

Class 46

Class 99

## CLASS 46

Now in its twelfth year, Class 46 is dedicated to European trade mark law and practice. This weblog is written by a team of enthusiasts who want to spread the word and share their thoughts with others.

Who we all are...

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THURSDAY, 10 OCTOBER 2019

### New trade mark examination guideline in Turkey

Mutlu Yıldırım Köse provides an update for Class 46 readers:

On 30 September 2019, the Turkish Patent and Trademark Office published The New Trademark



Examination Guideline that defines the criteria regarding the examination of trade mark applications on absolute grounds within the scope of the Industrial Property Code that came into force in 2017.

The main purpose of the Guideline is to update the previous guideline which was in force since 2011, clarify the principles of absolute grounds for refusal that are explained in the IP Code and provide consistency in the Office's decisions.

Within this context, the absolute grounds for refusal that are included between the articles 5(1) (a) and 5(1)(i) of the Law are examined in 12 main sections. The Guideline consists of 379 pages and includes a great number of examples in detail. The examples are given by taking the decisions of the Courts and the Office and also the recent EU

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sources and the Office and also the recent EU developments into consideration.

## Highlights

While the guideline includes details and great number of examples, the highlighted points can

be summarized as follows:

With regards to the representation of the trade mark in the registry, it is stated that since the graphical representation is not required, it is enough to upload the videos and the voice recordings for the applications of the sound marks. Further, it is highlighted that for colour mark applications, the section for the colour example must be filled fully and the Pantone colour code must be indicated.

With regards to “distinctiveness” and “descriptiveness”, the Guideline mentions the main criteria that should be taken into consideration in evaluating trade mark applications. It is emphasized that (i) the trade mark to be registered should be evaluated together with goods and services that are the subject of the application, (ii) the application should be evaluated as a whole, and (iii) the perception of the target consumers should be taken into consideration.

## Examples provided

Then there are a lot of examples provided for word marks, slogans, device marks, colour marks, colour combination marks, voice marks, movement marks, trade marks including INNs etc.

With regards to the indistinguishable similarity to a senior trade mark or trade mark application, it is specified that there will be an ex officio similarity evaluation by the Office for the same or indistinguishable trade marks. It is emphasized that (i) if there are two composite marks under evaluation, the overall impression that the marks

leave will be taken into consideration, (ii) if there are one composite and one non-composite mark under evaluation, the evaluation will be made upon the distinctive elements, and (iii) the distinctiveness level of the trade marks such as low-middle-high should be taken into

consideration while the protection scope is determined.

A lot of examples are provided for indistinguishable similarity of trade marks that include phrases such as OPTIMUM, GLOBAL, STAR, BY, THE, MY, GROUP, EURO, PLUS, SMART, EXTRA, PURE, SOFT, LIFE as well.

As mentioned in the announcement of the Guideline by the Office, it is expected that the Guideline will clarify the principles of absolute grounds for refusal and provide consistency in the Office's decisions. The Guideline is available [here](#).

*By Mutlu Yıldırım Köse, Gün+Partners, a member of the MARQUES Copyright Team*

Posted by: Blog Administrator @ 15.07

Tags: [Turkey](#), [trade mark examination](#), ,

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THURSDAY, 10 OCTOBER 2019

## Company names, trade names and other business identifiers study

There is great divergence in the law on trade names, company names and other business identifiers - even within the EU. In particular, there are differences regarding what qualifies as a company/trade name, whether registration and/or use is required, transfer, the scope of protection and (perhaps of most importance) the impact on trade marks.

To highlight and address some of these issues, the MARQUES Unfair Competition Team has published a New study on company names, trade names and other business identifiers, which is available for members to download from the Team's page.

The study is based on a questionnaire comprising 13 questions and sub-questions. It covers 14 countries: Argentina, Austria, Brazil, the Czech Republic, Denmark, Finland, France, Germany, Latvia, The Netherlands, Russia, Switzerland, Turkey and the UK.

The results of the survey are presented in five parts: (1)

an overview of trade names and their relationship with trade marks; (2) the results of the questionnaire; (3) narrative on the results; (4) the questionnaire; and (5) the PowerPoint presentation made on this topic at the Annual Conference 2017.

This study is an ongoing project, and the Team would welcome feedback from MARQUES members and others on the results published, as well as input from other countries not yet covered.

For more information, or if you wish to complete the questionnaire for your jurisdiction, please contact [Sascha Abrar](#), [Karin Pomaizlova](#) or [Alexandra di Maggio](#), all members of the Team.

Posted by: Blog Administrator @ 14.56

Tags: [unfair competition](#), [company names](#),

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THURSDAY, 10 OCTOBER 2019

## Are you coming to the Luxury Brands Symposium?

The third edition of the MARQUES Luxury Brands Symposium is taking place in Milan on 7 to 8 November 2019.



This Symposium will look at

protecting and enforcing luxury brands, with a particular focus on the changing face of luxury. Topics covered will include: plagiarism and art, selective distribution, the impact of social media, expanding brands in different directions and CJEU case law on luxury brands.

The speakers will include representatives of organisations such as the Victoria & Albert Museum, Porsche AG, LVMH, Facebook Inc, Furla S.p.A., Chiara Ferragni, Moncler, Bulgari S.p.A. and FMTM Distribution Ltd. The Symposium will be introduced by MARQUES Chair Susie Harris of The Plum Guide.

Registration is €800 for MARQUES members or €950 for non-members.

For more details see:

[Overview](#)

[Programme](#)

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MARQUES has requested accreditation for the Symposium from the Italian Institute of Patent and Trade Mark Attorneys, which is pending.

Posted by: Blog Administrator @ 14.00

Tags: [Luxury Brands](#), [Milan](#), ,

Perm-A-Link: <https://www.marques.org/blogs/class46?XID=BHA4795>

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TUESDAY, 8 OCTOBER 2019

## CJEU in AMS Neve vs. Heritage Audio: Enhanced international jurisdiction for online infringement cases

The internet is a boundless place. Along with the web's opportunities to easily trade across borders come corresponding risks of IP infringements, committed from literally anywhere in the world. The lack of borders in the online sphere brings significant challenges for right holders seeking to enforce their intellectual property. The ubiquity of infringing activities, and of their harmful impact, also calls for careful consideration of the existing tests for establishing international jurisdiction and the applicable law.

### Quo vado? Where best to enforce EU trademarks against online infringements?

When enforcing their trademarks against cross-border online infringements, right holders are regularly faced with the fundamental question: Quo vado? Somewhat astonishingly, the answer to this question has been far from clear with regard to EU trademarks, and has sparked significant debate over the last years.

Uncertainties particularly accumulated around [Art. 125 \(5\) of the European Union Trademark Regulation \(EUTMR\)](#), which provides that besides the defendant's seat, proceedings may also be brought before the courts of the EU Member State "*in which the act of infringement has been committed*". This wording provides clear answers for physical infringements such as print ads or infringing merchandise sold in brick and mortar outlets. But which of the many geographic connections of an online infringement is relevant to establish the place of the infringing activity? Is it the place from which the infringer uploaded the infringing offers and adverts? Is it the location of the server on which the infringing content is hosted? Or is it the place where the public is targeted and where the infringements have their effects?

The German Federal Court of Justice went down the first route in its hotly debated "Coty" decision (judgment of 9 November 2017, Case no. I ZR 164/16), holding that the location of the infringing act is the place where the infringer initiated the process of publishing the online content in

initiated the process of publishing the online content in question. Under this very narrow test, owners of an EU trademark were effectively limited to bringing infringement actions only in the home jurisdiction of the infringer - thus unduly favouring the defendant and eliminating the choice of venue provided by Art 125 EUTMR. This outcome left EU trademarks significantly less attractive and in consequence,

we have seen many right holders resort to basing their claims on national rather than EU trademarks.

With [AMS Neve vs. Heritage Audio \(C-172/18\)](#), the CJEU now had the opportunity to address the scope of Art. 125 (5) EUTMR for online infringement cases and provide its guidance to courts across the EU.

### **AMS Neve vs. Heritage Audio**

AMS Neve, a UK-based audio equipment manufacturer, accused Spanish company Heritage Audio of having offered and promoted imitations of their products to British customers through e-mails and several online presences, including websites and Social Media accounts. Based on its EU trademark, AMS Neve brought an infringement action against Heritage Audio in England. AMS Neve argued that the offers particularly addressed the British public because the online presences were published in English and (also) offered delivery to the UK.

Heritage Audio did not deny that the products at issue might have been purchased by UK customers. However, it took the view that English courts nonetheless had no jurisdiction as Heritage Audio had not advertised or conducted any sales activity from within the UK. All activity originated from Spain, so if there was an infringement, only Spanish courts were said to have jurisdiction.

While Heritage Audio was successful with this line of argument at first instance, the Court of Appeal of England & Wales referred the matter to the CJEU, raising doubts about the line of reasoning the German Federal Supreme Court had taken in its "Coty" decision.

### **The CJEU's decision**

The CJEU, following the [opinion of AG Szpunar](#), applied a broader test to Art. 125(5) EUTMR: A trademark owner may bring an infringement action in any Member State in which the customers targeted by the infringing offers are located. According to the court, it is irrelevant where the defendant is based, where the servers and the infringing products are located, or whether there have actually been any sales. AMS Neve could therefore bring its infringement action before the English courts, even though Heritage Audio did not conduct any infringing activity in the UK.

The CJEU supports this test with a number of convincing arguments:

Firstly, the court rightly points out that Art. 125(5) EUTMR is meant to provide an alternative forum for right holders beyond the defendant's home jurisdiction. This purpose would be undermined if the forum were to be determined by the place from which the defendant orchestrates the publication of infringing content, as this place will in most cases coincide with the defendant's seat.

Secondly, it is extremely difficult, sometimes even practically impossible, for a right owner to identify the place from where the defendant took operative decisions before even bringing the infringement action. In particular, the defendant cannot be compelled to disclose the relevant information before an action is pending.

Thirdly, the courts of the Member State of the targeted public are said to be particularly suited to determining whether or not an infringement has taken place. Through their proximity, they can assess the effect of the alleged infringement more appropriately and can more easily take evidence.

And finally, the CJEU notes that there must be some congruence between the rules for jurisdiction of the EUTMR and of the Brussels Ia Regulation which determines jurisdiction for the infringement of national marks. Otherwise, right owners might find themselves in a situation where they have to enforce their EU trademarks and their corresponding national marks in different jurisdictions, although both are infringed by the very same acts.

### Outlook

The CJEU handed down a balanced decision that provides right owners with the necessary degree of choice for their enforcement. The court acknowledged the difficulties trademark owners were faced with after the "Coty" decision of the German Federal Court of Justice, and has provided clear and consistent guidance on the circumstances under which online infringers can be sued out of their home jurisdiction.

It must of course be borne in mind that Art. 125 (5) EUTMR in any event only affords a limited scope of jurisdiction for "*acts committed or threatened within the territory of the Member State*" pursuant to Art. 126 (2) EUTMR. With that caveat in mind, the CJEU's ruling boosts the attractiveness of EU trademarks as bases of claims to combat cross-border online infringements. More often than not, the test applied by the CJEU will even provide trademark owners with the advantage of a "home match", relieving them from the additional costs of enforcing their rights abroad. And

correspondingly, the decision also affects portfolio strategy. While the "Coty" decision may temporarily have boosted the importance of national registrations, EU trademarks have now been restored to their rightful place.

Co-authors: Anthonia Ghalamkarizadeh and Florian Richter, Hogan Lovells International LLP

Posted by: Anthonia Ghalamkarizadeh @ 15.06

Tags: [AMS Neve](#), [Heritage Audio](#), [international jurisdiction](#), [CJEU](#), [EUTM](#), [trademarks](#), [online infringement](#), [online enforcement](#) ,

Perm-A-Link: <https://www.marques.org/blogs/class46?XID=BHA4794>

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MONDAY, 7 OCTOBER 2019

## Specialized chambers at the EU General Court and authorisation requirement for appeals

Petra Goldenbaum of the European Trade Mark Law and Practice Team provides a report on recent developments at the CJEU.



In the context of the reform of the structure of the courts of the European Union, the following two changes can be reported:

### Specialised chambers at the General Court

The gradual increase in the number of judges at the General Court over the past few years now has been completed and its last step also included the introduction of specialised chambers which applies since 26 September 2019.

A total of 53 judges make up a total of 10 chambers of five or six judges each, with the following distribution of cases:

- Six of these chambers deal with all cases of intellectual property (in 2018: 301 out of a total of 732 cases).
- The other four Chambers deal with all staff cases (2018: 93 out of 732 cases).
- The remaining cases (2018: 338) are distributed among all 10 Chambers.

For further details see [Press Release no. 111/19](#).

MARQUES has always supported the creation of an appropriate number of specialised chambers dealing with IP



appropriate number of specialised chambers dealing with IP matters, so this announcement is good news, in particular in view of the following change which already became effective as of 1 May 2019:

### Authorisation requirement for appeals

The Court of Justice has adopted new rules on whether or not to allow appeals to proceed.

Since 1 May 2019, when an appeal in IP matters is lodged with the Court of Justice, in addition to the statement of the grounds of appeal, any appeal must be accompanied by a request that the appeal be allowed to proceed. In this request – which must not exceed seven pages – it has to be set out, clearly, the issue raised by the appeal that is significant with respect to the unity, consistency or development of EU law.

If there is no such request, the appeal itself will be declared inadmissible.

If the request complies with the formal requirements prescribed, the Court of Justice, by a Chamber specially established for that purpose, will rule whether or not the appeal is to be allowed to proceed.

That means that there now is an additional filter: there will not be any automatic appeal proceedings, but the appeal has to be authorised.

For further details see [Press Release no. 53/19](#).

*Petra Goldenbaum is Counsel with CMS Hasche Sigle Partnerschaft von Rechtsanwälten und Steuerberatern mbB in Hamburg and Co-Vice-Chair of the [MARQUES ETMLP Team](#)*

Posted by: Blog Administrator @ 14.00

Tags: [CJEU](#), [ECJ](#), [General Court](#),

Perm-A-Link: <https://www.marques.org/blogs/class46?XID=BHA4793>

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FRIDAY, 4 OCTOBER 2019

## GREECE: EUTM filing seminar by EUIPO in Athens



that EUIPO is holding a seminar on EUTM filing in Athens, next Tuesday, 8 October. For additional info, agenda and registration see [here](#).

The event will be held in the Novotel Hotel in downtown Athens. Attendance is free, but will require registration. Oh, and the seminar is in English...

Posted by: Nikos Prentoulis @ 09.51

Tags: [Greece](#), [EUIPO](#), [EUTM](#), [filing](#), [seminar](#), [Athens](#),  
Perm-A-Link: <https://www.marques.org/blogs/class46?XID=BHA4792>

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FRIDAY, 4 OCTOBER 2019

## Madrid System webinars from WIPO

WIPO is hosting two more webinars on the Madrid System this year. They are aimed at intermediate and advanced level users, to help them better manage their international registrations.

The webinars are:

**Dealing with Corrections in the International Register**, Wednesday, 30 October, 4:00pm Geneva time. [Learn more and register](#)



**Requesting Certified Documents from the Madrid Registry**, Wednesday, 27 November, 4:00pm Geneva time. [Learn more and register](#)

The webinars will be presented by WIPO experts, who will answer any questions raised. To register for a webinar, complete the online registration form. You will receive an email with a link and personal access code. You can join the webinar via your PC or by dialling in by phone.

You can also listen to recorded webinars on the [All webinars](#) button on the Madrid webinar page.

If you have questions or suggestions for topics for future webinars, please [contact WIPO](#).

Posted by: Blog Administrator @ 08:53

Tags: [Madrid System](#), [WIPO](#), [webinars](#),  
Perm-A-Link: <https://www.marques.org/blogs/class46?XID=BHA4791>

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