

**NEWS**

**Costa Rica: Ratification of Hague Apostille Convention**

The Legislative Assembly of the Netherlands, as depositary of the Hague Apostille Convention, formally known as the Hague Convention of 5 October 1961 abolishing the requirement of legalization for foreign public documents, approved the adherence of Costa Rica in Law No. 8923, published in the Official Gazette on March 8, 2011. Apostilles will be affixed by the Authentications Department of the Foreign Affairs Ministry.

The Convention should become effective approximately in January 2012.

**Greece: New Draft Trademark Law to Be Submitted to Parliament**

Aiming at modernizing the Greek Trademark law No. 2239/1994 and harmonizing it with the Enforcement Directive 2004/48/EC, the new draft Trademark Law, which has already received Government’s approval on April 28, 2011, is to be submitted before Parliament. Such draft brings about several changes to the existing trademark normative framework:

- New provisions such as: the possibility to divide a trademark application or registration, the reduction of the opposition deadline from 4 to 3 months, the possibility to register an application as soon as the decision of the Administrative Trademarks Committee becomes final and not irrevocable as before, the duration of protection calculated on the filing date basis;
- Harmonisation of trademark law according to the Enforcement Directive (possibility for the Court to grant an Interim Order, to obtain bank, financial and commercial document from the infringer, change in calculation methods for damages, sharpened criminal sanctions);
- Consolidation of existing enforcement rules regarding Community trademark applications/registrations and international registrations designating Greece;
- Possibility for members of associations of consumers to file oppositions against trademark application or petitions for cancellation of a registered trademark.

**New Zealand: Changes to New Zealand Designs Practice**

As of April 19, 2011, important changes to New Zealand’s design law came into effect further to the adoption of the Designs Amendment Act 2010 and the Designs Amendment Regulations 2011:

- Abandoned design applications or lapsed design registrations can now be restored by the Commissioner of Designs, provided the application for restoration is made within 3 months of abandonment or within 12 months of lapsing.
- The issuance of the Certificate of Registration can now be delayed by up to 15 months from the application date;
- The Commissioner of Designs is now empowered to publish the basic details of pending design applications including their date, number, and all the details appearing on the application form.

**Portugal: Creation of a Specialized Court of Intellectual Property, The IP Court**

In order to reduce significant delays suffered by industrial property proceedings in Porto and Lisbon, the Portuguese Government enacted a new IP law, which was followed by the signature on March 18, 2011 of a protocol by the Portuguese Minister of Justice, in order to create a court specialized in Intellectual Property in Santarem, a small city near Lisbon.

The new court will have jurisdiction over the whole territory and will examine the disputes connected to industrial property, copyrights and registration of domain names under .pt. The disputes pending in front of the current commercial courts will be redistributed to the IP Court, ruling as one general authority.

**CASE LAW**

**France: Validity of The Well-Known Trademark “Pocket”**

Earlier trademark rights	Contested trademark applications
	

The publishing company Univers Poche, owner of the well-known trademark “Pocket” above referred in France, and publisher of the so-called collection, had brought proceedings for infringement against a competitor called Elytel, for the use of the expression “DVD Pocket” on the latter’s website and the filing of the two above French trademark applications. The main discussions focused on the point of knowing whether the English term “pocket” could be considered as distinctive or not.

In its judgment dated April 1st, 2011, the Court of Appeal of Paris ruled that the term “Pocket” was not descriptive of a feature of the goods and services covered and was thus distinctive.

The reasoning of the Court was that although the audience could perceive the English word as meaning “poche” (i.e. pocket) in French language, thus evoking a format, “such term cannot designate a book’s purpose” as it is not meant to stay closed in a pocket but opened, read and commented. The Court added that such sign could also not designate the substantial value of a book, whereas such value does not depend on the book’s size or number of pages, but on its content.

*CA Paris, Pôle 5 ch. 2, April 1st, 2011, Sté Elytel v/ Sté Univers Poche*

**European Union: When examining descriptiveness issues, the Board of Appeal cannot proceed on the basis of mere general assumptions, but must ascertain, with regard to each of the services in question, whether the dominant elements of the trademarks could serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production or of rendering of the service or other characteristics of those services.**

Earlier trademark rights	Contested trademark applications
	

On appeal, the Board of Appeal of the OHIM dismissed risk of confusion between the signs on the ground that the word “cheapflights” and the representation of an aeroplane, common to the trademarks in presence, were entirely descriptive of the services covered, and that the differences between the signs were therefore sufficient to exclude risk of confusion.

The EU General Court, in cases T-460/09 and T-461/09, annulled these decisions in considering that the Board of Appeal’s analysis of the descriptiveness character of the dominant elements that composed the trademark was incomplete.

The court indeed held that the Board of Appeal was wrong to justify its findings as to the absence of risk of confusion on the sole ground that the services covered may have connection with travel arrangements and that the word “cheapflights” was necessarily referring to cheap flights offer. Instead, the Board of Appeal should have developed arguments in its reasoning establishing how the word “cheapflights” or the representation of an aeroplane could serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, time of production or of rendering of the service or other characteristics of those services with regard to each of the services in question. In failing to do so, the Board of Appeal decisions did not meet the required legal standard and had to be annulled.

*CheapFlights International Ltd v OHIM, Cases T-460/09 and T-461/09, 5 May 2011.*

**European Union: A prohibition against infringement issued by a national court hearing a case as a Community trade mark court, extends, as a rule, to the entire area of the European Union**

Chronopost, owner of the French and Community trademarks “Webshipping”, brought proceedings in France for infringement against DHL because of the use by the latter of the signs “WEB SHIPPING”, “Web Shipping” and/or “Webshipping” to designate an express mail management service accessible via the Internet. By a judgment of November 9, 2007, the Court of Appeal of Paris prohibited DHL from continuing to use the litigious signs, subject to a periodic penalty payment in the event of breach of the prohibition. Although successful in appeal, Chronopost considered that the Court of Appeal violated Articles 1 and 98 of Regulation (EC) 40/94 in so far as the prohibition against further infringement issued did not extend to the entire area of the European Union. Chronopost sought appeal before the French Supreme Court, on the ground that a Community trade mark having a unitary character, it had to be given protection throughout the entire area of the Community. The Supreme Court decided to stay proceedings and to refer the following four questions to the Court of Justice of the European Union.

1. Must Article 98 of the Regulation [No 40/94] be interpreted as meaning that the prohibition issued by a Community trade mark court has effect as a matter of law throughout the entire area of the European Union?

2. If not, is that court entitled to apply specifically that prohibition to the territories of other States in which the acts of infringement are committed or threatened?
3. In either case, are the coercive measures which the court, by application of its national law, has attached to the prohibition issued by it applicable within the territories of the Member States in which that prohibition would have effect?
4. In the contrary case, may that court order such a coercive measure, similar to or different from that which it adopts pursuant to its national law, by application of the national laws of the States in which that prohibition would have effect?

In its decision dated April 12, 2011, the Court of Justice of the European Union ruled that:

- The regulation must be interpreted as meaning that a prohibition issued by a national court, hearing a case as a Community trade mark court (by virtue of Articles 93(1) to (4) and 94 (1) of that regulation), extends, as a rule, to the entire area of the European Union;
- A coercive measure ordered by a Community trade mark court by application of its national law has also effect in the other Member States where the prohibition applies.
- Where the law of a Member States does not contain coercive measures similar to that ordered by the Community trademark court, the competent court of that Member States must enforce the prohibition originally issued in having recourse to any equivalent measure provided by its national law.

The reasoning underlying the Court of Justice's judgement is that by principle, a Community trademark has a unitary character, which gives to a Community trademark equal effect and protection throughout the European Union, and that accordingly, decisions regarding the validity and infringement of Community trademarks must necessarily cover the entire area of the European Union in order to prevent inconsistent decisions on the part of national courts and/or the OHIM.

*DHL Express France v Chronopost SA, Case C-235/09, 12 April 2011.*

If you have finished with this document, please pass it on to other interested parties or recycle it, thank you.

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