

Legal Network International

IP and trade mark news – December 2024

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

In a recent decision regarding cosmetic articles, the Austrian Supreme Court developed further its jurisprudence concerning the issue of territorial exhaustion of trademark rights, in accordance with the principles of the CJEU judgment C-367/21 (Hewlett Packard) of January 2024:

In particular, it held that the burden of proof regarding the first placement of goods on the market outside the EEA shifts to the trademark owner applying a selective distribution system, if third parties are not able to determine the target market via product identifiers and the owner refuses to disclose such information. Furthermore, the goods must have been acquired within the EEA from suppliers which credibly assured their marketability but do not reveal their sources. In such situations, it is up to the trademark owner to demonstrate that the goods were initially marketed outside the EEA.

The Austrian Supreme Court also highlighted that it would be unreasonable to require distributors to request such information – despite the trademark owner generally refusing it – each time for every single product, and that such requirement also does not follow from the mentioned CJEU decision.



Austria

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Highlights of the decisions on genetic resources and traditional knowledge adopted at COP16 in Colombia:

1. Establishment of the Cali Fund: This multilateral mechanism aims to gather financial resources from the use of genetic and digital information related to plants and animals, ensuring a fair and equitable distribution to megadiverse countries. The pharmaceutical, biotechnology and agricultural sectors should contribute to this fund.

2. Creation of a new body within the Convention on Biological Diversity (CBD): Indigenous Peoples will have a permanent body dedicated to promoting actions and projects related to their Traditional Knowledge.

3. Colombia commitment to the International Treaty on Plant Genetic Resources for Food: This commitment supports the sustainable use of genetic resources.

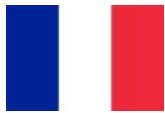


Colombia



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France

On 14 November 2024, French Supreme Court has issued a judgement in which it judges that in presence of an irregularity, only the measures taken to execute the infringement seizure that are affected by this irregularity are void. As a result, in the event of a violation by the bailiff of the limits of the authorization given by the Judge's Order, the voidness of the measure is limited to the measures carried out in violation of this authorization.

In this case, the bailiff conducted operations and seizure in a premise which was not mentioned in the Order. The Supreme Court has then considered that only the documents seized in this premise had to be judged void.

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India

IndiGo Airlines has filed a lawsuit against Mahindra Electric Automobile alleging trademark infringement over the use of "6E" (the airline code) in the name of their new electric car, "Mahindra BE 6E."

On 25.11.2024, the India Registrar of Trademarks accepted Mahindra's request to register "BE 6E", prompting IndiGo to seek relief from the IP Division of the Delhi High Court. Mahindra has undertaken not to use the "6E" mark till the disposal of IndiGo airline's trademark infringement suit against them and decided to contest the suit on merits. Based on this undertaking, the Delhi High Court disposed of the original application for interim orders and adjourned the case for final hearing.


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A geographical trademark is a trademark consisting in the proper name of a place, also known as toponym, as, for instance, the name of a city or a country, but also of a single urban element like a street or a square.



Italy

Recently, there has been a growing trend in the registration of geographical trademarks by both municipalities and private individuals. A notable example of this is the registration of the trademark “Cervinia”, a renowned mountain resort, by private parties. In such context, the Municipality of Milan has enacted a new regulation that appoints an authority within the administration itself to which individuals must submit a request for authorization when seeking to register a trademark that incorporates the name “Milan”.

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As technology, trade agreements and innovations are in constant change, Industrial Property has taken a central position in the world, therefore it is extremely discouraging that less than 10% of the new trademark applications filed with the Mexican Institute of Industrial Property (IMPI) are from Mexican nationals or companies.



Mexico

Consequently, as an indicator of economic health and protection of the governed, this statistic evidence that the government is not promoting and encouraging the Mexican population to exploit one of the major benefits of the T-MEC (USMCA).

What is certain is that the Mexican State has a greater focus on stopping counterfeit products and enforcing the rights of those who ALREADY have a trademark registration or enjoy a right of action in protection of their intellectual property.

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An association was granted trade mark registration for “VEDBOBACKEN” (*eng*: “The Vedbo slope” - “Vedbo” being an appellative geographical name, and “backen” meaning “the slope”) for a ski business located at the Vedbo slope.



Sweden

The municipality who owned the estate, was also the association’s lessor, objected. The municipality argued that the mark could mislead the public as it identified a place and not an operation. The Patent and Market Court disagreed and held that the mark was distinct and not likely to mislead the public.

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