

TAMAR KHUCHUA\* / GIORGIA GALEOTTA\*\*

# Intellectual Property and the European Courts, Conference at the Court of Justice of the European Union, Luxembourg, 5 June 2024

On 5 June 2024, the German Association for Intellectual Property Law (GRUR) and the University of Luxembourg organised a conference on Intellectual Property and the European Courts at the Court of Justice of the European Union (CJEU) in Luxembourg. This one-day event featured fruitful discussions on the role of courts in protecting and enforcing intellectual property rights. Among the renowned speakers and moderators were judges from European courts, prominent attorneys, representatives of various organisations and associations, and leading academics from across Europe.

## I. Opening remarks

The opening remarks were delivered by Judge Lars Bay Larsen, Vice President of the Court of Justice, Luxembourg, Dr Gert Würtenberger, President of GRUR, Attorney, Munich and Prof. Martin Stierle, Associate Professor in Intellectual Property Law, University of Luxembourg.

Judge Bay Larsen warmly welcomed all the participants of the conference to the Court of Justice of the European Union (CJEU or the Court) and thanked GRUR and the University of Luxembourg for organising the event. Drawing from his experience, first as a vice president and then as a president of the chamber that handles the filtering mechanism at the CJEU, Judge Bay Larsen noted the continuous arrival of new cases at the CJEU, both at the General Court and the Court of Justice, including preliminary references, on essential aspects of EU law. For example, the ruling *La Quadrature du Net*,<sup>1</sup> delivered on 30 April 2024, after the preliminary reference of a French national court on the question of online copyright infringement, led to the clarification of not only copyright but also wider legal issues, such as revision of balance struck in previous cases *Google Spain*<sup>2</sup> and *Digital Rights Ireland*.<sup>3</sup> Judge Bay Larsen mentioned that the Court's reasoning in *La Quadrature du Net* primarily refers to the fight against crime and that this ruling softened the case law on data access for security purposes in a copyright protection case and contributed to the consistency of the case law of the Court.

Dr Würtenberger extended a warm welcome and noted the significance of GRUR, founded in 1891, hosting a conference at the CJEU. He thanked the participants for their interest and invited them to consult the GRUR-Journals displayed outside the conference room.

Prof. Stierle announced the conference programme, highlighting diverse perspectives on intellectual property law and the courts. The opening presentation would feature the shaping of European intellectual property law by the Court of Justice, followed by the panel focusing on patent law and the Unified Patent Court's (UPC) new standards set in its first year of operation. The last panel was to be on copyright and trademark law exploring the Court of Justice's approach to the right of communication to the public and the General Court's approach to weak elements in trademarks. Lastly, Prof. Stierle thanked the CJEU, the co-organisers and partners, all speakers, and the audience.

## 1. Speaker: Judge Octavia Spineanu-Matei, President of the Ninth Chamber of the Court of Justice, Luxembourg

**'The role played by the Court of Justice with respect to the unity, consistency and development of IP law within EU – recent case law'**

Judge Octavia Spineanu-Matei discussed the role of the Court of Justice in achieving the unity, consistency, and development of IP law within the EU and the recent cases. In the first part of her presentation, she explored the new 'filtering mechanism' in force since 2019 concerning the appeals of the judgments of the General Court in IP cases. In the context of the increasing number of cases brought before the Court of Justice since May 2019, she explained that under Art. 58a of the Statute of the Court of Justice of the European Union, an appeal brought against a

\* Dr, post-doctoral researcher at the Faculty of Law, Economics and Finance (FDEF) of the University of Luxembourg, Luxembourg.

\*\* Doctoral researcher at the Faculty of Law, Economics and Finance (FDEF) of the University of Luxembourg, Luxembourg.

<sup>1</sup> Case C-511/18 *La Quadrature du Net and Others* ECLI:EU:C:2020:791.

<sup>2</sup> Case C-131/12 *Google Spain and Google* ECLI:EU:C:2014:317.

<sup>3</sup> Case C-293/12 *Digital Rights Ireland* ECLI:EU:C:2014:238.

ruling of the General Court concerning a decision of an independent board of appeal (among others) of the EUIPO, or the Community Plant Variety Office, shall not proceed unless the Court of Justice first allows it to do so. An appeal shall be allowed to proceed in accordance with the Rules of Procedure, where it raises an issue that is significant concerning the unity, consistency, or development of Union law.<sup>4</sup> Notably, the Rules of Procedure of the Court of Justice were amended accordingly.<sup>5</sup> While this new mechanism concerns general EU law as well as procedural aspects, Judge Spineanu-Matei concentrated only on IP issues for the conference context.

Judge Spineanu-Matei presented statistics to demonstrate the new mechanism's efficiency, noting that many appeals were refused due to failure to meet formal requirements, such as being confined to seven pages, or describing the significance of the unity, consistency and the development of EU law.<sup>6</sup> According to the Judge, the main aim of the new mechanism was not to drastically limit the number of appeals. Believing that the key role of this new mechanism has not been understood so far, Judge Spineanu-Matei explained the core requirements for a request, which are that it must demonstrate that the raised issue is of significance with respect to the unity, consistency, or development of EU law. She presented *KaiKai*<sup>7</sup> as the first case where the request for appeal was allowed to proceed.<sup>8</sup> This decision was considered to have an impact on the system of priority claims for all types of IP rights. The appeal was therefore allowed to proceed and the Court of Justice subsequently annulled the decision of the General Court.

Judge Spineanu-Matei also presented cases *Indo European Foods*<sup>9</sup> and *Shopify*<sup>10</sup> where appeals were allowed. Through these cases she once more shed light on the issue of significance. Overall, the main features that Judge Spineanu-Matei highlighted for the appeal to be allowed to proceed are its self-explanatory nature in terms of its significance, that it does not exceed seven pages, and that it is not necessary *prima facie* that the appeal is well-founded.

In the second part of her presentation, Judge Spineanu-Matei discussed the preliminary ruling mechanism under

Art. 267 TFEU and its transversal applicability in all fields of EU law, including IP law. She noted that this mechanism facilitates an ongoing dialogue between European judges. To illustrate the diversity of the issues that fall under the preliminary reference mechanism, Judge Spineanu-Matei talked about four cases, namely *Inditex*,<sup>11</sup> *Audi*,<sup>12</sup> *Seven.One Entertainment Group*<sup>13</sup> and *IRnova*.<sup>14</sup> *Inditex* concerned alleged trade mark infringement and the preliminary question asked by the Supreme Court of Spain concerning the interpretation of Art. 14(1)(c) of the Directive 2015/2436.<sup>15</sup> *Audi* stemmed from Polish national proceedings about the use of a mark for spare parts in the course of a trade and the question of whether such use could have affected one of the functions of a trade mark, and whether the 'repair clause' in the design law could have been applied by analogy to the trade mark law. The *Seven.One Entertainment Group* case, deriving from German proceedings, concerned copyright matter and whether broadcasting organisations have the right to fair compensation provided in Art. 5(2)(b) of Directive 2001/29.<sup>16</sup> Lastly, *IRnova* raised the issue of co-inventorship in the field of patent law. In particular, the Court of Appeal of Stockholm posed a question to the Court of Justice about whether the claim of inventorship falls under the exclusive jurisdiction for the purposes of Art. 24(4) of the Brussels Ia Regulation.<sup>17</sup>

In the Q&A session that followed Judge Spineanu-Matei's presentation, Dr Würtenberger pointed out that the new filtering mechanism might be restrictive due to the seven-page requirement. Judge Bay Larsen added that one needs to take a step back and argue for the amendments either regarding the manner in which the new filtering mechanism is applied or the mechanism itself as it stands, something he would not engage in as a judge responsible for handling appeals based on this new mechanism. He said there is room for some explanations as to what needs to be prioritised in drafting the request for appeal. Prof. Annette Kur asked about the preliminary reference mechanism and specifically about the reasons for general advice delivered by the Court of Justice on questions that have not been explicitly asked by a referring court. She also enquired whether the general policy arguments should play a role when applying limitations of one IP area to another in order to ensure the general consistency of IP law. In response to the first question, Judge Spineanu-Matei held that the Court of Justice reformulates the question to render the answer generalisable to all EU Members States, in other words the court clarifies

<sup>4</sup> art 58a, Statute of the Court of Justice of the European Union.

<sup>5</sup> According to the art 170a and 170b of the Rules of Procedure the appellant shall annex to the appeal a request for appeal that should not be longer than seven pages. Without the request, the appeal itself will be declared inadmissible.

<sup>6</sup> First appeal was allowed to proceed only in 2021 and since then only a few more appeals have been allowed.

<sup>7</sup> Case C-382/21 P *EUIPO v KaiKai Company Jaeger Wichmann* ECLI:EU:C:2024:172.

<sup>8</sup> In this case, the General Court held that art 41(1) of the EU Regulation 6/2002 authorises a priority period of 12 months based on the international patent application filed under the Patent Cooperation Treaty for a subsequent community design. It annulled the decision of the Boards of Appeal of EUIPO which had limited the period of claiming the priority to six months only. The EUIPO, acting as an appellant, had described its appeal in detail stating that the General Court misinterpreted art 41 of Regulation 6/2002 and art 4 of the Paris Convention, and that this infringement was likely to impact the outcome of the judgment under appeal. Moreover, the appellant set out the specific reasons for the significance of the raised issue with respect to the unity, consistency, and development of EU law and that the point of law raised went beyond the scope of appeal.

<sup>9</sup> Case C-801/21 P *EUIPO v Indo European Foods* ECLI:EU:C:2024:528.

<sup>10</sup> Case C-751/22 P *Shopify v EUIPO - Rossi and Others (Shoppi)* ECLI:EU:C:2023:328.

<sup>11</sup> Case C-361/22 *Inditex* ECLI:EU:C:2024:17.

<sup>12</sup> Case C-334/22 *Audi* (Support d'emblème sur une calandre) ECLI:EU:C:2024:76.

<sup>13</sup> Case C-260/22 *Seven.One Entertainment Group* ECLI:EU:C:2023:900.

<sup>14</sup> Case C-399/21 *IRnova* ECLI:EU:C:2022:648.

<sup>15</sup> Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks (recast) (Text with EEA relevance) [2015] OJ L336/1.

<sup>16</sup> Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society [2001] OJ L167.

<sup>17</sup> Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast) [2012] OJ L351/1.

the details concerning the concepts that go beyond the question addressed, as was the case in *Audi* decision. As for the second question, she noted that in trademark law, for example, the rights of the proprietor are the core of the legislation, so it therefore remains debatable whether the rights of consumers should be considered.

## II. SESSION: Unified Patent Court – the first year

### 1. Speaker: Judge Klaus Grabinski, the president of the Court of Appeal of the UPC, Luxembourg

**'The preliminary injunctions before the UPC – where is the threshold?'**

The first panel of the second session was chaired by Dr Christof Keussen, Chair of the GRUR Special Committee on Patent and Utility Model Law, Patent Attorney, Hamburg. In this panel, Judge Klaus Grabinski discussed the current state of patents with unitary effect and the UPC, and the preliminary injunctions at the UPC one year after it came into operation. He particularly underlined the several advantages of patents with unitary effect. First, Judge Grabinski mentioned that patents with unitary effect do not require administration by several national patent offices but only by the European Patent Office (EPO), which grants European patents and – upon the request of an applicant – the unitary character can be attributed for 17 contracting Member States. Second, he drew the audience's attention to the fact that the fee for a patent with unitary effect equals to the fee to be imposed by three to four national patent offices. He also mentioned that currently, every fourth European patent that has been granted has a unitary effect, which significantly contributes to the EU's economy. According to the presenter, patents with unitary effect generate three quarters of the GDP of the EU.

As for the UPC, Judge Grabinski said that another EU Member State, Romania, has deposited the instrument of ratification of the UPC Agreement (UPCA), making it, as of September 2024, the 18th country where the UPC will be effective. Another candidate to ratify the UPCA is Ireland which will hold a national referendum on the issue, the date of which is yet to be decided.

The session heard that 271 cases were filed at the First Instance Court of the UPC in its first year of operation. These included 134 actions for infringement, 63 counterclaims for revocation and 39 actions for revocation, two actions for declaration of non-infringement, one action for damages, 26 requests for preliminary measures, five requests for preserving evidence and one request for inspection. There were 63 appeals and two discretionary reviews filed at the Court of Appeal of the UPC (CoA) out of which there were three appeals brought under R.220.1(a), (b) RoP, 13 appeals under R.220.1(c) RoP, 47 appeals under R.220.2 RoP, 2 discretionary reviews under R.220.3 RoP and 1 application for rehearing under R.245 RoP. English was the language of proceedings in 50% of the cases, followed by German with 44%, leaving French, Italian and Dutch with 2% each.<sup>18</sup>

Moving on to preliminary injunctions, Judge Grabinski explained the requirements for *ex parte* and *inter partes* preliminary injunction (PI) requests. In *ex parte* PI cases, the Judge noted that in order to strike a fair balance between both parties' interests the applicant's PI request must be treated efficiently and the defendant's fundamental right to be heard must be guaranteed by the court. Therefore, an applicant of a PI is required to demonstrate the urgency of the situation and establish that any delay would cause irreparable harm, and that there is a risk of evidence being destroyed. On the other hand, the defendant's right to be heard can be secured by accessing any prior correspondence between the parties, by considering any previous decisions, or the protective letter submitted by the defendant beforehand. Observing these elements allows the court to assess the issue of infringement and validity of a patent and conclude whether to grant a PI. Notably, as a general rule, the presumption of validity of a patent applies as established by CJEU in *Phoenix*<sup>19</sup> and *Mylan*<sup>20</sup> cases, unless proven differently.

In *inter partes* PI requests, after an oral hearing the court decides either to grant the PI – in whole or in part – or dismiss the request altogether. Granting the PI results in the prohibition of continuation of the alleged infringement or making such a continuation subject to the lodging of guarantees. The burden of proof lies with the applicant, who must demonstrate that the entitlement and the infringement of the patent are 'more likely than not', allowing the court to decide with a 'sufficient degree of certainty'. While the entitlement can be verified through the EPO or national patent offices' register, for the infringement the court observes the claim construction and whether all elements of the patent claim are realised in the allegedly infringing product or process. As for the validity of a patent, the burden of proof lies with the defendant to prove that the patent in question is invalid. In deciding the validity of a patent, the court once again investigates the claim construction as well as the obviousness.<sup>21</sup>

Overall, in exercising its discretion when deciding on the PI, Judge Grabinski pointed out that the court must weigh up the interests of the parties, and particularly consider the potential harm resulting from the granting or refusal of the PI pursuant to Art. 62 UPCA and the R.211.3 RoP. Hence, PI issuance should be equitable, proportionate, and dissuasive. Importantly, if the PI is revoked the court may order the applicant, upon request of the defendant, to provide the defendant with appropriate compensation for any damage suffered as a result of the PI.

Following the presentation of Judge Grabinski, a question from the audience raised the issue of what small EU Member States would gain by joining the unitary patent system. Judge Grabinski replied that small Member States will have the opportunity to influence the system, as the judges from these countries will also sit in the panels. He added that the unitary patents circulate in a single market to which small countries adhere, rendering the unitary patents attractive for them as well. Another question

<sup>19</sup> Case C-44/21 *Phoenix Contact* ECLI:EU:C:2022:309.

<sup>20</sup> Case C-473/22 *Mylan* ECLI:EU:C:2024:8.

<sup>21</sup> *NanoString/10x Genomics* UPC CoA, 26 February 2024.

<sup>18</sup> Presented statistics are true as of 27 May 2024.



concerned the issue of forum shopping and whether there is any evidence that the system is more favourable for the applicants compared to the defendants. Judge Grabinski pointed out that there are indeed possibilities to bring an action in various places of the UPC Contracting Member States when, for example, the infringement has occurred on the internet. However, at least one judge of each panel is not a national of the country of the local division, and the existence of the CoA ensures the uniform application of the law, ensuring that the system entails sufficient safeguards to overcome the issue of forum shopping.

## 2. Speaker: Judge Florence Butin, President of the Court of First Instance of the UPC, Paris

### 'How the UPC can develop and disseminate an autonomous understanding of patent law: Importance of the language used'

The next panel was co-moderated by Dr Christof Keussen, Chair of the GRUR Special Committee on Patent and Utility Model Law, Patent Attorney, Hamburg and Mr Stephan Freischem, Secretary General of GRUR, Patent Attorney, Cologne. They gave the floor to the panel's first presenter, Judge Florence Butin, President of the Court of First Instance of the UPC in Paris. Her presentation focused on the importance of the language issue at the UPC.

In the first part of her speech, Judge Butin presented statistics, demonstrating the dominance of English language followed by German. She also pointed out the two dimensions of language use: internal communication among judges and clerks; and external communication in disseminating case law.

The second part of her presentation shed light on core rules with regard to the choice of language, such as the possibility to choose the language of the local division for the proceedings, or a second language, which can be the language of the patent granted. As for the regional division, Judge Butin pointed out that its working language is exclusively English. At the CoA, the language of the proceedings is the language used in the first instance proceedings. Moreover, when the counterclaim is transferred to the central division of the UPC, the judge rapporteur can request the translation of all documents or maintain the language used initially. Finally, the judge rapporteur can also change the language of the proceedings upon the agreement of the parties.

In the third part of her presentation, Judge Butin talked about the requests for a change of the language for proceedings at the UPC. She mentioned that up to the time of the conference she had received 17 requests to change the language of the proceedings in the language of the patent. However, the admissibility of some early applications has been challenged because under the RoP, any request for a change of the language must be included in the statement of defence. Judge Butin stated that for the efficiency of proceedings submission of a request for the change of language at an early stage is allowed. It is notable that convenience – which has been invoked as a ground in these requests – is not sufficient, since the UPCA underscores fairness as a main ground.

Judge Butin pointed out the recent decision of the CoA concerning the request for the change of the language based on R.323 RoP and Art. 49(5) UPCA and the principle of fairness.<sup>22</sup> According to the CoA, all relevant circumstances must be taken into consideration when deciding on the request of the change of the language, such as the language of the technical field concerned, the nationality and domicile of the parties, and the size of the parties. Importantly, when deciding upon a change into the language of the patent, the parties' interests shall be balanced. Curiously, the language of the representatives of the parties is irrelevant, making the parties central to the consideration of the language of the proceedings. When the outcome of the balancing of interests is equal, the position of the defendant is decisive, as stated by the UPC CoA. Notably, the RoP do not preclude a change of language even during the provisional proceedings.

Lastly, Judge Butin concluded that the multilingual environment of the UPC has changed the habits of judges compared with their time serving as national judges. Now that the UPC judges most frequently work in a foreign language, they are urged to communicate their message in the decisions in a straightforward and simple manner.

## 3. Speaker: Sabine Agé, Attorney, Paris

### 'UPC developing case law: New cultures in fertile soils'

After the presentation of Judge Butin, the floor was given to Ms Sabine Agé, Attorney in Paris. She presented the developing case law of the UPC and focused on the following six issues: preservation of evidence, service, jurisdiction, confidentiality, claim construction and infringing acts.

Ms Agé started with the preservation of evidence, and explained what has to be submitted in order to give rise to the latter and the inspection of premises. According to Arts. 60(1) and 60(3) UPCA, this must be reasonably available evidence and the evidence to support the claim, respectively. According to Agé, these concepts have already been applied in national courts through the laws implementing the Directive 2004/48/EC,<sup>23</sup> and up to now the practices have been different. On the one hand, the UPC has provided harmonisation on the required evidence through its several decisions of the local divisions of the UPC First Instance Court in Paris and Milan.<sup>24</sup> Based on these decisions, the required level of evidence is not the same as the level of evidence being sought, rendering the court's approach reasonable, in her opinion. On the other hand, the urgency of a matter – which is also relevant under R.194.2(a) RoP when deciding upon the presentation of evidence and the inspection of premises – is less uniform, as seen in the rulings of the local divisions in Brussels, Milan and Paris.<sup>25</sup>

<sup>22</sup> Court of Appeal, 17 April 2024, Order, UPC\_CoA\_101/2024.

<sup>23</sup> Directive 2004/48/EC of the European Parliament and of the Council of 29 April 2004 on the enforcement of intellectual property rights [2004] OJ L195/16.

<sup>24</sup> CFI\_127/2023, 13 June 2023; CFI\_141/2023, 14 June 2023; CFI\_286/2023, 25 September 2023; CFI\_397/2023, 14 November 2023.

<sup>25</sup> CFI\_127/2023, 13 June 2023; CFI\_141/2023, 14 June 2023; CFI\_329/2023, 21 September 2023; CFI\_286/2023; CFI\_397/2023, 14 November 2023.

Moving on to the issue of the service, Ms Agé highlighted the importance of speediness of service by underlying R.275.1 and R.275.2 RoP, according to which an alternative method or place can be used for service, which can, however, be reconsidered upon the reasoned request of the claimant. While the service with the registered letters is efficient inside the EU, such letters are delivered to the defendant very late or not at all in some countries outside the EU. Therefore, in the first set of cases, mostly of local divisions in Munich and Paris, the alternative method of service was chosen, including the sending of the statement of claim by a courier.<sup>26</sup> However, the local division of Hamburg ruled that it must be first proven that the attempt of service through the Hague Convention<sup>27</sup> has failed before opting for the alternative method of service,<sup>28</sup> an approach that the presenter believes might lengthen the process. Overall, Ms Agé noted that while the issue of the service is not substantive, it significantly impacts the length of the proceedings and thus is of high importance.

Regarding the jurisdiction, she mentioned that while the international jurisdiction of the UPC is a much-discussed topic among the lawyers, until now, the UPC has not issued decisions on this matter. In cases where the jurisdiction of the UPC was challenged, the judge rapporteurs of the local divisions of the UPC have decided to rule on this matter together with the merits, for reasons of procedural economy and efficiency.<sup>29</sup> There has only been one case where the Central Division of the Court of First Instance, the seat in Paris, decided that a German nullity action, pending at the appeal stage and filed prior to the transitional period against a European patent only validated in Germany, does not prevent a subsequent central revocation action before the UPC.<sup>30</sup>

Ms Agé then commented on the issue of confidentiality, particularly the protection of trade secrets without the natural person having access to documents. Concerning the issue of confidentiality, she pointed to a decision of the local division in the Hague in which access to financial information being limited to the legal representatives of a party was justified, among other things, by the circumstance that this information would not be relevant for the main proceedings. There had also been an agreement among parties on this limited access.<sup>31</sup> Moreover, the confidentiality requests due to the obligation stemming from the licence agreement in SEP cases have been rejected by the UPC local divisions in Mannheim and Munich.<sup>32</sup>

As for the issue of claim construction, she shed light on the prosecution history, something duly observed in the French patent culture, in particular, whether the statements made during the application process contradict the statements in the court proceedings. At the UPC, the local division in Munich stated that the history of the

claim amendment could have helped interpret the claim concerned.<sup>33</sup> However, the local division in Düsseldorf refused to observe the prosecution history due to no legal basis,<sup>34</sup> a decision with which Ms Agé respectfully disagreed. With regard to the prosecution history, the CoA stated in an appeal case deriving from the Munich local division that it did not need to address the question of whether the prosecution history was relevant when determining the scope of protection of a European patent as ‘the parts of the European Patent Office examination file cited by the parties [had] not shed any new light on this interpretation’.<sup>35</sup>

Finally, concerning the infringement acts, Ms Agé highlighted a decision of the local division in Düsseldorf concerning a penalty payment where there had been a breach of an injunctive relief by the act of ‘offering’. This decision is significant as it provides the first ruling on the interpretation of Art. 25(a) UPCA on direct infringement. The Court stated that ‘offering’ must be understood purely in an economic sense, i.e. making the object available for consumers. In the given case, the drawing of the product was made available at the trade fair, regarding which the CoA said that as it corresponded to the infringing device and an intent of a sale of a product was present, this drawing amounted to an offer.<sup>36</sup>

Having presented the first decisions of the UPC, Ms Agé concluded by praising the work of the UPC. She said the UPC judges combine expertise that is rooted in their national experiences with approaches that can establish something new and unique to the UPC, often tinged with pragmatism.

#### 4. Speaker: Prof. Mary-Rose McGuire, Chair of Private Law, Intellectual Property Law and German and European Civil Procedure Law, University of Osnabrück

##### ‘Determination of substantive law and methods to fill remaining gaps in proceedings before the UPC’

The third speaker of the panel was Prof. Mary-Rose McGuire from the University of Osnabrück. Her presentation focused on determining the applicable law and methods to fill remaining gaps in proceedings before the UPC. Prof. McGuire began by outlining the legislative framework governing conflicts of law, citing Rome I<sup>37</sup> and Rome II<sup>38</sup> regulations and the Brussels Regulation.<sup>39</sup> She emphasised that national patent offices have granted patents based on national laws for over 150 years. National patents have always fallen under the jurisdiction of the

<sup>26</sup> CFI\_62/2023, 27 September 2023; CFI\_495/2023, 28 February 2024.

<sup>27</sup> The Convention on the Service Abroad of Judicial and Extrajudicial Documents in Civil or Commercial Matter, 1965.

<sup>28</sup> CFI\_169/2024, 18 April 2024.

<sup>29</sup> Upcoming decisions in cases, CFI\_252/2023; CFI\_513/2023; CFI\_514/2023; CFI\_515/2023; CFI\_355/2023; CFI\_365/2023.

<sup>30</sup> CFI\_484/2023, 2 May 2024.

<sup>31</sup> CFI\_239/2023, 4 March 2024.

<sup>32</sup> CFI\_218/2023, 30 April 2024; CFI\_9/2023, 8 May 2024.

<sup>33</sup> CFI\_292/2023, 20 December 2023.

<sup>34</sup> CFI\_453/2023, 9 April 2024.

<sup>35</sup> COA\_1/2024, 13 May 2024, para 37.

<sup>36</sup> CFI\_177/2023, 18 October 2023, p 9.

<sup>37</sup> Regulation (EC) No 593/2008 of the European Parliament and of the Council of 17 June 2008 on the law applicable to contractual obligations (Rome I) [2008] OJ L177/6.

<sup>38</sup> Regulation (EC) No 864/2007 of the European Parliament and of the Council of 11 July 2007 on the law applicable to non-contractual obligations (Rome II) [2007] OJ L 199/40.

<sup>39</sup> Regulation (EU) No 1215/2012 of the European Parliament and of the Council of 12 December 2012 on jurisdiction and the recognition and enforcement of judgments in civil and commercial matters (recast) (n 17).

state that granted them, especially concerning novelty issues. In contrast, infringement issues are typically governed by general jurisdiction rules, such as the court at the defendant's seat or where the act of infringement occurred. Prof. McGuire explained that the application of national law stems from the principle that a state's sovereign power is confined to its national territory. Thus, decisions on patent novelty should remain within the jurisdiction of the granting state. This practice has been codified, for example, in Art. 24.4 of the 1968 Brussels Convention. She elaborated that once granted, a patent becomes a property right, and any infringement must be judged according to the national law of the country where the infringement took place, as stipulated in Art. 8 of the Rome II Regulation. This pre-grant and post-grant jurisdictional division, with national patent offices handling grants and national courts handling infringements, has been straightforward in theory and practice. Historically, European states collaborated in the pre-grant phase leading to the 1973 European Patent Convention (EPC) and the establishment of the EPO in 1977. While the EPO handles the granting of European patents, issues such as revocation remain under national jurisdiction. For example, a European patent granted by the EPO for France, Germany, and Switzerland is subject to national laws and courts in those respective countries for infringement cases. Prof. McGuire discussed amendments to the EPC, which allowed groups of Contracting States to enhance cooperation, resulting in the unitary patent system. This system aims to replace multiple national laws with a single unified patent law, enhancing legal certainty and efficiency.

Prof. McGuire then turned to the UPC, highlighting that it has exclusive jurisdiction over unitary patent revocation and infringement cases. However, confusion arises because Art. 3 of the UPCA indicates that the UPCA applies not only to unitary patents but also to classical European bundle patents, potentially altering the applicable substantive law. Prof. McGuire presented arguments for and against the application of the UPCA over national patent laws. Arguments for the application of the UPCA include the wording of Art. 3 UPR, Art. 24 UPCA, which prioritises UPCA over EPC, and the fact that applying the respective national law to bundle patents could be complex and inefficient. However, Prof. McGuire thinks that there are three better arguments in favour of the application of national patent law. First, Art. 64 EPC which refers to plane national patent law, has remained unchanged. Second, a systematic interpretation of the wording of Art. 3 UPCA suggests that it applies only to jurisdiction: if it would have also addressed the application of substantive law, then Art. 24 UPCA would be totally redundant. Third, Prof. McGuire expressed concerns about how anyone would know which law they must comply with if national courts apply national law to bundle patents and the UPC applies the UPCA, something that would spread legal uncertainty. As a practical solution, Prof. McGuire suggested adopting a 'presumption of similarity', where the UPC assumes that national laws comply with EU directives, as applied by the Austrian Supreme Court. This approach would harmonise enforcement without altering substantive laws. In conclusion, Prof. McGuire asserted that the UPCA establishes a common court without changing the substantive law for bundle European

patents. Such a constellation guarantees legal certainty, prevents forum shopping, and preserves the distinction between classical European bundle patents and the new unitary patent system.

The panel was followed by a discussion where a question was asked by Dr Keussen regarding the influence of the UPC on the national courts and vice versa. Judge Grabinski responded that in interpreting patent claims, the same standard should apply, and that harmonisation is seen in this regard despite the multi-layered structure of the European patent judiciary. Prof. Tilmann commented that patent law has already been largely harmonised in Europe, starting from the draft of the Community Patent Convention, which prepared the ground for national laws of the EU Member States leading to similarities that will be further enhanced in practice. Prof. McGuire commented that harmonisation has indeed already taken place, but that there is still some room for improvement, particularly with regard to damages. Judge Butin added that a majority of judges work in both the national and the UPC systems, which may foster further harmonisation. Ms Agé mentioned that the French national law was amended to ensure the full compliance with the UPCA, hence, legislative amendments can also lead to harmonisation. Lastly, Mr Freischem commented on the flexibility of the language regime at the UPC that have been one of the reasons for the acceptance of the new patent system. Maintaining this practical and open approach is therefore believed to be important for ensuring continued acceptance among the Contracting Member States.

### III. SESSION: CJEU – Current issues and developments in copyright and trademark law

#### 1. Speaker: Prof. Dr. Eleonora Rosati, Professor of Intellectual Property Law, Stockholm University

##### 'The construction of the right of communication to the public in CJEU case law: A future-proof building?'

The first panel of the third session was chaired by Dr Pablo Mohr, Deputy Director of the Intellectual Property Institute of Luxembourg (IPIL), Luxembourg. The session focused on current issues and developments in copyright and trademark law at the Court of Justice of the European Union (CJEU). The first speaker, Prof. Eleonora Rosati from Stockholm University, addressed the construction of the right of communication to the public considering CJEU case law.

Prof. Rosati began by quoting Advocate General Szpunar's recent opinion in *GEMA*,<sup>40</sup> highlighting that the right of communication to the public has been a significant focus of copyright referrals to the CJEU, with over 25 cases over the years. She explained that Art. 3 of the InfoSoc Directive<sup>41</sup> provides little clarity on what constitutes communication to the public, leading to a trend in

<sup>40</sup> Case C-135/23 *Gesellschaft für musikalische Aufführungs- und mechanische Vervielfältigungsrechte eV (GEMA) v GL* ECLI:EU:C:2024:151, Opinion of Advocate General Szpunar.

<sup>41</sup> Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (n 16).



CJEU case law to undertake individual assessments of the circumstances at hand. This approach has resulted in very tailored outcomes, creating a sense of insecurity across national courts, which increasingly refer cases to the CJEU unless there is an exact precedent. Prof. Rosati outlined the legislative history of the right, tracing it back to the 1996 WIPO Copyright Treaty,<sup>42</sup> which had complex linguistic choices regarding the definition of communication to the public. She discussed the CJEU's responses, which require both an act of communication and a public. However, the court has struggled with defining whether communication requires actual transmission or simply making a work accessible, leading to various interpretations in case law. A significant issue has been the concept of the 'new public', which originated from an older guide to the Berne Convention.<sup>43</sup> The CJEU stated that a new public is one not considered by the right holder when the initial communication was authorised. This concept has added complexity to the already intricate framework of the right of communication to the public. Prof. Rosati mentioned that the CJEU has also injected subjective criteria, such as whether the defendant's actions were illegitimate, into its case law. This has blurred the lines between primary and secondary liability. Prof. Rosati analysed several key cases, starting with *Svensson*,<sup>44</sup> where the CJEU held that providing a hyperlink was an act of communication to the public but did not create a new public since the right holder had already considered the general internet users. In *GS Media*,<sup>45</sup> the CJEU introduced subjective elements, considering whether the link provider had a profit-making intention and knowledge of infringing content. She then moved on to discuss the liability of platforms, using *The Pirate Bay*<sup>46</sup> as an example. The CJEU concluded that the operators of such platforms can be directly liable for communication to the public if they facilitate access to infringing content, even if they do not host the content themselves. This principle was later applied in *YouTube*, where the CJEU balanced various factors to determine platform liability.<sup>47</sup>

Prof. Rosati concluded that the CJEU's case law on the right of communication to the public has become highly fact-specific, leading to fragmented jurisprudence. National courts often feel obliged to refer cases to the CJEU due to the lack of general guidance. She emphasised the need for a fair balance between rights and interests, advocating the viewing of exceptions to copyright as user rights. Prof. Rosati highlighted the fundamental contradiction between the borderless nature of the internet and the territoriality of copyright law. She suggested that national legislators should transpose directives properly and avoid assuming that the absence of specific CJEU

rulings implies a lack of answers. She also called for a rethinking of the new public criterion to enhance clarity in the law.

During the Q&A session, Prof. Rosati was asked whether clearer distinctions between primary liability for communication to the public and secondary liability would be reasonable. She agreed, noting that while the CJEU aims to provide useful solutions for referring courts and Member States, a clearer separation would improve legal clarity.

## 2. Speaker: Judge Ulf Öberg, General Court, CJEU, Luxembourg

### 'The assessment of weak elements in complex trademarks: The approach of the General Court'

The second speaker of the third session was Judge Ulf Öberg from the General Court of the CJEU, who presented the General Court's approach to assessing weak elements in complex trademarks. This panel was chaired by Ms Katia Manhaeve, President of the AIPPI Luxembourg.

Judge Öberg began by acknowledging that courts strive for coherence and rationality but do not always achieve these goals. He shared personal reflections on cases he had presided over, starting with the challenge of trademark overcrowding and the potential influence of trademarks on competition. Judge Öberg noted there was a significant concern over whether courts are overprotecting weak trademarks. He identified a tendency to prioritise similarities over differences, potentially disregarding critical distinctions. This issue is reflected in two opposing theses within case law. One posits that once a trademark is protected, it deserves full protection without further consideration of similarities. The other suggests that weak trademarks should receive less protection, questioning the role of the judge in this determination. Judge Öberg highlighted the principle that all trademarks should receive equal protection once validly registered. However, the distinctive character of the earlier mark is only one element in assessing the likelihood of confusion, alongside visual, phonetic, and conceptual similarities. He referenced *PagesJaunes*,<sup>48</sup> which warned against systematically excluding the likelihood of confusion for weak marks as it could neutralise the similarity factor. Judge Öberg discussed whether less protection should be afforded to weak trademarks or weak elements within complex trademarks. He argued against monopolising common expressions, as it restricts their free use and hampers competition. He suggested a return to a 'requirement of availability' in the likelihood of confusion analysis. Judge Öberg outlined two distinct approaches in case law:

- Likelihood of Confusion Oriented Approach, which often disregards the inherent distinctiveness or weak character of common elements in conflicting signs, focusing instead on similarities.
- Non-Likelihood of Confusion Oriented Approach, which gives significant weight to the weak character of common elements or the signs themselves in the global assessment of likelihood of confusion.

<sup>42</sup> World Intellectual Property Organization (WIPO), WIPO Copyright Treaty (WCT) adopted in Geneva on 20 December 1996 <<https://www.wipo.int/treaties/en/ip/wct/>> accessed 8 August 2024.

<sup>43</sup> World Intellectual Property Organization (WIPO), Berne Convention for the Protection of Literary and Artistic Works, adopted at Berne, 9 September 1886, and revised at Paris on 24 July 1971 <<https://www.wipo.int/treaties/en/ip/berne/>> accessed 8 August 2024.

<sup>44</sup> Case C-466/12 *Svensson* ECLI:EU:C:2014:76.

<sup>45</sup> Case C-160/15 *GS Media* ECLI:EU:C:2016:644.

<sup>46</sup> Case C-610/15 *Stichting Brein v Ziggo BV and XS4ALL Internet BV (The Pirate Bay)* ECLI:EU:C:2017:456.

<sup>47</sup> Joined Cases C-682/18 and C-683/18 *YouTube* ECLI:EU:C:2021:503.

<sup>48</sup> Case T-134/06 *Xentral LLC v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* ECLI:EU:T:2007:387.

Judge Öberg provided several case examples, including *Black Label by Equivalenza*,<sup>49</sup> which was initially dismissed by the first chamber due to sign differences but reversed by the Court of Justice, emphasising a global assessment approach. He also mentioned *International Gaming Projects v EUIPO (Triple Turbo)*<sup>50</sup> and the *Deutsche Post* case,<sup>51</sup> which demonstrated varying degrees of distinctiveness affecting the court's decisions. Judge Öberg reflected on the burden of assessing similarity and the increasing importance of individual elements in trademarks. He noted a tendency toward confirming likelihood of confusion based on similarities. However, there has been considerable thought on this matter within the EUIPO's Boards of Appeal.

During the Q&A session, Ms Manhaeve observed a trend towards the non-likelihood of confusion strand. She asked Judge Öberg whether there is a need for clarification from the Court in *Shopify*.<sup>52</sup> Judge Öberg responded that multiple approaches exist, and the case law might

evolve, potentially involving the enlarged chamber. He noted an evolution within the Boards of Appeal of the EUIPO towards non-likelihood of confusion, depending on specific circumstances.

#### IV. Closing remarks

Dr Gert Würtenberger, President of GRUR, concluded the conference by thanking everyone involved in organising the event. He specifically acknowledged Prof. Martin Stierle for initiating the conference, Ms Sandra Von Lingen for her substantial support, and the cooperation partners for contributing to the conference. Lastly, Dr Würtenberger expressed gratitude to all the speakers and the audience for the engaging discussions. He also highlighted GRUR's continuous efforts in contributing to debates on intellectual property law through various past and upcoming events and announced the next GRUR Annual Meeting on 18-20 September 2024 in Augsburg, Germany.

<sup>49</sup> Case C-328/18 P *EUIPO v Equivalenza Manufactory* ECLI:EU:C:2020:156.

<sup>50</sup> Case T-210/17 *International Gaming Projects V Euipo – Zitro Ip (Triple Turbo)* ECLI:EU:T:2018:91.

<sup>51</sup> Case T-102/14 *Deutsche Post v OHIM* ECLI:EU:T:2015:279.

<sup>52</sup> Case C-751/22 P *Shopify v EUIPO – Rossi and Others (Shoppi)* ECLI:EU:C:2023:328.