



Legal Network International

IP and trade mark news – June 2024

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



Canada

The Federal Court of Canada found that a government agency's sharing of copyrighted content from a subscription news service was fair dealing, even though the terms and conditions prohibited such sharing. The agency bought a one user subscription that gave it access to news articles behind a paywall, but then shared the password with other users internally.

Despite the service's terms and conditions, the Court found that the agency's use was fair dealing for research because it was for a limited number of users with business reasons for accessing the articles, for only a few articles and the password for licitly attained. Read full article [here](#).

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www.airdberlis.com

Contributed by Lawrence Veregin
Email: lveregin@airdberlis.com



Colombia

DOLUTEGRAVIR COMPULSORY LICENSE IN COLOMBIA FOR REASONS OF PUBLIC INTEREST.

The Ministry of Health and Social Protection declared reasons of public interest over patent 1887 to a compulsory license in the mode of governmental use, since the evidence and analysis conclude that Dolutegravir is mainly needed to avoid a greater impact on the treatment of HIV/AIDS at the national level.

Based on this, the Ministry of Health and Social Protection submitted compulsory license petitions, and The Colombian Patent Office has decided to grant it until April 28th, 2026, establishing that it shall pay to the owners of the patent the amount of COP 0.11, for each milligram of Dolutegravir introduced or produced in the country for governmental use, plus taxes.



www.cuestalawyers.com

Contributed by Stephany Rojas
Email: patentes@cuestalawyers.com



France

On April 9, 2024, a French Court has confirmed recent case law which considers that the assignment of a trademark for free constitutes a donation that must be recorded before a public notary.

Consequently, the Court stated that *"the lack of notarial form of an ostensible donation is sanctioned by an absolute nullity with no possibility of confirmation."*

J.P. KARSENTY & ASSOCIÉS
Avocats à la Cour de Paris

www.jpksenty.com/

Contributed by Pierre Trusson
Email: ptrusson@jpksenty.com



India

In Google LLC v. MakeMyTrip (India) (P) Ltd. Google appealed an ad-interim order from the Delhi High Court's Single Judge, which had restrained Google from using 'MakeMyTrip' as a keyword on Google Ads. MakeMyTrip claimed this use constituted trademark infringement, as Booking.com, a competitor, was displaying ads using 'MakeMyTrip' as a keyword.

The Delhi High Court set aside this order, deeming it erroneous. The Single Judge had concluded that using 'MakeMyTrip' as a keyword by Booking.com amounted to trademark infringement under Section 29(4)(c) of the Trade Marks Act, 1999. However, the appellate court held that that using trademarks as keywords did not constitute infringement or unfair advantage if such use was not determined as deceitful. The court ruled that such use did not apply to material for advertising goods or services, thereby overturning the prior decision.



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www.universallegal.firm.in/

Contributed by Preksha Shah
Email: preksha@universallegal.firm.in

The Court of first instance of Milan held an interesting decision regarding the infringement of the trademark "FIORENTINA", owned by the famous football club of Florence.



The publisher of an online magazine dedicated to the Florence football team, according to the decision, had registered the trademark "fiorentina.it" in bad faith to take advantage of the plaintiff's notoriety, thus rejecting the trademark validation exception under Article 28 of the Industrial Property Code.

Despite the football club acted only 10 years after registering the trademark, validation takes place when the owner of the earlier trademark has tolerated the use of the later trademark for five years except where the later trademark was filed in bad faith.

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STUDIO LEGALE
www.rucellaieraffaelli.it/

Contributed by Ottavia Raffaelli
and Federico Casadei
Email:
o.raffaelli@rucellaieraffaelli.it

Federico Casadei
Email:
f.casadei@rucellaieraffaelli.it

Friday, June 7, 2024, a jurisprudence was published in Mexico that establishes that Article 8 of the Federal Film Law is unconstitutional due to the fact that the article states that films classified for children's audiences may be shown dubbed as long as they are subtitled in Spanish.



The Supreme Court of Justice established that dubbing has the sole purpose of translating the verbal expression made in the original language. In this sense, it is unconstitutional to establish that films for children must be subtitled in Spanish, since not all the population is literate or has sufficient vision to read only subtitles.

 **SESMA,**
Sesma & McNeese - Abogados
Attorneys & Government Relations Professionals
www.sesma.com.mx

Contributed by Karen Calvo
Rodríguez
Email: kcalvo@sesmalaw.com.mx

After ending a cooperation based on an agreement regarding patent licensed vitalisation of seeds, the licensee sued the licensor for copyright infringement and exploitation of trade secrets. The licensee claimed that the licensor had (i) copied the company's copyrighted items and (ii) unlawfully used the licensee's trade secrets.



The Patent and Market Court of Appeal dismissed the claim as the licensee had failed to establish that the items had been used as asserted by the licensee. In addition, the court held that the licensor to a certain extent had been granted a contractual right to copy.

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www.timedanowsky.se

Contributed by Maria Häagg
Email:
Maria.Haagg@timedanowsky.se

Limits on director liability for trade mark infringement in the UK - [Lifestyle Equities CV and another \(Respondents\) v Ahmed and another \(Appellants\) \(supremecourt.uk\)](#).



The Supreme Court ruled directors of companies who infringe trade marks can only be held personally liable as an accessory to that infringement in the UK if they know that what their company was doing amounted to trade mark infringement. The court confirmed where the director does have knowledge of the infringement, they will only be liable for the profits made themselves, and not the profits of the company. This could see IP rightsholders exerting pressure on directors for IP infringement to ensure the alleged infringer stops the infringing activity at an early stage.

hamlins
www.hamlins.com

Contributed by Matthew Pryke
Email:
Matthew.Pryke@hamlins.com