

EDWARDS ANGELL PALMER & DODGE

2010年度
欧州連合・米国における
知的財産主要判決概要集

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検索エンジンキーワード：ブランド所有者は、Googleのアドワーズプログラム内での第三者による商標の使用をモニターする必要があります



Google France v LVMH and others (Cases C-236/08, C-237/08 and C-238/08) 23 March 2010

Portakabin Ltd v Primakabin BV (Case C-558/08) 8 July 2010

Eis.de GmbH v BBY Vertreibsgesellschaft mbH (Case C-91/09) 26 March 2010

Die BergSpechte Outdoor Reisen und Alpinschule Edi Koblmüller GmbH v Günter Guni and trekking.at Reisen GmbH (Case C-278/08) 25 March 2010

広告主がその他の企業の商標をキーワードとして求めることを認めるGoogleの方針は依然として論議を呼んでおり、ヨーロッパや米国では相当数の訴訟が行われています。欧州連合司法裁判所の判決により問題の一部は明確になっています。

主な影響

- 商標所有者は、Google アドワーズプログラム内での第三者による商標の使用をモニターする必要があります。
- 商標所有者が、あるスポンサー広告が自分の商標を侵害していると考えた場合、Googleに削除通知を提出することができます（こちらをご覧ください：https://services.google.com/inquiry/aw_tmcomplaint）。当該商標が広告の本文または見出しに使用されている場合にのみ、Googleは問題となっているスポンサー広告を削除します。
- スポンサー広告は侵害を行っているが、広告の本文または見出しには商標が含まれていない場合、商標所有者は広告主に対して商標侵害訴訟を起こす（または商標侵害訴訟の意思を表す）ことを考慮する必要があります。

Discussion

Google provides its Internet search services for free. Google generates 99% of its substantial \$23.7 billion in revenue from its AdWords program. In addition to the natural search results returned in response to a particular search term, Google will also display “sponsored ads” where the advertised has “bid” for the search term within Google’s AdWords program (in other words, the advertiser pays for its advert to be displayed to Internet users who are searching against a particular term of combination of terms). For example, a law firm might bid for “trade mark lawyer” and Google would then display the sponsored ad for that law firm when an Internet user searches for “trade mark lawyer”.

In 2004, Google decided to offer within the AdWords program both generic terms (e.g. “trade mark lawyer) and trade marks. Until 2009, Google was generally cooperative when trade mark owners objected to the use of their trade marks within the AdWords program. In 2009, in addition to abandoning its famous “Don’t be Evil” slogan, Google also ceased to cooperate with trade mark owners who objected to the use of their trade marks within the AdWords program. This led to considerable litigation across Europe and the United States.

Trade mark owners complaints include the use of the AdWords program by advertiser’s whose sites offer counterfeits, unlawful grey imports and competing products.

In 2010 the Court of Justice gave its decisions in a series of cases which considered whether Google and/or the advertisers who bid for third party trade marks within Google’s AdWords program were liable for trade mark infringement.

The findings of the Court of Justice can be summarised as follows:

Question 1: Was Google’s offer of TM with AdWords program “trade mark use”? **Answer: No**

Question 2: Was Advertiser’s use of TM “trade mark use”? **Answer: Yes**

Question 3: Did advertiser’s use of TM create customer confusion? **Answer: No, provided advertiser is clear there is no association with the trade mark owner.**

Question 4: Could Google rely on the ISP defence available under the e-commerce Directive (2000/31/EC)? **Answer: Yes**

The CJEU found that a sponsored ad will be infringing if it “does not enable an average internet user, or enables that user only with difficulty to ascertain whether the goods or services referred to therein originate from the proprietor of the trade mark ... or on the contrary, originate from a third party.”

The CJEU also found that Google cannot be held responsible for infringing sponsored ads that it is hosting “unless, having obtained knowledge of the unlawful nature of those data or of that advertiser’s activities, it failed to act expeditiously to remove or to disable access to the data concerned”

Considerable uncertainty remains, in particular regarding the circumstances under which a sponsored ad will or will not enables an Internet user to ascertain whether the goods or services referred to in the sponsored ad originate from the proprietor of the trade mark or from a another party.”

Comment

Brand owners are now faced with the need to monitor Google and enforce their trade marks against individual advertisers whose sponsored ads are confusing.

Google has also introduced a “notice and take down” procedure so that trade mark owners can object to unlawful sponsored ads. The complaint form can be found here:

https://services.google.com/inquiry/aw_tmcomplaint

Google will only remove unlawful sponsored ads where the trade mark is used in the heading of ad text.

Despite Google’s claims to the contrary, there remain issues that are yet to be resolved. We hope that some of these issues – notably some clarification as to when a sponsored ad is unlawful – will be resolved when the CJEU gives its decision this summer in Interflora and others v Marks & Spencer and others (Case C-323/09). Owners of trade marks with “reputation” (i.e. marks that are likely the most attractive to competitors using Google’s AdWords program) will also wish to explore whether bidding for the trade mark as an AdWord infringes under Article 9(1)(c) of the CTM Regulation (provisions relating to “free riding”).

和解交渉文書内で生じた不当な脅迫に対する責任を免除

*Best Buy Co Inc & Anr v Worldwide Sales Corporation España SL** (Floyd J); [2010] EWHC 1666 (Ch); 08.07.10)



当事者が異議申立手続で合意に達せず、その結果原告が被告の商標侵害に対して英国で訴訟を起こすと脅迫し、被告は英国商標法の不当な脅迫の条項のもと原告に対して訴訟を起こしました。裁判所はその脅迫の目的が広すぎるため、不当な脅迫の法的除外に該当しないと判断しました。しかしながら、脅迫が和解交渉文書内で発生したため、その文書は特権通信と見なされる理由により請求を却下しました。

主な影響

- 不当な脅迫に対する訴訟は、申し立てられた脅迫が特権通信と見なされる真剣な和解交渉文書内で発生した場合には、起こすことができません。
- 原告は、請求が商標法の不当な脅迫の条項のもとで法的除外に該当するように、慎重に起草する必要があります。「脅迫」の目的が広すぎて除外行為以外の行為に及んでいる場合は認められません。
- 脅迫に対する訴訟は、両当事者が在英ではなくても、脅迫の「一般的な受け手」により英国が侵害訴訟の法廷地となると考える場合は、英国での訴訟と見なされます。
- 脅迫に対する訴訟は加盟国登録商標あるいは共同体登録商標の何れに関係がありません。訴訟は英国での侵害行為にかかわる必要があります。

Discussion

This decision highlights the limitations of the groundless threat provision under section 21 of the Trademark Act 1994, which enables any person whose commercial interests have been affected by a groundless threat of trademark infringement to commence legal action against the maker of the threat. The claimant, a US company and its UK subsidiary “Best Buy”, sought to launch their consumer electronics business in the UK under the name “Best Buy” for which it had made trademark applications. These applications were opposed by the defendant, a Spanish corporation “España”, who owned Community and national trade marks including the words “Best buy”. Best Buy was a US retailer, known for its consumer electronic shops who was looking to expand its business into Europe.

As part of the opposition proceedings, Best Buy wrote to España suggesting a cooling-off period to allow time for settlement negotiations and to consider the possibility of a co-existence in Europe. Best Buy responded and expressed its right to take legal action to defend its interests, with reference to its prior rights, if Best Buy chose to use the BEST BUY name in Spain and Europe. España did however suggest that it would allow Best Buy to use the BEST BUY name providing it received compensation. España's letter then provided a fifteen day deadline by which Best Buy was required to confirm its agreement to enter negotiations or to provide undertakings not to use the BEST BUY mark in Europe. Settlement negotiations broke down and Best Buy issued UK proceedings against España on the grounds that the letter from España contained a threat in accordance with Section 21 of the Trademarks Act 1994. The action was dismissed.

Even though the mark in question was a Community trade mark, and the business activities of both parties were based outside the UK, the court held that the threat was actionable because a "reasonable recipient" of the letter would consider that the UK might be a likely forum for the Community trade mark owner to bring infringement proceedings. The court reasoned that, because España had not limited the threat to Spain, and instead included all of Europe, and since Best Buy sought to launch its business operations in the UK, which had been widely publicised, it was reasonable for Best Buy to view the UK as a likely choice for proceedings. Section 21 provides exclusions, which include for example "the supply of services under the mark", however the judge held that because España's letter sought undertakings in respect of any trade mark use, this included non-excluded uses such as "offering to supply services". As such, the wording was too broad and the exclusion did not apply. The judge confirmed that an alleged threat must be worded carefully to benefit from the exclusions provided by Section 21.

Despite this, the Section 21 action was dismissed due to the context in which the alleged threat was made. The judge held that the letter from Best Buy offered a settlement proposal but at the same time stated the strength of its position. In response, España's letter suggested it might be prepared to settle but at the same time underlined the strength of its own position. As such, the letter from España formed part of genuine settlement negotiations and was therefore protected by privilege. Notably, the letter from España was not actually marked "without prejudice".

Comment

This decision highlights the limitations of bringing an unjustified threats action. If a perceived threat is made as part of a without prejudice correspondence seeking a settlement, then a court cannot chop up the letter but instead must view the entire letter as privileged. Further, brand owners also need to exercise caution when making claims of infringement that relate to the United Kingdom. In particular, the determining factor is how a "reasonable recipient" of the letter would interpret the threat and whether they would view the UK as a likely forum.

There are exceptions to the Section 21 rule which can prevent a threat from becoming actionable, for example where the trade mark owner can show that the acts in respect of which proceedings were threatened do constitute trade mark infringement. However, any "threat" that covers activities beyond the exclusions under Section 21, will not be exempt. As such, threats need to be drafted carefully to ensure that they fall within the excluded acts.

英国高等裁判所は共存合意書を支持

Omega Engineering Inc v Omega SA & Others, High Court (Chancery Division), [2010] EWHC 1211 (Ch)



OMEGA商標に関する長期にわたる争いで、英国高等裁判所は英国裁判所が両当事者間で適切に締結された商標共存合意書の条項を支持することを承認しました。そのため、共存合意書は、少なくとも英国において、同一または類似する商標を巡る争いの現実的な解決方法となります。

主な影響

- 共存合意書の当事者である商標所有者には、英国裁判所によりその条項が考慮されることが保証されます。
- 英国裁判所による共存合意書の承認は、明瞭で正確に草稿されていることが前提となります。
- しかしながら、欧州共同体商標意匠庁が共存合意書に対してどのような姿勢をとるかは不明です。

Discussion

Omega SA (“Swiss”) manufactures and markets wristwatches. Omega Engineering Inc (“Engineering”) manufactures and markets products for the measurement and control of temperature, humidity, pressure, strain, force, flow, level, pH and conductivity. Both companies operate under the trade mark OMEGA. In 1984 Swiss and Engineering entered into a Co-Existence Agreement. Under Clause 5 of the Agreement, Swiss undertook *inter alia* not to object to the use and registration by Engineering of the trade mark OMEGA in relation to the following goods (the “Excluded Goods”): “*instruments and apparatus intended for a scientific or industrial application in measuring, signalling, checking, displaying or recording heat or temperature and having provision to display the time of day*”.

In 2007, Engineering applied to register the trade mark OMEGA in respect of the Excluded Goods. Swiss opposed on the basis on their earlier rights in the OMEGA name. Engineering counterclaimed that the Co-Existence Agreement amounted to consent. Swiss submitted that consent was irrelevant to an objection on relative grounds. This argument was based on the decision of the Court of First Instance (as it then was) in Case T-90/05 *Omega SA v OHIM* (2007). In this case, OHIM considered that they did not have to take

account of Co-existence agreements, since these are not “*facts*”, as their terms are subject to interpretation. In the alternative, Swiss contended that the Agreement only provided consent to the registration of the Excluded Goods in Class 9 and not in Class 14. The hearing officer of the UK Intellectual Property Office rejected these arguments and Swiss appealed. Engineering commenced proceedings in the High Court of England and Wales for breach of Clause 5 of the Agreement and later applied for a summary judgment.

The High Court favoured Engineering’s arguments in relation to the construction of the Agreement. Regarding the classification of the Excluded Goods, the court held the definition of the Excluded Goods to mean any of the goods listed in the Agreement, regardless of their Class. In relation to Swiss’ assertion that, following *Omega SA v OHIM*, the Agreement was irrelevant to oppositions on relative grounds, The court held that the existence of an agreement between the parties was a “*very palpable fact*” and concluded that it would be unjust to permit a party who had previously consented to the registration to successfully oppose an application in contravention of its contract.

Comment

Brand owners who regularly enter into co-existence agreements will welcome the acknowledgement of their significance and relevance in the UK. On the basis of this acknowledgement, the drafting of co-existence agreements will always be fundamental to their enforcement. It therefore appears that such agreements are a means to avoid protracted and expensive litigation, while retaining the protection of any trade mark rights in the UK. Whether the same approach will be adopted by the OHIM, however, it remains to be seen.

VODKATはウォッカを 巡る訴訟に敗訴

*Diageo North America, Inc and Another v
Intercontinental Brands (ICB) Ltd and Others* Court of
Appeal (Civil Division), [2010] EWCA Civ 920

DIAGEO

VODKAT
SCHNAPPS

英国控訴院はアルコール飲料”VODKAT”がVODKA（ウォッカ）のパーシング・オフであるという英国高等裁判所による先の判決を承認しました。英国控訴院はまた、パーシング・オフの保護条件として製品の品質が優れている必要はないことを確認しました。

主な影響

- パーシング・オフというのは英国コモンロー上、非登録商標について主に虚偽表示による不法行為に対して適用されます。次の三つの条件を証明しなければなりません：1) 名声の確立、2) 被告による虚偽表示、3) その結果で生じたもしくは生じ得る損害です。
- 拡大したパーシング・オフは、特定の製品における名声を保護します。このような保護は、シャンペン、シェリー、アドヴォカート、ウイスキー、ウォッカに関して英国で認められています。
- 特定のクラスの製品に関しては、登録商標権が得られていない場合でも、模倣品の製造を防ぐことができます。
- パーシング・オフの判決を避けるために、販売業者は自社の製品と同じクラスのその他の製品を区別できるように注意する必要があります。

Discussion

The Diageo group of companies (“Diageo”) is one of the leading producers and distributors of alcoholic drinks in the world. Since the 1950s, Diageo has marketed the SMIRNOFF vodka in the UK. Intercontinental Brands Ltd (ICB) produced VODKAT, a mixture of vodka and naturally fermented alcohol. Under EU Council Regulation No. 110/2008/EC, vodka is required to have an alcohol by volume (ABV) of at least 37.5 per cent. VODKAT had an overall ABV of 22 per cent and was initially marketed in a get-up which was strongly reminiscent of vodka. Diageo brought legal proceedings against ICB in respect of its “VODKAT” drink which Diageo claimed ICB was passing off as vodka.

In order for a claim in passing off to succeed, the claimant must prove goodwill, misrepresentation and damage. As to goodwill, the High Court ruled that the term vodka has a protectable reputation. Vodka's qualities as a clear, tasteless, distilled, high strength spirit had created significant goodwill in the name. In considering misrepresentation, it was found that the marketing of VODKAT was "calculated to deceive a substantial number of members of the public into believing that the product is vodka". The name VODKAT suggested that it was Vodka, or a version of Vodka or contained or was made from Vodka. As a result of the misrepresentation, the High Court concluded that there had been a loss of sales and that ICB's marketing of VODKAT was likely to erode the distinctiveness of the term vodka.

On appeal, ICB did not challenge the High Court's findings in respect of reputation, misrepresentation or damage. The appeal was based on the claim that the extended form of passing off should be limited to products which have a cachet and are perceived by the relevant public as being of superior quality. In ICB's view, Vodka did not possess such a requirement. The Court of Appeal, however, held that cachet was not a requirement of passing off and concluded that there was no reason why the necessary goodwill could not attach to a product because consumers like and value it for its inherent qualities rather than its premium status. The Court confirmed that extended passing off seeks to protect such generic terms, which have themselves developed well defined meanings without actually being distinctive of one particular marketer, as in a classic passing off action. Indeed, the term "vodka" denoted a clearly defined class of goods and had a reputation giving rise to protectable goodwill.

Comment

The decision highlights that extended passing off not only protects premium or superior goods but can include any distinctive product which has the necessary reputation and goodwill among the public. What is required is that the product has become clearly defined in the eyes of members of the public, under a particular name, as being seen to possess certain defined qualities or characteristics.

The decision also confirms that traders in certain classes of products can prevent "copycats" from intruding the market through launching imitation products and passing them off as products of a particular type. Thus, companies should avoid using commonplace but well-known terms to market competing products or should make sure that they sufficiently distinguish their products.

新聞見出しの著作権保護 が可能であるとの判決

*Newspaper Licensing Agency Ltd v Meltwater Holding
BV Chancery Division* (Companies Court) [2010] EWHC
3099 (Ch)



英国高等裁判所は、新聞のヘッドライン（見出し）は著作権保護が可能であり、オンラインメディアのユーザーは侵害を避けるために適切なライセンスを入手する必要があるという判決を下しました。

主な影響

- 新聞のヘッドラインは著作権保護が可能です。
- 新聞見出しのついたニュース記事の要約を転送することは、一般消費者ではなく、ターゲットとするクライアントに向けられているため、公正な利用の防御はありません。
- オンラインニュースモニターサービスのユーザーは、著作権ライセンスが必要です。

Discussion

Six major UK newspapers and the Newspaper Licensing Agency (“the NLA”), the claimants, brought an action against Meltwater News UK Ltd and its parent company (together “Meltwater”). The third defendant was the Public Relations Consultants Association Limited (“PRCA”), an association that represents the interests of UK public relations providers, many of which use Meltwater’s service. Meltwater is an online news monitor that collects newspaper content and sends its subscribers alerts containing articles matched to search terms they have chosen. The alerts contain the article headline, the first 256 characters of the article and a link to the full article. Meltwater agreed to obtain a licence from the NLA to provide this service.

The claimants sued the defendants for copyright infringement. The court had to decide whether the end users of the Meltwater news service required a licence from the NLA to avoid the infringement of the copyright owned by the publishers. If the court held that the end users did not require a licence, then the NLA sought to charge Meltwater a higher fee to cover this use by the end users. Meltwater was profiting substantially from using the articles at the expense of the NLA and the

NLA submitted that, at the very least, some headlines are copyright works meaning end users required a licence. In its defence, the PRCA argued that headlines are not capable of copyright as they are too short, fact based, banal and form part of the article and are therefore not independent copyright works.

The judge was bound to apply the Court of Justice of the European Union decision in *Infopaq*, which held that short sentences, or precisely eleven words extracted from newspaper articles, are protected so long as they are an “expression of the intellectual creation of the author”. It was therefore held that newspaper headlines are either independent literary works or literary works in combination with the article. As regards the “fair dealing” defence, it was held that the receipt of Meltwater’s news alerts and/or the forwarding of these to clients, was not “reporting current events” for the purpose of the defence under the UK Copyright Designs and Patents Act 1988. Moreover, Meltwater is not intended for public consumption and instead is targeted to clients for their end users. Accordingly, it was held that through their use and receipt of the email alerts, Meltwater users infringed newspaper publishers’ copyright and would need a separate licence from the NLA to allow non-infringing use of the service.

Comment

The Meltwater decision is the first time a UK court has considered the issue of whether a copyright exists in a newspaper headline. This decision provides that a newspaper headline can achieve copyright independently and, as such, media monitors will have to be mindful of the way in which they use and report articles to ensure they do not infringe the publisher’s copyright. The UK Copyright Tribunal will meet next year to review and consider the fairness of the NLA’s web licence agreements with media monitors.

サッカー試合組み合わせ表の著作権保護が認定

Football Dataco Limited and others v. Brittens Pools Limited and others [2010] EWHC 841 (Ch)



英国高等裁判所は、英国とスコットランドのサッカーリーグ試合組み合わせデータベースには著作権保護が必要であるとして、原告側勝訴の判決を下しました。しかしながら、その他の種類の著作権保護を得ることはできませんでした。この判決は上訴されており、試合組み合わせ表に関する問題は、欧州連合司法裁判所に委託されました。

主な影響

- 英国およびスコットランドのプレミアリーグ、サッカーリーグに含まれる情報を利用したい場合はライセンスを得る必要があります、そうしなければ著作権侵害になります。これはまた、その他の類似するスポーツ競技大会試合組み合わせリスト（英国には数多くあります）にも適用されると考えられます。
- 控訴院は、サッカー試合組み合わせ表に関連するデータベース指令 (Database Directive) の解釈の問題を欧州連合司法裁判所に委託しました

Discussion

The Claimants organise professional football matches in England and Scotland, and produce and publish the annual fixture lists. The Defendants comprised of a football pools company, a media company, and two betting companies, who used the data for their own commercial means without obtaining a licence. The Claimants argued that unlicensed use was an infringement of their rights as the fixture lists were protected under either database copyright (sections 3 and 3A Copyright, Designs and Patents Act 1988); the *sui generis* right (Database Regulations 1997 SI 1997/3032); or copyright as a literary work irrespective of whether it was a database.

The Court held that the fixture lists were protected by database copyright, but not by the *sui generis* right or copyright as a literary work. It found that database copyright could protect selection and arrangement of the contents of the database even where this took place before all the data was created. Database copyright did require that the contents of

the database must represent the author's own intellectual creation. The Court noted that the Claimant's efforts in creating the database entailed "significant labour and skill". A measure of this intellectual creativity was that no two fixtures in the list would be able to be interchanged without affecting the others, thus meeting the standard for database copyright to subsist. The *sui generis* right did not apply to the protection of fixture lists. The investment provided by the Claimant was held to be in the creation of the database and not in the obtaining and verifying or presenting of the data, a pre-requisite of *sui generis*. The claim for subsistence of copyright irrespective of database copyright was also dismissed.

Comment

This case is relevant given the profile and value of sporting events in the UK. Such events often attract significant sponsorship and it is useful for major brands to understand to what extent fixture lists can be used. In the case of the English football leagues, a licence is now required. This is potentially a developing area of law and the decision of the CJEU is awaited with interest.

掃除機の登録意匠は競合製品に対して施行できない

Dyson Ltd v Vax Ltd [2010] EWHC 1923 (Pat)

英国高等裁判所は、サイクロン式掃除機の登録意匠が被告の掃除機の輸入販売により侵害されたという原告の請求を、2つの掃除機は関係者つまり観察眼の鋭い消費者に全体として異なる印象を与えるという理由に基づき、却下しました。製品間の類似、原告の意匠の非常に広い保護範囲にもかかわらず、この判決が下されました。



主な影響

- 登録意匠の侵害訴訟を考慮している企業は、全体的な意匠およびそれが知識のあるユーザーに与える印象の重要性を忘れてはいけません。
- 侵害訴訟の戦略を考える際、美的アピールと機能性に関する複雑な議論は説得力がある一方、最終的には全体的な意匠が与える印象よりも重要性が低いことを覚えておかなければなりません。

Discussion

The Claimant was a very well known manufacturer of vacuum cleaners, who held a registered design for a type of cyclonic dust separating vacuum cleaner. When the Defendant launched a similar product in the UK the Claimant brought a claim for infringement which was dismissed by the High Court. In its decision, the court noted that the Claimant's product enjoyed a high level of protection given the high degree of design freedom available at the time of its design. On statements of novelty, the court further noted that they do not serve to restrict the scope of the design's protection. In the instant case this meant that although the Claimant had not expressly sought to protect a 'transparent collecting bin' as part of its registration, it was not necessarily outside the scope of protection. Protection would not be offered however where the design was determined by functional requirements.

The main consideration in the Court's decision was that an informed user (in this case a member of the public with relatively good attention to detail – rather than, for example, a vacuum cleaner salesman) would perceive a difference in the overall impression of the two products. They would notice similarities, but these would not be significant and,

importantly, they would also notice significant differences.

Comment

This case is obviously important for parties who hold registered designs. It should be noted that even in the case of products that hold high levels of protection (given the creative freedom available at the time of design), overall impression is key. If the overall impression of a potentially infringing design is different from that of the earlier design it is unlikely that a Court will make a finding of infringement.

宣伝用スローガンには商標と比較して厳しい基準は適用されない

Audi AG v OHIM (Case C-398/08 P)



商標は称賛的であり、宣伝用文章は登録可能性に関してより厳しい基準が適用されるべきではありません。当該商標がブランド所有者の商品および役務を区別できる限り、必ずしもその登録を妨げてはなりません。これは、スローガンを使用してブランドを市販しており、スローガンを商標として保護したいと望むブランド所有者にとって好ましい進展です。

主な影響

- 欧州共同体商標出願が、その商標が品質の印、または、商品やサービスを購入する誘因となる宣伝用文章のみからなるという理由に基づき拒絶されることは珍しいことではありません。
- 自動車製造業者Audiは、一つの区分（即ち 第12類「乗物、陸上、空中、または水上の移動用の装置」）で識別性が認められたのを除き、Vorsprung durch Technik（テクノロジーによる進歩またはメリット）というスローガンを商標出願当初は登録することはできませんでした。

Discussion

Following an appeal by Audi, the Court of Justice of the European Union considered the registrability of the slogan *Vorsprung durch Technik*. The Court decided that the fact a word mark was laudatory or promotional in nature did not prevent it from fulfilling the essential function of a trade mark, namely as a indication of the commercial origin of goods or services. Furthermore, it held that it was inappropriate to assess slogans under stricter criteria than those applied to other trade mark applications. In particular, the Court decided that it was not appropriate to apply any requirements that a slogan must be imaginative, memorable or striking in order to qualify for trade mark protection, and that even a slogan with a simple, objective message could qualify for registration as a trade mark if it was capable of indicating to consumers the commercial origin of goods and services.

The decision confirmed that promotional marks or slogans, which brand owners frequently use in advertising, only need to pass the same threshold as any other mark or sign in order to satisfy the requirements for trade mark registration, namely

that the slogan is capable of being perceived by relevant consumers as an indication of the commercial origin of the goods and services covered by the mark.

Comment

Brand owners should now be reassured that they can secure trade mark registrations for promotional slogans, even where these are simple and objective messages, as long as the slogan can be shown to distinguish the brand owner's goods and services from those of other undertakings, including any distinctiveness acquired through use.

英国では初期混同が商標侵害の混同の要件を満たすと判断

Och-Ziff Management Europe Limited and another v Och Capital LLP and others [2010] EWHC 2599 (Ch)

英国高等裁判所は最近、アメリカの概念である「初期混同(initial interest confusion)」が英国でも適用されるとし、ブランド所有者の商品または役務を求める顧客を引きつけるために紛らわしい表示の使用を防止し、ブランド所有者に対してさらなる保護を与えました。



主な影響

- 英国商標法により、ブランド所有者は競合者がいわゆる「おとり商法」を用いて商品および役務に顧客の注目を得るために広告内で商標を不正使用するのを妨げることができます。
- ブランド所有者は、競合者がこのような商法を利用しようとした場合に、英国裁判所を通して差止め命令を求めることができます。
- 広告主は、顧客を引きつけるために有名な第三者のブランドを使用することは、それが意図的であるか否かにかかわらず、英国商標法の侵害に当たることには注意しなければならない。宣伝広告のマーケティング・キャンペーンの一環としてそのような行為を行う際は気をつけなければなりません。

Discussion

“Initial interest confusion” is a concept imported from United States trade mark law. It provides that infringement can be found in circumstances where consumers may be initially confused as to the source of goods or services at the time of interest, but where such confusion is corrected by the time of making the purchase of the goods or services. For example, an advertiser uses an on-line advert that uses a trade mark which suggests a connection with a well-known brand, but when the Internet user clicks through to the advertiser’s website, it is clear to customers that the website is not connected with that well-known brand in any way. Courts in the United States have held that initial interest confusion can misappropriate the goodwill in a brand to attract customers to unrelated goods or services, even if any confusion is corrected by the time of purchase. In contrast, in the European Union a likelihood of confusion at the time of purchase is required for infringement.

The court considered whether the use of a confusingly similar sign would infringe an earlier mark, even if the alleged infringement did not result in any additional sales. It also considered whether there would be any damage caused to the proprietor of the earlier mark, even where the confusion was dispelled prior to purchase. Following principles taken from the recent European decisions in *Die BergSpechte* and *Portakabin*, the court held that the use of a confusingly similar mark in advertising was still an infringing use, even where it did not directly result in a diversion of sales, as it resulted in a possibility that the reputation or distinctiveness of the earlier mark would be eroded. The judge consequently held that “initial interest confusion” is actionable under a claim of a likelihood of confusion.

Comment

This judgment is good news for trade mark owners, as many instances of alleged infringement occur when unscrupulous advertisers seek to attract customers using “bait and switch” tactics. Such tactics may now be considered to infringe a trade mark, even where any customer confusion has been corrected by the time of purchase.

英国高等裁判所は、データベース権侵害の発生地は送信の行われた場所によって決定されると判断

Football Dataco Limited and others v Sportradar GmbH and another [2010] EWHC 2911 (Ch)



英国最高等判所は、ウェブサイトの著作権およびデータベース権侵害は、サイトが閲覧されている場所ではなく、サーバーのある場所が発生すると判決を下しました。裁判所はオンライン送信により「送信可能」行為は送信が行われる場所でのみ発生すると結論しました。裁判所はさらに、この点は明白な行為ではなく、かかる問題を欧州連合司法裁判所に委託する必要はないと判断しました。この判決は上訴されており、「送信可能」行為に関する問題は、欧州連合司法裁判所に委託されました。

主な影響

- ウェブサイト所有者は、サーバーのある管轄区で適用される国内の著作権およびデータベース法に関して法的アドバイスを求めてもよいでしょう。
- 侵害者は法律が厳しくない管轄区にサーバーを置くようになるでしょう。

Discussion

The claimant Football Dataco creates football fixture lists for the English and Scottish premier leagues. The defendant Sportradar GmbH hosts live sports statistics on its servers in Austria. Football Dataco claimed Sportradar copied data relating to the English and Scottish football matches which are compiled in a database known as “Football Live”. This data includes goals scored, goal scorers, penalties, yellow and red cards and substitutions. The claimants argued that when members of the British public viewed Sportradar’s websites, Sportradar was infringing Football Dataco’s UK copyright and database right.

In reaching its decision, the court referred to the interpretation of the law concerning satellite broadcasts in the European Union, where it has been established that the so called ‘emission

theory' applies. This theory states that transmission occurs at the place where the content is "introduced under the control of the person making the broadcast into an uninterrupted chain of communication". For a satellite broadcast, that place is the terminal that the signal is up-linked from. The judge concluded that the "emission theory" applied in this case and held as follows: *"The act of making available to the public all or a substantial part of the contents of a database by online transmission within the meaning of art 7(2)(b) of Parliament and Council Directive 96/9/EC on the Legal Protection of Databases was committed and committed only where the transmission took place."*

Comment

This judgement could be bad news for right owners, as UK infringers may be encouraged to base the servers of their infringing websites in jurisdictions where copyright and database right law is less strict than in the UK.

同一の名字は必ずしも混同を生じ得る商標にはならない

Becker v Harman International Industries, Court of Justice of the European Union, Decision of 24 June 2010, C-51/09

H Harman International

欧州連合司法裁判所は、商標BARBARA BECKERとBECKERについて、混同を生じ得る商標とはならないという判決を下しました。この名字は一般的なものであり、Barbara Beckerの名前はよく知られている、このことが一般大衆の当該商標に対する認知に影響を与えるという理由からです。

主な影響

- 一般的な名字からなる商標の所有者は、同一の名字を含む商標に対して混同を生じる可能性を証明することがより困難となる場合があります。
- 知名度の高い個人の名前からなる商標の所有者は、特にその名字がよく存在する場合、同一の名字を含む先行権利に対する保護強化によって利益を得られる場合があります。

Discussion

Barbara Becker, the ex-wife of the German tennis player Boris Becker, applied to register her name as Community trade mark (“CTM”) for goods in Class 9. The US company Harman International Industries opposed the application on the basis of its earlier CTM for the mark BECKER also in Class 9. The General Court of the European Union held that since “Becker” was a common surname it retained an independent distinctive role in the mark BARBARA BECKER. On such basis, there was likelihood of confusion between the marks. The applicant appealed the decision before the Court of Justice.

The Court of Justice annulled the appealed decision and referred the case back to the General Court. The Court of Justice held that the General Court should have taken into account the specific facts of the case instead of relying only on the earlier case-law. All factors must be considered, such as the overall impression of the marks, their dominant components and the perception of the marks by the average consumer. Also, account must be taken of whether the surname in question is unusual or common: in this case, “Becker” is common. Moreover, account must be taken if the

applicant whose name comprises the mark is well known (like in this case, at least in Germany) as this will influence the perception of the mark by the relevant public. Finally, the Court of Justice held that in a composite mark a surname did not retain an independent distinctive role in every case merely because it will be perceived as a surname.

Comment

This decision is interesting as it requires all factors to be considered in assessing whether a likelihood of confusion arises, and not simply that the surnames in question overlapped. Other important considerations may apply, such as whether the surname is common or not, or whether one of the names is well known among the public.

人気のある掃除機の意匠の名声はレプリカ製品に対して執行可能

Numatic International Limited v Qualtex Limited [2010] EWHC 1237 (Ch); [2010] RPC 25



NumaticとQualtexについて、英国高等裁判所は人気のある掃除機の形状等、一般消費者がNumaticを連想する特徴の組み合わせには保護可能な名声があるという判決を下しました。裁判所は、Qualtexによる“the Henry”として知られる掃除機と同じ形状および主要デザインのレプリカ製品の販売により、このレプリカ製品はオリジナル製品のデザイン的な特徴をすべて含んでいるわけではないが、一般消費者の間で混同が生じる可能性が高いと判断しました。そのため、Numaticが市場でこのレプリカを販売できないようにQualtexに対する差止命令を認めました。

主な影響

- 製品デザイナーにとって、本ケースはパーシング・オフ訴訟により登録の有無にかかわらず期限の切れた意匠権の使用を妨げることができることを証明しています。
- 著名な製品の類似品を市販したい競合者は、一般消費者が類似品をオリジナル製品と混同する可能性がないようにしなければなりません。
- パーシング・オフの法的責任を避けるためには、デザインに微量な変更を加え、オリジナル製品のブランドを自分のものに代えるだけでは十分ではない場合があります。
- 類似品の外観は、オリジナル製品の「期待される基準から外れている」必要があります。

Discussion

Numatic sought an injunction to prevent Qualtex from launching the replica. However, it was still required to establish goodwill or reputation, a misrepresentation and the likelihood of damage. Provided the shape of a product is not dictated by the function of the product, the shape may acquire goodwill which may be protected. In this case, there was no argument that there was goodwill in the combination of the features of the Henry which included the brand name, a black bowler hat top and a smiley face.

Numatic produced survey evidence to show that Qualtex's

replica product was likely to mislead consumers into believing the replica was the Henry or Numatic’s product, even though the replica only featured the shape and the bowler hat of the Henry. The Court held that the omission of the face and the brand was not sufficient to prevent passing off since some consumers may not notice the omission and others may believe that it is a revamped version of the Henry. Qualtex had realised that there was a large market for a look-a-like of the Henry and identified expired designs of Numatic cleaners, on which to base the design of the replica. They believed that so long as they rebranded the replica, there would be no risk of confusion with the Henry. However the Court held that Qualtex’s rebrand of the replica as “Quick Clean Equipment” was not enough to dispel the risk of confusion, since “Quick Clean” was a descriptive name, it had not acquired a reputation in the name and the replica was likely to be displayed in some retailers without branding.

Comment

Competitors wishing to launch look-a-likes of popular designs must undergo an in-depth clearance exercise to ensure that they do not infringe not only any registered rights but also any unregistered rights protecting the design. Competitors should not simply copy prominent design features, and must adopt brand names which are distinctive and/or have an established reputation on the market or else risk not only possible claims for trade mark infringement but also in passing off.

位置商標は依然として 商標登録が困難

X Technology Swiss GmbH v OHIM (Case T-547/08) and (Case C-429/10 P)

X Technology Swiss GmbH社は、一般消費者が商標を単なる装飾と見なすという理由により、オレンジ色の靴下のつま先を特徴とする商標を共同体商標として登録することができませんでした。

主な影響

- ブランド所有者は、位置商標の登録の際に直面する障害について慎重であるべきです。
- 本ケースが示すように、裁判所は衣服の位置商標、特にライン、ストライプ、その他の明確な形状以外の特徴を含むものを単なる装飾とみなし、商標として登録することはできないと考える傾向があるかもしれません。

Discussion

X Technology applied to register the representation of an orange toe of a sock as a Community trade mark for clothing namely hosiery, socks and stockings. In the application it stated that the mark was a positional mark with the following description: “*the positional mark is characterised by an orange colouration, of the shade Pantone 16-1359 TP, in the form of a hood covering the toe of each article of hosiery. It does not cover the toes entirely; it features a limit, which, viewed from the back and the side, appears essentially to be horizontal. The mark always appears in sharp colour contrast to the remainder of the article of hosiery and is always in the same place.*” The examiner rejected the application on the ground that it was devoid of any distinctive character. On appeal, the applicant’s mark was rejected on the basis that the description accompanying the application was not precise enough to be admissible, that the applicable rules made no provision for the category of “positional marks” and that the mark was hence a 3-D or figurative mark lacking distinctive character. X Technology next appealed to the General Court, which also rejected its claims.

The General Court held that although the relevant rules did not refer to positional marks as a specific category, the list was non-exhaustive. Positional marks appeared similar to 3D

and figurative marks as applied to a surface of a product. The court did not see the relevance of classification of a positional mark as a figurative mark or three-dimensional mark, or as a specific category of marks for assessing its distinctive character. In assessing the perceptiveness of consumers, the General Court drew a distinction between articles of clothing which consumer's are generally attentive to when buying and those to which they are not. Socks and other items of hosiery fell into the later category given that they are not normally tried on prior to purchase. In this case, the colouration of a sock toe was judged to be devoid of distinctive character and subsequently refused for registration. As such, the General Court confirmed that the Board of Appeal did not err in finding that, by absence of any significant divergence from the norms and customs of the hosiery sector, the mark applied for would be perceived by the relevant public as a decorative element and that it was, for that reason, devoid of any distinctive character. X Technology is now appealing this decision to the Court of Justice of the European Union.

Comment

Positional marks remain difficult to register as trade marks, since they will need to show that they function as trade marks and are not merely decorative. It will be of interest to see how the Court of Justice of the European Union will decide on the registrability of such marks, and possibly provide guidance as to what distinctiveness requirements will be applied to such marks, in particular whether the same strict requirements as for figurative or three-dimensional marks apply.

機能的な形状は商標保護の対象とならない

Lego Juris A/S v OHIM (Mega Brands Inc. intervening)
(Case C-48/09 P)



欧州連合司法裁判所は、おもちゃを扱う大企業Legoの三次元形状の8スタッドのレゴ・ブリックからなる商標は無効であるという第一審裁判所の判決に対する上訴を棄却しました。欧州連合司法裁判所は、レゴ・ブリックの形状はレゴ・ブリックを互いにつなげた技術的結果として必然的なものであり、そのため商標として登録可能ではないと結論を下しました。

主な影響

- ブランド所有者は、製品の形状を商標として登録することを望む際、その形状が技術的結果として必然的なものである場合、注意する必要があります。
- その形状がユニークで独創的なものであっても、ある特定の機能を満たしている場合、商標として保護されません。

Discussion

Lego secured trade mark registration for the three-dimensional shape of a red brick for construction toys in 1999. Shortly thereafter, Ritvik Holdings Inc (now MEGA Brands Inc) which is Lego's main competitor in snap-together toys, applied for a declaration that the mark was invalid. MEGA Brands argued that Lego's trade mark registration would have to be refused as it consisted exclusively of the shape of goods which is necessary to obtain a technical result. In 2004, OHIM declared that the registration was invalid on the basis that it consisted exclusively of the shape of goods which was necessary to obtain a technical result. Lego filed an appeal against this decision, which was dismissed.

Lego appealed again, but this was also dismissed which resulted in Lego further appealing to the CJEU. In presenting its case, Lego argued that the Trade Marks Regulation should not prohibit the registration of every shape with a technical function, particularly where there were other shapes could perform the same technical function since as the registration would not create a monopoly. The court, however, rejected this argument and held that marks that consist exclusively of shapes that are necessary to achieve a technical result may not be registered. This was held to be true

even if that result can be achieved by other shapes using the same or another technical solution. The court also noted that its decision did not prohibit the registration of 'hybrid' marks, i.e. those in with a non-functional element, such as a decorative or imaginative element. Further, the CJEU highlighted the public interest in preventing the granting of monopolies on technical solutions and/or functional characteristics of a product.

Comment

The CJEU refused to grant protection to the shape of a product which it considered was necessary to fulfil a technical function. In its decision, the CJEU emphasised the public interest in reaching this decision so that other manufacturers would not be prevented from using that technical solution to make similar toy brick shapes.

スーパーの広告は有名なブランドを不正に利用しているとの判決

Specsavers International Healthcare Limited v Asda Stores Limited (No. 2) [2010] EWHC 2035 (Ch); [2011] FSR 1



英国高等裁判所は、Asdaの小見出し「本物のスペックセーバー(spec saver)になる」は登録商標のSpecsaversの評判を不当に利用しているという判決を下しました。しかし、Asdaの他の小見出し「Asdaでスペックセービング(spec savings)」は不当な利用とは見なされませんでした。



主な影響

- 競争相手の商標を参照又は利用し「危ない橋を渡る」的な広告戦略を求めるブランド所有者は、一般消費者が小見出しまたはスローガンから競合者の商標を強く連想しないようにしなければなりません。
- そうしなければ、そのような小見出しまたはスローガンは競争相手の商標を不正に利用していると考えられる可能性があります。

Discussion

The supermarket chain, Asda, launched a marketing campaign to promote its optician services which it provides in its larger stores. The campaign was designed to sail as close to the Specsavers' brand as legally possible and present Asda as being better than Specsavers on price. Asda launched new logos featuring green ellipses, which were reminiscent of the Specsavers' logo. However, unlike the Specsavers' logo, the ellipses in the Asda logos did not intersect and they featured the words "Asda" and "Opticians" prominently. Asda's marketing campaign featured two main straplines; the first was "Be a real spec saver at Asda" and the second "Spec savings at Asda".

Specsavers commenced proceedings under claims of trade mark infringement and passing off. The court dismissed the likelihood of confusion claims and for passing off. Due to the prominence of the Asda name in the Asda logos and straplines, there was no possibility of consumers being misled into believing that the logos were Specsavers or there was a connection with Specsavers. The court also dismissed

the majority of Specsavers' taking unfair advantage of its reputation claim, holding that the Asda logos and the second strapline had a only weak resonance with the claimant's marks. However, the court held that the use of "spec saver" in the first strapline took advantage of the claimant's mark as it made a clear reference to the knowledge of consumers and reputation of the SPECSAVERS brand as representing value. This advantage was unfair because Asda had intentionally sought to draw on the SPECSAVERS brand's reputation for value.

Comment

It is common practice for brand owners especially supermarkets to "live dangerously" by using competitors' brands as reference points for new products or in marketing campaigns. The prominent use of a well-known brand will often eliminate the likelihood for confusion with a competitor's registered mark. However, it may not be enough to prevent liability for unfair use of the competitor's brands. Brand owners who wish to make value comparisons with competitor brands are best advised if such brands are registered trade marks to make a straight comparison between the prices of their own and competitors' products in accordance with comparative advertising legislation. Otherwise, more should be done to avoid creating a strong association with the competitor's mark in the mind of the public.

「ビジネスモデル」特許は 少なくとも今のところ米国 特許保護の適格な対象

Bilski v Kappos, 130 S. Ct. 3218, 177 L. Ed. 2d 792, 2010 U.S. LEXIS 5521 (2010)

米国最高裁判所は、米国連邦巡回控訴裁判所の限定的な「機械または変換」テストは発明が特許権の保護対象に該当するか否かを決定する唯一の基準ではないと判決を下しました。その代わりとして、最高裁判所は「抽象的なアイデア」（例えばアルゴリズム）には特許性がないという確立した判例を継続して使用しました

主な影響

- ビジネスモデル特許は、米国の知的財産権の重要なカテゴリーです。少なくともデータ処理、ファイナンシャルサービス、医療診断および治療、遺伝および生化学研究ツールの分野を、ポートフォリオに加えてください

Background

Determining what is or is not eligible for patenting has been the subject of intellectual property law and subsequent litigation for decades. Determining whether a process or method is patentable has been particularly challenging.

In 2008, the CAFC ruled that processes or methods were eligible for patenting if, and only if, they satisfied one test: the “machine or transformation” test. This test required that a patentable process or method be tied to a particular machine or apparatus, or that it transform a particular article into a different state or thing. Many financial services, software and other industries were concerned that the test, if applied to so-called business methods patents, would render those patents invalid and worthless.

No Single Test Is To Be Applied

While the Supreme Court agreed with both the CAFC and the USPTO that *Bilski*'s commodities trading method was not eligible subject matter for patenting, it rejected the CAFC's creation and reliance upon the “machine or transformation” test. The Supreme Court made clear that the patent laws need to stay dynamic, as was intended, to encompass the inventions in new and unforeseen technologies. In addition, the Court cautioned that “limitations and conditions which

the legislature has not expressed” should not be read into the patent statutes enacted by Congress. In other words, since the Patent Act, Title 35, United States Code, does not categorically exclude business method and software patents, it is improper for courts to do so. (N.B. – this is a recurring theme of recent Supreme Court rulings overturning CAFC decisions.)

Comment

It is important to recognize that the Supreme Court did not preclude the courts’ further use of the “machine or transformation” test. Instead, the Court disallowed the use of this test as the exclusive test of patent eligibility for processes and methods. This test may still be used as “a useful and important investigative tool,” albeit in conjunction with other criteria and case law precedent to evaluate patent eligibility. Although the Supreme Court declined to impose specific limitations or tests for determining patent eligibility for “process patents” or provide additional insight into the meaning for the term statutory term “process,” it did leave the door open for lower courts to develop other “limiting criteria” (e.g., other tests for patent eligibility) in the area of processes and methods.

Thus, while business method and software patents are not to be entirely excluded from patent eligibility at this time, further development of US law in this area is expected.

A Cautionary Note

Of the nine current Supreme Court Justices, four concurred in the result but submitted a separate opinion expressing the view that business methods were never supposed to be patent-eligible subject matter. It is possible that a future case involving slightly different facts could present a better vehicle for these four Justices to persuade just one more of their colleagues to so rule.

「単離」DNAには特許性がない？

Ass'n for Molecular Pathology v USPTO, 702 F. Supp. 2d 181 (S.D.N.Y. 2010)

連邦地方裁判所（予審法廷）での判決のみですが、ニューヨーク判事の「単離」DNAには特許性がないという判決に世界中のバイオテクノロジー企業が狼狽しました。上訴での逆転がなければ（米国連邦巡回控訴裁判所の判決は2011年に下される見込み）、何万もの遺伝子工学特許が事実上無効となり、バイオテクノロジー産業は壊滅します。

主な影響

- 遺伝子工学産業では、通常通りビジネスに取り組んでください。もしこの判決が支持されれば、遺伝子工学産業のファイナンシャルモデルは一掃され、21世紀で最も重要な特許訴訟となりますが、これが実際に起こる可能性は非常に低いものです。

A Philosophical Challenge To Gene Patenting

Over the years since the USPTO started granting patents on genetically engineered materials and methods of producing and using them, individuals with largely philosophical objections (e.g., “life” cannot be patented, “nature” cannot be owned by private entities, etc.) have tried to challenge gene patenting on a variety of theories. Until early 2010, none had ever succeeded.

In this case, the plaintiffs managed to overcome significant obstacles to legal “standing,” with support from the American Civil Liberties Union and the Public Patent Foundation, and asked the federal district court to invalidate several “composition of matter” and method claims of gene patents owned and/or licensed by several universities, research institutions and companies. A few examples of the challenged patent claims are as follows:

1. An isolated DNA coding for a BRCA1 polypeptide, said polypeptide having the amino acid sequence set forth in SEQ ID NO:2. (U.S. Patent 5,747,282)
20. A method for screening potential cancer therapeutics which comprises: growing a transformed eukaryotic host cell containing an altered BRCA1 gene causing

cancer in the presence of a compound suspected of being a cancer therapeutic, growing said transformed eukaryotic host cell in the absence of said compound, determining the rate of growth of said host cell in the presence of said compound and the rate of growth of said host cell in the absence of said compound and comparing the growth rate of said host cells, wherein a slower rate of growth of said host cell in the presence of said compound is indicative of a cancer therapeutic. (U.S. Patent 5,747,282).

2. A method for diagnosing a predisposition for breast cancer in a human subject which comprises comparing the germline sequence of the BRCA2 gene or the sequence of its mRNA in a tissue sample from said subject with the germline sequence of the wild-type BRCA2 gene or the sequence of its mRNA, wherein an alteration in the germline sequence of the BRCA2 gene or the sequence of its mRNA of the subject indicates a predisposition to said cancer. (U.S. Patent 6,033,857)

The trial court granted summary judgment of invalidity of the composition of matter claims, based on its interpretation of old case law that a “product of nature” is not patent-eligible subject matter. The method claims were found invalid under the CAFC’s “machine or transformation” test – a legal analysis that surely will not stand on appeal in the wake of the Supreme Court’s rejection of exclusive reliance on that test for patent eligibility.

Substantive and Procedural Oddities

Among the head-turning aspects of case, a few stand out. First, 89-year old U.S. District Judge Robert Sweet either ignored or failed to understand the factual differences between naturally occurring DNA and “isolated” DNA sequences – which do not occur in nature, are not products of nature, and can only be made by the application of great human ingenuity and skill. If those differences were, in fact, understood and ignored, then the Judge also ignored 30-year old, controlling U.S. Supreme Court precedent (in *Diamond v. Chakrabarty*) that the creation of a living organism, i.e., a bacterium, that is not found anywhere in nature, constitutes a patentable “composition of matter.”

In another head-scratching aspect of the case, the U.S. Department of Justice, ostensibly the legal representative of the USPTO, has sided with the plaintiffs in arguing that USPTO should not be issuing gene patents!

Comment

This case laid the groundwork for what may be the biggest U.S. IP news story of 2011, or of the decade or even millennium. Watch for further developments: anything but the CAFC’s outright reversal of the lower court’s decision has the potential to destroy much of the economic model for genetic engineering research.

米国特許を無効にするのはどれほど困難であるべき？

i4i Ltd. P'ship v Microsoft Corp., 598 F.3d 831 (Fed. Cir.), cert. granted by *Microsoft Corp. v i4i Ltd. P'ship*, 2010 U.S. LEXIS 9311 (US, Nov. 29, 2010)



Microsoft®

Microsoftは、元々の特許出願の審査手続中に第一次審査で米国特許商標庁が異議申立者の依拠する先行技術を考慮していない場合、裁判で米国特許を無効にすることは比較的簡単であるべきか否かを考慮するように米国最高裁判所を説得しました。裁判所がこの場合より簡単であるべきであるというMicrosoftの議論に同意すれば、ほぼ30年以上の米国特許法が覆されます。

主な影響

- 米国最高裁判所がMicrosoftの議論を受け入れた場合、迅速に先行技術調査を行い、特許出願審査中に米国特許商標庁にあらゆる考え得る先行技術文献を提出する準備をしてください。

A Routine Case Inexplicably Turns Extraordinary

Patentee i4i sued Microsoft in 2007 for infringement of a patent covering the custom XML functionality of Microsoft Word. One of Microsoft's defenses was that i4i's patent was invalid as anticipated (under 35 USC § 102(b)) by an i4i product called S4, which Microsoft alleged had been publicly used or offered for sale by i4i more than one year before i4i filed its patent application. In addition, Microsoft alleged that i4i's patent was unenforceable due to inequitable conduct, as a result of i4i's failure to submit the S4 software as material prior art to the USPTO during prosecution of its patent application. The jury ruled in i4i's favor on all grounds, and damages and an injunction were awarded. Nothing unusual, so far.

If It Isn't Broken, Don't Fix It?

Microsoft had one serious problem with its S4 defense – no copies of S4 existed by the time of the litigation. Thus, the jury had nothing to inspect or consider when deciding whether S4 should have been submitted by i4i to the USPTO, or whether S4 did, in fact, embody the patented invention and thus invalidate i4i's patent. While not all that unusual a circumstance, Microsoft argued that because the USPTO never considered the allegedly prior art S4 software during examination of i4i's patent

application, the standard of proof for invalidity should be lowered from the well-established “clear and convincing evidence” test to the more easily demonstrated “preponderance of the evidence” test.

Microsoft’s argument for a lower standard of proof when the specific prior art at issue was not considered by the USPTO has been raised and uniformly rejected for nearly thirty years, and arguably for long before the creation of the CAFC in 1982, as well. On appeal, the CAFC once again rejected Microsoft’s position, as it has done countless times before. However, despite previously rejecting an equally countless number of attempts to appeal the very same issue to the next appellate level, on November 29, 2010, the U.S. Supreme Court decided to accept Microsoft’s appeal.

The single, most important question raised by the Supreme Court’s acceptance of Microsoft’s appeal is: why? Do the Supreme Court Justices see something wrong with the U.S. patent system, or the way it has been working for 30 years or more? Is the current composition of the Court more hostile to patents than in the past? One thing is certain: the Supreme Court does not have a habit of accepting discretionary appeals to congratulate the CAFC for doing its job well, or properly.

Reading Tea Leaves and Tarot Cards

While the AMP v. USPTO case has the potential to destroy the value of all genetic engineering patents, this case has the potential to dramatically reduce the value of all U.S. patents (including Microsoft’s own patents, it should be noted) by making it generally easier to invalidate them through litigation. Perhaps Microsoft (and its amici curiae supporters) believes that their patents are stronger or better than the patents on which they are sued by others; perhaps they believe that because they have so many patents, they are statistically much better off than other patent owners. The strategic thinking behind Microsoft’s challenge is not absolutely clear.

The “clear and convincing evidence” test has been viewed as a consequence of the statutory presumption of validity contained in the Patent Act, 35 USC § 282. It applies regardless of the whether or not the particular prior art, or legal issue concerning patentability, was considered by the Patent Office. However, the patent law does not actually state what the standard of proof at trial should be when challenging patent validity; many years ago, there was room to argue that the presumption of validity was a procedural mechanism, placing the burden of proof on the challenger – but not stating what standard of proof had to be met. Is this yet another instance of the Supreme Court’s campaign to rein in the CAFC’s use of rules or tests that do not appear in the patent statutes themselves?

While it might make sense that less deference should be given when the issue or prior art was not considered in the first instance, a lower standard of proof would undermine and destroy the value of nearly every patent and patent portfolio, value that has been justifiably relied upon for decades in a wide variety of circumstances, from corporate purchase and sale transactions, to financing considerations, and the like.

Equally importantly, a Supreme Court ruling in Microsoft’s favor would immediately cripple the operations of the USPTO, for every patent applicant would be best served by submitting every bit of prior art, no matter how remotely relevant, for consideration by patent examiners in order to avoid application of a lower standard of proof later.

While the result of this case will not be known until 2011, the mere fact that the Supreme Court accepted the appeal at all is regarded as one of the blockbuster IP events in 2010, and has already sent shudders throughout the inventing community.

「オンラインマーケットプレイス(電子市場)オペレーター」はどのような場合に商標権寄与侵害の責任を負う？

Tiffany (NJ) Inc. v eBay Inc., 600 F.3d 93 (2nd Cir.), cert. denied, 2010 U.S. LEXIS 9355 (U.S., Nov. 29, 2010)

TIFFANY & Co.



eBay等の「オンラインマーケットプレイスオペレーター」は、特定の売り手が模倣品を販売していることを知っている、または知っている理由があるにもかかわらず、サービスの提供を継続した場合にのみ、商標権寄与侵害の責任を負います。一部のユーザーがオンラインサービスを商標侵害に利用しているという一般知識だけでは十分ではありません。そのようなオンラインルートで販売されている商品を継続的および用心深くモニターし、オペレーターによって一般的に採用されている「通知および削除」処置を利用することはブランド所有者の責任です。

主な影響

- オンラインマーケットプレイスオペレーターは、効果的で迅速な通知および削除処置等、独自の反模倣品対策を確立し、責任ある電子市場運営をすることによりオンラインマーケットプレイスサービスを利用した販売側の特定の商標侵害行為に関する知識または寄与責任のために起訴されることを避ける必要があります。

Activities of Online Marketplace Operators Challenged

eBay is an Internet-based, online marketplace facilitating the sale and purchase of scores of millions of products of every kind and character. Among the listings on eBay's website are many of the most popularly branded products, including listings for "Tiffany" jewelry. There is no dispute that some of the listed branded products are genuine, and that a "significant portion" are counterfeit. At trial in 2008, Tiffany alleged that eBay's facilitating and advertising the sale of the counterfeit "Tiffany" goods constituted both direct and contributory trademark infringement, trademark dilution, and false advertising. The federal district court in New York ruled in favor of eBay on all of Tiffany's claims.

“General Knowledge” Is Not Enough To Establish Contributory Infringement

Nearly thirty years ago, the U.S. Supreme Court stated (in its *Inwood Labs v. Ives Labs* decision) that if “a manufacturer or distributor intentionally induces another to infringe a trademark, or if it continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement, the manufacturer or distributor is contributorily responsible for any harm done as a result of the deceit.” No appellate court had ever before considered the application of this rule in the context of an online marketplace operator. There was no allegation in the case eBay’s intentional inducement of trademark infringement. Instead, the second part of the *Inwood* test – whether eBay continued to supply its services to sellers whom it knows or has reason to know are selling counterfeit Tiffany goods – was the key issue on appeal.

It was undisputed that whenever Tiffany alerted eBay to specific infringements, eBay acted promptly and removed the listings in accordance with its own anti-counterfeiting measures, including its notice-and-take-down procedure. Not satisfied, however, Tiffany argued that “eBay knew, or at least had reason to know, that counterfeit Tiffany goods were being sold ubiquitously on its website,” and that eBay should be liable because, despite its knowledge of the widespread sale of counterfeit Tiffany merchandise on the eBay site, it continued to make its services available to infringing sellers.

The Second Circuit Court of Appeals affirmed the trial court’s decision that the sort of generalized knowledge of infringement alleged by Tiffany is not sufficient to support a finding contributory infringement, under the Supreme Court’s *Inwood* test. “For contributory infringement liability to lie, a service provider must have more than a general knowledge or reason to know that its service is being used to sell counterfeit goods. Some contemporary knowledge of which particular listings are infringing or will infringe in the future is necessary.” “[T]he particular phrasing that the [Supreme] Court used – that a defendant will be liable if it ‘continues to supply its product to one whom it knows or has reason to know is engaging in trademark infringement’ – supports the district court’s interpretation of *Inwood*, not Tiffany’s.” eBay’s satisfactory implementation and operation of its anti-counterfeiting measures, including its notice-and-take-down procedure, doomed Tiffany’s attempt to “demonstrate that eBay was supplying its service to individuals who it know or had reason to know were selling counterfeit Tiffany goods.”

Policy Issues Not The Court’s Concern

Tiffany argued that that trademark/brand owners should not be forced to monitor eBay’s website “24 hours a day and 365 days a year.” The Court of Appeals deemed that argument to be better directed to Congress, the body responsible for allocating the burden of policing trademarks through legislation.

Comment

Eventual acceptance by the Supreme Court of Tiffany’s appeal (once the case has been completely resolved) is certainly a possibility. But for now and the foreseeable future, online marketplace operators who implement reasonable notice-and-take-down procedures are immune from contributory infringement liability under U.S. trademark law for infringement solely by reason of the fact of, and their general knowledge of, the sale of infringing products on via those sales channels.

著作権消尽または著作権侵害： ソフトウェアは販売される？ それともライセンス付与？

Vernor v Autodesk, Inc., 621 F.3d 1102 (9th Cir. 2010)



消費者が店舗やオンライン小売業者から人気のあるコンピュータソフトプログラムを購入する際、「シュリンクラップ」または「クリックスルー」ライセンス規約内容を読むことはほとんどありません。少なくとも最近まで、多くのそのような消費者は購入したコンピュータソフトプログラムを所有しており、自由に転売できると考えていました。多くの場合、そのような転売は著作権侵害となります。元々の取引が販売ではなく、単なるライセンス付与取引だからです（その事実は「シュリンクラップ」または「クリックスルー」ライセンス規約内で詳しく説明されているように）。

主な影響

- ソフト会社は、ソフトの物質的譲渡に伴う文書において、(1) ユーザーはライセンスを付与されることを述べ、(2) ユーザーのソフトを譲渡する能力を明確に制限し、(3) 顕著な使用制限を課すことで、ソフトのユーザーが購入されたソフトの所有者ではなくライセンス使用者であることを明確に示す必要があります。

Background

Autodesk sold their flagship 2D and 3D computer-aided design product, AutoCAD, pursuant to the terms of a shrink wrap license that forbid resale of the software. AutoCAD was sold in sealed boxes for a fixed price with no-recurring fees or expirations for use. By including a license agreement with the copy of the software that purported to reserve to Autodesk ownership of, and title to, the copy, Autodesk argued that the copy was not owned by the purchaser.

Vernor, an eBay "PowerSeller," offered used copies of AutoCAD on eBay, which repeatedly removed Vernor's auction in response to Autodesk's DMCA) take-down notice in which Autodesk asserted copyright in the works being auctioned by Vernor. Vernor eventually filed a declaratory judgment action with the assistance of a public advocacy organization.

The federal district court ruled for Vernor, finding controlling case law on the issue precedent to be irreconcilably inconsistent and, thus, relying on the earliest directly applicable appellate court decision over later ones.

Vernor Is A Licensee, Not An Owner

The 9th Circuit Court of Appeals held that Vernor's resale of authentic, used Autodesk AutoCAD CDs constitutes copyright infringement because he is a licensee, and not a purchaser, of the copyrighted software programs. Because the CDs had never been "sold," Autodesk's rights were not exhausted by the Copyright Act's "first sale doctrine" (17 U.S.C. § 109(a)).

The Court of Appeals looked to the circumstances surrounding the transfer of the software, and held that a software user is a licensee, rather than an owner of a purchased copy, when the copyright owner: (1) specifies that the user is granted a license; (2) significantly restricts the user's ability to transfer the software; and (3) imposes notable use restrictions.

Comment

The decision is significant because most software packages include end user license agreements ("EULAs"), many of which would likely satisfy the 9th Circuit's "license" test. The case is a major victory for the software industry and for other industries (such as music and film) where the content protected by copyright can be licensed separately from the physical medium in which it is transferred to users. As a result, software publishers are now able to use copyright law to restrict the resale of "used" copies of their software products in stores and online venues such as eBay or Craigslist.

2010年米国知的財産判決トップ・リスト

特許判決

- *Bilski v Kappos*, 130 S. Ct. 3218, 177 L. Ed. 2d 792, 2010 U.S. LEXIS 5521 (2010)
- *i4i Ltd. P'ship v Microsoft Corp.*, 598 F.3d 831 (Fed. Cir.), cert. granted by Microsoft Corp. v. i4i Ltd. P'ship, 2010 U.S. LEXIS 9311 (U.S., Nov. 29, 2010)
- *Ass'n for Molecular Pathology v USPTO*, 702 F. Supp. 2d 181 (S.D.N.Y. 2010)
- *SEB S.A. v Montgomery Ward & Co.*, 594 F.3d 1360 (Fed. Cir.), reh'g denied, reh'g en banc denied, 2010 U.S. App. LEXIS 7937 (Fed. Cir., Mar. 25, 2010), cert. granted by Global-Tech Appliances, Inc. v. SEB S.A., 2010 U.S. LEXIS 8068 (U.S., Oct. 12, 2010)

The U.S. Supreme Court will decide whether actual knowledge of a patent is a prerequisite for a finding of “specific intent” needed to support liability for inducement of infringement of that patent. The CAFC appeared to so rule in an en banc decision in 2006, but in this case equated “deliberate disregard” for the likely existence of a patent with actual knowledge.

- *ResQNet.com, Inc. v Lansa, Inc.*, 594 F.3d 860 (Fed. Cir.), reh'g denied, reh'g en banc denied, 2010 U.S. App. LEXIS 7935 (Fed. Cir., Mar. 31, 2010)

The CAFC reined in speculative damages awards for patent infringement by announcing stricter standards for determining what types of evidence may be relied upon by damages experts in determining a “reasonable royalty.”

- *Prometheus Labs, Inc. v Mayo Collaborative Servs.*, Appeal No. 2008-1403, 2010 U.S. App. LEXIS 25956 (Fed. Cir., Dec. 17, 2010)

On remand from the Supreme Court following that Court's *Bilski* decision, the CAFC again found patent claims including the steps of (1) administering a drug to a subject; (2) determining metabolite levels; and (3) warning that an adjustment in dosage may be required, to recite patentable subject matter, and not merely natural phenomena.

- *Ariad Pharms, Inc. v Eli Lilly & Co.*, 598 F.3d 1336 (Fed. Cir. 2010) (en banc)

The CAFC ruled that Section 112, first paragraph, of the U.S. Patent Act (Title 35, U.S.C.), does indeed include a separate “written description” requirement in addition to the “enablement” requirement of the statute – as has been generally understood since at least since 1952.

- *Wyeth v Kappos*, 591 F.3d 1364 (Fed. Cir. 2010)

The USPTO's method of calculating Patent Term Adjustment (PTA) under 35 U.S.C. § 154(b) was ruled incorrect, resulting in extremely valuable “extended PTA” for many important pharmaceutical patents.

- *Uniloc USA, Inc. v Microsoft Corp.*, Appeal Nos. 2010-1035, -1055, 2011 U.S. App. LEXIS 11 (Fed. Cir., Jan. 4, 2011)

In another case curtailing excessive patent infringement damages awards, the CAFC rejected any use of the “25% rule of thumb” as a “fundamentally flawed tool for determining a baseline royalty rate” in the analysis of a reasonable royalty, and reiterated the limited circumstances in which the “entire market value” rule is correctly applicable.

- In re Microsoft Corp., Misc. Docket No. 944, 2011 U.S. App. LEXIS 80 (Fed. Cir., Jan. 5, 2011)

The CAFC continued its pattern of granting mandamus petitions seeking orders directing transfer of patent infringement cases truly having little or no real connection to the plaintiff's chosen litigation forum out of the U.S. District Court for the Eastern District of Texas.

- *Hyatt v Kappos*, 625 F.3d 1320 (Fed. Cir. 2010) (en banc)

In a rebuff to the USPTO's desire to limit a patent applicant's rights when challenging its refusal to grant a patent, the CAFC held that the U.S. District Court for the D.C. Circuit is not restricted to deferential review of the USPTO's decision under the Administrative Procedure Act, where the applicant offers new facts in evidence in a 35 USC § 145 civil action against the USPTO.

商標判決

- *Tiffany (NJ) Inc. v eBay Inc.*, 600 F.3d 93 (2nd Cir.), cert. denied, 2010 U.S. LEXIS 9355 (U.S., Nov. 29, 2010)

- *Nightingale Home Healthcare, Inc. v Anodyne Therapy, LLC*, 626 F.3d 958 (7th Cir. 2010)

Influentially regarded Circuit Judge Richard Posner announced a new test for use in federal courts of the Seventh Judicial Circuit (covering the states of Illinois (including Chicago), Indiana, and Wisconsin) for determining whether a Lanham Act case is "exceptional" under so as to warrant an award of attorneys' fees to the prevailing party.

- *FreecycleSunnyvale v Freecycle Network*, 626 F.3d 509 (9th Cir. 2010)

While courts in other federal judicial circuits require a showing of "naked licensing" plus proof that a mark has lost its trademark significance in order to find abandonment, the Ninth Circuit Court of Appeals affirmed a trial court's finding of abandonment based on the showing of naked licensing alone, without proof of loss of trademark significance. (It should be noted, however, that the trademark owner failed to raise the issue at the trial court, which may explain this decision and signal that that its significance may be limited, rather than representing an easing of the test for abandonment.)

著作権判決

- *Vernor v Autodesk, Inc.*, 621 F.3d 1102 (9th Cir. 2010)

- *Costco Wholesale Corp. v Omega, S.A.*, 178 L. Ed. 2d 470, 2010 U.S. LEXIS 9597 (2010)

The Copyright Act's "first sale doctrine" (17 U.S.C. § 109(a)) does not apply to goods manufactured abroad and then imported into the United States without the copyright holder's authorization.

- *Viacom Int'l, Inc. v YouTube, Inc.*, 718 F. Supp. 2d 514 (S.D.N.Y. 2010)

Viacom's copyright infringement claims (seeking more than \$1 billion) against YouTube were dismissed by the federal district court in New York. YouTube's compliance with "safe harbor" provisions for internet content hosts, namely, its compliance with the "notice-and-take-down" scheme of the Digital Millennium Copyright Act provides YouTube with complete immunity for any infringing conduct by its users. The decision is currently being appealed by Viacom to the 2nd Circuit Court of Appeals.

医薬品販売の特許システムおよび 手続の悪用に対する罰金を支持

AstraZeneca v Commission, Judgment of the General Court of the European Union (EU), Case T-321/05, 1 July 2010



第一審裁判所は、AstraZenecaが「プロトンポンプ阻害剤」市場での優勢な立場を悪用し、TFEU 第102条を侵害したという2005年の欧州委員会の判決を主として支持しました。しかし、罰金の金額を6000万ユーロから5250万ユーロに下げました。

主な影響

- 薬剤の保護期間を延長するための特許システムの明白な悪用は、市場での優勢な立場を不正に利用したものと思なされる可能性があります。
- 関係企業が優勢な立場にある場合、優勢な企業には競争を歪めない「特別な責任」があることを考慮して、行為が不正ではなくとも不当であると見なされる場合があります。
- 製薬業界では、特に問題となる薬剤が「大ヒット」であれば、容易に優勢な立場を確立できる場合があります。

Facts

On 15 June 2005, the EC adopted a decision finding that AstraZeneca has infringed Article 102 TFEU by engaging in two abusive practices in relation to its best-selling drug, Losec:

1. AstraZeneca misrepresented to national patent offices the date of the first marketing authorisation for Losec. This had the effect of enabling AstraZeneca to obtain an additional period of protection from generics competition in Belgium, Denmark, Germany, the Netherlands, Norway and the UK, by means of supplementary protection certificates (SPCs); and
2. AstraZeneca switched from selling Losec in capsule form to tablets, whilst simultaneously asking national medicines agencies to withdraw the market authorisations for Losec capsules. This meant that generic manufacturers wanting to manufacture and supply a generic similar to Losec, as well as parallel

traders, could not use the simplified marketing authorisation for the capsule form, because there would no longer be a current reference authorisation on file with the agencies.

On appeal, the General Court found that AstraZeneca had made ‘deliberately misleading representations’ to the patent offices of several EU Member States in order to obtain extended patent protection for Losec. The General Court found that this sufficed to constitute an abuse and that there was no need for the Commission to demonstrate AstraZeneca’s bad faith or any positively fraudulent intent on its part. It was held to be sufficient that the conduct of AstraZeneca was characterized by a “lack of transparency” or absence of “proactive disclosure” and was thereby contrary to the “special responsibility” of an undertaking in a dominant position “not to impair by its conduct genuine undistorted competition in the market”.

On the second abuse, the General Court found that AstraZeneca’s deregistration of its Losec capsule marketing authorizations in several EU countries at the same time as introducing Losec tablets did not constitute “competition on the merits” and, as such, amounted to an unlawful abuse.

The General Court annulled the Commission’s finding of an infringement on the deregistrations of the Losec capsule marketing authorisations in Denmark and Norway, on the ground that it was not proved that those actions were capable of restricting parallel imports and, on that basis alone, reduced the fine by €7.5m.

AstraZeneca has appealed this judgment to the Court of Justice of the EU.

Comment

This is the first time that the EC has found that creative use of the patent system and the procedures for marketing pharmaceutical products to prevent or delay the market entry of competing generic medicinal products can constitute the unlawful abuse of a dominant market position. This should be of particular concern for holders of highly successful pharmaceutical patents, given the narrow market definitions (based on specific clinical application) that are typically adopted by the competition authorities in such cases.

The EC specifically noted that the level of the fine in this case took into account the fact that some features of the abuses were novel. It is therefore likely to impose even higher fines in similar cases in future.

控訴院は商標侵害訴訟に対し 独占禁止法防御の却下を拒否

Oracle America, Inc (formerly Sun Microsystems, Inc) v M-Tech Data Ltd & Stephen Lichtenstein [2010] EWCA 997, Judgment of the Court of Appeal, 24 August 2010

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英国控訴院は、商標侵害の主張に対する被告の上訴を、原告の製品データベースへのアクセスを拒否する方針のために欧州経済地域内での当該製品の流通市場が閉鎖され、原告の配給業者が原告の商品を第三者から購入することを禁止するのは、非競争的であるということを根拠に認めました。

主な影響

- 独占禁止法は、侵害の疑いが明確な場合でも、商標侵害訴訟に対する「ユーロ防御」を根拠として使用することができます。
- そのような防御は略式判決の適用を無効にするのに十分な不確実性をもたらすかもしれませんが、訴訟で最終的に勝利を取めるか否かは定かではありません。

Facts

Sun Microsystems (subsequently acquired by Oracle) brought trade mark infringement proceedings against M-Tech (an independent distributor of computer hardware) for selling disk drives that it had acquired from a US hardware broker, and which bore the Sun trade mark, to a UK based customer without Sun's consent. Sun was able to prove from its internal records that it had first placed the disk drives in question on the market in China, Chile and the US. Sun was granted summary judgment against M-Tech by the High Court in November 2009 (*[2009] EWHC 2992 (Pat)*, Kitchen, J.), with the judge noting that it was an “inevitable conclusion that M-Tech has no defence to the claim”.

Not put off by this, M-Tech appealed this judgment to the Court of Appeal. As before the High Court, its defence was based on the following arguments:

- Sun's policy of not providing access to its product database, which would enable independent traders to distinguish products that had been placed on the market in the EEA with Sun's consent (and therefore could be legitimately resold) from others, and of vigorously

enforcing its IP rights against those traders, had the effect of effectively shutting down the secondary market in such products within the EEA. Such a policy restricted cross-border sales in the EU in a manner that was contrary to Article 34 TFEU (formerly Article 28 EC Treaty) (which prohibits governments imposing quantitative restrictions on imports and measures having equivalent effect) and was an abuse of Sun's rights. As a result, Sun was not entitled to enforce its trade mark rights against M-Tech, notwithstanding the express wording of Articles 5 and 7 of the Trade Mark Directive (2008/95/EC).

- Provisions in Sun's agreements with its authorised distributors prohibited them from purchasing Sun hardware from independent distributors, unless it was unavailable from other sources. On the assumption that such restrictions were contrary to Article 101(1) TFEU (formerly Article 81(1) EC Treaty) (which was so assumed for these purposes), Sun's enforcement of its trade mark rights against independent distributors such as M-Tech would reinforce those anticompetitive agreements and should therefore not be permitted, on the basis that the exercise of IP rights is subject to competition law (relying on *Sportswear Spa v. Stonestyle Ltd* [2007] FSR 2).

Rather surprisingly, the Court of Appeal found that both of these defences were properly arguable. On the first, it rules that the principles of Article 34 TFEU arguably superseded the express provisions of the Trade Mark Directive. (Some indication of the court's attitude, which arguably contributed to this finding, is given by its observation that "the practices alleged arguably have more to do with restricting imports with the object of preventing price competition within the EEA and thereby protecting Oracle's profit margins than with the proper exercise of the right to control the first marketing of Oracle equipment within the EEA".) On the second defence, the court found that Oracle's argument that there was a '*complete disconnect*' between the agreements and its enforcement of its trade mark rights did not take into account the allegation that both formed part of "an overall scheme for excluding secondary traders from the market".

The Court of Appeal therefore allowed the appeal and ordered that the case be remitted to the High Court, with an indication that there was a strong case for a reference by the trial judge to the Court of Justice of the EU, under Article 267 TFEU (formerly Article 234 EC Treaty). Oracle has sought leave to appeal the Court of Appeal's judgment to the Supreme Court.

Comment

This case shows that, in the absence of established authority, a well-argued defence based on European law reasoning may introduce sufficient uncertainty over the legal position to defeat an application for summary judgment, even where the issue of infringement appears to be clear cut. What is particularly surprising about this case is that the trade mark owner was seeking to enforce its rights to prevent sales of products *into* the EU that had quite clearly never been placed on the market within the EU. As such, the approach diverges from the usual one of focusing on restrictions on cross-border trade *between* EU Member States and could be viewed as a reintroduction of the concept of international exhaustion of rights. It will be interesting to see how the Supreme Court responds, if leave to appeal is granted.

欧州委員会は「特許の迎撃」を矯正するために法的義務を認める

Rambus Inc, European Commission commitments decision under Article 9 Regulation 1/2003, dated 9 December 2009, Case COMP/38.636



2009年12月9日、欧州委員会は、ダイナミックRAM (DRAM) チップに適用される標準規格に関する特許ライセンスのロイヤルティーについて、テクノロジーライセンス企業Rambusの拘束力を有する義務を認めると発表しました。責任の代償として、欧州委員会は当該企業が標準規格のDRAMチップを製造する企業に要求したロイヤルティーが優勢な立場を悪用したものか否かに関する調査を中止しました。これは、特許が標準規格に関連する場合で、Rambusは標準規格が設定された時点で、標準化団体のすべての関連する特許および特許出願を開示するという規則に従っていなかったためです。

主な影響

- 特許所有者は、特許が後に標準規格品となり、そのために所有者が市場を支配するようになった場合、優勢な立場を与えられる場合があります。
- 独占禁止法当局が特許ライセンスの適切なロイヤルティー(特許料)を結果論で論じることを決しても、標準規格品が採用された際、標準規格が設定された実際の状況を参照して、特許所有者が要求するロイヤルティーが悪用と見なされる場合があります。
- 不正行為または標準化団体の規則の不遵守の証拠は、この行為の時点で関係企業が優勢ではなかった場合でも、優勢な立場の悪用を証明する関連要因となる可能性があります。

Facts

Rambus was a member of standard setting body, JEDEC, which is responsible for setting the standard for DRAM chips. This standard includes the manner in which DRAM chips interface with other computer hardware. As a member of JEDEC from 1991 to 1996, Rambus was involved in the setting of the original DRAM standard. Contrary to the rules of the organisation, however, it did not disclose that it held issued and pending patents relating to that standard. Once the

standard was adopted, Rambus demanded royalties from all manufacturers of JEDEC-compliant DRAMs.

Following complaints from chip manufacturers, on 30 July 2007 the EC formally accused Rambus of abusing a dominant position, contrary to Article 102 of the Treaty on the Functioning of the European Union (TFEU), by claiming unreasonable royalties for the use of its patents, in circumstances where it was able to demand such high royalties only because of ‘intentional deceptive conduct’ and failure to comply with the rules of the JEDEC standard setting process. Even though Rambus had not been dominant on the market for DRAM interface technologies at the time that it engaged in this conduct, it subsequently became dominant on that market as a result of the relationship between its patents and the JEDEC standard.

Under the commitments accepted by the EC, Rambus has agreed to charge no royalties for use of those patents relating to standards that were set at the time when it was engaged in the allegedly intentionally deceptive conduct. In addition, Rambus committed to royalty caps for later generations of DRAM standards, which were not directly affected by such conduct, to reflect the fact that the industry is now locked in to the JEDEC DRAM standards on an ongoing basis and hence the effects of the original abuse are still being felt by licensees.

The commitments are valid for five years. Although the EC is prevented from reopening its investigation while the commitments are in force, it can take enforcement action against Rambus for failure to implement them.

Comment

This case clearly demonstrates the scope for attacking ‘patent ambushes’ as an abuse of dominance under Article 102 TFEU. It is consistent with the EC’s wider policy on standard setting, which emphasises that the process should take place in a non-discriminatory, open and transparent way. Further details of the EC’s attitude to standard setting are provided in its new Horizontal Agreement Guidelines, which were adopted on 14 December 2010. These include the statement that, to comply with Article 101(1) TFEU, a standard setting body should require good faith disclosure of potentially relevant IP rights and a commitment by all participants to license those rights on fair, reasonable and non-discriminatory terms.

Other 2010 competition cases/investigations which might interest you:

- *FAPL and Others v. QC Leisure/Murphy v. MPS*, C 403/08 and C-429/08, Court of Justice of the EU.
- *Reckitt Benckiser/Gaviscon*, see press release of the UK Office of Fair Trading 106/10 of 15 October 2010.
- European Commission report on the pharmaceuticals sector inquiry (see Press Release IP/09/1098 of 8 July 2009) and follow-up (including ongoing investigations into Lundbeck and Servier).

欧州特許庁の拡大審判部は 外科手技の特許性を決定

Decision G1/07 of the Enlarged Board of Appeal at the European Patent Office



拡大審判部は外科手技、特に診断法をなす外科手技の特許性について決定を下しました。欧州特許条約のもとで、人間または動物の外科手術による治療方法は、特許保護から除外されています。この判決は、この除外の範囲やヨーロッパでの外科手技の特許性の決定方法について指針を与えるものです。

主な影響

- 拡大審判部は、人間に対して相当な身体的介入のある侵襲的処置を含む請求されたイメージング方法は、除外された外科治療法として特許性はないと判決を下しました。
- しかし、審判部はまた、この除外を避けるために、この種の処置のある実施形態を放棄してもよいと決定しました。
- この判決により審判部は、相当な故意の身体的介入を含むが、患者の健康維持または回復に明らかに適切ではない方法は特許性を除外しないという先の判決を却下しました。
- 拡大審判部は、方法の目的ではなく性質を評価することでこの除外が適切か否かを決定するべきであるとしています。

Discussion

This Decision was in response to a refusal of a patent application relating to a magnetic resonance imaging method involving a step of “administering” an imaging agent. One method of administration disclosed in the application was by injection into the heart. The Enlarged Board decided that a surgical step carried out in a diagnostic method is still a surgical step and should be judged under the surgical exclusion. The Enlarged Board then went on to consider the meaning of the term “method of treatment by surgery”. It was acknowledged that it was not possible to provide an exact definition of this exemption in the Decision. However, the guidance that was provided included that the surgical method should be excluded if it: includes an invasive step; it includes a substantial physical intervention; it requires professional

medical expertise; and it entails a substantial health risk. The Enlarged Board explained that it may be possible to exclude a surgical step from a claim in order to work around this exclusion. Thus, for example, the use of a specific disclaimer could be considered or the surgical step could be excluded from the claims.

Comment

This decision clarifies the exclusion of surgical methods from patentability in Europe. The existing practice of drafting claims in Europe to exclude a surgical step appears to remain valid practice in Europe. Due consideration should be given to the fact that surgical methods are not excluded from patentability in other countries - such as the United States.

欧州特許庁の拡大審判部は投薬量法には特許性があると決定

Decision G2/08 of the Enlarged Board of Appeal at the European Patent Office



拡大審判部は、新しく独創的な投薬量法に対する医療使用クレームには特許性があるという判決を下しました。同時に、スイス型の医療使用クレームは改正欧州特許条約のもとでは許可されないと決定しました。

主な影響

- 新しく独創的な薬物に関する医療使用クレームは許可されます。
- 医療使用は必ずしも新しい疾患である必要はなく、新しく独創的な投薬量法でも構いません。
- 欧州特許出願においてスイス型クレームを用いることはもうできません。
- その代わりに、既知の薬物の新しい医療使用には次のフォーマットのクレームを用います。“Compound X for use in the treatment of disease Y”. (“混合物Xは疾患Y治療に使用”)

Discussion

The case at issue concerned a Swiss-type claim where the only distinguishing feature over the prior art was a specific dosage regime for a drug already known to treat a disease (hyperlipidaemia). There had been conflicting decisions from the European Patent Office as to whether a dosage regime could be considered a new medical use capable of imparting novelty on a medical use claim, or whether it would simply be considered a method of medical treatment. The following questions were referred to the Enlarged Board and answered as follows:

1. Where it is already known to use a particular medicament to treat a particular illness, can this known medicament be patented under the provisions of Articles 53(c) and 54(5) EPC 2000 for use in a different, new and inventive treatment by therapy of the same illness? Yes - Where it is already known to use a medicament to treat an illness,

the medicament can still be patented for use in a different treatment by therapy of the same illness.

2. If the answer to question 1 is yes, is such patenting also possible where the only novel feature of the treatment is a new and inventive dosage regime The answer to this question was also yes.
3. Are any special considerations applicable when interpreting and applying Articles 53(c) and 54(5) EPC 2000? Yes – the claim may no longer have the format of a so-called Swiss-type claim.

Comment

This is an important decision from the Enlarged Board since it confirms that when it is already known to use a medicament to treat an illness, this medicament can still be patented for use in a different treatment by therapy of the same illness. Moreover, the decision confirms that novel and inventive dosage regimes are patentable subject matter.

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