



Legal Network International

IP and trade mark news – January 2023

A monthly update on global IP and trade mark news from the member firms of the Legal Network International (LNI).



Canada

In *Blossman Gas, Inc. v. Alliance Autopropane Inc.*, 2022 FC 1794, the Federal Court expunged a sublicensee's registration of the brand owner's trademarks on the basis of bad faith. The sublicensee knew of the brand owner's trademark and that its use was dependent on licensing agreements. The sublicensee's ignorance of the law and subjective assessment of its own conduct could not excuse its improper registration of the brand owner's trademarks. In addition to expunging the registrations, the Court awarded damages for passing off the brand owner's trademarks and punitive damages for the bad faith registrations.

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China

The CNIPA's new Guidelines on Registration and Use of Trademarks on Services in Class 35 clarifies the intention of this class. The key points are: commodity sales are not regarded as a service. The key feature of services registrable under Class 35 is that they are provided "for others", not for the activities undertaken by brand owners for their own business.

Accordingly, general manufacturers whose scope of business is confined to producing and selling their own products do not need to register their trademarks under Class 35 unless they intend to provide advertising or business management assistance services for others.

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France

On September 28, 2022, the Paris Court of Appeal ordered to put under seal all the documents seized following a "counterfeiting seizure" measure in order to protect trade secrets. The seizure was conducted based on a claim of patent infringement.

The documents sealed will be consulted in the framework of a "confidentiality club" composed of parties' lawyers and patent attorneys. They will together review the documents seized and remove the confidential parts of them, in particular all information other than those useful and strictly necessary for the proof of the infringement.

J.P. KARSENTY & ASSOCIÉS
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India

The Delhi High Court in the case of *N.V. Satheesh Madhav & Anr vs Deputy Controller of Patents & Designs* reiterated that principles of audi alteram partem ("[hear both sides](#)") must be followed by the Patent Office while rejecting a patent application. The Delhi High Court observed that the patent application was in respect of an invention (method of making of a bio bed). The Delhi High Court further noted that the Controller failed to analyse how the subject matter of the application was lacking inventive steps and obvious in the light of prior art.

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Italy

The Court of Cassation, through judgment no. 38165 of 2022, established that the exploitation of the notorious trademark of others shall be deemed to be prohibited according to art. 20 Italian Code of Industrial Property when it takes unfair advantage of, or is detrimental to, the distinctive character or the reputation of the trademark, irrespective of the fact that the trademark is not used to distinguish the goods or services of the author of the use, as may be the case with the parodistic representation of the trademark.

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Mexico

In the last 30 years, the intangible assets of the 5 largest companies in the world have gone from approximately 10 to 85%, it means, that the relevance of tangible assets against intangibles has been reversed. In Mexico, industries based on IP only represent 4.8% of GDP, approaching that of G8 countries where these industries represent between 5 and 11.5% of GDP. For this reason, the relevance of protection of IP deserves an important level of attention; and hopefully this 2023 would be a decisive year to strengthen what has been achieved up to now on IP protection.



Singapore

Daimler is unsuccessful in its opposition claim that VIVO is similar to its VITO mark. In deciding this matter, the Registrar clarified and affirmed how short word marks with mostly similar letters are viewed. The differences in letters would be more amplified as compared to longer marks. The fact that there are more letters in common than not does not necessarily lead to a conclusion that the marks are therefore similar. Learn more here:

<https://www.alphaandomega.com.sg/updates/popular/daimler-unsuccessful-in-its-opposition-claim-that-vivo-is-similar-to-vito>



Sweden

The Swedish Patent and Market Court has in a recent ruling concluded that the cushion of the armchair "Jetson", designed by the famous furniture designer Bruno Mathsson, is in itself protected by copyright as a work of applied art. A furniture upholsterer was thus prohibited from manufacturing and sell its own cushions to the armchair as these were regarded as unauthorised copies of the Jetson armchair cushion.



UK

The Trade Marks (Amendment) Regulations 2022 came into force on 27 December 2022. The Regulations amend Section 56 of the Trade Marks Act 1994 in relation to the use of well-known marks. The changes apply to the UK holders of both registered and unregistered well-known marks, however, the effect is likely to be of more benefit to the holders of unregistered well-known marks by offering an additional remedy to enhance the protection enjoyed.

<https://www.legislation.gov.uk/uksi/2022/1303/introduction/made>

