

# MARQUES

Annual Conference

Conference Photos

GeoNews Latest

 GI reforms in Argentina

Courts rule on Google Suggest

Versace succeeds in Israel

Foreign advertising in Turkey

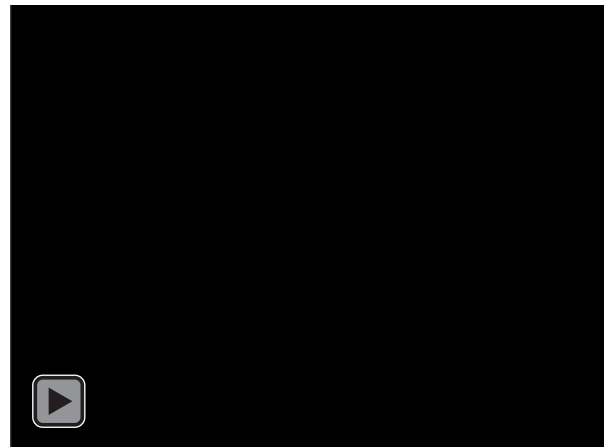
## The Annual Conference in pictures and video

The **MARQUES** Annual Conference was held in Brighton, UK from 15th to 18th September and the theme was “Sustainable Brands – A Luxury or a Necessity”.

The conference was opened by Ann Norman, Mayor of Brighton, who welcomed delegates and discussed the importance of environmentalism. The other speakers at the conference’s opening session, on sustainable branding, were consultant David Green and Nel Hofstra of Erasmus University Amsterdam.



The theme for Wednesday night’s reception at the Brighton Dome was “Best of British” and it featured performers from England, Scotland, Wales and Northern Ireland including the band of the Grenadier Guards.



Andrew Layton, Director of Trade Marks and Designs, discussed the UK IP Office’s latest initiatives to increase the efficiency of trade mark granting.

**Continued**

## Contents:

Annual Conference	1
Conference Photos	2-4
GeoNews Latest	5
GI reforms in Argentina	6
Courts rule on Google suggest	7
Versace succeeds in Israel	8
Foreign advertising in Turkey	9

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# MARQUES

Annual Conference

Conference Photos

GeoNews Latest

 GI reforms in Argentina

Courts rule on Google Suggest

Versace succeeds in Israel

Foreign advertising in Turkey

The delegate packs at the conference were made from recycled material and included sticks of iconic Brighton rock.



Speakers provided different perspectives on sustainable branding, many with case studies. Michael Keogh of BP discussed how a brand can be adapted over time, while Marjolijn Vencken of Trouble in Paradise showed various examples of advertising to demonstrate how brand owners and consumers can work together to develop social responsibility.

OHIM President Wubbo de Boer gave a thought-provoking speech on the need to reform OHIM's opposition system. Vincent O'Reilly of OHIM and Charles Gielen of NautaDutilh NV discussed recent European cases.



# MARQUES

Annual Conference

Conference Photos

GeoNews Latest

 GI reforms in Argentina

Courts rule on Google Suggest

Versace succeeds in Israel

Foreign advertising in Turkey

Delegates enjoyed traditional seaside pastimes at the "Sussex by the Sea" welcome reception on Tuesday night.



**MARQUES** Chairman Guido Baumgartner awarded the annual Lewis Gaze Memorial Scholarship.

He also presented past chairman Tove Graulund with an honorary lifetime membership of **MARQUES**.



A popular and topical conference session looked at the plan to launch new generic top-level domains on the internet. ICANN's Karla Valente and Nick Wood of Com Laude explained the latest developments.



# MARQUES

Annual Conference

Conference Photos

GeoNews Latest

 GI reforms in Argentina

Courts rule on Google Suggest

Versace succeeds in Israel

Foreign advertising in Turkey

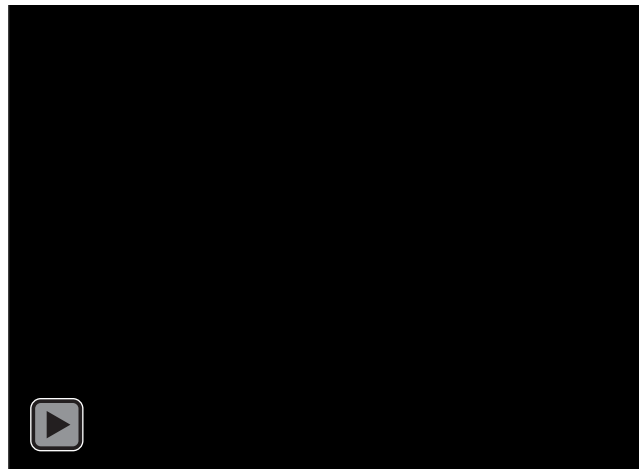
Karen Percival of Nestlé took part in a panel looking at what is acceptable in food and health claims.



Delegates took to the dance floor to enjoy a band after the Gala Dinner on Thursday night.



Publications and Website Team Chair, Hanne Weywardt of MAQS Law Firm, gave delegates a guided tour of the new **MARQUES** website.



## New online

The Class 46 blog is now part of the **MARQUES** website. Log on for all the latest trade mark-related news and comment.

The blog also includes daily reports from the **MARQUES** annual conference.

Recently posted in the Trade Mark Law and Practice Team's section of the website is an article by Team member Markus R Frick and Lucas M David of Walder Wyss & Partners Ltd on third-party use of trade marks in Switzerland.

The article looks at surnames, generic use, comparative advertising, internet use and other areas and asks which uses can be stopped by trade mark owners, and which cannot.

# MARQUES

Annual Conference

Conference Photos

GeoNews Latest

 GI reforms in Argentina

Courts rule on Google Suggest

Versace succeeds in Israel

Foreign advertising in Turkey

## Moskovskaya decision overturned

**Paul Reeskamp of Allen & Overy provides the regular report from the MARQUES GI Team.**



On 29th April 2009, the United States Court of Appeals for the Federal Circuit (CAFC) overturned a decision by the Trademark Trial and Appeal Board of the USPTO refusing registration of the mark *Moskovskaya* for vodka, in an appeal by the applicant, Spirits International NV.

The Board held that the meaning of the term *Moskovskaya* ("of or from Moscow") would be understood by "at least one significant group of 'ordinary American purchasers'" who the Board found would be deceived if such vodka was not manufactured, produced or sold in Moscow.

In short, the CAFC held that the Board should have considered whether Russian speakers were a substantial portion of the intended audience.

The CAFC held that only 0.25 percent of the US population speaks Russian and that this was not a substantial portion,

unless Russian speakers formed a greater percentage of vodka consumers, and combined with some non-Russian speakers who understand the mark's reference to Moscow, would form a substantial portion of the intended audience. It is now up to the Board to make this assessment.

**Read the decision here:**  
<http://www.cafc.uscourts.gov/opinions/08-1369.pdf>

**By Virginia Taylor, Partner, Kilpatrick Stockton**

### Opinion in *Salami Felino* case

On 7th May 2009 ECJ Advocate General Eleanor Sharpston delivered her opinion in the *Severi v Regione Emilia-Romagna* case (C-446/07). She advised that a pending registration process of a protected geographical indication (PGI) or protected designation of origin (PDO) does not imply that a name is generic within the meaning of the PGI Regulation.



Such a conclusion is justified only if an application for protection of the name has been rejected by the European Commission on the ground that the name has become generic.

Second, she held that the name of a food product that is evocative of a place, but not registered as a PGI, may legitimately be used provided that the name is not used in a way which is likely to mislead the consumer.

In assessing whether that is the case, national jurisdictions may have regard to the length of time during which the name has been used. The good faith of the producer is, however, irrelevant.

Her opinion came in response to questions asked by the Court of Modena after a local sausage producer in Modena sought to overturn an administrative fine, claiming the used name was generic and had been used for a substantial number of years and in good faith outside the municipality of Felino, including in respect of a collective trade mark.

The fine was imposed by the Emilia-Romagna region on the basis that the name *Salame tipo Felino* misled consumers, since the sausages were produced in Modena. Relevant is that the term *Salame Felino* was neither registered as a PDO nor as a PGI, but an application was pending.

Continued

[Annual Conference](#)
[Conference Photos](#)
[GeoNews Latest](#)

[GI reforms in Argentina](#)
[Courts rule on Google Suggest](#)
[Versace succeeds in Israel](#)
[Foreign advertising in Turkey](#)

## Salami Felino case continued

[Read the decision, Click here.](#)

### Other recent developments

On 28th May 2009 the European Commission published a Communication relating to the debate on the quality of agricultural products through a Green Paper. The Commission proposed to create a unique register for all geographical indications, while preserving the specifics of each system. Legislative proposals on this subject are expected in 2010.

Pursuant to this Communication, Insight Consulting and Connor & Company organized a debate on 9th June 2009, on the ex officio protection of geographical indications in the European Union.

This debate allowed the stakeholders in the GI sector to discuss with the representatives of the European Commission and of national administrations how the new provision on ex officio protection will be implemented in practice.

## New GI regulation in Argentina

By Mercedes Bullrich of Mitrani, Caballero, Rosso Alba, Francia, Ojam & Ruiz Moreno

A new regulation, Decree No 556/2009, was recently issued in Argentina to complete the legal framework on protection of geographical indications and appellations of origin.

It became effective on 18th May 2009.

This regulation supplements the Rules on Geographical Indications and Appellations of Origin of Agricultural Products and Foodstuffs, as established in Laws Nos 25,380 and 25,966.



The main provisions of this decree are:

- It sets up a GI registry for agricultural products and foodstuffs.
- It puts into effect registration and opposition procedures for local and foreign GI applications.
- It regulates a cooperation agreement between the GI registry for agricultural products and foodstuffs and the Argentine Trademark Office (INPI).

In an evolving food market, this new regulation is an important step towards protecting quality agricultural and food production according to international standards.

Note that wines and some spirits are not affected by this decree, since they have special protection in Law No 25,163 on Wines and Spirits of Wine Origin and its regulatory Decree No 57/2004.

Annual  
ConferenceConference  
PhotosGeoNews  
LatestGI reforms  
in ArgentinaCourts rule on  
Google SuggestVersace succeeds  
in IsraelForeign advertising  
in Turkey

## Google suggest decisions in conflict

The recently launched Google suggest tool has led to two decisions issued by the French courts, as Jean-Philippe Bresson and Franck Soutoul of INLEX IP Expertise explain. But the two decisions took opposite positions despite the same circumstances.



On 7th May 2009, the Paris Court of First Instance found Google liable on the basis of a fault.

Direct Energie complained that a Google search relating to it generated "direct energie arnaque" ("direct energy rip-off") as the first suggestion.

It was requested that the Court order Google to delete the wording "arnaque" ("rip-off") from the suggestions when "Direct Energie" was typed by internet users.

Google raised arguments already used in the proceedings involving its AdWords system. Google suggest was presented as "a statistical,

automatic and objective function of the search engine" so that Google's liability could not be sought as there was no intervention from its side on the suggestions displayed. Google also argued freedom of speech and right of information.



The suggested results were presented as legitimate and useful for everyone as they objectively reflected the most frequent searches performed by internet users.

The Court said the expression "direct energie arnaque" created suspicion of the plaintiff and was not acceptable considering that "arnaque" was displayed as not the most frequent word entered by internet users in relation to the plaintiff.

The plaintiff's claim was also regarded as not being in breach of freedom of speech as there was no general request for a deletion of the word "arnaque" but only a specific suppression in relation to the plaintiff's name.

In the other case, the Paris Trade Court ruled on 10th July 2009 that the suggested result "CNFDI arnaque" ("CNFDI rip-off") displayed while searching for the plaintiff's name on Google could not be considered as an affront under the law of 29th July 1881 concerning press freedom. The Court here refused to remove the suggestion. Google similarly raised the automatic function of the search engine so as to exclude its liability. It additionally argued that there was no affront because there was no "guilty intent".

For the Court, Google still had the suggestions tool under control. The management of the corresponding database remained in its hands as it voluntarily excluded for instance pornographic terms or words inviting violence and expressly invited internet users to report queries which should not be suggested. The injurious word "arnaque" added to the plaintiff's name was not however regarded in itself as an affront. This suggestion relied on evidenced and real results of past internet searches. It was then upheld as a reliable support for the broadcast of freedom of thought and information.

These decisions are the early efforts to judge the liability of Google's suggest tool, and more cases are expected, which should lead to further guidance.

Annual  
Conference

Conference  
Photos

GeoNews  
Latest



GI reforms  
in Argentina

Courts rule on  
Google Suggest

Versace succeeds  
in Israel

Foreign advertising  
in Turkey

## Versace mark cancelled in Israel

Italian fashion company Gianni Versace SpA has won its decade-long legal battle against an Israeli company that has been using the trade mark Versace since 1983.

Miriam Hackmey of Glusman Shem-Tov Chowers Broid & Co reports.



Gianni Versace started legal proceedings against the Israeli company, Versace 83 Ltd, in 2000 both in the courts (requesting damages and a permanent injunction) and before the Trade Marks Registrar (in a series of cancellation actions). The Tel Aviv District Court, in a precedential ruling, ordered the Israeli company to permanently cease use of the trade mark Versace in both Latin and Hebrew letters, and also prohibited the Israeli company from using the trade mark Versace as part of its company or domain names.

The Court further ruled that the Israeli company must refrain from using the Medusa head design and the design known as the Greek key frame.

The Israeli company has been using the trade mark Versace in Israel for over 20 years in its chain of Versace stores, in connection with men's clothing and various accessories. In 1989, following the withdrawal of the oppositions filed by the Italian company (for reasons which remain unclear), Versace 83 succeeded in obtaining trade mark registrations in class 25 for the trade mark Versace.

Despite the fact that the Italian company withdrew its oppositions at the time, the Israeli Trademarks Registrar cancelled the Israeli company's trade mark registrations for Versace in June 2008.

The main grounds for cancelling the registrations were that the marks were selected, registered and used in bad faith.



Versace

The Tel-Aviv District Court has now ruled that the Israeli company adopted the trade mark Versace because it is an international brand, very well known in Israel.

The Court recognized the Italian company's extensive goodwill and reputation worldwide (including in Israel) and consequently acknowledged that the trade marks Versace, and the two designs are all famous trade marks owned by Gianni Versace SpA.

The Court concluded that a severe and clear-cut remedy should be awarded and also stated that the Italian fashion company suffered significant losses as a result of the infringing activities.

The monetary part of the claim will be heard in the second phase of the case, which will start soon.

The Court rejected the arguments of acquiescence, waiver of rights and laches, which were the main arguments of the defence.

Glusman Shem-Tov Chowers Broid & Co represented Gianni Versace SpA in this case.

Annual  
ConferenceConference  
PhotosGeoNews  
LatestGI reforms  
in ArgentinaCourts rule on  
Google SuggestVersace succeeds  
in IsraelForeign advertising  
in Turkey

## New Turkish regulation on foreign-language advertising

**Uğur Aktekin and Deniz Merve Ersoy Pınar of Mehmet Gün & Partners discuss the controversial issue of advertising in languages other than Turkish.**



Broadcasting in ethnic languages, foreign languages or dialects has been a controversial issue in Turkey for many years.



Recently, the Turkish Radio and Television Institution (TRT), which is Turkey's state public broadcaster, launched a new TV channel broadcasting in Kurdish and is preparing to launch a second one which will broadcast in Arabic.

With the channels broadcasting in different languages and dialects, the language of advertisements became an ambiguous issue.

On 31st January 2009, a new Regulation amending the TRT Advertising Regulation dated 17th April 1993 was published in the Official Gazette and came into force on the same date.

In line with this new Regulation, the following provision has been added to Article 5 of the TRT Advertising Regulation: "Channels broadcasting in different languages or dialects may also place ads in these languages or dialects. These types of ads may run only on the channels to which they belong."

### "Using foreign languages in advertisements is still a debatable issue in Turkey"

On 26th August, the TRT Advertising Regulation was abrogated and a new TRT Advertising Regulation came into force. The provision regarding the language of advertisements has been kept in Article 7/1 of the new Regulation.

This Regulation regulates only the broadcasts of TRT channels and not privately owned channels.

Article 7/1 gives permission for advertisements in foreign languages only on the channels that broadcast in the relevant foreign language. Other channels cannot run ads in foreign languages.

Using foreign languages in advertisements is still a debatable issue in Turkey.

**Some people in the advertising industry think that broadcasting advertisements in foreign languages may be accepted as irritating and indecent in Turkey and may cause loss of a part of consumers or even affect the cultural identity of the society.**

On the other hand, a majority of the people in the industry are of the opinion that since these ads will be broadcast only in the channels broadcasting in foreign languages this should not be a problem.

Nevertheless, it is generally believed that this Regulation will bring a new momentum to the advertising industry and the level of recognition of brands will increase throughout the country.