Basic reading list for the trade mark part of Module 2a

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NOTE: THE FOLLOWING IS A BASIC LIST OF SCHOLARLY LITERATURE AND CASE LAW THAT ALL STUDENTS MUST READ. FURTHER INDEPENDENT RESEARCH IS REQUIRED AND STRONGLY ENCOURAGED.

As a general resource, you are recommended to refer to Part IV of **Bently and Others, Intellectual Property Law (OUP:2018), 5th edn** [NOTE: it is extremely important that you use an up-to-date textbook which reflects the amendments made to the EU trade mark system in the context of the 2015 EU trade mark reform].

Recommended journal articles and basic case law for the various specialist parts of the module:

**Trade mark registration**

- **Textbook**
  - Bently and Others: Chapters 35-39

- **Journal articles**
  - Blum – Round, ‘Boop oop a doop – protection for cartoon image of Betty Boop’ (2014) 9(7) JIPLP 546
  - Fhima, ‘The public interest in European trade mark law’ (2017) 4 IPQ 311
  - Gommers and Others, ‘Louboutin v Van Haren: white flag for red soles or provisional truce?’ (2018) 13(11) JIPLP
  - INTA, *Review of the European Union trademark system*
  - Senftleben and Others, *Recommendation on measures to safeguard freedom of expression and undistorted competition in EU trade mark law* (2014)

- **Case law**
  - *Constantin Film Produktion v EUIPO*, C-240/18 P, EU:C:2019:553 (AG Opinion)
  - *General Motors Corp v Ypsilon S.A.*, C-375/97, EU:C:1999:408
Trade mark infringement

- **Textbook**
  - Bently and Others: Chapters 40-41

- **Journal articles**
  - Kur, ‘Trademarks function, don’t they? CJEU jurisprudence and unfair competition principles’ (2014) 45(4) IIC 434
  - Senftleben, ‘Free signs and free use – How to offer room for freedom of expression within the trademark system’ (16 June 2013)
  - Senftleben and Others, ‘Recommendations on measures to safeguard freedom of expression and undistorted competition in EU trade mark law’ (15 September 2014)

- **Case law**
  - Arsenal Football Club plc v Matthew Reed, C-206/01, EU:C:2002:651
  - Céline SARL v Céline SA, C-17/06, EU:C:2007:497
  - Coty Germany GmbH v Parfümerie Akzente GmbH, C-230/16, EU:C:2017:941
  - Trebor v Football Association, [1997] FSR 211

Trade mark enforcement online

- **Textbook**
  - Bently and Others: Chapter 40.11

- **Journal articles**
  - Bonadio, ‘Trade marks in online marketplaces: the CJEU’s stance in L’Oreal v eBay’ (2012) 18(2) CTRL 37
  - Headdon, ‘Beyond liability: on the availability and scope of injunctions against online intermediaries after L’Oreal v Ebay’ (2012) 34(3) EIPR 137
  - Husovec, ‘Holey cap! CJEU drills (yet) another hole in the e-Commerce Directive’s safe harbours’ (2017) 12(2) JIPLP 115-125
  - Kalèda, ‘The role of the principle of effective judicial protection in relation to website blocking injunctions’ (2017) 8(3) JIPIPEC 216
  - Rosati, ‘International jurisdiction in online EU trade mark infringement cases: where is the place of infringement located?’ (2016) (2016) 38(8) EIPR 482-491
– Rosati, ‘Intermediary IP Injunctions in the EU and UK Experiences: When Less (Harmonization) is More?’ (2017) 12(4) JIPLP 338

• Case law
  – AMS Neve Ltd and Others v Heritage Audio SL and Pedro Rodríguez Arribas, C-172/18, EU:C:2019:674
  – Cartier International AG & Ors v British Sky Broadcasting Ltd & Ors [2014] EWHC 3354 (Ch) (17 October 2014)
  – Tommy Hilfiger Licensing LLC and Others v DELTA CENTER a.s., C-494/15, EU:C:2016:528
  – Google France and Google, C-236/08, EU:C:2010:159
  – Interflora Inc and Interflora British Unit v Marks & Spencer plc and Flowers Direct Online Ltd, C-323/09, EU:C:2011:604
  – L’Oreal SA and Others v eBay International AG and Others, C-324/09, EU:C:2011:474
  – Cartier International AG & Ors v British Sky Broadcasting Ltd & Ors [2014] EWHC 3354 (Ch) (17 October 2014)
  – Cartier International AG and Others v British Sky Broadcasting Limited and Others [2016] EWCA Civ 658
  – Wintersteiger AG v Products 4U Sondermaschinenbau GmbH, C-523/10, EU:C:2012:220

Image/publicity rights, passing off, etc.

• Textbook
  – Bently and Others: Chapters 31, 32, 33, 34

• Journal articles
  – Blum – Ohta, ‘Personality disorder: strategies for protecting celebrity names and images in the UK’ (2014) 9(2) JIPLP 137
  – Farish, ‘Do Deepfakes Pose a Golden Opportunity? Considering Whether English Law Should Adopt California’s Publicity Right in the Age of the Deepfake’ (forthcoming) JIPLP (you’ll find the article here)
  – Lee, ‘Putting a face to the game: the intellectual property implications of using celebrity likenesses in videogames’ (2018) 13(2) JIPLP 143
  – Rosati, ‘Italian court confirms that unauthorized use of Audrey Hepburn’s likeness infringes (post mortem) image rights’ (2019) The IPKat

• Case law
  – Fenty and Others v Arcadia Group Brands Ltd and Another [2015] EWCA Civ 3
  – Michael E. DAVIS, aka Tony Davis and Others v. ELECTRONIC ARTS INC., 775 F.3d 1172 (2015)
  – Olivia de Havilland v FX Networks, LLC et al, B285629
INDUSTRIAL PROPERTY RIGHTS
READING MATERIAL FOR THE PATENT PART

Due to the lack of literature that covers all areas of patent law that we discuss in the course, you are encouraged to find literature from different sources. Here you have an indication of potential sources and recommended reading but you may and should search for further sources in order to work with the assignments and the examination exercises.

Please check the following authorities for relevant interesting material
EPO Website (containing e.g. cases, Guidelines for the Examination in the EPO, and Case Law collections)
WIPO Website
UKIPO Website

Journals of interest (non-exhaustive list)
Journal of Intellectual Property Law & Practice (See Westlaw)
International Review of Intellectual Property and Competition Law (IIC, see Westlaw)
Intellectual Property Quarterly (IPQ, see Westlaw)
http://www.stockholmiplawreview.com/

Recommended Articles and Books
Bostyn, S., No contact with the human body please! Patentability of diagnostic method inventions after G1/04, E.I.P.R. 2007, 29(6), 238-244 (European Intellectual Property Review, available on Westlaw)


Hellstadius, Å., Schovsbo, J., You told me, right? Free and informed consent in European Patent Law, Chapter 6 in Global Genes, Local Concerns – Legal Ethical and Scientific Challenges in International Biobanking, Edward Elgar 2019 (eds. T. Minssen, J. Rothmar Herrman, J. Schovsbo), available on SSRN


Papadopoulou, F., The impact of regulatory systems in life sciences: emerging exclusive rights, growing outside the scope of the traditional intellectual property system? E.I.P.R. 2018, 40(5), 301-310

Papadopoulou, F., Legal transplants and modern lawmaking in the field of pharmaceutical patents - a way to achieve international harmonisation or the source of deeper divergences, IIC 2016, 47(8), 891-911

Papadopoulou, F., Supplementary Protection Certificates; still a grey area, Journal of Intellectual Property Law & Practice, ISSN 1747-1532, Vol. 11, nr 5, s. 372-381


Virtanen, P., Software Patents and “Technology Specific” exclusion in Article 52 (3) EPC. A Legal Chimera? NIR 6/2013

Ventose, Eddy, D., In the footsteps of the framers of the European Patent Convention: examining the travaux preparatoires, E.I.P.R. 2009, 31(7), 353-363

Ventose, E., The Enlarged Board of Appeal rules on the scope of the exclusion from patent protection for methods for treatment of the human or animal body by surgery, J.I.P.L.P. 2010, 5(6), 393-396
Wested, J., Minssen, T., An Update on Research- and Bolar exemptions in the U.S. and Europe, Unsolved questions and potential scenarios in an increasingly important area of law, NIR 2/2019

Zadeikyte, E., Human Gene Patents in the United States and Europe. Eligibility and Market Effects in Light of Recent Practice Changes NIR 5/2014

Case-law CJEU

PROTECTION of BIOTECH INVENTIONS

Monsanto, C-428/08 , ECLI:EU:C:2010:402

Brüstle C-34/10,  ECLI:EU:C:2011:669

International Stem Cell Corporation v Comptroller General of Patents C-364/13 ECLI:EU:C:2014:2451

SUPPLEMENTARY PROTECTION CERTIFICATES

Boston Scientific Ltd (C-527/17) ECLI:EU:C:2018:867; [2018] 10 WLUK 394 (ECJ)

Eli Lilly & Co v Human Genome Sciences Inc (C-493/12) (ECJ (3rd Chamber)), ECLI:EU:C:2013:835

Decision of the European Court of Justice (Fourth Chamber) 21 March 2019 – Case No. C-443/17

Teva UK Ltd v Gilead Sciences Inc (C-121/17) ECLI:EU:C:2018:585; [2018] 7 WLUK 534 (ECJ)


Actavis/Sanofi judgment (C-443/12), ECLI:EU:C:2013:833

Actavis/Boehringer (C-577/13), ECLI:EU:C:2015:165

Georgetown case (C-484/12), ECLI:EU:C:2013:828

Teva/Gilead judgment (C-121/17), ECLI:EU:C:2018:585

Neurim (C-130/11), ECLI:EU:C:2012:489

Abraxis Bioscience (C-443/17), ECLI:EU:C:2019:238

Current referrals of interest

C-650/17 (Royalty Pharma)
C-114/18 (Sandoz v Searle)
Santen C-673/18 (referral)
Novartis (C-354/19) (referral)

**International Case-law**


Court of Appeal of Paris with decision of 9 October 2018 in Santen v. INPI (RG no. 17/19934

**EPO case law**

**Enlarged Board of Appeal**

G 1/83 (Second medical indication) of 5.12.1984

G 5/83 (Second medical indication/ESAI) of 5.12.1984

G 6/83 (Second medical indication) of 5.12.1984


G 1/07 (Treatment by surgery/MEDI-PHYSICS) of 15.2.2010

G 2/08 (Dosage regime/ABBOTT RESPIRATORY) of 19.2.2010


G 1/08 (Tomatoes/STATE OF ISRAEL) of 9.12.2010, OJ 2012, 130

G 2/12 (Tomatoes II) of 25.3.2015
G 2/13 (Broccoli II) of 25.3.2015

G 3/19 (pending) (on the relation between EPC Articles and Implementing Regulations in relation to Art. 53(b) and Rule 28(2))

Technical Boards of Appeal

Morality, Plants, Animals

T 19/90 (Onco-mouse/HARVARD) of 3.10.1990, OJ 1990, 476 (morality, animals)

T 356/93 (Plant cells/PLANT GENETIC SYSTEMS) of 21.2.1995, OJ 1995, 545 (morality, plants, microbiological processes)

T 866/01 (Euthanasia compositions/MICHIGAN STATE UNIV.) of 11.5.2005 (morality)

T 315/03 (Transgenic animals/HARVARD) of 6.7.2004, OJ 2006, 15 (morality, animals, relation EPC and BD)

T 1213/05 (Breast and ovarian cancer/UNIVERSITY OF UTAH) of 27.9.2007 (morality)

T 522/04 (Stem cells/CALIFORNIA) of 28.05.2009 (morality, embryo exclusion)


T 1199/08 (Selected sperm/XY) of 3.5.2012 (plants)

T 1262/04 (Non-invasive localization/LELAND STANFORD) of 13.7.2012 (morality, animals etc.)

T 2221/10 (Culturing stem cells/TECHNION) of 14.2.2014 (morality, embryo exclusion)

T 1441/13 (Embryonic stem cells, disclaimer /ASTERIAS) of 9.9.2014 (morality, embryo exclusion)

T 1729/06 (Seedless watermelon/SYNGENTA) of 17.9.2014 (plants)

T 915/10 (Soybean event/MONSANTO) of 11.6.2015 (plants)

T 83/05 (Broccoli III/PLANT BIOSCIENCE) of 10.9.2015 (plants)

T 1242/06 (Tomatoes III/STATE OF ISRAEL) of 8.12.2015 (plants)

T 547/10 (Transgenic cotton plants/BAYER CROPSCIENCE) of 13.7.2016 (plants)

T 2323/11 (Sequence excision/BASF) of 24.1.2017 (plants)

T 1208/12 (Oilseed/PIONEER HI-BRED) of 7.2.2017 (plants)

T 1063/18 (Extreme dark green, blocky peppers/SYNGENTA) of 5.12.2018 (plants)

Methods of treatment and diagnostic methods
T 144/83 (Appetite suppressant) of 27.3.1986 (methods of treatment by therapy)
T 820/92 (Contraceptive method) of 11.1.1994 (methods of treatment by therapy)
T 1172/03 of 4.5.2005 (methods of treatment by therapy)
T 5/04 of 17.1.2006 (CAMTECH) (methods of treatment by surgery)
T 1197/02 of 12.7.2006 (diagnostic methods)
T 143/04 of 12.9.2006 (diagnostic methods)
T 1635/09 (Zusammensetzung für Empfängnisverhütung/BAYER SCHERING PHARMA AG) of 27.10.2010 (method of treatment by therapy)
T 992/03 of 4.11.2010 (methods of treatment by surgery)
T 385/09 of 25.11.2010 (methods of treatment by therapy)
T 663/02 of 17.3.2011 (methods of treatment by surgery)
T 836/08 of 12.5.2011 (methods of treatment by surgery)
T 1075/06 of 17.5.2011 (methods of treatment by surgery)
T 923/08 of 2.8.2011 (methods of treatment by surgery)
T 1695/07 of 28.9.2011 (methods of treatment by surgery)
T 1798/08 of 21.8.2012 (surgical methods, apparatus claim)
T 2438/11 of 7.10.2015 (methods of treatment by surgery)
T 44/12 of 11.1.2017 (methods of treatment by therapy)
T 1819/13 of 21.2.2018 (methods of treatment by therapy)

**Pharmaceuticals (selection, second medical use, swiss-type claims)**

T 12/81 (Diastereomers) of 9.2.1982
T 181/82 (Spiro compounds) of 28.2.1984
T 144/83 (Appetite suppressant) of 27.3.1986 (industrial application)
T 12/90 of 23.8.1990
T 658/91 (Enantiomère/SANOFI) of 14.5.1993
T 352/93 (Pyrazolinverbindungen/CIBA-GEIGY) of 4.4.1995
T 366/96 (Fabric bleaching/NOVO NORDISK) of 17.2.2000
T 767/95 (Interleukin 1/IMMUNEX CORPORATION) of 5.9.2000
T 1336/04 (Cellulase/NOVOZYME) of 9.3.2006
T 1599/06 (Mycobacterium vaccinating agent/UNIVERSITY OF CALIFORNIA) of 13.9.2007
T 1450/07 (TGFalpha-HII/HUMAN GENOME SCIENCES) of 11.2.2009 (industrial application)
T 1758/07 of 7.6.2010
T 1841/09 of 15.9.2011
T 1099/09 of 12.1.2012
T 1780/12 (Cancer treatment/BOARD OF REGENTS, THE UNIVERSITY OF TEXAS SYSTEM) of 30.1.2014
T 13/14 (Agent for treatment of schizophrenia/SUMITOMO DAINIPPON) of 15.10.2015
T 754/10 (Enzyme Granulate/NOVOZYMES) of 8.2.2017

Second medical use and novelty of the therapeutic application – see further cases in Case Law of the Boards of Appeal of the EPO

Novelty criteria for use claims and process claims containing a purpose feature, see here

Inventive step – problem and solution approach in chemical inventions, see here