

NEWS

Domain Names: The New Generic Extension .XXX

The Sunrise period granted for trademark's holders to block non-authorized registration under the new extension .XXX for web sites dedicated to "adult" entertainment was closed on October 31, 2011.

From December 6, 2011, the new extension is now opened to all, but brand owners can still apply for non-resolving domain names corresponding to their brands, other names of legitimate interests (no trademark registration required) on a first-come first-served basis to block anyone from using the .XXX to create an adult website.

Domain Names: New Provisions For .fr Extension

From December 6, 2011, registrations of *.fr* domain names will be opened to all individuals or legal entities established in the EU, Norway, Gibraltar, Iceland, Liechtenstein or Switzerland. There will be no longer any requirement to own trademark rights in France to get such registration.

The following French oversea extensions will also follow the same rules: *.re* (Reunion Island), *.yt* (Mayotte), *.pm* (St Pierre & Miquelon), *.wf* (Wallis à Futuna), *.tf* (Austral territories).

These new provisions are a clear drawback for non-EU entities (having no subsidiaries or establishments in the above countries), which were until now able to register *.fr* extension on the basis of French or Community trademark rights. It will no longer be so and *.fr* extension will now only be available to non-EU entities having a subsidiary or an establishment in the EU, in Norway, Gibraltar, Iceland, Liechtenstein or Switzerland.

.fr domain names owned by non-EU entities prior to December 6, 2011 will remain valid. Their owner may however be requested to put their domain names in conformity with the new requirements in order to avoid any contestation or issue concerning their domain names' registrability.

Italy: Trademark Opposition Now Possible

Since May 1st, 2011, Italian trademark applications can be opposed by third parties, within 3 months from the publication date in the national gazette. The first fillings subject to opposition have been published in the Gazette in July 2011.

Mexico: New Provision Regarding Priority Claim

Since June 13, 2011 the filing of certified copies of the priority documents are no longer required before the Mexican Trademark Office. When claiming priority, only the filing date, the corresponding filing number and the country of origin must be indicated. Nevertheless, false indication may lead to nullity of trademark registration.

Pakistan – Venezuela: Increase in the Official Taxes

The official fees for filing patent application have been increased by 100% in Pakistan and 30% in Venezuela.

Qatar – Rwanda: New PCT Members

Since August 2011, Qatar and Rwanda are now part of the PCT. These two countries can therefore now be claimed in international patent application.

CASE LAW

France: The Trademark BIKE POLO Constitutes an Imitation of the Earlier Mark BIKE

The company RUSSEL CORPORATION filed opposition on the basis of the earlier mark BIKE designating helmets, face masks and sport protection against the application BIKE POLO designating for instance crash pad. The French Trademark Office, which considered that the earlier mark had only a weak distinctive character, dismissed the risk of confusion between the signs because of the element POLO, which gave to the trademark application a different visual and phonetic impression. The opposition was therefore rejected by the French Trademark Office. On Appeal against the Office's decision, the Court decided to admit the risk of confusion between the signs and to annul the decision.

The reasoning of the Court was that despite certain visual and phonetic differences between the signs, the two trademarks remain close due to the common word element BIKE, which keeps its distinctive character in the trademark application for BIKE POLO. The Court indeed stated that the word element BIKE was visually individualized and that intellectually, the public will not assign to the combination BIKE POLO any specific meaning, but would only perceive the sign as designating products relating to polo sport on bicycle, so that the expression would only be perceived as a form of biking activities.

CA Paris, Pôle 5 ch. 2, July 1st, 2011, RUSSEL CORPORATION v/ INPI and Monsieur Y...

European Union: Exhaustion of Rights of a Three-Dimensional Trademark

The Danish Supreme Court sought a ruling of the Court of Justice of the European Union to help him assess whether according to the circumstances of the case, the proprietor of a three dimensional trademark has legitimate reasons to oppose further commercialization of the goods pursuant to Article 7(2) of the Directive.

The question raised was basically to know whether the proprietor or the holder of an exclusive license for the use of composite gas bottles, which particular shape is registered as a three-dimensional Community trademark and a three-dimensional Danish trademark, can prevent a third party from refilling with gas an empty composite gas bottle, which was regularly purchased by the consumer from the proprietor or the holder of an exclusive license.

It must be observed that in the case, the word and figurative marks affixed by the proprietor/the exclusive licensee on the composite bottles were not removed or covered by the third party and that the latter attached to those bottles an adhesive label bearing its name and the filling station number together with a further adhesive label providing inter alia information as required by law.

The Court of Justice indicated that in order to determine if the proprietor or the exclusive licensee has legitimate reasons to prohibit further commercialization of the goods subject to the trademark rights, it must be assessed whether, because of the labeling of the composite bottles and/or the circumstances in which they are exchanged between the consumer and the third party, the public may have the erroneous impression that there is a connection between the proprietor/the exclusive licensee and the third party in the main proceedings or that the gas used to refill those bottles comes from the proprietor/the exclusive licensee.

In consideration of the practices in the sector, the Court of Justice therefore held that:

“The holder of an exclusive licence for the use of composite gas bottles intended for re use, the shape of which is protected as a three-dimensional mark and to which the holder has affixed its own name and logo that are registered both as word and figurative marks, may not prevent those bottles, after consumers have purchased them and consumed the gas initially contained in them, from being exchanged by a third party, on payment, for composite bottles filled with gas which does not come from the holder of that licence, unless that holder is able to rely on a proper reason for the purposes of Article 7(2) of Directive 89/104.”

Viking Gas A/S v Kosan Gas A/S, Case C-46/10, 14 July 2011.

European Union: There is Likelihood of Confusion between the Earlier Mark NAVI and the Trademark Application NaViKey

The EU General Court, in case T-393/09, approved the Board of Appeal decision, which held that there was a likelihood of confusion between the earlier mark NAVI and the mark applied for NaViKey. They both considered that the goods respectively covered in class 9 (computer and computer accessories) were similar and that the signs were visually and phonetically similar.

The General Court, following the Board of Appeal, indeed considered that the applicant did not furnish sufficient proof showing that the element “navi” was perceived by the relevant public as a known abbreviation for “navigation”, throughout the European Union. However, the General Court admitted, contrary to the Board of Appeal, that the element “navi” could evoke the idea of movement within the computer network in respect to goods such as equipment for computers or for mobile phones and must therefore be considered as having a weak distinctive character.

The General Court also recalled that the fact that the sign NAVI is represented only in upper-case whereas the sign NaViKey alternates between upper-case and lower-case does not help to offset the similarity existing between them since the protection offered by the registration of a word mark applied to the word itself and not to the graphic or stylistic characteristics of the mark.

NEC Display Solutions Europe GmbH v OHIM, Case T-393/09, 13 October 2011.

European Union: The Essential Functions of Trademark are being Specified

Interflora brought proceedings for trademark infringement before the High Court of Justice (England & Wales) because of the selection by Marks & Spencer of the word “Interflora” as keywords through the “Adwords” referencing services and the advertisement under the heading “sponsored links” inviting internet users to order flowers online. The High Court of Justice (England & Wales) sought a ruling of the Court of Justice of the European Union as to whether, in essence, in accordance to Article 5(1)(a) of Directive 89/104 and Article 9(1)(a) of Regulation No. 40/94, the proprietor of a trademark is entitled to prevent a competitor from displaying – on the basis of a keyword which is identical to that trademark and which has been selected in an Internet referencing service by the competitor without the proprietor’s consent – an advertisement for goods and services identical to those for which that mark is registered.

The Court of Justice concluded that the exercise of the exclusive right conferred by the trademark to its proprietor must be reserved to cases in which a third party's use of the sign adversely affects, or is liable to adversely affect, any of the functions of the trademark, irrespective of whether the function concerned is the essential function of indicating the origin of the products and services covered, or the other functions, such as that of guaranteeing the quality of the products and services, or that of its advertising or investment functions.

On the question whether the circumstances of the case may adversely affect the function of indicating the origin:

The Court of Justice held that it would be the case if the advertisement does not enable reasonably well-informed and reasonably observant internet users, or enables them only with difficulty, to ascertain whether the goods and services referred to by the advertisement originate from the proprietor of the trademark or an undertaking economically connected to it, or on the contrary, originate from a third party.

The Court of Justice asked therefore the High Court of Justice to take into account in its assessment the commercial network of the trademark proprietor, composed of a large number of retailers, as according to the Court, it may be difficult for the Internet user to determine, in the absence of any indication from the advertiser, whether or not that advertiser – whose advertisement is displayed in response to a search using that trademark as a search term – is part of that network.

On the question whether the circumstances of the case may adversely affect the advertising function:

The Court of Justice stated that the selection of a sign identical with another person's trademark, in a referencing service with the characteristics of "Adwords", does not have the effect of denying the proprietor of that trademark the opportunity of using its mark effectively to inform and win over consumers.

On the question whether the circumstances of the case may adversely affect the investment function:

It is admitted that a trademark may also be used by its proprietor to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty.

The Court of Justice considered that in a situation in which the trademark enjoys a reputation, the investment function is adversely affected where use by a third party of a sign identical with that mark affects that reputation and thereby jeopardizes its maintenance. That would however not be the case if the only consequence of the use made by the third party (provided that the use is made in conditions of fair competition, i.e. in a way which does not affect the essential function of indicating the origin of the trademark) is to oblige the proprietor of the trademark to adapt its effort to acquire or preserve a reputation capable of attracting consumers and retaining their loyalty.

Interflora Inc., Interflora British Unit v. Marks & Spencer Plc, Flowers Direct Online Ltd, Case C-323/09, 22 September 2011.

CONTACT

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