

# Foreign Case Law Update

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Exhibit  
Exhibit A Trademark Case Law Throughout the World. . . . . 4-13

## I. Argentina

### A. Confusion

The Court of Appeals for Federal Civil and Commercial Matters held that YUKON for real estate services was not confusingly similar to YUKON for the sale of fire extinguishers. *World Trademark Law Report*, June 17, 2004.

### B. Mediation

In *Instituto Sidus SA v Astra Aktiebolag*, the Supreme Court of Justice held that the time frame for mediation need not be limited to one year. Mediation is part of the procedure for trademark oppositions in Argentina. The Court reasoned that limiting mediation to a year would obstruct the intent of the Mediation and Conciliation Law enacted in Argentina in 1995. *World Trademark Law Report*, March 15, 2004.

## II. Australia

### A. Counterfeiting

The Federal Court ordered MJM 2000 Plus Pty Limited to pay Sony AU\$200,000 for lost profits and AU\$120,000 for costs based on counterfeit PLAYSTATION games it sold for over 5 years. *World Trademark Law Report*, April 23, 2004.

## III. Belgium

### A. Color

The Brussels Court of Appeals held that orange is a valid trademark for Veuve Clicquot Porsardin champagne. It further held that the brewer Emmanuel De Landtsheer could not use the color orange on its beer named MALHEUR BRUT RESERVE that it launched in 2001. The Court decided that color could distinguish products and that one trader would not monopolize a color in that there are many shades of every color. Lastly, the court decided that the orange beer infringed the orange champagne in that the goods are related. *World Trademark Law Report*, July 26, 2004.

### B. Non-Distinctiveness

The Antwerp Court of Appeal cancelled the registration of the mark NEWTEL owned by Newtel Essence for telecommunication equipment based on non-distinctiveness of the combined terms. The Dutch company Newtel Essence sued the Belgium company for infringement; the defendants counterclaimed for cancellation. *World Trademark Law Report*, April 23, 2004.

### C. Search and Seizure Orders

The Belgian Constitutional Court held that the Belgian Code of Civil Proceedings allows a trademark owner to obtain a search and seizure order. This order allows the court to appoint an expert to visit the defendant's premises unannounced. The judge may also allow the seizure of the infringing goods. *Linklaters' Intellectual Property News*, Issue 34, May 2004, p. 6.

#### **D. Spare Parts**

The President of the Commercial Court of Charleroi held that a former exclusive distributor of Volvo could no longer use the VOLVO trademarks. Although the ex-distributor used the word “independent” with the VOLVO trademarks on his sign, the lettering was too small for a legitimate use of a trademark by a third party to sell spare parts. Linklaters, *Intellectual Property News*, Issue 33, March 2004, pp. 7-8.

### **IV. Brazil**

#### **A. Genericness**

The Third Panel of the Superior Court held that in an infringement case, the defendant can claim that the plaintiff's mark is generic. Off Price Comercio de Roupas Ltda sued Pro Mall Empreendimentos e Participacoes Ltda, owners of a mall name Rio Off Price Shopping. The plaintiffs owned a registration for OFF PRICE. The Court held that the term was generic; therefore, the defendants could continue to use it. *World Trademark Law Report*, May 7, 2004.

### **V. Canada**

#### **A. Dilution**

The Federal Court of Appeal held that CLIQUOT for clothing did not infringe CLICQUOT for champagne. Veuve Clicquot Ponsardin sued Les Boutiques Cliquot Ltee for infringement, passing off and dilution. The Court held that mark could only be diluted if consumers associated the two, which they did not. *World Trademark Law Report*, May 19, 2004.

### **VI. China**

#### **A. Bad Faith**

The Shenzhen Intermediate People's Court held that Enotec, a German company, could stop the sale of OXYTEC, zirconia oxygen analyzers, by Hua Kang Sheng, a Shenzhen company. Hua Kang once was a distributor of Enotec, selling OXITEC analyzers produced by Enotec. When Enotec ended the distribution agreement, Hua continued to sell the product under the OXYTEC name. Hua used false documents to mislead its customers so that it appeared as an authorized distributor of Enotec. The Court also ordered Hua to pay damages of RMB 500,000. *International IP Update*, Freshfields Bruckhaus Deringer, Summer 2004 Newsletter, p. 3.

#### **B. Well-Known Marks**

The State Administration of Industry and Commerce has published 43 trademarks which have achieved well-known status under the new law for the protection of well-known marks effective in June 2003. Only trademarks involved in a dispute may benefit from a well-known mark status. All 43 of these marks were involved in infringement proceedings. *World Trademark Law Report*, March 23, 2004.

### **VII. European Court of Justice (ECJ)**

#### **A. Counterfeiting**

The ECJ held that a national court cannot impose criminal penalties under European Union (EU) law against counterfeiting if its national law does not prohibit the transit of

counterfeit goods (even if this national law contravenes EU law). Rolex, Tommy Hilfiger, and the Gap requested that the Eisenstadt Regional Court open a judicial investigation against the unidentified transporters of the respective goods that belonged to these companies. *World Trademark Law Report*, February 10, 2004.

### **B. Descriptiveness**

In *Koninklijke KPN Nederland NV v Benelux Trademarks Office*, the ECJ held that all relevant circumstances should be taken into consideration when assessing distinctiveness of a term. For those marks which consist of two descriptive words, the term will not be descriptive if the combination is unusual and creates an impression sufficiently removed from the meaning of the elements. In addition, if the two terms have acquired secondary meaning, then the term will not be held to be descriptive. *World Trademark Law Report*, April 15, 2004.

### **C. Genericness**

Procordia Food AB owns the mark BOSTONGURKA for gherkins in Sweden. Bjornekulla Fruktindustrier AB applied to revoke the mark based on its genericness. Both sides submitted surveys. The District Court in Sweden held that Procordia's survey of the distribution chain was more relevant; therefore, it prevailed. The Swedish Court of Appeal held that the relevant group was the group that dealt with the product commercially. This court referred the issue to the ECJ. ECJ Court held that the perceptions of consumers play the decisive role. The intermediaries simply try to determine what the consumers want. *Lovells Newsletter*, June 2004, pp. 9-10.

### **D. Shapes**

Proctor & Gamble and Henkel both filed CTM applications for the shapes of their washing machine and dish washer tablets. The ECJ ruled, in two separate cases, that the marks did not contain any element which gave them a distinctive character. The public was not like to use the shape to identify the origin of the product. Furthermore, the level of attention given to the products would be low. *Lovell's Newsletter*, June 2004, pp. 11-12.

### **E. Three-Dimensional Shapes**

The ECJ held that three-dimensional trademarks which reproduce the product or are packaging must fulfill the same criteria as trademarks. Therefore, if a product cannot be traded without its packing (in this case, wool detergent), then the shape of the packaging is the shape of the product itself. A trademark office must decide this type of distinctiveness based on other marks on its registry, not all marks in the European Union. *World Trademark Law Report*, April 6, 2004.

## **VIII. France**

### **A. Infringement**

The Cour de Cassation (Supreme Court) held that Estee Lauder's CLINIQUE mark was not infringed by CLINQUE ROND POINT DES CHAMPS ELYSEES for cosmetics and other similar products. The junior mark did not incorporate the senior mark to the extent it lost its individuality, in that the junior mark constitutes an indivisible whole. *World Intellectual Property Report*, Volume 18, Number 3, March 2004, p. 7-8.

## **IX. Hong Kong**

### **A. Service**

The Hong Kong Court of Appeal held that the Japanese company Yoshida & Co. Ltd., correctly served notice for an invalidation action against the mark PORTER on the law firm that represented Porter International Co. Ltd, the Taiwanese owner of the mark. The Court overturned the Court of First Instance, holding that the ordinance included court proceedings, not just proceedings before the Trademark Registrar. *World Trademark Law Report*, June 18, 2004.

## **X. Hungary**

### **A. Bad Faith**

The Metropolitan Appeal Court held that Skandinav Company registered HAGA for optical products in bad faith. The mark was therefore cancelled. Skandinav had been a distributor of Haga Optik AB which owned the mark HAGA OPTIK AB. The Appeal Court upheld the decision of the Hungarian Patent Office. *World Trademark Law Report*, March 22, 2004.

### **B. Confusion**

The Supreme Court held that the overall impression of a mark is considered when determining likelihood of confusion between WWW for clothing and WWW WHAT WE WEAR for clothing. The three Ws were the dominant part of the marks. Minor differences cannot be considered. *International Law Office*, March 15, 2004.

## **XI. India**

### **A. Reputation (International)**

The Supreme Court of India held that Allergan could stop the use of OCUFLOX, a preparation for eye care, by Milmet, an Indian company, even though Allergan had not registered or used the mark in India. In that potential harm to consumers is considerable over confusion with medicinal products, the Court held that if reputation is shown internationally, then the Court can stop use of such a mark on medicinal products in India. This case began in 1996 and was heard by two lower courts. The Supreme Court upheld the Division Bench of the Honorable Calcutta High Court which overturned a single judge from the High Court. *Milmet Oftho Industries & Ors. V. Allergan Inc.*, as reported in *INTA Bulletin*, Vol. 59, No. 14, August 1, 2004.

## **XII. Iran**

### **A. Confusion**

The appellate court held that CHEETOZ in Farsi in Classes 5, 16 and 24 was confusing to PepsiCo. Inc.'s CHEETOZ in English in Class 30 for snacks. Although the court held that the mark was not famous, it did hold that the two marks targeted the same consumers. The court overturned the Trademark Office which had rejected Pepsi's opposition to the application.

### **XIII. Israel**

#### **A. Surnames**

The Supreme Court held that Ariel McDonald, an Israeli basketball player, cannot use his surname in a Burger King commercial when he said, "Listen to McDonald – only Burger King!" Even though McDonald's used a reference from a news article that said McDonald ate at McDonald's without his permission, McDonald infringed McDonald's trademark through misuse. The Supreme Court overturned the Tel-Aviv District Court. *INTA Bulletin*, Vol. 59, No. 11, June 15, 2004. p. 6.

### **XIV. Italy**

#### **A. Confusion**

The Italian Supreme Court held that DDS did not infringe the mark D, even though the goods were the same (leather goods). In that the two marks were conceptually different, that difference would override any phonetic similarity. DDS SpA filed a declaratory judgment action seeking a holding that it did not infringe D SpA's D mark. *World Law Trademark Report*, May 27, 2004.

### **XV. Liechtenstein**

#### **A. Shape**

The Supreme Court upheld Nestle SA's action to cancel Masterfoods AG's registration for a tube shape based on its own registration for a tube shape. The Court held that the shape of the packaging did not result from the goods. It was not functional in that there were alternative shapes to be used for this type of packaging. The shape had acquired distinctiveness, overturning the Liechtenstein High Court and the Office of Harmonization in the Internal Market which both held that the naked tube shape was not used as a trademark. *World Trademark Law Report*. February 16, 2004.

### **XVI. Lithuania**

#### **A. Well-Known Marks**

In two rulings, the Supreme Court established significant guidelines for the protection of well-known marks. In *Beecham Group plc v Kalinin* (3k-3-1103/2003), the Court held that a mark need not be the best known in a given market to be well-known. Furthermore, the plaintiff must show that the mark was well-known at the time the defendant's mark was filed. In *Japan Tobacco Inc. v. Schrader-Bridgeport International Inc.* (3K-31191/2003), the Supreme Court held that identical or similar marks, though not registered for the same goods/services, can be invalidated automatically; however, the Court must determine if the registration violates rights in the well-known mark. Bad faith is one of the factors that should be considered in this determination. *World Trademark Law Report*, February 27, 2004.

### **XVII. Mexico**

#### **A. Damages**

The Supreme Court held that in order to collect statutory damages/loss of profits, the prevailing party must have a final decision of infringement in an administrative proceed-

ing from the Mexican Institute of Industrial Property (INPI). *INTA Bulletin*, Vol. 59, No. 11, June 15, 2004, p. 6.

## **XVIII. Norway**

### **A. Use**

The Court of Appeal ruled that the registration for the TRIPP TRAPP mark for furniture, even though it was only used on chairs, be maintained. The Court dismissed the cancellation action brought by Trip Trap Denmark A/S, a maker of furniture, against Stokke Gruppen AS, the registrant of the TRIPP TRAPP mark. In reversing the District Court, the Court also held that the mark was well known; therefore, it should be protected for all goods in Class 20. *World Trademark Law Report*, April 8, 2004.

## **XIX. OHIM (Office of Harmonization in the Internal Market); Community Trade Mark Office**

### **A. Confusion**

The Board of Appeal held that BUDEJOVICKY BUDVAR for beer is not confusingly similar to BUD for beer owned by Anheuser Busch. The Board upheld the Opposition Division which had rejected the oppositions filed by Anheuser against the applicant, Budejovicky Budvar there was little visual, phonetic, and conceptual meaning between the marks. That fact that the goods were identical is a lesser criterion in the confusion evaluation. *World Trademark Law Report*, March 5, 2004.

## **XX. Portugal**

### **A. Confusion**

The Supreme Court upheld both the court of first instance and the appellate court when it decided that VASP for transportation services (including books) and BRASP for distribution of books and multimedia products are not confusingly similar. The Court explained that the people who come into contact with the services and marks before the services go to the end consumer know the origin of the marks. *World Trademark Law Report*, June 3, 2004.

### **B. Surnames**

The Court of Appeals of Lisbon allowed Cascaistapa – Bares e Restaurantes Lda to use the name HEMINGWAY for a restaurant and bar. The Court overturned the Commercial Court of Lisbon which held that the mark could mislead the public and was an unfair appropriation of the name. The Court held that the mark would not cause any damage to the reputation of Hemingway and his estate. Furthermore, when looking at a historic surname, the Court must consider its universal nature, not its linguistic and territorial origins. *World Trademark Law Report*, March 19, 2004.

## **XXI. Russia**

### **A. Use**

The Commercial Court overturned a decision from the Chamber for Patent-Related Disputes which cancelled the mark MISTER NUT for nuts owned by New Factor for non-use. New Factor sold MISTER NUT nuts to a distributor who in turn sold the products to

consumers without a valid license. The Court held that New Factor was the owner of the products until they were sold to the consumer; therefore, there was use of the product in Russia.

## **XXII. Saudi Arabia**

### **A. Living Creatures**

The Review Panel overseeing the Board of Grievances held that representations of living creatures as trademarks are now registrable in Saudi Arabia. The Panel, in overturning the Committee for the Promotion of Virtue and Prevention of Vice, held that holding otherwise would damage Saudi Arabia's reputation and the interests of trademark owners. *World Trademark Law Report*, January 26, 2004.

## **XXIII. Singapore**

### **A. Counterfeiting**

The Chief Justice of Singapore has upheld a sentence for 32 months for counterfeiting for the following reasons: Singapore is a major trading center; counterfeiters must be deterred; and the interests of intellectual property owners must be protected. *World Trademark Law Report*, May 13, 2004.

## **XXIV. South Korea**

### **A. Confusion**

After losing an opposition against the BUDEJOVICKY BUDVAR and BUDWEISER BIDVAR applications of Budejovicky Budvar's before the Supreme Court, Anheuser-Busch has lost another decision before the High Court of Seoul to prevent the use of these marks in Korea. As did the other courts, the High Court of Seoul ruled that the marks were not confusingly similar to Anheuser's BUDWEISER and BUD marks. *World Trademark Law Report*, March 12, 2004.

## **XXV. Spain**

### **A. Well-Known Marks**

The Supreme Court held that a Spanish toymaker infringed Harley Davidson's mark when it placed HARLEY-DAVIDSON on a scale replica of the HARLEY-DAVIDSON motorcycle. The Court held that it was a self-evident association and that the toymaker took unfair advantage of the reputation of an earlier registered mark. *World Intellectual Property Report*, Vol. 18, No. 6, June 2004, p. 11.

## **XXVI. Sweden**

### **A. Distinctiveness**

The Swedish Patent Appeals Court held that the application of IMB Corporation for the mark @ with an "e" instead of an "a" was distinctive for e-commerce services and therefore registrable. Therefore, the Court overturned the Patent and Registration Office decision which refused registrability. The mark was already registered for computers. *World Trademark Law Report*, April 20, 2004.

## XXVII. Switzerland

### A. English Words

The Federal Commission for Intellectual Property Rights refused registration of SWISS BUSINESS HUB for advertising services in that it was descriptive. The Commission held that services were aimed at an English-speaking audience on the whole. The mark directly described the place where the services would be provided. *World Trademark Law Report*, March 9, 2004.

### B. Geographic Indications

The Federal Commission of Appeal for Intellectual Property Rights allowed the registration of VOLTERRA for energy generation and distribution services, overturning the Institute's refusal for registration because the mark is a well-known town in Tuscany. The Commission reasoned that if the country of Italy did not protect the mark as a geographic indication in that it registered as a Community trademark, then the Swiss need not protect it as such. Furthermore, it is an invented term coming volt and terra (earth). *World Trademark Law Report*, July 13, 2004.

### C. Shape

The Supreme Court held that Novartis AG's shape trademark for its catalytic disc as part of the AOSEPT contact lens cleaning system was protectible. Bausch & Lomb lost a cancellation action against the mark, arguing that it was functional. The Court held that many other shapes were available for the disc; therefore, Novartis did not hinder competition. *World Trademark Law Report*, July 2, 2004.

### D. Three-Dimensional Marks

The Swiss Supreme Court held that Swatch Group would have to submit a consumer survey to show that the battlement-shaped hinge of a watch bracelet had acquired distinctiveness. The Court upheld the Swiss Federal Institute of Intellectual Property's decision to refuse registration despite the fact that the hinge had been used for 10 years. The Institute required evidence of acquired distinctiveness. The Court held that the Institute can decide on the level of evidence it deems necessary to prove acquired distinctiveness. *World Trademark Law Report*, May 20, 2004.

## XXVIII. Thailand

### A. Reputation (International)

The Thai IP and International Trade Court held that Shin Tung Electronic Industry Co. Ltd., a Taiwanese company, had greater rights to the mark RADAR in Chinese characters for electric switches. Therefore, the Court cancelled the trademark registration for RADAR in Chinese characters, filed by a Thai individual, which blocked an application filed by Shin Tung. Shin Tung submitted evidence showing its use and reputation behind the mark in many countries outside of Taiwan since 1978. The Thai registrant had also filed criminal proceedings for trademark infringement against the distributor for Shin Tung. The prosecutor found that the distributor acted in good faith and declined prosecution. *World Trademark Law Report*, July 15, 2004.

## **XXIX. Ukraine**

### **A. Well-Known Marks**

The Kiev Economic Court recognized three graphic MCDONALD'S marks as well-known from December 5, 1996. *International Law Office*, April 26, 2004.

## **XXX. United Kingdom**

### **A. Geographic Indication**

The Court of Appeal held that MEZZACORONA was not a geographic area recognized by European Union law for wine production. Cantine Mezzacorona filed an application for MEZZACORONA for wine. Miguel Torres, a Spanish wine producer opposed it. The Court dismissed the opposition based on the fact that the Mezzacorona area in Italy was not well-defined and that all the grapes used in the wine did not come from that area. *World Trademark Law Report*, March 19, 2004.

### **B. Surnames**

The Court of Appeal dismissed ST Dupont's opposition against the application DUPONT filed by El Du Pont de Nemours & Company for clothing. Even though the mark is a common surname in France, the mark was still distinctive if it was capable of distinguishing clothing in the UK. The Court held that DuPont used the mark extensively on fabrics; therefore, it could distinguish clothing. Furthermore, the Court held that ST DuPont's use of the mark on clothing was insufficient to prevent registration by Du Pont. *World Trademark Law Report*, January 16, 2004.

## **XXXI. United States**

### **A. Counterfeiting and Damages**

Gucci America Inc. Sued Daffy's Inc., a retailer, for selling counterfeit GUCCI purses and requested an injunction. When Daffy's received the purses, it had a Gucci employee at a Gucci store verify that the purses were not counterfeit. Daffy's also sent a bag to Gucci for repair. It was returned and repaired with no comment. The U.S. Court of the Fifth Circuit upheld the district court ruling which denied a recall order of all purses sold. The Court held that injunctive relief and an award of profits were not merited in that there was no willful infringement. Furthermore, Gucci did not suffer tarnishment of its mark in that the bags were of high quality. *BNA's Patent, Trademark and Copyright Journal*, Vol. 67, No. 1653, January 9, 2004, p. 202.

### **B. Holding Company**

The Supreme Court refused to hear a case from the Maryland Court of Appeals on holding companies. The Maryland court held that the two holding companies in question had no substance as separate business entities in Delaware to warrant their status as a holding company. Neither company had a full time employee; the offices in Delaware were no more than mail drops. Therefore, an appropriate proportion of the royalty income received by the holding companies was taxable as corporate income in Maryland. *The World Licensing Report*, Vol. 6, No. 2, February 2004.

**C. Trade Dress**

The U.S. Court of Appeals for the Eleventh Circuit held that the design of a frozen ice cream product was functional in that the product design affected the taste and quality of the ice cream; therefore, there was no infringement of the DIPPIN' DOTS product by Frosty Bites Distributors, LLC. Because the method described in the patent affected the shape and size of the final product, and because the shape of size affected the quality of the taste, the method was functional. *BNA's Patent, Trademark and Copyright Journal*, Vol. 68, No. 1672, May 21, 2004, p. 70.



**Exhibit A**  
**Trademark Case Law Throughout the World**

**Trademark Case Law  
Throughout The World**

ICLE 2004 International  
Trademark Forum

Tuesday, October 19, 2004  
WMU Graduate Center, Grand Rapids, MI

Wednesday, October 20, 2004  
Oakland Center, Rochester, MI

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**Trademark Case Law  
Throughout The World**

- ◆ Registrable marks
- ◆ Famous Marks
- ◆ Counterfeiting
- ◆ Miscellaneous

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### Registrable Marks

- ✦ NEWTEL is non-distinctive for telecommunications equipment (Antwerp Court of Appeal; defendant cancels plaintiff's mark that is basis for infringement suit)
- ✦ OFF PRICE for a shopping mall is generic (defendant strikes again), Third Panel of the Superior Court of Rio

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### Registrable Marks (cont'd)

- ✦ BOSTONGURKA for gherkins not generic because survey focusing on consumers more relevant (District Court in Sweden and ECJ)
- ✦ Shapes of washing machines non-distinctive; level of attention low (ECJ)
- ✦ Three-dimensional shapes registrable if distinctive like TM's; each TMO must decide (ECJ)

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### Registrable Marks (cont'd)

- ✦ Ariel McDonald, an Israeli basketball player, cannot use his name in a Burger King commercial; misuse (Supreme Court)
- ✦ Nestlé's tube shape for candy is distinctive and non-functional; Nestlé can cancel similar tube shape (Liechtenstein Supreme Court)

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**Registrable Marks (cont'd)**

- ✦ Restaurant could use HEMINGWAY since the universal nature is limited (The Court of Appeals of Lisbon)
- ✦ Representations of living creatures are registrable (Saudi Review Panel)
- ✦ @ with an "e" is registrable by IBM for e-commerce services (Swedish Patent Appeals Court)

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**Registrable Marks (cont'd)**

- ✦ SWISS BUSINESS HUB is not registrable for advertising services; descriptive when aimed at English speakers (Federal Commission for Intellectual Property Rights)
- ✦ Catalytic disc for part of AOSEPT cleaning system for contact lenses is non-functional; other discs can be used (Swiss Supreme Court)

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**Registrable Marks (cont'd)**

- ✦ Hinge on SWATCH watches needs a survey to show acquired distinctiveness (Swiss Supreme Court)
- ✦ Design of DIPPIN' DOTS affected shape, size and taste of product (method patent), so shape is functional; no infringement against Frosty Bites (US CA 11<sup>th</sup> Cir.)

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### Famous Marks

- ♦ Orange is a valid TM for Veuve Clicquot's champagne; Emmanuel De Landsheer cannot use orange on its beer (Brussels Court of Appeals)
- ♦ CLIQUOT for clothing does not infringe CLICQUOT for champagne; users don't associate the two (Canadian Federal Court of Appeal) Win some, lose some

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### Famous Marks (cont'd)

- ♦ Former distributor can no longer use VOLVO on his sign for parts; "independent" too small (Belgium: President of the Commercial Court of Charleroi)
- ♦ The State Administration of Industry and Commerce in China listed 43 famous marks in June; none was a US mark; list will evolve. Stay tuned.

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### Famous Marks (cont'd)

- ♦ CLINIQUE ROND POINT DES CHAMPS ELYSEES for cosmetics does not infringe CLINIQUE for cosmetics. Senior mark did not lose its individuality (French Supreme Court)
- ♦ Allergan could stop use of OCUFLOX, a preparation for eye care, based on its international reputation; greater protection for medicinal products (no registration in India) (Supreme Court)

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**Famous Marks (cont'd)**

- ◆ CHEETOS in Farsi confusing to CHEETOS in English, even though mark not famous (Iran Appellate Court)
- ◆ OHIM Board of Appeal held that BUDEJOVICKY BUDVAR is not confusingly similar to BUD (visual, phonetic and conceptual)
- ◆ Similar holding by South Korean Supreme Court

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**Famous Marks (cont'd)**

- ◆ Spanish toymaker cannot put HARLEY-DAVIDSON on scale replica (Supreme Court)
- ◆ Thai distributor could not register RADAR in Chinese characters for electric switches based on the international reputation held by Taiwanese owner of mark (Thai IP and International Trade Court)

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**Counterfeiting**

- ◆ Australian company paid \$230,000 to Sony for counterfeit PLAYSTATION games sold over 5 years (Federal Court)
- ◆ A court can appoint an expert to visit premises unannounced and seize goods (Belgian Constitutional Court)

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### Counterfeiting (cont'd)

- ◆ A national court cannot impose criminal penalties if its law does not prohibit transport of counterfeit goods (ECJ)
- ◆ The Chief Justice of Singapore upheld a 32 month sentence because Singapore is a major trading center and counterfeiters must be deterred.

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### Counterfeiting (cont'd)

- ◆ The US CA for the 5<sup>th</sup> Cir. refused damages to Gucci because the counterfeit product was of high quality, and Gucci itself repaired the bag without comment. No willful infringement.

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### Miscellaneous

- ◆ Maryland Court of Appeals held that two holding companies in Delaware were not separate business entities; had to pay income tax in Maryland (SC refused to hear case)
- ◆ The Metropolitan Appeal Court in Hungary refused registration of HAGA for optical products by former distributor based on bad faith

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**Miscellaneous (cont'd)**

- Trader could not use OXYTEC for oxygen analyzers. Former distributor of Entorec which used OXITEC. Bad faith. \$61,000 in damages paid (Shenzhen Intermediate People's Court in China)
- The use of a mark by a distributor who sold without a proper license is use of goods in Russia (Commercial Court)

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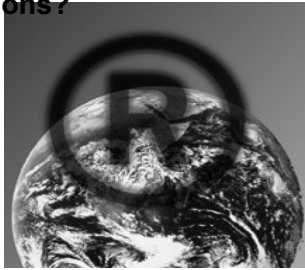
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**Questions?**



[www.brinkshofer.com](http://www.brinkshofer.com)

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