

MARQUES members meet Spanish judges

MARQUES recently organised the first in a series of meetings with judges of CTM courts. Cristina Duch reports on the discussions.

As part of its activities to promote the debate on and knowledge of the socio-economic function of trade marks and their legal aspects in society, MARQUES has launched a programme of conferences, with the aim of developing study and collaboration between trade mark holders and the judges of the Community trade mark (CTM) courts in various EU countries.

The first of these meetings was organised together with OHIM and took place in Alicante on 11th June. The session was opened by Guido Baumgartner (MARQUES Vice-chair) and Joao Miranda de Sousa (Director of the General Affairs and External Relations Department at OHIM).

The seminar focused on the Spanish CTM courts and included presentations from four judges: one of the Court of First Instance (Mr Rafael Fuentes Devesa) and three from the Court of Appeal (Mr Francisco José Soriano Guzmán, Mr Luis Antonio Soler Pascual and Mr Enrique García-Chamón Cervera).

There were four main topics for the presentations: (1) jurisdiction and competence of the CTM courts – objective and territorial competence; (2) unfair

competition – passing off actions and their links to CTM infringement; (3) CTM infringement part I – risk of confusion, association and impact of well-known marks; and (4) CTM infringement part II – the outcome of infringement, with special reference to recovering damages.

These presentations were followed by open discussions between the judges and seminar participants. The discussion were chaired by Guido Baumgartner, Jennifer Powers (MARQUES Council and member of the Unfair Competition Team), Joao Miranda de Sousa and Cristina Duch (MARQUES External Relations Officer).

More than 50 people attended and the debates were lively. MARQUES has sent a CD to participants containing the presentations and some other documentation of the event.

MARQUES wishes to thank the Spanish judges for having participated with such enthusiasm in this project. Thank you also to the OHIM for hosting the event and helping to organise it. And finally many thanks to all the attendees who made possible the success of the event.



Cristina Duch

MARQUES is now working on the organisation of the next meeting with CTM Judges from another jurisdiction, which is planned to be in Winter 2009.

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Contents:

MARQUES sponsors guide for new gTLDs	2
Landmark decisions on auction websites in Germany and France	3
Auction websites given greater responsibility	4
New IP law in Iran	4
Companies names dispute resolution launched in UK	5
Company names: France, Spain, Netherlands	6-7
How trade dress is treated in Argentina	8
New GI rules in Indonesia	9
Versace wins cancellation action in Israel	10
Formal Notice of Annual General Meeting of the Association 2008	11
Interview: Guido Baumgartner	12



Landmark decisions on auction websites in Germany and France

Below, Kay-Uwe Jonas and Katja Grabienski describe a recent German decision that imposes tougher requirements on online auction sites, and examine which issues need further clarification. Overleaf, Nathalie Dreyfus examines a recent case between Hermès and eBay in France.

In a decision on 30th April 2008 (Docket-No I ZR 73/05 – Internet-Versteigerung III), the German Federal Court of Justice (FCJ) confirmed that providers of online auction websites have duties going beyond the blocking of individual account names upon notice of trade mark infringements. The FCJ also more precisely defined the requirements when use in the course of trade can be assumed. This decision expressly leaves room to clarify further factual questions (for example, which filters and controls may have to be implemented) in possible subsequent proceedings, such as if the plaintiff claims violation of the decision by the defendant when further similar cases of trade mark infringement appear as offers on the specific online auction site.

The same case was already the subject of the FCJ's decision "Internet-Versteigerung I" (Docket-No I ZR 304/01 in 2004). The plaintiff produces watches under the famous trade mark ROLEX. The defendant operates the internet platform Ricardo. Ricardo is an online auctioneer comparable to eBay. Third parties had offered imitated ROLEX watches for sale via the Ricardo platform. The plaintiff sued the defendant for tolerating online auctions of obviously counterfeited ROLEX watches. In its first decision, the FCJ decided that providers of online auction websites might be held liable if goods infringing trade mark rights were sold via their platforms. The FCJ had remanded the case to the Appeal Court, since it found it was not sufficiently clarified whether the relevant offers on the internet platform had been

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made in the course of trade. After a further decision of the Appeal Court, the parties again took the case to the FCJ, which now clarified the requirements for use of a trade mark in the course of trade when offering products via an internet auction platform.

Use in the course of trade

The FCJ held with regard to use in the course of trade that:

a designation is used in the course of trade if the use is in connection with a commercial activity aiming for a commercial advantage and not in the private sector. Considering the interests of trade mark protection, the requirements to fulfil this presupposition are not high. An activity in the course of trade stands to reason in those cases where the offerer deals with similar goods on a continuing basis, in particular also with new products. Also, if an offerer has only recently purchased the goods now offered, this indicates dealing in the course of trade. The fact that the offerer usually acts on a commercial basis also indicates a use in the course of trade.

As further indications – which were relevant in this case – the FCJ mentioned the frequent sale of possibly infringing goods, indicated by so-called feedbacks provided by former purchasers. The burden of substantial argumentation and proof initially lies with the plaintiff. However, the FCJ held that if the infractions described above are brought forward by the plaintiff, the defendant would have to substantially argue against the assumption of use in the course of trade. In this regard, the defendant apparently stated that he could not substantiate his argument due to data protection reasons. It is not clear how data protection reasons might hinder the defendant's argument. The FCJ merely stated that due to lack of further explanation, this argument is irrelevant for the case. Since the indications argued by the plaintiff that use in the course of trade had taken place were not substantially questioned by the defendant, the unsubstantiated argument that due to data protection reasons no



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further argument against use in trade could be provided by the defendant was not sufficient.

The FCJ again confirmed that the internet auction platform is obliged to block any specific offer including trade mark-infringing products once this is brought to its knowledge. Furthermore, the FCJ held that the internet auctioneer platform also has to take precautionary measures that, to the extent possible, no further similar trade mark infringements can take place. These further measures in detail are subject to the requirement that the necessary effort is reasonable (filter procedures and possibly subsequent manual controls). Since in this case the defendant did not state that any verifications or controls were conducted, the FCJ did not have to decide which measures would be reasonable. However, the FCJ clearly stated that in possible subsequent proceedings the internet auction platform could argue that in the specific case of a new trade mark infringement, this could not have been prevented with reasonable effort.

Summarising, one will have to await possible subsequent proceedings following this decision to get clarity on the question of which measures have to be implemented by internet auction platforms to avoid trade mark infringement.

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