Global Intellectual Property Newsletter

A topic for 2016 – EU Trademark Law

Issue 03/16

CLIFFORD CHANCE

contents

We welcome you to the latest issue of our Global IP Newsletter. This marks the 9th edition of the Newsletter and we are happy to keep you informed on the latest trends and developments in intellectual property law in Europe and worldwide.

In this March issue, we will deal in particular with the vast ramifications of the recent EU Trade Mark Law reform and the review of the EU legal framework for the enforcement of intellectual property rights. The reform does not only include the revision of the EU Trade Mark Directive and the EU Trade Mark Regulation, but also incorporates several adjustments with respect to proceedings at the European trade mark office. We will highlight the key changes of this reform and its consequences for the protection and enforcement of trademarks in European and national trademark law. In this context, this issue also outlines why current and future trademark owners must take a closer look at the specifications of the goods and services of their European Trademarks prior to 23 September 2016. Other important trademark related topics are: the current situation of the harmonisation of Trade Mark laws within the six GCC states (Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the UAE), the use of trademarks for similar and non-similar products in Italy and the protection of patronymic (personal names) in France.

The Newsletter will then leave the world of trade marks and turn to other significant developments in intellectual property law. In order to modernize EU copyright law, the European Commission recently adopted a proposal for a Regulation on cross-border portability of online content services as part of its Digital Single Market Strategy. We will also discuss the recent inclusion of Dutch contract law into the Dutch Copyright Act, as well as, the complicated enforcement of copyrights in Poland, where triple license fees for copyright infringements have been declared unconstitutional.

Finally, we will outline the recent introduction of employee invention remuneration in China and the new Draft Directive concerning the envisaged harmonization of Trade Secret law across the EU.

We hope you enjoy reading our Newsletter and are looking forward to receiving your feedback. Our prior issues of the Global IP Newsletter can be retrieved by clicking here.

London: Reform of EU Trade Mark Law

Major reforms will soon be coming to the Community Trade Mark Regulation (207/2009/EC) and the Trade Marks Directive (2008/95/EC). On 8 June 2015, the European Council published its final compromise texts for a new Regulation and Directive which will effect changes to the current system of EU trade mark law. The EU Parliament adopted the European Council's position on the legislation on 16 December 2015, followed by publication of Regulation (2015/2424) on 24 December 2015 and Directive (2015/2436) on 23 December 2015. Amendments made to the Regulation seek to make the EU's current trade mark system more effective, efficient and cohesive, providing a more efficient trade mark service at a lower cost to those using it. The purpose of the Directive reform is to introduce further harmonisation into national systems, thereby improving the cooperation between EU and national offices when dealing with trade marks.

The Regulation and Directive have been extensively reworked, with numerous new articles being introduced into both. The following sections identify some key changes.

Key Issues

- The new Trade Mark Regulation will take direct effect on 23 March 2016
- EU Member States will have three years to transpose the new Trade Mark Directive into their national laws
- The Community Trade Mark will be renamed to the European Trade Mark, while the Office for Harmonisation in the Internal Market will be known as the European Intellectual Property Office
- Other changes include those to fees, the classification of goods and services, opposition proceedings and graphic representation

A new name

The most noticeable change following the reform is that the Community Trade Mark ("**CTM**") will be known as the European Trade Mark ("**EUTM**"). Similarly, the Office for Harmonization in the Internal Market ("**OHIM**") will be known as the European Intellectual Property Office ("**EUIPO**"). This is to better reflect the actual work carried out by the office which also handles registered designs (but not patents).

Fees

Brandowners are likely to make material savings from reductions in EUTM renewal fees. The starting cost for any EUTM renewal after the new fees apply will be significantly reduced by approximately 37% from €1,350 to €850. The reduction in renewal fees and other changes are expected to result in overall savings of €40 million each year to brandowners.

At the same time, the fee structure for applications will also change. Previously, an applicant could apply for a trade mark in up to three classes under a flat rate of €900. An additional fee of €150 was then levied for each additional class applied after the third. This pricing (three for the price of one) was perceived as having encouraged unnecessarily broad filings leading to cluttering on the register. Under the new fee structure, applying for a single class will cost €850, while applying for two classes will be €900. Each additional class covered after the second will be at an additional cost of €150.

The approach taken for EUTM renewal fees discourages maintenance of rights for classes not of interest. The period in which a renewal request must be made is also changed. Previously, the renewal request needed to be submitted on the last day of the month in which protection ends. Under the new system, renewals must be made by the expiry date of the trade mark registration. This will apply to all EUTM registrations which have renewal dates occurring after 23 March 2016.

Classification of goods and services and grace period

New provisions are being introduced with respect to the use of class heading and general terms in the specification of an EUTM application. General indications included in the class headings of the Nice Classification or other general terms may be used, provided that they comply with the requisite standards of clarity and precision. As such, class headings will only include the goods and services covered by the literal meaning of the terms. These provisions correspond to the case law set out in 2012 as part of the *IP Translator* case (*Chartered Institute of Patent Attorneys v the Registrar of Trade Marks, C-307/10*) and current practice of the office. *IP Translator* rejected the "class heading covers all" approach, which is similarly deemed too vague under the new rules. Those registrants who have EUTMs registered in respect of Nice class headings dating prior to *IP Translator*, 22 June 2012, will be given a 6 month grace period in which they can amend their specifications of goods and services. Amendments are only expected to be necessary for a small number of marks, but proprietors are recommended to use this as an opportunity to audit the scope of their portfolios.

Other changes

The Regulation introduces several changes, including amendments to opposition proceedings relating to international registrations designating the EU. While the opposition period for international registration designations will still be 3 months, the start date for the period will occur one month after the date of publication instead of six months.

The revision to the Regulation introduces EU certification marks. A certification mark is a type of mark already available in certain Member States which allows a certifying institution or governing body to permit its members to use their mark as a sign for goods and services complying with certification requirements. However, where a national law does not provide for the registration of certification marks, a registrant will not be able to convert an EU certification mark into a national application.

Both the Regulation and the Directive have removed graphic representation as a requirement for a valid registration. The new requirement states that signs only need to be represented clearly by any available and appropriate technology. This will increase the possibilities of registering non-traditional marks, such as sounds and smells.

New protections against counterfeit goods are also provided under the Regulation and Directive reforms. Owners of trade marks will now be able to prevent counterfeit goods from transiting through the EU unless the alleged infringer is able to prove the trade mark owner could not prevent a sale of the goods in the final destination. Trade mark owners will be in a stronger position as the trade mark reforms place the burden of proof on the alleged infringer.

Under the Directive, Member States which do not already offer this will be required to introduce administrative proceedings for both the opposition and cancellation of trade marks.

The question as to how to the current OHIM surplus, estimated to be €400 million, should be applied has also been answered. Instead of these funds being allocated to national offices or national budgets, the funds will be spent on intellectual property with strict key performance indicators.

What next?

The Regulation will take direct effect 90 days following the legislation's publication in the Official Journal of the European Union, i.e. on 23 March 2016. On this date OHIM will be renamed EUIPO, with all existing CTMs and CTM applications automatically becoming EUTMs and EUTM applications. The EUIPO will also update its online application forms and fee calculators on 23 March 2016. Those who registered CTMs using Nice class headings prior to 22 June 2012 will have until 24 September 2016 to amend their specifications of goods and services.

The Directive entered into force 15 January 2016 and Member States will have three years to implement it into national laws, although they will have seven years to introduce administrative cancellation proceedings.

Spain: A Spanish perspective on the new European Trade Mark Directive

Currently, national trade mark protection provided by individual EU Member States coexists with the EU wide protection provided by EU trade marks. The coexistence and interplay of trade mark systems at a national and EU level constitute a cornerstone of the EU's approach to intellectual property protection.

The new Trade Marks Directive (Directive (EU) 2015/2436) (the "**Directive**") will help iron out some of the differences that exist between the practice of the Office for Harmonization in the Internal Market (which as of 23 March 2016 will be called the European Union Intellectual Property Office) ("**OHIM**") and the practice of the Spanish Patent and Trade Mark Office. The aim of the new Directive is to approximate substantive law and procedural rules to enhance trade mark protection in Member States, bringing them in line with the Community trade mark system.

Key Issues

- The aim of the new European Trade Mark Directive is to approximate substantive law and procedural rules to enhance trade mark protection in the Member States.
- Currently trade mark protection is only granted in Spain for signs that can be represented graphically. The new European Trade Marks Directive introduces a significant change by removing the requirement of graphic representation.
- An administrative procedure for the revocation or declaration of invalidity of a trade mark before the Spanish Patent and Trade Mark Office will have to be implemented.
- The new European Trade Marks Directive makes it clear that "transit" is an act of trade mark infringement.

(i) Signs which a trade mark may consist of

Currently, trade mark protection is only granted in Spain for signs that can be represented graphically. The current Spanish Trade Mark Act (Act 17/2001) allows the following graphic representations to be considered marks, either on their own or in combination: (i) words and combinations of words; (ii) images, figures, symbols and drawings (for example, logos, landscapes, geometric figures and figures of animals; (iii) letters, figures and combinations thereof; (iv) three-dimensional forms (packages, containers and the shape of the product); and (v) sounds. With regard to sound trade marks, to date the Spanish Patent and Trade Mark Office only accepts sounds that can be represented graphically, for example by a pentagram.

The new Directive introduces a significant change by removing the requirement of graphic representation:

"A trade mark may consist of any signs, in particular words, including personal names, or designs, letters, numerals, colours, the shape of goods or of the packaging of goods, or sounds, provided that such signs are capable of:

(a) distinguishing the goods or services of one undertaking from those of other undertakings; and

(b) being represented on the register in a manner which enables the competent authorities and the public to determine the clear and precise subject matter of the protection afforded to its proprietor."

The removal of the graphic representations establishes an open, permissive system and will, for example, make it possible to use a video file to represent a moving trade mark or an audio file to represent a sound trade mark. This standardises the practice of OHIM and the practice of the Spanish Patent and Trade Mark Office, which does not accept audio or sound files.

Member States must bring into force the laws, regulations and administrative provisions necessary to comply with this amendment by 14 January 2019. As such, the Spanish Trade Mark Act will have to be amended to remove the graphic representation requirement for the registration of trade marks in Spain.

(ii) Procedure for the revocation or declaration of invalidity of a trade mark

The new Directive requires Member States to provide an efficient and expeditious administrative procedure in their offices for revocation or invalidity proceedings. This procedure is currently possible before OHIM in relation to Community trade marks.

However, in Spain, and in relation to Spanish trade marks, once the decision granting the trade mark is final (either by the Spanish Patent and Trade Mark Office or after an appeal before the Administrative Courts), the procedure for the revocation or declaration of invalidity of a trade mark takes place before the Commercial Courts. These courts have jurisdiction to hear trade mark infringement disputes, as well as similar matters related to other industrial and intellectual property rights, patents, industrial models and copyright, but also areas as varied as competition, transport, consumer protection, maritime law and insolvency disputes.

The idea is to bring the way national offices work in line with the practices of OHIM. The administrative procedure for the revocation or declaration of the invalidity of a trade mark before the Spanish Patent and Trade Mark Office will have to be implemented at the start of 2023, which will represent a significant change as well as the transfer of part of the trade mark disputes currently heard by the Commercial Courts in Spain to the Spanish Patent and Trade Mark Office (although the civil proceedings will remain available in parallel).

(iii) Stopping counterfeits

In order to strengthen trade mark protection and combat counterfeiting more effectively, the new Directive provides proprietors of trade marks the right to prevent third parties from bringing counterfeit goods, in the course of trade, into a Member State where the trade mark is registered without being released for free circulation there. This is in instances where such goods come from third countries and bear an unauthorised trade mark which is identical or essentially identical to the trade mark registered in respect of such goods, or which cannot be distinguished in its essential aspects from that trade mark.

To this effect, trade mark proprietors will be allowed to prevent the entry of infringing goods and their placement in customs situations and locations, including, transit, transhipment, warehousing, free zones, temporary storage, inward processing or temporary admission. This is the case even when such goods are not intended to be placed in the market of the Member State concerned.

The rights of the trade mark proprietor in this sense shall lapse if, during the proceedings to determine whether the registered trade mark has been infringed, evidence is provided by the declaring party or the holder of the goods that the proprietor of the registered trade mark is not entitled to prohibit the placing of the goods on the market in the country of the final destination.

The previous Spanish trade mark act, Act 32/1988, of 10 November, specifically contemplated “transit” as an act of trade mark infringement, in particular, “importing products, exporting them or subjecting them to any other customs regime, such as transit or deposit, for example.” Unfortunately, the current Trade Mark Act (dating from 2001) removed the express mention of “transit” as an act of trade mark infringement, simply including the acts of “importing or exporting products with the mark.” This created doubt as to whether this elimination implied that the status of “transit” as an act of trade mark infringement in Spain was questioned. Fortunately, the new European Trade Marks Directive makes it clear that “transit” is an act of trade mark infringement and obliges Member States to establish it as such in their legislation prior to January 2019. This will bring legal certainty to market operators, to the customs authorities when it comes to seizing products in transit and to the Commercial Courts when hearing trade mark infringement disputes.

Congratulations to our Spanish Team!

The team received the “**IP Firm of the Year Award for 2015**” by the prestigious magazine Managing Intellectual Property (MIP)

Already in 2008, 2012 and in 2014 the team was distinguished with this award, which recognizes leadership and career of **Clifford Chance** in this sector.

Düsseldorf: New EU Trade Mark Law – New chance to fight the transit of counterfeit goods

In recent times European trade mark law has been subject to extensive reforms. The new Trade Mark Directive (EU) No. 2015/2436 came into force on 13 January 2016 and now has 3 years to be implemented into national law across EU Member States. Alternatively, the new Trade Mark Regulation (EU) No. 2015/2424 will have immediate effect in all Member States as of 23 March 2016.

Key Issues

- Under Article 10(4) of the new EU Trade Mark Directive, the mere transit of goods in the EU may constitute a trade mark infringement, strengthening the position of trade mark owners to stop product piracy at an early stage.
- In order to counter any infringement claims leading to the seizure of goods, importers may provide evidence that the goods do not infringe any trade mark rights in the respective EU Member States the trade mark at issue seeks protection.

The new legal framework brings a number of modifications ranging from terminological changes (the *community trade mark* being renamed *European Union trade mark* ("**EUTM**") and the *Office for Harmonisation of the Internal Market* becoming the *European Union Intellectual Property Office* ("**EUIPO**")) to minor procedural reforms (such as the lowering of fees for the renewal of trade marks, for opposition and cancellation proceedings and other administrative acts) through to material reforms that strengthen trade mark owners' position in the fight against counterfeit goods.

One of the most important changes applies to goods that infringe a EUTM but are only transiting through a Member State and having a final destination in a third country which does not offer protection to the trade mark.

Legal situation before the reform

The mere transit of counterfeit goods was previously exempted as it was not regarded as an infringing act. Although Regulation (EU) No. 608/2013 allowed for the seizure of such goods at European borders by national customs authorities, any subsequent claims for cease and desist or for damages required the trade mark owner to prove that the goods were actually intended to be sold on the European market. In the past, placing the burden of proof on the trade mark owner has often been the reason for the dismissal of such claims in national courts. Furthermore, the trade mark owner himself could be exposed to damages claims by the counterfeiter for unjust seizure for example in Germany under Sections 150 (8) and 149 German Trade mark Act. This inconsistency, addressed by the European Court of Justice in the Joined Cases C-446/09 and C-495/09 – *Philips and Nokia*, was due to the fact that for a border seizure under Regulation (EU) No. 608/2015 to be justified the mere suspicion of an infringing act such as the sale of the goods within the European Union was sufficient. However, the claim for damages by the trade mark holder required full proof that the infringing goods were actually destined to be sold in an EU member state. If the trade mark holder failed to provide sufficient evidence, the potential infringers could recoup damages resulting from illegitimate seizure. This substantial financial risk ultimately deterred many rights holders from starting court proceedings.

Legal situation after the reform

After the trade mark reform, the mere transit of counterfeit goods will be treated as equivalent to the other already prohibited forms of use and constitutes an infringement pursuant to Article 9 (4) of the new Regulation and Article 10 (4) of the new Directive.

Both Articles entitle the proprietor of a registered trade mark to prevent all third parties from bringing goods, in the course of trade, into Member States where the trade mark is registered, without being released for circulation. This is provided that such goods come from third countries and are not authorised by the proprietor of a trade mark which is identical to the trade mark registered or which cannot be distinguished from it in its essential aspects.

Remarkably, the Articles provide for a reversed burden of proof. Now the importer must submit evidence to show that there will be no infringement in the jurisdiction of the final destination of the goods. If the importer can prove the absence of an infringement, the claims for cease and desist as well as for damages will be dismissed while the initial seizure by the custom authorities remains lawful. As a result, no damages claims against the trade mark proprietor will be enforceable.

The new category of transit being an act of infringement and the shift of the burden of proof to the potential infringer certainly brings significant advantages to trade mark owners to protect their trade mark rights at an early stage prior to any actual marketing and distribution of the infringing goods in the European market. Infringing transit now requires a real risk of the goods to be distributed in a EU member state, establishing a novel kind of trade mark violation alongside the "conventional" acts of infringement listed in Article 10(3)(c) of the new Directive. The shift of the burden of proof to the potential infringer appears to be proportionate in order to provide the trade mark owner with a swift and easy remedy to stop the import of potential counterfeit goods and any subsequent acts of product piracy that might significantly and irreversibly harm the trade mark.

Conclusion

Due to the rapid growth of product piracy, endowing trade mark owners with much more efficient means for the fight against counterfeiters was necessary. Trade mark owners will welcome resolving the dilemma of possibly being exposed to damages claims for unjustified seizures which they were facing before the new legal framework came into force. Trade mark owners are now in a much stronger position to not only have infringing goods seized the moment they pass European borders, but also to win subsequent claims for damages. Counterfeiters, on the other hand, may still exculpate themselves by providing evidence that the goods at issue will not infringe any trade mark rights in the respective EU member states.

It remains to be seen how the courts will apply the new provisions in the future.

London: GCC Trade Mark Law, a big step forward towards harmonisation

The concept of harmonisation for the six Gulf Cooperation Council ("**GCC**") states of Bahrain, Kuwait, Oman, Qatar, Saudi Arabia and the United Arab Emirates of a unifying trade mark law which applies across the GCC states is becoming a reality.

2013 saw the publication of the Trade Mark Law of the GCC States and since then brand owners and IP practitioners have patiently been waiting to see how this law (the "**GCC Trade Mark Law**") will be implemented, when it will come into force and what this will mean.

Key Issues

- Kuwait has become the first GCC State to approve Implementing Regulations, ratifying the GCC Trade Mark Law
- The remaining GCC states are at varying stages of ratification, but none have yet to publish the Implementing Regulations
- The Implementing Regulations introduce several key changes to trade mark law across the GCC states. These include an increase in the official fee, faster examination times, a longer opposition period and a longer grace period for late renewals

Legislation in the GCC States

The Supreme Council of the GCC (the highest decision-making body of the GCC) issued a Resolution in December 2012 requiring member states to implement the GCC Trade Mark Law into their respective national laws *"within a period of sixth months as from the date on which the Commercial Co-operation Committee approves the Implementing Regulations of the Trade Mark Law"* (the "**Implementing Regulations**").The Commercial Co-operation Committee (a division of the GCC General Secretariat) is responsible for issuing the Implementing Regulations which were approved and issued in December 2015, and until now, not publically available.

Current status

On 28 December 2015, Kuwait became the first GCC state to approve the Implementing Regulations by publishing Ministerial Decision No.500 of 2015. This in turn ratified the GCC Trade Mark Law, which will come into effect in Kuwait as of June 2016.

In theory, the publication of the Implementing Regulations should mean that the GCC Trade Mark Law will come into force in all other GCC member states by July 2016, however in reality this is unlikely.

Below sets out how far along in the process other member states have come:

i. Bahrain and Qatar

Along with Kuwait these two countries are often referred to as "Good-to-go" member states.

The Implementing Regulations have yet to be published in these countries. Six months from publication of these, the GCC Trade mark Law will automatically come into force.

ii. Saudi Arabia

In May 2014 the Saudi Cabinet agreed to ratify the GCC Trade Mark Law and a royal decree has been drafted (but not published) to complete this ratification process.

Further legislation must be passed in order to enable the GCC Trade Mark Law to come into force and to repeal the current Saudi Trade Mark Law.

iii. Oman and the UAE

At present, neither Oman nor the UAE have published any legislation with regard to the 2013 version of the GCC Trade Mark Law. It therefore remains to be seen how or when the GCC Trade Mark Law will be implemented in each of these member states.

Summary of key changes

Previously, the Implementing Regulations draft documents were not made available to the public. Now that they are available, some of the key changes which they will introduce are summarised in the table below.

Change introduced	Description
An increase in the official fee	The publication of the Implementing Regulations brought into force a new official fee regime. All GCC member states have or currently are in the process of increasing their official fees for trade mark applications. This includes an increase in fees for renewals, oppositions and recording assignments and licences. By example Kuwait was known for being one of the least expensive countries in the Gulf in which to obtain trade mark registration. This is now about to change with substantial fee increases The trademark application fee is increasing from approximately USD25 to USD150. The publication and registration fees are going from approximately USD60 to USD875. Renewal fees will be over USD1000. Despite this, trade mark registration fees will still be less expensive than in the UAE (USD3300) and Saudi Arabia (USD1870).
A change in the supporting documents for trade mark applications	The documents that are now required to support a trade mark application in Kuwait under the Implementing Regulations are: (i) a notarised and legalised Power of Attorney; (ii) a copy of a Certificate of Incorporation or Commercial Licence for the applicant; and (iii) a legal translation of the trade mark, if it includes any words which are not in Arabic. Regarding the first of these requirements, many brand owners will be use to submitting a locally legalized Power of Attorney when filing a trade mark application in a GCC country. However, the Implementing Regulations do not specify that the Power of Attorney must be legalised for use in the specific country where the application is being filed. Potentially this may be interpreted as permitting applicants to rely on a Power of Attorney which has been legalised for use in any GCC country (rather than in the specific country where the application is being filed). This could potentially have significant cost saving implications for brand owners who are seeking to file applications in more than one country. It is also worth noting that the Implementing Regulations to the GCC Trade Mark Law require all supporting documents to be submitted at the time the application is filed.
Faster examination times	The Implementing Regulations impose a requirement for an initial examination report to be issued within 90 days of the filing date. This should result in applications being processed more quickly than has previously been the case.
A longer opposition period	The opposition deadline has been increased to 60 days (from the current 30 days in Kuwait). However, the deadline remains non-extendable.
A longer grace period for late renewals	This has been increased to six months (from the current three months in Kuwait).

Conclusion

The GCC Trade Mark Law will replace the local trade mark laws of each of the GCC member states and create a unified implementing set of regulations for trade mark prosecution and enforcement in all states. It will not, however, offer a unified filing system, as is the case in Europe, nor a single receiving office. Nonetheless a big step forward towards harmonisation has now taken place. Brand owners and IP practitioners should navigate through the trade mark landscape of each jurisdiction easily.

Given that the GCC Trade Mark Law has now been enacted in Kuwait, the Trade Mark Office and the Courts in Kuwait are empowered to interpret and apply the provisions of the GCC Trade Mark Law and in due course, when the GCC Trade Mark Law is enacted in the other GCC member states, they too will do the same. One potential and crucial concern this raises relates to whether the Law will be subject to different interpretations in each of the GCC states. This then raises the question of whether the concept of a harmonized GCC Trade Mark Law will actually work in practice.

It would appear that the GCC Trade Mark Law does provide a solution for this situation by providing the GCC Trade Cooperation Committee with the power to interpret the law. However, both the GCC Trade Mark Law and the Implementing Regulations are silent as to how this might work in practice.

In the absence of any process and framework for bringing matters of interpretation to the GCC Trade Cooperation Committee, it is difficult to see how a unified position under the GCC Trade Mark Law will be maintained across all six member states. Nonetheless in time we anticipate further amendments to be made to the GCC Trade Marks Law which will perhaps clarify the referral process and contribute to bringing greater legal certainty.

Milan: The Italian perspective on trade mark use for similar and non-similar products with specific regard to well-known trade marks

Key Issues

- Under Italian law, the notion of similarity between particular products and services is used to prevent deemed non-registration for particular classes. For a well known trade mark (the protection of which may also extend to dissimilar products or services under certain circumstances), this means there may not be deemed non registration for particular classes as part of the expanded protection afforded to well-known trade marks. This is on the basis that the claimant does not have *locus standi* for a declaration from the courts as to such deemed non-registration;
- Well-known trade marks appear to have the benefit of special treatment, whereby deemed non-registration would only apply where use ceased entirely;
- Leading academic authorities consider that harmonisation with Community trade mark law means that while well-known trade marks are afforded greater protection, that should not mean they are not susceptible to deemed non-registration for particular classes, but only to enjoy a greater protection in case of infringement if the conditions of the broader protections are satisfied.

Can revocation apply?

Under Italian law, a registered trade mark may be liable to revocation for reason of non-use if (i) it has not been the subject of "genuine use" by the proprietor, or by a person with the proprietor's authority, for the products or services for which it was registered, or (ii) if its use has been suspended for an uninterrupted period of five years. There is an exception where there are "proper reasons" for the non-use.

Where a trade mark has been registered for more than one product or service, and in practice it is not used for all of these, it may be deemed to be registered in respect only of the products or services for which it has been used.

By contrast to Community law, Italian courts tend to find that non-registration does not apply to products and services that are similar to those for which the trade mark has seen genuine use. This is even if the classes of goods are drawn very widely. Where the trade mark is well-known, the courts go much further. In such cases, use of the well-known trade mark means the registration is not susceptible to revocation not only for the products or services for which it has been registered, but also for dissimilar products and services.

As a result, a well-known trade mark only risks being revoked, for any of its registered classes, if its use has ceased completely in relation to all classes.

The Court of Rome first took up this position in a decision of 8 November 2005. The case concerned the trade mark "Boss", owned by the clothing company Hugo Boss and well-known in connection with perfumes. The court found that if the trade mark provided protection against infringement in the use of publishing products, non-use in those sectors could not result in its revocation. This is despite the fact that the trade mark had not been used for those products and services.

Similarly, the Court of Milan in a decision of March 2010 found that "*where the trade mark is well-known, there is no cause of action for a declaration that the trade mark is deemed revoked by non-use in some classes of products and services for which it was registered, because any such ruling would not remove the obstacle that hinders free use [by persons other than the proprietor] of the mark in classes of goods and services other than those in which the mark had been used*".

In a judgment of July 2013, the Court of Milan again ruled that it seemed "*reasonable to maintain that the system whereby trade marks may be deemed revoked for some of the registered classes of goods and services cannot apply to well-known marks. Indeed, where it is recognised that a mark must enjoy protection also in relation to products not covered by the registration, it would be gravely inconsistent to find that a penalty could be applied for non-use in an area that was asserted in the application*".

The Court of Venice in April 2013 reached a decision in a similar vein. The case regarded a brand of sunflower oil. The court found that "*the fact that the trade mark 'Cuore' is well-known enables extension of the protection of the trade mark also to unrelated products (provided they are within the food sector), such that non-use of the trade mark by the claimant on products other than sunflower oil cannot result in the registration being deemed revoked for non-use for the other classes for which it was registered. Indeed, if the protection afforded to a well-known trade mark extends also to products for which it was not registered, inevitably this means there cannot be a declaration of deemed revocation for products within the classes for which it was registered*".

Leading academic authorities have observed, however, that such a stance does not appear consistent with the treatment of trade marks under Community law, with which Italy's domestic law should now be harmonised.

They argue that treating well-known trade marks in this way means they not only benefit from expanded protection (that is subject, in any case, to a strict burden of proof), but also from a further advantage that is conferred by registration for particular classes.

The protection of well-known trade marks should, in their view, no longer be assessed on the basis of an unfair advantage for the infringer and prejudice to the proprietor. Registration in a variety of classes should, in their view, mean that protection may be invoked merely by showing the use related to the particular registered trade mark, for the particular registered classes, and no further conditions should apply.

Meet us:

- 14-15 March 2016
  C5's 8th Conference on "Pharma & Biotech Patent Litigation"
  sponsored by Clifford Chance, panel discussion on Second Medical Use Pharmaceuticals of **Claudia Milbradt** with moderator **Miquel Montana** and speech of Claudia Milbradt on "Enforcement of Patent Rights against Biosimilars" at the Pharma Patent Litigation Congress
  event location: **Amsterdam, Netherlands**
- 04 April 2016
  You are kindly invited to join our client seminar on "IP-Rights"!
  event location: **Düsseldorf, Germany**
  our topics for your information:
  - Creation, protection, use and ownership of IP rights – registration strategies and intragroup allocation
  - Tax risks and benefits of intragroup allocation/transfer of IP rights (IP box regime, BEPS etc.)
  - Safeguarding IP rights in the event of insolvency
- 21-25 May 2016
  INTA - International Trademark Association meeting
  event location: **Orlando, USA**
  meet **Ling Ho** and **Leigh Smith** at this conference

Düsseldorf: The revised class headings under the new EU Trade Mark Regulation

The current reform of EU trade mark law brings a variety of substantial changes both to the EU Trade Mark Directive and the EU Trade Mark Regulation (the "**Regulation**"). These improvements concern both substantive trade mark law as well as registration proceedings for European Trade Marks ("**EUTMs**", formerly known as Community Trade Marks) at the European Intellectual Property Office ("**EUIPO**", formerly known as the Office for Harmonisation of the Internal Market). In particular, the applicable class headings for goods and services pursuant to the Nice regime have come under review. In June 2012 the European Court of Justice ("**ECJ**") held in *IP Translator* that trade mark class headings must be constructed in a way that allows for the easy identification of the goods and services. The subsequent application of this decision led to prior trade mark specifications being interpreted as "too general" throughout the EU. The new regulation comes into force on 23 March 2016 and will require EUTM owners to take several steps.

Key Issues

- The new EU Trade Mark Regulation requires EUTM owners to revise any generic Nice Class headings by specifying the particular goods and services that go beyond the literal meaning of the class heading.
- The aforementioned applies to all registered EUTMs regardless of their date of filing.
- If EUTM owners do not provide the EUIPO with a declaration as to whether they wish to add or provide specifications for any goods and services in accordance with the new law by 23 September 2016, trade mark protection for certain goods and services might be irrevocably lost.

The previous practice of the EUIPO

Pursuant to the Nice regime, trade mark applications are filed for defined goods and services which are further categorised into various classes (the "**Nice Classes**"). The goods and services listed in each Nice Class bear general class headings for ease of reference. However, the class headings are not always suitable for all the categories of goods and services listed under each particular heading and there can also be significant overlap with other classes and headings. Moreover, the breadth of each class can vary substantially. For example, although the heading of Nice Class 13 reads "firearms; ammunition and projectiles; explosives; fireworks" the that class also contains the term "cartridge pouches" which is a simple accessory and would likely not fall within the literal meaning of "firearms". The same might apply to Nice Class 15 which bears the heading "musical instruments" but also contains bags for musical instruments.

The previous practice of the EUIPO and several national IP authorities granted protection for the entirety of goods or services within a class regardless of whether all of the goods and services were explicitly claimed in the application or whether the goods and services actually fell within the literal meaning of the class headings indicated by the applicant. Hence, it has become common practice to use headings to register EUTMs for the entirety of a class.

The implementation of the IP Translator case law into the new EU Trade Mark Regulation

In the *IP Translator* decision, the ECJ held that the use of a "class heading" was now to be interpreted by its "literal meaning" when providing protection. This replaced the previous practice of automatically covering all goods and services under generic terms. As a result, the ECJ decided that EUTM registrations filed **after** the IP TRANSLATOR-decision of 22 June 2012 were to be interpreted to cover only the goods and services clearly falling under the literal meaning of the class heading. The trade mark holders were free to amend and refine the list of goods and services in order to ensure the coverage of the specific goods and services originally intended to be covered. However, any trade marks filed before 22 June 2012 were left "untouched" as they fell under the "old" way of interpretation regarding class headings.

In order to achieve greater legal certainty, the *IP Translator* case law implemented by the new Regulation will be expanded to all trade marks regardless of their date of registration, requiring trade mark owners previously not concerned by the ECJ's ruling to check their trade mark portfolio for generic Nice Class headings.

Trade mark owners have been granted a deadline of 23 September 2016 to make a declaration whether they wish to add or specify any goods and services in the specifications of their trade marks with regard to the products the mark is seeking protection for. Otherwise, the loss of trade mark protection for one or several goods and services could occur.

Conclusion

By implementing the *IP Translator* case law into the new Regulation, trade mark owners will be subject to significant practical requirements not only for future trade mark applications, but also existing registered trade marks filed before 22 June 2012. As a result, trade mark owners should carefully assess their next steps in order to retain comprehensive trade mark protection. Trade mark owners should therefore consider taking the following actions:

1. carry out an internal review of any EUTMs applied for before 22 June 2012 to identify any rights that specify goods and services using class headings only;

2. identify whether the use of the class heading was actually intended to also achieve protection for goods and services that are not covered by the literal meaning of the class headings; and

3. if necessary, issue a declaration to the EUIPO in order to extend the goods and services covered by the EUTM **by 23 September 2016**. It should be noted that the protection granted by such additional designations will not be regarded as retrospective. Therefore, it is recommendable to file the additions as soon as possible.

Paris: How To Trade One's Name

The common trait of many brands including François Théron, Yves Saint Laurent, and Inès de la Fressange is that they are also the namesake of the company's founder.

Traditionally, French law prohibited the commercialization of "patronymic names"[1] on the grounds that they constituted a component of personality rights which cannot be assigned. However, the situation changed with the promulgation of the French Trademark Act, dated 31 December 1964, which authorised the registration of a patronymic name as a trade mark. In addition, the *Bordas* decision, dated 12 March 1985, validated the assignment of trade marks comprised of a patronymic name.

Since then, the issues presented before courts mainly relate to (i) the right to protect one's patronymic name, primarily against unauthorised use by third parties and (ii) the conditions of assignment of such a name for commercial purposes as well as the possibility of using this name for commercial purposes after already assigning it to a third party.

The outstanding number of court decisions, which sometimes contradict each other, highlights the complexity of the situation.

Key Issues

- Under French law, a person is entitled to use his patronymic name for commercial purposes. On this ground, such person may decide to apply for the registration of his patronymic name as a trademark.
- A person is entitled to oppose unauthorised use by third parties of his patronymic name for commercial activities under certain conditions.
- In specific cases, a person is entitled to assign the commercial use of his patronymic name to third parties. For instance, a person might well use, as a company name, his own patronymic name. If and when this person leaves the company, the new owner will in all likelihood request the assignment of the company name and authorisation to use the previous owner's patronymic name for commercial purposes. Difficulties arise after such assignment, when the owner of the patronymic name wishes to continue using this name for commercial purposes after such assignment. French courts rule on a case by case basis to determine a possible co-existence in the business between the owner of the patronymic name and the assignee.

1. The use of one's name for commercial activities

As a general principle, an individual may use his name in conjunction with commercial activities. As such, an entrepreneur may use his patronymic name as a company name or protect it as a trade mark. French law has authorised the use of a patronymic name as a trade mark since 1964.

Simultaneously, as a patronymic name is often perceived by the public as a sign of the authenticity of those goods or services designated under such name, third parties can be inclined to misappropriate, whether in bad faith or not, another's name as a classification for their own goods or services. A person whose name is being used in an unauthorised fashion would have specific grounds in law to oppose such use.

Such a person may rely on (i) Article 9 of the French Civil Code which provides protection of one's personality rights, or (ii) Article 1382 of the French Civil Code which prohibits unfair competition and "parasitism". Furthermore, Article L.711-4 of the French Intellectual Property Code ("**IPC**") states that "*signs may not be adopted as marks where they infringe earlier rights, notably the personality rights of another person, particularly his patronymic name, pseudonym or likeness*". However, judges have interpreted this article quite strictly. The

1 "Patronymic names" are those which are passed down by families. Often these are just surnames, However, depending on the naming conventions in a jurisdiction, this can include first names or other variations on the name. As such, patronymic names should be read more widely than simply surnames.

person claiming that he has been caused prejudice by a third party's registration of his patronymic name as a trademark must demonstrate that the public would assume that the goods or services under the trademark have a specific link with him. Hence, if the name is quite common, the likelihood of confusion would be small (*Civ.1, 19 December 1967, Savignac*) but if the claimant is well known, the likelihood may be found to be important (*TGI Paris, 4 October 1996, Coubertin*).

Difficulties arise when several persons with the same patronymic name want to designate their commercial activities especially when these activities are identical or similar. In this case, Article L.713-6 of the IPC states that "*registration of a mark shall not prevent use of the same sign or a similar sign as a company name, trade name or signboard, where such use is made by another person using his own patronymic name in good faith*". French courts will also rule on a case by case basis on the likelihood of confusion between the signs before them and will often request that the second person, who used his patronymic name for identical or similar products or services to those offered by the first person, differentiate it by adding complementary information to the designation, such as his/her first name, activities or place of business (*CA Paris, 14 September 2011, Poilane*).

2. Third party use of another's patronymic name for commercial activities

As a general principle, French case law assimilates names with the attributes of personality rights. As such, they cannot be assigned. However, judges have ruled that when a person uses his patronymic name in the course of his commercial activities, it implies that he automatically confers a commercial nature to this name, which can be the subject of transfer.

On rare occasions, judges have ruled that such a transfer may occur implicitly. For instance, when one uses his patronymic name to name one's company, he automatically transfers the right to use the name for commercial purposes to the Company. If the company is sold, the next owner may continue to use the name in the course of the activities of the company (*Cass. Com., 12 March 1985*). In this context, the scope of the assignment is strictly interpreted. As a result, the consent given to use does not allow the company to register the patronymic name as a trademark without the owner's prior consent (*Cass. Com. 6 May 2003*).

In most occasions, however, a transfer in writing or specific consent for the use of the name will be requested from subsequent users of the name. Judges will strictly apply and interpret the dispositions between the parties. Consent to use another's patronymic name is not consent to file a trademark consisting of identical or similar signs to the name. French courts will therefore have a tendency to render a disposition void if it is too general (*CA Paris, 12 February 2015*).

In any event, transferring the rights to a patronymic name does not preclude a person from using his own name to identify his business, even if its activities are identical to the transferee's activities (*Cass. Com, 13 June 1995*). However, the transferor will have to make sure that the public does not confuse his new activities with his prior ones. For instance, Mr. Takada Kenzo created a company which bore his patronymic name "Kenzo" and he consented to the company filing trademarks comprising of his name. When he left the company, Mr. Kenzo could still exercise his chosen activities under this name. However, it had to be in a way that would not mislead the public by suggesting his activities had a link with the company. Therefore Mr. Kenzo now carries his activities under his full name "Takada Kenzo", which he has protected as a trademark.

Such use is in line with European (*CJEC, 30 March 2006, C-259/04*) and French caselaw (*CA Paris, 9 April 2014, François Théron*). As clearly stated by the ECJ, "*it would be for the national court to determine whether or not, in the presentation of the trade mark comprised of a patronymic name there is an intention on the part of the undertaking which lodged the application to register that mark to make the consumer believe that the person identified by such patronymic name is still the designer of the goods bearing the mark or that she is involved in their design. In that case there would be conduct which might be held to be fraudulent but which could not be analysed as deception and which, for that reason, would not affect the trade mark itself and, consequently, its prospects of being registered.*" The reverse is also true. Individuals wishing to use their patronymic names, and those third parties who are using the names of others, must be aware of the intricacies of such use and the potential issues that may arise.

Prague: The review of the EU legal framework for the enforcement of intellectual property rights

This article provides a brief overview of the ongoing review of the effectiveness of the current European legal framework for the enforcement of intellectual property rights ("**IPRs**") being carried out by the European Commission (the "**Commission**"). The review is aimed at evaluating the functioning of Directive 2004/48/EC of the European Parliament and the Council on the enforcement of intellectual property rights ("**IPRED**") with an emphasis on the context of the online environment and is being undertaken in order to identify whether there is any need to amend the directive. The material that formed the basis for the evaluation was collected over a four month period through a public consultation that was launched on 9 December 2015 with a deadline for submissions of 15 April 2016. The Commission has been seeking feedback from those parties who are involved with the application of the Directive, in particular rights holders, public authorities, members of the judiciary and the legal profession, as well as consumers and broader civil society.

Key Issues

- The effectiveness of the current European legal framework for the enforcement of IPRs is being reviewed.
- The review follows recent initiatives aimed at addressing the infringement of IPRs as part of the fostering of the cross-border digital economy and a single digital market.
- The Commission has been seeking feedback, through public consultation, from those parties involved in the application of the Directive, in particular rights holders, public authorities, members of the judiciary and the legal profession, as well as consumers and broader civil society.
- The Commission is expected to analyse the output from the public consultation and to address the issues that emerge by proposing appropriate legislative measures.

Content of the Public Consultation

Those taking part in the public consultation were asked to submit their experiences with IPR infringements in the course of offering services or trading goods as well as their views on the development of IPR infringements over the past ten years. As part of their responses, the respondents were also expected to evaluate the key provisions of IPRED, to discuss their experiences with the filing of legal action against IPR infringers, and to provide their opinion on whether measures and remedies available are applied in a homogenous manner across the Member States. Special emphasis was placed on feedback from concrete experiences with the measures, procedures and remedies providing for the protection of IPRs under IPRED. This includes feedback on the means available for presenting, obtaining and preserving evidence or the application of rules for provisional and precautionary measures and injunctions.

Contribution of IPRs to EU economy

It is clear that the effectiveness of the protections afforded by IPRs is crucial. In 2013, the European Patent Office carried out an EU-wide study of the contribution of IPRs to the EU economy. Their main findings were that almost half of EU industries are IPR intensive, using a large number of IPRs per employee, and that these industries directly account for 26% of all jobs in the EU. This accounts for approximately 56 million jobs directly, with an additional 20 million indirect jobs. The conclusions were that businesses that own IPRs generate more revenue per employee than those businesses that do not, indicating a positive relationship between the ownership of IPRs and the performance of a firm.

However, the conclusion of a study undertaken by the Office for Harmonization in the Internal Market (OHIM) that focused on the economic costs of IPR infringement in specific sectors was that IPR owners are significantly affected by counterfeiting and piracy, especially in the online environment. The cosmetics and personal care sector, for example, has an annual revenue loss of approximately €4.7 billion due to the presence of counterfeit cosmetics and other personal care products in the EU marketplace. The loss corresponds to 7.8% of the sector's total sales. In theory this translates into employment losses of approximately 50,000 jobs. In the handbag and luggage sector these losses are even more significant and amount to 12.7% of all sales (i.e. revenue of approximately €1.6 billion) with an additional €1.6 billion of lost sales in related sectors together with the loss of 12,100 direct jobs and €516 million of government revenue lost in social contributions and taxes.

Recent activities of the Commission

The protection and enforcement of IPRs is one of the Commission's fundamental concerns. Prior to the present review, there were several recent initiatives that were aimed at addressing the infringement of IPRs. In July 2014, the Commission issued the EU Action plan which shifted the focus from those individuals infringing IPRs, albeit often unknowingly, to infringements of IPRs on a commercial scale (the Commission adopted a "follow the money" approach). In addition, the Commission enhanced the existing assistance provided to SMEs by strengthening enforcement of IPRs, improving cooperation between national authorities and providing a comprehensive analysis of trends in IP and IP-infringing activities.

In May 2015, the Commission turned its focus to the online environment and issued the Communication on a Single Digital Market for Europe. As part of the commitment to fostering the cross-border digital economy and a single digital market, the Commission undertook to ensure a safe environment for both business operators and consumers and to propose concrete solutions that would maximise the effectiveness of IPRs enforcement in this regard. The Commission also emphasised that the maintenance of an effective and balanced enforcement system to combat commercial scale IPR infringements is crucial for the continued and increasing investment in innovation and job creation.

In October 2015, the Commission issued the Single Market Strategy, in which it expressly stated that it would review the existing IPR enforcement framework in order to achieve greater effectiveness, implement the "follow the money approach" aimed at the deprivation of revenue flow for commercial-scale infringers and enhance the assistance provided to SMEs by the enforcement of their IPRs.

In addition to these commitments, the Commission's other noteworthy activities aimed at the improvement of IPR enforcement include both the establishment of an expert group that will establish and maintain cooperation between the Commission and the relevant authorities in individual EU countries and the launch of a European Observatory on Infringements of IPRs, whose tasks include encouraging greater collaboration between public and private stakeholders in the fight against IPR infringement.

Main drawbacks of the current legislation

Recent developments have given rise to the ongoing review of IPRED, with the public consultation being the first step in the review process. It is expected that this review will confirm the findings of the surveys previously carried out, namely that the factors that most discourage the acquisition and enforcement of IPRs are (i) the high cost and complexity of enforcement procedure, (ii) the deficiencies in the regulation of low value claims, and (iii) the failure to effectively tackle organised crime in the IPR sector. Furthermore, the main drawbacks of the current legal landscape of IPR enforcement are considered to be the disparities among member states in their civil proceedings which differ vastly from state to state, the lack of availability of fast track proceedings that would provide cost-effective action against IPR infringers, the difficulties experienced in proving the amounts of damages caused by IPR infringement, and the lack of protection of the stakeholders' fundamental rights, such as the right to be heard, the right of due process or the basic assumption of innocence.

Conclusion

It is expected that the public consultation will not only confirm these findings but indeed identify further material problems unique to the online environment. However, it is clear that the most important part of the process is for the Commission to analyse the output from the public consultation and to address the issues that emerge by proposing appropriate legislative measures.

Brussels: European Commission presents legislative proposal on cross-border portability of online content services and sets out its plans to reform EU copyright rules

Reflecting its strong political will to further the single market for digital content, on 9 December 2015, the European Commission adopted a proposal for a Regulation on cross-border portability of online content services, and published a policy paper setting out its plans to reform EU copyright rules as part of the actions announced in its Digital Single Market Strategy. The EU copyright reform has been one of the key priorities of the European Commission since it took office in the beginning of 2015. The legislative proposals on the EU copyright reform are expected to be adopted by the end of the second quarter of 2016.

Key Issues

- European Commission proposes cross-border portability of online content services
- It outlines plans for a broader EU copyright reform
- EU copyright reform proposals are expected in the end of June 2016

On 9 December 2015, the European Commission (the "**Commission**") took its first step towards implementing its Digital Single Market Strategy and acknowledging the importance of digital technologies and the Internet in "*transform*[ing] *the way creative content is produced, distributed and used*." The Commission presented two important documents: (i) a legislative proposal on cross-border portability of online content services (the "**proposed Regulation**"), and (ii) a policy paper outlining its plans to reform the EU copyright framework.

The Commission's legislative proposal on cross-border portability of online content services

The purpose of the proposed Regulation is to gradually eliminate obstacles to cross-border access to online content. This will enable users who have subscribed to or acquired content in their home country to access that content in another Member State.

In particular, the proposed Regulation stipulates the following:

- The providers of online content services are obliged to enable their subscribers – while temporarily present in another EU Member State from the one where they habitually reside – to access and use the services they are subscribed to;
- The obligation imposed on the providers of online content services cannot be overwritten by any contractual terms. However, service providers should provide effective verification to rightholders explaining that service providers are providing access to subscribers in accordance with the proposed Regulation. The means by which such verification is achieved must be reasonable and limited to what is necessary;
- The processing of personal data carried out within the framework of the proposed Regulation, including the effective verification provided to the rightholders, should be carried out in compliance with the EU data protection framework; and
- The Regulation will have retroactive effect on rights and contracts that predate it.

The most controversial issue that arises in the context of the proposed Regulation concerns the means to assess whether a person is temporarily in another Member State although the Commission seems to suggest that the notions of residence and temporary stay are mutually exclusive.

The proposed Regulation aims to provide European consumers with access to online content they have rights to when they travel to other countries temporarily. This Regulation does not address, for example, an Italian resident who would like to get access to a Belgian online content service. Moreover, it concerns both copyrighted and audiovisual content. However, it does not target public broadcasters who offer a public website.

The legislative proposal takes the form of a Regulation, which is a binding legislative act that must be applied in its entirety across the European Union ("**EU**"), and which does not require transposition into national law before it is applied in one of the EU Member States.

It is expected that the process to adopt the proposed Regulation will be relatively short as there is the political momentum both within the European Parliament and the Council of the European Union to take things forward. Sources suggest that the Regulation may even be adopted in 2016, which would mean that it would enter into force six months after adoption. While ambitious, it may not be unrealistic for the proposal to enter into force by mid 2017, which means that businesses should be ready to adapt their operations by end of 2016.

The Commission's plans to reform EU copyright rules

In addition to the proposed Regulation on cross-border portability of online content services, the Commission adopted a Communication presenting its plans to reform the EU copyright framework (the "**Communication**"). In the Communication, the Commission announced a series of legislative proposals it plans to adopt by the end of the second quarter of 2016. These legislative proposals will cover the following four pillars:

i. Wider access to content across the EU

Apart from the already proposed Regulation on cross-border portability of online content services, the Commission is planning to adopt legislative proposals that will address:

- Enhanced cross-border distribution of television and radio programmes online; and
- The execution of licences that would allow for cross-border access to content, including "*catering for cross-border requests from other Member* States" taking inspiration from the rights clearance mechanisms (although the debate about the right approach is still open).

In this context, the Commission will also be looking into leveraging various policy instruments that it has at its disposal.

ii. The exceptions and limitations to copyright

The Commission does not envisage an overhaul of the existing exceptions and limitations to copyright, but it will be looking at legislative proposals that would address specific issues such as:

- Allowing public interest research organisations to carry out text and data mining of content they have lawful access to;
- Clarifying the exception concerning "*illustration for teaching*";
- Implementing the Marrakesh Treaty, which aims to help people with disabilities access copyrighted works;
- Supporting remote consultations of works held in research and academic libraries; and
- Clarifying the 'panorama exception' in relation to the publishing of images of public spaces.

The Commission also announced its plans to consider "*how levies can be more efficiently distributed to right holders.*" The Commission will *inter alia* examine the link between compensation and harm to rightholders, the relation between contractual agreements and the sharing of levies, double payments, transparency towards consumers, exemptions and the principles governing refund schemes, and non-discrimination between nationals and non-nationals in the distribution of any levies collected.

Recently, it was announced that EU officials are conducting an in-depth study of how to improve the fair compensation of rightholders by taxing sales of consumer electronics.

iii. Furthering a "*well-functioning marketplace*" for copyright

On this front, the Commission will be looking at addressing copyright as part of a broader platform discussion. The Commission will take into consideration issues such as the definition of the rights of 'communication to the public' and of 'making available,' and decide on whether any actions are needed to facilitate "*new forms of online distribution of copyright-protected works among the various market players.*" Moreover, the Commission will consider whether any action specific to news aggregators is needed and also assess the role of alternative dispute resolution mechanisms.

iv. The provision of an effective enforcement system

The final pillar concerns the enforcement of intellectual property rights. The Commission will consider setting up and adopting a self-regulatory "follow-the-money" approach involving different types of intermediary service providers. The Commission intends to reach agreements with various parties by spring 2016.

Moreover, the Commission will consider the potential revision of the legal framework for the enforcement of intellectual property rights (initially scheduled for autumn 2016). The input on the public consultation launched in December (and which will close on 15 April 2016) will feed into the legislative proposal that the Commission is planning to adopt, but the timing of which is yet unclear. Issues that the revision will concern include the rules for identifying infringers, the cross-border application of provisional and precautionary measures and injunctions, and the calculation and allocation of damages and legal costs. Finally, the Commission looked at the issues of "notice and action" mechanisms and the "take down and stay down" principle in relation to its public consultation on online platforms, and plans to take this feedback in consideration in its comprehensive assessment.

Conclusion

While there is strong political will at any level and within all EU institutions to move forward with the modernisation of the EU copyright framework, the process leading to the adoption of the various proposals will be lengthy and take several years, and a number of controversial issues such as territoriality, limitations and exceptions, and third-party liability may raise concerns and cause an intense debate before the EU institutions in the various stages of the legislative procedure.

Amsterdam: Introduction of the new Dutch Copyright Contract Law act (Wet auteurscontractenrecht)

As of 1 July 2015, a new chapter has been added to the Dutch Copyright Act (*Auteurswet*), providing a specific set of mandatory provisions concerning contracts between authors and their counterparties with respect to the exploitation of copyright protected works. Although specific contractual rules on copyright protect works already exist in some other countries, such as Germany, Belgium and France, under Dutch law, contracts relating to copyright protected works were, prior to the amendment, only subject to the provisions of general contract law. The main purpose of the changes is to provide a stronger position to authors to protect them from the usual imbalance between the party exploiting the copyrighted work (often a professionally organised business with financial and legal support) and the authors (often individual creators not having the same level of support).

The new set of rules also ensures that an author's counterparty will actually exploit the rights the author has transferred or licensed to it and consequently, that the authors' rights will be exploited effectively with the work being made accessible to the public.

Key Issues

- As of 1 July 2015, the Dutch Copyright Act (*Auteurswet*) has been amended, implementing the Dutch Copyright Contract Law Act (*Wet auteurscontractenrecht*);
- The amendments contain additional provisions to the Dutch Copyright Act with respect to contracting between authors and those parties who exploit authors' works
- These aim to strengthen the contractual position of authors and ensure that the compensation threshold for authors is safeguarded;
- The rules consist of mandatory law (i.e. parties cannot contract out of these terms) and are applicable to any contract entered into after 1 July 2015.

Key changes to the Copyright Act

The most important changes in the new set of rules in the Dutch Copyright Act are the following:

(A) Exclusive licences require signed deed

Previously, licences for copyright protected works were not subject to any prescribed form. The amendment introduces the requirement of a signed deed when an exclusive licence is granted. The amendment is specific to exclusive licences and therefore no such requirement will apply to non-exclusive licences.

(B) Exploitation Contracts

New rights for compensation have been bestowed on authors, including the following:

- the right to obtain fair compensation for the exploitation of his work. It is not yet clear what is meant by "fair compensation", so this definition will have to be further developed in practice.
- the right for additional compensation in the event the party exploiting the work starts to exploit the works in a way which was unknown at the time of executing the contract; and
- the right to receive fair, additional compensation, in the event the income of the party exploiting the work has disproportionately increased in comparison to the compensation initially agreed (the so called 'bestseller clause'). Such additional compensation shall also be due when a disproportionate income has been obtained by a third party to which the rights have been transferred.

(C) Non-use

If a party exploiting the work does not effectively exploit the works subject to an exploitation agreement, the author is entitled to fully or partially dissolve the agreement, unless the counterparty in the exploitation agreement has a significant interest in keeping the exploitation agreement in place. This right can also be invoked against third parties to whom the copyright was transferred by the counterparty of the author.

(D) Unreasonable provisions

The author has the right to (partially) nullify a specific provision in an exploitation agreement when such clause is unreasonably onerous for the author. A provision that contains an unreasonably long or vague term within which the counterparty has the right to exploit any future works of the author is also capable of nullification. Furthermore, if the counterparty is entitled to terminate the contract, the author is automatically entitled to have the same termination rights.

(E) Open access

The author of a short scientific work for which the research has been partially or fully financed with Dutch public means, has the right to make its work freely available to the public (after a reasonable period of time after the first publication of such work).

Retroactivity

Certain rules also apply retroactively to existing agreements, including: (i) the right of the author to partially dissolve the agreement when the counterparty does not sufficiently exploit the work, and (ii) the right of the author to nullify provisions of the agreement that contain an unreasonably long or vague term within which the counterparty has the right to exploit any future works of the author.

Mandatory law

According to the new set of rules, it is not possible for the author to waive these rights. However, the new rules are not applicable for employer's copyright, copyright of legal entities or in the event that the party exploiting the works is the main objective of such party (for instance publishers, producers etc.)

Film producers

The Copyright Contract Law Act includes specific rules on contracting with film producers. A producer who has added a substantial creative contribution to a production is entitled to the right of "fair compensation" for each exploitation of the film, as well as in cases where the parties have agreed separately. This means that paying producers a one off fee will no longer be sufficient. This obligation also applies to third parties to whom the rights have been transferred to.

Conclusion

As of 1 July 2015, authors will be in a better position to contract with counterparties for agreements entered into exploiting their works. The new set of rules form an exception to the general principle of freedom of contracting. Both authors and other parties active in the exploitation of copyright protected works should take this into account when contracting. The key principle from the new set of rules that the author receives a fair compensation will apply regardless of whether the copyright has been transferred or exclusively licensed and regardless of what the parties contractually agreed.

Warsaw: Polish Triple Licence Fee declared unconstitutional

Until recently, Article 79.1(3b) (the "**Provision**") of the Polish Copyright Act (the "**Copyright Act**"), provided an injured party with an alternative to the general principles of damages under the Polish Civil Code. An author whose rights had been infringed could demand, from the copyright infringer, double the value of the appropriate licence fee if the infringement was unintentional (the "**Double Licence Fee**"), and triple the value of licence fee if the infringement was deliberate (the "**Triple Licence Fee**"). In these instances, the value of a licence fee was usually determined by the market standard where applicable.

The tiered remuneration system was justified by the nature of copyright, in particular its vulnerability to violations and the difficulty in providing evidence of actual losses or lost profits. The Provision gave rise to a long-standing discussion on whether such protection of copyright is in line with Article 32 (equal treatment before the law) and Article 64 (equality of protection for property ownership) of the Polish Constitution.

Key Issues

- Copyright protection must be in line with a constitutional provision ensuring equality of protection for property ownership
- Copyright infringement fines and the compensation due to rightholders should be proportionate to the size of the incurred loss
- The recent ruling in Poland highlights a broader question on the character of copyright enforcement across the EU

UPC Case

The Polish Filmmakers Association sued a digital cable television provider, UPC Poland (the "**UPC**"), for rebroadcasting television programs without paying royalties. The Court of Appeal ordered the defendant to pay damages calculated according to the Triple Licence Fee. The UPC challenged the constitutionality of the Triple Licence Fee and filed a constitutional complaint. Consequently, the Polish Constitutional Tribunal (the "**Tribunal**") decided that the contested part of the Provision is in violation of the Polish Constitution.

Analysis

The Tribunal concluded that the Triple Licence Fee is disproportionate and provides a far greater level of protection to copyrighted works than for other forms of property. In the Tribunal's view, the Triple Licence Fee is unjustified as a form of statutory damages and puts rightholders in too privileged a position. This type of remuneration was claimed to be too severe a sanction against an infringer and unacceptably interfered with his economic rights. The Tribunal reasoned that the Copyright Act already provides strong protection for a wide range of claims against copyright infringements. Thus, the obligation to pay compensation for the infringement should be proportionate to the size of the incurred loss.

Implications

This decision means that the Triple Licence Fee is no longer in force and casts a new light on copyright enforcement in Poland. It is hard to predict how this will affect the efficiency of civil proceedings in copyright infringement cases, but it cannot be ruled out that the Provision may be entirely replaced.

As the Tribunal was bound by the scope of the complaint, it did not cover the constitutionality of the Double Licence Fee (for unintentional infringements). This part of the Provision may be seen as even more questionable than the Triple Licence Fee because of its punitive nature which conflicts with the compensatory nature of civil law.

Conclusion

The Tribunal's decision is of considerable importance to copyright disputes in Poland. Although the question of Double Licence Fee and calculation of damages remains unanswered, there is a possibility that the Court of Justice of the European Union (the "**CJEU**") will resolve this matter. Recently, the Polish Supreme Court referred a question to the CJEU on the compliance of Article 79 of the Copyright Act with the Enforcement Directive (2004/48/EC). This will allow the CJEU to more intimately examine the enforcement of intellectual property rights within the EU.

Hong Kong: The Recent Introduction of Employment Invention Remuneration in China

Mandatory remuneration requirements under the TCL

The People's Republic of China ("**PRC**") government has recently amended the Technological Achievements Commercialization Law (the "**TCL**"), effective on 1 October 2015. The amendment significantly increases the minimum remuneration paid to employees who have made important contributions relating to scientific and technological achievements either (i) under the employer's assignment, or (ii) by primarily using the employer's facilities and resources (the "**employment achievements**"). The remuneration is as follows:

i. no less than 50% of the net income from the assignment or licensing of scientific and technological achievements;

ii. no less than 50% of the shareholding or capital contribution resulting from the investment of scientific and technological achievements; or

iii. no less than 5% of the annual operating profits from the implementation of scientific and technological achievements for a consecutive 3 to 5 years.

Exemption to private companies

The TCL provides an exemption for private companies. These companies do not have to follow the minimum remuneration requirements above if: –

i. the private companies have set out their remuneration arrangements (including the amount, form and time of remuneration/rewards) in an agreement with the relevant employees or in their company policies or other public documents; and

ii. such remuneration arrangements have been made and implemented pursuant to and in accordance with the agreement and consultation of the relevant group of employees.

Key Issues

- To comply with remuneration requirements set out in the TCL, private companies are recommended to:
  - set out their remuneration in an agreement with the relevant employees or in their company policies or other public documents; and
  - consult such arrangements with the relevant group of employees before implementing.

Recommendations on compliance with the TCL remuneration requirements

Companies who have R&D activities in China may need to review their remuneration schemes to ensure that they are in compliance with this newly amended TCL. In particular, private companies are advised to:

i. set out general arrangements and standards regarding the remuneration payments in either (i) a company policy on invention remuneration which all employees, or at least employee-inventors, can access and are eligible for, or (ii) an agreement with each employee who is likely to contribute to any inventions made in the course of employment;

ii. solicit opinions from employee-inventors' or research and development personnel regarding the remuneration policy and incorporate these opinions into the policy;

iii. duly document and record the consultation process with the employees;

iv. obtain an acknowledgement from each employee in respect of their agreement to the company remuneration policy;

v. put in place a confirmatory assignment (that also confirms the payments made and received) from the relevant employees in respect of any employment achievements realized and brought into existence; and

vi. have a transparent review process in place that monitors and documents employment achievements made by employee-inventors, and payments made by companies.

Practical issues associated with the TCL remuneration requirements

i. Cooperation with PRC state-owned companies

Unlike private companies, state-owned entities in China are not exempt from the minimum remuneration requirements set out in the TCL. As such, a private company may still need to bear in the mind minimum remuneration requirements when dealing with a state-owned entity. The minimum remuneration requirements could still affect the deal price in respect to any targeted state-owned intellectual property.

Moreover, since state owned intellectual property would be regarded as state-owned assets, a private company should act prudently in its dealings. For example, when determining the consideration for assignment or licensing of any state-owned intellectual property, the deal parties are advised to engage an independent third party to evaluate the fair market value of the targeted state-owned intellectual property so as to avoid the risks of loss or erosion of any stated owned assets.

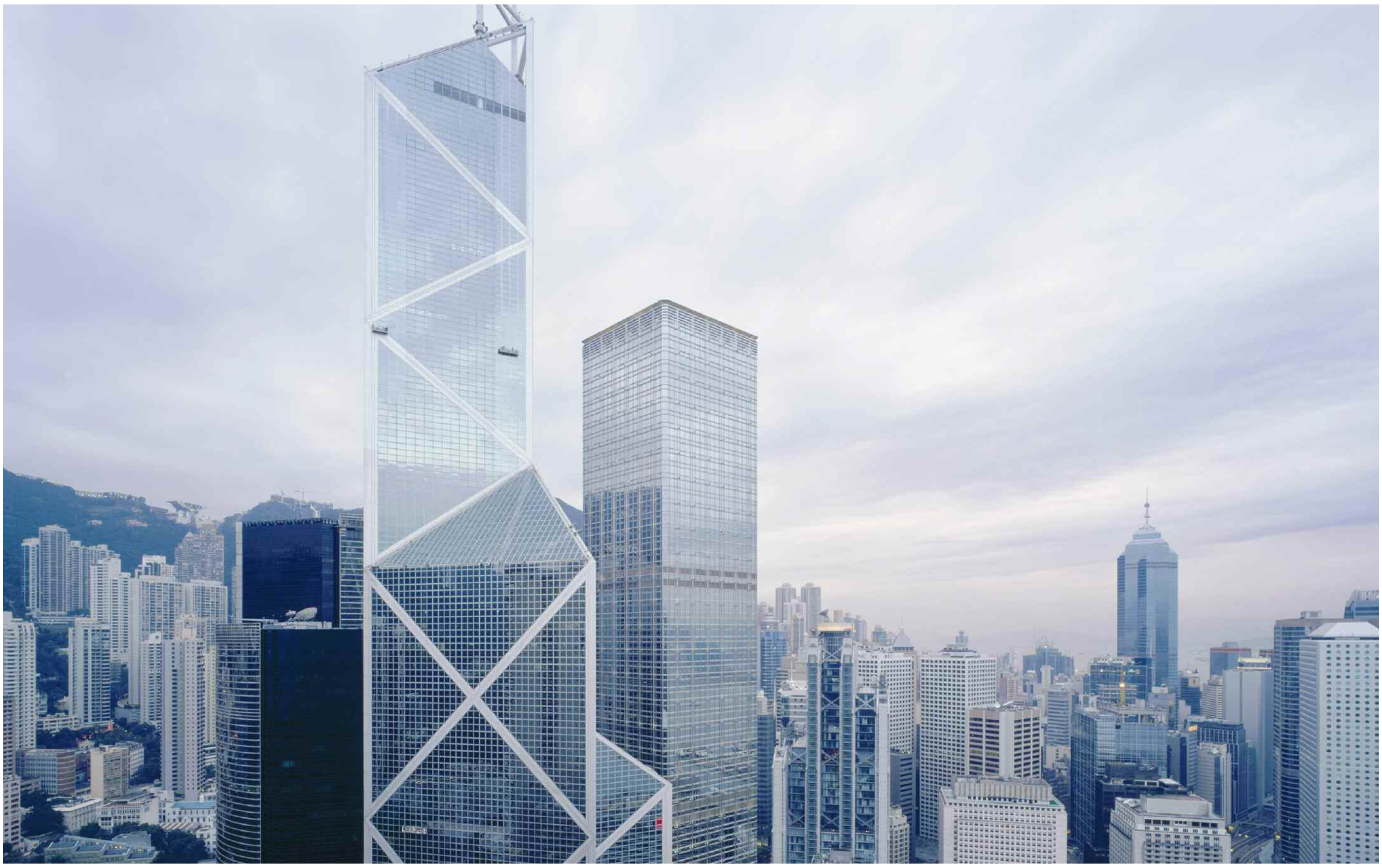
ii. Other PRC laws and rules regulating employment invention remuneration issues

In addition to the TCL, there are multiple laws and rules concerning employment inventions and remuneration matters in China.

The PRC government aims to legislate a regulation specific to employment invention issues and published a draft Employment Invention Regulation in April 2015. Although the draft Employment Invention Regulation set outs different levels of minimum remuneration paid to the employees, like the TCL, it allows an employer and its employee-inventors to agree upon the remuneration details for inventions made in the course of employment. The current PRC Patent Law and its Implementation Rules also follow a similar position as the draft Employment Invention Regulation.

Of the current PRC laws, the TCL will have the broadest scope applicable to all outcomes of R&D, such as patented inventions, know-how and trade secrets. The PRC Patent Law will only be applicable to patentable inventions while the draft Employment Invention Regulation would be applicable to proprietary rights like patents, new varieties of plants and layout designs of integrated circuits.

A company will need to take note of the various requirements when preparing and implementing its employment invention remuneration plan in China.



London: Text of the Draft Trade Secrets Directive agreed

In November 2013, the Commission adopted a proposal for a draft directive on protection of undisclosed know-how and business information (trade secrets) against their unlawful acquisition, use and disclosure (the "**Draft Directive**"). Following the review of the proposal by the Working Party on Intellectual Property, negotiations started between the European Commission (the "**Commission**"), European Parliament and the Council of the European Union on 15 September 2015 to finalise the text of the Draft Directive. It was announced on 18 December 2015 that agreement had been reached, and it is now expected that the Draft Directive will be adopted by the European Parliament in the first quarter of 2016.

The purpose of the Draft Directive is to address the inconsistent approach taken across EU Member States to the protection of trade secrets. In 2013, the Commission conducted a study which highlighted the differing approaches taken to the protection of trade secrets, in particular in respect to the causes of action and remedies available. The approach in the Draft Directive is minimum harmonisation, which leaves it open for Member States to implement additional protective measures.

Key Issues

- The Draft Directive is to be adopted in the first quarter of 2016
- Employee mobility has been identified as a key concern in the Draft Directive
- The impact of the Draft Directive is likely to be most significant in the harmonisation of civil law remedies
- The limitation period for bringing a trade secrets claim will be six years

Trade Secrets

A "trade secret" is defined in Article 2(1) of the Draft Directive as being information which has the following three qualities:

1. it is secret "in the sense that it is not, as a body or in the precise configuration and assembly of its components, generally known among or readily accessible to persons within the circles that normally deal with the kind of information in question";
2. it has "commercial value because it is secret"; and
3. it has been "subject to reasonable steps under the circumstances…to keep it secret".

A key issue in the law of trade secrets generally is drawing the distinction between a trade secret which is capable of protection and employee know-how developed through experience, which an employee should be free to exploit without restriction. The Draft Directive identifies employee mobility as a key concern. Under Article 1(2a), the Draft Directive states that nothing in the Draft Directive offers any ground to limit employees' use of either information not constituting a trade secret under the Draft Directive or of the experience and skills honestly acquired in the normal course of their employment.

Civil Law Remedies

The definition of trade secrets in the Draft Directive replicates the language of Article 39(2) of the Agreement on Trade-Related Aspects of Intellectual Property Rights (the "**TRIPS Agreement**"). Although each Member State is already obliged to comply with its obligations under the TRIPS Agreement, the approach taken to implementing these obligations varies across the Member States. As such the impact of the Draft Directive is likely to be most significant in the area of the harmonisation of civil law remedies. According to the Commission's study, there is inconsistency in approach across the Member States not only in respect of the civil law remedies available, but also in respect of the calculation of damages. For example, only a few Member States allow for a reasonable royalty as a measure of damages.

The Draft Directive provides for both preliminary (Article 9(1)(a)) and final injunctions (Article 11) as a civil law remedy against the unlawful use of trade secrets. The Draft Directive also contains detailed provisions on the factors to be taken into consideration when deciding whether a court should grant relief (Article 9(1)(2)) and when deciding the quantum of damages (Article 13(2)). The destruction of infringing goods, i.e. those goods benefiting from the unlawful acquisition or use of a trade secret, is also available (Article 11).

Another remedy introduced by the Draft Directive is the publication of decisions (Article 14). This reflects the approach of the IP Enforcement Directive which provided for the publication of decisions in respect of the infringement of IP rights. This remedy is seen as particularly attractive to rights holders as it often results in the infringer being required to post a prominent message on its website, and even in third party publications, pointing out its infringement.

Crucially, the Draft Directive also provides for the preservation of trade secrets in court proceedings so as to allow the trade secret holder to bring proceedings without jeopardising the trade secret which it claims has been infringed (Article 8).

The Draft Directive sets a limitation period of six years for bringing a claim in respect of trade secrets (Article 7). However, the Draft Directive leaves it to Member States to decide from which point this limitation period should run, which may lead to inconsistency in approach across the Member States.

Whistleblowing defence

The Draft Directive contains a whistleblowing defence which allows for the otherwise unlawful acquisition, use or disclosure of trade secrets to reveal "misconduct, wrongdoing or illegal activity, provided that the respondent acted for the purpose of protecting the general public interest". This replaces a narrower provision in previous drafts, which qualified the defence by requiring the infringing act to blow the whistle. As such the Draft Directive does not appear to impose any requirement of proportionality on the use of the trade secret in order for the defence to apply, which may be broader than the position at national law in some Member States.

Comment

Although each member state is already obliged to comply with its obligations under the TRIPS Agreement, the approach taken to implementing these obligations varies across the Member States. As such the impact of the Draft Directive is likely to be most significant with respect to the harmonisation of civil law remedies.

The language of the Draft Directive will undoubtedly lead to a number of references to the Court of Justice of the European Union (the "**CJEU**"). Even if the position under the Draft Directive appears to be aligned with national law, this may not be the case in the long term. As has been the case with copyright and trade mark law for example, intervention of the CJEU could potentially overturn the long-settled approach of national courts to the protection of trade secrets. Terms such as "honest commercial practices", which is relevant to clauses in relation to both the lawful and unlawful acquisition of trade secrets, and "commercial value" seem ideally suited to a reference to the CJEU.

Acknowledgements

We would like to thank the following people for their contributions to this publication:

Rais Amils
Petra Belova
Anna Blest
Marcin Czarnecki
Luciano Di Via
Maria Fda Giron
Fabio Guastadisegni
Krzysztof Hajdamowicz
Ling Ho
Nadia Jagusiak
Michal Jasek
James Jeffries-Chung
Matthieu Juglar
Alvin Khodabaks
Sunny Kumar
Diego de Lammerville
Emmanuelle Levy
Montserrat Lopez-Bellosta
Vanessa Marsland
Sonia Masco
Andrei Mikes
Claudia Milbradt
Miquel Montana
Josep Montefusco
Sara van Mourik
Haruka Okihara
Florian Reiling
Monica Riva
Konrad Rominkiewicz
Shila Ruff
Ludvik Ruzicka
Anja Schwarz
Sybille Sculy-Logotheti
Leigh Smith

Contacts

Belgium

Thomas Vinje
Partner, Brussels
T: +32 2 533 5929
E: thomas.vinje
@cliffordchance.com

China

Ling Ho
Partner, Hong Kong
T: +852 2826 3479
E: ling.ho
@cliffordchance.com

Czech Republic & Slovakia

Vlad Petrus
Partner, Prague
T: +420 22255 5207
E: vlad.petrus
@cliffordchance.com

France

Diego de Lammerville
Partner, Paris
T: +31 4405 2448
E: diego.delammerville
@cliffordchance.com

Emmanuelle Levy
Senior Associate, Paris
T: +31 1 4405 2439
E: emmanuelle.levy
@cliffordchance.com

Germany

Claudia Milbradt
Partner, Düsseldorf
T: +49 211 4355 5962
E: claudia.milbradt
@cliffordchance.com

Florian Reiling
Lawyer, Düsseldorf
T: +49 211 4355 5964
E: florian.reiling
@cliffordchance.com

Italy

Fabio Guastadisegni
Partner, Milan
T: +39 02 80634 353
E: fabio.guastadisegni
@cliffordchance.com

Monica Riva
Counsel, Milan
T: +39 02 80634 383
E: monica.riva
@cliffordchance.com

Japan

Hidehiko Suzuki
Partner, Tokyo
T: +81 3 5561 6662
E: hidehiko.suzuki
@cliffordchance.com

Poland

Krzysztof Hajdamowicz
Counsel, Warsaw
T: +48 22429 9620
E: krzysztof.hajdamowicz
@cliffordchance.com

Romania

Mihaela Mindru
Counsel, Bucharest
T: +40 21 6666 137
E: mihaela.mindru
@cliffordchance.com

Russia

Torsten Syrbe
Partner, Moscow
T: +7 495725 6400
E: torsten.syrbe
@cliffordchance.com

Spain

Miquel Montañá
Partner, Barcelona
T: +34 93 344 2223
E: miquel.montana
@cliffordchance.com

Montserrat López-Bellosta
Of Counsel, Barcelona
T: +34 93 344 2255
E: montserrat.lopez-bellosta
@cliffordchance.com

The Netherlands

Alvin Khodabaks
Partner, Amsterdam
T: +31 20 711 9374
E: alvin.khodabaks
@cliffordchance.com

UK

Vanessa Marsland
Partner, London
T: +44 20 7006 4503
E: vanessa.marsland
@cliffordchance.com

US

Roni Bergoffen
Counsel, Washington
T: +1 202 912 5031
E: roni.bergoffen
@cliffordchance.com

Daryl Fairbairn
Counsel, New York
T: +1 212 878 4960
E: daryl.fairbairn
@cliffordchance.com

C L I F F O R D
C H A N C E

Worldwide contact information
35* offices in 25 countries

Abu Dhabi
Clifford Chance
9th Floor, Al Sila Tower
Abu Dhabi Global Market Square
PO Box 26492
Abu Dhabi
United Arab Emirates
T +971 2 613 2300
F +971 2 613 2400

Amsterdam
Clifford Chance
Droogbak 1A
1013 GE Amsterdam
PO Box 251
1000 AG Amsterdam
The Netherlands
T +31 20 7119 000
F +31 20 7119 999

Bangkok
Clifford Chance
Sindhorn Building Tower 3
21st Floor
130-132 Wireless Road
Pathumwan
Bangkok 10330
Thailand
T +66 2 401 8800
F +66 2 401 8801

Barcelona
Clifford Chance
Av. Diagonal 682
08034 Barcelona
Spain
T +34 93 344 22 00
F +34 93 344 22 22

Beijing
Clifford Chance
33/F, China World Office Building 1
No. 1 Jianguomenwai Dajie
Beijing 100004
China
T +86 10 6505 9018
F +86 10 6505 9028

Brussels
Clifford Chance
Avenue Louise 65
Box 2, 1050 Brussels
T +32 2 533 5911
F +32 2 533 5959

Bucharest
Clifford Chance Badea
Excelsior Center
28-30 Academiei Street
12th Floor, Sector 1,
Bucharest, 010016
Romania
T +40 21 66 66 100
F +40 21 66 66 111

Casablanca
Clifford Chance
169 boulevard Hassan 1er
20000 Casablanca
Morroco
T +212 520 132 080
F +212 520 132 079

Doha
Clifford Chance
Suite B
30th floor
Tornado Tower
Al Funduq Street
West Bay
P.O. Box 32110
Doha, Qatar
T +974 4 491 7040
F +974 4 491 7050

Dubai
Clifford Chance
Level 15
Burj Daman
Dubai International Financial Centre
P.O. Box 9380
Dubai, United Arab Emirates
T +971 4 503 2600
F +971 4 503 2800

Düsseldorf
Clifford Chance
Königsallee 59
40215 Düsseldorf
Germany
T +49 211 43 55-0
F +49 211 43 55-5600

Frankfurt
Clifford Chance
Mainzer Landstraße 46
60325 Frankfurt am Main
Germany
T +49 69 71 99-01
F +49 69 71 99-4000

Hong Kong
Clifford Chance
27th Floor
Jardine House
One Connaught Place
Hong Kong
T +852 2825 8888
F +852 2825 8800

Istanbul
Clifford Chance
Kanyon Ofis Binasi Kat. 10
Büyükdere Cad. No. 185
34394 Levent, Istanbul
Turkey
T +90 212 339 0000
F +90 212 339 0099

Jakarta**
Linda Widyati & Partners
DBS Bank Tower
Ciputra World One 28th Floor
Jl. Prof. Dr. Satrio Kav 3-5
Jakarta 12940
T +62 21 2988 8300
F +62 21 2988 8310

London
Clifford Chance
10 Upper Bank Street
London
E14 5JJ
United Kingdom
T +44 20 7006 1000
F +44 20 7006 5555

Luxembourg
Clifford Chance
10 boulevard G.D. Charlotte
B.P. 1147
L-1011 Luxembourg
T +352 48 50 50 1
F +352 48 13 85

Madrid
Clifford Chance
Paseo de la Castellana 110
28046 Madrid
Spain
T +34 91 590 75 00
F +34 91 590 75 75

Milan
Clifford Chance
Piazzetta M. Bossi, 3
20121 Milan
Italy
T +39 02 806 341
F +39 02 806 34200

Moscow
Clifford Chance
Ul. Gasheka 6
125047 Moscow
Russia
T +7 495 258 5050
F +7 495 258 5051

Munich
Clifford Chance
Theresienstraße 4-6
80333 Munich
Germany
T +49 89 216 32-0
F +49 89 216 32-8600

New York
Clifford Chance
31 West 52nd Street
New York
NY 10019-6131
USA
T +1 212 878 8000
F +1 212 878 8375

Paris
Clifford Chance
1 Rue d'Astorg
CS 60058
75377 Paris Cedex 08
France
T +33 1 44 05 52 52
F +33 1 44 05 52 00

Perth
Clifford Chance
Level 7
190 St Georges Terrace
Perth WA 6000
Australia
T +618 9262 5555
F +618 9262 5522

Prague
Clifford Chance
Jungamannova Plaza
Jungamannova 24
110 00 Prague 1
Czech Republic
T +420 222 555 222
F +420 222 555 000

Riyadh
Clifford Chance
Building 15, The Business Gate
King Khalid International Airport Road
Cordoba District, Riyadh, KSA.
P.O.Box: 3515, Riyadh 11481,
Kingdom of Saudi Arabia
T +966 11 481 9700
F +966 11 481 9701

Rome
Clifford Chance
Via Di Villa Sacchetti, 11
00197 Rome
Italy
T +39 06 422 911
F +39 06 422 91200

São Paulo
Clifford Chance
Rua Funchal 418 15ºandar
04551-060 São Paulo-SP
Brazil
T +55 11 3019 6000
F +55 11 3019 6001

Seoul
Clifford Chance
21st Floor, Ferrum Tower
19, Eulji-ro 5-gil, Jung-gu
Seoul 100-210
Korea
T +82 2 6353 8100
F +82 2 6353 8101

Shanghai
Clifford Chance
40th Floor, Bund Centre
222 Yan An East Road
Shanghai 200002
China
T +86 21 2320 7288
F +86 21 2320 7256

Singapore
Clifford Chance
Marina Bay Financial Centre
25th Floor, Tower 3
12 Marina Boulevard
Singapore 018982
T +65 6410 2200
F +65 6410 2288

Sydney
Clifford Chance
Level 16, No. 1 O'Connell Street
Sydney NSW 2000
Australia
T +612 8922 8000
F +612 8922 8088

Tokyo
Clifford Chance
Akasaka Tameike Tower
7th Floor
2-17-7, Akasaka
Minato-ku
Tokyo 107-0052
Japan
T +81 3 5561 6600
F +81 3 5561 6699

Warsaw
Clifford Chance
Norway House
ul.Lwowska 19
00-660 Warsaw
Poland
T +48 22 627 11 77
F +48 22 627 14 66

Washington, D.C.
Clifford Chance
2001 K Street NW
Washington, DC 20006 – 1001
USA
T +1 202 912 5000
F +1 202 912 6000

*Clifford Chance's offices include a second office in London at 4 Coleman Street, London EC2R 5JJ. **Linda Widyati and Partners in association with Clifford Chance.
Clifford Chance has a best friends relationship with Redcliffe Partners in Ukraine.

www.cliffordchance.com

J201602010048478