

TABLE OF CONTENTS

<i>Contributors</i>	v
<i>Preface</i>	vii
<i>Table of Cases</i>	xxi
<i>Table of Statutes</i>	lxxxvii
<i>Table of International and European Legislation, Treaties and Conventions</i>	lxxxix

1. INTRODUCTION

INTELLECTUAL PROPERTY RIGHTS IN THE 21ST CENTURY	1-001
PLAN OF THIS BOOK	1-019
History of the EU	1-024
Structure and framework of the TFEU	1-032
EU law	1-041
THE EU AND INTELLECTUAL PROPERTY	1-106
Introduction	1-106
Legislative basis for EU intellectual property legislation	1-112
Competency of EU and Member States for IPRs	1-124
EUROPEAN ECONOMIC AREA	1-133
History of the EEA	1-133
Fundamental aspects of the EEA	1-137
Structure and framework of the EEA Agreement	1-141
Acquis communautaire	1-145
Institutions of the EEA	1-148
Uniform interpretation and surveillance of EEA and EU provisions	1-153
Intellectual property and the EEA	1-156
INTERNATIONAL CONVENTIONS AND EU LAW	1-165
International conventions, Member States and the EU	1-165
International IP Treaties and EU law	1-170
TRIPs AGREEMENT	1-185
Minimum standards	1-188
Enforcement	1-190
Doha Declaration on TRIPs	1-195
TRIPs and EU law	1-197
BREXIT	1-201
Brexit and chapters of this book	1-211

2. PATENTS IN EUROPE

INTRODUCTION	2-001
PARIS CONVENTION	2-010
TRIPs AGREEMENT	2-013
Availability of patents for all inventions	2-014
Exceptions to patentability	2-017
Rights conferred by a patent	2-020
Requirement of disclosure	2-022
Exceptions to rights conferred	2-024
Compulsory licences	2-026

CONTENTS

Revocation/forfeiture of a patent	2-027
Term of a patent	2-028
Burden of proof in actions for infringement of a process patent .	2-029
PATENT COOPERATION TREATY	2-034
Fundamentals of the PCT	2-034
International application	2-045
International search	2-057
Amendment of the claims	2-065
Publication of the application	2-066
Communication to designated offices	2-070
Copy, translation and fee to designated offices—national phase	2-071
International preliminary examination—Chapter II PCT	2-075
EUROPEAN PATENT CONVENTION	2-089
Structure of this chapter on EPC	2-089
Introduction	2-091
Substantive requirements for a European patent	2-119
Rule against double patenting	2-295
Biotechnological inventions	2-296
Protection afforded by European patent	2-335
Practice and procedure under the EPC	2-372
Prosecution of application before EPO	2-429
Revocation: National Courts and Opposition Division	2-517
THE EPC, PCT AND EPO	2-527
Introduction	2-527
Roles of the EPO	2-531
EU PATENT LEGISLATION	2-537
EU Unitary Patent	2-537
Agreement on a Unified Patent Court	2-562
BIOTECHNOLOGICAL PATENT DIRECTIVE	2-605
Introduction	2-605
Proposals for a Directive approximating the laws of the Member States in relation to utility models	2-629
Supplementary protection for patented pharmaceutical and plant protection products	2-631
EU law and the Nagoya Protocol	2-706
EEA PATENT LEGISLATION	2-710
COMPARISON OF NATIONAL, PCT, EPC AND EU UNITARY PATENT	2-711
Brexit	2-713

3. TRADE MARKS IN EUROPE

INTRODUCTION TO TRADE MARKS	3-001
STRUCTURE OF THIS CHAPTER	3-012
INTERNATIONAL TREATIES	3-013
Paris Convention	3-014
TRIPs	3-017
The Madrid System	3-055
The Trademark Law Treaty	3-060
EU LAW	3-061
Introduction	3-061
Functions of a Trade Mark	3-072

CONTENTS

The Trade Mark Directive and European Trade Mark Regulation	3-125
Substantive provisions of TMD and EUTMR	3-144
Relative grounds for refusal	3-328
Consent, acquiescence and honest concurrent usage	3-436
Infringement	3-447
Defences to infringement	3-523
Defence of use of later EUTM or national registered mark	3-549
Acquiescence	3-556
Has the sign been used with the consent of the proprietor?	3-560
SPECIAL SITUATIONS	3-571
Exhaustion of the rights conferred by a trade mark	3-625
Infringement and breach of licence	3-710
Grounds for invalidity of registered trade marks	3-715
Grounds for revocation of registered trade marks	3-717
Collective and certification marks	3-819
Practice, procedure and remedies	3-833
EUROPEAN UNION TRADE MARK: PRACTICE AND PROCEDURE BEFORE EUIPO AND NATIONAL COURTS	3-837
Introduction	3-837
Res judicata between Opposition and Cancellation Divisions and decisions of national courts and intellectual property offices	3-853
Conversion of a EU Trade Mark	3-856
Enforcement of a EUTM in EU Trade Mark Courts	3-862
Appeals within and from EUIPO	3-902
International registrations and EUTMs	3-906
EUTM, NATIONAL TRADE MARKS AND MADRID SYSTEM	3-907
GEOGRAPHICAL INDICATIONS OF ORIGIN	3-911
Lisbon system	3-913
TRIPs	3-916
EU law	3-917
Regulation 1151/2012	3-928
Grounds for objection to PDOs/PGIs	3-937
Rights afforded by a PDO or PGI	3-944
Interrelationship of the law of registered trade marks and GIOs	3-972
Interrelationship of EU and national legislation for GIOs	3-986
Compliance with conditions of PDOs and PGIs	3-994
Who can enforce a PDO or PGI?	3-995
Practice and procedure for applying for PDOs/PGIs/TSGs	3-996
EEA LEGISLATION	3-1001
Brexit	3-1004
 4. COPYRIGHT IN EUROPE	
INTRODUCTION	4-001
INTERNATIONAL TREATIES	4-016
Introduction	4-016
The Universal Copyright Convention	4-045
The Rome Convention and the Phonograms Convention	4-046
The TRIPs Agreement	4-059

CONTENTS

The WIPO Copyright Treaty and the WIPO Performances and Phonograms Treaty	4-069
The Beijing Treaty on Audiovisual Performances	4-081
EU LAW	4-089
Introduction	4-089
The Computer Software Directive	4-118
The Rental Right and Neighbouring Rights Directive	4-183
Rental and lending right	4-192
Neighbouring rights	4-201
The Satellite and Cable and Online Retransmission Directives ..	4-221
The Term Directive	4-237
Database Directive	4-269
Information Society Directive	4-300
Artist's Resale Right Directive	4-442
Orphan works	4-465
The Collective Rights Management Directive	4-479
EEA LEGISLATION	4-499
Brexit	4-501
5. DESIGN PROTECTION IN EUROPE	
INTRODUCTION	5-001
PLAN OF CHAPTER	5-005
INTERNATIONAL LEGISLATION	5-006
Paris Convention	5-006
Berne Convention	5-008
WTO Agreement (TRIPs)	5-009
The Hague Agreement	5-016
EU LEGISLATION	5-030
Introduction	5-030
The Design Directive	5-035
Community Design Regulation	5-039
Common provisions under the Directive/Regulation	5-046
Provisions peculiar to the Regulation	5-197
Brexit	5-213
6. PLANT VARIETY RIGHTS IN EUROPE	
INTRODUCTION	6-001
What is a plant variety?	6-001
Background to plant variety rights	6-006
Current plant variety legislation	6-010
Plant varieties, biotechnology and patents	6-012
THE TRIPs AGREEMENT	6-015
THE CONVENTION ON BIOLOGICAL DIVERSITY	6-018
THE UPOV CONVENTION	6-023
Introduction	6-023
The 1991 Act	6-027
Fundamental principles of the 1991 Act	6-029
Equality of treatment	6-030
Cumulative protection	6-031
Protection of plant genera and species	6-032
Conditions for protection for plant varieties	6-033

CONTENTS

Examination	6-034
Variety	6-035
Novelty	6-040
Distinctness	6-046
Uniformity	6-049
Stability	6-052
Scope of plant variety rights	6-053
Exhaustion of the plant variety rights	6-071
Procedure	6-073
Miscellaneous	6-074
EU REGULATION ON PLANT RIGHTS	6-075
Introduction	6-075
Definition of “variety”	6-081
Requirements for protection	6-085
Entitlement to CPVR	6-096
Scope of CPVR	6-098
Essentially derived varieties	6-105
Miscellaneous provisions	6-110
Farmers’ privilege	6-113
Compulsory exploitation right	6-118
Exhaustion of CPVR	6-124
Duration and termination of CPVR	6-130
Practice and procedure: CPVO	6-131
Prohibition on cumulative protection	6-149
Remedies	6-150
Limitation periods	6-155
Disputes on entitlement to CPVR	6-157
Jurisdiction in infringement or entitlement disputes	6-158
Entitlement to sue	6-164
Validity of CPVR in national proceedings and stays	6-166
Brexit	6-170
 7. INTELLECTUAL PROPERTY AND FREE MOVEMENT OF GOODS	
INTRODUCTION	7-001
PLAN OF CHAPTER	7-013
FREE MOVEMENT OF GOODS—TFEU PROVISIONS	7-015
ARTICLES 34–36 AND INTELLECTUAL PROPERTY RIGHTS	7-025
Deutsche Grammophon	7-027
Centrafarm v Sterling & Winthrop	7-031
King, Queen and Knave	7-035
Specific subject-matter and the doctrine of consent	7-060
Further principles applicable to arts 34–36	7-067
Application of the principle of exhaustion of rights	7-112
Burden and standard of proof and exhaustion of rights	7-114
IPR products marketed in the EEA by licensees, economically linked persons and assignees	7-129
When and where is a product first placed on the market?	7-165
Goods marketed in Member State where there is no IPR protection	7-184
Consent and compulsory licences	7-198
International or EU-wide exhaustion of rights principle?	7-203

CONTENTS

INDIVIDUAL TYPES OF INTELLECTUAL PROPERTY	7-206
Trade marks	7-208
Patents	7-228
Copyright and industrial design	7-233
CONSUMER PROTECTION AND UNFAIR COMPETITION LAWS	7-259
Introduction	7-259
The “Dassonville” principle	7-265
The “Cassis de Dijon” principle and exceptions	7-266
Application of the “Dassonville” principle	7-269
Application of the “Cassis de Dijon” exceptions	7-285
Ancillary principles	7-289
Exhaustion and unfair competition	7-290
Unfair competition laws and GIO legislation: Article 34 or 36? ..	7-293
ARTICLE 101, ASSIGNMENTS AND TRADE MARKS	7-308
Sirena v Eda	7-312
FREE TRADE AGREEMENTS COUNTRIES	7-322
TRANSITIONAL PROVISIONS FOR ACCEDING STATES	7-327
THE EEA, FREE MOVEMENT OF GOODS AND INTELLECTUAL PROPERTY	7-337
Brexit	7-352
 8. INTELLECTUAL PROPERTY AND ARTICLE 101	
INTRODUCTION	8-001
Structure of this chapter	8-011
COMPETITION LAW AND INTELLECTUAL PROPERTY: PRINCIPLES	8-014
Introduction	8-014
The competition law “toolbox”	8-026
INTELLECTUAL PROPERTY LICENCES AND COMPETITION	8-049
Introduction	8-049
ARTICLE 101	8-070
Agreement, decisions and concerted practices	8-072
Jurisdictional aspects of art.101	8-117
Object or effect: The prevention, restriction or distortion of competition within the EU	8-121
Effect of finding that an agreement is contrary to art.101	8-141
Article 101(3) and exemption	8-144
ARTICLE 101(1) AND LICENCES	8-149
No limited licence approach	8-152
CJEU’s approach to intellectual property licensing	8-154
Article 101 and specific subject-matter	8-181
BLOCK EXEMPTIONS	8-202
INDIVIDUAL CLAUSES IN IP LICENCES	8-208
Introduction	8-208
Exclusivity and sole licences	8-213
Territorial restrictions	8-236
Duration of licence	8-245
Royalties	8-251
Field-of-use	8-270
Output restrictions	8-276
Tie-in and bundling clauses	8-284
Resale price maintenance	8-295
Downstream sales restrictions	8-299

CONTENTS

Grantback clauses	8-305
Non-compete (exclusive dealing) clauses	8-314
Captive use restrictions	8-323
Miscellaneous clauses	8-327
No challenge clauses	8-331
LITIGATION SETTLEMENT AGREEMENTS	8-354
Introduction	8-354
Decisions of CJEU	8-359
English cases	8-367
2014 Technology Transfer Guidelines	8-375
Historical decisions of the Commission	8-379
Pay for delay settlement agreements	8-386
The US approach	8-396
Summary—IP settlement agreements	8-400
NATIONAL COLLECTING SOCIETIES AND AGREEMENTS	8-403
Custom pressing: Re GEMA (Commission)	8-408
Refusal by copyright-management society to grant access to its repertoire to user established in another Member State: Ministère Public v Tournier and Lucazeau v SACEM (CJEU)	8-409
Collecting societies and single-state licences: CISAC	8-411
SUB-CONTRACTING AGREEMENTS	8-413
MERGERS AND ACQUISITIONS INVOLVING IPRs	8-420
TECHNOLOGICAL STANDARDS AND STANDARD ESSENTIAL PATENTS	8-421
EXERCISE OF IPRs CONTRARY TO ART.101	8-425
9. INTELLECTUAL PROPERTY AND TECHNOLOGY TRANSFER LICENCES	
INTRODUCTION	9-001
Structure of chapter	9-004
2014 TECHNOLOGY TRANSFER GUIDELINES	9-006
Overview	9-006
Licences covered by 2014 Guidelines	9-009
Principles to be applied to technology licences	9-012
TECHNOLOGY TRANSFER BLOCK EXEMPTION	9-013
Introduction	9-013
Sphere of application of TTBE	9-017
Relationship with other block exemptions	9-021
Market power	9-024
Competitors or non-competitors	9-028
Exemption	9-029
Hardcore restrictions	9-031
Excluded restrictions	9-052
Withdrawal in individual cases	9-056
Transitional provisions	9-057
INDIVIDUAL CLAUSES IN TECHNOLOGY TRANSFER LICENCES	9-058
10. INTELLECTUAL PROPERTY, VERTICAL AGREEMENTS	
INTRODUCTION	10-001
Franchises	10-007
FUNDAMENTAL ASPECTS OF BUSINESS FORMAT FRANCHISES	10-011
Franchises and other distribution agreements	10-014

Franchise agreements and trade mark licences	10-018
Franchise agreements and know-how licences	10-021
EU LAW AND FRANCHISES	10-023
Pronuptia v Schillgalis	10-023
Exemption: Commission's decisions post-Pronuptia	10-030
Yves Rocher: "business format" goods franchise	10-032
ServiceMaster: "business format" service franchise	10-035
SELECTIVE DISTRIBUTION: TECHNICAL AND LUXURY PRODUCTS	10-037
THE VERTICAL AGREEMENTS BLOCK EXEMPTION	10-042
Introduction	10-042
Definition of vertical agreements	10-044
Application of VABE	10-046
Market share	10-047
Competing and non-competing undertakings	10-048
IPR provisions must be ancillary to distribution or supply of goods or services	10-049
Hardcore provisions	10-058
Excluded restrictions	10-078
Withdrawal of block exemption	10-087
GUIDELINES	10-088
11. INTELLECTUAL PROPERTY AND HORIZONTAL AGREEMENTS	
INTRODUCTION	11-001
HORIZONTAL CO-OPERATION AGREEMENTS	11-008
CONCENTRATIVE JOINT VENTURE?	11-013
CO-OPERATIVE HCAs AND ART.101	11-016
General approach taken by the Commission	11-016
Research and Development Agreements	11-018
Licensing relationship between parent undertakings and JVC	11-027
Payment of royalties between participating undertakings in a joint venture	11-031
Restrictions on licensing of third parties	11-032
Commission decisions	11-033
Examples in Guidelines	11-050
RESEARCH AND DEVELOPMENT BLOCK EXEMPTION	11-053
Introduction	11-053
R&D agreements	11-058
Scope of R&D Block Exemption	11-060
Conditions for exemption	11-062
Non-competing undertakings	11-063
Competing undertakings	11-064
Hardcore restrictions	11-067
Excluded restrictions	11-074
PRODUCTION VENTURES	11-077
Commission decisions: Production JVs	11-080
SPECIALISATION BLOCK EXEMPTION	11-084
STANDARDISATION AGREEMENTS	11-088
Safe harbour	11-092
Patent disclosure	11-093
Commission Guidelines on FRAND licences	11-095
PATENT POOLS	11-097

CONTENTS

Introduction	11-097
Guidelines and block exemptions	11-102
2014 Technology Transfer Guidelines	11-103
Commission decisions: Patent pools	11-111
US approach	11-116
 12. ABUSE OF A DOMINANT POSITION	
INTRODUCTION	12-001
IPR monopolies and dominant position	12-003
TRIPs and abuse	12-018
PLAN OF CHAPTER	12-026
ARTICLE 102	12-027
DOMINANT POSITION	12-030
Market definition	12-030
Relevant market	12-032
Product interchangeability	12-033
Aftersales market—consumables, spare parts and maintenance and support	12-039
Relevant product markets and legal monopolies	12-046
Relevant product market and raw materials	12-048
Supply substitution	12-050
Barriers to entry	12-054
Supply-side substitutability and demand substitutability	12-056
Potential competition	12-061
Evidence to define relevant product market	12-062
Relevant geographic market	12-063
Determination of relevant geographic market	12-065
Evidence for defining relevant geographic market	12-069
Intellectual property and relevant market	12-070
Relevant market and SEPs	12-075
Relevant market and IP licences	12-078
Relevant market and collecting societies	12-082
Dominant position in relevant market	12-085
Market shares	12-089
Barriers to entry	12-095
Behaviour suggesting dominance	12-103
Intellectual property and dominant position	12-105
Intellectual property, licensees and market share	12-109
Intellectual property as barriers to entry	12-113
INTELLECTUAL PROPERTY AND ABUSE UNDER ART.102	12-122
Introduction	12-122
Exceptional circumstances	12-134
Leveraging	12-147
Essential facilities	12-169
Abusive conduct and collateral exercise of IPRs	12-236
Abusive patent strategies	12-284
Technological standard and Standard Essential Patents (“SEPs”)	12-290
Patent ambush	12-323
Article 102 and defences under EU IP legislation	12-325
REMEDIES FOR ABUSE	12-328

CONTENTS

WHICH AFFECTS TRADE BETWEEN MEMBER STATES?	12-338
SUBSTANTIAL PART OF THE INTERNAL MARKET	12-340
ONE OR MORE UNDERTAKINGS	12-342
13. EU DEFENCES TO EXERCISE OF IPRs	
INTRODUCTION	13-001
NEXUS	13-006
ARTICLE 101 DEFENCES TO EXERCISE OF IPRs	13-009
Exercise of intellectual property rights is contrary to art.102:	
Nexus	13-028
Exercise of IPRs is contrary to arts 34–36	13-045
ABUS DE DROIT	13-050
HUMAN RIGHTS	13-062
E-COMMERCE DIRECTIVE	13-071
Mere conduit and caching and hosting	13-074
14. PROCEDURES AND REMEDIES FOR ENFORCEMENT OF IPRs	
INTRODUCTION	14-001
HARMONISATION OF PROCEDURES AND REMEDIES RELATING TO ENFORCEMENT	
OF IPRs	14-004
General provisions	14-009
Proceedings and persons who can bring proceedings for IPR	
infringement	14-012
Evidence	14-014
Right to information	14-017
Provisional and precautionary measures	14-024
Final remedies	14-033
15. BORDER CONTROLS	
INTRODUCTION	15-001
OVERVIEW OF THE CUSTOMS REGULATION	15-004
INTELLECTUAL PROPERTY RIGHTS COVERED BY THE CUSTOMS REGULATION ...	15-008
GOODS COVERED BY THE CUSTOMS REGULATION	15-009
GOODS INTENDED TO BE MARKETING IN THE EU	15-011
IMPORTATION INTO EU FOR PRIVATE USE	15-014
APPLICATION TO CUSTOMS AUTHORITIES BY IPRs OWNER	15-016
MONITORING AND SEIZURE OF GOODS SUSPECTED OF INFRINGING IPRs	15-017
DESTRUCTION OR FORFEITURE OF GOODS	15-022
LIABILITY OF CUSTOMS	15-028
16. JURISDICTION AND INTELLECTUAL PROPERTY	
INTRODUCTION	16-001
Brussels Convention	16-005
Lugano Convention	16-007
Hague Convention	16-008
The Brussels Regulation	16-009
Recast Brussels Regulation	16-011
Jurisdiction and choice of law	16-012
Structure of this chapter	16-014

CONTENTS

THE RECAST BRUSSELS REGULATION	16-015
Introduction	16-015
The Brussels Convention, the Jurisdiction Regulations and their interpretation	16-018
Fundamental principles of the Recast Brussels Regulation	16-020
The golden rules	16-029
Domicile of the defendant: Fundamental rule	16-031
Supplemental jurisdictional rules	16-041
Place where harmful event occurred—art.7(2)	16-045
Online infringements of IPRs	16-069
Co-defendants/art.8(1)	16-091
Submission to jurisdiction	16-108
Provisional and protective measures	16-109
Exclusive jurisdiction	16-123
Proceedings concerning the validity of registered IPRs	16-125
IP disputes between employee and employer	16-178
Written jurisdiction agreements	16-183
Lis pendens	16-197
Special jurisdictional rules	16-227
Jurisdictional dispute between courts of a Member State and a third state	16-241
Recognition and enforcement of judgments	16-254
Determination of jurisdictional issues under the Recast Brussels Regulation	16-267
Anti-suit injunctions	16-269
INTELLECTUAL PROPERTY AND PRIVATE INTERNATIONAL LAW	16-271
THE UK AND BREXIT	16-293
<i>Index</i>	1447