



Legal Network International

IP and trade mark news – January 2024

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



Canada

In *Janssen Inc. v. Apotex Inc.*, the Canadian Federal Court of Appeal declared a subsequent patent action brought under Canada's *Patented Medicines (Notice of Compliance) Regulations* to be an abuse of process. In an earlier proceeding, the generic defendant alleged that its drug would not infringe the plaintiff's patent, but did not challenge the patent's validity. After the Court ruled against the defendant on infringement, the defendant then alleged that the patent was invalid. The Court held that since the defendant could have raised the invalidity allegation in the first proceeding but chose not to, it could not challenge the patent's validity in a new proceeding. [The case is discussed further in our article.](#)

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China

On December 29, 2023, the China National Intellectual Property Administration issued *Guidelines on Distinctiveness of Non-Traditional Marks* ("NTM") to help business operators understand the required distinctiveness of acceptable NTMs including 3D marks, color combination marks and sound marks and guide the registration and use thereof.

For example, the Guidelines specify that for a 3D mark, if the proposed NTM is easily recognized as part of the goods (like the yellow stitching surrounding the shoe in the sample below), unless distinctiveness is acquired through long-term or extensive use, usually it would not be deemed as having sufficient distinctiveness because the public would not regard it as an identifier of the source of goods.



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France

French Supreme Court has voided a counterfeiting seizure order on the basis that the applicant did not present all the objective elements relating to its request and that the omission of known elements was unfair.

The counterfeiting seizure request did not mention that the adverse party was the holder of a trademark and that the French office has set aside all risk of confusion with the applicant's trademark.

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India

In a recent Delhi High Court case of Phonographic Performance Ltd. v Esteem Services, the Plaintiff filed a copyright infringement case on the Defendant because the defendant wanted to play sound recordings that were under the Plaintiff's copyright without obtaining a license. The Plaintiff sought an ex-parte interim injunction to prevent that infringement. Defendant stated that various associations such as DJ Light & Sound Association Chandigarh were misinforming the public that a license is not required to be taken from copyright holders on the ground that they are not registered copyright societies. The court then directed DJ Light & Sound Association Chandigarh to be impleaded as Defendant No. 2. The court enjoined Defendant No. 2 from misleading the public.



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Italy

On January 11th, 2024 the Law n. 206/2023 on "Made in Italy" entered into force. New legislation includes, *inter alia*: financial support to encourage start-ups patenting their breakthroughs, the possibility for the Ministry of Economy to take over the ownership of historical trademarks of national interest in particular circumstances, the right for cultural institutes and heritage sites to register their respective trademarks and a stronger protection of their domain name – with the prospect of entering into a special agreement with ICANN –, the creation of a public fund for the registration and protection of Italian indications of origins abroad and, ultimately, a public census of geographical indications for craft and industrial products, in view of the new Regulation 2023/2411/UE.

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Luxembourg

Luxchat – Luxembourg's instant messaging service

The Luxembourg Internet Exchange - an association of different business actors, the Luxembourg Chamber of Commerce and the Luxembourg Ministry of Digitalisation have recently launched an end-to-end encrypted instant messaging service called *Luxchat*. This alternative to current instant messaging services is fully operated from Luxembourg and can be used on devices using Android or iOS.



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In addition to the general Luxchat service to be used by businesses and the general public, the Luxembourg government has launched a separate version Luxchat4Gov that can be used by the civil service for instant messaging and the exchange of documents. The government version is operated from a separate IT infrastructure, but according to the operator the encryption technology is identical.



Mexico

In México, the Supreme Court of Justice of the Nation (SCJN) will discuss a project that could open the door to pharmaceutical companies seeking to have patents of other companies declared null and void so that they can manufacture certain drugs.

The issue is scheduled to be addressed this week by the First Chamber of the Court, where Minister Margarita Ríos Farjat will propose to grant the protection of justice to a company.

This was because, for years, Sandoz S.A. de C.V., a leading generic and biocomparable drug company, has been seeking to develop a drug to prevent strokes, which is produced by Pfizer with apixaban particles, whose patent expires on February 24, 2031.



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Singapore

The evidence presented by the Opponent regarding supposed actual confusion was deemed inadequate to prove that the alleged misrepresentation resulted in a probability of confusion. Assessment on the specificity and reliability of the presented evidence, particularly focusing on whether the likelihood of confusion was minimal is a pertinent consideration in reaching a conclusion. Read more [here](#).



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Sweden

The Swedish Patent and Market Court of Appeal upheld in part truck manufacturer SCANIA's claim on trademark infringement against a supplier of superstructures for trucks. The court ruled that the supplier had used symbols confusingly similar to Scania's trademarks. However, SCANIA failed to establish use-based trademark rights e.g. with regards to a V8 logo signifying a type of engine. Moreover, in some instances SCANIA had not proved that the defendant had placed the symbols on the products. The case unravels questions on acquisition of distinctive character, parallel import, trademark use and copyright infringement.



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UK

On 11 January 2024, the UK Government responded to the Culture, Media and Sport Committee's second report on AI and Intellectual Property which was published on 30 August 2023. The report, *Connected tech: AI and creative technology*, focused on the concerns of the creative industries about the impact of AI systems profiting from mining private intellectual property without sharing the profits with the original creators. In its response, the Government confirmed its original proposal for a broad copyright exception for text and data mining will not proceed and a more detailed response to the report will be published in the coming months.
<https://committees.parliament.uk/committee/378/culture-media-and-sport-committee/news/199318/connected-technology-cms-committee-publishes-government-response-to-report-on-ai-and-intellectual-property/>



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