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INTELLECTUAL PROPERTY,  
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## COPYRIGHT

*Copyright — Harmonisation of certain aspects of copyright and related rights in the information society — Directive 2001/29/EC — Scope — Article 2 — Reproduction rights — Concept of 'work' — Taste of a food product*

### The taste of food not protected under EU copyright law – for now

The Court of Justice of the European Union rules that the taste of food is not protected by copyright given the lack of precision and objectivity with which taste can be identified using current scientific means.

***Levola Hengelo BV v Smilde Foods BV (Court of Justice of the European Union), C-310/17, ECLI: EU:C:2018:899 (13 November 2018)***

#### Facts

The plaintiff, Levola Hengelo BV ("**Levola**"), owner of intellectual property rights in a cream cheese dip ("**Heksenkaas**"), instituted proceedings in a district court in the Netherlands, for infringement of copyright, claiming that the product manufactured by the defendant, Smilde Foods BV ("**Smilde**") was a "reproduction" of the taste of Heksenkaas. At first instance, Levola's claims were rejected on grounds that Levola had not indicated the elements of the taste of Heksenkaas that gave it its unique, original character. On appeal by Levola, the appellate court made a request to the Court of Justice of the European Union ("**CJEU**") for a preliminary ruling on whether the taste of a food product is protected by copyright.

#### Issue

The issue for the CJEU was whether the taste of a food product fell within the meaning of a "work" under 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 ("**Directive**").

#### Decision

The CJEU held that the taste of a food product did not fall within the definition of a "work" referred to in the Directive, and was thus not protected by copyright. In this connection, it clarified that two conditions must be met before a subject matter could be considered a "work" within the Directive: (i) the subject matter must be original and (ii) the subject matter must be the expression of the author's own intellectual creation. Notably, the CJEU held that the "expression" of a work protected by copyright must be in such a manner which makes it identifiable with sufficient precision and objectivity.

The CJEU concluded that given the "current state of scientific development", it was not possible to ascertain or identify the taste of food products in a precise and objective way through technical means. The CJEU made clear that in light of the need for a uniform application of EU law, national legislation in the EU should not be interpreted in a way so as to grant copyright to the taste of food.

## Comments

This decision reinforces the position that not every original intellectual creation is afforded copyright protection. The creation must be capable of being expressed in a manner which makes it sufficiently identifiable, before it constitutes “work” that is deemed protectable. However, at the same time, the decision demonstrates a potential openness by the CJEU to accord copyright protection to creations beyond traditional categories of works, provided that these fulfil the definition of “works” and relevant criteria stipulated under legislation.

### ***Copyright and related rights — Directive 2001/29/EC — Article 4(1) — Distribution right — Infringement — Goods bearing a copyrighted motif intended for sale — Storage for commercial purposes — Storage facility separate from place of sale***

## The Court of Justice of the European Union confirms that a copyright owner’s exclusive distribution right can be violated by the storage and intended distribution of infringing goods

The Court of Justice of the European Union rules that Article 4(1) of the EU Directive 2001/29/EC, which provides for exclusivity of distribution rights for copyright holders, can be infringed by the storage of goods bearing motifs protected by copyright by a retailer, when the retailer offers such goods for sale without the authorisation of the copyright holder.

### ***Criminal Proceedings against Imran Syed (Court of Justice of the European Union), Case C-572/17, ECLI:EU:C:2018:1033 (19 December 2018)***

## Facts

Mr Imran Syed (“**Mr Syed**”) who ran a retail shop in Stockholm selling clothes and accessories with rock music motifs, also stored such goods in a storage facility adjacent to the shop and in another storage facility in the suburb. Mr Syed’s shop was regularly restocked with merchandise from these storage facilities. In criminal proceedings in Sweden, it was determined that the sale of several of those items infringed trade mark and copyright. The issue that was eventually brought to the Sweden Supreme Court, was whether Mr Syed should be liable, in addition, for the storage of infringing goods in the storage facilities.

## Issue

Article 4(1) of the Directive 2001/29/EC (“**Directive**”) requires that Member States of the European Union provide an exclusive right for authors, in respect of the original of their works or of copies thereof, “to authorise or prohibit any form of distribution to the public by sale or otherwise”. Notably, neither Swedish law – “Law (1960:729) on copyright in literary and artistic works” nor Article 4(1) of the Directive expressly prohibits the storage of goods bearing a copyright motif for the purposes of sale. In light of the above, the Supreme Court referred two questions to the Court of Justice of the European Union (“**CJEU**”) for a preliminary ruling: (a) When goods bearing protected motifs are unlawfully offered for sale in a shop, can

there also be an infringement of the author's exclusive right of distribution under Article 4(1) of Directive as regards to goods with identical motifs, which are held in storage by the person offering the goods for sale?  
(b) Is it relevant whether the goods are held in a storage facility adjacent to the shop or in another location?

## Decision

The CJEU ruled that: (a) the storage by a retailer of goods bearing a protected motif in the territory of the Member State where the goods are stored may constitute an infringement of the exclusive distribution right as defined by Article 4(1) of the Directive when that retailer offers for sale, without the authorisation of the copyright holder, goods identical to those which he is storing, *provided that the stored goods are actually intended for sale in the territory of the Member State in which that motif is protected*; and (b) the distance between the place of storage and place of sale cannot, on its own, be decisive in determining whether the stored goods are intended for sale in the territory of that Member State.

The CJEU provided the following guidelines for the determination on the issue of intention:

- **All factors to be considered:** Account must be taken of all factors which may demonstrate that the goods concerned are stored with a view to being sold on the Member State where the motifs in question are copyright protected.
- **Distance is not conclusive:** The distance between the storage facility and the place of sale is merely one factor that the court may take into account, but cannot, on its own, be decisive. The court must also consider all other factors likely to be relevant, which may include the regular restocking of the shop with goods from the storage facilities, accounting elements, the volume of sales and orders as compared with the volume of stored goods, or current contracts of sale.

## Comments

This decision by the CJEU clarifies the scope of the exclusive distribution right accorded to copyright holders under Article 4 of the Directive: the mere act of storing goods identical to the infringing goods is not sufficient; instead, it is the intention to market or sell the stored goods which must be established.

## TRADE MARKS

### Trade Mark – Opposition – Section 8(2)(b) of the Trade Marks Act

#### Guess the opposition failed?

The viewpoint of the average consumer must be assumed in the assessment of similarity between marks. A relatively simplistic geometric shape in a trade mark may be taken by an average consumer as a decorative element, rather than bearing any trade mark significance.

#### Guess?, Inc v Jen, Chi [2019] SGIPOS 3 (20 February 2019)

#### Facts

Guess?, Inc ("**Opponent**"), an American clothing and fashion brand and retailer, filed an opposition with the Intellectual Property Office of Singapore ("**IPOS**") to Jen Chi's ("**Applicant**") application to register the mark



("Application Mark"). For the opposition, the Opponent sought to rely on its earlier registered marks ("**Opponent's Earlier Marks**"), which included the following:

(i)  ("**Opponent's Earlier Registered Device Mark**")

(ii)  ("**Opponent's Earlier Registered GUESS Mark**")

One of the key issues in contention was whether the Application Mark was similar to the respective Opponent's Earlier Marks.

#### Decision

The Principal Assistant Registrar ("**PAR**") concluded that the Application Mark was visually and conceptually more dissimilar than similar to the Opponent's Earlier Registered Device Mark and that the Application Mark was visually, aurally and conceptually more dissimilar than similar to the Opponent's Earlier Registered GUESS Mark.

The PAR rejected the Opponent's arguments that the inverted triangle device, which is the common element in both the Opponent's Earlier Marks and the Application Mark, has a high level of distinctiveness such that each of the Opponent's Earlier Marks "enjoys a high threshold before a competing sign will be considered dissimilar to it". The average consumer is not likely to recognise the inverted triangle device as a mathematical symbol, as argued by the Opponent. Instead, he or she is likely to view the device as simply a decorative element.

The PAR identified various differences between the Application Mark and the Opponent's Earlier Marks, such as, in the textual elements and their positioning in the respective marks. Similarity between the respective marks was thus not established on the facts.

## Comments

This decision reinforces the principle that the assessment of similarity of marks must be considered from the viewpoint of the average consumer. Where consumers view the common element between the marks in question to be a decorative element, instead of a dominant or significant overlapping feature, mark-similarity may not be established.

### *Trade Marks and Trade Names – Opposition – Relative and Absolute Grounds of Opposition*

#### “LOVE” and “GOLD” glitter in opposition action


French jewellery company unsuccessful in opposition action against application to register “LOVE GOLD” composite mark in Singapore.

#### *Cartier International AG v MoneyMax Jewellery Pte. Ltd. [2018] SGIPOS 22 (20 December 2018)*

## Facts


Cartier International AG (“**Opponent**”) commenced a trade mark opposition action against MoneyMax Jewellery Pte. Ltd. (“**Applicant**”) in respect of the Applicant's application to register its “LOVE GOLD” mark



in Singapore:  (“**Application Mark**”) for jewellery in Class 14 and retail and other services relating to jewellery in Class 35. The Opponent relied on its prior registration of its “LOVE” trade mark registered for jewellery (among other things) in Class 14:  (“**Opponent Mark**”) in support of the opposition.

The Opponent relied on various grounds in its opposition, namely: (i) **Relative Grounds of Opposition:** Section 8(2)(b) of the Trade Marks Act (“**TMA**”) (similarity of marks and likelihood of confusion), section 8(4)(b)(i) of the TMA (similarity with well-known marks) and section 8(7)(a) of the TMA (passing off); and (ii) **Absolute Grounds of Opposition:** Section 7(1)(b) of the TMA (devoid of distinctive character) and section 7(1)(c) of the TMA (descriptiveness).

## Decision

On the Relative Grounds of Opposition, the Principal Assistant Registrar (“**PAR**”) concluded that the Application Mark was not “similar” to the Opponent Mark, within the meaning of the relevant sections of the TMA. The word “LOVE” simpliciter was not distinctive in relation to jewellery, and the only distinctive elements in the Opponent Mark resided in the stylised “Screw-head Device”  and possibly the use of a



small letter “e”. However, these elements were not present in the Application Mark. As mark-similarity could not be established, the Relative Grounds of Opposition failed on this basis.

On the Absolute Grounds of Opposition, the PAR found that although the Chinese words in the mark had no meaning, the combination of the Chinese words (which comprised a significant portion of the mark) enclosed in a rectangular device, with the words “LOVE” and “GOLD”, and the arrangement of the features in the mark, rendered the mark as a whole distinctive. In coming to this decision, the PAR emphasised that in the assessment of distinctiveness, a mark should be considered as a whole (and not in respect of its individual elements). Accordingly, the grounds of opposition under sections 7(1)(b) and 7(1)(c) of the TMA were rejected.

## Comments

The decision reaffirms the principle that no trader may claim exclusive rights over non-distinctive words in relation to goods and services concerned. Conversely, using a non-distinctive word in a trade mark is not fatal to the validity of a trade mark registration, as long as other distinctive elements are incorporated such that the mark as a whole remains overall distinctive.

# PATENTS

## *Patents – Validity – Insufficiency of Disclosure – Infringement – "Swiss-style" Claims*

### UK Supreme Court rules on the test of sufficiency and infringement for second medical use patents

The UK Supreme Court clarified the test of sufficiency for second medical use "Swiss-style" patents and declared the patentee's patent invalid for lack of sufficiency.

#### ***Warner-Lambert Company LLC v Generics (UK) Ltd t/a Mylan and another [2018] UKSC 56 (14 November 2018)***

#### **Facts**

This case concerned, inter alia, a patent revocation claim brought by Generics (UK) Ltd (trading as Mylan) ("**First Claimant**") and Actavis Group PTC EHF ("**Second Claimant**") and collectively the "**Respondents**") of a second medical use patent owned by Warner-Lambert Company LLC's ("**Appellant**") on grounds including insufficiency, and a patent infringement claim brought by the Appellant against the Second Claimant alleging the infringement of Claims 1 and 3 of the same patent.

The dispute concerned the drug, Pregabalin, which is a derivative compound of Isobutylgaba, marketed by the Appellant under the brand name "Lyrica" for three indications (epilepsy, generalised anxiety disorder and neuropathic pain). While the Appellant's patent protection under European Patent No 0641330 for Isobutylgaba for the treatment of seizure orders (notably epilepsy) had expired in the UK in 2013, the Appellant held a further second medical use patent, European Patent, EP(UK) No 0934061 ("**Patent**") containing "Swiss-style" claims covering one of the three indications (neuropathic pain). The relevant claims are set out below: (a) Claim 1: Use of [Pregabalin] or a pharmaceutically acceptable salt thereof for the preparation of a pharmaceutical composition for treating pain; (b) Claim 2: Use according to claim 1 wherein the pain is inflammatory pain; and (c) Claim 3: Use according to claim 1 wherein the pain is neuropathic pain. The Appellant contended that all the patent claims were valid and the Respondents argued that no claim as to neuropathic pain was valid, and the only valid claim was limited to inflammatory pain.

#### **Issues**

The four main issues raised on appeal (as determined by the UK Supreme Court ("**UKSC**")) were: (a) whether the Patent claims ought to be construed narrowly or broadly (in particular, Claim 3 as to neuropathic pain); (b) whether there was sufficient disclosure in the specification of the Patent; (c) whether the Appellant's attempt to amend the Patent amounted to an abuse of process and rightly rejected; and (d) the applicable test for infringement of a patent in relation to manufacturing for a limited use.

#### **Decision**

The UKSC dismissed the appeal and allowed the cross-appeal by the Respondent.

### *Construction of claims and abuse of process*

The UKSC held that a broad construction of the claims ought to be adopted (i.e. that Claim 1 extends to all pain and Claim 3 to all neuropathic pain, whether peripheral or central), and that the Appellant's attempt to amend its patent post-trial amounted to an abuse of process.

### *Sufficiency of disclosure in the specification for Claims 1 and 3*

The UKSC held, by a majority, that Claims 1 and 3 were found to be invalid for insufficiency, as the disclosure in the specification supported the claims in relation to inflammatory pain, but not neuropathic pain, whether peripheral or central. The majority of the UKSC held that the patentee was required to demonstrate that the specification discloses some scientific reason why the implied assertion of therapeutic efficacy in the patent claim was plausible. In so doing, a bare assertion or mere possibility of therapeutic efficiency would not suffice. Applying this reasoning, the majority of the UKSC found that there was no credible disclosure in the patent specification of the efficacy of Pregabalin against neuropathic pain.

### *The test for infringement of a patent manufactured for a limited use*

The UKSC unanimously found that even if Claims 1 and 3 had been valid, they would not have been infringed by Claimant 2. The reasoning of the UKSC is not binding given their findings on the invalidity of the Patent claims, but provides guiding principles. The UKSC judges agreed that only direct infringement was relevant. The UKSC unanimously dismissed the Appellant's contention that Claimant 2, in supplying pharmacists with the means for putting the patented claim into effect, had indirectly infringed the Appellant's Patent, as a "Swiss-style" claim protects only the manufacture of Pregabalin for the designated use and not the subsequent use of the product for treating patients.

The judges, however, could not agree on the applicable test in determining whether the alleged infringer had infringed a "Swiss-style" claim. Whilst two judges opined that the test is whether the alleged infringer subjectively intended to target the patent-protected market, another two judges held that the alleged infringer would only infringe a "Swiss-style" claim under circumstances where there is some indication on the product itself that it is intended for the patented indication – the "outward presentation" test. The fifth judge agreed that the test should depend on the objective appearance and characteristics of the product as it is prepared, presented and put on the market, leaving open the possibility that (a) in rare cases the context may make it obvious that these are not to be taken at face value, and (b) that there may be circumstances in which the alleged infringers or generic manufacturers should positively exclude use for the patent-protected purpose.

## **Comments**

This landmark decision highlights the importance of including, in a patent specification, the technical rationale for why the experimental data makes an invention plausible in relation to all significant areas of a second medical use patent claim. While traditionally, an invention will be deemed sufficiently disclosed if the specification enables it to be performed, this does not apply where second medical use patents are involved, given that the invention is not the compound nor its manufacturing process per se, but rather the new purpose for which the product is to be manufactured. Notably, the majority in dismissing the Appellant's

appeal and allowing the Respondents' cross-appeal, reiterated that to determine whether the patent specification in a "Swiss-style" claim has sufficiently disclosed an invention, the disclosure in a patent specification must be such as to render "plausible" the efficacy specified in a medical use claim.

While the UKSC was unable to agree on a definitive test on infringement of second medical use patents, it offered useful guidance to generic manufacturers wishing to market their drug for an out of patient use. Following this decision, generic manufacturers may want to satisfy both the "outward presentation" test (*i.e.* ensure that the final product is not presented as being suitable for the patent-protected market), and ensure that there is no subjective intention to target the patent-protected market. Prudent generic manufacturers ought to ensure that the formation, dosage, package, labelling and patient information leaflet for its drugs avoid any reference to the patented indication.

To discuss the possible implications of this for your business, please contact:



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11 July 2019	ChinaWatch: China Issues 2019 Negative List for Foreign Direct Investment

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