

**Intellectual Property Office launches five-year strategy setting out plans to boost British innovation and UK's creative sector.**

The publication, "Making life better by supporting UK creativity and innovation", highlights core areas of focus that will help boost economic growth and competitiveness via a world-class Intellectual Property regime. This includes:

- increasingly strong enforcement action against counterfeiters and other IP thieves;
- a dedicated programme of IP education for UK businesses and students; and
- a commitment to joining and shaping an EU-wide patent system that will provide improved protection for UK business across Europe.

The strategy recognises that despite the UK's strong IP regime, more must be done to ensure that businesses and individuals are capitalising on their creativity.

The IPO says that even a modest increase in the registration, protection, and exploitation of IP would contribute to UK job creation and economic growth. For example firms that apply for trade marks are 7% more productive than those that do not, it says.

The IPO's programme of education and its commitment to digitising and streamlining the application process for all registered rights will work to address and overcome any accessibility issues.

The strategy also recognises the important role the UK will play in delivering the Prime Minister's vision for an EU Digital Single Market in which individuals and businesses can legitimately access online goods and services regardless of nationality and location. To read the IPO's press release in full and for a link to the strategy, click [here](#).



**High Court reapplies principles in *British Telecom v One in a Million* and finds mere registration of domain names in which defendant had goodwill amounts to passing off.**

In March and April 2014, the claimant, Yoyo.email Ltd registered the domain names, rbsbank.email, rbs.email, natwest.email and courtts.email. The defendant, Royal Bank of Scotland Group plc, was the registered proprietor of the trade marks RBS, RBSBANK, NATWEST and COURTTS.

In May 2014, RBS filed a complaint with the World Intellectual Property Organisation pursuant to ICANN's Uniform Dispute Resolution Policy. The domain name dispute resolution Panel found that: (i) the domain names in question were identical or confusingly similar to RBS's registered trade marks; (ii) that Yoyo.email's proposed use of them could not be regarded as *bona fide*, nor was the intended use of them legitimate or fair; and (iii) that Yoyo.email had registered the domain names and intended them to be used in bad faith. The Panel ordered that the domain names be transferred to RBS. The domain names were transferred accordingly, but were held in "lock" due to these proceedings.

Yoyo.email contended that the Panel's decision was wrong and commenced proceedings in the High Court for negative declaratory relief to the effect that it had been guilty of no wrongdoing. RBS denied that Yoyo.email was entitled to such relief and counterclaimed for passing off and registered trade mark infringement.

RBS applied to the court, first, to strike out the claim and/or for reverse summary judgment on the claim and, secondly, to strike out Yoyo.email's Defence to Counterclaim and/or for summary judgment on the counterclaim.

In terms of passing off, RBS's goodwill and reputation in the names RBS, RBSBANK, NATWEST and COURTTS, was not in dispute. The central issue was misrepresentation.

Following the Court of Appeal decision in *British Telecommunications plc v One in a Million Ltd [1999] FSR 1*, His Honour Judge Dight, found that the mere registration of the domain names, which were distinctive, made a representation to those consulting the register that the registrant was connected or associated with the names registered and thus the owner of the goodwill in those names. Further, they would believe that the registered owners were connected or associated with the owner of the goodwill in the registered domain names.

HHJ Dight did not accept Yoyo.email's submission that the court's reasoning in *One in a Million* was out of date because the internet had developed to such an extent since that decision was made (or that the public had become significantly more sophisticated) that the reasoning no longer held good. The essential factual elements behind the decision had not altered, HHJ Dight said, namely the registration of a distinctive domain name on a register that could be accessed by the public.

HHJ Dight also did not accept that the law had moved on in any relevant way since *One in a Million* was decided. The reasoning of the Court of Appeal had been followed and applied in a number of cases in the intervening years both in first instance decisions and in the Court of Appeal. Therefore, *One in a Million* established a principle of law by which HHJ Dight was bound and meant that registration of the domain names by Yoyo.email amounted to passing off.

HHJ Dight rejected Yoyo.email's submission that its proposed business model and intended use of the domain names needed to be explored at trial. Yoyo.email argued that, applying its business model, no one had been or would be misled by its registration of the domain names into believing that its products or services were those of or connected or associated with or approved by RBS. Yoyo.email emphasised that it had not threatened to use the domain names to pass off or dispose of them. This was, however, irrelevant, HHJ Dight found because actionable passing off had already occurred at the point of registration of the domain names.



As for RBS's application to strike out the claim, HHJ Dight found that clause 4K of the UDRP, which allows either side to submit the dispute to the court for independent resolution either before UDRP proceedings are commenced or after such proceedings are concluded, did not give rise to a separate cause of action in favour of Yoyo.email. Further, clause 4K did afford any jurisdiction to the court to act as an appeal or review body from the decision of the URDRP Panel.

There was no practical utility in granting declaratory relief because: (i) the UDRP scheme had already dealt with the issue; (ii) any declaration made by the court could not alter the findings of the Panel; and (iii) the effect of HHJ Dight's conclusions on the application for summary judgment on the counterclaim rendered the claim otiose.

This was, therefore, a "*plain and obvious case for striking the Claim out*". Further, had he not reached such conclusion, HHJ Dight said, he would have granted reverse summary judgment, dismissing the claim on the basis that it had no real, as opposed to fanciful, prospect of succeeding and that there was no other compelling reason why it should proceed to trial. (*Yoyo.email Ltd v Royal Bank of Scotland Group plc [2015] EWHC 3509 (Ch) (2 December 2015)* – to read the judgment in full, click [here](#)).



**Government publishes consultation on European Commission’s draft Directives on online sale of digital content and tangible goods.**

As part of its Digital Single Market Strategy, the European Commission published two new draft Directives proposing harmonised consumer rights for the sale of digital content and the online sale of tangible goods.

The aim of the Directives is to reduce barriers to the growth of cross-border e-commerce in the EU by setting common rules across Member States for certain key aspects of consumer law. The Government says that taking *“effective steps toward unlocking these barriers could have an enormous impact on UK businesses and consumers”*.

The Government explains that the draft Directives are based on existing EU law and, as such, mirror many of the consumer rights and obligations already in place in the UK. However, there are also some important aspects in which the proposals differ from the rights currently in place in the UK (contained in the Consumer Rights Act 2015). If adopted as currently drafted, the proposal would therefore require some changes to the UK consumer protection regime.

The consultation sets out some brief observations on the proposals, including in respect of the main differences with the current position in the UK. The Government is objectively seeking the views of interested parties. It is keen to receive observations on some or all of these potential changes, as well as broader reflections on the proposals and the benefits of having a maximum harmonisation measure from both a business and consumer perspective.

In particular, it would like to receive comments on the potential impacts of these changes to respondents’ businesses, their staff and on consumers. It would also like to see views on the balance of the proposals, comparing the impact of the changes to UK law against the benefits of opening up the digital single market. To access the consultation documentation, click [here](#).



**European Data Protection Supervisor announces new “Digital Ethics” project.**

The EDPS has launched a discussion, both in the EU and globally, on how to ensure the integrity of fundamental rights and values while embracing the benefits of new technologies. Speaking at the annual Conference of Computers, Privacy and Data Protection, Giovanni Buttarelli said that he had established an Ethics Advisory Group, which will enable the realisation of the benefits of technology for society and the economy in ways that reinforce the rights and freedoms of individuals.

The Group will comprise six people, each an expert in their respective field, who will consider digital ethics from a variety of academic and practical perspectives, with a view to producing a new ethical approach to data protection, privacy and the digital world.

The Advisory Group will work with other experts, for example through interviews and workshops with representatives of the scientific community around the world as well as data protection experts. In the interests of transparency, periodic summaries of their work will be made public.

The EDPS will also contribute ideas to the work of the group, for instance on how experience, common sense and morality can be factored into automated decision-making processes. Otherwise, the group members, who will not be remunerated, are expected to work autonomously and free from any interference or conflict of interest.

The group is expected to deliver its findings, recommendations and views in the form of reports (interim, discussion and final), which will be presented at public meetings and workshops. A draft final report setting out the group’s new ethical approach to data protection, privacy and the digital environment is expected to be submitted by January 2017 for public consultation.

Mr Buttarelli said: *“Most of us agree that we are each more than the sum of our data and yet we are more defined by our quantified selves than ever. Our privacy has almost become a commodity, used to sell ideas and products back to us or to influence our behaviour. I am, therefore, delighted to announce that the EDPS, with the support of an Ethics Advisory Group, has started his work to re-consider the ethical dimension of the relationships between human rights, technology, markets and business models and their implications for the rights to privacy and data protection in the digital environment. With the help of this group, we intend to identify a new ethical approach in the coming years so that individuals are no longer reduced to mere data subjects in the digital environment”*. To read the EDPS’s press release in full, click [here](#).



## **Government publishes response to IPO consultation on unjustified threats on intellectual property rights.**

Patent, trade mark and design law provides businesses with certain protections, so that they are not unfairly threatened with legal action for infringing someone's intellectual property rights. The existing provisions do not however work as well as they should, the Government explains. They are thought to be inconsistent and unclear, enabling experts to exploit technical loopholes while tripping up the unwary. They have been accused of failing to achieve the necessary balance, which is to allow rights holders to protect highly valuable assets, but not to misuse threats of infringement to distort competition.

In 2012 the Department for Business, Innovation and Skills and the Intellectual Property Office asked the Law Commission to review the relevant statutory provisions. The Law Commission published a Consultation Paper in 2013 and responses showed strong support for retaining protection against unjustified threats and overall support for reform of the existing law.

The consultation exercise was followed by a Law Commission Report in April 2014, which summarised the responses received and made 18 recommendations for reform. The Government responded on 26 February 2015, accepting the recommendations (in a few cases with some qualifications), and tasked the Law Commission with drafting a bill. This was published along with the Law Commission's final report on 12 October 2015.

In October 2015, the Intellectual Property Office launched a discussion document on the Law Commission's final report. It received 12 responses and has now published its own response.

The Government has accepted the Law Commission's recommendations for reform, including those made in the final Law Commission report, and intends to introduce primary legislation to implement these reforms. Essentially, the legislation will bring the law for trade marks and designs into line with that for patents by allowing a rights holder to challenge someone who is a primary actor without fear of facing a groundless threats action. It will also:

- make sure that the threats provisions are much clearer;
- make it easier for parties to make good faith attempts to settle an IP infringement dispute before litigation; and
- stop legal advisers from being subject to threats and accusations when the dispute is between the parties that they represent.

To read the response in full, click [here](#).

