



Legal Network International

IP and trade mark news – March 2023

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

New Intellectual Property Chambers at the Federal Court in Canada



Canada

In Canada, the Federal Court has jurisdiction to resolve disputes regarding intellectual property rights. This month, the Canadian Federal Court launched a pilot project involving the creation of specialized intellectual property Chambers of the Court. As a result, judges with experience in intellectual property will hear intellectual property cases – similar to the approach used in the English High Court. For a copy of the Notice to the Parties and the Profession describing the new chambers please see [here](#).

AIRD BERLIS

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As part of the institutional reform, in March 2023, the China National Intellectual Property Administration ("CNIPA") has been restored to an institution directly under the State Council – a higher status.



China

This important change signals the focus of IP policy development is moving from protection to utilization. The CNIPA's improved position will facilitate this. The new focus is to accelerate the building of an IP powerhouse and comprehensively improve the creation, application, protection and management of IPR. In 2018, when the CNIPA was administered by the State Administration for Market Regulation, the focus was to enhance IP enforcement.

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On December 15, 2022, French Court of Appeal of Versailles cancelled the model of a plate representing a watch face because of the disclosure of the model by the right holder's commercial partner.



France

It also recalled that the novelty of a design is not assessed on the basis of the use that the consumer may make of it, but on the basis of what is represented in the application. It is therefore irrelevant, from the point of view of prior art, whether the model is intended for decorative or functional use.

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The Delhi High Court recently ruled that the stylized "H" logo mark of the French Luxury brand, Hermès International is a well-known mark, ruling against a Mumbai-based footwear label. Hermès International had found that Crimzon Fashion Accessories Private Limited, sells products similar to Hermès's international trademark. The Court considered the issue of well-known status after passing an order of permanent injunction against Crimzon for infringing use of the mark on its website.



India



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The Supreme Court has ruled, through the order no. 3013 of the 1st February 2023, that the use of descriptions and designs, far from extending the scope of protection beyond that expressed by the claims, allows the granting of the right to be more closely aligned with the owner's wishes and, pursuant to Article 52, third paragraph, of the Code of Industrial Property, guarantees, besides the equitable protection of the owner, the reasonable legal security to third parties, who are potentially benefited by the limitation of the scope of protection.



Italy

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Mexico

Tesla and Elon Musk have made headlines in Mexico after the arrival of a *gigafactory* of electric cars in the state of Nuevo León was confirmed. However, in the field of IP, the owner of Tesla has had some obstacles regarding his brand "TESLAQUILA", since the Tequila Regulatory Council (CRT) opposed its concession as the word TEQUILA is a denomination of origin, the rights of its use only belong to the agro-industry of this drink and nobody can register the word. A great success of the authority for the respect of IP.



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Singapore

NCL Corporation is Partially Successful In Opposing Trade Marks by Norwegian Brand Ltd. A point of interest is the Registrar's finding that The Opponent's revenue figures, advertising and promotion, and email and direct mail campaigns, show that it has a tangible business in Singapore which is promoted to an inconclusive extent. However, this alone does not establish that the Opponent's Marks are well known in Singapore. The Opponent's evidence failed to show how and to what extent it impacts the relevant sector of the public in Singapore. Learn more here:

<https://www.alphaandomega.com.sg/updates/popular/ncl-corporation-partially-successful-in-opposing-protection-of-marks-by-norwegian-brand-ltd>



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Cameroon

In **FACEBOOK INC. v. MOUSTAPHA BARRY**, based on the principle of specialty and notoriety, the High Commission of Appeal ruled that the products associated with the trademark "**FACEBOOK**" owned by FACEBOOK INC were distinct from those connected to the "**FACEBOOK ENERGY**" trademark owned by Mr. MOUSTAPHA BARRY, according to the principle of specialty and that only judicial courts of OAPI member states hold the authority to make decisions regarding notoriety, not the OAPI organization or commission.

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Sweden

The Patent and Market Court of Appeal has asked the Court of Justice of the EU for a preliminary ruling regarding the interpretation of the E-commerce Directive. One question concerns whether a Member State can introduce legislation to prohibit it from applying its own national law within the Directive's field when the service provider is established in and provides its services from another Member State.

Another question is whether the Directive coordinates rules on website promotion and on line sales when it is claimed that labelling does not comply with the requirements of the consumer's Member State.

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UK

In response to the Department of Culture, Media and Sport's proposals for changes to UK copyright law in relation to the right for musical creators to regain copyright in their music after a set period, the UK's Intellectual Property Office has published a study which researches two of the proposals. The study concludes the proposals could benefit the artists greatly compared to suggested measures to increase competition.

<https://www.gov.uk/government/publications/economics-of-streaming-contract-adjustment-and-rights-reversion/rights-reversion-and-contract-adjustment#chapter-3-contract-adjustment>

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USA

The US Patent and Trademark Office (USPTO) has suspended action on pending trademark applications that are critical of public or government officials. The suspension will remain in effect until the US Supreme Court considers the issue.

This follows the USPTO's refusal to register "TRUMP TOO SMALL" for apparel on the grounds that the consuming public would view "TRUMP" as a reference to Donald Trump. The decision was reversed on appeal on 1st Amendment freedom of speech grounds. The USPTO in turn, has sought a writ of Certiorari from the US Supreme Court.

The USPTO guidance can be found at:

<https://www.uspto.gov/sites/default/files/documents/TM-ExamGuide-1-23.pdf>

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