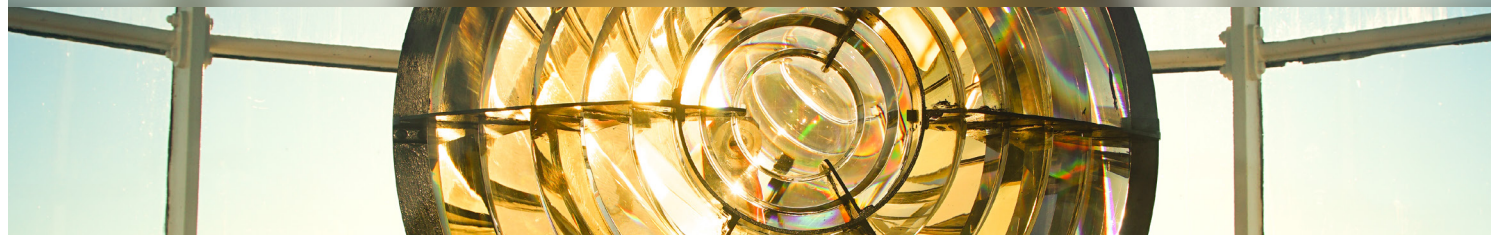


**C L I F F O R D**  
**C H A N C E**

21<sup>ST</sup> EDITION



**GLOBAL INTELLECTUAL PROPERTY NEWSLETTER**  
**IP TOPICS AROUND THE GLOBE**  
ISSUE 03/19



## 21<sup>ST</sup> EDITION

### Introduction

We welcome you to the **21<sup>st</sup> edition of our Global IP Newsletter** in which we would like to shed once again some light on current topics in the world of Intellectual Property.

With **Brexit** looming on 29 March 2019, this March edition will begin with a brief overview about potential consequences of Brexit for the protection of IP rights in Germany and Europe, in particular with respect to Trademark Law, Patent Law, Copyright Law and Data Protection.

We will then focus on another current topic: the **European trademark law reform** in the context of the 2015 EU Directive which were needed to be transposed into the national laws of the Member States. The most important changes and novelties of the Reform will be highlighted from a German, Spanish and Polish law perspective.

Staying with the topic of Trademark Law, this edition will touch on recent case law by the Italian Supreme Court regarding the infringement of a **renowned three-dimensional fashion trademark**.

Turning to Copyright Law, the article by our Italian colleagues discusses the **protectability of a TV format** as copyrighted work and, inter alia, the legal pre-requisites that need to be fulfilled in order to proof protectability.

With respect to the use of **Open Source Software**, we will outline the “*Do’s and Don’ts*” in the course of a company’s software development and business activities regarding the use and commercialization of self-developed and/or in-licensed software in order to be compliant with the many possible Open Source Software license terms.

The remaining two articles deal with a ground-breaking decision of the court of Rome finding **Facebook** liable for failing to remove links to videos and images covered by Mediaset’s copyrights followed by an overview about a series of recent measures to by the Chinese legislator to enhance **IP protection in China**.

We hope you have an interesting read and feel free to get in touch in case of any questions or comments at any time. Looking forward for your feedback.

***Your Global Clifford Chance IP Team***

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## **GERMANY:**

Dr. Florian Reiling, Günter Barth, Fabian Wild

### **IP AND BREXIT – KEY ISSUES**

Friday, 29 March 2019 – Brexit Day. Up to the day of the printing of this IP Newsletter, the United Kingdom and the European Union have not reached a consensus over a Withdrawal Agreement. That means, the “No Deal Brexit” or “Hard Brexit” becomes more probable. Barring a last-minute change of heart, we will see the UK becoming a non-EU country with practically no valid bilateral agreements with European Union member states in place.

What does this mean for Intellectual Property Law? This article is meant to give you a summary of the key issues of Brexit and its impact on IP. We will focus on Patents, Trademarks, Copyright, exhaustion of IP rights, License Agreements, Trade Secrets and Data Protection Law.

#### **Handling of Patents After Brexit**

With regard to Brexit and the handling of patent rights at least three individual topics need to be taken into consideration; these are UK and European patents, supplementary protection certificates (“**SPC**”) and the participation of the UK in the Unified Patent Court Agreement (“**UPCA**”).

#### **UK and European patents**

Patents which cover the UK territory are either UK national patents or European patents. These patents are granted by the UK Intellectual Property Office (“**UKIPO**”) or the European Patent Office (“**EPO**”).

A (hard) Brexit will not affect the current European Patent Systems since the EPO is not an EU institution.<sup>1</sup> Hence, the EPO will continue to function as before Brexit, i.e. UK businesses can still file for patent protection with the EPO and already existing European patents (filed and registered with the EPO) will also remain unaffected.

Already today, the EPO system includes several non-European contracting member states (e.g. Norway, Switzerland and Turkey). After Brexit, the UK will become such a non-EU-member state and applicants of a European patent (filed with the EPO) may request the grant or validation of such patent in the UK.

#### **Supplementary Protection Certificates**

In contrast to patents granted by the EPO the granting of a SPC is subject to an EU regulation (EC No. 469/2009, 6 May 2009).

#### **Key Issues**

- UK and European patents will be unaffected by Brexit. Existing UK Supplementary Protection Certificates will continue to be valid, and UK businesses may still apply for SPC protection in the remaining EU member states. However, UK courts will no longer refer to EU courts and legal interpretation of SPCs may differ between UK and EU over time. Whether the UK remains part of the Unified Patent Court Agreement is unclear and depends mainly on political decisions in the future.
- While already existing European Union Trade Marks will continue to be valid in the remaining EU Member States, the UK Intellectual Property Office will grant a new UK equivalent right to all current EUTM owners. For a nine-month period after exit day applicants with an ongoing application for a EUTM are going to have the option to file for a UK equivalent right, inheriting the filing dates and claims of earlier priority and UK seniority from the corresponding EUTM application.
- The UK does not intend to repeal Copyright provisions based on its EU membership in the mid-term. Main consequence of Brexit would be the creation of a new national UK database right, separated from the EEA database right. EEA persons will not benefit from automatic protection of databases in the UK anymore. Instead, they must be active in the UK to gain UK database right protection.

1. See Guidance on IP and Brexit, available under <https://www.gov.uk/government/publications/ip-and-brexit-the-facts/ip-and-brexit#patents> (accessed on 25 February 2019).

Generally, once the UK leaves the EU, UK businesses may still apply for SPC protection in the then current EU member states and existing UK SPCs continue to be valid.<sup>2</sup> However, although it is the intention of the UK government that the SPC legal framework remains part of UK law, UK courts will no longer refer questions regarding the interpretation of such directives to the EU courts (in particular, to the European Court of Justice (“CJEU”)), i.e. the interpretation of how to handle SPCs might (over time) be different in the UK and the EU. It remains to be seen, whether the UK courts rather tend to follow the ruling of the CJEU or whether a wholly new legal interpretation of SPCs will be created.

### Participation of the UK in the Unified Patent Court Agreement

On 26 April 2018, the UK ratified the Unified Patent Court Agreement.<sup>3</sup> Although the UPCA is an international treaty, it is technically very strongly linked to the EU.

In particular, Art. 84 UPCA stipulates that only EU member states may sign, ratify or (later) join the UPCA's framework. In addition, the UPCA contains numerous references to EU law and regulations and, ultimately, the CJEU shall have final jurisdiction over UPCA matters.

The fact that the unified patent court is required to refer questions relating to European law to the CJEU seems to stand in contrast with the UK's intention to remove its legal system from the CJEU. In addition, the granting of unified patents is governed by an EU regulation, which – again – seems to contradict the UK's plan to act independently from the EU legal framework. Therefore, it remains highly questionable whether the UK may indeed be in a position to become a contracting member to the final UPCA or whether Brexit and the UK becoming a non-EU country, ultimately, prevents the UK from joining the UPCA framework. In any case, a large number of technical issues will need to be solved before the UK could theoretically get involved in the UPCA.

Another area which is not yet sufficiently clear is the area of patent exhaustion. The UK Government published a draft legislation in late 2018 that aims to change UK IP law in a way that the doctrine of EEA wide exhaustion continues to apply.

### Trademarks

In any conceivable Brexit scenario, European Union Trade Marks (“EUTM”) will continue to be valid in the remaining Member States of the European Union and UK businesses will still be able to register such EUTM after Brexit. More importantly, owners of currently registered EUTM will be granted a new UK equivalent right by the UK Intellectual Property Office, which will be treated as if it had been applied for and registered under UK law and will therefore inherit the filing dates and priority dates from the corresponding EUTM. The new equivalent rights will, however, be independent from the original EUTM and may thereby be challenged, assigned, licensed and renewed separately. The UK government expects minimal administrative burden caused by this conversion. Right holder who do not wish to receive an equivalent right will have the opportunity to opt

### Key Issues

- License Agreements referring to the EU as a matter of geographical scope will need individual interpretation and risk assessment, to answer the question whether licensees will still be entitled to use their license inside the UK.
- The Law of Trade Secrets, including the recently implemented EU Trade Secret Directive (No. 2016/244/EU), will remain harmonized even after Brexit. However, without being bound to CJEU legislation the interpretation of the harmonized regulations might alter over time.
- Although no immediate change to the UK's data protection standards is expected, the UK will lose its privileges under the EU General Data Protection Regulation. Until the UK is determined by the European Commission to ensure an “adequate” level of protection, as required by the GDPR for third countries, companies transferring data to the UK should take precautions to comply with GDPR.
- The principle of exhaustion of IP rights shall – even after Brexit – be governed the doctrine of EEA wide exhaustion. However, this requires that the EU adopts similar changes in its statutes.
- Rights of representation for IP professionals outside of the UK will continue and representation before the courts and the UKIPO will also be possible after Brexit in any proceeding relating to the equivalent trademark. However, the representation before the EUIPO is bound to strict requirements which need to be fulfilled before a UK national may represent a party in a proceeding before the EUIPO.

<sup>2</sup> See Guidance on IP and Brexit, available under <https://www.gov.uk/government/publications/ip-and-brex-it-the-facts/ip-and-brex-it#patents> (accessed on 25 February 2019).

<sup>3</sup> See Guidance on IP and Brexit, available under <https://www.gov.uk/government/publications/ip-and-brex-it-the-facts/ip-and-brex-it#patents> (accessed on 25 February 2019).

out.<sup>4</sup> The same will apply to international registrations which designated the European Union filed with the World Intellectual Property Organization.

If a business, organization or individual has a EUTM application ongoing at the date of exit, it will have the option to refile an application for a UK equivalent right with the UKIPO, using the normal UK application process. For a period of nine months from the day of exit, filing dates and claims of earlier priority and UK seniority will be recognised as recorded on the corresponding EU application.<sup>5</sup>

As regards the rights of representation for equivalent rights registered in the UK after Brexit, such equivalent rights will inherit the representative details that are currently registered for the respective eutm, i.e. ip professionals based outside of the UK may continue to represent the specific trademark before the courts and the UKIPO in any proceeding relating to the equivalent trademark. An issue which is still subject to discussions is the question as to whether UK trademark representatives may continue to exercise their representation rights before the EUIPO. Whereas, there seemed to be agreement at first, that such UK representatives can – within a transition period until 31 december 2020 – act before the EUIPO and the cjeu, it is meanwhile rather unclear whether the required representation rights shall be granted. There seems to be a clear commitment of the EUIPO, however, to allow a uk national to represent a party in a proceeding before the EUIPO who (i) is a qualified legal practitioner in one of the member states of the european economic area (“EEA”) and (ii) is established in the eea, and (iii) is entitled to act as representative in trade mark matters in that eea member state.hence, applicants for and/or holders of EU trademarks will need to carefully consider their trademark portfolio and whether they want to keep/obtain trademark protection in the territory of the united kingdom after brexit. particularly applicants of currently pending EU trademark applications will have to be aware as they won’t be notified in advance of the necessity/possibility to refile the application with the UKIPO.

## Copyright

Copyright is a national right, but it has been heavily influenced by international treaties and European legislation. The UK’s membership in the EU significantly shaped and influenced the UK Copyright, Design and Patents Act of 1988 (as subsequently amended). The UK reacted by proposing “The Intellectual Property (Copyright and Related Rights) (Amendment) (EU Exit) Regulations 2018” which removes or corrects references to the EU, EEA, or Member States in UK copyright legislation.<sup>6</sup> Therefore, UK does not intend to repeal any “European” based Copyright provisions due to Brexit – at least in the short to mid-term following Brexit.

One crucial aspect, especially in the light of digitalization and the unclear situation of the protection of data, is the future of (sui generis) database rights. Database rights are a unique European intellectual property right that is only available to EEA nationals



**Claudia Milbradt** – “Claudia Milbradt of Clifford Chance has a broad intellectual property practice, representing clients in patent infringement cases and trade mark disputes, as well as advising on unfair competition and patent filings.”

Chambers Europe 2019 – Germany, Intellectual Property: Patent Litigation

**Claudia Milbradt** – Claudia Milbradt is also ranked in the german “WirtschaftsWoche” as prominent patent lawyer. (<https://www.wiwo.de/finanzen/steuern-recht/top-kanzleien-rechtsanwaelte-fuer-patentrecht-wen-die-fachleute-empfehlen/23753792-2.html>)

4. See Guidance on IP and Brexit, available under <https://www.gov.uk/government/publications/trade-marks-and-designs-if-theres-no-brex-it-deal/trade-marks-and-designs-if-theres-no-brex-it-deal> (accessed on 28 February 2019).

5. See Guidance on IP and Brexit, available under <https://www.gov.uk/government/publications/trade-marks-and-designs-if-theres-no-brex-it-deal/trade-marks-and-designs-if-theres-no-brex-it-deal> (accessed on 28 February 2019).

6. See Guidance on IP and Brexit, available under <https://www.gov.uk/government/publications/changes-to-copyright-law-in-the-event-of-no-deal/changes-to-copyright-law-in-the-event-of-no-deal> (accessed on 26 February 2019)



(private persons or businesses). The aforementioned “Brexit Copyright Regulation Amendment” will lead to a national UK database right that will remain but be separate from the EEA database right. Hence, UK citizens, residents, and businesses are eligible for new national database rights after exit. But they will no longer be eligible to receive or hold European database rights in the EEA.

For the rest, the rather specific issues of “portability of online content services”, which is important for consumers, and the “copyright clearance in satellite broadcasting”, which is important for broadcasting stations, will cease to apply in a “No Deal Scenario”.

### **Exhaustion of IP Rights**

Another area which is not yet sufficiently clear is the area of patent exhaustion. The UK Government published a draft legislation in late 2018 that aims to change UK IP law in a way that the doctrine of EEA wide exhaustion continues to apply.

Hence, the area of exhaustion is another issue that will need to be dealt with post Brexit in order to adequately regulate the potential effects on owners of UK IP rights. Assuming that the UK will indeed recognise EEA-wide exhaustion and the EU will not change its standpoint, then, owners of rights in the EEA would be able to prevent parallel imports from the UK, whereas UK IP right owners would not have a similarly strong IP position, given that their rights would be subject to the principle of exhaustion.

### **License Agreements**

Further, the impact of Brexit on already concluded agreements, in particular license agreements, is worth considering. Extending the license grant geographically to the “European Union” as such may be considered common practice. Obviously, parties concluding a license agreement (significantly) before the referendum in June 2016 did not take into account the eventuality of a country, in particular the UK, leaving the European Union at a later stage during the effectiveness of the license grant. Thus, the vast majority of prior license agreements will most likely not contain a stipulation explicitly covering the scenario of an exit of a Member State, hence leaving room for interpretation. In particular, licensees may face the question whether they will be still entitled to use the licensed right in the territory of the UK after Brexit.

Against this background, the section governing the geographical scope and generally referring to the “European Union” needs to be thoroughly interpreted and risks caused by Brexit carefully assessed individually. In general, the reference to the European Union may be interpreted statically which means that it covers all Member States at the day of execution of the agreement regardless of the future composition of the European Union. Alternatively, it might be understood dynamically, meaning that future changes in the composition of the European Union affect the geographical scope of the license.

## Trade Secrets

By 9 June 2018 any EU member state had to implement the EU Trade Secret Directive (No. 2016/244/EU) into national law. Although not any member state has concluded the implementation, e.g. Germany where the respective act is still not passed by the Bundestag, the UK has done so. Just in time, “The Trade Secrets (Enforcement, etc.) Regulations 2018” came into force in UK. Therefore, the regulations will remain to have effect after Brexit unless it will be repealed. There seem to be no imminent plans by the government to amend or repeal the regulations in the near future. In summary, the Law of Trade Secrets will remain harmonized even after Brexit.

However, there is one practical difference after Brexit. The UK will not be subject to the CJEU’s legislation of the EU Trade Secret Directive. Instead, British courts will have the exclusive right to interpretation of the UK Regulations. This might lead to differing interpretation in the UK and EU over the years.

## Data Protection Law

Although not directly an IP issue, Data Protection Law deserves to be mentioned in this article. Not just that Data Protection is linked to any matter in the digital world and, therefore, comes along with classical IP issues like Copyright Law and the Law of Trade Secrets. Moreover, Data Protection Law will effectively change upon a “No Deal Brexit” and requires action when data is transferred from the EEA to the UK.

The EU General Data Protection Regulation (“**GDPR**”) restricts transfers of personal data to countries outside of the EEA which have not been determined by the European Commission to ensure an “adequate” level of protection for personal data (Art. 44, 45 GDPR). As the Commission has not yet decided on the adequacy of UK’s data protection regime (see below), the transfer is prohibited by law unless derogations for specific situations or an appropriate safeguard applies.

Until Brexit Day, the UK is a member state of the EU. Data transfers within the EU or EEA, respectively, are privileged by the GDPR. Upon the effective withdrawal of the UK from the EU, UK will become a “third country” in the meaning of Art. 45 GDPR. However, the UK will not automatically benefit from an “adequacy determination” which would make the UK comparable to, among others, Switzerland, Canada or Japan. Unfortunately for the UK, the determination process for the adequacy determination cannot begin whilst the UK is still in the EU. And even after withdrawal, an adequacy determination is not guaranteed and can take many months.

Therefore, any company (group) that transfers data to the UK on a regular basis should make arrangements for “Hard Brexit” and introduce appropriate safeguards. One of these potential safeguards are binding corporate rules. However, they need to be approved by the competent data protection authority, which is straight out unrealistic if the preparations of such rules have not yet started. It is therefore recommendable that companies consider to implement standard data protection clauses with UK transferees.

On the other hand, it is expected that there will be no immediate change to UK’s own data protection standards, as the UK government has indicated that it intends to incorporate the GDPR into UK law. The UK government has confirmed that transfers from the UK to the EEA will remain unaffected and continue to flow freely.

## GERMANY

Nicolas Hohn-Hein, LL.M., Noël Lücker

# THE TRADEMARK LAW REFORM 2018/19 IN GERMANY

### Introduction

On 11 December 2018, the German Bundestag passed the German Trademark Law Modernization Act ("**MoMaG**"), coming into force on 14 January 2019 (except for some parts taking effect on 1 May 2020). The MoMaG (among some other updates of the law considered necessary by the national legislator) finally transposes European Directive (EU) 2015/2436 regarding a trademark law reform "to approximate the laws of the Member States relating to trade marks" ("**Reform**") into German law.

The Reform's main objective is to further develop and strengthen the harmonization of European trademark law, taking into consideration important case law of the Court of Justice of the European Union in recent years. The Reform's focus lies in particular in the simplification of the trademark application and registration proceedings and the enhancement of the degree of legal protection in order to fight product piracy more effectively in court as well as out of court (including before the trademark offices).

The main changes of the Reform in view of German trademark law and MoMaG shall thus be outlined below.

### Adaptation to modern types of marks

Prior to the Reform, the German Trademark Act ("**GTA**") required the "graphic representability" of a sign in order to be registered as a trademark in the trademark register, which in respect to modern trademark forms (e.g. olfactory marks, musical marks, three-dimensional marks) is not always easily achievable. To allow registration of such mark, European courts had to interpret Section 8 GTA in its broadest meaning. Following this case law, the new GTA stipulates that only designations should be excluded from registration if they

*"are not capable of being represented in the register in such a way that the competent authorities and the public can clearly and unambiguously determine the subject-matter of protection",*

abandoning the rather strict requirement of graphic representability in favour of a more flexible concept of determinability. This adapts the German trademark law to modern forms of trademarks and improves the legal situation for unconventional trademark forms. Overall, it allows companies to also register trademarks by providing audio files or other technical media (admissibility to be determined at the discretion of the respective trademark offices).

## **Introduction of a national “certification mark”**

Section 106a GTA introduces a so-called *certification mark*, a new form of quality-related trademark. Unlike “classic” trademarks, certification marks shall not convey product origin, but shall encompass a warranty function, providing a transparent and neutral assurance of product quality, such as the “Fairtrade” symbol or the “TÜV” sign.

Independent trademark owners may award companies that meet certain quality criteria with a right of use. The quality criteria need to be defined by the owner in the mark’s statutes. The statute must be publicly accessible in the trademark register.

In this context, the owner takes the role of a certifier and is required to ensure that the user of the certification mark, i.e. the licensee, complies with the trademark statutes.

## **Fighting product piracy**

Section 14a GTA now expressly regulates that a trademark owner may also enforce prohibition rights against goods in transit which in many cases involve counterfeit goods being transported through the EU market. Thus, where a trademark has been affixed to goods without the consent of the owner of the mark, the latter may, in the event of obvious infringements, prohibit the third party from importing the goods to Germany before the actual release of the goods into market circulation. This provides trademark owners with a remedy to fight trademark infringement early on.

## **Presumption of urgency in case of preliminary injunctions**

As a matter of principle, the applicant for a preliminary injunction (“**PI**”) must substantiate “urgency” of the action, i.e. that immediate action of the court is required to avoid unbearable consequences for the applicant/trademark owner. However, exceptions to that principle exist, for example, in Section 12 (2) Unfair Competition Act (“**UCA**”), stipulating a (rebuttable) presumption of urgency. As previous pre-Reform trademark law did not include such a presumption, the applicability of the presumption in Section 12 (2) UCA to trademark cases under the GTA was regularly subject to intense dispute.

Against the above background, Section 140 (3) GTA now includes a presumption identical to Section 12 (2) UCA, harmonizing trademark law with unfair competition rules. In order to rebut the presumption of urgency, the defendant may bring forward evidence suggesting that the applicant was in fact aware of the alleged infringement much earlier and therefore is not entitled to a PI anymore (as he could have lodged it earlier). In such case, the applicant is entitled only to standard legal action.

## **Changes in trademark opposition proceedings**

The new Section 42 (3) GTA stipulates that an opposition before the German Patent and Trademark Office (“**GPTO**”) may now be based on several prior rights if they are owned by the same owner. Apart from trademarks, geographical indications as well as indications of origin, Section 42 (5) GTA may provide ground for an opposition, but only against trademarks filed *after* 14 January 2019.

Further, important means of defense by the defendant/trademark applicant in opposition proceedings usually is the plea of non-use of the older trademark the opposition is based on. The plea of non-use is regulated in Sections 43 (1), 25 and 26 GTA and can only be levied after a five-year grace period. Previously, the grace period started with publication of the older trademark. Now, pursuant to Section 26 (5) GTA, the period begins when no further oppositions can be filed against the older trademark or the objection proceedings have ended, extending the grace period in some cases substantially.

In addition, the new Section 26 (3) GTA clarifies that not every design change of a trademark needs to be formally registered in order to comply with the use-criteria pursuant to Section 26 (1) GTA, provided that the difference does not alter the distinctive character of the trademark.

Finally, in order to increase the number of amicable settlements in the course of opposition proceedings, Section 42 (4) GTA introduces a cooling-off period granting the parties, on mutual request, at least two months to resolve the dispute amicably. The assertion of a legitimate interest or a sufficient cause is not required in this respect. However, the cooling-off period is not applicable for any oppositions pending before 14 January 2019.

### **Introduction of a new forfeiture and invalidity proceeding**

With the Reform, new forfeiture and invalidity proceedings before the GPTO have found their way into Sections 53 and 54 GTA (taking effect from 1 May 2020). The introduction of these procedures is intended both to speed up the duration of the procedure and to reduce procedural costs. They can be brought alternatively before the GPTO or an ordinary court, pursuant to Section 55 GTA. However, as the GPTO needs certain lead time to prepare for the new procedures, these provisions will not enter into force before 1 May 2020. Until then, the existing provisions on cancellation proceedings for forfeiture or invalidity will remain in force.

In this context, it is important to note that relative grounds for invalidity, such as existence of already registered trademarks within the meaning of Section 9 GTA, can now be asserted in the cancellation proceedings before the GPTO, providing a new remedy between opposition proceedings (Section 42 GTA) and cancellation proceedings before an ordinary court (Section 55 GTA).

### **Changes regarding the trademark register and the process of registration**

According to Section 30 (6) GTA, it is now possible to register licenses in the trademark register. This is positive in view of the fact that further legal certainty will be ensured. This way, third parties will be able to easily determine whether someone is legally using a trademark. In addition, this can be a major advantage when it comes to detecting any plagiarism.

Furthermore, pursuant to Section 37 (6) GTA, third parties can be involved in the registration proceedings. While they may explain in written comments why a trademark shall not be registered, the GPTO will however not be obliged to take these comments

into account. In addition, the third parties will not become parties to the proceedings. This new procedure aims at preventing improper trademark application at an early stage without the need for time- and cost-intensive opposition proceedings or further proceedings later on.

### **Conclusion**

Germany has finally managed to transpose Directive (EU) 2015/2436 into national law. In practice, the improved enforcement of trademark rights in preliminary proceedings through the presumption of urgency is particularly significant. By removing a procedural hurdle or at least an uncertainty, this should further increase the chances of trademark owners to enforce their rights.

In addition, the opening of the trademark register for new trademark forms, the introduction of a national warranty trademark as well as the new infringement situation for goods under customs supervision will further shape trademark law in the long term.

### **Key Issues**

- Changes in the 2015 EU trademark law Directive (EU) 2015/2436 further shape national trademark laws of EU member states.
- Germany has finally transposed the new provisions into its national law.
- Significant modifications can be seen especially in the bandwidth of registrable trademark types, but also in improvements of (in-court as well as office) proceedings.



## SPAIN

Josep Montefusco, Sonia Sebé

### NEWS ON THE SPANISH TRADEMARK FIELD: AMENDMENTS TO THE CURRENT SPANISH TRADEMARK ACT

On 22 January 2019, the Spanish Parliament ratified Spanish Royal Decree-law 23/2018, of 21 December (“**Royal Decree-law**”), which transposes Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks (“**Directive**”) into Spanish law. Title I thereof transposes said Directive by amending Spanish trademark law; specifically, Act 17/2001, of 7 December, on Trademarks (“**Spanish Trademark Act**”) and also includes other new aspects.

Save for some exceptions, the new text of the Spanish Trademark Act entered into force on 14 January 2019.

#### Relevant changes

The most relevant changes contained in this amendment are as follows:

- **Entitlement to apply for a trademark or trade name.** This is an amendment not expressly established in the Directive and which is designed to remove the restrictions contained in the previous trademark act. Now, any natural or legal person, including public corporations, may apply to register a trademark or trade name, regardless of the applicant’s nationality or the Member State where it has its establishment or domicile.
- **Removal of the “graphic representation” requirement for trademarks.** This change is set out in the Directive and entails the removal of the former requirement for trademarks to be represented by graphic means. Now, any sign can constitute a trademark, provided that it (i) serves to distinguish the products and services of one company from those of others, and (ii) can be represented in the Trademark Registry in such a way that the subject of the protection granted to its proprietor can be plainly determined. This change permits those signs that are represented by means of audio or video files to also be registered. The director of the Spanish Patent and Trademark Office (“**SPTO**”) has issued a decision in this regard, dated 9 January 2019, providing applicants with information on the various forms in which trademark applications can be presented, depending on the type of trademark in question.

Law Firm of the Year in Patent  
Litigation for Spain 2019  
(MIP EMEA Awards 2019)

Patent Litigation – ranked in  
Chambers Europe 2019 –  
Spain in Tier 1

**Miquel Montañá – ranked as Star Individual:** “Head of department Miquel Montañá’s “extremely high level of technical knowledge” in pharmaceutical patents is widely acknowledged by interviewees, who deem him to be “clearly number one” in his field. His clients include important originator companies, including AstraZeneca, which he assisted with two infringement proceedings concerning its Faslodex patent. His skill set extends to trade mark registration and infringement for important Spanish and multinational corporates.”

Chambers Europe 2019 – Spain:  
Intellectual Property:  
Patents & Trade Marks

- **Elimination of the concept of “well-known” trademark.** In line with the provisions of European Union legislation on trademarks and in order to transpose the contents of the Directive, the Royal Decree-law amends the article on well-known and reputed trademarks, eliminating the concept of “well-known”, which consisted of trademarks that were known by the relevant sector of the public targeted by the products or services identified by the trademark. Only the concept of trademark with reputation is maintained; this was defined as a trademark that is known by the general public. As the SPTO now states, under the Royal Decree-law, a reputed trademark can be known by a specific sector or by the general public.
- **Proof of use in opposition proceedings.** Also to harmonise with the provisions of EU legislation on trademarks, the Royal Decree-law adds an amendment in relation to opposition proceedings. This amendment consists of the possibility for the trademark applicant facing opposition to request that the opponent – the proprietor of an earlier trademark registered for at least five years – furnish proof of the use of the earlier trademark on which it is basing its opposition during the five-year period prior to the application date or the priority date of the trademark in question, or give justified reasons for its lack of use. If such proof is not provided, the opposition will be dismissed.  
  
This amendment, however, cannot be currently invoked, since Final Provision Seven of the Royal Decree-law postpones its entry into force until the date the implementing regulation of the Spanish Trademark Act – which is currently being drafted – enters into force.
- **Trademark revocation and invalidity actions.** Another major change introduced by the Royal Decree-law affects proceedings seeking the revocation and invalidity of trademarks. **The possibility of directly bringing an action before the courts, seeking the revocation or the invalidity of the Spanish trademark, is eliminated. The SPTO will have competence to hear and decide these actions,** although ordinary courts may hear them only when they take the form of a counterclaim in trademark infringement proceedings. However, this change will not enter into force until 14 January 2023, as established in the Directive.
- **Use of the trademark.** One further amendment consists of the change in the date on which the five-year period of use begins to be counted, for the purpose of preventing the trademark from expiring. According to the new Royal Decree-law, this five-year period begins not on the date of publication of the trademark’s granting, but on the date when the trademark’s registration becomes final. This date will be recorded at the registry.

### **Key Issues**

**The most relevant changes included in the Spanish Trademark Act consist of the following:**

- Broader entitlement to apply for a trademark.
- Removal of the graphic representation requirement.
- Elimination of the concept of “well-known” trademark.
- Competence of the SPTO to hear revocation and invalidity actions.
- Proof of use in opposition proceedings.
- *Locus standi* of licensees to join infringement proceeding to claim damages.



## Other changes

Together with these changes, the Royal Decree-law also contains other less noteworthy changes, such as: (i) expanding the list of absolute grounds for refusing to register a trademark by adding prohibitions regarding plant varieties and traditional specialities guaranteed, terms for wine and designations of origin and geographical indications; (ii) modifying the effects of trademark revocation; (iii) including the prohibition for trademark proprietors to invoke their trademarks to release them from liability in actions for infringement of other earlier intellectual property rights; (iv) expanding the scope of protection of the trademark, under certain conditions, to goods in transit in Spain; and (v) regulating the licensee's *locus standi* to intervene in trademark infringement proceedings to claim damages.



## POLAND

Krzysztof Hajdamowicz, Dominika Pietkun

### NEW TRADEMARK REGULATIONS IN POLAND

On 20 February 2019, the Polish Parliament passed the amendment to the Act on Industrial Property Law<sup>1</sup> (“**Industrial Property Law**”), which is intended to implement the EU 2015/2436 directive to approximate the laws of the Member States relating to trademarks<sup>2</sup> (“**EU Directive**”). The new law is expected to enter into force early around mid-March 2019.

#### A new definition of a trademark

The act introduces a new trademark definition which corresponds to the definition included in the EU Directive. The amendment removed the graphic requirement for the representation of a trademark, and therefore provided the opportunity to register new forms of trademarks, including unconventional trademarks such as fragrances, sounds or flavours.

According to the new wording of Article 120 of the Industrial Property Law, a trademark may be any sign enabling the goods of one company to be distinguished from another company's goods and be displayed in the register of trademarks in a manner that allows the determination of the unambiguous and accurate subject of protection.

Although the formal requirement of a graphic representation has been removed, the burden for unconventional trademarks has been transferred to the need to present such a trademark in the register in a way that allows to establish an unambiguous and accurate subject of protection. This requirement reflects the provisions of the EU Directive, specifically point 13 according to which it is essential to require that the sign is capable of being represented in a manner which is clear, precise, self-contained, easily accessible, intelligible, durable and objective. The fulfilment of the above prerequisites may be difficult in the case of unconventional signs.

The amendment also extended the catalogue of signs which are incapable of constituting a trademark. So far, the signs which consisted exclusively of the shape (resulting from the nature of the goods themselves) were not subject to registration. The amendment extended this exclusion, providing that signs consisting exclusively of the shape or other characteristics, resulting from the nature of the goods themselves, or necessary to obtain a technical effect or to increase the value of the goods shall not be the subject of registration.

1. The Act of 30 June 2000 – The Industrial property law (Dz.U. 2001 nr 49 poz. 508)

2. Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trademarks

## Facilitating the extension of the protection right to a trademark

The amendment reduces unnecessary formalism and accelerates the procedure of extending the protection right to a trademark. So far, the entrepreneurs were obligated to submit applications to the Polish Patent Office (“**Patent Office**”) and pay for these applications. In accordance with the amendment, this rather onerous requirement will disappear. It will be enough to pay the fee for the next protection period before the end of the previous one.

It is also worth mentioning that the new regulation does not indicate that the fee for a further period of protection must be made by the rightsholder. In the previous legal status, the application for extension of the protection right could only be submitted by the rightsholder. But this cannot be clearly assessed as an opportunity for anyone to pay a fee with effect for the rightsholder, as according to the new wording of Article 153 paragraph 4 of the Industrial Property Law, the Patent Office may request the payer to submit explanations as to the entitlement to pay a fee.

Further, pursuant to the amendment, the Patent Office will be obliged to inform the rightsholder about the elapsed time of protection in relation to all industrial property rights. However, the rightsholders should continue to control the dates of expiry of protection rights on their trademarks themselves, as the lack of information from the Patent Office about the impending payment deadline will not affect the expiry date of the protection right. Therefore, the rightsholders who fail to pay the fee for the next protection period on time will not be able to rely on the fact that they did not receive a notification from the Patent Office of the impending payment date.

It is also worth noting that, under present regulations, the trademark holder had an additional cure period of six months in which it could still file for renewal subject to payment of some extra renewal fees. The new regulation will no longer provide for such cure period.

## The extension of the license holder's rights

Until now, the catalogue of entities who could have filed claims for infringement of trademark protection rights was very limited. In addition to the rightsholder, only the exclusive licensees could have filed such claims, and only if they were disclosed in the trademark register. The non-exclusive licensees had practically no claim against the infringer and could have only tried to oblige the licensor to take appropriate action against the infringer. The licensees could have also tried to obtain an appropriate procedural mandate from the licensor and then act on their behalf; but in such case, the compensation or the return of unjustified profits were to be awarded to the licensor.

According to the new wording of the Article 163 paragraph 11 of the Industrial Property Law, unless the licensing agreement provides otherwise, the licensee may bring an action for infringement of the protection right to a trademark only with the consent of the rightsholder. While the consent of the rightsholder to the trademark is still required for the licensee not to be excluded from the trademark infringer, it appears that if such consent is obtained, the non-exclusive licensee may file claims on their own behalf.

The changes also affected the rights of the exclusive licensee, who according to the new regulation, may bring an action against the infringer of trademark protection rights, if the rightsholder (the licensor) fails to act in a relevant time with an action for infringement.

### **The extension of protection in case of infringement of a trademark**

The amendment introduces new rights for trademark owners in the fight against counterfeiting. The amendment regulates in a special way the issue of packaging, labels, tags, elements of the product, and its protection or verification of the authenticity of the trademark, all of which could be used in relation to the goods in a manner that infringes the trademark protection law. The entrepreneurs will be able to demand the omission of placing there a sign identical to his trademark or similar to it. In addition, they may demand the cessation of offering, placing on the market, importing or exporting or storing (for the purpose of offering or placing on the market) labelled packaging, labels or security in such a way.

The amendment states that whoever, for the purpose of placing on the market, including within the European Union (EU), a registered trademark or EU trademark, for which they have no right to use or trade in goods marked with such marks, is subject to a fine, restriction of liberty or imprisonment for up to two years.

Prior to the amendment, the person entitled to the trademark protection right could file claims for infringement of this right against two entities: (i) the direct infringer or (ii) a person who only places goods already marked on the market with a sign if they do not come from the rightsholder or the person who had his permission to use the mark. Pursuant to the amendment to the Industrial Property Law, the circle of responsible entities was extended to a third-party entity whose services were used in violation of the trademark rights.

### **Key Issues**

- A new definition of a trademark
- New extended catalogue of designations that may be registered as trademark
- New simplified trademark extension procedure
- Broader protection of license holders
- Extended protection upon trademark infringement



## ITALY

Monica Riva, Ph.D., Andrea Andolina, LL.M

### THE GANCINI TRADEMARK: NEW RULING OF THE ITALIAN SUPREME COURT

The Italian Supreme Court has recently ruled in favour of appellant Ferragamo, the Italian fashion house based in Florence, by remanding the case to the lower Court of Appeal for a new ruling in the proceedings commenced by Ferragamo against an Italian competitor that used, in its handbags, a strap hook in the shape of the Greek letter “omega” ( $\Omega$ ), which is registered by Ferragamo as a tridimensional mark, called “Gancini.”

The Court of Appeal of Milan, therefore, will have to issue a new ruling, after assessing whether the prerequisites exist for protection of renowned marks. The Court of Appeal will have to ascertain, on the basis of the evidence submitted by Ferragamo, as the owner of the renowned mark, whether any unlawful violation occurred, i.e., whether the renown of the mark has been prejudiced or the competitor achieved any potential or actual unjust advantage.

#### Overview of the case and legal topics

The Italian Supreme Court (*Corte di Cassazione*) has issued a ruling in the field of renowned marks.

With Order no. 26001, issued on 17 October 2018, the Supreme Court remanded the case to the Court of Appeal of Milan, which had denied the allegations and claims of infringement of the instant trademark brought forth by Ferragamo against Ripani, an Italian manufacturer of leather products, and its metal parts supplier.

The Supreme Court held that the Court of Appeal had ignored the “notoriety and renown” of the instant mark, and consequently neglected to take into account the rules applicable to renowned marks.

The Court of Cassation agreed with Ferragamo’s grounds of appeal that the Court of Appeal had erred in not finding a similarity between Ripani’s metal part and the “Gancini” trademark and consequently had erred in ruling that the distinctiveness or renown of the Ferragamo trademark had not been prejudiced or that Ripani had not gained undue advantage by using a trademark identical or similar to Ferragamo’s tridimensional mark.

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Moreover, the Supreme Court also stated that the Court of Appeal failed to consider (i) the issue of consumer confusion, given the strong similarity between the competitor's hook and Ferragamo's *Gancini* and (ii) that the use of a trademark identical or similar to that of a protected mark is unlawful in the context of the sale or supply of products, regardless of whether the use of the mark is a distinctive feature or has a functional/ornamental role. What matters for the purposes of a finding of infringement is that the counterfeiter uses, in its economic activities, a trademark that is identical or similar to a protected mark, even if the function is not distinctive, **as long as the mark is likely to evoke the message ("nexus") that the imitated mark evokes.**

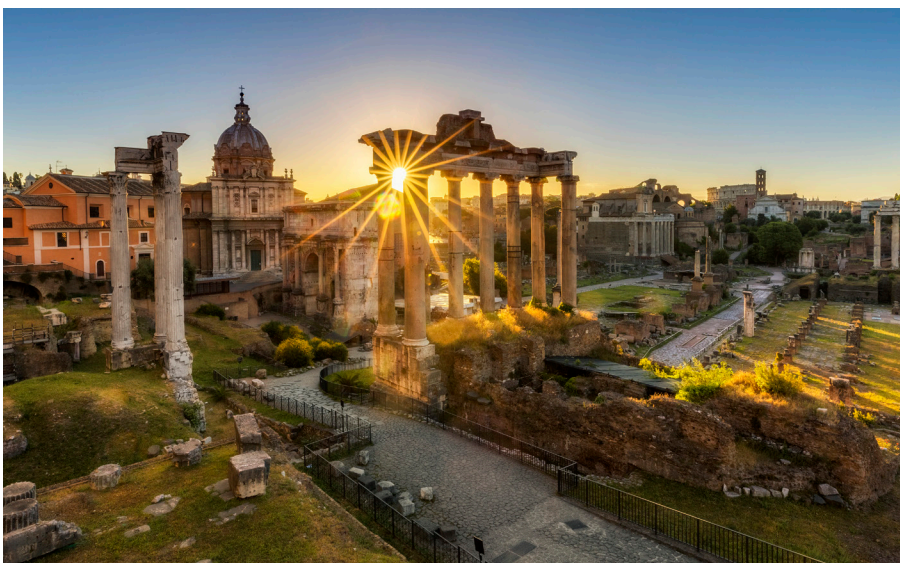
The Order of the Supreme Court sets out notions that have been frequently expressed by the Court of Justice and appears to imply that the protection arises from the competitor's intent to imitate a renowned mark in a parasitic attempt to exploit the message the trademark evokes.

This is a very interesting holding, because the instant case regards a very minute element of the handbag, a small metal hook that is nevertheless perceived by the fashion consumer, who is extremely focused on details. A consumer will choose to purchase a handbag because she wants a Ferragamo-style bag and recognizes such brand in that small element.

This ruling fosters protection from those incidents of counterfeit that, although ultimately offering a quality product (such as Italian leather made in Italy), are motivated by a hidden parasitic intent. The owner of the trademark will continue, however, to bear the burden of proving, first and foremost, that the mark is distinctive and renowned.

### Key Issues

- Infringement may occur even if the infringing trademark is used with a function that is not distinctive, as long as the trademark is likely to evoke the message ("nexus") that the imitated mark evokes
- A consumer can choose to purchase a product because she wants a specific brand style bag and recognizes such brand also in a small element, making this element distinctive
- The owner of the renowned trademark will continue to bear the burden of proving, first and foremost, that the trademark is distinctive and renowned.



## ITALY

Monica Riva, Ph.D., Andrea Andolina, LL.M

### TV PROGRAMMES AND FORMAT: COPYRIGHT PROTECTION IN ITALY

The format of a show has been protected in Italy as an author's work since the Italian Collecting Society ("**SIAE**") started a special register in 1994. The registration, however, is not a formal requirement to obtain copyright protection, but allows to take advantage of the authorship presumption as to the rightholder and establishes priority in case of future dispute (in either case, both the authorship presumption and the priority, if questioned in court, should be proven by the claimant).

The copyright protection of the format is independent and additional to other potentially involved and independently protected matters (movie, screenplay, title, characters, etc.).

According to Italian judicial precedents, copyright protection on format will not exist unless (i) there are a number of clearly identified elements which, taken together, distinguish the format from others of a similar type; (ii) those distinguishing elements are connected with each other in a coherent framework that can be repeatedly applied in an original and not banal structure; and (iii) this structure should allow the creation of "multiple" versions of the programme based on the same format ("*multipli*" in Italian). This means that the owner should document as much detailed information as possible about the format to demonstrate that it has a detailed and exhaustive framework.

#### The subject-matter

In the absence of a legal definition of "format" as copyright work, Italian courts have always referred to the notion expressed by SIAE for its special register (set out in SIAE's bulletin 66/1994): "*a work having **original structure** which explains the functioning of a show and its complete articulation of scenes and topic sequences, **ready to be represented** in a radio/television programme or theatrical show, immediately or through an arrangement for the creation of series. In order to be protected, the work shall present the following characterising elements: **title, plot and concept, scenes and main characters**"<sup>1</sup>.*

1. Free translation from the original in Italian: "*un'opera dell'ingegno avente struttura originale esplicativa di uno spettacolo e compiuta nell'articolazione delle sue fasi sequenziali e tematiche, idonea ad essere rappresentata in un'azione radiotelevisiva o teatrale, immediatamente o attraverso interventi di adattamento o di elaborazione o di trasposizione, anche in vista della creazione di multipli. Ai fini della tutela, l'opera deve comunque presentare i seguenti elementi qualificanti: titolo, struttura narrativa di base, apparato scenico e personaggi fissi*".

A high-level review of judicial precedent decisions on the matter shows that format protection has been invoked in a number of different situations; given that the fulfilment of requirements for the copyright protection is not easy to prove, often the protection has been denied (sometimes, however, courts have granted the alternative claim of unfair competition). In the majority of TV programmes (talk-shows, reality shows, quiz shows, talent shows, etc.) the subject-matter is straightforward. However, in other cases the existence of a protectable “format” can be denied if the peculiarity of the audio-visual programme (e.g. newscasts or award ceremonies) is based on common (and therefore, non-original) elements. At the same time, the broad notion of “format” also enabled the coverage of shows that do not air on television, such as film festivals or theatrical events.

### **Creativity**

The format of a show is protected under Italian law as a copyrightable work; therefore, the ordinary requirement of creativity applies. On this issue, the Italian Supreme Court has affirmed in several occasions that for format, too, there is no threshold of artistic value to ascertain creativity; it is sufficient that the ideas underpinning the format, even if simple, are characterised individually as a result of the author's creative effort (Italian Court of Cassation, decision no. 3817, 17 February 2010; Italian Court of Cassation, decision no. 21172, 13 October 2011).

In line with general principles of copyright law, it has been also affirmed that creativity in the format does not require absolute originality (Court of Rome, 23 September 2011). On the other hand, a format which consists only of banal and common elements (such as the structure of an award ceremony) does not attract copyright protection. Accordingly, the Court of Milan, with a decision on 17 June 2016, denied format protection for the programme entitled “Oscar of Football”, because the programme relied on a banal structure of a ceremony and replicated – without particular creative efforts – similar and common events for films and TV series.

### **The form... in format**

Format protection is subject also to the other main principle of general copyright law, i.e. the idea/form dichotomy. Therefore, the copyright protects only the formal expression of a creative effort and not the underlying idea, which always remains in the public domain.

On the basis of this principle, Italian Courts have sometimes denied protection to formats which were at their very initial and raw phase, requiring additional creative efforts to be completed (although maybe already filed with the SIAE special register). A format cannot be protected if it consists only of a title and a very generic idea of the location, without specific mention of the other characterising elements listed in the notion, i.e. plot, concept, scenes and main characters (see Court of Appeal of Rome, 2 March 2009; Court of Milan, 16 February 2011). As affirmed recently by the Italian Supreme Court: *“if these elements lack or are not elaborated in a sufficiently clear and determined fashion, it is not possible to invoke the copyright protection, because we are dealing with an idea so vague and generic to be compared to an empty shell, without any market utility and missing of the requirements of creativity and individuality necessary to implement the notion itself of a work of author”* (Italian Court of Cassation, decision no. 18633, 27 July 2017).



## Certain takeaways

- **Register your format...** The filing of the format in the special register held by SIAE is a very valuable method to take advantage of the authorship presumption as to the right holder and to establish priority in case of future disputes (both of which, if questioned in court, should be proven by the claimant).
- **...diligently...** Although useful, the mere act of filing should not be overestimated; a rough and incomplete registration runs the risk of being ineffective and counterproductive in court. All and any characterising elements of the format should be carefully drafted: title, plot and concept, scenes and main characters.
- **Focus on creativity and ... be as detailed as possible!** The scope of protection of the format (if any) varies on the creative elements which it contains. Focus on the original aspects of your format, and avoid referencing common and banal elements which are typical of the type of show you are writing, which are therefore likely to be in the public domain. In any event, rough and undetailed ideas are not protectable under Italian copyright law.

## Key Issues

- Format is protected as work in Italian copyright protection, subject to the requirements of originality and expression in form.
- Any type of format can, in principle, be protected.
- The rightholders can register the format before SIAE, the Italian Collecting Society; the registration is aimed to give legal certainty and priority and is not a formal requirement to obtain copyright protection.



## **GERMANY**

Günter Barth

### **OPEN SOURCE SOFTWARE – HIDDEN LIABILITY RISKS IN YOUR COMPANY?**

A main consequence of digitalization is the drastic increase of different types of software in any field of business. It is not just the Tech sector and their big players like Google, Facebook or SAP & Co. Any large company nowadays uses software other than the absolute basic operation systems, text processing programs or web browsers. Companies employ software and computer programs for a vast variety of processes, and maintain huge databases. Software helps – or even replaces – production processes, and boosts communication and more frequently becomes the main asset of start-ups.

This fundamental importance of software for contemporary economy is reason enough to direct our attention to specific legal problems in this field. Of course, software issues are a modern, classic aspect of Intellectual Property Law. Software and computer programs make for a fair amount of Copyright Law and, sometimes, Patent Law work. One rather unfamiliar aspect of software-related matters is Open Source Software (“**OSS**”). This is astonishing since nearly every complex piece of software employs OSS code.

This article is meant to provide you with an overview of the factual and legal implications of OSS. Based on these principles, we focus on liability risks that come along with the use of OSS in a company. Is your company also affected? Find out!

#### **What is Open Source Software?**

OSS is software, or more precisely, a group of computer programs, which is distributed under publication of its source code. The source code is the text written in a computer language which contains the control commands to be processed by a computer. The opposite of OSS is proprietary software, where the owners keep the source code confidential and only distribute the software in binary code (also called “object code”). The object code is the machine-readable compilation of the source code. Computers can only process data in binary form, i.e. zeros (0) and ones (1).

Thus, OSS gives software developers the opportunity to analyze the structure of the computer program and identify weaknesses or develop improvements. Further, OSS is normally free to use, copy, modify and combine with other works. However, free in this context does not mean that there are no license conditions. Actually, OSS is licensed under standardized license texts with certain standard license obligations for the user.

Such standardized license models are, among others, the MIT license, the Berkeley Software Distribution (“**BSD**”) license, the Apache 2.0 license or the important GNU

General Public Licenses (“**GPL**”) in its versions two and three. Each text varies in its obligations and ranges from permissive licenses with nearly no restrictions (see MIT and BSD licenses) to strict license conditions imposing harsh restrictions on users and developers (see GPL).

Many popular standard software tools are OSS. There are OSS operating systems such as Linux or Android for mobile phones that are alternatives to the proprietary systems like Windows or Apple iOS. In the field of application software, there are Mozilla Firefox and Thunderbird which are OSS alternatives to Microsoft products like Internet Explorer or Outlook. Another example is GIMP (GNU Image Manipulating Program) which is an alternative to Adobe Photoshop. This list could go on and on.

OSS is also very important in modular software development. There are reams of OSS libraries and frameworks, i.e. programs that form templates for known problems in software development. Programmers can download these libraries and frameworks from internet sources such as GitHub and implement them into their software projects in no time. And since there are so many great OSS projects, many software modules of individual software consist of OSS code to a lesser or greater extent.

OSS tools will become more and more important because many Big Data applications such as Apache’s Hadoop, Spark or Storm are used by Tech giants like Amazon, Facebook, IBM or Twitter. It also plays a crucial role in embedded systems in the Internet of Things (“**IoT**”) where the operating software may be OSS. It is also expected that autonomous driving software might contain a significant amount of OSS code.

## **What are the risks of using or implementing Open Source Software?**

### **Cease-and-desist**

As already indicated above, OSS comes with more or less strict license conditions. One obvious risk is the lack of awareness of the license conditions. It is important to note that many OSS license models, in particular the widespread GPL version 2, foresees an automatic termination of the granted license in case of breach of license conditions.

Since Intellectual Property Law foresees liability for cease-and-desists regardless of negligence or fault, a breach of license conditions may lead to the automatic termination of the right to use the OSS and, consequently, to warning letters and/or preliminary injunctions against OSS owners. Such cease-and-desist consequences might range from simple workarounds that only require a few hours of work to major obstruction of a business if the OSS is major component which may not be easily replaced by another code. In the latter case, the economical risk could be tremendous.

### **Damages**

Besides cease-and-desist claims, users of OSS in breach of OSS license conditions could be subject to damages claims. Two aspects mainly arise in this context: on the one hand there must be fault or negligence by the user, and on the other hand the amount of damages is not easily determinable. Regarding negligence, users may not effectively defend by proving that they did not know the OSS license conditions and/or their breach thereof. The omission of having an OSS license management or

compliance system could be sufficient to establish negligence. With a view on the amount of damages, breaching users may not refer to the software being available free of charge. At least in German law, damages could also be determined by the saved investment time and cost by using OSS libraries or frameworks. In other jurisdictions, there could also be punitive damages. In particular, international businesses should be very aware of OSS legal implications.

### **Copyleft**

One of the most prominent problems in the context of OSS is the “Copyleft” effect. What is the Copyleft effect? According to the Free Software Foundation’s definition:

*“Copyleft is the general method for making a program free software and requiring all modified and extended versions of the program to be free software as well.”*

This means Copyleft is a means to keep the program and all modifications of it Open Source. It is in contrast to the traditional goal of Copyright Law to award exclusive rights to the creator of a work. This is also the reason for the peculiar term “Copyleft” – whereas Copyright means exclusivity, the “Copyleft” effect goes in another direction.

The Copyleft effect is not a characteristic of any OSS. It depends on the applicable OSS license. As the Copyleft effect is probably the most restrictive obligation in an OSS license, the Free Software Foundation – which is responsible for standardizing OSS license texts – categorizes mainly three groups of OSS licenses:

- Strong Copyleft Licenses,
- Weak Copyleft Licenses and
- Permissive Licenses.

Strong Copyleft Licenses require any modification of an OSS to be licensed under exactly the same OSS license as the original OSS. Prominent examples of these licenses are the different versions of the GPL.

The Copyleft effect is triggered when the modified software is distributed (as is the wording in the GPL Version 2) or conveyed (as is the wording in the GPL Version 3). These broad terms trigger the Copyleft effect without a doubt if the modifications are made publicly available over the internet.

The strong Copyleft effect is sometimes also referred to as the “viral effect”. This is due to the consequence of combining proprietary source code with OSS code and thereby modifying the OSS, potentially triggering the Copyleft effect on the entire code assembly. The proprietary code will be “infected” with the Copyleft license. If the new modification will be distributed or conveyed, it legally must be under the strong Copyleft license. If such publication under the OSS is omitted, it leads to the aforementioned liability risks.

You might ask: “How shall anybody take notice of this?” Do not feel too secure. If your company’s work based on strong Copyleft OSS is publicly available, OSS right owners may detect the implementation of their OSS code with specific tools. Even if such software work is only conveyed intra-group, whistleblowers pose a risk to your software developing investment.

Weak Copyleft Licenses also contain the described obligation to publish modified works under the same license texts, but not in generality and only in specified cases. Examples for Weak Copyleft Licenses are the GNU Lesser General Public Licenses (“**LGPL**”) or the Mozilla Public License (“**MPL**”). Both employ specific delimitations of Copyleft effected use or unrestricted use of the affected OSS code. In doubt, a technical expert in collaboration with a legal expert should assess the risk of Copyleft effects if you detect Weak Copyleft Licenses in your software stack or seemingly proprietary code.

Permissive Licenses generally are admissible without greater concerns. This is especially true for the very popular MIT and BSD Licenses. However, there are still license terms to respect. While the MIT and BSD Licenses are very short, another popular Permissive License is Apache 2.0, which indeed contains several obligations that might interfere with other OSS and even in-licensed proprietary software.

Finally, you might also encounter OSS license texts with an option to choose if a String Copyleft effect or a similar effect will be triggered (e.g. the Artistic License 2.0 which is not overly popular).

Summing up, the Copyleft effect poses immediate risks to your investment in software development. The inclusion of Strong Copyleft licensed code and the “wrong” inclusion of Weak Copyleft licensed code might lead to a vulnerable situation for your software dependent business. Developing or in-licensing a workaround comes with huge effort and costs, especially if the OSS is included deep down in your software’s code. Sometimes a workaround might not even be possible – the absolute worst-case scenario.

### License Compatibility

Another relatively unknown risk among software developers is OSS license compatibility. Due to the Copyleft obligations which urge you to put modifications under the exact strong Copyleft License as the implemented OSS, they might interfere with other license texts demanding the same. This is the scenario where Copyleft Licenses may cause issues.

A conflict might also become problematic between a Copyleft and a Permissive License. For example, the GPL Version 2 is considered incompatible with the permissive Apache 2.0. This is due to the fact that the GPL Version 2 prohibits imposition of further restrictions on the recipients’ exercise of granted rights. The Apache 2.0 forestalls such further restriction by automatically terminating the license in case a licensee brings a patent infringement lawsuit against the patent owner of the licensed subject matter.

Prominent incompatibilities are the abovementioned GPL Version 2 & Apache 2.0, GPL Version 2 & GPL Version 3 or Apache 2.0 and MPL.

What makes matters even worse is that many widespread software libraries include loads of OSS – but not necessarily all compatible to each other. Therefore, your software developing department might have included a library in your software solution that contains inextricable incompatibilities. And the mere fact that many people and companies use those libraries does not justify the potential infringement of OSS owners’ legal rights.

### Compliance and criminal liability

In most jurisdictions, patent and copyright infringements are criminal or administrative offenses. Further, most jurisdictions do not require knowledge of the infringement and negligence is sufficient. This poses another risk to your company and even the personal interests of CEOs and managers. OSS management is a compliance issue like Data Protection, Bribery and Money Laundering, albeit relatively unknown.

However, this might change with digitalization altogether. With the increased importance of software in all parts of business and everyday life, it is just a matter of time until the first “blockbuster” OSS cases will be discussed on a larger scale. Not having implemented a viable process for verifying OSS compatibility and compliance of Copyleft licenses might easily result in a claim for negligence.

### Is your business affected?

To answer this question, you might ask yourself the following questions: Does my business develop software or has the business instructed external software developers to develop custom software solutions? Have I ever heard about the Copyleft effect or OSS license compatibility? Have we ever screened our proprietary code for OSS code? Do we have a code clearing system? (How) Do we encounter these risks in collaboration with third parties?

If the answer is “yes” for the first question and “no” for the others, there is a realistic chance your business might be affected by OSS-induced risks. It might be a good idea to put OSS on the agenda and right the ship, if and as necessary.

### Summary

Summing up, software becomes inevitable in the age of digitalization. Being aware of OSS means knowing one of the riskiest and under-the-radar pitfalls of our time. Good news: the risk may be mitigated by instituting good processes, raising awareness and training employees. Avoid liability, loss of investment and compliance issues and update your business managing processes for the future.

### Key Issues

- Open Source Software is widely popular, yet the legal risks are rather unknown.
- Open Source Software is the backbone of several important technologies of the near future such as Big Data, IoT and autonomous driving.
- Lack of awareness of Open Source License conditions may lead to liability for cease-and-desists and damages.
- The Copyleft effect may effectively prevent your software developments from being economically exploited. Therefore, it may lead to a write-off of your financial investments into the development of this software.
- If you have never heard of Open Source License Compatibility, you might be at risk of breaching several license conditions.
- Awareness and organizational measures form the backbone of an effective Open Source Software compliance system.



## ITALY

Monica Riva, Ph.D., Carlo Felice Giampaolino, Alessandro Sciarra

### FACEBOOK'S LIABILITY FOR LINKED CONTENT

With a groundbreaking decision on 15 February 2019, the Court of Rome found Facebook Inc. and Facebook Ireland Limited liable for failing to remove (i) links to videos and images covered by Mediaset's copyrights and (ii) comments on a Facebook profile, damaging Mediaset's reputation.

The decision raises questions regarding the obligation of so-called "passive" hosting providers to promptly remove unlawful content on their servers, even if they have no say on the posted information. According to the decision, the "actual awareness" of the violation triggers the providers' liability. Providers must, therefore, carefully examine any notice of infringement they receive.

#### The case

Broadcasting company Reti Televisive Italiane S.p.A., belonging to the Mediaset Group, ("**Mediaset**") brought an action on 2012 against Facebook Inc. and Facebook Ireland Limited (together, "**Facebook**") before the Court of Rome, alleging that:

1. a Facebook profile contained unlicensed links to YouTube videos and images related to the Japanese animated television series "Kilari", covered by Mediaset's exclusive rights and broadcast on the Mediaset's television channel named "Italia 1";
2. on the same Facebook profile, offensive comments were posted, which damaged Mediaset's reputation; and
3. Facebook violated Mediaset's rights on the "Italia 1" channel trademark.

After several requests from Mediaset, the Facebook profile was removed in 2012, two years after the first request.

Based on the above, Mediaset claimed damages amounting to EUR 250,000.

#### The decision

With the decision dated 15 February 2019 ("**Decision**"), the Court of Rome ruled in favour of Mediaset and found Facebook liable for failing to promptly remove the unlawful content.

The Decision highlighted that the links posted on the Facebook profile led to a third party's site (YouTube) – which had not been authorised by Mediaset – and not to videos published by Mediaset itself.

Therefore, according to the Court, sharing on Facebook the content covered by Mediaset's exclusive rights constituted a communication to "new public", i.e. to a public that "was not already taken into account by the copyright holders when they authorised the initial communication to the public of their work" (see Court of Justice of the European Union, judgment 7 August 2018).

#### Key Issues

- Hosting service providers can be found liable for unlawful content posted by their users.
- "Passive" hosting service providers have a duty to remove unlawful content, when they are aware of its presence.
- Italian Courts have jurisdiction on Facebook when the damaging event occurred in Italy.

On this basis, and provided that no authorisation had been granted by Mediaset as copyright holder, the Court found that posting on Facebook a link to YouTube videos related to the “Kilari” animated series was not lawful.

### The general rule on hosting service provision

Facebook qualified itself as a “passive” hosting service provider, i.e. a provider of the storage service related to information provided by a recipient of the service.

On this basis, Facebook tried to invoke the principle under article 14 of the EU Directive no. 31/2000<sup>1</sup> (“**Directive**”) and under Italian Legislative Decree no. 70/2003 implementing the Directive (“**Italian Decree**”), that excludes hosting service providers’ liability for the information processed and activities performed by the users.

While the Decision consented that Facebook is a host service provider under the Directive, it rejected Facebook’s objection and stated that the general exemption from liability does not apply to this case.

### ... And the exception relevant to the case

The Decision focused on the exception under article 16 of the Italian Decree, under which, in line with the Directive, the hosting service provider is liable when the provider has actual knowledge of illegal activity or information and, as regards claims for damages, is aware of facts and circumstances from which the illegal activity or information is apparent.

In particular, according to the Court, and in line with the case law of the Court of Justice of the European Union (judgments 23 March 2010, *Google vs Louis Vuitton et al.*, and 12 July 2011, *L’Oréal vs eBay*), the knowledge of the unlawfulness of the information stored on the provider’s server, no matter how it is acquired, gives rise to the provider’s liability, irrespective of an order to remove the content being issued by a public authority.

It is worth noticing that, according to the Court of Rome, the above exception also applies to a “passive” hosting provider (i.e. a provider neutral in respect of the content posted by the users), as Facebook qualified itself in the judgment before the Court of Rome. Under the Decision, the passive hosting provider is bound to promptly remove, or prevent the access to, the unlawful information published on its server, provided that a general duty of care binds the “passive” hosting service provider to identify and prevent unlawful activities it is aware of.

Under the Decision, the link of the hosting service provider’s liability to the actual awareness of the unlawfulness of the information published on its server ensures the right balance between (i) the copyright holder’s rights from one side and (ii) the provider’s rights to conduct its business and the user’s right to receive or send information, on the other side.

<sup>1</sup> Directive 2000/31/EC of 8 June 2000 on certain legal aspects of information society services, in particular electronic commerce, in the Internal Market (Directive on electronic commerce).



## The jurisdiction of the Court of Rome

The Court of Rome also rejected the objection of lack of jurisdiction raised by Facebook, based on the fact that Facebook's registered office is in California. The Court grounded its ability to decide based on the special jurisdiction principle under Article 5(3) of the 1968 Brussels Convention, that, in relation to tort liability, "anchors" the proceedings to the place where the damaging event occurred. According to the Court, this principle applies also to American defendants, notwithstanding the fact that the United States never signed this Convention, since this principle was incorporated into Article 3 of the Italian Law No. 218 of 1995 as a general rule.

With reference to damaging events occurring on the internet, according to settled Italian case law, the place where the event occurs is not the one where the infringing content is uploaded, but where the damage is suffered, which is the market area where the affected party resides or exercises its economic activity. On this basis, the Court found that Reti Televisive Italiane S.p.A. has its registered office in Rome and Rome is the place where the damaging event occurred.

Lastly, the Court of Rome excluded the applicability of the Facebook jurisdiction clause in its Terms of Service, since this applies only to contractual breaches.

## The findings of the Court of Rome

### The Court of Rome:

1. found that Facebook is liable for violation of Mediaset's image and reputation from one side, and copyright from the other side;
2. found for liquidated damages in favour of Mediaset (i) on equitable basis with reference to the reputational damage and (ii) with reference to the copyright violation, on the basis of the value to which Mediaset would have been entitled, had the Facebook user requested authorisation to post the links;
3. ordered Facebook to abstain from violating the abovementioned rights and copyright and fixed a EUR 1,000 penalty for each further violation; and
4. found that no violation of "Italia 1" trademark occurred, since Facebook never used this trademark to market or advertise its own products or services.



## **CHINA**

Jill Ge

### **CHINA IP – MORE CHANGES ON THE HORIZON**

#### **Introduction**

Over the years, China's IP protection regime has constantly been accused of being inadequate by the West. IP and technology transfer has been a focus in the China-US trade war. Against this backdrop, China has recently unveiled a series of measures to enhance IP protection, ranging from a Supreme Court guideline on preliminary injunctions in IP cases to a new draft Amendment to the Patent Law. Even more notably, a National IP Appeals Court in the form of an IP Tribunal has been established within the Supreme People's Court ("**SPC**") which is already up and running. With those institutional changes, we hope to expect stronger protection and enforcement when it comes to procuring, utilizing and enforcing IP in China.

#### **Supreme Court guideline on preliminary injunctions in IP cases**

On 26 November 2018, some four years after the issuance of a draft for comments, the Judicial Committee of the Supreme Court issued the regulation regarding preliminary injunctions in IP disputes ("**PI Regulation**") which has come into effect on 1 January 2019.

Some key points of the PI Regulation include the following:

- (i) confirming that preliminary injunction may be permitted without communicating to the respondent if the grant of a preliminary injunction is of urgency;
- (ii) listing the substantive factors to be considered for the grant of a preliminary injunction include the factual and legal merits of the case, whether the failure to grant a preliminary injunction will cause irreparable damage to the legitimate rights and interests of the applicant, or cause difficulty in the enforcement of the ruling for the case; whether the damage caused by the failure to grant a preliminary injunction exceeds the damage caused by the preliminary injunction to the respondent, whether the preliminary injunction will damage public interests and other factors;
- (iii) procedurally, stipulating the time for the court to consider the grant of a preliminary injunction and distinguishing the different procedural requirements for a utility model or design patent;
- (iv) setting out remedies against wrongful application for preliminary injunction; and
- (v) setting out the guidelines on the bond amount required.

As such, the PI Regulation is a welcome measure which marks China's effort to give consistency and more legal certainty across courts at all levels and geographical areas in China.

#### **New draft Amendment to the Patent Law**

The proposed Fourth Amendment to the Patent Law is another measure by the Chinese government to step up its efforts in protecting IP rights in China. The

allegation that IP protection in China is inadequate has always been linked with low damages awards and the difficulty in collecting evidence due to the lack of the discovery processes under Chinese law.

The most notable changes in the draft Amendment are as follows:

- (i) Increasing statutory damages for patent infringement from the current range of RMB 10,000 to RMB 1 million to RMB 100,000 to RMB 5 million.
- (ii) Introducing fines against infringer for wilful infringement for up to five times the determined amount of damages.
- (iii) Codifying the court's authority in determining damages solely based on the plaintiff's claim and evidence if the infringer fails to disclose its financial records and all other materials relating to the infringement as ordered.
- (iv) Setting out the responsibilities of internet service provider to comply with takedown requests by the rightholder based on the decision of the courts or administrative bodies.
- (v) Increasing the term of protection for design patents to 15 years.
- (vi) Affording patent term extension for innovative pharmaceutical patents for up to five years.

The aforementioned changes have long been hoped for and would further harmonize the Patent Law with laws of major IP jurisdictions. It remains to be seen how the draft Amendment will be finally adopted and later implemented by the Chinese courts.

### **National IP Appeals Court**

In addition to the specialized courts in Beijing, Guangzhou and Shanghai and the specialized IP tribunals in other regions to handle technical IP disputes, the newly established National IP Appeals Court in the form of an IP Tribunal within the SPC will mainly handle appeals relating to civil and administrative IP issues, especially on patent cases and other technology-related cases which require a high degree of technical knowledge. Going forward, IP-related appeals from the Intermediate People's Court and the specialized IP courts in Beijing, Guangzhou and other regions will be heard by this new National IP Appeals Court within the SPC.

Judges at the new National IP Appeals Court under the SPC are expected to be equipped with specialized knowledge and experience in adjudicating technical IP cases, and are believed to be able to better handle such cases with more consistent rulings than local, provincial courts.

Practitioners are also hopeful that through consolidating appeals in one court, it would help bring about consistent rulings in infringement cases appealed from a first-instance infringement court and concurrent invalidation proceedings appealed from the Beijing IP Court.

While the effectiveness of this new National IP Appeals Court under the SPC will need to be tested, in view of the volume of patents and patent cases in China, it is certainly going to be a busy forum and is going to have a significant impact on IP jurisprudence in China in the years to come.

### **Conclusion**

China has the ambition to build a knowledge- and innovation-based economy. Against this backdrop, IP has been elevated to signify such strengths and, as a result, improving the environment and infrastructure for IP protection and litigation has been an active agenda item within China for several years now. Those recent changes, whether associated with any outside pressure or not, are here to stay. More importantly, given this changing dynamic, it would be increasingly crucial to tailor any IP strategies for China.

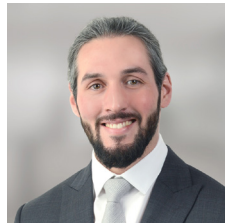


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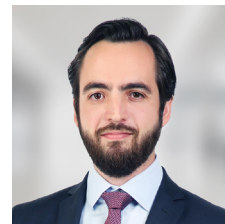
**Dr. Florian Reiling**  
Senior Associate  
Düsseldorf



**Günter Barth**  
Lawyer  
Düsseldorf



**Fabian Wild**  
Lawyer  
Düsseldorf



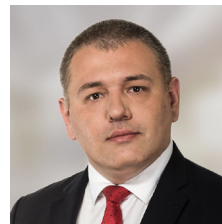
**Nicolas Hohn-Hein**  
Lawyer  
Düsseldorf



**Josep Montefusco**  
Partner  
Barcelona



**Sonia Sebé**  
Abogado  
Barcelona



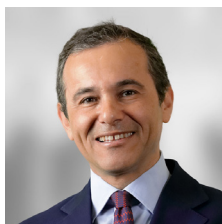
**Krzysztof Hajdamowicz**  
Counsel  
Warsaw



**Monica Riva**  
Lawyer – Counsel  
Milan



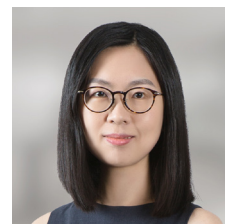
**Andrea Andolina**  
Associate  
Milan



**Carlo Felice Giampaolino**  
Partner  
Milan



**Alessandro Sciarra**  
Lawyer  
Rome



**Jill Ge**  
Qualified Lawyer  
Shanghai

## FURTHER CONTRIBUTORS

Noel Lücker

Dominika Pietkun

Judith Dany

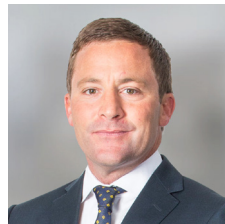
Vincent Schildt

## CONTACTS

### Australia



**Tim Grave**  
Partner  
Sydney  
T: +61 28922 8028  
E: tim.grave@cliffordchance.com



**Sam Luttrell**  
Partner  
Perth  
T: +61 892625 564  
E: sam.luttrell@cliffordchance.com

### Belgium



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



**Dieter Paemen**  
Partner  
Brussels  
T: +32 2533 5012  
E: dieter.paemen@cliffordchance.com

### China



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



**Diego de Lammerville**  
Partner  
Paris  
T: +31 1 4405 2448  
E: diego.delammerville@cliffordchance.com

### Germany



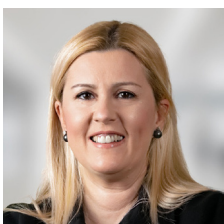
**Claudia Milbradt**  
Partner  
Düsseldorf  
T: +49 211 4355 5962  
E: claudia.milbradt@cliffordchance.com

### Italy



**Luciano Di Via**  
Partner  
Rome  
T: +39 064229 1265  
E: luciano.divia@cliffordchance.com

### Poland



**Monica Riva**  
Counsel  
Milan  
T: +39 02 8063 4383  
E: monica.riva@cliffordchance.com



**Krzysztof Hajdamowicz**  
Counsel  
Warsaw  
T: +48 22 429 9620  
E: krzysztof.hajdamowicz@cliffordchance.com

### Russia



**Torsten Syrbe**  
Partner  
Moscow  
T: +7 49 5725 6400  
E: torsten.syrbe@cliffordchance.com

### Spain



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

## Spain



**Josep Montefusco**  
**Partner**  
**Barcelona**  
T: +34 93 344 2225  
E: josep.montefusco@cliffordchance.com

## The Netherlands



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

## United Kingdom



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



**Stephen Reese**  
**Partner**  
**London**  
T: +44 20 7006 2810  
E: stephen.reese@cliffordchance.com

## United States



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



**Steve Nickelsburg**  
**Partner**  
**Washington**  
T: +1 202912 5108  
E: steve.nickelsburg@cliffordchance.com

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40215 Düsseldorf, Germany

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