



Materials for Mock Trial

Barcelona 2014

Panel of Experts

- Plaintiff Counsel
 - Marek Lazewski—LDS Lazewski Depo & Partners
- Defence Counsel
 - Caroline Casalonga—Casalonga Avocats
- Judge
 - Robert S. Katz—Banner & Witcoff, Ltd.
- Moderator/ Clerk of the Court
 - Joe Nabor—Fitch, Even, Tabin & Flannery LLP



Disclaimer

- Hypothetical
- Actual Shoe
- Continuum
 - Daphne model
 - 3d Printable
- Everything else (including accused infringer names) is made up for the purposes of this mock trial



Continuum Daphne Shoe



Continuum Daphne Shoe

- 3D files sold on line for \$800 (limited personal license)
- Downloaded/sold only 1,000 times
- *Great deal of press*
- Procured design patent/registered design rights in many countries
- Procured trademark registrations to “Daphne” and “Continuum”



Continuum Daphne Shoe



www.Modelsharing.com

- On-line site
- Users post 3D model files (over 25,000 models)
- Some products are of nature and common goods
- Other files correspond to articles made by companies and were made and uploaded without authorization
- Website accessible worldwide



SlyFox Posting on Modelsharing Website

Daphne Shoe Model



Product File Downloads

CheckMate Lite Certified

on Sep 26, 2012



Lightwave 11 (.lwo, .lw, .lws) 45 MB

Renderer: Default Scanline 11
Inspected in: Lightwave 11

Unreviewed Formats

Autodesk FBX 200611 (.fbx) 46 MB

OBJ (.obj) 45 MB

Live Chat Now 24/7

Quality Guarantee

File format conversions



Product License

Royalty Free License

[All Extended Uses](#)

[FAQ](#)

3D Model Specifications

Native file format: Lightwave 11

Product ID: 687783



SlyFox Posting on Modelsharing Website

- \$59 to download file
- Indicates it is “Modelsharing.com Certified”
- Specific downloadable page can be found by searching on modelsharing site for terms “Daphne” or “Continuum” or searching “shoe” and looking at the results
- Specific downloadable page can be found by searching on SearchMe web search as a sponsored 2nd hit by searching for terms “Daphne” and “Continuum” and “3d model”
- Actual model sale page just indicated “Daphne Shoe Model”
- The shoe 3D image of the file does not include any word trademarks (the Continuum download has the marks “Continuum” and “Daphne” on the sole)



SlyFox Posting on Modelsharing Website

- Downloaded over 400 times
- Has been downloaded and printed
 - Shoes seen being worn on the red carpet at the Academy Awards by famous actress Angelina Aniston (does not appear to have been authorized)
- Has been downloaded and is being used by the main character in the new video game *Black Widow* manufactured by Ninja Games.



Party Overview

Continuum

SlyFox
(Poster)

Modelsharing.com
(Host)

SearchMe
(Search Engine)

Angelina Aniston
(end user)

Ninja Games
(end user)



Assumptions -The trial of the future

- The World's Court – global competence & unified procedure over all existing IP rights
- No substantive law unification. Court can pull legal principles from any jurisdiction based on:
 - Fairness
 - Best suited to the particular task
- Can apply principles of equity



The background of the slide is a blue gradient with several overlapping circles of varying shades of blue, creating a modern, abstract design.

Plaintiff's argument

Grounds

- Council Regulation (EC) No 6/2002 of 12 December 2001 on Community designs

Article 19

Grants the holder the right to prevent any third party not having his consent from using the design (at the territory of the EU). The use covers, in particular, the making, offering, putting on the market, importing, exporting or using of a product in which the design is incorporated or to which it is applied, or stocking such a product for those purposes.

- Council Regulation (EC) No 207/2009 of 26 February 2009 on the Community trade mark

Article 9

The proprietor of the Community trademark is entitled to prevent all third parties not having his consent from using in the course of trade (in the EU) any sign which is identical with the Community trade mark in relation to goods or services which are identical with those for which the Community trade mark is registered;



Grounds

- Directive 2000/31/EC ('Directive on electronic commerce')

Article 14

Member States shall ensure that the service provider is not liable for the information stored at the request of a recipient of the service, on condition that:

- a) the provider does not have actual knowledge of illegal activity or information and, as regards claims for damages, is not aware of facts or circumstances from which the illegal activity or information is apparent; or*
- b) the provider, upon obtaining such knowledge or awareness, acts expeditiously to remove or to disable access to the information.*



Grounds

- WIPO Copyright Treaty 1996
- Article 6 (1) right of distribution:
- *Authors of literary and artistic works shall enjoy the exclusive right of authorising the making available to the public of the original and copies of their works through sale or other transfer of ownership*



Slyfox - 400 x \$59



Claim against Slyfox

- Direct infringement of trademark „Daphne“
 - identical trademark used in commerce
 - use for identical goods - shoes, regardless that no real shoe but a file is offered
- Explicit commercial exploitation of the design (use, offering, putting into trade and... making?)
 - the use of the design has to be understood **widely**, not only as use of the design incorporated into the product but as use of any manifestation of the design, **including graphical presentation and reproduction**. Offering and selling a 3D model constitutes use of the design
- Violation of copyrights exclusivity



Claim against Modelsharing.com

- Modelsharing.com is liable for the infringements occurring at its websites, because it had actual knowledge of this illegal activity (Directive on electronic commerce)
- It took active role in presentation of this specific offer, as the offer is designated “Modelsharing.com Certified” (see C-324/09 L’Oréal vs. eBay)
- Infringement of “Daphne” and “Continuum” trademarks also because Modelsharing.com is an advertiser at SearchMe which constitutes the use of trademark (see C-236/08, Google France SARL i Google Inc. v. Louis Vuitton Malletier SA)



Claim against Searchme

- Searchme is liable for trademark infringement
- A provider who makes available to advertisers keywords reproducing registered trade marks and arranges to display advertising links to sites offering infringing goods is using those trade marks in trade and the trademark proprietor is entitled to oppose it
- Actions of Searchme harm the reputation of the trademarks
- Search me has insufficient takedown procedures



Angelina Aniston



Claim against Angelina Aniston

- Liable for design and copyright infringement
- Appearance in Academy Awards cannot be classified as private and noncommercial use of the design
- The use goes beyond the private use
- Image of a celebrity (of particular professions e.g. an actor) can be described and assessed in financial terms
- Academy Awards is a business event, transmitted and commented worldwide. Particular attire may result e.g. in number future engagements (e.g. movies, commercials, photo sessions) and may e.g. translate into higher income of the actor. It is use for business purposes



Claim against Ninja Games

- Ninja Games is exploiting the design commercially in the video game
- The use of the design has to be understood widely, not only as use of the design incorporated into the product but as use of any manifestation of the design, including its graphical presentation.
- Presenting the design in the video game constitutes use of the design



The background is a solid blue gradient. Overlaid on this are several large, semi-transparent circles of varying shades of blue, creating a layered, abstract effect. The circles are positioned such that they overlap each other, with some appearing more prominent than others.

Defendant's argument

Slyfox (poster)

I have just shared
with my friends
those
cool and chic
Daphne shoes!



Slyfox (poster)



- **Alleged trademark infringement:** the trademark is registered for shoes only. The DAPHNE mark was not used by Slyfox to designate shoes, but a CAO file for which the claimant has no right
- **Alleged design infringement:** the design should be cancelled as it has no individual character: simple reproduction of the roots of a tree in the Everglades
- **Copyright exception of private use :** Slyfox has just shared the design with her friends. No commercial use, no use in trade. .

Modelsharing.com (HOST)

- Modelsharing.com is a service provider. It has more than 100.000 CAO files on its platform that have been uploaded by third parties.

Modelsharing does not promote the listings placed on its platform:

- No actual knowledge of the alleged litigious acts: never received any notice from the claimant
- No active role in the upload of the files, just provides a platform - has no control over the files - neutral role, no knowledge of these files (absence of liability - see case Google Adwords March 23, 2010, case C-236/08)



No liability according to art. 14 of the directive on electronic commerce



SearchMe (search engine)

- The claimant argues that SearchMe is liable for trademark for the keywords reproducing the DAPHNE trademark and the display of the ad.
- DAPHNE is a first name, SearchMe may sale such keywords without beeing held liable of any trademark infringement
- The use of keywords does not constitute trademark use - so no trademark infringement
- As a service provider, SearchMe may not be held liable without actual knowledge of the alleged infringing acts.



Angelina Aniston (end user)



I have 3Dprinted those cool
DAPHNE shoes for the
festival.
My friends all loved the
shoes!

- Exception of private use applies whether public or private person
- Was not paid by Slyfox or Modelsharing to wear the shoes
- No commercial use
- Would agree to receive payment from the claimant for the free advertising!

Ninja game (end user)

My new shoes are part of my force!

No copy of the DAPHNE design.
The game is an animated movie.
It is a work of art.
All elements are drawn by the
Ninja designers.
The similarities with the
DAPHNE shoes are pure
coincidence.



No design infringement



The background of the slide is a blue gradient with several overlapping circles of varying shades of blue, creating a modern, abstract design.

Plaintiff's rebuttal

Amici curiae?

The background consists of several overlapping rounded rectangular shapes in various shades of blue, ranging from a very light, almost white blue to a deep navy blue. The shapes are layered, creating a sense of depth and movement. The word "Verdict" is written in a white, serif font, positioned on the right side of the image, overlapping the darker blue shapes.

Verdict