question. It is important as the catalogue of information approved by the court in this matter is wider than that enumerated in the new provisions of the Code of Civil Procedure on the right of information. This in turn delivers interpretational clues as to the practical possibility of expanding this list to cover also information about Internet infringers of copyright, including their personal identification numbers. The court in fact emphasized that the list in the statutory provisions contains only examples of information which can be requested, while the catalogue of this information includes all information that is necessary to pursue the claim, including information which is needed to evidence the very infringement, not only the damage caused.

In addition, this decision is important as it challenges an older judgement issued on October 5, 2020, in similar circumstances, where the court refused to order making information available due to interpreting the provisions in a very narrow manner (XXII GWo 54/20). This is particularly interesting because the court issuing this older judgement mentions the judgement of the CJEU in case C-264/19 as one of the grounds of the narrow interpretation of the new Polish provisions. In case C-264/19, the CJEU concluded that the notion of "address" as used in the Enforcement Directive does not cover e-mail address, telephone number or an IP address. In the judgement of 2023, the Polish IP court does not address this CJEU judgement at all, as in fact the IP address was not requested - it was already in the possession of the rightholder, and a factor identifying the infringers, which holds true also in case XXII GWo 54/20.



THE BIG Q – HOW TO REGULATE THE NET

The question of how to regulate the proliferation of harmful online content and create a safer online environment is one that tends to polarise opinion.

Mark Zuckerberg said in 2020, *“We have to balance promoting innovation and research against protecting people’s privacy and security”*

As a litigator myself, it is important to keep an eye on the regulatory challenges, not only in terms of horizon scanning, but also as a useful temperature check on the direction of travel when it comes to where society seeks to draw out boundaries and expectations of its legal rights, as we become more sophisticated in our understanding of technological change.

The law is fairly well settled in the EU and the UK with regard to online liability and when a social media platform loses its safe harbour defence, thereby adopting the status as secondary publisher and liable in law. The starting point of the legal principles is the EU Directive, which was transposed into national law by virtue of The E-Commerce Directive 2002. This statutory framework provides both transparency for a complainant, and access to a timely Notice and Take Down reporting mechanism, as well as providing immunity from liability for social media platforms in certain circumstances. The framework provides social media platforms with a qualified safe harbour defence, and which first established the Notice & Take Down procedure for complainants.

In one of the online privacy & harassment cases heard in Belfast, the Court recognised the importance of social media platforms taking down unlawful content quickly when notified under the legal framework. In *CG -v- Facebook Ireland Ltd* the Court observed:

The speed with which social media operates is that the number of comments under the original posting can increase rapidly minute to minute or hour to hour.

In the UK, Ofcom has confirmed that its focus under the Online Safety Act 2023 (“OSA”) is Governance, Design, Trust and enabling choice to social media users, identifying a road map to implementation of the OSA by pinpointing three key phases:

1. Phase one: illegal harms duties: Ofcom published draft codes and guidance on these duties, which are anticipated to come into effect from 2025.
2. Phase two: child safety, pornography and the protection of women and girls. Draft guidance is due to be published by Spring 2025.
3. Phase three: transparency, user empowerment, and other duties on categorised services. A small proportion of regulated services if they meet certain thresholds will have duties to:
 - produce transparency reports;
 - provide user empowerment tools;
 - operate in line with terms of service;
 - protect certain types of journalistic content; and
 - prevent fraudulent advertising.



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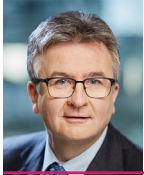
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Notes



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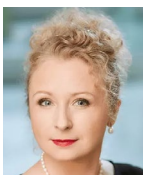
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