

# European Intellectual Property Review

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### Opinion

CHRISTOPHER MORCOM QC

#### **The Implications of Brexit for Trade Marks and for Practitioners in the UK: What are the Likely Effects and What Needs to Happen Now? 657**

Even before the vote on 23 June, practitioners in intellectual property law had been thinking about the possible consequences for IP rights and for practitioners if the UK were to leave the EU. There was probably little such thought among politicians, whichever side they supported. Once the result was announced, the whole situation changed. All concerned with IP, including owners of the rights as well as lawyers and of course people at the UK IP Office, have been actively assessing the problems that will arise when UK exit actually happens, and how the inevitable adverse effects may be overcome or mitigated. The author's aim is to cover trade marks and in particular the consequences of exit for owners of unitary EU trade marks, and how the rights of proprietors in the UK might be protected. Another important aspect is the position of those whose rights of representation before the EU institutions, including the EUIPO in particular, will be affected if appropriate measures are not put in place.



### Articles

DUNCAN MATTHEWS AND OLGA  
GURGULA

#### **Patent Strategies and Competition Law in the Pharmaceutical Sector: Implications for Access to Medicines 661**

Potentially anti-competitive practices, such as reverse payment agreements and strategic patenting, risk allowing pharmaceutical companies to block the entry of generic and innovative medicines, stifling competition and harming consumers. Such practices create particular challenges for developing countries. Policy coherence between the IP system and competition law must be strengthened in order to promote innovation and access to health technologies.

ELEONORA ROSATI

#### **Why a Reform of Hosting Providers' Safe Harbour is Unnecessary under EU Copyright Law 668**

In the context of its Digital Single Market Strategy (DSMS) the EU Commission is currently engaged in a discussion of whether the liability principles and rules envisaged by Directive 2000/31 (the E-Commerce Directive) should be amended. One of the principal concerns in relation to unlicensed online intermediaries (notably unlicensed hosting providers) is that these have been increasingly said to invoke the safe harbour immunities in the E-Commerce Directive lacking the conditions for their application. This alleged abuse has led to a distortion of the online marketplace and the resulting "value gap" indicated by some right holders. This contribution discusses a recent proposal advanced in France which asks for the removal of the safe harbour protection pursuant to art. 14 of the E-Commerce Directive for hosting providers that give access to copyright works. After addressing some of the points raised by the French proposal, this work concludes that the Court of Justice of the EU (CJEU) has not erred in its interpretation of relevant provisions of the E-Commerce Directive and that—in practice—the removal of safe harbour protection for passive hosting providers that give access to copyright works would not provide any distinct advantages to right holders. Overall, the current framework already provides an adequate degree of protection: what is required is a rigorous application by national courts of the principles enshrined in the E-Commerce Directive, as interpreted by the CJEU.

DR DANNY FRIEDMANN

#### **The Uniqueness of the Trade Mark: A Critical Analysis of the Specificity and Territoriality Principles 677**

This article advances three interrelated propositions that can stimulate fair competition. It first explores the gradual decoupling of the trade mark from goods or services, then investigates the coupling of the extension of trade mark use to protection against confusion, dilution and free-riding. The article continues by researching the decoupling of protection against dilution from fame or reputation, and then combines these propositions, with reference to the legislation and case law in the US and EU, before providing conclusions.

GIANCARLO MORETTI

#### **The Registration of Geographical Indications for Non-Agricultural Products in France and its Impact on Proposed EU Legislation 686**

In the wake of the EU proposal to extend the protection of geographical indications to non-agricultural products, France enacted *sui generis* legislation for the registration of non-agricultural GIs. This article will argue that this form of protection for non-agricultural products may face difficulties in satisfying the specific and identifiable characteristics that intrinsically link a product to its geographical origin.

OLASUPO OWOEYE AND MODUPE  
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### **3D Printing and Patent Law: A Balance of Rights and Obligations** 697

The article examines 3D printing technology and how it affects intellectual property law, with particular emphasis on patents. It highlights the benefits and gains that the technology offers as well as the economic and legal challenges that attend its emergence. It argues that 3D printing is a disruptive technology that calls for fresh insights on balancing the rights of patent holders and the need to promote technological advancement.

### **Comments**

DR MARKUS HECHT AND DR BIRGIT  
CLARK

### **Landlord Liability for IP Infringements: CJEU Holds that Operators of Physical Marketplace are Intermediaries under the Enforcement Directive in *Tommy Hilfiger (C-494/15)*** 703

The article discusses the CJEU's decision in *Tommy Hilfiger*, in which the CJEU has extended the application of the guidance in its landmark decision in *L'Oréal* from an online to an offline environment by finding that the operator of a physical ("bricks and mortar") marketplace may be similar to an online marketplace and therefore qualify as an intermediary under art.11 Enforcement Directive 2004/8448. While this decision strengthens the rights of right holders, it will put landlords on alert since they may be forced to bring trade mark infringements committed by market-traders to an end and/or take measures to prevent further infringements.

AGATA SOBOL

### **Court of Turin on the Doctrine of Equivalents: When Do the Equivalents Really Apply? *Pewag Schneeketten GmbH v Transit Srl*** 708

In this judgment, the Court of Turin decided that certain differences between what is claimed in a patent and what is accused of patent infringement cannot be considered equivalents. The Turin judges made a deeper analysis of the application of the doctrine of equivalence in Italy and then tried to apply it to the specific case, which is worth describing. The basic argument is that there are elements of the claim that do not accept equivalents: this comment will examine why that is, according to the Court of Turin, and considers whether this can be true.

### **Book Reviews**

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