

# Dot-eu advice for MARQUES members

**Nick Wood, managing director of Com Laude in London, reviews the first two months of the new .eu domain and highlights some lessons for brand owners.**

It is now three months since Phase One of the Sunrise period for the new .eu domain name launched for public bodies and the owners or licensees of registered trade marks. Already over 3,000 names have been activated and are in daily use for email and web sites.

Some 180,000 applications were made during the Phase One period. Following the launch of the Phase Two period on 7th February, a total of some 308,000 applications have been made for 223,000 separate terms, broken down as follows:

Geographical indications or denominations of origin	1,407
Public bodies	20,069
Community or international trade marks	38,968
National trade marks	137,668
Unregistered trade marks	6,401
Company names/business identifiers	84,298
Literary and artistic works	2,290
Other	13,229

An analysis of the country of origin of applications shows that Germany is way ahead of the rest of Europe with more than 35% of the market share.

Germany	28.8%
Netherlands	16.5%
France	11.0%
United Kingdom	9.1%
Italy	6.0%
Belgium	5.3%
Sweden	4.2%
Denmark	3.1%
Czech Republic	2.9%
Austria	2.8%

Given this scale of activity, it is appropriate for MARQUES members to consider a number of issues at this time:

## Sunrise Phase Two

Sunrise Phase Two started at 10am on 7th February 2006 and is designed for the owners (not licensees) of prior rights protected in the country of residence of the applicant, including registered and unregistered trade marks, company and trade names, business identifiers and the distinctive titles of protected literary and artistic works. Although the application process is similar to Phase One, featuring multiple competing accredited registrars racing to be first for a term, the validation process is much more complicated.

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**“Even if your application is second or third in line for a name, it is still worthwhile sending in your evidence.”**

Generally, applications must be supported both by proof of public use such as sales figures, copies of advertising or promotional materials and an affidavit by a qualified legal practitioner stating:

- that the type of prior right claimed by the applicant is protected in the home country of the applicant;
- that the prior right meets all of the conditions required for such protection (for example, under the laws of passing off in the UK);
- that the documentary proof provided in support of the affidavit clearly indicates the existence of the prior right in the complete term applied for.

For more detailed information on your jurisdiction and the prior rights that are acceptable, refer to the .EU Sunrise rules, Chapter V, Sections 12 to 18 available from the EURid website at <http://www.eurid.eu/en/registrant/launch> as listed under “Sunrise Rules” and “Annex One, Prior Rights – Country Overview”.

### **The validation process: eliminate common mistakes**

It is vital that information in support of each application demonstrating the applicant's ownership of a valid right is received by the validation agents, PricewaterhouseCoopers, within 40 days of the date of application. Even if your application is second or third in line for a name, it is still worthwhile sending in your evidence. This is because a very high number of applications have been incorrectly

filed or are based upon a right that will not stand up to scrutiny.

PwC have a team of 60 people validating applications. Currently they are each averaging about 100 applications per day. If each validator works a seven-hour day, that's just over four minutes per application – sufficient only for a *prima facie* review of the evidence before them but not long enough (as PwC have stated all along) to recheck the information.

It is probably wise under these conditions to supply a small amount of good quality supporting information rather than a large quantity of poor quality data.

Although it is rumoured that EURid are considering a request from PwC to allow the validators some discretion over minor errors that do not fundamentally negate an application, it is important that **MARQUES** members recheck their supporting evidence to meet five key criteria:

1. Does the domain applied for exactly match the “complete name” as exhibited in the documentary evidence?
2. Does the name of the owner of the trade mark as exhibited on the trade mark or

prior right exactly match the name of the applicant for the domain name?

3. Does the language of the documentary evidence match the official language selected by the applicant? If not, it must be accompanied by a certified translation.
4. If you are applying on the basis of a device mark, is the word element predominant? Can it be clearly separated from the device element? Is the general impression of the word apparent without any reasonable possibility of a misreading of the characters? If you hesitate in answering “yes” to any of these questions, your application will most probably be rejected.
5. Do you or does the applicant meet the European Community residency requirements? If you are applying through a licensee, does the licensee meet the European residency requirements?

#### **Weblink**

**More information is available from:**  
[www.eurid.eu](http://www.eurid.eu)

*Nick Wood is a **MARQUES** Council Member and managing director of Com Laude in London.*

Days before the launch of Phase Two of the Sunrise, EURid announced a reversal in its policy on trade mark licences.

In December, EURid had said in a newsletter to registrars: “Licensees of trade marks can only apply for a .eu domain name under Sunrise I, whereas holders of trade marks can do so under Sunrise I and II.”

But, in a clarification published on 1st February, the registry said: “EURid has asked legal advice and has decided to allow anyone that was eligible during Sunrise I also to apply during Sunrise II.” This means that licence holders can apply during Sunrise II as well as Sunrise I.

EURid claims that this clarifies the position that has always existed – although some trade mark owners were forced to take steps (such as filing Benelux registrations and setting up European licensees) during Phase 1 in the belief that they would not be able to apply under Phase 2.

# **SAVE THE DATE!**

## **20th MARQUES Annual Conference Hilton Malta, Portomaso, Malta – 12th-15th September 2006**

**Full details available soon.**

# Yellow Pages wins... and loses

Occasionally, a judicial ruling has all the hallmarks of intellectual property law. Take, for example, the case that was played out in the Netherlands last year between the Dutch version of the Yellow Pages, De Gouden Gids, and I-Local, a new competitor. Bas Kist reports.

Just over a year ago, the Yellow Pages launched a new advertising campaign which was promoted by the well-known Dutch actress Katja Schuurman. Ms Schuurman duly appeared on billboards, on the sides of buses and trams, in commercials and on the Yellow Pages itself, dressed in a yellow outfit made of pages from the popular directory and always against the company's familiar yellow background.

## Parody using a look-alike

Just over six months later, when the Yellow Pages campaign was well under way in the Netherlands, rival company I-Local launched a spin-off campaign parodying the original. This showed a woman from behind who looked remarkably like Katja Schuurman. In this version, however, the girl was standing against a yellow background in an outfit made out of bank notes. The accompanying text read: "The downside of advertising in the Pages."

## Court case

Yellow Pages objected to the parody and brought a case against I-Local. It claimed that not only did the rival campaign infringe its trade mark rights in the colour yellow, but it also infringed its copyright in the advertising campaign itself. Yellow Pages also maintained that I-Local had infringed Katja Schuurman's

portrait rights and that the campaign was guilty of unlawful comparative advertising.

The ruling issued by the president of the district court in Breda last year involved a detailed examination of each of these complaints.

## No trade mark infringement

The court straightaway overturned two of Yellow Pages three colour mark registration claims, ruling that it had no PMS or Pantone designation and that the claims were therefore invalid.

A more recent colour mark registration did have a PMS/Pantone designation, but could not, according to the court, lead to trade mark infringement because the shade of yellow used was slightly different to that used by I-Local. One important factor in this argument was that in a search carried out on Google, the keyword "Yellow Pages" brought up a range of different companies, all of which were using the colour yellow. The colour yellow might therefore even be regarded as no more than "purely descriptive" of the service provided by the Yellow Pages, the court concluded.

## No copyright on style

The court also rejected Yellow Pages' claim regarding the need to protect the style of the

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**“In a search carried out on Google, the keyword “Yellow Pages” brought up a range of different companies.”**

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advertisement, maintaining that "style" was not protected by copyright.

## Portrait rights

The court did, however, uphold the claim over portrait rights, on the grounds that a ruling issued in the Netherlands some years before stated that if an individual was recognisable by a particular physical stance or attitude, this could constitute a portrait even if the face was not visible.

## No lawful parody

The court concluded that I-Local's advertising campaign was not a lawful parody since a lawful parody involves no risk of confusion and/or competitive motives. In this case, however, there was a risk of confusion, and competitive commercial gain was the key motive behind the I-Local campaign.

## Comparative advertising

Finally, the court concluded that the campaign was an example of unlawful comparative advertising in that it incorrectly gave the impression that Yellow Pages was more expensive to advertise in than I-Local.

## Win or lose?

So although the court ruled that I-Local had to withdraw its campaign and provide rectification, it is doubtful whether Yellow Pages was entirely happy with the outcome. After all, the court overturned one of the key "assets" of the Yellow Pages brand, namely its claim to the colour yellow. This could open the way to a whole raft of other "yellow page" guides.

*Bas Kist is a partner of Shield Mark Amsterdam and a member of the MARQUES Publications and Website Team.*



# Preventing counterfeits in the Baltic Sea area

A year full of sporting activity in Europe promises much excitement for spectators, but also increases the risk of counterfeit imports for brand owners. Christina Berggren, MAQS Law Firm, examines what border protection is in place in three EU member states.

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**“In Estonia the number of confiscated products increased by an impressive 281% from 2003 to 2004.”**

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During 2006 we will all have the possibility of enjoying top class sporting events within the EU, starting with the Winter Olympic Games in Italy in February, continuing with the FIFA World Cup in Germany in June and the European Athletics Championships in Gothenburg in August. These championships will be challenging for all participants but will also constitute a challenge for everyone involved in the prevention of counterfeiting and piracy. The sporting events are expected to result in large quantities of counterfeit and pirated goods being put on the market all over the world but not least within the EU.

## Customs compared

Customs is one of the first hurdles the counterfeiters have to pass. For this article, we have compared the Customs Departments' working methods regarding counterfeit products in Sweden, Denmark and Estonia. Sweden and Estonia both have borders with non-EU countries, Norway and Russia. Estonia is a new member of the EU, unlike Denmark and Sweden. All countries have implemented the applicable EU rules. On an EU level, new methods to promote member states' Customs work are being pursued. However, trade mark owners as well as local Customs, police, prosecutors and courts still have a major task to try and prevent counterfeited goods from entering the EU.

The facts behind the counterfeit business are commonly known, but are still worth

repeating. Counterfeiting has an estimated value of 5% to 10% of worldwide trade. Counterfeiting leads to a reduction in profit for companies and loss of earnings and diminished number of jobs at the national level. Some counterfeit products cause injury, damage or even death. Furthermore, counterfeiting is known to support other illegal business, harming countries and societies.

In all three countries, the amount of goods confiscated by national Customs increased significantly between 2003 and 2004.

## New task force in Denmark

Due to the implementation of the EU regulation in Denmark, a new task force to control and act against counterfeiting was started in 2005. The primary goal is to confiscate as many counterfeit products as possible. The Danish task force aims to cooperate on the EU level as well as with the business community and other public authorities in the fight against counterfeiting.

The Swedish Customs have appointed a number of specialists, who focus on the problem of counterfeit products. The number of actions taken by the Swedish Customs increased by 18% between 2003 and 2004. Moreover, starting from March 2006, three groups will concentrate on the confiscation of counterfeit goods.

In Estonia the number of confiscated products increased by an impressive 281% from 2003 to 2004. Customs are content with the result of this work and the implementation of the EU rules. No specific further actions will therefore be taken to prevent counterfeiting in the near future.

Our contact with Customs departments at the national level has been very positive. In all countries, it is clear that authorities

are now taking these matters seriously. We believe that it is of utmost importance that authorities have appointed specialists. This gives us as local representatives a speaking partner. With education, information and good contacts with the specialists, the trade mark owners' opportunities to fight counterfeits and piracy are greatly enhanced. Without specialists the effects of counterfeiting may be seriously underestimated. We also believe that police and local prosecutors most focus even more on the worldwide problem of counterfeiting and piracy at the national level.

We are hoping for successful championships, for the athletes and the organizers, but perhaps even more for all those active in the fight against counterfeiting and piracy. Faster, higher, stronger!

*Christina Berggren, MAQS Law Firm Sweden, is a MARQUES Newsletter correspondent.*

*Hanne Weywardt, MAQS Law Firm Denmark, and Karolina Ullman, MAQS Law Firm Estonia, assisted with this article.*

*More information on Customs is available from the World Customs Organisation: <http://www.wcoomd.org>*

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**“With education, information and good contacts with the specialists, the trade mark owners' opportunities to fight counterfeits and piracy are greatly enhanced.”**

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# Good news for rights owners in Romania

Andrew Ratza analyses the new Romanian law regarding the enforcement of IP rights during Customs procedures. Since the communist period, Romania has been one of the territories counterfeiters use to pass goods from the East to the West. The very low prices of counterfeit goods, the unaware and uneducated Romanian population and the 1990s were not very good friends for IP rights owners.

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“*The Law is even more in favour of the IP right holder as it introduces a procedure for destroying the counterfeit goods without a court decision.*”

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It was only in 2000 that the Romanian Parliament passed the first law regarding the enforcement of intellectual property rights during Customs procedures. A few years later, in 2005, the fairly well-trained Customs workers were able to block most of the counterfeited merchandise that was trying to enter EU territory through Romania. Some of the most famous trade marks that are constantly infringed by large imports and exports of counterfeit goods include: adidas, Nike, Puma, Ferrari, Christian Dior, Dolce & Gabbana, Tefal (kitchenware), Marlboro (gear and clothing), Formula 1 (promotional goods and clothing), Louis Vuitton and Barbie.

But 2006 brings some even better news for all IP rights holders: a new law has been adopted by the Romanian Parliament, effective from 3rd February. This short article will highlight the most important additions and modifications brought by this new law to the procedure as well as its advantages.

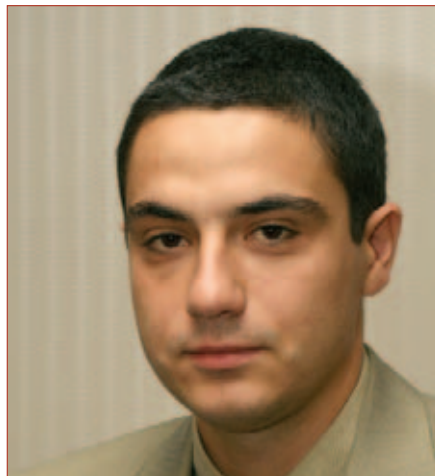
## Official fees abolished

The first and most important change is that the official fees have been eliminated. It is now completely free of charge to file an

application for the protection of IP rights with the Romanian Customs Authority (except for attorney fees). Another important issue is that the guarantee equal to the value of the seized goods that was supposed to be deposited under the provisions of the previous law has been eliminated as well. However, the holder of the IP rights has to make a statement that it will cover any damages caused to the transporter and/or owner of the goods if the court's decision is in favour of the latter, as well as all storage, transportation and other related costs. IP rights holders who have filed an application for Customs protection under the previous law must make this statement and file it with the Customs Authority within 10 working days from 3rd February 2006.

## Destruction procedure

And last but not least, the law is even more in favour of the IP right, holder as it introduces a procedure for destroying the counterfeit goods without a court decision.



As such, after the seizure of the suspected goods, the Customs Authority sends notifications to both the holder and the owner/transporter of the blocked goods and, if the latter does not respond to this notification within 10 days, the holder of the infringed IP rights can successfully demand the destruction of the respective goods.

Other important provisions are:

- The Law applies to all kind of IP rights, including patents, plant varieties, supplementary protection certificates and copyrights as well as trade marks and industrial designs.
- The Law clearly states that its provisions do not apply to parallel imports.
- The renewal of the application can be requested without submitting the initial documents all over again unless they have changed.
- If the IP right that the Customs application was based on has expired, the holder has 15 days to notify the Customs Authority accordingly. Otherwise, the holder may be subjected to a fine between €1000 and €3000.

In conclusion, the new law is a step further towards harmonization with EU laws concerning the enforcement of IP rights. It is expected that more and more IP rights holders will use this procedure, especially in the light of the efficiency acquired by the Romanian Customs Authority.

Andrew Ratza is a partner of Ratza & Ratza and a **MARQUES** correspondent

# Using trade marks in comparative advertising in Latvia

Valters Gencs, of the Law Firm of Valters Gencs, in Riga, Latvia, explains how brand owners can prevent comparative advertising in Latvia, following the implementation of the European directive.



The use of trade marks in comparative advertising is regulated by the Law On Trade Marks and Geographical Indications as well as the Advertising Law of 2000. The Advertising Law transposes the Directive on comparative advertising 1997/55/EC to Latvia. The Competition Council is the main institution supervising comparative advertising, along with the Consumer Rights Protection Centre. If consumers are misled, the Centre can adopt a decision regarding incorrect comparative advertising. The competence of the Competition Council regarding the use of trade marks in comparative advertising does not extend to disputes related to the trade mark's use outside of advertising.

## The use of trade marks in advertising

The Advertising Law, like the Directive, prohibits unfair use of the trade mark of a competitor, as well as the discrediting or denigration of the trade marks, trade names, other distinguishing marks, goods, services, activities or circumstances of a competitor.

In addition the Advertising Law prohibits the exploitation of the name, surname, name (firm name) or other identifying designation (including a trade mark) of another entrepreneur without the consent of the entrepreneur. However this prohibition is not applicable to comparative advertising if it corresponds to the requirements provided. Therefore, if no comparison is used in the advertising, then using a trade mark belonging to another entrepreneur without his consent is prohibited.



## Notion of comparative advertising

It will be noted that a difference exists between the notion of comparative advertising in the Directive and that in the Advertising Law. In the Directive, comparative advertising is defined as any advertising that explicitly or by implication identifies a competitor or goods or services offered by a competitor, but under the Advertising Law comparative advertising is any advertising in which comparison is used which directly or indirectly indicates a competitor or goods or services offered by a competitor.

In other words, the notion of comparative advertising in the Advertising Law is narrower than that in the Directive, because in Latvia only advertising with a comparison is recognized as comparative advertising. This approach is based on recital 15 of the preamble to the Directive where it is prescribed that use of another's trade mark, trade name or other distinguishing marks does not breach this exclusive right in cases where it complies with the conditions laid down in this Directive, the intended target being solely to distinguish between them and thus to highlight differences objectively. We may therefore infer that a trade mark may be used solely for the purposes of distinguishing, that is only in comparison to highlight differences objectively – as was mentioned in the *Toshiba Europe* case (C-112/99 paragraph 81).

As the notion of comparative advertising in the Advertising Law of Latvia is narrower than that in the Directive, advertisers are not allowed to use a trade mark if a clear comparison is not used in the advertising.

However it must be considered that Recital 6 of the preamble to the Directive prescribes that the aim of the Directive is to provide a broad concept of comparative advertising to cover all means of comparative advertising. For this reason, the definition of comparative advertising in national law had to be applied taking into consideration the Directive and had to be as broad as possible as prescribed in the *Toshiba Europe* case (paragraph 37). In this case, it is said that the conditions required of comparative advertising must be interpreted in the sense most favourable to it.

## Ryanair's case

A significant case regarding the application of the definition of comparative advertising was recently decided by the Competition Council. This concerned advertising for the airline Ryanair Ltd, where the registered trade mark AIR BALTIC belonging to the Latvian national airline Air Baltic Corporation was used.

In the advertising, a pilot recruitment day was announced and advertising was targeted specifically at pilots from Air Baltic. Also slogans such as "Ryanair Ltd is the Number 1 European low fare airline" and "Number 1 airline by income in Europe" were used. In its decision, the Competition Council admitted that the primary target audience of the advertising is pilots and also that the information in the advertising is not such as could discredit or denigrate competitors. It also found that the advertising may not create confusion between the advertiser and competitor and finally decided that as the advertising did not include a comparison, it cannot be considered to be comparative advertising.

We may infer that if the Competition Council considered that this advertising includes indirect comparison as it uses the above-mentioned slogans and a trade mark of a competitor (even though the announcement of a recruitment day is targeted only at pilots and specifically pilots

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“A difference exists between the notion of comparative advertising in the Directive and that in the Advertising Law.”

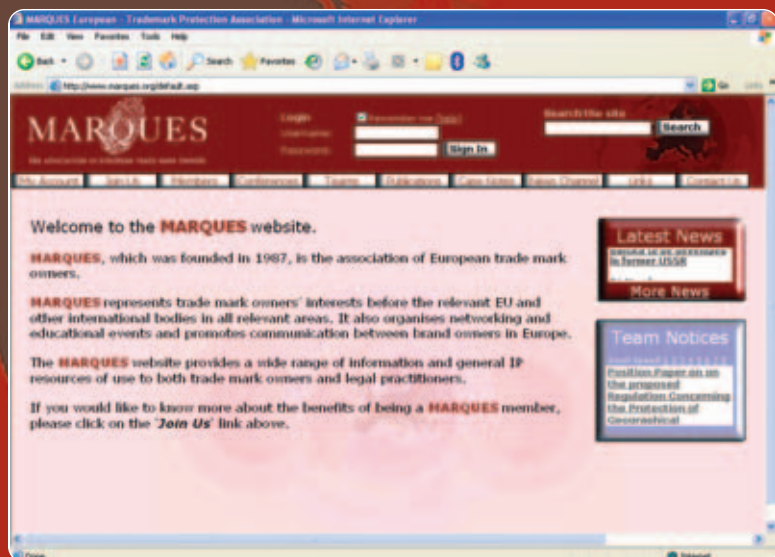
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It includes the latest rolling news on brand-related issues, case notes, news from MARQUES teams, details of activities, publications, conference booking facilities and much more.

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of Air Baltic) it had to consider that this advertising must be regarded as comparative advertising as it compares two employers and competitors. Ignoring these characteristics of comparative advertising, the Competition Council of Latvia concluded that Ryanair's advertising is contrary to fair practices in advertising and therefore unlawful.

The Competition Council needed to explain in broader terms why advertising using such slogans and a competitor's trade mark is not regarded as comparative advertising. With this decision, the Competition Council did not follow its established practice based on Recital 15 of the preamble of the Directive which says that if, in advertising, the advertiser himself or his goods and services are praised without using any kind of distinguishing marks or indications of a competitor, such advertising may not be considered to be comparative advertising. But the advertising of Ryanair contained visible indications of its competitor Air Baltic.

The only explanation for this decision is that the Competition Council considered that the primary intention of the advertising was to announce a job opportunity, and that no goods or services were compared in the advertising. For this reason it may not be regarded as comparative, even though two competitors as employers are compared in it. But such an application of the Advertising Law is too narrow and does not correspond to the aim of the Directive. However if the Competition Council recognizes this advertising as comparative, its compliance with the requirements for comparative advertising still needs to be examined.

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*“It is mostly indirect comparison, without identifying competitors, that is used in Latvia.”*

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## Court approach

Before Ryanair's case, there was a case regarding use of a design model of a bottle of beer and denigration of a competitor's goods in comparative advertising. In this case, a beer and a cider were compared in two separate advertisements distributed by two separate advertising companies for the benefit of one alcoholic beverage (cider) producer. The Supreme Court decided that the definition of comparative advertising in the Advertising Law must be interpreted more broadly and abolished the decision of the Competition Council which ruled that there was no violation of the Advertising Law in the above-mentioned two advertisements.

Another case concerned the comparison of tariffs of mobile and fixed telephone conversation service. TELE 2, the provider of mobile telephone services, complained about the advertising of Lattelekom, a provider of fixed telephone services. Lattelekom's advertising said it was silly to ride on a cow if a horse is available. The advertisement showed a man trying to ride a cow with a sunflower in his hand: the sunflower was a registered trade mark for TELE 2 and the word "tele" in Latvian means "heifer". TELE 2 argued that this advertising denigrated the trade mark of TELE 2 as a

competitor. The argument that both services are not comparable was also used. The Competition Council decided that as the advertising did not compare services intended for the same purpose and as it discredited or denigrated the trade mark, trade name, or other distinguishing marks of a competitor, distribution of this advertising was prohibited and Lattelekom was required to withdraw the advertising. Regrettably in this case reasoning was fully devoted to the question of whether these services are comparable or not, but evaluation of the denigration of trade mark was not carried out.

## Narrow interpretation

Understanding of the use of competitors' trade marks in advertising in Latvia generally complies with the requirements of the Directive and mostly is properly applied by the institutions and courts. However understanding of advertising including comparative advertising is still disputable and awareness of it needs to grow in future together with the further development of competition in Latvia.

Now it is mostly indirect comparison, without identifying competitors, that is used in Latvia. There were only a few cases decided by Competition Council that featured direct comparison and the use of trade marks.

However it seems that the Competition Council is interpreting the notion of comparative advertising too narrowly, contrary to the aim of the Directive, which is to cover all modes of comparative advertising, and this must be improved by the Competition Council in future.

*Valter Gencs is a partner of the law firm Valter Gencs in Riga.*



# Enforcement progress in India in 2005

Last year saw significant trade mark litigation in India.

Manisha Singh of Lex Orbis reviews some of the most important cases.



The Indian courts decided important infringement suits involving top IT brand names last year. Infosys Technologies and Intel Corporation won legal battles against the infringers of their well-known trade marks INFOSYS and INTEL respectively.

In *Infosys Technologies Ltd v Access Infosys & Another* 2005 (31) PTC 378(Del) Infosys sought a permanent injunction against Access Infosys to restrain the latter from using its reputed trade mark INFOSYS as a part of its corporate name.

The verdict of the court was in favour of Infosys and a permanent injunction was passed preventing Access Infosys from using INFOSYS as a part of its corporate name or on its website or advertisements or other commercial operations in any other manner.

*Intel Corporation v Retd Admiral B.R. Vasant & Another* involved usurpation of the trade mark INTEL by an Indian company named Intel Soft. In this case, which extended over three years, the court proceeded ex parte and passed a permanent injunction against Intel Soft from using the trade mark INTEL or any other deceptively similar trade mark.

## Court awards deterrent damages

A good precedent for the grant of punitive damages was set by Delhi High Court in the case of *Time Incorporated v Lokesh Srivastava & Another* 2005 (30). This case gives a significant boost to the philosophy of deterring trade mark infringements and not just compensating the aggrieved party for the losses suffered.

In this case, Time Incorporated, the owner of the famous magazines TIME and TIME ASIA, filed a suit for infringement against one Lokesh Srivastava. The latter was printing, publishing and distributing for sale a

magazine styled as TIME ASIA SANSKARAN with the phrase "now in Hindi also a News Magazine of international standards". In this magazine, the infringer copied the font style and size identical to TIME's trade mark along with the red border appearing on the cover page of the Time magazine. Ruling in favour of Time, the court awarded damages to the tune of Rs5 lakh for loss of reputation and another sum of Rs5 lakh (US\$11,100) as deterrent damages against the infringer.

## Interim injunctions passed

Interim injunctions and other interlocutory relief are of the utmost importance in the enforcement of trade marks. If the proprietor of the trade mark is made to wait until the final decision of the suit, he/she will suffer irreparable injury both in terms of money and loss of reputation. Bearing this in mind and the time taken to conclude an infringement suit, the courts have been prompt in granting interim injunction and ex parte interim injunctions, wherever an appropriate case is made out.

In *Franco Indian Research Pvt Ltd v Unichem Laboratories* 2005 (30) PTC (BOM) the Court passed an interim injunction restraining Unichem Laboratories from using the trademark EVACAL owned by Franco Research Pvt Ltd. The interim relief was granted by the Court despite a delay of over one year in instituting the infringement suit on the part of Franco. In *Cisaco Technologies v Shrikant* 2005 (31) PTC 538 (Del), the Court granted an ex parte interim injunction preventing Shrikant from using the trade mark CISCO, as well as elaborate search and seizure orders and also directed a ban on the import of goods bearing the infringed trade mark.

“The courts were liberal in granting damages where the plaintiff specifically asked for it and also succeeded in establishing his case.”



“Infosys Technologies and Intel Corporation won legal battles against the infringers of their well-known trade marks.”

Generally, in granting ex parte interim injunctions, the courts have taken into account the nature and extent of injury caused to the plaintiff, the public interest involved, the time taken in filing the application and the knowledge of infringement on the part of the plaintiff. Delay defeated the plea for an ex parte injunction in the case of *Albatross Pharma v Cipla Ltd* 2005 (31) PTC 551 (Del).

## Cybersquatting

To prevent piracy of trade marks in the cyber world, the courts have resorted to regular trade mark jurisprudence and well-evolved principles of passing off in India. In *Tata Sons Limited and Another v Fashion ID Limited* [2005 (30) PTC 182 (Del)], the Court ordered the transfer of the domain name tatainfotecheducation.com to Tata Sons Ltd as the latter was the proprietor of the famous trade mark TATA INFOTECH. Further, use of the domain name by Fashion ID was causing deception among the Internet users and injury to the reputation of Tata Sons.

## Conclusion

The courts were liberal in granting damages where the plaintiff specifically asked for it and also succeeded in establishing his case. As interim relief is critical in infringement suits the courts have granted ad interim as well as ex parte interim injunctions in many infringement cases. The enforcement scenario is looking up with courts granting increased damages, deterrent damages, costs and other interim relief in a catena of infringement cases. On the whole, the year 2005 set positive precedents for the protection of trade marks in India.

Manisha Singh is a partner of Lex Orbis in Delhi.



# MARQUES teams meet at winter meeting

The **MARQUES** Council and teams met in Lisbon on 16th and 17th February to discuss the Association's activities and plan future strategies at the annual winter meeting.



David Stone introduces the new Designs Team

Some 60 **MARQUES** Council and team members attended the meeting. Team members met to discuss their particular areas of focus, and then reported back to the rest of the attendees.

The meeting provided an opportunity to see the wide range and large scale of activities that **MARQUES** has been involved with over the past year. Members of the Anti-Counterfeiting Team, for example, have been active with a number of international associations such as GBLAAC and the WCO as well as the European Commission. A sub-group of three members of the team is now focusing on trade mark infringement and internet auctions and is looking into working with eBay to address this problem.

It has been a busy year for the Cyberspace team, which has been monitoring the launch of the new .eu domain and the validation process. It is likely that the Team will be able to report on the first ADR decisions on .eu domains by the time of the **MARQUES**

Annual Conference in Malta. The Team is also beginning to look into the issues surrounding advertising on search engines, following cases involving Google in France and the US.

The Education Team has a broad agenda: one of its main achievements this year has been the compilation of a list of books that might be of interest to members. The list is on the **MARQUES** website and members can recommend new books or reviews. The team has also worked with WIPO on its Learning Programme.

Following the EC proposal on GI protection, the Geographical Indications Team is looking at coordinating a **MARQUES** response. Team members have also updated the landmark GI database launched last year, and it is now fully searchable. Further countries are set to be included later this year.

The IAM team has been focusing on UNCITRAL proposals on IP licences, and team chair Ben Goodger has attended meetings in Geneva and New York on that subject. The team is now looking at working with other organisations to address the IP issues raised by the proposals. It is also working on a set of 10 questions for CEOs of brand-owning companies.

The IP Marketing Team gave a lively presentation featuring real examples of controversial advertising – a subject which they are looking into with a view to preparing a presentation or workshop for a future **MARQUES** meeting. They will look into why certain adverts are banned in some countries and not others. The IP Outer Borders Team is also looking into some controversial areas, such as trade marks and religious symbols and product placement.

One of the largest teams is the Trade Mark Team, and its members



Chairman Tove Graulund with João Miranda de Sousa of OHIM and Antonio Campinos, President of the Administrative Council of INPI.



Ken Taylor illustrates how the membership team will balance priorities

have worked on various international issues, including producing a position paper on the Madrid Protocol and taking part in OHIM User Group Meetings. The Unfair Competition Team have compiled information from across Europe on unfair competition laws which will be checked and assembled later this year.

A new team has been launched to look into design issues. The team, led by David Stone of Howrey, already has some members and will contribute an article to the next **MARQUES** newsletter on recent Community design cases.

Representatives of the programming and promotion teams also provided updates on **MARQUES** plans for future activities. To liven things up towards the end of the morning, Ken Taylor of Marksmen demonstrated how the membership team will balance priorities in a performance that attracted a big round of applause.

The meeting also included a drinks reception followed by a Portuguese dinner, where the guest of honour was the Director of the Portuguese Patent and Trade Mark Office.

# What use is use?

Jeremy Phillips and Ilanah Simon

**Jeremy Phillips and Ilanah Simon consider what constitutes use of a Community trade mark, in the light of comments from OHIM's director of IP policy Vincent O'Reilly.**

The authors have discussed the importance of trade mark use previously in this column (see **MARQUES** Newsletter, Autumn 2004, Issue 80). In this issue we consider the scope of use necessary for a trade mark to be maintained in the light of comments made by Vincent O'Reilly, Director of IP Policy at OHIM.

Under Article 50(1)(a) of Regulation 40/94 (the Community Trade Mark Regulation), a Community trade mark is liable to be revoked where, within a continuous period of five years, it has not been put to genuine use in the Community. This begs the question: what counts as genuine use within the Community?

Thus far, the geographical scope of use has played an important role in defining "genuine use in the Community". The CFI in *HI WATT* established that genuine use in the Community means that "the mark must be present in a *substantial part of the territory* where it is protected" and that, within that territory, it must be used in accordance with the essential function of a trade mark, i.e. to distinguish the goods of one undertaking from those of other undertakings. Although this decision was delivered in the context of Article 43(2) CTMR (under which applicants for CTMs can require their opponents to show that they have put their CTMs to genuine use within the Community) it seems likely that the same standard applies in revocation proceedings since identical wording has been used in the two Articles.

There is little authority or guidance to date on what constitutes a substantial part of the Community. The term "substantial part" suggests that use in the entire Community will not be necessary but decisions by the OHIM tribunals have not provided a definitive ruling on where the use must take place in order to be considered sufficient to maintain the CTM. The OHIM website states: "A Community trade mark may be maintained in all the countries of the European Union by using it effectively and genuinely in a **single Member State**" (emphasis in the original – see Ten Good Reasons for Using the Community Trade Mark <http://oami.eu.int/en/mark/role/raisons.htm>).

In short, while we have a geographical test for genuine use, it may not be particularly onerous.

It is against this background that Mr O'Reilly made his comments about use for the purposes of revocation. At the 2005 ECTA Conference he said:

In framing the statement on the meaning of genuine use in the Community I would suggest, with the greatest of respect to the legislators, that the formulation is incorrect. The reference point should not be "any country" but instead "any market". My view is that genuine use cannot be properly assessed except in an economic context. If this is the case the focus must be on the relevant market. The boundaries of a market may or may not coincide with any country ("The evolution of the European system, have promises and compromises been kept? An administrative view" *ECTA Past, Present and the Future – the Development of Trade Marks, Designs and Related Rights in Europe*, proceedings of the 2005 ECTA Conference, London, 8-11 June 2005, available on CD-ROM).

He made similar comments at the at the International Trademark Association (INTA)

trade mark forum The Importance of Evidence and Other Burning Issues in Berlin on December 5.

At first sight, changing from use in "any country" to use in "any market" appears to require a significant change in position. However, a closer examination reveals that the current geographical-based use standard would automatically encompass use in any product or service-based market. Use in a single Member State appears to be all that is required to maintain a CTM. In almost every case, whenever a mark is used in a product market there would be use in at least one EU Member State. A possible exception would be where goods were offered for sale by internet from a location outside the EU and no or very few sales were made within the EU, but this would likely fail the genuine use standard on other grounds.

This position is contingent on the statement on the OHIM website about the necessary geographical scale of use being correct. If wider-scale use is required, use that is substantial in a single product market, but which is not geographically substantial, becomes a possibility. Until we have further guidance of what counts as genuine use of a CTM, it is impossible to appreciate fully the import of Mr O'Reilly's suggestion.



Jeremy Phillips



Ilanah Simon

# Meet the IP Marketing team

The **MARQUES** IP Marketing team analyses the legal and commercial issues associated with the use and exploitation of IP rights including portfolio management, advertising, marketing, brand creation, tarnishing and dilution, brand extension, co-branding, sponsorship, licensing, comparative advertising, trading standards, trade libel, brand creation and searching. We are delighted to introduce our commercially experienced team members who come from private practice and industry.



**Jane Collins**

Jane Collins graduated in law from Southampton University in 1976 and is a registered UK trade mark attorney. She spent a number of years in private practice and in-house with BatMark before joining Zeneca Agrochemicals in 1999 as Managing Trade Mark Attorney. When the crop protection businesses of AstraZeneca and Novartis were spun off and merged to form Syngenta in December 2000 she became Head of Trade Marks at Syngenta based in Basel, Switzerland. She joined the **MARQUES** Council in 1996.



**Kirsi Ekstrom**

Kirsi Ekstrom obtained her BSc in business administration in 1989 and after graduation worked at Keijo Heinonen Oy, a Finnish trade mark agency. In 1999 she started work as Trade Mark Specialist for TeliaSonera Oyj, the leading telecommunications operator in Finland.



**Nicholas Foot**

Nicholas graduated with a BA/LLB from the University of Auckland, New Zealand in 1991 and received an MA (Hon) in Spanish from the same university the following year. After completing his legal professionals course, he was admitted as a barrister and solicitor of the High Court of New Zealand in June 1991. Between June 1991 and January 1994, he worked as a refugee advocate before the New Zealand Refugee Status Appeals Authority and High Court of New Zealand. In February 1994, he joined AJ Park & Son (one of New Zealand's leading intellectual property law firms) where he advised on all aspects of trade mark and copyright law. Following his move to the UK in 1998, Nicholas was employed by Rouse & Co International in its trade mark department before joining the BBC's Corporate Legal & Intellectual Property Department. In 2004 Nicholas moved to Diageo plc.



**Mark Hodgkin**

Mark is a Senior Intellectual Property Counsel at Cadbury Schweppes plc, based in Bournville, England. Mark advises the Cadbury Schweppes Group Companies on all aspects of IP surrounding its confectionery and beverage brands, in particular trade marks, designs, copyright, licensing, advertising and promotions, and research & development work. Mark joined Cadbury in 2002 from the law firm, Eversheds, where he was an IP lawyer dealing with both contentious and non-contentious intellectual property matters, principally on trade marks, designs and copyright. Mark joined Eversheds in 1995, having completed his legal professional examinations. He has also obtained the Intellectual Property Diploma from Bristol University. Prior to becoming a lawyer, Mark worked for four years as a journalist after leaving York University in 1989 with a BA (Hons) in English.



**Panos Malamis**

After six years in the jewellery industry covering manufacturing, design and sales and after obtaining his MBA degree at the Rotterdam School of Management, Panos joined the marketing department of L'Oréal in Greece managing their hair dyes, hair care and skin lines. He then joined the marketing department of the Coca-Cola Company managing the Fanta, Sprite and Nestea Brands in Greece. Established in 1951, Malamis & Malamis is a firm that serves clients across the full spectrum of IP issues, from the creation of a brand to its commercialization and protection, with special emphasis on the maximization of its potential in the market.



**Claire Mounteney**

Claire advises on general trade mark prosecution matters as well as worldwide trade mark portfolio management programmes for major companies. A substantial part of Claire's practice consists of German corporate clients and associates and she corresponds in German on many trade mark cases. Claire graduated with an honours degree in international marketing and German from Greenwich University, London. As part of her degree, she studied business and marketing at Fachhochschule Rosenheim and spent a year working in the marketing services and product management departments of Schering AG in Berlin. Claire joined Marks & Clerk in September 1993 and became a partner in 2003. She is Chair of the **MARQUES** IP Marketing Team and has also been a member of the ITMA Training Committee. Claire is a member of ITMA and ECTA. In addition to being fluent in German, Claire has some knowledge of French and Spanish.



**Gabriela Reniero**

Born in England in 1970, Gabriela obtained a masters degree in law in Italy. She specialized in IP focusing in particular on trade marks. After gaining experience in the IP field, she is now a partner and managing director of the Italian company Dr Reniero & Associati, is active in the IP field as an Italian and European trade mark attorney, and co-operates with IP specialized solicitors and barristers as well as Italian and European patent attorneys associated with Dr Reniero & Associati.



**Tobias Cohen Jehoram**

Tobias graduated from Leyden University in 1992, after writing his thesis at the University of San Francisco. He joined the law firm of De Brauw Blackstone Westbroek that year, and he has been a partner since 2001. Tobias specialises in intellectual property law, and in particular trade mark and design law. His practice also extends to copyright, advertising and media law. In addition, Tobias is a Supreme Court litigator. He has been involved in most of the landmark IP cases decided by the Dutch Supreme Court in the past five years. He is the author of the Schuurman & Jordens book on TRIPs and often gives lectures on IP. Tobias is also a WIPO arbitrator under the ICANN rules and an arbitrator in .nl domain name disputes.



**Regina Quek Mei Lin**

Regina Quek is a Director of One Legal LLC. She has over 15 years of experience in IP practice and is a Registered Patent Agent in Singapore. She set up and headed the IP Department in her previous firm for more than seven years, until the end of March, 2005 when she established One Legal LLC. She is recommended by Euromoney Legal Media Group's Experts Guide as a leading trade mark and patent lawyer; she is listed in both An International Who's Who of Trade Mark and Patent Lawyers; and in AsiaLaw Leading Lawyers 2003-2005. Regina has given numerous talks/lectures on the various aspects of IP and has chaired and participated in various roundtables/forums. She is serving her third term as the President of AIPPI, Singapore.



# Write for the MARQUES Newsletter

All **MARQUES** members are welcome to submit articles for publication in the Newsletter. Articles should be submitted by email, and should be about 500 words in length. Relevant photographs and illustrations should also be submitted. **MARQUES** considers publishing articles on any topic that is of interest to members, in particular case reports, details of new legislation, government initiatives, deals, IP strategy and other trade mark-related developments.

If you would like to submit an article, please contact the editor ([editor@marques.org](mailto:editor@marques.org)) well in advance of the deadline, with details of the subject you propose to cover. You can also contact any of the country correspondents listed below.

The deadline for the next issue is 15th June 2006.

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