



Legal Network International

IP and trade mark news – September 2024

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



Colombia

The Andean Decision 486 establishes that registered trademarks may be annulled when they have been granted notwithstanding the configuration of any of the grounds of irregular registrability.

In Colombia this figure is almost inoperative, since nullities are subject to the ordinary regime, which implies that these actions are heard by the contentious-administrative justice following a process that can take several years, causing, in most cases, that the decision issued no longer has any effect.

The good news is that the National Development Plan of the current government orders the inclusion of administrative nullity for all industrial property matters, which, if implemented, would greatly expedite this process, to the benefit of owners and attorneys-in-fact.



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France

On April 26, 2024, The Paris Court of appeal condemned a company for disparagement for the sending of two formal notices to a host provider and a marketplace in which it reveals the existence of an ongoing infringement proceeding before the Courts against one of their clients.

The Courts judged that such disclosing "*without caution or measure that the products marketed by a competitor on this site constitute an infringement*" was an act of disparagement and condemned the company to pay 10.000€ to the plaintiff.

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India

In Burger King Corporation vs. Ms. Anahita Irani & Anr., the Pune District Court ruled against the global franchise owner in favour of a single outlet in Pune using the "Burger King" name.

The plaintiff sought damages and an injunction but failed due to procedural lapses, including improper affidavit verification, unauthorised filing, insufficient evidence, and delayed registration. The defendant had used the trademark since 1991, while the plaintiff's Indian registration was effective only from 2006.

Despite protections under the Trademarks Act, this ruling underscores that even globally recognised entities must rigorously observe procedural formalities to effectively assert their trademark rights in India. The Mumbai High Court has since stayed this order, pending further arguments.


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Italy

The Court of Ancona, in its judgement No. 1309 of 4 July 2024, pronounced on the distinctiveness of the trade mark 'Bi-Bag'. This is an expression widely used in the fashion industry to describe double lining bags, which, however, acquired distinctiveness through its secondary meaning.

Regarding secondary meaning, Italian case law requires that words in common use relating to the genre of a product can be used for a valid trademark only when they have been altered to the extent that their original linguistic meaning has been obscured, and designates, with strong identification, a product because they are used in an arbitrary, fantastic, hyperbolic sense, without any conceptual adherence to the object they are intended to distinguish.

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UK

The UK's Intellectual Property Office has confirmed its trial of issuing Statements of Grant of protections (SOGs) for indicating acceptance of international registrations has been successful. As such, the IPO has announced it will continue issuing these statements going forward.

<https://www.gov.uk/government/news/ipo-introduces-statements-of-grant-for-international-designs>

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Austria

The Vienna Appellate Court recently dealt with the question whether the use of a trademark for goods/services that are only similar to the registered goods/services is considered as trademark use that preserves rights.

In this case, the trademark was inter alia registered for 'casino games' and 'hardware and software, especially for casino and gambling hall games'. However, the trademark was merely used to designate a game that was only available online, without stakes or winnings.

The Austrian court clarified that it is necessary to use the trademark specifically for the registered goods/services in order to preserve rights. If a trademark has been used for only similar goods/services, it can – once the non-use grace period has expired – be cancelled for non-use.

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Sweden

Universal Music Publishing AB (publisher) and Polar Music International AB (master owner) sued a company selling food products, Clean Eating AB, for unauthorized use of the ABBA song The Winner Takes it All in a 15 seconds commercial on Instagram.

The defendant was ordered to pay SEK 100 000 in reasonable compensation to each of the plaintiffs plus litigation costs. Compensation for further damages was not included. The Patent and Market Court found the requested compensation to be reasonable, considering e.g. that ABBA was “Iconic” and above the “Top Tier” table, and furthermore that ABBA as matter of principles never license out their music for commercials.

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Mexico

On September 15 of this year, a decree was published in the Official Gazette of the Federation amending, adding and repealing several provisions of the “Constitución Política de los Estados Unidos Mexicanos” regarding the Judicial Branch. The substantive part of the decree determines that Judges, Magistrates and Ministers will be elected by popular vote.

This reform affects the entire judicial branch, and regarding Industrial Property, it will be harmed during amparo proceedings and those matters heard by the Supreme Court of Justice, creating an environment of legal insecurity, with possible effects on the rights of citizens. All these changes will come into effect in mid-2025.



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Canada

In companion patent infringement decisions (*Rovi Guides, Inc. v. Videotron Ltd.*, 2024 FCA 125 and *Rovi Guides, Inc. v. Telus Corporation*, 2024 FCA 126), the Federal Court of Appeal held that rights holders are presumptively entitled to accounting of profits and injunction for patent infringement.

Although the courts retain discretion to decline an accounting of profits or injunction if it would be inequitable, the fact that a patentee has licensed or intends to licence its patents rather than practice the invention has no weight in this analysis. An accounting of profits and injunction should only be denied if there are compelling reasons to do so.



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