

TM5

Raising Awareness about
Trademark Infringement



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1. Case topic		MORISON INDUSTRIES PLC v. CPL INDUSTRIES LTD	
2. Country		Nigeria	
3. Case citation (Title, Court and Case No.)		(2021) LPELR-52981 (Court of Appeal)	
4. Date of order or judgment		Friday, January 29, 2021	
5. Type of infringing goods (categories)		Pharmaceutical	
6. Parties			
	Right Holder (Plaintiff)	CPL INDUSTRIES LIMITED (Respondent)	
	Infringer (Defendant)	MORISON INDUSTRIES PLC (Appellant)	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

The Respondent, who was the Claimant at the trial court instituted this action against the Appellant claiming that the packaging of the Appellant's product infringed its registered trademark registered as RTM 40551 for "CONPHAMOL AND DEVICE". At the conclusion of the trial, the learned trial Judge found and held that the Appellant infringed the Respondent's trademark and therefore entered judgment in favour of the Respondent. Aggrieved by this judgment the Appellant appealed to the Court of Appeal. The Court of Appeal formulated the following issue for determination; "whether the trial Court was right in holding that the Respondent's registered trade mark, RTM 40551 for "CONPHAMOL AND DEVICE" has been infringed by the Appellant.?" In determining the issue, the learned judge considered Sections 4 to 7 of the Trade Marks Act. He noted that the use of the phrase "likelihood to deceive or cause confusion in the course of trade", in Section 5(2) provides the yardstick in determining the question of infringement. The CA explained that it is the duty of the judge to examine the marks and decide whether one is likely to be confused by a user/consumer with the other in the course of trade, especially if one product is seen in the absence of the other, and not necessarily side by side. The packaging of the respondent's product and that of the Appellant have different colours, blue and orange colors, but the same design or mark and neither 'MSJ' nor 'MORISON' registered by the Appellant as RTM 30507 and 30511 appear on its packaging as a distinguishing feature of her company's paracetamol drug. After a close examination of both packaging (which were in black and white in the record of appeal) and careful perusal of the evidence the CA agreed with the trial court's findings that the packaging of both parties are identical, in such a way that they will cause confusion especially if the Appellant's paracetamol product is seen in the absence of the Respondent's Conphamol.



1. Case topic	TOYOTA MOTOR CORPORATION v. SUBAYA METALWARE (NIG) LTD & ANOR	
2. Country	Nigeria	
3. Case citation (Title, Court and Case No.)	(2017) LPELR-45368(CA)	
4. Date of order or judgment	2017-12-29	
5. Type of infringing goods (categories)		
6. Parties		
	Right Holder (Plaintiff)	SUBAYA METALWARE (NIG) LTD
	Infringer (Defendant)	TOYOTA MOTOR CORPORATION
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

This was an appeal challenging the decision of the lower court to award damages of NGN500,250,00.00 (Approximately USD1,390,000.00) against Toyota Motor Corporation ("Appellant"). Subaya Metalware Nigeria Limited ("1st Respondent") had registered LEXUS as a trademark in classes 9 and 11, amongst other classes. Toyota had also filed trade mark applications to register LEXUS & DEVICE in classes 9 and 11. The lower court held that filing the said trade mark applications and the Registrar of Trademarks' publication of the same in the Trademarks Journal are acts of trademark infringement and passing off by Toyota. The Court of Appeal disagreed with the submissions of the 1st Respondent and the decision of the lower court that the fact that Appellant filed applications with respect to the registration of confusingly similar mark, "LEXUS & Device" will amount to an infringement of the Plaintiff's existing trade mark.

section 18 of the Trademark Acts empowers any person claiming to be the proprietor of a Trade mark used, or proposed to be used by him who is desirous of registering it must apply to the Registrar of Trade marks in the prescribed manner, and also provides for publication of notice of application by the Registrar whereas Section 19 makes provisions for opposition or objection to registration. The court held that compliance with the unambiguous provisions of a Statute, the Trademarks Act, cannot in law amount to infringement of a right which is available to a proprietor of a Trade mark and that the Appellant has a legal right to make an application for the registration of Trade mark proposed to be used under Section 18 of the Trade Marks Act, the motive for such application or reasons motivating the application is clearly irrelevant to its validity.

Therefore Toyota's trade mark applications for LEXUS and the publication of the same in the Trademarks Journal by the Registrar, do not amount to use in the course of trade and, therefore, cannot constitute trademark infringements.



1. Case topic	Nkiru Emchebe V Ceto International Nigeria Limited	
2. Country	Nigeria	
3. Case citation (Title, Court and Case No.)	(2018) 11 NWLR (PT. 1631) 520(Court of Appeal)	
4. Date of order or judgment		
5. Type of infringing goods (categories)	Alcoholic drink	
6. Parties		
	Right Holder (Plaintiff)	Ceto International Nigeria Limited (Respondent)
	Infringer (Defendant)	Nkiru Emchebe (Appellant)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

This appeal sought to challenge the decision of the Federal High Court which granted an interlocutory injunction to restrain the Appellant from trading or dealing in alcoholic products branded ALIZE. The interlocutory injunction was granted in favour of the Respondent, a competitor of the Appellant in the local market, who instituted a trademark infringement action against the Appellant on the basis of a Power of Attorney issued to the Respondent by the foreign licensor.

In a well-considered judgment, the Court of Appeal observed that the Respondent had sought to protect the justiciable interest of its Principal, but that the Power of Attorney donated to it covered only registration of products with National Agency for Food and Drug Administration and Control (NAFDAC), and not commencement of a court action. Therefore, the action ought to have been brought in the name of the Principal or in a representative capacity, not as an agent of a disclosed Principal. The Court of Appeal held that the Respondent lacked the requisite locus standi to institute the trademark infringement action in its own name at the Lower Court. The Court subsequently struck out the suit and vacated the Lower Court's order for interlocutory injunction made against the Appellant.



1. Case topic	Piaggio C.S.P.A. vs. Autobahn Techniques Limited & Registrar of Trade Marks	
2. Country	Nigeria	
3. Case citation (Title, Court and Case No.)	FHC/L/CS/1307/12	
4. Date of order or judgment	November 30 2017	
5. Type of infringing goods (categories)	Scooters	
6. Parties		
	Right Holder (Plaintiff)	Piaggio C.S.P.A (Appellant)
	Infringer (Defendant)	Autobahn (Respondent)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

This was an appeal which flowed from the decision of the Registrar of Trade Marks to the Federal High Court. Piaggio has a global business and it uses various trade marks including the word Piaggio and a hexagonal device. Piaggio registered its trade marks in Nigeria, before going on to appoint Nigerian company, Autobahn Techniques, as its local distributor. The relationship did not last and in 2010, Autobahn Techniques filed seven trade mark applications for the word Piaggio together with the hexagonal device. Piaggio opposed these applications on the basis that Autobahn Techniques could not claim to be the true proprietor of the trade mark. Autobahn Techniques, in turn, applied to cancel Piaggio's registrations for non-use. The Registrar of Trade Marks held that the goodwill attached to the APE and PIAGGIO trademarks reside in the Respondent (i.e. the Applicant) and not the Appellant, since the trade in PIAGGIO and APE branded products in Nigeria was carried on by the Respondent. On the strength of this conclusion, the Tribunal went further to cancel and expunge the Applicant's existing trademark registrations for APE and PIAGGIO on the Register. On appeal to the Federal High Court the Appellant contended that in view of the undisputed fact that all trading activities carried out by the Respondent in respect of the PIAGGIO branded products in Nigeria were pursuant to the authorization and active support of the Appellant, the goodwill in the business resides in the Applicant as the true proprietor of the trademark. The Appellate Court agreed with the Appellant's submissions and held that the goodwill in the business of PIAGGIO branded products in Nigeria vests on the Appellant who is the true proprietor and was actively involved in the trading activities for PIAGGIO products within Nigerian. To this end, the Court held that the Respondent's trademark applications were unlawful and must be refused.

Instructively, the Appellate Court also agreed with the Appellant's counsel submissions that the Trademarks Opposition Tribunal adjudicating on the registrability of trademark applications lacked the requisite jurisdiction to cancel and expunge subsisting registered trademarks, especially in the face of non-compliance with Sections 31(1) and 38(1) of the Trademarks Act, as well as Regulation 83 of the Trademarks Regulation, which lay down the grounds and procedure cancellation of trademarks. Consequently, the Court reversed the Tribunal's decision removing the Applicant's subsisting registered trademarks from the Register.



1. Case topic	BRITISH AMERICAN TOBACCO NIGERIA LTD V. INTERNATIONAL TOBACCO COMPANY PLC & ANOR	
2. Country	Nigeria	
3. Case citation (Title, Court and Case No.)	(2013) 2 NWLR (Pt. 1339) 493 (Court of Appeal)	
4. Date of order or judgment	4th day of June, 2012	
5. Type of infringing goods (categories)		
6. Parties		
	Right Holder (Plaintiff)	BRITISH AMERICAN TOBACCO NIGERIA LTD(Appellant)
	Infringer (Defendant)	International Tobacco Company PLC (Respondent)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

The Appeal which arose from the judgment of the Federal High Court on an 'Inquiry as to Damages', following the discharge of an Anton Pillar order of search and seizure earlier made in favour of the Appellant. The Court of Appeal agreed with Respondent counsel's submissions that a party against whom an Anton Pillar order was obtained but later discharged is not automatically entitled to exemplary and aggravated damages. The issue which the court would consider in determining eligibility for exemplary or aggravated damages is whether the Claimant's application for Anton Pillar order was tainted with malice, fraud, insolence, cruelty or flagrant disrespect of the law, or whether the execution of the order of court was done contrary to the terms of the order.

The court further held that although a party may pray for special damages in relation to a discharge of Anton Pillar orders against it, the party seeking special damages must prove his entitlement to such special damages by credible evidence of such character as would suggest that he is indeed entitled to the award.



1. Case topic	Trade mark infringement - test for likelihood of confusion	
2. Country	South Africa	
3. Case citation (Title, Court and Case No.)	Plascon-Evans Paints Ltd v Van Riebeeck Paints 1984 (3) SA 623 (Appellate Court)	
4. Date of order or judgment	1984-05-21	
5. Type of infringing goods (categories)	Paints	
6. Parties		
	Right Holder (Plaintiff)	Plascon-Evans Paints Limited (Appellant)
	Infringer (Defendant)	Van Riebeeck Paints (Pty) Limited (Respondent)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	MICATEX	MIKACOTE

8. Outline (summary) of the case

The appellant, a company dealing in paints and allied products, is the proprietor of the registered MICATEX trade mark. It was registered on 13 September 1971 in respect of the following goods falling within class 2 of the fourth schedule of the Trade Marks Regulations, 1963 (the regulations current at the time of registration):

"Paints, varnishes (other than insulating varnish), enamels (in the nature of paint), distempers, lacquers, preservatives against rust and against deterioration of wood and anti-corrosives, all containing mica".

The respondent is a company also carrying on business as a dealer in paints and allied substances. Early in 1980 the appellant instituted High Court proceedings against respondent in the Cape Provincial Division, alleging that respondent was using a mark, MIKACOTE, which infringed appellant's registered trade mark and also was wrongfully passing off its goods as being those of the appellant; and claiming interdicts against infringement and against passing off and consequential relief. The application was opposed by respondent, which also applied for the striking out of certain passages in a replying affidavit filed by appellant.



In addition to the notable "Plascon-Evans Rule" that applies to factual disputes in motion proceedings often used by our courts, the overall test to be applied in determining whether two marks are confusingly similar was summarised in the case as follows:

1. Similarities and differences between the marks;
2. Assessment of impact defendant's mark would make upon average type of customer likely to purchase the kind of goods;
 - Notional customer: person of average intelligence, proper eyesight and buying with ordinary caution
3. comparison with reference to the sense, sound and appearance of marks;
4. Marks must be viewed as they would be encountered in the market place and against the background of relevant surrounding circumstances;
5. Marks must be considered side by side and separately;
6. Make due allowance for fact that ordinary purchaser may encounter defendant's goods with an imperfect recollection of the registered mark;
7. If each mark contains a dominant/main feature or idea: take into account the likely impact of this on the consumer's mind;
 - Marks are remembered by general impression or some significant or striking feature rather than photographic recollection of the whole.
8. Manner in which marks are likely to be employed (E.g. use of name marks in conjunction with generic description of goods).

The "Plascon-Evans Rule" holds that when factual disputes arise in circumstances where the applicant seeks final relief (i.e. interdicts), the relief should be granted in favour of the applicant only if the facts alleged by the respondent in its answering affidavit, read with the facts it has admitted to, justify the order prayed for. Essentially, the rule allows the courts, in certain circumstances, to make a determination on disputes of fact in application proceedings without having to hear oral evidence and on the respondent's written version of events. A denial by the respondent of a factual allegation in the applicant's founding affidavit must be real, genuine and bona fide before it can be considered prohibitive to the applicant being granted final relief.

After applying the above principles, the court held that the appellant established an infringement of its registered trade mark Micatex by the use by respondent of its mark Mikacote.



1. Case topic		Counterfeit Goods	
2. Country		South Africa	
3. Case citation (Title, Court and Case No.)		Puma AG Rudolph Dassler Sport v Rampar Trading (Pty) Ltd and Others [2011] 2 All SA 290 (Supreme Court of Appeal)	
4. Date of order or judgment		2010-11-19	
5. Type of infringing goods (categories)		Shoes	
6. Parties			
	Right Holder (Plaintiff)	Puma AG Rudolph Dassler Sport (Appellant)	
	Infringer (Defendant)	Rampar Trading (Pty) Limited (First Respondent)	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case

The Supreme Court of Appeal (SCA) upheld an appeal against an order of the KwaZulu-Natal High Court, (Durban) and held that the shoes imported by the respondents were counterfeit.

The respondent is the owner of a chain of retail shoe stores known as Dodo's and has a budget line under its name mark together with a device mark incorporating a stylised letter D. A consignment of shoes, imported by the respondent, was detained on suspicion that the shoes were counterfeits of the appellant's brand PUMA, and were later seized by the police.

The respondent then proceeded to file an application in the Durban High Court for an order setting aside the warrant and the search and seizure. The respondent furthermore sought an order in terms of s 7 (4) of the Counterfeit Goods Act 37 of 1997, that the goods were not counterfeit and they should therefore be returned. The court a quo found in favour of the respondent and granted the order in terms of s 7 (4) of the Act and neglected to deal with the issue of whether the shoes were indeed counterfeit. The appellant's then proceeded to lodge an appeal against this decision.

The respondent argued that his shoes could be distinguished from that of the appellant's as it contained the presence of a prancing dragon and the Dodo device mark on the heel and the name Dodo Sport on the side which was distinguishable from the Puma trade marks of the appellant. The court dismissed this argument, contending that the marks do not come close in comparison to the split form strip so as to distinguish nor could it be viewed as ornamentation.

The SCA had to decide whether the respondent discharged the onus on it, in terms of s 7 (4) of the Act, to show that the goods in question were not counterfeit, and whether actual cloning of a product was required. The SCA found that counterfeiting was possible without cloning. The fact that the appellant may not have produced a shoe bearing the particular trade mark was not an indication that the shoes imported by the respondent were not counterfeit. 'Counterfeiting' is defined in s 1(1) in a somewhat opaque manner but one thing is clear: it is not the same as copyright or trade mark infringement – it requires more. This follows from the proviso to this definition, namely that 'the relevant act of counterfeiting must also have infringed the intellectual property right in question'. And it follows from the fact that the Act did not refer back to or reproduce the definitions of infringement in the IPR statutes. This appears to be logical because 'to counterfeit' ordinarily means to make an imitation of something in order to deceive or to make a copy of something.

The SCA considered whether the marks applied to the respondents shoes are 'the subject matter' or 'a colourable imitation' of the appellant's trade marks in terms of the Act. It was decided that to be 'the subject matter', the respondent's mark must be identical to the appellant's Puma trade mark, whereas an 'imitation', is essentially a copy and the word 'colourable' merely affirms that the copy is counterfeit. It was on this premise that the court concluded that 'calculated to be confused with', or 'taken as being' the registered trade mark, as stated in the Act, involves a deliberate and fraudulent infringement of trade marks. This test is not the same as the standard trade mark infringement test of 'likely to deceive or cause confusion but counterfeiting, by its very nature, amounts a fortiori to trade mark infringement.

The appellant initially relied on five marks, which during argument it reduced to two, one of which had not been registered at the time of seizure and therefore the appellant was only left with one mark, called its split form strip, registered under no. 2004/14412. The SCA held that there could be little doubt from the evidence presented that the shoes of the respondent were counterfeit.



1. Case topic	Trade mark infringement - confusing similarity related to online infringement	
2. Country	South Africa	
3. Case citation (Title, Court and Case No.)	Yuppiechef Holdings (Pty) Ltd v Yuppie Gadgets Holdings (Pty) Ltd [2016] ZASCA 118 (Supreme Court of Appeal)	
4. Date of order or judgment	2016-09-15	
5. Type of infringing goods (categories)	Online sale of kitchen and household goods	
6. Parties		
	Right Holder (Plaintiff)	Yuppiechef Holdings (Pty) Ltd
	Infringer (Defendant)	Yuppie Gadgets Holdings (Pty) Ltd
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	YUPPIECHEF	YUPPIE GADGETS

8. Outline (summary) of the case

Yuppiechef is an online retail business that specialises in kitchen and household goods. The company has various South African trade mark registrations for the trade mark YUPPIECHEF, and these registrations are in classes 8, 11 and 21 and cover a range of goods. When a rival online retailer that specialises in so-called "novelty items" changed its name from Urban Gadgets to Yuppie Gadgets, Yuppiechef instituted proceedings for trade mark infringement.

Judge Wallis dealt with this issue in some detail, making the point that a person who buys goods from a physical or online retailer does not expect the goods to actually emanate from that retailer. The judge also said that Yuppie Gadgets did not use its trade mark in "physical or other relation" to goods. The judge queried why Yuppiechef had not obtained a registration in class 35 for retail services.

Yuppiechef's trade mark registrations cover various goods, whereas the name Yuppie Gadgets appears to be used for retail services. This was one of the issues raised by Yuppie Gadgets, which argued that there can be no question of primary infringement (same goods or services) when the registrations are for goods and the allegedly infringing use is in respect of services.

The court held that, even if YUPPIECHEF had a trade mark registration in class 35, the marks are not confusingly similar and quoted the definition of the word 'Yuppie'. "There are many cases in which it has been said that it is not the purpose of trade marks or copyright to enable people to secure monopolies on the commons of the English language ... yuppie is an ordinary word in common use." The court further held that the words "chef" and "gadgets" are incapable of being confused.

The court considered the issue of online retail and made the point that people who purchase goods online are generally internet savvy, being able to distinguish adverts and other listings. Moreover, the security features built into the online purchasing process, which often require the confirmation of details, reduce the likelihood of confusion. The court held that: "The shopping process always provides time for reflection."

The Court therefore held that the claim for infringement must fail because the marks are not so similar that the use thereof is likely to cause deception or confusion.



1. Case topic		Trade mark infringement - dilution	
2. Country		South Africa	
3. Case citation (Title, Court and Case No.)		Laugh It Off Promotions CC v South African Breweries International (Finance) BV t/a Sabmark International and Another (CCT42/04) 2006 (1) SA 144 (CC) {Constitutional Court}	
4. Date of order or judgment		2005-05-27	
5. Type of infringing goods (categories)		T-Shirts/clothing	
6. Parties			
	Right Holder (Plaintiff)	LAUGH IT OFF PROMOTIONS CC (Applicant)	
	Infringer (Defendant)	SOUTH AFRICAN BREWERIES INTERNATIONAL	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case



This case presents a dispute around the proper interpretation of the anti-dilution provision, section 34(1)(c), of the Trade Marks Act in light of section 16 of the Constitution, which deals with freedom of expression. South African Breweries (SAB) claimed that Laugh It Off Promotions CC's use of the slogan BLACK LABOUR WHITE GUILT on its T-shirts amounted to an infringement of its trade mark. SAB owns trade mark registrations for "America's lusty, lively beer -Carling Black Label Beer - Brewed in South Africa". In 2001 SAB discovered that Laugh It Off Promotions CC (Laugh It Off) was producing and selling T-shirts that lampooned the trade mark by stating: "Africa's lusty, lively exploitation since 1652 - Black Labour - White Guilt - No regard given worldwide". Laugh it Off opposed the application and contended that the right to freedom of expression protects both these messages, and hence that an interpretation of the anti-dilution provision that gives adequate effect to this right does not allow SAB to obtain an interdict, except where it has shown that it is likely to suffer economic harm. The Constitutional Court found that Section 34(1)(c) did not apply in these circumstances and emphasised that the aforementioned section does not limit use that takes fair advantage of the mark or does not threaten substantial harm to the repute of the mark or in fact could lead to harm but in a fair manner.

The court found that where the trade mark is being used in a manner which would qualify as 'free expression', the use should, to that extent, enjoy protection as fair use and would not amount to tarnishment of the trade mark. The court found that:

"The exercise calls for an evaluation of the importance of the purpose, nature, extent and impact of the limitation of free expression invoked against claims of unfair advantage or of likelihood of material detriment to a registered trade mark. In sum, in order to succeed the owner of the mark bears the onus to demonstrate likelihood or substantial harm or detriment which, seen within the context of the case, amounts to unfairness."

The court went on to find that SAB failed to prove Laugh It Off's infringement of its trade marks. The "likelihood of taking advantage of, or being detrimental to, the distinctive character or repute of the marks", has not been established. The rights of persons to express themselves cannot be lightly limited: the harm to the trade mark holder has to be material, and this is one of the internal limitations of section 34(1)(c). However, an interpretation of the section that conforms to the Constitution and the kind of society it envisions requires the one relying on the protection of the Act to show a real likelihood or probability of harm. Such harm must be of an economic sort. This is because the aim of the section is to protect the trade mark's selling power rather than its dignity. It cannot therefore be inferred from a mere observation of the two marks that there is a likelihood of economic harm. This must be shown by adducing evidence to this end.



1. Case topic		Trade mark infringement - use in the course of trade	
2. Country		South Africa	
3. Case citation (Title, Court and Case No.)		Verimark (Pty) Ltd v Bayerische Motoren Werke AktienGesellschaft 2007 (6) SA 263 (Supreme Court of Appeal)	
4. Date of order or judgment		2007-05-17	
5. Type of infringing goods (categories)		Use of the BMW Logo in an advertisement as well as packaging of car polish	
6. Parties			
	Right Holder (Plaintiff)	Verimark (Pty) Limited (Apellant)	
	Infringer (Defendant)	Bayerische Motoren Werke AktienGesellschaft (Respondent)	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case

This is a case of direct trade mark infringement and dilution. The well-known BMW logo is registered in different classes and those in contention are registered in class 3 for, amongst others, cleaning and polishing preparations and vehicle polishes and class 12 for vehicles. BMW applied for an interdict restraining Verimark from infringing these two trade marks. Verimark is the market leader in the field of direct response television marketing in which demonstrative television commercials are used. Two of its many products are its Diamond Guard car care kit and Diamond Guard car polish. Throughout this period Verimark used vehicles of different makes, but more particularly BMW cars, to demonstrate the wonders of these products. In one particular television flight a BMW car is first treated with Diamond Guard and then an inflammable liquid is poured onto the hood of the car and set alight without causing any damage to the car's paintwork. The complaint of BMW is that its logo on the BMW car is clearly visible and because of this its case is that Verimark is infringing its trade mark registrations. The same complaint was directed at the use of a clip from the advert where the BMW logo is visible packaging material for Verimark's product.

The Supreme Court of Appeal stated that a trade mark serves as a badge of origin and that the car was being used to illustrate Diamond Guard's properties and that no-one would perceive that there existed a material link between BMW and Diamond Guard or that the logo on the car performed any guarantee of origin function in relation to the Diamond Guard product. It therefore concluded that the BMW logo was not being used as a trade mark and that no infringement of the trade mark was committed in terms of s 34(1)(a) of the Trade Marks Act 194 of 1993. The section provides that the unauthorised use of a mark identical to a registered trade mark, in the course of trade, in relation to goods or services in respect of which the trade mark is registered, constitutes an infringement of the registered trade mark.

The SCA at the same time dismissed the dilution claim. The SCA agreed with the High Court that although Verimark may be taking advantage of the reputation of the BMW logo, it is not done in a manner that is unfair; Verimark's emphasis is on the effectiveness of its own product sold under established trade marks and cannot be expected to advertise car polish without using any make of car; it would be contrived to expect of Verimark to show vehicles in such a way that their logos are not visible. It concluded that it failed to see how the use of the logo could affect the advertising value of the logo detrimentally.



1. Case topic		Requisite elements of the crime of sale of counterfeit goods.	
2. Country		Argentina	
3. Case citation (Title, Court and Case No.)		Case Nro. 361/2013 - "Matos Berna, Beatriz Noelia s/ recurso de casación - Federal Criminal Court of Appeal	
4. Date of order or judgment		02/26/2014	
5. Type of infringing goods (categories)		Apparel	
6. Parties			
	Right Holder (Plaintiff)	adidas AG	
	Infringer (Defendant)	Beatriz Noelia Matos Berna	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		N/A	N/A

8. Outline (summary) of the case

Ms. Matos was arrested while selling counterfeit ADIDAS apparel; all products were seized and Mrs. Matos faced charges upon counts of sale of counterfeit products, under Trademarks Law No. 22362.

The acting federal criminal court dismissed the charges against the defendant, interpreting that the circumstances of the case (street sale of obviously counterfeit products) excluded the possibility of consumer deception and thus caused no harm to the trademark holder. The Federal Criminal Court of Appeals upheld the decision.

The Federal Prosecutor challenged the ruling before the Federal Court of Criminal Cassation, on the grounds that the potential for consumer deception is not a requisite element of the crime of trademark counterfeiting. Section IV of the Federal Criminal Court of Cassation reversed the ruling in a unanimous decision. In so deciding, the Court of Cassation held that the Trademark Law protects both the consumer and the rights holder. Therefore, the prosecution need not show the potential for consumer deception to secure a conviction on trademark counterfeiting charges. Otherwise, trademark holders would be left unprotected despite having complied with all requirements that the State imposes precisely to acquire trademark protection.

This ruling broke with a trend that had developed in many criminal federal circuits throughout the country, whereby visibly counterfeit products were not considered to infringe criminal trademark provisions as they entailed no risk of consumer deception as to the origin of goods.



1. Case topic	a leading case on trademark infringement that sets out the test for likelihood of confusion	
2. Country	Argentina	
3. Case citation (Title, Court and Case No.)	Case N° 1564/2003 - Editorial Buen Vivir S.R.L c/ Vinares S,A s/cseeking to set aside opposition - Federal Court of Appeals in Civil and Commercial matters	
4. Date of order or judgment	02/27/2009	
5. Type of infringing goods (categories)	N/A	
6. Parties		
	Right Holder (Plaintiff)	VINARES S.A
	Infringer (Defendant)	EDITORIAL BUEN VIVIR SRL
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	BUEN VIVIR (class 16)	BONVIVIR (classes 29, 30, 31, 33 and 34)

8. Outline (summary) of the case

Editorial Buen Vivir SRL filed an application for the trademark BUEN VIVIR (Application No. 2,301,038) to cover only "publications in general" in class 16.

Vinares S. A. filed an opposition based on the earlier trademark BONVIVIR in classes 29, 30, 31, 32 and 34 and arguing that their activities in the food and beverage industry are related to the editorial business as they promote their goods through catalogues and other publications.

The main aspect of the case was the determination of whether the trademark "BUEN VIVIR" (class 16) for "publicatios in general" was confusingly similar to a virtually identical trademark registered in unrelated classes.

The Court of First Instance determined the lack of likelihood of confusion based on the different classes involed in the conflict.

The Appellate Court confirmed the decision of the Court of First Instance. In its decision, the Appellate Court ruled that a test of likelihood of confusion cannot be analyzed in abstract and that the judge must review the case from the consumer's perspective. The Court concluded that there is no relation between goods in class 16 and goods in the food and beverage classes and therefore confirmed the decision of the Court of First Instance.



1. Case topic	leading case on trademark infringement online	
2. Country	Argentina	
3. Case citation (Title, Court and Case No.)	Organización Veraz S.A. c/ Open Discovery S.A. precautionary measures - Federal Court of Appeals in Civil and Commercial matters	
4. Date of order or judgment	05/26/2009	
5. Type of infringing goods (categories)	N/A	
6. Parties		
	Right Holder (Plaintiff)	Organización Veraz SA Comercial de Mandatos e Informes
	Infringer (Defendant)	Open Discovery
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Veraz (in class 5, word mark) Organización Veraz (in class 35, word mark)	Veraz Organización Veraz Veras Beraz Beraz
8. Outline (summary) of the case		

Organización Veraz SA Comercial de Mandatos e Informes ("Organización Veraz") requested an injunction against Open Discovery requesting the Court to order Open Discover to immediately stop using the trademarks "Veraz" and "Organización Veraz" as keywords used to promote their competing services on online advertising.

Organización Veraz claimed that Open Discovery's use of Organización Veraz's trademarks as keywords infringed its trademark rights and also constituted an act of unfair competition.

The judge of first instance granted the preliminary injunction and ordered Open Discovery to immediately cease in the use of the trademarks "Veraz" and "Organización Veraz" owned by Organización Veraz SA, in the advertising carried out on the Internet through the Google search engine until a final ruling was issued.

This relevance of this case is that the Court addressed the unauthorized use of trademarks as keywords.



1. Case topic	Online saler of counterfeit goods	
2. Country	Argentina	
3. Case citation (Title, Court and Case No.)	Case N° 4568/08 - "P. A. L. et al on Trademarks Law violation" - National Court in Federal Criminal and Correctional Matters N° 4	
4. Date of order or judgment	08/31/2011	
5. Type of infringing goods (categories)	Clothing, pens, wallets, necklaces and purses	
6. Parties		
	Right Holder (Plaintiff)	Louis Vuitton Malletier
	Infringer (Defendant)	Unidentified
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	N/A	N/A

8. Outline (summary) of the case

Louis Vuitton Malletier ("LVM") filed a criminal complaint against certain defendants engaged in the online sale of counterfeit LVM products, including purses and wallets, among others.

The products were all counterfeit and were sold through the Internet, with buyers retrieving the purchase at different locations.

LVM further alleged that the company did not work with distributors or resellers, meaning that third party online sales necessarily involved counterfeit or otherwise illegal products.

The acting court investigated the case with the assistance of IT crimes experts with the Federal Police, identified relevant retailers and warehouses, and issued search warrants for all targets of interest.

The defendants were charged and indicted on counts of sale of counterfeit products, under Trademarks Law No. 22,362.



1. Case topic		Opposition -	
2. Country		Argentina	
3. Case citation (Title, Court and Case No.)		Case N° 3397/98 - "Campo Andino S.A c/Molinos Río de la Plata S.A s/seeking to set aside opposition - Federal Court of Appeals in Civil and Commercial matters	
4. Date of order or judgment		2001-04-06	
5. Type of infringing goods (categories)		N/A	
6. Parties			
	Right Holder (Plaintiff)	Campo Andino S.A	
	Infringer (Defendant)	Molino Río de la Plata S.A	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		CAMPO ANDINO (in classes 29, 30 and 31)	HUERTA ANDINA (class 29) ANDINA (class 29) ANDINO (classes 29 and 30)

8. Outline (summary) of the case

Molinos Río de la Plata S.A. ("Molinos") objected the applications for "CAMPO ANDINO" based on the trademarks "HUERTA ANDINA", "ANDINO" and "ANDINA", and Campo Andino filed court action requesting the court declare the oppositions ill-founded.

The Court of First Instance rejected the claim and ruled that the trademarks in conflict were confusingly similar from a graphical, phonetical and visual perspectives.

Campo Andino appealed the decision arguing that the term "andino" was common in the class. Although the Court of Appeals recognized that the word "andino" was common in the class, they focused on the remaining distinctive elements (HUERTA vs. CAMPO) and concluded that both words would conceptually very close, and therefore, ruled confirmed the decision of the Court of First Instance.

In its ruling, the Court listed the following rules that should apply when analyzing the analyze the likelihood of confusion:

- The trademarks should be compared as a whole, avoiding an arbitrary comparison of the individual elements that compose the trademark;
- In cases involving trademarks that include commonly used elements, the Court should focus on the distinctive elements of each trademark;
- upon comparing the trademarks in conflict, the Court must focus on the similar elements rather than those that are dissimilar, since the likelihood of confusion lies precisely, on the similarity of the elements that could lead to consumer confusion.
- The Court must take in consideration any circumstantial evidence and factors, such as type of consumers, channels of trade, relationship of the goods/services involved, etc. to test the likelihood of confusion and avoid an abstract analysis of the case.



1. Case topic	Trademark infringement - test for likelihood of confusion	
2. Country	Brazil	
3. Case citation (Title, Court and Case No.)	Superior Court of Justice - Appeal nº 1.346.089	
4. Date of order or judgment	May 15, 2015	
5. Type of infringing goods (categories)	Foods	
6. Parties		
	Right Holder (Plaintiff)	BRF S/A
	Infringer (Defendant)	Pepsico
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	CHESTER	CHESTER CHEETAH

8. Outline (summary) of the case

BRF S/A filed a claim against PEPSICO and the Brazilian PTO aiming at reversing the administrative decision which granted trademark registration for CHESTER CHEETAH (for snacks) to PEPSICO. BRF alleged that there was likelihood of confusion with its previous trademark registration CHESTER (for 'meat, poultry and eggs' for food). The Lower Court rejected BRF's claim based on lack of likelihood of confusion. The Federal Court of Appeals maintained the Lower Court's decision. The Superior Court of Justice rejected BRF's appeal, affirming the decision which allowed the coexistence of both trademarks. The decision of the Superior Court of Justice applied the so-called 360° test, which takes into consideration seven main criteria when examining the issue of likelihood of confusion. The criteria established by the 360 test are: (i) the degree of intrinsic distinctiveness of the marks; (ii) the degree of similarity of the marks; (iii) the legitimacy of the alleged infringer; (iv) period of coexistence of the marks in the market; (v) nature of the products or services at issue; (vi) the specialisation of the target audience; and (vii) the possibility of dilution of the senior mark.



1. Case topic	Infringement - counterfeit goods	
2. Country	Brazil	
3. Case citation (Title, Court and Case No.)	Superior Court of Justice - Appeal n. 1.535.668	
4. Date of order or judgment	September 15, 2016	
5. Type of infringing goods (categories)	Socks	
6. Parties		
	Right Holder (Plaintiff)	Nike International Ltd.
	Infringer (Defendant)	Imadco Comércio de Brinquedos Ltda.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	NIKE	NIKE

8. Outline (summary) of the case

Nike filed a claim aiming seeking the seizure of counterfeit socks identified by the Brazilian customs. Besides the definitive seizure and destruction of the products, Nike claimed material and moral damages. The Lower Court Judge awarded material damages to Nike, however, rejected the moral damages claim based on the fact that the products were not offered for sale since the custom authorities seized the products. The State Court of Appeals rejected Nike's appeal. The Superior Court of Justice decided that Nike was entitled to moral damages regardless of the fact that the products were not offered for sale.



1. Case topic	Trademark Infringement - Online	
2. Country	Brazil	
3. Case citation (Title, Court and Case No.)	State Court of Appeals of São Paulo - Appeal n. 2000156-56.2020.8.26.0000	
4. Date of order or judgment	November 10, 2020	
5. Type of infringing goods (categories)	TV Show	
6. Parties		
	Right Holder (Plaintiff)	Moomin Characters OY Ltd.
	Infringer (Defendant)	Google Brazil Internet Ltda. (+unknown party/internet user)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	MOONINS and MOOMINVALLEY	MOONINS and MOOMINVALLEY

8. Outline (summary) of the case

Moomin filed a claim against Google and an internet user who was making available the TV series Moomins with no authorization. The claim was based on trademark and copyright infringements. According to the Brazilian Internet Act, in such cases, the Plaintiff is obliged to clearly identify the content to be removed by indicating the URLs. The Lower Court granted the preliminary injunction request, ordering Google to remove the content indicated by the Plaintiff. Google alleged that the URL indicated by the Plaintiff was related to a folder which stored several materials and that licit material could be removed if it followed the Court's order. In an appeal filed by Google, the State Court of Appeals of São Paulo decided that the folder in question should be completely removed since the Plaintiff proved that there were illegal materials in the referred folder (i.e.: even if part of the content is licit, the folder should be completely removed since it contained illicit materials).



1. Case topic	Prior User rights	
2. Country	Brazil	
3. Case citation (Title, Court and Case No.)	Superior Court of Justice - Appeal n. 1.464.975	
4. Date of order or judgment	December 14, 2016	
5. Type of infringing goods (categories)	Apparel	
6. Parties		
	Right Holder (Plaintiff)	Padrão Grafia Industrial e Comercial Ltda.
	Infringer (Defendant)	Brazilian PTO
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	PADRÃO GRAFIA	PADRÃO GRAFIA
8. Outline (summary) of the case		

In Brazil, there are many cases involving the registration of famous foreign trademarks by individuals before the titleholder decides to operate locally. In most of the cases, when the titleholder finds out that its trademark is registered before the PTO by a third party, there are no administrative appeals available. In such cases, the titleholders were obliged to file nullity court actions to preserve their rights. For many years, the Brazilian PTO sustained that the titleholder should present an opposition before the PTO and, in case the titleholder failed to comply with the deadline, he would not be entitled to pursue the nullity of the trademark before the courts. In the above captioned case, the Superior Court of Justice decided that the lack of opposition before the PTO shall not impede the analysis of the nullity claim by the Judiciary.



1. Case topic	Confusion	
2. Country	Canada	
3. Case citation (Title, Court and Case No.)	Mattel, Inc v 3894207 Canada Inc, 2006 SCC 22 (Supreme Court of Canada)	
4. Date of order or judgment	2006-06-02	
5. Type of infringing goods (categories)	N/A	
6. Parties		
	Right Holder (Plaintiff)	Mattel, Inc.
	Infringer (Defendant)	3894207 Canada Inc.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	BARBIE (for dolls)	Barbie's (for restaurants)

8. Outline (summary) of the case

Opponent owned a trademark registration for BARBIE in association with dolls. Applicant applied to register the trademark Barbie's in association with restaurant services, takeout services, catering and banquet services. Opponent opposed registration of the mark on the basis of confusion with its registered trademark. The Trademarks Opposition Board denied the opposition and allowed the trademark. Opponent appealed to the Federal Court of Canada, the Federal Court of Appeal and, finally, the Supreme Court of Canada. The appeal was dismissed at each instance. While this case discusses famous marks, it also confirmed the test for a likelihood of confusion for infringement in Canada.

Opponent argued that some marks are so famous that a mark such as Barbie could no longer be used in in association with most consumer goods or services without the average consumer being confused and led to infer the existence of a trade connection or association with the owners.

The Opposition Board agreed that Barbie was a famous trademark but only in respect of dolls and all accessories. In contrast, the use of the applied-for trademark Barbie's in connection with very different goods and services was not likely to be confusing with any of Opponent's Barbie marks. This finding was upheld on appeal.

The Supreme Court held that trademarks law protect the use of a trademark by the owner to distinguish goods or services manufactured, sold, leased, hired or performed by the owner from those manufactured, sold, leased, hired or performed by others.

If the hypothetical purchaser would be led to the mistaken inference that the goods or services associated with trademarks are manufactured, sold, leased, hired or performed by the same person whether or not the goods or services are of the same general class, then confusion will be found to arise. The hypothetical purchaser is the casual consumer somewhat in a hurry. All the surrounding circumstances must be considered, including those set out in subsection 6(5) of the Trademarks Act, including the nature of the goods, services or business, and the nature of the trade. The general class of goods and services is relevant but not controlling. In some case, the goods and services of the parties do not even need to be of the same general class in order for confusion to arise.

A more famous trademark may lead to confusion across broader product lines than a less famous trademark. However, just because a mark is famous does not mean that confusion would occur if used in conjunction with any goods or services. Here, the BARBIE trademark was only found to be famous in association with dolls. Accordingly, it was difficult to see how the casual consumer, somewhat in a hurry, would be led to the mistaken inference that Applicant's services are manufactured, sold, leased, hired or performed by the same person as BARBIE dolls. The parties' goods and services were very different and occupied different channels of trade.

While evidence of actual confusion is relevant to assessing the likelihood, it is not required. However, the absence of actual confusion may lead to a negative inference if such evidence would be expected if confusion were indeed likely, such as when both marks have been shown to have long existed in the same marketplace.



1. Case topic	Confusion	
2. Country	Canada	
3. Case citation (Title, Court and Case No.)	Veuve Clicquot Ponsardin v Boutiques Clicquot Ltée, 2006 SCC 23	
4. Date of order or judgment	2011-05-26	
5. Type of infringing goods (categories)	N/A	
6. Parties		
	Right Holder (Plaintiff)	Veuve Clicquot Ponsardin, Maison Fondée en 1772
	Infringer (Defendant)	Boutiques Clicquot Ltée; Mademoiselle Charmante Inc.; 3017320 Canada Inc.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	VEUVE CLICQUOT (for wine and champagne)	CLICQUOT (for women's wear shop)

8. Outline (summary) of the case

Plaintiff owned a registered trademark for VEUVE CLICQUOT in association with wines and Champagne. Defendant operated an inexpensive women's clothing boutique. Plaintiff sued for trademark infringement and depreciation of goodwill claiming, among other things, that Defendant's trademark was confusing with its registered trademark.

The purpose of trademarks is to function as a symbol of the source and quality of goods and services, to distinguish those of the merchant from those of another, and thereby to prevent confusion in the marketplace. If use of both trademarks in the same area would be likely to lead to the inference that the goods or services associated with those trademarks are manufactured sold leased hired or performed by the same person, whether or not the goods or services are of the same general class, then there will be confusion. The test to be applied as a matter of first impression in the mind of a casual consumer somewhat in a hurry who sees the Defendant's trademark at a time when he or she has no more than an imperfect recollection of Plaintiff's trademarks, and does not give the matter any pause, detailed consideration or scrutiny nor to examine closely the similarities and differences between the marks.

In assessing confusion, the trier of fact must have regard to all the surrounding circumstances, including those enumerated in subsection 6(5) of the Trademarks Act: the inherent distinctiveness of the trademarks or trade names and the accent to which they have become known, the length of time the trademarks or trade names have been in use, the nature of the goods services or business, the nature of the trade, and the degree of resemblance between the trademarks or trade names in appearance sound or in the ideas suggested by them. The fame of a mark can be a relevant surrounding circumstance.

The court found that Plaintiff's mark VEUVE CLICQUOT had a high degree of distinctiveness, and that the mark enjoyed significantly more longstanding use than the Defendants' CLICQUOT mark. The VEUVE CLICQUOT mark carried an aura of luxury which may extend outside the wine and champagne business. The mark was famous and was even well known in Defendants' trade area. However, while the reputation of VEUVE CLICQUOT may extend beyond champagne more broadly into the luxury goods market, there was no evidence that the ordinary consumer would associate the mark with Defendant's mid-priced women's clothing.

Accordingly, the court found that confusion was unlikely and that there was no infringement. The court also considered depreciation of goodwill, which is not discussed here in any detail.



1. Case topic	Counterfeiting	
2. Country	Canada	
3. Case citation (Title, Court and Case No.)	Louis Vuitton Malletier SA v Wang, 2019 FC 1389	
4. Date of order or judgment	2019-11-15	
5. Type of infringing goods (categories)	Purses, wallets, shoes, jewellery, sunglasses and clothing	
6. Parties		
	Right Holder (Plaintiff)	Louis Vuitton Malletier S.A.; Louis Vuitton Canada Inc; Celine; Christian Dior Couture, SA; Givenchy SA.
	Infringer (Defendant)	Audrey Wang; Jun Yang; Canada Royal Import and Export Co Ltd
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	N/A	N/A

8. Outline (summary) of the case

This was a case where the Defendants sold counterfeit products over an approximately 8-year period. Plaintiffs, owners of trademarks for well-known luxury goods, sued for trademark infringement, among other grounds.

Defendants kept poor financial records and were not forthcoming with information, making it difficult to determine the extent of damages. Plaintiffs' investigations revealed numerous instances of infringement over the years.

Plaintiffs brought a motion for summary trial. The court agreed that summary trial was appropriate because Plaintiffs' case was relatively straightforward, and the evidence was not overly complex.

The court found Defendants had infringed Plaintiffs' trademarks, had depreciated Plaintiffs' goodwill in their trademarks, had directed public attention to their goods so as to cause or be likely to cause confusion between their goods and the goods and business of Plaintiffs, and Add had used false and misleading descriptions which would mislead the public regarding the character quality and slash or composition of such goods, contrary to sections 7, 19, 20 and 22 of the Trademarks Act.

The more difficult issue was the assessment of damages in view of Defendants' inadequate record-keeping. Further, in a case like this, which involved counterfeiting of expensive luxury goods, the damages assessment must focus on the harm to Plaintiffs' goodwill rather than Plaintiffs' loss of sales. Here, Plaintiffs agreed that a sale of Defendants' counterfeit products was not likely displacing a sale of Plaintiffs' products. Rather, the damage to Plaintiffs arose out of a loss of control over their trademarks and the exclusivity of their associated products.

Given the lack of evidence of Defendants' turnover, it was improper to assume a number of sales for the period in issue. Therefore, it was appropriate to assess damages on a "nominal" per instance infringement basis. The court applied a conventional scale gleaned from similar prior cases and multiplied by the number of infringement instances detected by Plaintiffs' investigations. Historically, these depended on the size of the operation and reflected a single instance of infringement, ranging between \$3,000 for operations of transient vendors, \$6,000 for operations from more conventional retail premises, and \$24,000 for operations as importers, manufacturers and distributors of counterfeit goods. The court awarded Plaintiffs compensatory damages of \$383,000.

The court also awarded Plaintiffs punitive damages, because Defendants had exhibited recidivist conduct, had intentionally, knowingly and deliberately infringed trademarks and copyrighted works, and had made extensive ongoing sales. The court, considering that punitive damages must be significant, set the amount at \$225,000.

The court granted other relief, including a permanent injunction and delivery up and destruction of counterfeit goods. There were also allegations of copyright infringement, not discussed here.



1. Case topic	Online Infringement	
2. Country	Canada	
3. Case citation (Title, Court and Case No.)	Red Label Vacations Inc v 411 Travel Buys Ltd, 2015 FC 19, aff'd FCA 290.	
4. Date of order or judgment	2015-01-07	
5. Type of infringing goods (categories)	Travel services	
6. Parties		
	Right Holder (Plaintiff)	Red Label Vacations Inc
	Infringer (Defendant)	411 Travel Buys Ltd
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	redtag.ca; redtag.ca vacations; Shop. Compare. Payless!! Guaranteed	Metatags: Red Tag Vacations; shop, compare, & pay less

8. Outline (summary) of the case

Plaintiff Red Label Vacations owned and used three registered trademarks for travel services, which it promoted and sold through a website. Defendant 411 Travel Buys operated a travel website which contained numerous metatags from Plaintiff's website, including several that included Plaintiff's registered trademarks.



Metatags are embedded text that is not necessarily visible to the consumer but rather provide key information about the website that is useful for search engines to gather information, index a website and match the website to keywords in a user's search query.

In this case, there was no evidence that the Plaintiff's registered trademarks had been visible on the Defendant's website. As such, the trademarks were not "used" in association with the Defendant's services within section 4 of the Trademarks Act. That is, the trademarks were not used or displayed in the performance or advertising of those services, but rather were embedded as invisible metatags. Accordingly, the court held that there was no infringement under section 20 of the Trademarks Act and no depreciation of goodwill under section 22, both of which required "use" of a trademark as set out in section 4.

With respect to Plaintiff's claim for passing off, the court found Plaintiff had goodwill in its two of its trademarks, but not the other because of a lack of evidence of use of that mark. However, there was no misrepresentation due to confusion. The court held that the use of metatags in a search engine merely gives the consumer a choice of independent and distinct links that he or she may choose from at will, rather than directing a consumer to a particular competitor. In this case, there was no likelihood of deception because there was no visible use of the Plaintiff's trade name or trademarks on the Defendant's website. A consumer was free to redirect the search to the Plaintiff's website.

The Plaintiff's claim on trademarks and copyright grounds (not discussed here) was denied.

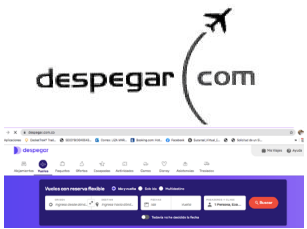


1. Case topic	Infringement of 3D trademark on the basis of literals a) and d) of Article 155 of the Andean Decision 486 / Using, in the course of trade, identical or similar signs to the trademark for goods or services, where such use would result in a likelihood of confusion.	
2. Country	COLOMBIA	
3. Case citation (Title, Court and Case No.)	17 - 336591 Superintendence of Industry and Trade	
4. Date of order or judgment	September 13, 2019	
5. Type of infringing goods (categories)	Class 25 footwear	
6. Parties		
	Right Holder (Plaintiff)	CROCS INC
	Infringer (Defendant)	EVACOL S.A.S
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

1. Defendant EVACOL tried to register the shoe as an "industrial design, in 2012, and the Superintendence of Industry and Trade denied this possibility due to lack of novelty" as the design had similar characteristics to the design of the reference "Crocs Imagine", whose antecedent dates back to 2010.
2. In 2016, CROCS registered the crocs design as a three-dimensional trademark before the TMO.
3. Despite the rejection of the industrial design, EVACOL continued using the shoe design in the market.
4. CROCS filed an infringement action before the Superintendence of Industry and Trade as EVACOL was using his tridimensional registered trademark in the market.
5. EVACOL argued that the company was using the trademark since 2014, which means prior to the registration date of the tridimensional trademark by CROCS, registered in 2016.
4. According to the Trademark Office the argument regarding the prior use by EVACOL in 2014, is not valid in a trademark infringement action, since Colombia is under a first to file system, and the granting of the trademark registration in 2016 in favor of CROCS entails the owner of the registration, the possibility of excluding any market agent that uses this distinctive sign after the granting date of the industrial property right.
5. The Superintendence of Industry and Trade prohibited the sale and commercialization of the products identified with the references "Zueco 084", "Zueco 078", "Zueco 078-07" immediately, and right after the notification of the decision.
 Regarding the above-mentioned shoe references, the Superintendence of Industry and Trade ordered to: Withdraw from commercial establishments all products with the aforementioned references.
 Collect all products from the commercial establishments of its distributors nationwide.
 Destroy the molds used to make these shoe references, in a term of 30 working days.
 Destroy all products identified with the above-mentioned references within a maximum term of 30 days after the notification of the decision. For this process EVACOL S.A.S. must take all measures to guarantee the environmental care.
 During the diligence, EVACOL S.A.S was also ordered to pay in favor of CROCS INC the sum of \$ 74,530,440 of Colombian pesos (COP) for compensation of damages.
6. EVACOL filed a recourse of Appeal against the decision adopted by the Superintendence of Industry and Trade before the Superior Tribunal, which has not been decided yet. It is difficult to determine when the appeal decision will be made, but likely within about one year.



1. Case topic	Online Infringement- Infringement of a trademark on the basis of literal d) of Article 155 of the Andean Decision 486 / Using, in the course of trade, identical or similar signs to the trademark for goods or services, where such use would result in a likelihood of confusion.	
2. Country	COLOMBIA	
3. Case citation (Title, Court and Case No.)	18-83033 Superintendence of Industry and Trade	
4. Date of order or judgment	October 13, 2020	
5. Type of infringing goods (categories)	Class 39 travel agencies services	
6. Parties		
	Right Holder (Plaintiff)	TRAVEL RESERVATIONS S.R.L. group DESPEGAR
	Infringer (Defendant)	GUSTAVO ALBERTO ALVAREZ ZULUAGA owner of DESPEGAR.NET.CO; and CARLOS ALVARES
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		DESPEGAR.NET.CO image not currently available

8. Outline (summary) of the case

1. TRAVEL RESERVATIONS (Plaintiff) is the owner of the distinctive signs DESPEGAR.COM and Design in Class 39, DESPEGAR and Design in Class 39 to identify travel agency services which are provided online.
2. TRAVEL RESERVATIONS stated that they found domain name DESPEGAR.NET.CO through which the defendant provided online travel agency services such as tickets, lodging, car rental, tours, among others, in the name of GUSTAVO ALVAREZ making a misuse of DESPEGAR.COM. The plaintiff stated that the defendant in his web page used institutional videos property of DESPEGAR.COM, infringing the plaintiff's copyrights and trademarks' rights.
3. The plaintiff stated that on despegar.net.co website, the officials posed as despegar.com officials and requested the delivery of money to agencies affiliated with despegar.com and to the general public. The plaintiff stated that the services they offer are of a low standard, which compromises the reputation of despegar.com.
4. The Plaintiff stated that the web page DESPEGAR.NET.CO; and the Facebook page DESPEGAR.NET.CO reproduced the main element of the previously registered trademarks, which is the nominative expression DESPEGAR.
5. The Superintendence of Industry and Trade ruled in favor of the Plaintiff and ordered to: Immediately cease the acts that constitute the infringement of the trademarks owned by TRAVEL reservations s.r.l.
Suspend and refrain from using the expression "despegar" as a trademark and / or commercial name, or to use despegar.net.co to promote services of class 39.
Remove any advertisement, print or banner using the expression "DESPEGAR.NET.CO" as a title, trademark or commercial name associated with services of Class 39.
Pay the sum of \$ 4,389,015 Colombian pesos (COP) of legal costs.



1. Case topic	Trademark infringement and notoriety- Infringement of a trademark on the basis of literal d) of Article 155 of the Andean Decision 486 / Using, in the course of trade, identical or similar signs to the trademark for goods or services, where such use would result in a likelihood of confusion.	
2. Country	COLOMBIA	
3. Case citation (Title, Court and Case No.)	13121206 Superintendence of Industry and Trade	
4. Date of order or judgment	June 10, 2014	
5. Type of infringing goods (categories)	Class 29	
6. Parties		
	Right Holder (Plaintiff)	Federación Nacional de Cafeteros (Colombian National federation of Coffee)
	Infringer (Defendant)	Bamboo y Café (Bamboo and Coffee)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

1. BAMBOO & CAFÉ LTDA in a commercial establishment of its property located in Bogotá, used the expression JUVENAL VALDEZ to identify coffee.
2. The Colombian FEDERATION OF COFFEE (plaintiff) filed an infringement action on the basis of the similarity of the expression JUVENAL VALDEZ used in a commercial establishment, to trademarks JUAN VALDEZ registered in the name of the FEDERATION.
3. The Superintendence of Industry and Trade took into account the notoriety of trademark JUAN VALDEZ and its traditional logo in the judicial proceeding of infringement.
4. The notoriety of a trademark in Colombia is usually recognized in an administrative proceeding before the TMO and it has to be claimed and proved in an opposition proceeding or either in a cancellation action on the basis of notoriety. The Colombian TMO cannot declare the notoriety of a trademark ex officio.
 However, in judicial proceedings even though the notoriety of a trademark is not recognized for a specific period of time, in this case the Superintendence of Industry and Trade took into account the well-known character of trademark JUAN VALDEZ, at the moment of the final decision regarding trademark infringement.
5. The Superintendence of Industry and Trade stated that it has been demonstrated that the use of the expression "JUVENAL VALDEZ" to identify a business establishment for the sale of coffee-based beverages constitutes an infringement of the "JUAN VALDEZ" well-known trademarks owned by the Colombian FEDERATION OF COFFEE. The foregoing taking into account that a risk of confusion could arise between the "JUVENAL VALDEZ" establishment and "JUAN VALDEZ" stores, not only because of the grammatical similarity between them, but also as the font used by the defendant is very similar to the trademarks used by the Colombian FEDERATION OF COFFEE stores.
6. The Superintendence of Industry and Trademark ordered the defendant to cease the use of JUVENAL VALDEZ as a trademark, trade name, or either in advertisement or Stationery. The defendant was ordered to pay the amount of \$ 3.080.000 Colombian pesos regarding legal costs.



1. Case topic	Criminal action regarding trademark infringement and counterfited products	
2. Country	COLOMBIA	
3. Case citation (Title, Court and Case No.)	660016000058200503562 - Superior Court of the Judicial District of Pereira(Rda.), Criminal Decision Chamber	
4. Date of order or judgment	October 19, 2011	
5. Type of infringing goods (categories)	Class 16, pens	
6. Parties		
	Right Holder (Plaintiff)	Attorney General
	Infringer (Defendant)	SAÚL ENRIQUE ZULUAGA OLIVAR
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

FACTS

- The business establishment called “Papelería Occidente” underwent a customs inspection on December 15, 2005.
- In said inspection, the Tax Administration seized 5,832 “PAPER MATE” pens, without the owner being able to prove their legal introduction into Colombia, taking into account that they came from Guatemala.
- During the inspection, 7,476 “KILOMETRIC PLUS” pens were also discovered, when NEWELL SANFORD is the authorized manufacturer of PAPER MATE AND KILOMETRICO PLUS pens.
- From the analysis of the pens, it was determined that they did not comply with the characteristics of the originals, being marketed by the accused at a lower price.

PROCEDURAL ACTION

- The Colombian Prosecutor’s Office filed an indictment against SAÚL ENRIQUE ZULUAGA OLIVAR as a perpetrator of smuggling.
- On 2010/12/15 the accused was acquitted of the charges, since the Prosecutor’s Office did not present evidence of the existence of the company NEWELL SANFROD, nor of the exclusivity on the production of the pens “PAPER MATE” and “KILOMÉTRICO PLUS”.
- In the appeal filed by the Prosecutor’s Office and the Defense, the certification of the Superintendence of Industry and Commerce was provided, in which it was indicated that the owner of the trademarks “PAPER MATE” and “KILOMETRIC PLUS”, was the company BEROL CORPORATION of the United States of America and that this company had not granted a license of use of the trademarks to any other company.
- Witnesses indicated that the company NEWELL SANDFORD is the only company authorized to manufacture the “PAPER MATE” and “KILOMÉTRICO PLUS” pens, which have special characteristics that the contraband products did not have.
- It is not known from where the accused obtained the contraband pens since he does not have any contractual relationship with NEWELL SANDFORD.
- The company NEWELL SANDFORD had already been recognized as a victim by the judge of first instance, therefore it is requested to pronounce a conviction and the destruction of all the contraband pens.
- It is indicated that SAUL ENRIQUE ZULUAGA carried out the commercialization of counterfeit products and made an undue use of the trademarks “PAPER MATE” and “KILOMÉTRICO PLUS”.
- It was demonstrated that BEROL CORPORATION does not have factories in Colombia and there is no certainty as to how the pens were brought into Colombia, since there were no documents indicating this.

DECISION

The Superior Criminal Court of Pereira confirmed the decision adopted in the first instance and decided to declare SAUL ENRIQUE ZULUAGA as “not guilty” of the crime of smuggling, because the Prosecutor’s Office could not prove that the company SANFORD was authorized to produce and distribute the pens with the trademarks “PAPER MATE” and “KILOMÉTRICO PLUS”, as well as the right to use the registered trademarks.



1. Case topic		Seizure of goods on customs	
2. Country		Mexico	
3. Case citation (Title, Court and Case No.)		P.C. 975/2018 (F-10) 10376	
4. Date of order or judgment		February 28, 2020	
5. Type of infringing goods (categories)		CLASS 14	
6. Parties			
	Right Holder (Plaintiff)	Tiffany and Company	
	Infringer (Defendant)	Liu Meiying	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case

On a regular inspection, the Mexico City Airport customs identified the a shipment addressed at the infringer, with possibly infringing goods bearing the trademark and business name TIFFANY&CO., as well as the trade dress of the products with a different quality from what would be expected. Customs sent an alert to the Right Holder, who confirmed that the goods that the Infringer was attempting to import were not authorized or original. The Right Holder filed a request for provisional measures at the Mexican Trademark Office, consisting of the seizure of the goods, along with a provisional bond to cover possible damages. Afer an initial notification to the Infringer, they disappeared to avoid being served with further official communications. At the request of the Right Holder, the Mexican Trademark Office agreed to carry on with the provisional measures inaudita altera parte, in accordance with TRIPS article 50.2. Upon seiing the goods, the Mexican Trademark Office noted that the products were mock or costume jewelry and their value and therefore the possible damages did not surpass the provisional bond, and no extension was requested. After a successful seizure, the Right Holder filed an infringement action. A ruling was issued, finding that the Right Holder's IP rights had been infringed by the unauthorized use of the mark in goods blonging in the a class connected to a the Right Holder's products.



1. Case topic	Infringement online	
2. Country	MEXICO	
3. Case citation (Title, Court and Case No.)	P.C. 3471/2018 (I-440) 35609	
4. Date of order or judgment	DECEMBER 20, 2019	
5. Type of infringing goods (categories)	CLASS 16	
6. Parties		
	Right Holder (Plaintiff)	JUAN PABLO GURRIA BARCENAS
	Infringer (Defendant)	MERCADO IM S.A. DE C.V.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	ENCUENTRA	ENCUENTRA TU HOGAR
8. Outline (summary) of the case		

PLAINTIFF alleged infringement based on advertisings and website that allegedly used the phrase ENCUENTRA TU HOGAR. Nevertheless, the Mexican Trademark Office denied the claim on account that the plaintiff failed to provide evidence that would link them to the defendant. therefore, while online advertisings can infringe a registered mark, if a link cannot be shown to the specific defendant named in the complaint the claim will fail. This is important because even if infringement is shown, if it is not the defendant who is demonstrated to have comitted it, then no infringement will be declared.



1. Case topic	UDRP	
2. Country	MEXICO	
3. Case citation (Title, Court and Case No.)	Case No. D2020-0019	
4. Date of order or judgment	July 1, 2020	
5. Type of infringing goods (categories)	Class 12	
6. Parties		
	Right Holder (Plaintiff)	THE GOODYEAR TIRE & RUBBER COMPANY
	Infringer (Defendant)	Artemio Garza
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	GOODYEAR	LLANTASGOODYEAR.COM

8. Outline (summary) of the case

The defendant would use the domain llantasgoodyear.com to pass off as Goodyear and sell tires. The defendant even copied the colors and fonts of the official site of the company. They further attempted to “cyberflight” and claimed they had sold the domain name. The expert found that site would probably confuse users and that the defendant’s attempts to cyberflight and falsely claim the domain name had been sold constituted bad faith and transferred the domain name to the plaintiff, which now redirects to their site for Mexico.



1. Case topic	Trademark infringement	
2. Country	Mexico	
3. Case citation (Title, Court and Case No.)	Intellectual Property Chamber of the Federal Court of Administrative Justice (FCJA) 1498/20-EPI-01-10	
4. Date of order or judgment	May 31, 2021	
5. Type of infringing goods (categories)	Class 9,16 and 28	
6. Parties		
	Right Holder (Plaintiff)	SANRIO COMPANY, LTD
	Infringer (Defendant)	ROBERTO YUKIHIRO SHMIZU KANEKO
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	HELLO KITTY	HELLO KITTY

8. Outline (summary) of the case

Infringement Action filed by SANRIO for the unauthorized use of HELLO KITTY trademark in Mexico.

On November 2017, the MUJAM (a Mexican museum directed by Roberto) announced and celebrated an event called "KITTY'S BIRTHDAT AT MUJAM) whereby we could find several items for sale that were not authorized by Sanrio, and counterfeit goods.

In this sense we devised the strategy for the infringement action, as well as for the defense of HELLO KITTY trademark, obtaining evidence of the infringement, as well as evidence of use of the mark showing its notoriety.

Afterwards the Mexican Trademark Office (MTO) declared the infringement action against MUJAM, ordering to not use the marks and the character. Furthermore, the MTO imposed a fine to MUJAM of US \$8,500.00 dollars approximately.

This ruling was appeal by the defendant, nevertheless the FCA denied the appeal.



1. Case topic		Trade mark Infringement: trade mark comparison	
2. Country		Egypt	
3. Case citation (Title, Court and Case No.)		Decision in Appeal No. 11414 of Judicial Year 85; Commercial Court of Cassation – Session 13 February 2018	
4. Date of order or judgment		2018-02-13	
5. Type of infringing goods (categories)		Not disclosed	
6. Parties			
	Right Holder (Plaintiff)	Not disclosed	
	Infringer (Defendant)	Not disclosed	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		Not disclosed	Not disclosed

8. Outline (summary) of the case

For purposes of your reading, the binding decisions from the Court of Cassation in Egypt are generally not issued with detailed discussion of the facts: rather, they only set out the primary considerations and legal principles. Then, the Court gave detailed guidance on trade mark comparison, where it said that:

“It is also decided that imitation of the trade mark is based on a [comparison] of the similarity between the original and imitation, by [comparing the marks as wholes, to see if the] similarity would mislead the public. The [test] in imitation of the trade mark is not in the differences, but rather in the similarities, that create confusion between them, which leads to misleading the consumer public and involves [offence to] the ownership of the mark. [It is not a comparison [b]etween two signs [which] contains letters, symbols, or images, [as compared to the other mark], but rather in the general image that is imprinted in the mind as a result of the combination of these letters, symbols or images together and the form in which they appear in one sign or another, regardless of the elements from which they are composed, and [irrespective of the number of elements shared], [but the determination turns on] whether [the average consumer is deceived], not a [technical person].

(in this matter)[comparing the trade marks, the infringer had used] the same [design] of the contesting company, represented in the shape of the wing above the letter (C) in the trade mark, as well as [overlapping letters], which [results in the same pronunciation], which would imprint in the mind a general picture of the two contested marks, in a way that raises confusion that the products of the first contested, belong to the products of the appellant, especially since these marks are [used] for the same products [...], which leads to misleading the consumers of this category and contradicts the purpose for which the legislator granted - in national legislation and international treaties - protection for trade marks and industrial This was not achieved, as the General Administration of Trademarks refused to register the trademark of the appellant”.



1. Case topic	Trade mark Infringement: counterfeiting	
2. Country	Egypt	
3. Case citation (Title, Court and Case No.)	Decision in Appeal No. 17846 of Judicial Year 89; Misdemeanour Court of Cassation - session 6 June 2021	
4. Date of order or judgment	2021-06-06	
5. Type of infringing goods (categories)	Not disclosed	
6. Parties		
	Right Holder (Plaintiff)	Not disclosed
	Infringer (Defendant)	Not disclosed
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Not disclosed	Not disclosed
8. Outline (summary) of the case		

For purposes of your reading, the binding decisions from the Court of Cassation in Egypt are generally not issued with detailed discussion of the facts: rather, they only set out the primary considerations and legal principles. Then, the matter concerns the use of an identical, registered trade mark, and trade in counterfeit goods. The infringer had been indicted by the Public Prosecutor on a charge of a misdemeanour offence, before the Cairo Court of Misdemeanours (CCM) in 2015, which found that the infringer had intentionally imitated the registered trade mark, in a way which would mislead the public. The CCM found, on the basis of relevant provisions of the Egyptian Law on the Protection of Intellectual Property Rights (82 of 2002); the Egyptian Consumer Protection Law (67 of 2006) and the Egyptian Penal Code, that: a) the infringer pay a penalty award; b) that the decision be published in two daily newspapers; and that the counterfeit goods be confiscated for destruction.

The decision was appealed to the Misdemeanour Court of Cassation (MCC), which had to consider various grounds for appeal, including: i) whether the trial Court had correctly found that criminal intent was present; ii) whether a formal defect in the evidence preservatory measures could nullify the decision; and iii) whether the penalty imposed was justified. In respect of i) the MCC found that the MCC was not to competent to rule on matters of fact, and that only the Trial Court, with evidences before it, was competent to make rulings of fact; ii) that procedural irregularities do not, necessarily, lead to the annulment of decisions, and the particular error in this matter did not justify annulment; and iii) importantly, when considering if an act of counterfeiting merited penalties, that:

"Displaying products bearing a trade mark that is [a] counterfeit of a legally registered trade mark [involves] providing the consumer with incorrect information about the nature and characteristics of the product, which leads to creating an [untrue] and misleading impression on the consumer, [causing the consumer] to fall into confusion and error. [The] crime of displaying products bearing a [counterfeit] of a legally registered trade mark is the crime with the most severe description pursuant to Article 113 of Law No. 82 of 2002. The correct [application of the law] requires that only the most severe description penalty be imposed on the offender alone, [but] without the complementary, [lighter] penalties. [In this matter, the lighter penalty of publication of the decision] was supplementary [and, therefore, there was] no place for judgment on it".

Importance: This is one of the latest decisions by the MCC on dealing in counterfeit goods. It exemplifies that the Egyptian Courts take counterfeiting seriously, and that, on the facts, the simple act of displaying goods for sale bearing an imitated trade mark, constituted an offence, and that the Court had assumed intent through the infringers conduct. The fine imposed was relatively low from an International perspective (around US\$ 636), but, placed in context, this is considered to be a material fine in the country. The case shows that the Courts are empowered to order the confiscation and destruction of goods, and that non-material procedural irregularities can be considered to be de minimis, which is an important principle for practitioners versed in IP litigation in the country, where procedural issues are not infrequent. The Court's decision not to publish the decision is interesting, and perhaps shows a balancing of interests, because, from the reported decision, one can see that the infringer did strongly express innocence.



1. Case topic	Trade mark infringement: damages	
2. Country	Egypt	
3. Case citation (Title, Court and Case No.)	Appeal No. 12806 of the Judicial Year 87 [Civil Court of Cassation]	
4. Date of order or judgment	2001-01-01	
5. Type of infringing goods (categories)	Not disclosed	
6. Parties		
	Right Holder (Plaintiff)	Not disclosed
	Infringer (Defendant)	Not disclosed
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Not disclosed	Not disclosed
8. Outline (summary) of the case		

For purposes of your reading, the binding decisions from the Court of Cassation in Egypt are generally not issued with detailed discussion of the facts: rather, they only set out the primary considerations and legal principles. Then, the Court presented dictum on damages in civil trade mark infringement: *The material damage [which] necessitates compensation in this field is the damage that has occurred, i.e. the damage that has actually occurred or will inevitably occur, which is what is called future damage. [That is, it is a claim] for monetary compensation for the damage incurred by the victim or will inevitably be inflicted on him. It represents a breach of his financial interest, and the burden of proof rests on the latter as a plaintiff. It was decided that, although the material damage and the estimation of compensation for damages are among the issues [falling within the discretion of the Courts and the discretion must be exercised upon evidences before the Court].*



1. Case topic	Trade mark infringement: nature of a trade mark	
2. Country	Egypt	
3. Case citation (Title, Court and Case No.)	Appeal No. 4583 of the Judicial Year 84 [Commercial Court of Cassation]	
4. Date of order or judgment	2015-06-25	
5. Type of infringing goods (categories)	Not disclosed	
6. Parties		
	Right Holder (Plaintiff)	Not disclosed
	Infringer (Defendant)	Not disclosed
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Not disclosed	Not disclosed

8. Outline (summary) of the case

For purposes of your reading, the binding decisions from the Court of Cassation in Egypt are generally not issued with detailed discussion of the facts: rather, they only set out the primary considerations and legal principles. Then, the Court presented dictum on the nature of a trade mark: *[a trade mark] is one of the most important methods that merchants and factory owners resort to in order to introduce their goods to their consumers. Distinguishing his products from those of his competitors in a way that protects them from a defect in a competing product that he may not be able to repudiate, lose the ability to dispose of it to his consumers, or [in terms of which a competitor can] achieve an advantage [...] that they do not deserve that increases their ability to compete with him. By means of this distinctive mark, the consumer can identify the commodity he wants to buy. (in reference to infringement) [The consumer can become] confused by its identity or [no longer have] the quality to which it is accustomed. Accordingly, the trade mark or industrial trade mark must be characterized in its form and content by what, on its surface, indicates the difference that is intractable [from similar marks], free from confusion and doubt, and [is unique and distinctive].*

2. China(1) Case 1



1. Case topic	a leading case on trademark infringement that sets out the test for likelihood of confusion	
2. Country/Region	Hong Kong SAR, China	
3. Case citation (Title, Court and Case No.)	Tsit Wing (Hong Kong) Co Ltd and TWG Tea Co Pte Ltd (No 2) (2016) 19 HKCFAR 20	
4. Date of order or judgment	2016-01-29	
5. Type of infringing goods (categories)	Coffee and tea products; food services and operation of cafes	
6. Parties		
	Right Holder (Plaintiff)	Tsit Wing (Hong Kong) Co Ltd
	Infringer (Defendant)	TWG Tea Co Pte Ltd
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

The Plaintiff, a wholesaler of coffee and tea products and operator of coffee shops in Hong Kong brought a passing off and trade mark infringement action under the Trade Marks Ordinance (Cap. 559) over the use of TWG's trade mark against the Defendants who produce tea and established as a tea shop operator in Singapore. The Court of Final Appeal found in favour of the Plaintiffs.

The test to be applied when considering whether marks confusingly similar have been set out by the Court of Final Appeal in this case. First, the question of the similarity of the mark and sign and/or goods and services must be determined. Second, the likelihood of confusion is then to be determined. In determining the likelihood of confusion the degree of similarity of the mark and sign and/or goods and services may be taken into account.

To determine likelihood of confusion – (a) the likelihood of confusion must be appreciated globally, taking account of all relevant factors; (b) the matter must be judged through the eyes of the average consumer of the goods or services in question, who is deemed to be reasonably well informed and reasonably circumspect and observant, but who rarely has the chance to make direct comparisons between marks and must instead rely upon the imperfect picture of them he has kept in his mind; (c) the average consumer normally perceives a mark as a whole and does not proceed to analyse its various details; (d) the visual, aural and conceptual similarities of the marks must normally be assessed by reference to the overall impressions created by the marks bearing in mind their distinctive and dominant components; (e) a lesser degree of similarity between the goods or services may be offset by a greater degree of similarity between the marks, and vice versa; (f) there is a greater likelihood of confusion where the earlier mark has a highly distinctive character, either per se or because of the use that has been made of it; (g) mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient; (h) the reputation of a mark does not give grounds for presuming a likelihood of confusion simply because of a likelihood of association in the strict sense; and (i) if the association between the marks causes the public to wrongly believe that the respective goods or services come from the same or economically-linked undertakings, there is a likelihood of confusion.



1. Case topic		a leading case on infringement dealing with counterfeit goods	
2. Country/Region		Hong Kong SAR, China	
3. Case citation (Title, Court and Case No.)		MGA Entertainment, Inc v Combuy Co Ltd & Anor [2020] HKCU 863	
4. Date of order or judgment		2020-04-29	
5. Type of infringing goods (categories)		Toys and dolls	
6. Parties			
	Right Holder (Plaintiff)	MGA ENTERTAINEMNT, INC.	
	Infringer (Defendant)	1st Defendant: COMBUY CO., LIMITED 康伯有限公司 2nd Defendant: SHANTOU CITY COMBUY TOYS & GIFTS CO., LIMITED 汕頭市康伯玩具禮品有限公司	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		<p>L.O.L. SURPRISE!</p> 	<p>Counterfeit dolls bearing combinations of the marks L.Q.L. SURPRISE!, L.O.L and L.Q.L.</p>

8. Outline (summary) of the case

This an application for summary judgment by the Plaintiff (which is one of the largest privately owned toy companies in the world based in California) against the Defendants (which is a toy manufacturer with its head office in Hong Kong, sales office in Guangzhou and factory in Chenghai of Guangdong) for trade mark infringement and passing-off. The Plaintiff claims that the Defendants have offered or exposed for sale the counterfeit dolls under the signs "L.O.L. SURPRISE!" and "L.Q.L. SURPRISE!" or other variants on its website and promoting the counterfeit dolls in the Mega Show Part 1 at the Hong Kong Convention and Exhibition Centre. The defendant defended by arguing that the website was only targeted at the Mainland market and the samples at the Mega Show "were not offered, exposed or in any way put for sale".

The court held that the website was not merely targeting the Mainland market as there had been overwhelming evidence to show that the average consumer of the goods in issue is in fact originated from Hong Kong and would therefore regard the website and the advertisements thereon as being directed at residents of Hong Kong. In particular, the court noted that the website was presented in English and customers anywhere in the world could purchase the counterfeit dolls on the website. Together with the fact that the Defendants had participated in the Mega Show which was promoting sale of their products to international buyers, the claims for trade mark infringement and passing-off are therefore found to be actionable in Hong Kong. The court allowed the application and granted summary judgment against the Defendants.

2. China(1) Case 3



1. Case topic	a leading case on trademark infringement online	
2. Country/Region	Hong Kong SAR, China	
3. Case citation (Title, Court and Case No.)	MARY KAY INC AND OTHERS v ZHEJIANG TMALL NETWORK CO, LTD (浙江天猫网络有限公司) AND OTHERS [2021] HKCU 2335	
4. Date of order or judgment	2021-05-20	
5. Type of infringing goods (categories)	Cosmetics	
6. Parties		
	Right Holder (Plaintiff)	1st Plaintiff: MARY KAY INC. 2nd Plaintiff: MARY KAY (HONG KONG) LIMITED (玫琳凱(香港)有限公司) 3rd Plaintiff: 玫琳凱(中國)有限公司 (MARY KAY (CHINA) COMPANY LIMITED)
	Infringer (Defendant)	1st Defendant: 浙江天猫网络有限公司 (ZHEJIANG TMALL NETWORK CO., LTD) 2nd Defendant: 浙江天猫技术有限公司 (ZHEJIANG TMALL TECHNOLOGY CO., LTD) 3rd Defendant: TAobao CHINA HOLDING LIMITED (淘寶中國控股有限公司) 4th Defendant: 蒙城县庆丰商贸有限公司 (MENG CHENG COUNTY QINGFENG TRADING CO., LTD) 5th Defendant: 上海天翌电子商务有限公司 (SHANGHAI TIANYI ELECTRONIC COMMERCE CO, LTD)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Mary Kay 玫琳凱	N/A

8. Outline (summary) of the case

The Plaintiffs (an international cosmetics company) had filed a lawsuit in Hong Kong against Chinese e-shopping platforms Tmall and Taobao as well as two online shops alleging trade mark infringement and passing-off for the sale of its products. The lawsuit also claimed that Alibaba Companies as platform service providers were joint tortfeasors for failing to conduct proper checks on products being sold on the e-commerce platforms.

In Hong Kong, it is not a trade mark infringement if parallel imported goods are put on the market with the trade mark owner's consent (whether express, implied, conditional or unconditional) ("Exhaustion Defence"), unless the condition of the goods have been changed or impaired after they have been put on the market, and the use of the registered trade mark in relation to those goods is detrimental to the distinctive character or repute of the trade mark.

The Plaintiff claimed that there was trade mark infringement because the production lot codes had been removed from the packaging of the genuine Mary Kay products being offered for sale by the vendors, which had changed or had been impaired the condition of the goods. The court held that the exception to the Exhaustion Defence can only apply if the physical condition of the goods themselves has been adversely affected and the damage is substantial. Therefore, there is no trade mark infringement. Further, there is no passing off as no evidence to support the vendors who were selling genuine goods misrepresented that they were related to the Plaintiffs.

It was also held that the platform operators, Alibaba Companies were not jointly liable because the provision of an online platform is to facilitate the marketing and sale of products by vendors. They merely implemented a policy which requires applicants wanting to set up a store to submit certain documents showing that the products are prima facie genuine. There are also Notice-Take-Down procedures to deal with complaints from brand owners. A platform operator is under no legal duty to prevent infringement of third parties' registered trade marks.



1. Case topic	Leading case on trademark infringement that sets out the test for likelihood of confusion	
2. Country	India	
3. Case citation (Title, Court and Case No.)	Amritdhara Pharmacy V. Satyadeo Gupta Supreme Court AIR 1963 SC 449	
4. Date of order or judgment	April 27, 1962	
5. Type of infringing goods (categories)	medicinal preparation	
6. Parties		
	Right Holder (Plaintiff)	Amritdhara Pharmacy
	Infringer (Defendant)	Satyadeo Gupta
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	AMRITDHARA	LAKSHMANDHARA

8. Outline (summary) of the case

Satya Deo Gupta (Respondent) filed an application for registration of the mark "Lakshmandhara" in 1950 under class 5 claiming use since 1923 claiming that their products were sold not only in India but in foreign market as well. Amritdhara Pharmacy (Appellant) filed an opposition claiming to be prior user of the mark "Amritdhara" since 1901, reputation throughout India and "Lakhmandhara" was used to denote the same medical preparation as that of "Amritdhara", likelihood of confusion. The Trademarks office held the rival marks to be similar. In appeal, Allahabad High Court held that there is no possibility of confusion between the two marks and disallowed registration of the trademark "Lakshmandhara". Amritdhara Pharmacy preferred an appeal against the order passed by High Court.

The Apex Court laid down the test for determining similarity between the two marks. The comparison to determine resemblance between the two marks is from the point of view of a person of average intelligence with imperfect recollection. The question whether a trade name is likely to deceive or cause confusion by its resemblance to another already registered is a matter of first impression and has to be decided by taking an overall view of the circumstances. The Court was of the view that the two names should be considered as a whole for comparison and a critical comparison of the two names may disclose some points of difference, but an unwary purchaser of average intelligence and imperfect recollection would be deceived by the overall similarity of the two names having regard to the nature of the medicine he is looking.

The Court observed that there exists overall similarity between the trade Marks AMRITDHARA v LAKSHMANDHARA and the High Court was erred in its observation. Thus, the appeal was allowed and the order passed by High Court was set aside.



1. Case topic	leading case on infringement dealing with counterfeit goods	
2. Country	India	
3. Case citation (Title, Court and Case No.)	Sandisk Corporation v Ramjee and Ors Delhi High Court CS(OS) 3205/2014	
4. Date of order or judgment	May 4, 2017	
5. Type of infringing goods (categories)	Flash Memory Storage solutions	
6. Parties		
	Right Holder (Plaintiff)	Sandisk Corporation
	Infringer (Defendant)	Ramjee and Others
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	SanDisk, SanDisk Logo	SanDisk, SanDisk Logo

8. Outline (summary) of the case

Sandisk Corporation (US based entity) engaged in the business of flash memory storage solutions under the registered trademark/house mark 'SanDisk' and 'SanDisk' Logo in more than 150 countries and owner of copyright of the unique packaging style filed a suit against the defendants for permanent injunction restraining infringement of trademarks and copyright, delivery up, rendition of accounts of profits, damages.

The defendants were engaged in selling counterfeit SanDisk Micro SD memory cards through large number of stalls set up all across the pavements in the makeshift markets at Daryaganj, Old Delhi. The packaging of these counterfeit memory cards was identical to that of plaintiff's bearing the trademark 'SanDisk' of the plaintiff in an identical manner. As it was impossible to identify the names of fly-by night operators, unnamed persons were arrayed as 'John Doe/s' initially at the stage of filing the suit. The Court granted ex-parte ad interim injunction in favour of the plaintiff and appointed three local commissioners were appointed to visit the premises to seize the counterfeit products and also to identify the infringers.

The local commissioners identified three sellers of the counterfeit products - Mr. Ramjee, Mr. Munna Kumar and Mr. Vikas Jain. These proposed sellers were impleaded as defendants. The local commissioners seized 4500 packets of the infringing memory cards bearing the identical SanDisk logo and packaging. The defendants did not appear and were proceeded ex-parte.

The Photographs of the counterfeit products when compared with those of the plaintiff's bearing the trademark 'SanDisk' clearly established that the infringing products were identical in all aspects. The Court observed that the defendants have copied the trademark and logo of the plaintiff's in all respects. This adoption of the trademark of the plaintiff is fraudulent and has caused huge losses to the plaintiff.

The suit was decreed in favour of the plaintiff by grant of permanent injunction restraining the defedants from manufacturing, selling, offering for sale, advertising or dealing in products bearing the plaintiff's trademark 'SanDisk' and 'SanDisk logo' and the 'Red Frame' logo, with identical product packaging, product get-up, colour scheme, layout, overall look and feel as used by the plaintiff and from passing off their goods as those of the Plaintiff and which infringe the plaintiff's copyright in the artistic work comprised in the SanDisk product packaging, the 'Red Frame' Logo, color scheme, product layout. The court awarded damages to the tune of Rs. 15 lakh (US\$ 20,270) and cost of the suit in favour of the plaintiff.



1. Case topic	leading case on trademark infringement online	
2. Country	India	
3. Case citation (Title, Court and Case No.)	Christian Louboutin SAS vs. Nakul Bajaj And Ors Delhi High Court CS (COMM) 344/2018	
4. Date of order or judgment	November 2, 2018	
5. Type of infringing goods (categories)	Luxury shoes	
6. Parties		
	Right Holder (Plaintiff)	Christian Louboutin SAS
	Infringer (Defendant)	Nakul Bajaj and Ors
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	CHRISTIAN LOUBOUTIN	CHRISTIAN LOUBOUTIN

8. Outline (summary) of the case

The plaintiff, Christian Louboutin is a luxury brand which specializes in shoes and other related goods sought an injunction against the Defendants' use of its CHRISTIAN LOUBOUTIN trademarks and sale of goods-products under the said marks on the website www.darveys.com ("Darveys.com")

In support of its case, the plaintiff pleaded that the use of CHRISTIAN LOUBOUTIN trademarks and meta tags comprising of CHRISTIAN and LOUBOUTIN to attract web traffic on Darveys.com website amounts to infringement, violation of personality rights of Mr. Christian Louboutin, Defendants are themselves engaged in offering for sale counterfeit products on their website Darveys.com, Defendants act much more than a mere intermediary; customers are of the Defendants themselves than the hosted sellers, Defendants themselves infringe and are disentitled to shelter under Section 79 of the IT Act. Section 79 of the IT Act provides safe harbour protection to intermediaries over content uploaded or sold through third parties.

The Defendants claimed immunity under Section 79 of the IT Act took the plea that they are merely an E-commerce platform acting as an intermediary; that they are not involved in the manufacture, sale or purchase of products by the sellers; that provide a website-portal as a technological interface to sellers and provide take-down policy for anyone complaining of trademark infringement by a hosted seller. The Defendants submitted that no actual sales of products featuring the Plaintiff's marks have yet transpired on Darveys.com.

In its decision, the Court analyzed the various business models of e-commerce platforms and examination of various tasks such as provision of transportation, quality assurance, authenticity guarantees, collection of payment, advertisement and promotion of product, enrolling members upon payment of membership fees, using trademarks through meta-tags etc., when performed by e-commerce platform would be key to determining whether an online marketplace is conspiring, abetting, aiding or inducing and is contributing to the sale of counterfeit products on its platform" thus rendering the conduct of the platform as more than that of merely an 'intermediary'.

The Court examined the functioning of Darveys.com website and noted that as per its own claims and policies, Defendants themselves take responsibility for authenticity of the goods, arrange for the transport and delivery of goods themselves and themselves maintain and change prices of the goods-products at their own discretion.

The court held that the use of the mark, Christian Louboutin, name, photograph of founder, without permission of Plaintiff, and without ensuring that products which were sold was in fact genuine, constitutes violation of the Plaintiff's rights. The Court observed that the Defendants, exercise complete control over the infringing products on Darveys.com and Darveys.com cannot be considered as an intermediary and claim exemption under section 79 of IT Act. The use of meta-tags which comprises of brand names of others amounts to infringement. The court concluded that "... if the sellers themselves are located on foreign shores and the trade mark owner cannot exercise any remedy against the said seller who is selling counterfeits on the e-commerce platform, then the trade mark owner cannot be left remediless." The court issued various directions to Daveys.com website by stating that Darveys.com will disclose complete details of the sellers, obtain certificate from its sellers that the goods are genuine, removal of meta tags consisting of plaintiff's marks, Darveys.com shall seek guarantee from the sellers that the product are not impaired and if the seller on Darveys.com website is unable to provide any evidence that the product is genuine, it shall take down the listing and notify the plaintiff.



1. Case topic	additional case to round out the landscape	
2. Country	India	
3. Case citation (Title, Court and Case No.)	Cadila Health Care Ltd. vs Cadila Pharmaceuticals Ltd Supreme Court Appeal (civil) 2372 of 2001, Special Leave Petition (Civil) 15994 of 1998	
4. Date of order or judgment	March 26, 2021	
5. Type of infringing goods (categories)	Medicinal and pharmaceutical preparations	
6. Parties		
	Right Holder (Plaintiff)	Cadila Health Care Ltd
	Infringer (Defendant)	Cadila Pharmaceuticals Ltd
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	FALCIGO	FALCITAB

8. Outline (summary) of the case

This case truly set the tone for a completely new thought process in the field of trade mark law concerning medicinal and pharmaceutical preparations.

Cadila Healthcare, a pharmaceutical Company filed a suit against another pharmaceutical company, Cadila Pharmaceutical Ltd. Cadila Healthcare was engaged in manufacturing a drug under the name "FALCIGO" used for treatment of cerebral malaria. Cadila Healthcare applied for registration of FALCIGO in class 5 on 20th August 1996 before the Trade Marks Registry. The company was granted permission to sell FALCIGO in the market on 7th October 1996 by the Drugs Controller. Cadila Pharmaceuticals received permission to sell FALCITAB drug on 10th April 1997 for the same treatment.

As soon as it came to the notice of Cadila Healthcare in April 1998, suit for injunction was filed in District Court of Vadodara alleging that the drug of Cadila Pharmaceuticals Ltd. would be passed off as FALCIGO due to similarity in marks, composition, and treatment. The Court refused to grant injunction stating there is difference in appearance and price and are Schedule L drugs, i.e. they are only sold to hospitals and clinics, and therefore there is no scope for deception or confusion.

Cadila Healthcare filed an appeal before High Court, which was dismissed stating that confusion is unlikely to occur. Cadila Healthcare filed an appeal before the Supreme Court. The case was aggressively contested.

In order to bring uniformity, Supreme Court laid down the following broad guidelines taking into account the realities of the Indian market:

- Although drugs are sold on prescription, this fact alone is not sufficient to prevent confusion. The actual social conditions and practices must also be borne in mind.
- Linguistic variations across India could lead to high levels of confusion when pharmacists dispense drugs in urban and rural areas.
- Strict measures should be applied in the case of medicines to prevent confusion. The public interest would support a lesser degree of proof with regard to medicinal products, compared to non-medicinal products.
- Since confusion relating to drugs and medicines could be fatal not merely inconvenient, drugs should be treated as poisons, not sweets.
- Physicians and pharmacists are trained professionals, yet they are not infallible - in this sector there can be no room for error, since any mistake could prove fatal.
- Doctors in India are under tremendous pressure and therefore steps should be taken to mitigate confusion wherever possible.
- As drugs are available on oral request via telephone services, there is a high risk of confusion. Purchasers may have no knowledge of English or the language in which the trademark is written, and slight differences in spellings may sound phonetically the same.
- Some of the essential factors to be considered for determining deceptive similarity are nature of marks, extent of similarity between the competing marks - phonetic and visual similarity, nature of goods, area where the goods are used, similarity in the goods in relation to performance, nature, character of the goods, class of purchasers who are likely to buy the goods, their intelligence, and the requisite degree of care they are likely to exercise in purchasing the goods.

The Cadila guidelines have helped courts to adjudicate claims involving medicinal products with a greater degree of certainty.



1. Case topic		additional case to round out the landscape	
2. Country		India	
3. Case citation (Title, Court and Case No.)		Kaviraj Pandit Durga Dutt Sharma v Navratna Pharmaceuticals Laboratories Supreme Court AIR 1965 SC 980	
4. Date of order or judgment		October 20, 1964	
5. Type of infringing goods (categories)		Medicinal Preparation	
6. Parties			
	Right Holder (Plaintiff)	Kaviraj Pandit Durga Dutt Sharma v Navratna Pharmaceuticals Laboratories	
	Infringer (Defendant)	Navratna Pharmaceuticals	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		Navaratna Kalpa	Navaratna Navaratna Pharmaceutical Laboratories

8. Outline (summary) of the case

Respondent firm was founded in 1926 under the name of "Navaratna Pharmacy" and it later changed the name to "Navaratna Pharmaceutical Laboratories" in 1945. Respondent was a manufacturer of medicinal products and owner of two registered trademarks "Navaratna" and "Navaratna Pharmaceutical Laboratories" from a period prior to February 25, 1937.

Appellant was engaged in carrying on the business of ayurvedic pharmaceutical products under the name "Navaratna Kalpa Pharmacy" and had been vending medicines prepared under the name "Navaratna Kalpa". The Appellant applied for registration of "Navaratna Kalpa" as a trademark. The opposition was decided in favour of the Respondent and the registration was refused. The Appellant approached the Registrar of Trade Marks for removing from the register the trade mark "Navaratna" by itself and the word "Navaratna" in the other mark of the Respondent.

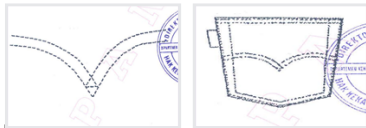


The Registrar directed the Appellant to approach the High Court as the Respondent firm had already filed a suit at the District Court for a perpetual injunction against the Appellant objecting to sale of goods under a trade mark combining the "Navaratna" or any similar word on the basis it was the proprietor of two registered marks "Navaratna" and "Navaratna Pharmaceutical Laboratories".

The District Court granted the Respondent, a decree for an injunction confined to the trademark "Navaratna Pharmaceutical Laboratories". Appellant filed an appeal before High Court of Travancore-Cochin. The decree against the Appellant was confirmed by the High Court and the Original Petition seeking removal of the Respondent's trade marks was dismissed. Appellant approached the Supreme Court.

The Supreme Court dismissed the appeals filed by the Appellant and observed that :

- (i) in an action for infringement, the plaintiff is required to establish that the defendant's marks is deceptively similar. If similarity between the Plaintiff's and Defendant's marks is so close either visually, phonetically or otherwise and the Court reaches a conclusion that there is an imitation, no further evidence is required to establish that the Plaintiff's rights are violated.
- (ii) where the two marks are identical, the case for infringement is made out. Where the two marks are not identical, the plaintiff will have to establish that that the mark used so nearly resembles and is likely to cause confusion.
- (iii) there was no error in the approach of the District Judge holding that the length of the user is a material factor for the mark to be considered as distinctive and was exclusively associated with the goods of the Respondent as they were using the said mark since 1926 which was not disputed.
- (iv) the viewpoint arrived by the lower courts was correct and the Appellant's mark is deceptively similar to that of the Respondent



1. Case topic		
2. Country		Indonesia
3. Case citation (Title, Court and Case No.)		Commercial Court of Central Jakarta - Case No. 56/Pdt.Sus-HKI/ Merek/2018/PN Niaga Jkt.Pst
4. Date of order or judgment		2019-09-05
5. Type of infringing goods (categories)		Levis jeans' back pocket stitching pattern devices
6. Parties		
	Right Holder (Plaintiff)	Levis Strauss & Co
	Infringer (Defendant)	Tomi Yomriko
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Registered marks:  In use: 	Registered marks:  In use: 

8. Outline (summary) of the case

Levis Strauss & Co., a clothing and jeans company headquartered in California, United States, has registered "Arcuate device" trademarks Nos. IDM000005515 & IDM000005518 both in class 25 since 2003.

Tomi Yomriko, the Defendant, is a local businessman who uses arcuate stitches on the back pocket of his products without the Plaintiff's permission.

Plaintiff filed a trademark infringement claim on the basis of similarity in principle and entirety with its well-known mark. Plaintiff order the Defendant to stop all actions and activities relating to the use of the stitching device and to surrender all goods and clothing products that used the said device. Plaintiff also asked the court to punish the Defendant to pay for material damages in the amount of Rp2.628.000.000,00 (two billion six hundred and twenty-eight million rupiah) and immaterial damages in the amount of Rp2.000.000.000,00 (two billion rupiah).

The Commercial Court partially accepted the claims. The Panel is of the opinion that the Plaintiff is the owner and registrar of the "ARCUATE PAINTING" Trademark and can be categorized as a well-known trademark because the Plaintiff has carried out intensive and massive promotions through websites and the internet that can be accessed in various countries at a considerable cost;




The Panel is of the opinion that the Defendant's Arcuate Painting trademark sold in his store has similarities in principle with the Plaintiff's Arcuate Painting regarding the form of placement.

Because the Defendant has sold jeans with the Arcuate painting trademarks that have similarities in principle with the Plaintiff's trademark and the Plaintiff did not give any permission to the Defendant to use/sell it, it should be proper to stop activities related to the use of Arcuate painting trademarks

Regarding the material and immaterial damages, the Panel cannot grant it because there is no clear measure of the calculation of losses suffered by the Plaintiff, namely losses which are mainly based on estimates of total sales per day at the Defendant's store based on verbal information from the shopkeeper.

The Panel punish the Defendant to pay for the court's fees in the amount of Rp5.716.000,00 (five million seven hundred and sixteen thousand rupiahs).



1. Case topic		
2. Country		Indonesia
3. Case citation (Title, Court and Case No.)		Commercial Court of Surabaya - Case No. 6/Pdt.Sus-HKI/Merek/2019/PN Niaga Sby
4. Date of order or judgment		2019-12-19
5. Type of infringing goods (categories)		Gold and Precious metals Jewelry's logo mark
6. Parties		
	Right Holder (Plaintiff)	PT. Dynasty Mas Prima
	Infringer (Defendant)	1. Sudiwanto Tandiya; 2. Linagustin
7. Mark		Examples of Infringing (Defendant's) Trademark
Examples of Infringed (Plaintiff's) Trademark		<p>Actual Use:</p> <ol style="list-style-type: none"> 1. The Defendants' Stores used the DYNASTY mark, (Proven by photo evidence of Plaques for the Dynasty Store Advertisement Showroom Address Atom Mall LT.1. A.21, Surabaya.); 2. The Defendants' Stores use the DYNASTY mark (Proven by video evidence of Dynasty Stores); 3. The Defendants' stores used a receipt with the DYNASTY mark logo with the R mark. Which means the mark should be registered with the DGIP. (Proven by sales receipt dated August 16, 2019); 4. The Defendants's stores in making sales, used a brochure with the DYNASTY logo with the R mark. (Proven by sales receipt dated 19 August 2019); 5. The Defendants' store in order to promote themselves to the public, used the Internet and non-electronic electronic media like brochures., which uses the DYNASTY mark; 6. Wrapping or packaging using the DYNASTY mark.
Registered marks:  No. IDM000259487 in class 14		
		 

8. Outline (summary) of the case

PT Dynasty Mas Prima, represented by Hendy Purnomo as the President Director, filed a trademark infringement lawsuit with the Surabaya Commercial Court. The lawsuit was addressed to Sudiwanto Tandiya and Linagustin that have used the well-known DYNASTY mark without permission, namely:

1. The Defendants' Stores used the DYNASTY mark, (Proven by photo evidence of Plaques for the Dynasty Store Advertisement Showroom Address Atom Mall LT.1. A.21, Surabaya.);
2. The Defendants' Stores used the DYNASTY mark (Proven by video evidence of Dynasty Stores);
3. The Defendants' stores used a receipt with the DYNASTY mark logo with the R mark. This should be registered with the DGIP. (Proven by sales receipt dated August 16, 2019);
4. The Defendants's stores in doing sales, use a brochure with the Dynasty mark logo with the R mark. Which means that the brand has been registered with the DGIP. (Proven by sales receipt dated 19 August 2019);
5. The Defendants' store in order to introduce themselves to the public, using the Internet and non-electronic electronic media through brochures, both oral and written. which uses the DYNASTY mark;
6. Wrapping or packaging using the DYNASTY mark.



The Plaintiff asked the court to punish the Defendant to pay material damages of Rp. 14.000.000.000 (fourteen billion rupiah) with details that each year the plaintiff suffers a loss of Rp. 2.800.000.000. (two billion eight hundred rupiah); and immaterial damages of 5.000.000.000 (five billion rupiah).

The Plaintiff also requested the Court to punish the Defendants so that they are not allowed to use the DYNASTY mark. The Dynasty mark used by the Defendants must be disbanded, terminated and closed, either through Electronic media or Non-Electronic Media.

The Panel of Judges partially accepted the Plaintiff's claims. The Defendant was proven to use the mark based on bad faith. The Panel of Judges ordered the Defendants not to use the DYNASTY mark and the DYNASTY mark used by the Defendants must be ceased, terminated and closed, and they may not use the DYNASTY mark either through electronic or non-electronic media.

However, the Panel of Judges rejected the Plaintiff's claim regarding compensation, with the consideration that there is no evidence supporting the material or immaterial damages suffered by the Plaintiff, thus the claim for compensation must be declared rejected.



1. Case topic		a leading case on trademark infringement that sets out the test for likelihood of confusion
2. Country		Kazakhstan
3. Case citation (Title, Court and Case No.)		Civil case on trademark infringement, The Supreme Court of the Republic of Kazakhstan, case number 3rn-281(2)-17
4. Date of order or judgment		2017-12-13
5. Type of infringing goods (categories)		Non-alcoholic beverages
6. Parties		
	Right Holder (Plaintiff)	The Coca-Cola Company
	Infringer (Defendant)	Unix LLP
7. Mark		
Examples of Infringed (Plaintiff's) Trademark		Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

In the period of 2014-2015 it was found a non-alcoholic beverage being sold in Kazakhstan under the brand name KAZAKHSTAN COLA and produced by Unix LLP.

In 2016 it was filed a claim with the Specialized Interdistrict Economic Court of Shymkent city on the ground of the trademark infringement and unfair competition. As confirmation of unfair competition it were submitted the results of the consumer poll according to which 85% of respondents replied that KAZAKHSTAN COLA is associated with the producer of the COCA-COLA.

On July 18, 2016 it was issued the Court decision and the claim of the Coca-Cola company was rejected. In the opinion of the court the trademarks COCA-COLA and KAZAKHSTAN COLA are not confusingly similar and misleading the public is impossible.

In August 2016 it was file an appeal with the court of the appeal instance (Appeal Judicial Panel for Civil Cases of the South Kazakhstan regional court). On September 19, 2019 the Appeal Judicial Panel for Civil Cases of the South Kazakhstan regional court issued a Resolution on rejection of the appeal.

In 2017 it was filed a cassation complaint with the Supreme Court of the Republic of Kazakhstan. On May 30, 2017 the Supreme Court of the Republic of Kazakhstan issued a Resolution on sending the case on new consideration to the Appeal Judicial Panel for Civil Cases of the South Kazakhstan regional court.



On August 15, 2017 the Appeal Judicial Panel for Civil Cases of the South Kazakhstan regional court considered the case and again issued a Resolution on rejection of the requirements of the Coca-Cola Company.

In October 2017 it was filed a cassation complaint with the Supreme Court of the Republic of Kazakhstan.

Finally on December 13, 2017 the Supreme Court of the Republic of Kazakhstan issued the Resolution to oblige the Unix LLP to stop an infringement to prohibit the use the bottle shape and label of the Kazakhstan Cola, and the Cola.kz, confusingly similar to the trademarks of the Coca-Cola and containing the elements of the trademarks of The Coca-Cola Company, by manufacturing, use on the goods, storing, offering for sale and selling the goods, use in advertising, printed materials or other business documents; to oblige the Unix LLP to destroy the packaging, including the bottles of the product, to which the non-alcoholic beverage is poured and on which the designations confusingly similar to the trademarks of The Coca-Cola Company are placed; to oblige the Unix LLP to remove from the documentation, advertising, signs and other materials that accompany the production and sale of the non-alcoholic beverages, the designations confusingly similar to the trademarks of The Coca-Cola Company.



1. Case topic	a leading case on infringement dealing with counterfeit goods
2. Country	Kazakhstan
3. Case citation (Title, Court and Case No.)	Criminal case on trademark infringement, Court of Almaly district of Almaty city, case number 7511-21-00-1/532
4. Date of order or judgment	On-going
5. Type of infringing goods (categories)	Auto spare parts
6. Parties	
Right Holder (Plaintiff)	Toyota Motor Corporation
Infringer (Defendant)	Mr.Tursynbek Bayaly, Ms. Mira Talblimova

7. Mark	
Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
<p>TOYOTA</p>	 

8. Outline (summary) of the case

In the period of June 10-15, 2021 upon an application of Toyota Motor Corporation the Department of Economic Investigations of Almaty city (Kazakhstan) conducted 3 raid actions from which more than 86,000 counterfeit spare parts were arrested.

Total harm to the trademark owner exceeds 1 750 000 000 KZT (approx. US \$ 4,116,180).

The infringer were bringing counterfeit parts from China and selling locally in bulk. Some of the parts came already assembled, the others were assembled locally (came without the boxes and stickers, and then packed) by the infringers.

During the raid action, one of which happened on the open market, the infringers invited about 200 people (sellers from that market) and by various means created obstacles to the officers by not allowing to arrest the goods.

After the raid action the goods were twice moved to other warehouses due to a risk of being stolen.

Independent expertise confirmed that the goods are counterfeit.

Currently the case is in the criminal court, awaiting for the final decision.



1. Case topic	a leading case on trademark infringement online	
2. Country	Kazakhstan	
3. Case citation (Title, Court and Case No.)	Administrative case on illegal trademark use in domain name, Specialized interdistrict administrative court of Almaty city, case number 7528-20-00-3/15530	
4. Date of order or judgment	2020-09-20	
5. Type of infringing goods (categories)	Service on repair of electronics	
6. Parties		
	Right Holder (Plaintiff)	Samsung Electronics Co., Ltd.
	Infringer (Defendant)	Individual Entrepreneur Mr. Yuri Krylov
7. Mark		
Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark	
SAMSUNG		
8. Outline (summary) of the case		

In 2018 the infringer registered a domain name samsungservice.kz and placed a web-site advertising the service on Samsung electronic devices. The web-site was very alike to official Samsung web-site, and apart of the trademark also used the copyright photos of Samsung products.

The infringer did not react to numerous C&D letters.

On July 20, 2020 the Justice Department of Almaty city upon an application of the Right Holder conducted a raid action at infringer's home and confirmed the fact of the trademark use. The infringer denied the infringement. However, the court confirmed the fact of infringement and issued a decision to fine the infringer.



1. Case topic		additional case
2. Country		Kazakhstan
3. Case citation (Title, Court and Case No.)		Criminal case on illegal trademark use, City court of Turkestan city, case number 5126-21-00-1/145
4. Date of order or judgment		2021-07-26
5. Type of infringing goods (categories)		Washing powders
6. Parties		
	Right Holder (Plaintiff)	The Procter & Gamble Company
	Infringer (Defendant)	Mr. Rysbai Abdullaev
7. Mark		
Examples of Infringed (Plaintiff's) Trademark		Examples of Infringing (Defendant's) Trademark
<p>ARIEL TIDE MYTH</p>		

8. Outline (summary) of the case

In 2020 the company noticed raise of number of counterfeit washing powders in various cities of Kazakhstan. After a thorough investigation the leads came to Turkestan city.

In June 2021 the Department of Economic investigations of Turkestan city conducted a raid action at infringer's address and arrested more than 3 tons of packed powders, and more than 5 tons of preparations (no-name powders, salt), packing facilities.

Total harm from the selling of such counterfeit powders was 502 540 000 KZT (approx. US \$1 182 500).

The infringer recognized his guilt in full, reimbursed part of the Right Holder's expenses and settled the dispute amicably.



1. Case topic	A leading case on trademark infringement that sets out the test for likelihood of confusion;	
2. Country	Pakistan	
3. Case citation (Title, Court and Case No.)	Hamdard Laboratories (Waqf) Pakistan VS Muhammad Fahim (2016 CLD 2144) Karachi High Court Sindh	
4. Date of order or judgment	2016-05-03	
5. Type of infringing goods (categories)	Concentrated juice syrup for drinking	
6. Parties		
	Right Holder (Plaintiff)	Hamdard Laboratories (Waqf) Pakistan
	Infringer (Defendant)	Muhammad Fahim
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	ROOH AFZA	ROOH-E-SAMAR
8. Outline (summary) of the case		

A use of predominant feature of one trade mark in another mark would constitute infringement and passing off. In this case the predominant feature was the word "ROOH" in the Plaintiff's trade mark "SHARBAT ROOH AFZA" and the Defendant's trade mark "ROOH-E-SAMAR". The Court set out requirements for determining the likelihood of deception and confusion by applying (a) The Moron in a Hurry Test, (b) Lapp Test and (c) Classic Trinity Test. Since the defendant incorporated the predominant feature "ROOH" in its trade mark, regardless of the remaining elements of the mark, it constituted infringement, as the word "ROOH" itself had a strong goodwill attached to it.



1. Case topic	A leading case on trademark infringement online;	
2. Country	Pakistan	
3. Case citation (Title, Court and Case No.)	OLX Classifieds Pakistan VS Pak Wheels (Pvt.) Limited (294/PakWheels/ OFT/CCP/2017) Competition Commission of Pakistan	
4. Date of order or judgment	2020-01-23	
5. Type of infringing goods (categories)	Unauthorised use of advertisement material and registered trademarks	
6. Parties		
	Right Holder (Plaintiff)	M/s. OLX Classifieds Pakistan
	Infringer (Defendant)	M/s. Pak Wheels (Pvt.) Limited
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	OLX (Logo)	OLX (Logo)

8. Outline (summary) of the case

The Complainant alleged that the respondent had without authorization wilfully copied and reproduced on its website www.Pakwheels.com several advertisements, listings, photographs and descriptions bearing the Complainant's watermarked trademark which was originally posted on the Complainant's website. The Commission in exercise of its powers conducted various examination exercises to verify the Complainant's allegations including Google Analytical Examination, Log File Examination, Server Analysis, Dry Tests and Bots Examination. The Competition Commission in passing its order found the Respondent to be in violation of The Competition Act Articles 10(2)(a) - Distribution of false or misleading information capable of harming business interests of another, 10(2)(b) - Distribution of false or misleading information to consumers, 10(2)(d) - fraudulent use of another's trademark.





1. Case topic	A leading case on infringement dealing with counterfeit goods;	
2. Country	Pakistan	
3. Case citation (Title, Court and Case No.)	Telebrands Corporation VS Telebrands Pakistan (Pvt.) Limited (2006 CLD 580) Karachi High Court Sindh	
4. Date of order or judgment	2006-02-27	
5. Type of infringing goods (categories)	Personal Care, Health and Exercise Equipment	
6. Parties		
	Right Holder (Plaintiff)	Telebrands Corporation
	Infringer (Defendant)	Telebrands Pakistan (Pvt.) Limited
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	TELEBRANDS	TELEBRANDS

8. Outline (summary) of the case

The Defendant in addition to using the same trademark as that owned and registered by the Plaintiff, was involved in the production and marketing of counterfeit goods identical to those that were produced and marketed by the Plaintiff. The Court declared that a mere addition of a suffix or prefix to a registered and well-known mark is not sufficient to distinguish a trade name or mark from the well-known mark. In addition, the fact that identical goods were being produced and marketed by the Defendant using identical advertisement material including pictures and displays of the goods as those used by the Plaintiff showed a clear intention of misleading the general public into believing that the goods offered are linked to or offered by the Plaintiff.

7. Philippines(1) Case 1



1. Case topic	Opposition to Trademark Application	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	Mang Inasal Philippines, Inc. v. IFP Manufacturing Corporation Supreme Court, Third Division G.R. No. 221717	
4. Date of order or judgment	2017-06-19	
5. Type of infringing goods (categories)	30, 43- food, restaurant services	
6. Parties		
	Right Holder (Plaintiff)	Mang Inasal Philippines, Inc.
	Infringer (Defendant)	IFP Manufacturing Corporation
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	 <p>Mang Inasal, Home of Real Pinoy Style Barbeque and Device.</p>	 <p>OK Hotdog Inasal Cheese Hotdog Flavor Mark</p>

8. Outline (summary) of the case

FACTS: IFP Manufacturing Corporation, the respondent, is a local manufacturer of snacks and beverages. The respondent filed with the Intellectual Property Office (IPO) an application for the registration of the mark "OK Hotdog Inasal Cheese Hotdog Flavor Mark" under Class 30 of the Nice Classification.

This was opposed by petitioner Mang Inasal Philippines, Inc. - the owner of the mark "Mang Inasal, Home of Real Pinoy Style Barbeque and Device" (Mang Inasal mark) for services under Class 43 of the Nice Classification which had been used by petitioner for its chain of restaurants since 2003.

Petitioner, in its opposition, contended that the registration of respondent's OK Hotdog Inasal mark is prohibited under Section 123.I (d)(iii) of Republic Act No. (RA) 8293. Petitioner averred that the OK Hotdog Inasal mark and the Mang Inasal mark share similarities—both as to their appearance and as to the goods or services that they represent—which tend to suggest a false connection or association between the said marks and, in that regard, would likely cause confusion on the part of the public.

ISSUE: Whether or not the registration of respondent's OK Hotdog Inasal mark is prohibited under Section 123.I (d) (iii) of Republic Act No. (RA) 8293

RULING: The court ruled in the affirmative - The OK Hotdog Inasal mark meets the two conditions of the proscription under Sec. 123.I(d)(iii) of RA 8293 and is indeed likely to cause deception or confusion on the part of the public.

I. It is similar to the Mang Inasal mark, an earlier mark.

First, the fact that the conflicting marks have exactly the same dominant element is key. It is undisputed that the OK Hotdog Inasal mark copied and adopted as one of its dominant features the "INASAL" element of the Mang Inasal mark. Given that the "INASAL" element is, at the same time, the dominant and most distinctive feature of the Mang Inasal mark, the said element's incorporation in the OK Hotdog Inasal mark, thus, has the potential to project the deceptive and false impression that the latter mark is somehow linked or associated with the former mark.

Second, the differences between the two marks are trumped by the overall impression created by their similarity. The mere fact that there are other elements in the OK Hotdog Inasal mark that are not present in the Mang Inasal mark actually does little to change the probable public perception that both marks are linked or associated. It is worth reiterating that the OK

Hotdog Inasal mark actually brandishes a literal copy of the most recognizable feature of the Mang Inasal mark. We doubt that an average buyer catching a casual glimpse of the OK Hotdog Inasal mark would pay more attention to the peripheral details of the said mark than it would to the mark's more prominent feature, especially when the same invokes the distinctive feature of another more popular brand.

II. It pertains to goods that are related to the services represented by such earlier mark.

Related goods and services are those that, though non-identical or non-similar, are so logically connected to each other that they may reasonably be assumed to originate from one manufacturer or from economically-linked manufacturers.

First, Petitioner uses the Mang Inasal mark in connection with its restaurant services that is particularly known for its chicken inasal, i.e., grilled chicken doused in a special inasal marinade. The inasal marinade is different from the typical barbeque marinade and it is what gives the chicken inasal its unique taste and distinct orange color. Inasal refers to the manner of grilling meat products using an inasal marinade.

Second, the Mang Inasal mark has been used for petitioner's restaurant business since 2003. The restaurant started in Iloilo but has since expanded its business throughout the country. Currently, the Mang Inasal chain of restaurants has a total of 464 branches scattered throughout the nation's three major islands. It is, thus, fair to say that a sizeable portion of the population is knowledgeable of the Mang Inasal mark.

Third, Respondent, on the other hand, seeks to market under the OK Hotdog Inasal mark curl snack products which it publicizes as having a cheese hotdog inasal flavor.

Accordingly, it is the fact that the underlying goods and services of both marks deal with inasal and inasal-flavored products which ultimately fixes the relations between such goods and services.

To the court's mind, it is not unlikely that such buyer would be led into the assumption that the curls are of petitioner and that the latter has ventured into snack manufacturing or, if not, that the petitioner has supplied the flavorings for respondent's product. Either way, the reputation of petitioner would be taken advantage of and placed at the mercy of respondent.



1. Case topic	Trademark Infringement; Unfair Competition	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	MCDONALD'S CORPORATION vs. L.C. BIG MAK BURGER, INC. Supreme Court, First Division G.R. No. 143993	
4. Date of order or judgment	August 18, 2004	
5. Type of infringing goods (categories)	hamburgers, restaurant services	
6. Parties		
	Right Holder (Plaintiff)	McDonald's Corporation ("McDonald's")
	Infringer (Defendant)	L.C. Big Mak Burger, Inc. ("LC")
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	"BIG MAC"	"BIG MAK"

8. Outline (summary) of the case

FACTS: LC applied for the registration of its "Big Mak" mark for hamburger sandwiches. McDonald's opposed LC's application on the ground that "Big Mak" was a colorable imitation of its registered "Big Mac" mark for the same food products. McDonald's sued LC for trademark infringement and unfair competition. LC contends that of the two words in the "Big Mac" mark, it is only the word "Mac" that is valid because the word "Big" is generic and descriptive proscribed under the law, and thus, incapable of exclusive appropriation.

ISSUE/S:

- Whether or not LC is liable for trademark infringement.
- Whether or not LC is liable for unfair competition.

RULING:

- Yes. LC is liable for trademark infringement.

To establish trademark infringement, the following elements must be shown: (1) the validity of plaintiff's mark; (2) the plaintiff's ownership of the mark; and (3) the use of the mark or its colorable imitation by the alleged infringer results in "likelihood of confusion."

The "Big Mac" mark of McDonald's is valid. A mark is valid if it is "distinctive" and thus not barred from registration. The "Big Mac" mark, which should be treated in its entirety and not dissected word for word, is neither generic nor descriptive. This mark falls under the class of fanciful or arbitrary marks as it bears no logical relation to the actual characteristics of the product it represents (hamburgers). As such, it is highly distinctive and thus, valid. McDonald's has likewise sufficiently established exclusive ownership of the "Big Mac" mark.

With respect to the element of likelihood of confusion, the Supreme Court applied the Dominancy Test in finding that this element exists. Under the Dominancy Test, courts give greater weight to the similarity of the appearance of the product arising from the adoption of the dominant features of the registered mark, disregarding minor differences.

Applying the Dominancy Test, the Court finds that LC's use of the "Big Mak"

mark results in likelihood of confusion. First, "Big Mak" sounds exactly the same as "Big Mac." Second, the first word in "Big Mak" is exactly the same as the first word in "Big Mac." Third, the first two letters in "Mak" are the same as the first two letters in "Mac." Fourth, the last letter in "Mak" while a "k" sounds the same as "c" when the word "Mak" is pronounced. Fifth, in Filipino, the letter "k" replaces "c" in spelling.

Clearly, LC adopted in "Big Mak" not only the dominant but also almost all the features of "Big Mac." Applied to the same food product of hamburgers, the two marks will likely result in confusion in the public mind.

- Yes. LC is liable for unfair competition.

The essential elements of an action for unfair competition are (1) confusing similarity in the general appearance of the goods, and (2) intent to deceive the public and defraud a competitor.

The dissimilarities in the packaging between the competing goods are minor compared to the stark similarities in the words that give LC's "Big Mak" hamburgers the general appearance of McDonald's "Big Mac" hamburgers. The law provides that the similarity in the general appearance of the goods may be in the "devices or words" used on the wrappings. LC has applied on their plastic wrappers and bags almost the same words that McDonald's use on their styrofoam box. What attracts the attention of the buying public are the words "Big Mak" which are almost the same, aurally and visually, as the words "Big Mac." The dissimilarities in the material and other devices are insignificant compared to the glaring similarity in the words used in the wrappings.

Further, there is actually no notice to the public that the "Big Mak" hamburgers are products of "L.C. Big Mak Burger, Inc." and not those of McDonald's, who have the exclusive right to the "Big Mac" mark. This clearly shows LC's intent to deceive the public. Had they placed a notice on their plastic wrappers and bags that the hamburgers are sold by "L.C. Big Mak Burger, Inc.", then they could validly claim that they did not intend to deceive the public.

7. Philippines(1) Case 3



1. Case topic	Opposition to Trademark Application	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	Seri Somboonsakdikul v. Orlane S.A. Supreme Court, Third Division G.R. No. 188996	
4. Date of order or judgment	2017-02-01	
5. Type of infringing goods (categories)	Class 3 -cosmetics	
6. Parties		
	Right Holder (Plaintiff)	Seri Somboonsakdikul v. Orlane S.A.
	Infringer (Defendant)	Orlane S.A.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

FACTS: Seri Somboonsakdikul (Petitioner) filed an application for registration of the mark LOLANE with the IPO for goods classified under Class 3 (personal care products). Orlane S.A. (Respondent) filed an opposition to petitioner's application, on the ground that the mark LOLANE was similar to ORLANE in presentation, general appearance and pronunciation, and thus would amount to an infringement of its mark.

Respondent alleged that:

- (1) it was the rightful owner of the ORLANE mark which was first used in 1948;
- (2) the mark was earlier registered in the Philippines on July 26, 1967 under Registration No. 129961 with the following goods: x x x perfumes, toilet water, face powders, lotions, essential oils, cosmetics, lotions for the hair, dentrifices, eyebrow pencils, make-up creams, cosmetics & toilet preparations under Registration No. 12996; and
- (3) on September 5, 2003, it filed another application for use of the trademark on its additional products.

Petitioner denied that the LOLANE mark was confusingly similar to the mark ORLANE. He averred that he was the lawful owner of the mark LOLANE which he has used for various personal care products sold worldwide. He alleged that the first worldwide use of the mark was in Vietnam on July 4, 1995. Petitioner also alleged that he had continuously marketed and advertised Class 3 products bearing LOLANE mark in the Philippines and in different parts of the world and that as a result, the public had come to associate the mark with him as provider of quality personal care products.

Petitioner maintained that the marks were distinct and not confusingly similar either under the dominance test or the holistic test.

ISSUE: Whether or not there is a confusing similarity between ORLANE and LOLANE which would bar the registration of LOLANE before the IPO.

RULING: No, there is no confusing similarity between ORLANE and LOLANE which would bar the registration of LOLANE before the IPO.

There is also no colorable imitation between the marks LOLANE and ORLANE which would lead to any likelihood of confusion to the ordinary purchasers.

In determining the likelihood of confusion, the Court must consider:

- [a] the resemblance between the trademarks;
- [b] the similarity of the goods to which the trademarks are attached;
- [c] the likely effect on the purchaser; and
- [d] the registrant's express or implied consent and other fair and equitable considerations.

The Court found that LOLANE is not a colorable imitation of ORLANE due to distinct visual and aural differences using the dominance test. Likewise, the Court found that the suffix LANE is not the dominant feature of petitioner's mark. Neither can it be considered as the dominant feature of ORLANE which would make the two marks confusingly similar.

First, an examination of the appearance of the marks would show that there are noticeable differences in the way they are written or printed. As correctly argued by petitioner in his answer before the BLA, there are visual differences between LOLANE and ORLANE since the mark ORLANE is in plain block upper case letters while the mark LOLANE was rendered in stylized word with the second letter L and the letter A co-joined.

Second, as to the aural aspect of the marks, LOLANE and ORLANE do not sound alike. The first syllables of each mark, i.e., OR and LO do not sound alike, while the proper pronunciation of the last syllable LANE-""LEYN"" for LOLANE and ""LAN"" for ORLANE, being of French origin, also differ. The Court took exception to the generalizing statement of the Director General, which was affirmed by the CA, that Filipinos would invariably pronounce ORLANE as ""ORLEYN."" While there is possible aural similarity when certain sectors of the market would pronounce ORLANE as ""ORLEYN,"" it is not also impossible that some would also be aware of the proper pronunciation-especially since, as respondent claims, its trademark ORLANE has been sold in the market for more than 60 years and in the Philippines, for more than 40 years.

Hence, the Court ruled that the mark LOLANE is entitled to registration.

7. Philippines(1) Case 4



1. Case topic	Trademark Infringement	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	SKECHERS, U.S.A., INC. vs. INTER PACIFIC INDUSTRIAL TRADING CORPORATION Supreme Court, Second Division G.R. No. 164321	
4. Date of order or judgment	March 23, 2011	
5. Type of infringing goods (categories)	Class 25 - rubber shoes	
6. Parties		
	Right Holder (Plaintiff)	Skechers, U.S.A., Inc. ("Skechers")
	Infringer (Defendant)	Inter Pacific Industrial Corporation ("Inter Pacific")
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	"S" with oval design	"S"

8. Outline (summary) of the case

FACTS: Skechers filed with Regional Trial Court of Manila an application for the issuance of search warrants against an outlet and warehouse operated by Inter Pacific for trademark infringement. In the course of business, Skechers has registered the trademark "SKECHERS" and the trademark "S", within an oval design.

Two search warrants were issued by the RTC and were served on the premises of Inter Pacific. As a result of the raid, more than 6,000 pairs of "Strong" rubber shoes bearing the "S" logo were seized.

ISSUE: Whether or not Inter Pacific is guilty of trademark infringement.

RULING: Yes. Inter Pacific is guilty of trademark infringement. In finding that Inter Pacific is guilty of trademark infringement, the Supreme Court applied the Dominancy Test, which focuses on the similarity of the prevalent or dominant features of the competing trademarks that might cause confusion, mistake, and deception in the mind of the purchasing public. Duplication or imitation is not necessary; Neither is it required that the mark sought to be registered suggests an effort to imitate.

The Court noted that the use of the stylized "S" by Inter Pacific in its rubber shoes infringes on the mark already

registered by Skechers. While it is undisputed that Skechers' stylized "S" is within an oval design, to the Court's mind, the dominant feature of the trademark is the stylized "S," as it is precisely the stylized "S" which catches the eye of the purchaser. Thus, even if Inter Pacific did not use an oval design, the mere fact that it used the same stylized "S," the same being the dominant feature of Skechers' trademark, already constitutes infringement under the Dominancy Test. While there may be dissimilarities between the appearances of the shoes, to this Court's mind such dissimilarities do not outweigh the stark and blatant similarities in their general features.

Neither can the difference in price be a complete defense in trademark infringement. The registered trademark owner may use its mark on the same or similar products, in different segments of the market, and at different price levels depending on variations of the products for specific segments of the market. The purchasing public might be mistaken in thinking that Skechers had ventured into a lower market segment such that it is not inconceivable for the public to think that Inter Pacific's Strong or Strong Sport Trail shoes might be associated or connected with Skechers' brand, which scenario is plausible especially since both parties manufacture rubber shoes.

7. Philippines(1) Case 5



1. Case topic	Trademark Infringement; Unfair Competition	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	SHANGRI-LA INTERNATIONAL HOTEL MANAGEMENT, LTD. vs. DEVELOPERS GROUP OF COMPANIES, INC. Supreme Court, Second Division G.R. No. 159938	
4. Date of order or judgment	March 31, 2006	
5. Type of infringing goods (categories)	restaurant business; hotels	
6. Parties		
	Right Holder (Plaintiff)	Shangri-La International Hotel Management, Ltd. ("SLIHM"), Shangri-La Properties, Inc., Makati Shangri-La Hotel & Resort, Inc., and Kuok Philippines Properties, Inc.
	Infringer (Defendant)	Developers Group of Companies, Inc. ("DGCI")
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	"SHANGRI-LA" mark "S" logo	"SHANGRI-LA" mark "S" logo

8. Outline (summary) of the case

FACTS: At the core of the controversy are the "Shangri-La" mark and "S" logo. DGCI obtained registration over the "Shangri-La" mark and "S" logo on May 31, 1983 and has since started using the subject marks in its restaurant business and allied services.

The Kuok Group owns and operates a chain of hotels with interest in hotels since 1969 and has used the name "Shangri-La" in all Shangri-La hotels and hotel-related establishments around the world. EDSA Shangri-La Hotel and Resort, Inc., and Makati Shangri-La Hotel and Resort, Inc. were incorporated in the Philippines beginning 1987 to own and operate the 2 hotels put up by the Kuok Group in Mandaluyong and Makati. All hotels owned, operated and managed by the aforesaid SLIHM Group of Companies adopted and used the distinctive lettering of the name "Shangri-La" as part of their trade names.

The Kuok Group and/or SLIHM registered the "Shangri-La" mark and "S" logo in different countries around the world. In 1988, SLIHM filed a petition for cancellation of DGCI's registration of the "Shangri-La" mark and "S" logo on the ground that the same were illegally and fraudulently obtained and appropriated for the latter's restaurant business.

Until 1987 or 1988, SLIHM did not operate any establishment in the Philippines, but they advertised their hotels abroad since 1972 in numerous magazines widely circulated around the world, all readily available in Philippine magazines and newsstands. They also maintained reservations and booking agents in airline companies, hotel organizations, tour operators, tour promotion organizations, and in other allied fields in the Philippines.

DGCI filed a complaint for Infringement and Damages with the RTC of Quezon City against SLIHM et. al. The latter accused DGCI of appropriating and illegally using the "Shangri-La" mark and "S" logo, adding that the legal and beneficial ownership thereof pertained to SLIHM and that the Kuok Group and its related companies had been using this mark and logo since March 1962 for all their corporate names and affairs.

ISSUE: Whether or not SLIHM et. al are guilty of trademark infringement.

HELD: NO. SLIHM et. al are not guilty of trademark infringement as they were able to own establish widespread prior use of the contested mark and logo.

DGCI's registration of the contested mark and logo, without more, does not confer upon it an absolute right to the registered mark. The certificate of registration is merely a prima facie proof that the registrant is the owner of the registered mark or trade name. Evidence of prior and continuous use of the mark or trade name by another can overcome the presumptive ownership of the registrant and may very well entitle the former to be declared owner in an appropriate case.

Ownership of a mark or trade name may be acquired not necessarily by registration but by adoption and use in trade or commerce. As between actual use of a mark without registration, and registration of the mark without actual use thereof, the former prevails over the latter. Trademark is a creation of use and therefore actual use is a pre-requisite to exclusive ownership and its registration with the Philippine Patent Office is a mere administrative confirmation of the existence of such right.



Here, DGCI's own witness testified that a jeepney signboard artist allegedly commissioned to create the mark and logo submitted his designs only in December 1982. This was two-and-a-half months after the filing of the DGCI's trademark application. It was also only in December 1982 when DGCI's restaurant was opened for business. DGCI cannot now claim before the Court that the certificate of registration itself is proof that the two-month prior use requirement was complied with, when its very own witness testified otherwise in the trial court. Since at the time DGCI filed its application for trademark registration of the "Shangri-La" mark and "S" logo, it was not using these in the Philippines commercially, the registration is void.

One who has imitated the trademark of another cannot bring an action for infringement, particularly against the true owner of the mark, because he would be coming to court with unclean hands. Priority is of no avail to the bad faith plaintiff. Good faith is required in order to ensure that a second user may not merely take advantage of the goodwill established by the true owner.

With the double infirmity of lack of two-month prior use, as well as bad faith DGCI's registration of the mark, it is evident that SLIHM et. al cannot be guilty of infringement. It would be a great injustice to adjudge them guilty of infringing a mark when they are actually the originator and creator thereof.

8. Philippines(2) Case 1



1. Case topic	Leading Case on Trademark Infringement and Unfair Competition - Test in Determining Likelihood of Confusion	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	Asia Brewery, Inc. vs. Court of Appeals and San Miguel Corporation, Supreme Court, G.R. No. 103543 (Civil Case No. 56390, Regional Trial Court Branch 166, Pasig City, Metro Manila)	
4. Date of order or judgment	1993-07-05	
5. Type of infringing goods (categories)	Alcoholic Beverages (Beer)	
6. Parties		
	Right Holder (Plaintiff)	San Miguel Corporation
	Infringer (Defendant)	Asia Brewery, Inc.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	 <p>Photo of bottle from: https://idrinkbeer.weebly.com/the-philippines.html</p>	 <p>Photo of bottle from: https://idrinkbeer.weebly.com/the-philippines.html</p>

8. Outline (summary) of the case

The Plaintiff and the Defendant are two of the major players in the beer industry in the Philippines. Plaintiff filed a complaint against the Defendant for infringement of trademark and unfair competition on account of the latter's BEER PALE PILSEN or BEER NA BEER product which has been competing with the Plaintiff's SAN MIGUEL PALE PILSEN for a share of the local market.

The issue is whether the Defendant, by manufacturing and selling its BEER PALE PILSEN in amber colored steinie bottles of 320 ml capacity with a white painted rectangular label committed trademark infringement and unfair competition.

The Supreme Court held that the Defendant neither infringed the Plaintiff's trademark nor committed unfair competition with the latter's SAN MIGUEL PALE PILSEN product. While its BEER PALE PILSEN admittedly competes with the latter in the open market, the competition is neither unfair nor fraudulent. Infringement is determined by the "test of dominance" rather than by differences or variations in the details of one trademark and of another. Similarity in size, form and color, while relevant, is not conclusive. If the competing trademark contains the main or essential or dominant features of another, and confusion and deception is likely to result, infringement takes place. Duplication or imitation is not

necessary; nor it is necessary that the infringing label should suggest an effort to imitate.

In this case, the Supreme Court found that the dominant features of the Plaintiff's trademark is the name of the product "SAN MIGUEL PALE PILSEN," written in white Gothic letters with elaborate serifs at the beginning and end of the letters "S" and "M" on an amber background across the upper portion of the rectangular design; while the dominant feature of the Defendant's trademark is the name "BEER PALE PILSEN," with the word "Beer" written in large amber letters, larger than any of the letters found in the Plaintiff's label. Further, the word "BEER" does not appear in Plaintiff's trademark, just as the words "SAN MIGUEL" do not appear in Defendant's trademark. Hence, there is absolutely no similarity in the dominant features of both trademarks. Neither in sound, spelling or appearance can BEER PALE PILSEN be said to be confusingly similar to SAN MIGUEL PALE PILSEN. No one who purchases BEER PALE PILSEN can possibly be deceived that it is SAN MIGUEL PALE PILSEN.

The Supreme Court thus held that there is no confusing similarity between the competing beers for the name of one is "SAN MIGUEL" while the competitor is plain "BEER" and the points of dissimilarity between the two outnumber their points of similarity.

8. Philippines(2) Case 2



1. Case topic	Trademark Infringement Involving Counterfeit Goods	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	Gemma Ong a.k.a. Maria Teresa Gemma Catacutan vs. People of the Philippines, Supreme Court, G.R. No. 169440 (Criminal Case No. 00-184454, Regional Trial Court Branch 24, City of Manila)	
4. Date of order or judgment	2011-11-23	
5. Type of infringing goods (categories)	Cigarettes	
6. Parties		
	Right Holder (Plaintiff)	Philip Morris Philippines, Inc.
	Infringer (Defendant)	Gemma Ong
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	[images on the marks/goods involved were not included in the Decision]	[images on the marks/goods involved were not included in the Decision]

8. Outline (summary) of the case

Defendant was charged with trademark infringement as regards the distribution, sale and offering for sale of counterfeit Marlboro cigarettes which had caused confusion deceiving the public that such cigarettes were Marlboro cigarettes under the MARLBORO trademark together with the devices, including the famous Roof Device, without seeking permit or authority to manufacture and distribute the same.

The Supreme Court found Defendant guilty of violating Section 155 in relation to Section 170 of Republic Act No. 8293, i.e, trademark infringement.

A ""mark"" is any visible sign capable of distinguishing the goods (trademark) or services (service mark) of an enterprise and shall include a stamped or marked container of goods. To establish trademark infringement, the following elements must be shown: (1) the validity of plaintiff's mark; (2) the plaintiff's ownership of the mark; and (3) the use of the mark or its colorable imitation by the alleged infringer results in ""likelihood of confusion."" Of these, it is the element of likelihood of confusion that is the gravamen of trademark infringement.

A mark is valid if it is distinctive and not barred from registration. Once registered, not only the mark's validity, but also the registrant's ownership of the mark is prima facie presumed.

The prosecution was able to establish that the trademark ""Marlboro"" was not only valid for being neither generic nor descriptive, it was also exclusively owned by the Plaintiff, as evidenced by the certificates of registration issued by the Intellectual Property Office of the Department of Trade and Industry.

8. Philippines(2) Case 3



1. Case topic	Recent Case on Trademark Infringement - Prior User in Good Faith	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	Zuneca Pharmaceutical, Akram Arain and/or Venus Arain, M.D., and style of Zuneca Pharmaceutical vs. Natrapharm, Inc., Supreme Court, G.R. No. 211850 (Civil Case No. Q-07-61561, Regional Trial Court Branch 93, Quezon City, Metro Manila)	
4. Date of order or judgment	2020-09-08	
5. Type of infringing goods (categories)	Medicines and Drugs	
6. Parties		
	Right Holder (Plaintiff)	Natrapharm, Inc.
	Infringer (Defendant)	Zuneca Pharmaceutical, et al.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	ZYNAPSE	ZYNAPS

8. Outline (summary) of the case

"Plaintiff is engaged in the manufacturing, marketing and distribution of pharmaceutical products for human relief. One of its products is citaloline under the trademark ""ZYNAPSE"" which is registered with the Intellectual Property Office of the Philippines. Defendant has been engaged in the importation, marketing and sale of various kinds of medicines and drugs in the Philippines. It imports generic drugs from Pakistan using different brand names, including a drug called carbamazepine under the brand name ""ZYNAPS,"" which is an anti-convulsant used to control all types of seizure disorders of varied causes like epilepsy. Plaintiff filed a complaint against Defendant for trademark infringement, alleging that ZYNAPS is confusingly similar to its registered trademark ZYNAPSE and the resulting likelihood of confusion is dangerous because the marks cover medical drugs intended for different types of illnesses.

The Supreme Court held that, under the law, the owner of the mark shall have the exclusive right to prevent all third parties not having the owner's consent from using identical or similar marks for identical or similar goods or services where such use would result in a likelihood of confusion. To establish trademark infringement, the following elements must be proven: (1) the trademark being infringed is registered in the IPO; (2) the trademark is reproduced, counterfeited, copied, or colorably imitated by the infringer; (3) the infringing mark is used in connection with the sale, offering for sale, or advertising of any goods, business, or services; or the infringing mark is applied to labels, signs, prints, packages, wrappers, receptacles, or advertisements intended to be used upon or in connection with such goods, business, or services; (4) the use or application of the infringing mark is likely to cause confusion or mistake or to deceive purchasers or others as to the goods or services themselves or as to the source or origin of such goods or services or the identity of such business; and (5) it is without the consent of the trademark owner or the assignee thereof.

The Supreme Court found that: (a) Plaintiff is the registrant of the ""ZYNAPSE"" mark which was registered with the IPO on September 24, 2007; (b) Defendant has been using the ""ZYNAPS"" brand as early as 2004; and (c) ""ZYNAPSE"" and ""ZYNAPS"" are confusingly similar and both are used for medicines. In light of these settled facts, it is clear that Plaintiff is the first-to-file registrant of ""ZYNAPSE"". Defendant, on the other hand, is a prior user in good faith of a confusingly similar mark, ""ZYNAPS"".

The IP Code contemplates that a prior user in good faith may continue to use its

mark even after the registration of the mark by the first-to-file registrant in good faith, subject to the condition that any transfer or assignment of the mark by the prior user in good faith should be made together with the enterprise or business or with that part of his enterprise or business in which the mark is used. The mark cannot be transferred independently of the enterprise and business using it.


It can be gleaned that while the law recognizes the right of the prior user in good faith to the continuous use of its mark for its enterprise or business, it also respects the rights of the registered owner of the mark by preventing any future use by the transferee or assignee that is not in conformity with Section 159.1 of the IP Code. Notably, only the manner of use by the prior user in good faith - that is, the use of its mark tied to its current enterprise or business - is categorically mentioned as an exception to an action for infringement by the trademark owner. The proviso in Section 159.1 of the IP Code ensures that, despite the transfer or assignment of its mark, the future use by the assignee or transferee will not go beyond the specific confines of such exception. Without the proviso, the prior user in good faith would have the free hand to transfer or assign the ""protected use"" of its mark for any purpose to a third person who may subsequently use the same in a manner unduly curtailing the rights of the trademark owner. Indeed, this unilateral expansion of the exception by a third person could not have been intended, and is guarded against, by the legislature through the foregoing proviso.

In any event, the application of Section 159.1 of the IP Code necessarily results in at least two entities - the unregistered prior user in good faith or their assignee or transferee, on one hand; and the first-to-file registrant in good faith on the other - concurrently using identical or confusingly similar marks in the market, even if there is likelihood of confusion.

The two marks were thus allowed to co-exist and held that there is no trademark infringement in this case. The Supreme Court declared that the Defendants are prior users in good faith of the ZYNAPS mark and accordingly protected under the IP Code, while also affirming that the Plaintiff is the lawful registrant of ZYNAPSE. Both owners were ordered to indicate on their respective packaging, in plain language understandable by people with no medical background or training, the medical conditions that their respective drugs are supposed to treat or alleviate and a warning indicating what ZYNAPS is not supposed to treat and what ZYNAPSE is not supposed to treat.

8. Philippines(2) Case 4



1. Case topic	Recent Case on Unfair Competition - Continuing Crime	
2. Country	Philippines	
3. Case citation (Title, Court and Case No.)	Petron Corporation and People of the Philippines vs. William Yao, Sr., Luisa C. Yao, William Yao, Jr., Richard C. Yao and Roger C. Yao, Supreme Court, G.R. No. 243328	
4. Date of order or judgment	2021-03-18	
5. Type of infringing goods (categories)	Liquefied Petroleum Gas Containers	
6. Parties		
	Right Holder (Plaintiff)	Petron Corporation
	Infringer (Defendant)	William Yao, Sr., Luisa C. Yao, William Yao, Jr., Richard C. Yao and Roger C. Yao
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

"Plaintiff is one of the bulk suppliers of Liquefied Petroleum Gas (LPG) in the Philippines. It uses the trademark ""GASUL"" for its LPG products and the only entity in the Philippines authorized to refill, use, sell and distribute Petro Gasul LPG containers and/or products.

It has come to the attention of the Plaintiff that Masagana Gas Corp, which is owned and operated by the Defendants, is engaged in the unauthorized refilling, sale and distribution of Petron-owned Gasul LPG cylinders. With the help of the National Bureau of Investigation, discreet surveillance operation and test-buys were conducted. The investigating officers personally witnessed that Masagana employees in the act of refilling Petron Gasul LPG cylinders and selling it to them at the Masagana refilling plant in Cavite. The investigating agents also followed a ten-wheeler truck of Masagana carrying Petron Gasul LPG cylinders from its refilling plant in Cavite to its warehouse in Makati City. They saw at least 120 Petron Gasul LPG cylinders in the Makati premises.

Based on the foregoing information, Plaintiff filed two complaints for unfair competition against the Defendants before the trial court in Cavite where the Masagana refilling plant is located, and in Makati City where the Masagana warehouse is located. The case is Makati City was dismissed as the trial court held that the case at bar is a continuing crime of unfair competition and thus, since the case had been earlier filed in Cavite, then the court in Cavite has already

acquired jurisdiction over the case.

The Supreme Court held that, as can be seen from the complaint, the Petron owned gasul tanks were allegedly refilled by respondents at their Trece Martires City refilling plant and were sold therein. Thus, the crime of unfair competition was already consummated in Trece Martires City. However, respondents continued to pass off the Petron gasul tanks as their own by subsequently selling the same in Makati City, hence, there is a continuing violation of the law. Therefore, the sales made in Cavite and Makati City cannot be considered as separate offenses of unfair competition as they merely constitute the ingredients of the crime.

In transitory or continuing offenses in which some acts material and essential to the crime and requisite to its consummation occur in one province and some in another, the court of either province has jurisdiction to try the case. Here, both the RTC of Cavite and Makati City have jurisdiction to try the case for unfair competition filed against respondents. However, it has been held that in cases of concurrent jurisdiction, the court first acquiring jurisdiction excludes the other courts. Since it is the RTC of Trece Martires City, Cavite which had earlier acquired jurisdiction over the case of unfair competition filed against respondents, the RTC of Makati City correctly quashed the Information filed with it for lack of jurisdiction.



1. Case topic	The prevailing Taiwan Trademark Act does not recognize the concept of reverse confusion. Determining whether there is likelihood of confusion between the two trademarks shall be based on the 8 factors of confusion and misidentification.	
2. Country/Region	Taiwan, China	
3. Case citation (Title, Court and Case No.)	Civil Judgement, 104-Min Shang Shang-No.1, Intellectual Property Court	
4. Date of order or judgment	2015-08-27	
5. Type of infringing goods (categories)	watch products in Class 14	
6. Parties		
	Right Holder (Plaintiff)	FORMOSA WATCH CO., LTD. (a Taiwan company)
	Infringer (Defendant)	PORTER INTERNATIONAL CO., LTD. (a Taiwan company)
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	<p>(Reg. No. 00011405)</p>	<p>(Reg. No. 01375331) (unregistered)</p>

8. Outline (summary) of the case

Background:

FORMOSA WATCH CO., LTD. ("Plaintiff") initiated a civil litigation action against PORTER INTERNATIONAL CO., LTD. ("Defendant") for trademark infringement based on the grounds that the trademarks used by the Defendant are similar to its registered trademark and are used on goods or services identical with or similar to those for which the registered one is designated, and hence there exists a likelihood of confusion on relevant consumers.

The Plaintiff also argued that different theories, such as reverse confusion, have been developed to determine whether there is likelihood of confusion between the two trademarks concerned.

Intellectual Property Court's decision:

The Intellectual Property Court ruled in favor of the Defendant for the following reasons:

1. "Likelihood of confusion" means that the two trademarks are identical or considered similar, causing the consumers of the same or similar goods or services to be confused and misidentify the two trademarks as the same trademark, or are series trademarks from the same source, or are from different sources but related nature.




Determining whether there is likelihood of confusion between the two trademarks concerned shall consider the following eight factors: (1) strength of distinctiveness of the trademarks; (2) whether the trademarks are similar and the extent of similarity between them; (3) whether the goods/services are similar and the extent of similarity between them; (4) status of the diversified

operation of the prior right owner; (5) whether any confusion has actually occurred; (6) the extent to which relevant consumers are familiar with the trademarks concerned; (7) whether the applicant of the disputed trademark has filed such application in good faith; and (8) other factors that may cause confusion or misidentification.

2. "Reverse confusion" means that the prior right owner is in a weak position in the market while the later right owner is famous or in a strong position, which resulting in a likelihood that the consumers will mistakenly believe the later right owner's goods are from the prior right owner. Notwithstanding the U.S. Tenth Circuit in *Big O Tire Dealers, Inc. v. Goodyear Tire & Rubber Co.* case recognizes the concept of reverse confusion, the prevailing Taiwan Trademark Act does not stipulate and recognize such concept. Under the current practice, determining whether there is likelihood of confusion between the two trademarks concerned shall be based on the aforesaid eight factors.

3. Although both parties' trademarks are quite distinctive and are used on the same products, the two trademarks are distinguishable in overall impression. Besides, the relevant consumers are quite familiar with the both parties' trademarks and are able to distinguish that they are from different origins. After comprehensive consideration of these factors, it should be recognized that the Defendant's trademarks will not cause relevant consumers to confuse the source of the goods and services and therefore, the Defendant's act does not constitute trademark infringement.



1. Case topic	In trademark infringement cases, the determination on the requirements of likelihood of confusion shall be based on the actual used trademark in the market rather than the registered one.	
2. Country/Region	Taiwan, China	
3. Case citation (Title, Court and Case No.)	Civil Judgement, 106-Min Shang Shang-No.9, Intellectual Property Court	
4. Date of order or judgment	2018-03-08	
5. Type of infringing goods (categories)	Sports shoes in Class 25	
6. Parties		
	Right Holder (Plaintiff)	New Balance Athletics, Inc.
	Infringer (Defendant)	Chung Yang Shoes Co., Ltd.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		 Examples of Defendant's Registered Trademark(Reg. No.1370394)
		

8. Outline (summary) of the case

Background:




New Balance Athletics, Inc. ("Plaintiff") initiated a civil litigation action against Chung Yang Shoes Co., Ltd. ("Defendant") for trademark infringement because a batch of 96 pairs of sports shoes imported by the Defendant was inspected by the Custom administration, and the trademark used on the shoes highlighted a capital letter "N" in large font size with white background, which was confusingly similar to the Plaintiff's well-known "N design" trademark. However, the Defendant rebutted that it was legally using its registered trademark under Reg. No. 1370394.

Intellectual Property Court's decision:

The Intellectual Property Court ruled in favor of the Plaintiff for the following reasons:

1. In trademark infringement cases, the determination on the requirements of likelihood of confusion shall be based on the actual used trademark in the market rather than the registered one.
2. The trademark used on the Defendant's sports shoes is different from the one registered under Reg. No. 1370394. Compared with the registered version, the trademark in actual use not only adds a white border and double lines on letter "N" but also changes the pattern design, color contrast, thickness and length of lines, on both its left and right sides. The word "NITAU" in the middle comes to be vague, and the overall impression emphasizes the "letter N with a white border". The trademark used on the Defendant's sports shoes is highly similar to the Plaintiff's well-known "N design" trademark, which may cause likelihood of confusion to the relevant consumers. Therefore, the Defendant's act indeed constitutes trademark infringement.



1. Case topic	How to calculate the damages suffered from trademark infringement (the interpretation of statutory angyld)	
2. Country/Region	Taiwan, China	
3. Case citation (Title, Court and Case No.)	Civil Judgement, 106-Min Shang Shang-No.9, Intellectual Property Court	
4. Date of order or judgment	2018-03-08	
5. Type of infringing goods (categories)	Sports shoes in Class 25	
6. Parties		
	Right Holder (Plaintiff)	New Balance Athletics, Inc.
	Infringer (Defendant)	Chung Yang Shoes Co., Ltd.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	 <p>(Reg. No. 01336554)</p>  <p>MOROCCANOIL (Reg. No. 01336554) (genuine product)</p>	 <p>(infringing product)</p>

8. Outline (summary) of the case

Background:

MOROCCANOIL ISRAEL LTD. ("Plaintiff") initiated a civil litigation action against JUI-TAI PRECISION IND. CO., TAIKAI INTERNATIONAL CORP., and WATSON'S PERSONAL CARE STORES (TAIWAN) COMPANY LIMITED ("Defendants") for trademark infringement based on the grounds that the design, color, font and configuration thereof of the products manufactured, distributed, and sold by the Defendants are highly similar to its registered trademarks, showing that the Defendants has the intent to take the advantage of its reputation and may cause likelihood of confusion to the consumers.

This case appealed to the Supreme Court. The Defendants argued that they did not infringe upon the Plaintiff's trademark right and even if they did, the damages they have to compensate shall be calculated at the lower retail price of the infringing product.

Supreme Court's decision:

The Supreme Court ruled in favor of the Plaintiff for the following reasons:

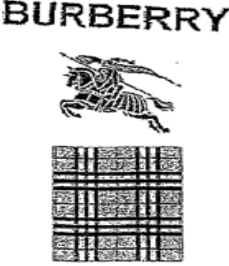

1. In overall impression, the trademarks used on the infringing product are highly similar to the Plaintiff's trademarks in appearance, color, concept and pronunciation. The extent of similarity is even sufficient to recognize that the Defendants have the imitation intention. The infringing hair oil product is the same kind of product as the hair care product designated for the Plaintiff's trademarks. The Plaintiff's trademarks have acquired relatively high reputation among the relevant consumers through its marketing and advertising of its trademarked goods. After comprehensively reviewing the above, it is highly likely that the relevant consumers may be consider that the infringing product and the Plaintiff's trademarks are from the same source, or are from different but related sources and thus, there is a likelihood of confusion.

2. Those intentionally or negligently infringing upon another's trademark right shall have the liability to compensate the damages arising therefrom. Considering that the trademarks used on the infringing product are highly similar to the Plaintiff's trademarks, it is difficult to recognize that the Defendants have no intention to infringe upon the Plaintiff's trademarks.

3. The Plaintiff has chosen to calculate the damages in accordance with Article 71 I (3) of the Taiwan Trademark Act. Regarding the "retail unit price multiple or total amount (statutory angyld)" stipulated in Article 71 I (3), it is to reduce the burden of proof of the trademark owner and to estimate the actual manufacturing and sales of the counterfeit goods. The "retail unit price" of counterfeit goods shall refer to the normal price at retail under normal circumstances, excluding occasional abnormal prices. If the infringer only occasionally sold the counterfeit goods at a promotional lower price, the original price should be used as its retail unit price.

(Remark: since it may be difficult for the registrant to prove the amount of actual damages suffered from the infringement, according to Article 71 I of the Taiwan Trademark Act, damages requested by the registrant may be calculated as follows: (1) based on the amount of the balance derived by subtracting the profit earned through using the trademark after infringement from the profit normally expected through using the same trademark; (2) the profit earned by the infringer as a result of trademark infringement; if no proof on costs or necessary expenses can be furnished by the infringer, the total amount of revenue from selling the infringing goods shall be presumed to be the amount of profit; (3) the amount no more than 1,500 times of the unit retail price of the infringing goods; if over 1,500 pieces of infringing goods were found, the amount of damages shall be a lump sum of the market value of the infringing goods; or (4) the equivalent amount of royalty that may be collected from using the trademark under licensing.)



1. Case topic	Liability for Trademark Infringement of TV shopping channels and online shopping platforms	
2. Country/Region	Taiwan, China	
3. Case citation (Title, Court and Case No.)	Civil Judgement, 107-Min Shang Shang Geng Yi-No.2, Intellectual Property Court	
4. Date of order or judgment	2019-06-03	
5. Type of infringing goods (categories)	watches in Class 14	
6. Parties		
	Right Holder (Plaintiff)	Burberry Limited
	Infringer (Defendant)	Eastern Home Shopping & Leisure Co., Ltd.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

Background:

Burberry Limited ("Plaintiff") initiated a civil litigation action against Eastern Home Shopping & Leisure Co., Ltd. ("Defendant") for trademark infringement based on the grounds that the Defendant didn't exercise the due care of a good administrator in intergrating suppliers and selling products because the Defendant sold on its TV shopping channel and online store the counterfeit watches supplied by a Taiwanese individual, Li-Wei Chen, which used the Plaintiff's well-known trademarks, with the advertisements of "authorized goods" and "British Boutique".

The Defendant argued that it only operated the shopping channel and online platform, but it wasn't the real seller. It already exercised the due care of a good administrator by requesting Li-Wei Chen to sign an affidavit and provide the import declaration. It should not be liable for further checking whether the watches were indeed authorized products.

Intellectual Property Court's decision:

The Intellectual Property Court ruled in favor of the Plaintiff for the following reasons:

1. Usually there are three types of e-commerce: (1) Consumer to Consumer (C2C), which enables customers to trade with each other frequently in an online environment, (2) Business to Customer (B2C), where products move directly

from a business to the end user who has purchased the goods or service, (3) Business to Business (B2B), the form of transaction between businesses, such as one involving a manufacturer and wholesaler, or a wholesaler and a retailer. Given the Defendant plays a dominant role in selecting the products, making the advertisements and monitoring the sales, obviously the trading mode it adopts is B2C. Hence, the Defendant should be deemed as a seller rather than an intermediate platform.

2. In the TV show, not only Li-Wei Chen but also a program host hired by the Defendant together introduce the counterfeit watches using the Plaintiffs trademarks, and the program host emphasizes that the watches are authorized products and would be under warranty. Besides, the Defendant is also responsible for receiving orders from consumers, delivering products and issuing invoices. These facts also prove that the Defendant should be deemed as the seller instead of an intermediate platform.

3. As the Defendant is the seller of these watches, it should be liable for checking whether they are authorized products before selling them on its TV shopping channel and online store rather than simply rely on Li-Wei Chen's affidavit and import declaration. The Defendant's act undoubtedly constitutes trademark infringement.



1. Case topic		Trademark infringement and the likelihood of confusion	
2. Country		The Netherlands	
3. Case citation (Title, Court and Case No.)		Adidas v H&M, Court of Justice, ECLI:NL:GHDHA:2020:72	
4. Date of order or judgment		2020-01-28	
5. Type of infringing goods (categories)		25	
6. Parties			
	Right Holder (Plaintiff)	Adidas AG	
	Infringer (Defendant)	H&M Hennis & Mauritz Netherlands B.V.	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case

In this case, Adidas invoked its three-stripe figurative mark against H&M after H&M sold fitness clothing with two, according to Adidas, infringing similar stripes.

The District Court ruled that H&M infringed Adidas' trade mark rights, due to the likelihood of confusion. Later, the Court of Justice overturned the judgment of the District Court and dismissed the claims of Adidas. Subsequently, Adidas went in appeal to the Supreme Court, who upheld the decision of the Court of Justice and briefly dismissed the appeal.

Firstly the Court of Justice sets out the criteria relevant for determining the likelihood of confusion. For invoking infringement of a trademark based on the likelihood of confusion, it requires a similarity which is likely to cause (direct or indirect) confusion among the relevant public for the goods or services in question. The assessment should be made globally in the light of the impression that the trademark makes on the average consumer of the goods or services in question who is reasonable well informed and reasonably observant in the case of (sports) clothing. This while taking into account all the relevant circumstances of the case, in particular the similarity of the trademark and the similarity of the goods or services concerned. Relevant is the overall impression given by the mark and sign, taking into account their distinctive and dominant components (p. 20).

The Court of Justice was of the opinion that the space between the two stripes on the work out clothes of H&M is not equal to the width of the stripes (P. 26). According to the Court, the overall image of the marks is determined in particular by the specific combination of the three vertical stripes, with spacing equal to the width of the stripes. The stripes, together with the spacing creates a pattern. This in contrast to the stripes used by H&M, which miss the repetition of the stripes and do therefore not form a pattern. Because of the fact that a stripe by itself and a random combination of two stripes is so simple and banal, missing distinctive character, the spacing and specific combination of the stripes determine its overall appearance. Therefore the Court judges that the two stripes used by H&M differ significantly from the three stripes of Adidas, which do thus not cause trademark infringement (p. 30).

Additionally, market surveys can merely be an aid in establishing a likelihood of confusion. The likelihood of confusion can, according to the Court, not be established with sufficient certainty as the questions to the respondents are often either too vague or too directive to provide reliable answers (p. 35).

In conclusion, the Court of Justice annuls the judgment of the District Court and dismisses the claims of Adidas.



1. Case topic		Infringement dealing with counterfeit goods (watches)	
2. Country		The Netherlands	
3. Case citation (Title, Court and Case No.)		Fossil v ITG, The Hague District Court, ECLI:NL:RBDHA:2020:2852	
4. Date of order or judgment		15 March 2020	
5. Type of infringing goods (categories)		14	
6. Parties			
	Right Holder (Plaintiff)	Fossil USA	
	Infringer (Defendant)	International Time Group B.V.	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

Fossil USA sells, produces and distributes watches for various brands licensed to it, such as the Michael Kors brand. Michael Kors International GmbH has given Fossil USA the right to act against trademark infringement.

IGT is a wholesaler engaged in the trade of watches amongst others. In 2017 Fossil became aware of IGT trying to import counterfeit goods of Michael Kors watches. Fossil invoked the Michael Kors trademark and summoned IGT to cease and desist all infringement of the MK-brand by importing counterfeit products.

The Hague District Court sets out the requirements for identifying counterfeit products: this has to be established based on article 2.20 (2) under a of the Benelux Treaty of Intellectual Property (BTIP). The trademark owner is entitled to prevent the non-consensual use of the trademark for goods and services, if the used sign is identical to the trade mark and is used for the same goods or services as those for which the trade mark is registered (p. 4.2.).

The Court establishes that IGT simply has not substantiated the differences between the Michael Kors watches and the allegedly infringing products (p. 4.3.). Furthermore, IGT has stated that it does not always check whether their suppliers are authorized to sell products of Fossil (p. 4.11.). Therefore the court concludes that IGT must have had every reason to doubt the authenticity of the imported goods. Based on this the court rules that IGT has infringed the trademark rights of Fossil (p. 4.12.).



1. Case topic	Exhaustion and the burden of proof	
2. Country	The Netherlands	
3. Case citation (Title, Court and Case No.)	Converse v Sporttrading, Court of Justice Den Bosch, ECLI:NL:GHSHE:2020:2699.	
4. Date of order or judgment	2020-09-01	
5. Type of infringing goods (categories)	25	
6. Parties		
	Right Holder (Plaintiff)	Converse
	Infringer (Defendant)	Sporttrading
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	<p>CONVERSE CONVERSE CHUCK TAYLOR ALL STAR ALL STAR</p>	

8. Outline (summary) of the case

Converse designs and manufactures leisure shoes and is the holder of the Benelux word marks CONVERSE, CONVERSE CHUCK TAYLOR ALL STAR, and ALL STAR. Sporttrading is a wholesaler that sells sports shoes, among other things. Converse made test purchases of Converse shoes at various retail chains, which, according to the party involved, showed counterfeit Converse products.

Thereafter, Converse started summary proceedings in which it was claimed, among other things, that the trademark infringement should cease and that the trustee should be held liable for the damage suffered as a result. The court in preliminary relief proceedings denied these claims. According to the District Court, the burden of proof of exhaustion rested on Converse, and Converse had not sufficiently proven the existence of counterfeit goods. In this procedure Converse claimed that there had been large-scale fraud in the importation and trading of Converse shoes, and disputed that the trademark-infringing shoes came from a legal flow of goods. As a result, the court saw reason to place the burden of proof on Converse to prove that the traded shoes came from an organization engaged in large-scale fraud. Converse appealed this decision amongst others on the ground that there was no actual reason for the reversal of the burden of proof.

On appeal, the Court of Justice ruled that the burden of proof - with regard to exhaustion of the trademark right - lies with the trustee and therefore not with Converse. Reference is made to the European judgment Van Doren/Lifestyle (p. 3.79). It follows from this judgment that reversal of the burden of proof is only possible when the protection of the free movement of goods requires it. Therefore, the trustee must prove that there is a real danger of foreclosure of the market. According to the Court, the trustee in this case had failed to prove both a real danger of foreclosure of the market and the existence of exhaustion. Finally, the Court emphasized that a successful reliance on exhaustion requires that permission had been given for each copy of the goods provided for by the trademark.



1. Case topic		Trademark infringement via domain name	
2. Country		The Netherlands	
3. Case citation (Title, Court and Case No.)		ITT v Karl Dungs, Court of Justice, ECLI:NL:GHDHA:2020:1657.	
4. Date of order or judgment		2020-04-21	
5. Type of infringing goods (categories)		9, 42	
6. Parties			
	Right Holder (Plaintiff)	ITT Controls	
	Infringer (Defendant)	Karl Dungs	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		"Dungs"	"Dungs"

8. Outline (summary) of the case

The defendant Karl Dungs is a manufacturer of burner systems and burner management systems based in Germany and also the holder of the Union word mark 'DUNGS'. Since the beginning of 2012, the plaintiff had been using the domain name 'www.dungs.nl', which provided access to the website where, amongst others, products of the DUNGS brand were offered. The WIPO arbitrator ruled that the defendant must transfer the domain name to Karl Dungs in view of the confusing way in which the domain name corresponds to the DUNGS trademark. The claimant then sought the annulment of the WIPO Dispute Resolution Judge's decision before the Dutch courts, which the District Court and Court of Appeal rejected without addressing the substance of the claimant's trademark appeal. The Supreme Court (ECLI:NL:HR:2018:2221) finally ruled that the Court of Appeal of The Hague should have involved the trademark right in the claims and referred the case back to the Court of Appeal of The Hague.

The Court holds that it is relevant whether the use of the DUNGS trademark can lead to the impression that there exists a commercial connection between ITT Controls and Karl Dungs, and in particular that the company ITT Controls belongs to the distribution network of Karl Dungs or that there is a special relationship between the two companies (p. 57).

ITT Controls is not an official reseller of Karl Dungs. The fact that there is a text on the website under the hidden header ""disclaimer"" which clarifies the nature of the relationship with Dungs, and the fact that ITT Controls also offers other brands, does not detract from the impression created that there is a special relationship of cooperation between ITT Controls and Karl Dungs. The Court hereby mainly refers to the following text on ITT Controls' website:

""Dungs is the brand that sells and supports the full product range. ITT Controls is the partner who can give you advice on all products and does the maintenance and management of all these products.""

The court therefore ruled that Karl Dungs' trademark right had been infringed. Consequently, Karl Dungs did not act unlawfully by transferring the domain name dungs.nl to himself.



1. Case topic		Figurative trademark infringement on website	
2. Country		The Netherlands	
3. Case citation (Title, Court and Case No.)		Cleonice (SWK) v Digikeur, Rechtbank Amsterdam, ECLI:NL:RBAMS:2013:CA3795.	
4. Date of order or judgment		2014-05-08	
5. Type of infringing goods (categories)		35, 42, 45	
6. Parties			
	Right Holder (Plaintiff)	Cleonice (Stichting Webshop Keurmerk)	
	Infringer (Defendant)	Digikeur	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			<p>"Webshop Keurmerk" or "Webwinkel Keurmerk"</p>

8. Outline (summary) of the case

The plaintiff Stichting Webshop Keurmerk (hereafter: SWK) is a trade organization and publisher of a certification mark called "Webshop Keurmerk". Entrepreneurs who offer their products via the internet (thus webshops) may use the certification mark if they meet the requirements set by SWK. The organization has only registered a figurative mark, the words "Webshop Keurmerk" have not been registered. Defendant Digikeur is a later established trade organization and publisher of a certification mark for webshops affiliated to Digikeur. In the past, Digikeur has used the mark "Webshop Keurmerk" in e-mails sent to webshops and on their own website, in summary proceedings the judge ordered the removal of those texts. Subsequently, Digikeur changed the infringing words of "Webshop Keurmerk" to "Webwinkel Keurmerk" (wherein winkel is a Dutch translation for shop). SWK argues that there is still infringement and invokes their trademark protection based on their registered figurative mark.

There is no direct infringement of SWK's trademark right, as the word element Webshop Keurmerk has not been registered by the plaintiff. Firstly, the court assessed whether there was a form of likelihood of confusion. As stated before, decisive is the overall impression the image leaves on the average consumer. Dominant and distinctive elements of the trademarks and the sign must also be taken into account (p. 4.5). In this case, the similarity between the signs and trademarks is limited to the words Webshop Keurmerk. However, the visual representation does not correspond. Moreover, the visual elements of the trademark are missing, as a result of which the overall impression differs and there is thus no likelihood of confusion.

Alternatively, SWK argued that the Digikeur's use of the trademark is detrimental to the reputation of SWK's trademark. Again, the overall impression is decisive. However, as stated above, there is a lack of similar overall impression. Therefore, Article 2.20(2)(d) cannot be invoked.



1. Case topic	Trademark Infringement - Online Infringement	
2. Country	Greece	
3. Case citation (Title, Court and Case No.)	2849/2020 Athens MultiMember First Instance Court (Published in NOMOS online legal directory)	
4. Date of order or judgment		
5. Type of infringing goods (categories)	Entertainment , TV streaming	
6. Parties		
	Right Holder (Plaintiff)	Fashion Television LLC
	Infringer (Defendant)	Undisclosed
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Fashion Television Logo	Fashion Television
8. Outline (summary) of the case		

The owner and licensee of the above mentioned logo /international trademark valid in Greece, filed a lawsuit against cable TV / online channels for using similar sign in relation with TV streaming services in Greece. The Athens Multimember Court of First Instance, first, found that the mere broadcasting of the plaintiff's channels in Greece, whether in TV or online, is not sufficient to establish reputation or increased distinctiveness. Then, taking into account that the sign of the defendants, consisting of the words "Fashion Television", would be perceived as descriptive by the Greek audience, the Court concluded that there is no risk of confusion and dismissed the lawsuit.



1. Case topic	Trademark Infringement - Counterfeit Products	
2. Country	Greece	
3. Case citation (Title, Court and Case No.)	Supreme Court Decision no 15/2021, January 11, 2021 (Published in NOMOS online legal directory)	
4. Date of order or judgment		
5. Type of infringing goods (categories)	Cosmetics	
6. Parties		
	Right Holder (Plaintiff)	Malibu LTD
	Infringer (Defendant)	Undisclosed
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	MALIBU and design	Undisclosed
8. Outline (summary) of the case		

Following the termination of the distribution agreement with the principal and owner of the EU and national trademarks, the local distributor in Greece, continued trading identical products (sunscreens etc) bearing signs and designs similar to the trademarks of the principal. Despite several unsuccessful attempts to register those signs in EU and national level, the distributor persisted in trading the abovementioned products in Greece. The Supreme Court, after confirming the criteria and conditions for risk of confusion and trademark infringement, upheld the decision of the Court of Appeals, which had found that the distributor had infringed the principal's trademark rights, but most importantly, clarified the method for calculating actual damages of the trademark owner, corresponding to the profits made by the distributor from the sale of the counterfeit product. It is one of the rare cases in Greece where the Courts actually award damages, given that in principle, TM owners receive only "moral damages", which corresponds usually to only a fraction of their actual damages.



1. Case topic		Trademark Infringement - Online Infringement	
2. Country		Greece	
3. Case citation (Title, Court and Case No.)		Athens Multimember Court of First Instance no 5246/2014 (Published in legal magazine APM 2015/1536)	
4. Date of order or judgment			
5. Type of infringing goods (categories)		Food and Beverages	
6. Parties			
	Right Holder (Plaintiff)	Nikas SA	
	Infringer (Defendant)	Panagiotis Nikas	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		Nikas	With the recipe and care of Panagiotis Nikas
8. Outline (summary) of the case			

The owner of the trademark and a well known company with a long tradition in Greece in the field of cold cuts, filed a lawsuit against a later competitor using his own name, which was identical to the trademark of the plaintiff, as part of a slogan to distinguish similar goods. The Court after considering that the conditions of risk of confusion were not met, and that the defendant, using its name, did not act against the principles of good faith, dismissed the lawsuit.



1. Case topic	A leading case on trademark infringement that sets out the test for likelihood of confusion	
2. Country	Italy	
3. Case citation (Title, Court and Case No.)	Court of Milan, Specialized Section of Company Law, n.13395/2016	
4. Date of order or judgment	2016-12-05	
5. Type of infringing goods (categories)	Class 38, 39, 16 and 35 of Nice Classification.	
6. Parties		
	Right Holder (Plaintiff)	MBE WORLDWIDE s.p.a. / SISTEMA ITALIA 93 s.r.l.
	Infringer (Defendant)	MAIL & BOX EXPRESS DIP. C.G.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	Mail Boxes ETC - MBE - MBE Mail Boxes ETC	MBE - Mail & Box Express

8. Outline (summary) of the case

The Plaintiffs complained of the use of signs interfering with its own by the Defendant. In particular, (...) complains of the registration of the domain name <http://www.mbespedizioni.it> containing its trademarks, of the advertising also through the internet of national and international express delivery services using the MBE signs unduly. In this respect, in light of Art. 20(1)(a) and (b) of the Code of Civil Procedure, the Court held that the judgement of infringement was certainly positive. The assessment of confusion is based on well-established criteria, i.e. through "an overall assessment of the risk of association, which implies an interdependence between the factors taken into consideration, and in particular the similarity of the goods or signs designated. So that a slight degree of similarity between the marks can be compensated by a high degree of similarity between the goods (see in European Court of Justice, 29.9.1998, Case C-39/97, Canon Kabushiki Kaisha v. Kaisha v. Metro-Goldwyn-Mayer Inc., paragraph 17).

In the present case, the services marketed by the litigants are completely overlapping, not only in terms of product and market segment, since in both cases they are national and international shipping services. Even a slight similarity between the signs is then sufficient to infer confusability. And in the present case, that finding is undoubtedly positive, given that the 'Mail & Box Express' logo slavishly reproduces the core of the applicants' sign from a phonetic point of view (the last word of the respondent's sign begins with the letter 'E', as in the case of the current mark) visual and conceptual.

The possibility for the public to believe that the services come from the same undertaking, or possibly from economically-linked (judgment of the Court of First Instance of 21 April 2005, Case T-164/03, Ampafrance v OHIM Johnson & Johnson (monBeBe, Rec. p. ii-1401, paragraph 46) in view of the identity of the signs - visually, graphically and conceptually and the overlapping of the services - is therefore extremely high.

In addition, the contested trademark even seems to reproduce figurative elements of the elements of the MBE trademarks, thus increasing the risk of confusion and possibly even constituting usurpation (see order cited above). Therefore, the Plaintiffs are entitled to prohibit the Defendant:

- "the use of the identical sign 'MBE' for services identical (i.e. shipping and transport) to the one services (i.e. dispatch and transport) for which

it is registered, which exempts the Defendant from the the likelihood of confusion;

- the use of a sign - 'Mail & Box Express' - which is entirely similar to that of the applicants (Mail Boxes

Mail Boxes ETC) for services identical to those for which the mark applied for was registered (transport and shipping). This is because of the likelihood of confusion on the part of the public because of the extreme similarity of the sign and the identity of the services'. In light of the above:

Court of Milano, definitively ruling on the claims brought by MBE Worldwide s.r.l. and Sistema Italia 93 s.r.l. against Mail & Box Express diP. C.G. and disregarding all other requests and objections, has ruled as follows:

- ascertains and declares the unlawfulness of the conduct of Mail & Box Express di P.C. G. for infringement of the plaintiffs' trademarks and for conduct of unfair competition, for the reasons indicated in the foregoing;
- definitively prohibits Mail & Box Express diP. C.G. from using - in any context whatsoever the signs "MBE" "Mail & Box Express" or similar, in any company name or domain, as much as they interfere with the trademarks of the ownership of the plaintiffs;
- orders Mail & Box Express diP. C.G. a penalty of € 500,00 for each day of violation or failure to comply with the requirements of point 2, starting from the twentieth day following notification of this judgment;
- orders the definitive transfer in favour of Sistema Italia 93 s.r.l. of the following domain name: "http://www.mbespedizioni.it; http://www.facebook.com/mbespediz;http://twitter.com/mbespedizioni owned by the defendant;
- orders the defendant to pay damages to the plaintiffs jointly and severally in the sum of 98 980,00 euros, plus interests;
- orders the defendant to pay the costs of the proceedings jointly and severally in favour of the applicants, assessed at EUR 14,000.00, of which EUR 1,700.00 for legal costs and the remainder for fees, in addition to 15% flat-rate costs, VAT, CPA and registration fees.



1. Case topic		A leading case on infringement dealing with counterfeit goods	
2. Country		Italy	
3. Case citation (Title, Court and Case No.)		Court of Cassino, Criminal Section, n.237/2021	
4. Date of order or judgment		2021-04-14	
5. Type of infringing goods (categories)		Shirts, sweater, belt and shoes in class 25 of Nice Classification	
6. Parties			
	Right Holder (Plaintiff)	///	
	Infringer (Defendant)	///	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		Ralph Lauren, Ferrè, Fendi, Adidas and Nike	///

8. Outline (summary) of the case

The Defendant is charged with possessing for sale 1 shirt of the brand Ralph Lauren; 1 shirt branded Ferrè; 1 belt branded Fendi; 2 pairs of shoes branded Adidas, 6 pairs of Nike brand shoes, with counterfeit trademarks. The defendant does not appear and the trial continues in his absence. The Court, according to the principles set out in case law (Sez. 2, no. 9362 of 13/2/2015, Rv. 262841), considers that the reproduction of a registered trademark, "even if not faithful, but expressing a strong similarity, when it is possible to detect an objective and unequivocal possibility of confusion of the images, such as to lead the public to mistakenly identify the goods as coming from a particular manufacturer" constitutes the infringement of trading in products with false signs. The Court also held (Sect. 2, no. 36139 of 19/07/2017, Rv. 271140), that, for the purposes of the subsistence of the crime provided for by Article 474 of the Criminal Code, when it is a matter of a trademark of widespread use and of uncontested use by the relevant manufacturing companies (as in our case, since they are all well-known trademarks), proof of their registration is not required, the burden of proving that the conditions for its protection are not met rests on the party claiming such non-existence. In this regard, it should also be noted that the fraud in the exercise of trade can also be committed if the purchaser does not carry out any checks on the goods offered for sale, since both the seller's behaviour, whether fraudulent or not, and the possibility for the buyer to notice the difference between the goods delivered and those requested are irrelevant (Sez. 3, no. 23819 of 30/04/2009, (...), Rv. 244024; Sez. 3, no. 54207 of 18/11/2016, O G., Rv. 269591). According to the established case law, Article 474 of the Criminal Code, refers to products bearing counterfeit trademarks, i.e. the distinctive signs of the manufacturing companies, is intended to protect the economic order (Sect. 5, no. 9389 of 4/02/2013, dep. 4/02/2013, dep. 27/02/2013, P.M. in proc. (...) and others, Rv. 255227; Sect. 3, no. 2003 of 13/11/2007, dep. 13/11/2007, dep. 15/01/2008, (...), Rv. 238557), in respect of which the putting in circulation of intellectual products or industrial works bearing trademarks or distinctive signs designed

to mislead the purchaser as to the origin, provenance or quality of the work or product, even without any "upstream" counterfeiting conduct. Jurisprudence has affirmed the principle that the legal interest protected by the provision of Art. 474 of the Criminal Code is "public faith" in an objective sense, understood as the trust of the public on the trademarks or distinctive signs that identify original works or products and guarantee their circulation, and not the trust of the individual, so that it is not necessary for the offence to be committed that a situation be created that could mislead the customer in error as to the genuineness of the product. The offence under Article 474 of the Criminal Code exists where a commercial activity is found to have a counterfeit mark; according to case law, the res does not necessarily have to be potentially misleading for patrons, precisely because of their lack of homogeneous knowledge (see Court of Appeal, Milan Sez.IV, 13/02/2008; Cass. Pen. Sez. V, sentence no. 3028/1999); it is therefore a crime of danger, whose

configuration of which is not dependent on the deceit being carried out, because the case is aimed at protect public faith, such as customers' reliance on the genuineness of goods bearing well-known trademarks. For the configuration of the offence under Article 474 of the Criminal Code, as said, it is sufficient even the mere the ability of the forgery to cause confusion, with reference not only to the moment of purchase, but also that of the subsequent use of the product with the counterfeit mark. In the presence of all this, recent case law suggests that an expert's report on both the goods seized and their value is superfluous. Having regard to Articles 533-535 of the Code of Criminal Procedure, declares the defendant responsible for the offence ascribed to him and condemned him to a final punishment of 4 (four) months' detention and a fine of E3,335.00, as well as to pay payment of court costs. Having regard to Articles 163, 164 and 133 of the Criminal Code, declares that the sentence is suspended.

Having regard to Article 240 of the Criminal Code, orders the confiscation and destruction of any items still in seizure.



1. Case topic	A leading case on trademark infringement online	
2. Country	Italy	
3. Case citation (Title, Court and Case No.)	Court of Cassation, first section, n. 4721/2020	
4. Date of order or judgment	2020-02-21	
5. Type of infringing goods (categories)	Classes 16 (magazines) and 41 (online publication of electronic magazines) of Nice Classification	
6. Parties		
	Right Holder (Plaintiff)	Arnoldo Mondadori Editore s.p.a.
	Infringer (Defendant)	S.G.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	GRAZIA	grazia.net

8. Outline (summary) of the case

The Plaintiff complained that S.G. had registered and used the distinctive sign "grazia.net", included in the website, in violation of his exclusive rights relating to the trademark and to his newspaper. The case is brought before the Court of Cassation, where S.G. puts forward a ground of appeal. In this regard, the Court stated that "the registration of a domain name which reproduces or contains a trademark of another party constitutes an infringement of the trademark because it allows the activity to be linked to that of the holder of the trademark, exploiting the reputation of the sign and thus taking unfair advantage of it. It follows that only the owner of a registered trademark may legitimately use it on his website or as a domain name." Domain names are indeed "tools through which to access, within the Internet, to a vast commercial marketplace of global dimensions that allow to identify the owner of the website and the products and services offered to the public, so those names have genuine distinctiveness, since, according to the current view of the nature and function of trademarks, they do not merely indicate the origin of the goods or services, but perform an advertising and suggestive function which has the the purpose of attracting the consumer and inducing him to buy". In the present case it is undisputed, as judicially ascertained by the Territorial Court itself, that the registered trademark in question is 'strong' so that it is covered by the most rigorous protection, characterised by a greater incisiveness which renders illegitimate the variations, even original ones, which, in any case, leave intact the ideological nucleus of the sign (Court of Cassation, n. 5091/2000; n. 1413/1995; n. 5924/1996), since even slight modifications, which the weak mark must tolerate, would lead to the result of prejudicing the sign (cf. Cass., no. 26000/18). There is no doubt that the use of the trademark grazia.net has led to an objective link, given the same ideological and semantic core, to the renowned and highly distinctive trade mark GRAZIA. The Court dismisses the appeal and orders the appellant to pay, in favour of the opposing company, the costs of the proceedings, which it settles in the sum of EUR 6400.00, including EUR 200.00 for disbursements, plus an additional 15% as a flat-rate reimbursement of general costs.

The Court of Appeal ordered S.G. to transfer the domain name (OMISSIS) in favour of the Plaintiff within 30 days from the communication of the sentence, and ordered the appellant to pay the costs. order the appellant to pay a penalty of Euro 100.00 for each day of delay.



1. Case topic		Additional case to round out the landscape	
2. Country		Italy	
3. Case citation (Title, Court and Case No.)		Court of Cassation, first section, n.25070/2021	
4. Date of order or judgment		2021-09-16	
5. Type of infringing goods (categories)		Class 38 of Nice Classification, as "transmission of television programs", Class 9 "Computer telephony equipment", Class 25 "clothing" and Class 40 "custom tailoring".	
6. Parties			
	Right Holder (Plaintiff)	R.T.I. Reti Televisive Italiane s.p.a.	
	Infringer (Defendant)	R.N.R. - Computer Line S.r.l.	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		xxx trademark	xxx domain name

8. Outline (summary) of the case

The Plaintiff claimed that it had been broadcasting a television programme for more than 24 years, noting that it had registered the relevant trademark, and complained that the Defendant R.N.R. had also registered the similar domain name for a website intended to advertise its tailoring business and the sale of telephone products. He also complained that Computer Line, as Internet access provider, had allowed him to be visualized. The Court of First Instance held that the registration of the domain name was an infringement of the registered trademark and therefore prohibited its use, ordered its cancellation and ordered the defendants to compensate the damage.

The Court of Appeal overturned the judgment and rejected, in short, RTI's claim.

The case goes to the Court of Cassation, where the Court considers that the decision of the Court of Appeal was incorrect. In detail, as far as we are concerned here, the Supreme Court considers that the Court of Appeal erred in finding the mark to be non-distinctive and therefore not protectable against the domain name. In fact, the Court makes it clear that RTI's sign has to be considered as an overall mark, characterized by the absence of a distinguishing element, since all the various elements composing it are individually devoid of distinctiveness, and so the distinctiveness, more or less accentuated, derives only from their combination or, indeed, from their "togetherness". The Court of Appeal then erred in rejecting the claim for damages because it lacked evidential support. The Supreme Court points out that in the liquidation of damages in IP matters, the following must be taken into account the specific discipline dictated by art. 125 c.p.i., paragraph 2, on the basis of which the judge can liquidate the damage in a "global sum established on the basis of the documents of the case and the presumptions deriving from them", taking into consideration, therefore, even only the circumstantial elements offered by the injured party and, in the

event that the owner is unable to demonstrate the loss of earnings, the loss of earnings may be settled by resorting to the alternative method of just royalty or virtual royalty, without the burden on the holder of the right to demonstrate

what would have been the certain royalty claimed in case of a hypothetical request for a licence by the infringer, since that criterion does not represent the damage actually suffered but a 'compulsory minimum'. The criterion of the just royalty or virtual royalty, as has been pointed out in doctrine, operates, then, independently of the effective availability of the owner of the infringed intellectual property rights to license them, when no other method of liquidation of damages can be used and, in the absence of licensing contracts concluded by the rightholder in respect of those rights, the Court itself, with the assistance, where appropriate, of an expert, must refer to the royalty which for products or services and for intellectual property rights similar to those whose infringement is at issue. Finally, the Court states that the liability of the hosting provider is incurred by a service provider who has failed to take immediate action to remove unlawful content, or has continued to publish it, when the following conditions are jointly met: -the hosting provider has legal knowledge of the unlawful act perpetrated by the user of the service, having been informed of it by the holder of the right infringed or aliunde;

-the unlawfulness of the conduct of others is reasonably ascertainable, so that the hosting provider is seriously negligent for failing to detect it positively, in accordance with the degree of diligence reasonable to expect of a professional network operator;

- has the possibility of taking useful action, since it has been made aware in a sufficiently specific manner of the unlawful content to be removed. The Court annuls the decision and refer it back to the Court of Appeal, ordering it to decide on the basis of the above principles of law.



1. Case topic	Confusing similarity in case of word marks v. figurative marks with an identical word element	
2. Country	Poland	
3. Case citation (Title, Court and Case No.)	Judgment of the Supreme Court of 22/02/2207 in case No. III CSK 300/06	
4. Date of order or judgment	2007-02-22	
5. Type of infringing goods (categories)	dairy products	
6. Parties		
	Right Holder (Plaintiff)	anonymized
	Infringer (Defendant)	anonymized
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	MIXEŁKO (word mark)	MIXEŁKO ŁACIATE (figurative mark with word elements, anonymized in the judgement as to its representation); from the judgment's substantiation it follows that the work mark 'MIXEŁKO ŁACIATE' on the infringing goods was accompanied by additional figurative elements in form of white and black spots similar to colour of cow's hair

8. Outline (summary) of the case

The Parties were producing dairy product in form of a mix of butter and vegetable oil, under the name 'MIXEŁKO'. The Plaintiff registered it's sign as a Polish national trademark and filed a court claim against its competitor, claiming that the use of its trademark 'MIXEŁKO ŁACIATE' constitutes it's trademark right infringement.

The District Court, as well as the Appeal Court, dismissed the claim. The District Court stated that signs should be assessed globally, i.e. not only by their word elements, but also by taking into account their figurative elements. According to the Court, the signs under comparison shared only some partial phonetical similarity in the element 'MIXEŁKO'. This element, however, was dominated in the infringing goods by the additional word element 'ŁACIATE', which was visually striking and highly distinctive. Therefore, both Courts confirmed that there was no risk of confusion for the relevant public.

The Supreme Court did not share these findings. The Supreme Court emphasized that visual similarity should be assessed in close consideration of the requirement of trademark's graphic representation. Word marks are represented by a string of letters. In this context, the Infringed Trademark 'MIXEŁKO' (word mark), was fully incorporated in the Infringing Trademark. The figurative elements in this matter played a less important role. Figurative elements would play a more important role in cases related to figurative marks with an identical word element, but they do not have such significance in case of word marks.


The Supreme Court established that the signs were also very similar phonetically, as the word 'MIXEŁKO' was clearly audible in the Infringing Trademark 'MIXEŁKO ŁACIATE'. In this regard the Infringing Trademark should be seen as a copy of the Infringed Trademark. This fact could not be changed by a different figurative representation of the signs, as it was irrelevant if the infringing party used a different figurative design of its products.



1. Case topic		Trade mark infringement in a domain name	
2. Country		Poland	
3. Case citation (Title, Court and Case No.)		Judgment of the Supreme Court of 11 December 2013 IV CSK 191/13	
4. Date of order or judgment		2013-12-11	
5. Type of infringing goods (categories)		restaurant	
6. Parties			
	Right Holder (Plaintiff)	anonymized	
	Infringer (Defendant)	anonymized	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		p. (anonymised)	http://www.pastaandbasta.pl/
8. Outline (summary) of the case			


Use of a trade mark in an Internet domain by a third party constitutes an infringement of the trademark protection right if it creates a risk of confusion as to the origin of the goods (services) or leads to an infringement of the advertising function of the trademark. The use of a trade mark on the Internet is a form of use covered by the trade mark owner's monopoly of protection. One of the forms of using the mark in the Internet environment is placing the mark in an Internet domain. The use of the mark on the Internet, connected with specific goods (services) and their offering on the market is often connected with additional functions of the mark, i.e. informational and advertising, however, it does not diminish the dominant character of the function of the indication of origin.



1. Case topic	General rules of trade mark comparison; assessment of the overall impression given by the marks in order to establish confusing similarity; word element having stronger impact than a figurative element in a word-and-device mark	
2. Country	Poland	
3. Case citation (Title, Court and Case No.)	Judgment of the Supreme Court of 21 December 2006 in case No. III CSK 193/06	
4. Date of order or judgment	2006-12-21	
5. Type of infringing goods (categories)	tinned fish	
6. Parties		
	Right Holder (Plaintiff)	anonymized
	Infringer (Defendant)	anonymized
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	SALSA (word mark), SALSA figurative mark 	Anonymised, but according to the judgement the etiquette of the tinned fish displayed the element 'SALSA', aiming to describe a sauce flavour
8. Outline (summary) of the case		

The dispute revolved around a similarity between the plaintiff's trade marks and a tinned fish etiquette produced by the defendant. In the process of deciding whether there is a similarity between the signs, and likelihood of confusion, the Court emphasised the need for an overall assessment of the marks, i.e. "a comprehensive assessment including all its elements, as only in this way it is possible to reach a reasonable conclusion as to the existence of similarity between the trade marks". The Court stated that "the analysis should be carried out at the phonetic, visual and semantic level, including the overall impression produced by the signs in comparison on the so-called average consumer". The Court stressed that in case of figurative marks containing word element, it is the latter that generally has a stronger impact on the relevant consumer. Based on the abovementioned rules, the Court agreed with the Regional Court and Court of Appeal, stressing that the courts made a comprehensive assessment of conflicting marks and convincingly demonstrated that there is no real risk of confusing the origin of the goods offered for sale. The Court stated that they differ significantly in the shape of packaging, colours of labels and inscriptions.



1. Case topic	Well-known mark infringement in the domain name and on the website	
2. Country	RUSSIA	
3. Case citation (Title, Court and Case No.)	Commercial court of the Moscow region, case No. A41-7379/2019	
4. Date of order or judgment	Final judgement of IP Court (cassation) of February 11, 2020	
5. Type of infringing goods (categories)	Motor vehicles	
6. Parties		
	Right Holder (Plaintiff)	PAO "KAMAZ", Russia
	Infringer (Defendant)	Mr. Kosakyan Dmitry, Russia and Limited Liability Company "KDR-Group", Russia
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		kamazi.ru

8. Outline (summary) of the case

Plaintiff is the owner of the Russian trademark KAMAZ registered as well-known mark under Reg.No. 36 for the goods of class 12 and he became aware of registration of the domain name kamazi.ru in the name of the Defendant Mr. Kosakyan and use of KAMAZ trademark on the website www.kamazi.ru. When evaluating the likelihood of confusion of the trademark, the Court of appeal reasonably proceeded from the fact that the Plaintiff's trademark has become widely known for heavy dump trucks since December 31, 1999, which was due to the long and intensive use by the Plaintiff of his trademarks under his control and, as a result, the use of confusingly similar designations poses a great threat of confusion of these trademarks and the designation used by the Defendants in the minds of consumers (Supreme Court, case No. 305-ES20-6564, Ruling dated May 15, 2020).

By resolution of the Court of Appeal dated October 21, 2019 and the resolution of the Court of Cassation (IP Court) dated February 11, 2020 the claim was satisfied, the Defendants were prohibited from using the designation "KAMAZI" confusingly similar to the Plaintiff's trademark in the domain name kamazi.ru, Defendants also were prohibited from using it on the pages of kamazi.ru website, and KDR-GROUP was prohibited from using it in its e-mail addresses info and zakaz at www.kamazi.ru. KDR-GROUP was obliged to publish the court judgment in Moskovskaya Pravda newspaper.

In its cassation appeal, the appellant refers to incorrect application of legal norms by the Court of Appeal and the Court of Cassation. Having examined the arguments provided in the appeal the judge of the Supreme Court established that there are no grounds, on which the cassation appeal may be referred for consideration in the court hearing of the Collegium on Economic Disputes of the Supreme Court.



1. Case topic		Trademark infringement and abuse of right	
2. Country		RUSSIA	
3. Case citation (Title, Court and Case No.)		Commercial Court of Irkutsk region A14-10320/2014	
4. Date of order or judgment		Judgement of the Court of Appeal of January 16, 2017	
5. Type of infringing goods (categories)		Confectionery (chewing marmalade)	
6. Parties			
	Right Holder (Plaintiff)	Limited Liability Company "Novye Technologii", Russia	
	Infringer (Defendant)	Limited Liability Company "Perfetti Van Melle", Russia	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		ФУТБОЛ (FOOTBALL in Cyrillic)	FRUIT-TELLA ФУТБОЛ

8. Outline (summary) of the case

Plaintiff was the owner of the Russian trademark registration No. 393967 FOOTBALL (in Cyrillic) registered for the goods of class 30. Defendant has used designation similar to the Plaintiff's trademark as one of the elements on the packaging of the chewing marmalade. Plaintiff has filed a claim against Defendant - Perfetti Van Melle which is the Russian subsidiary of the international holding Perfetti Van Melle Holding B.V. and produces candies, such as «Chupa Chups», «Fruit-tella», «Mentos». Plaintiff referred to the illegal use by the Defendant of the designation «FOOTBALL» which is registered trademark, and claimed that infringement be terminated, counterfeit products be seized and destructed as well as monetary compensation be paid.

Plaintiff is the right holder of several thousand trademarks containing as protected elements or consisting only of the popular words which are in general use, such as «ЗДОРОВЬЕ» («health»), «ВОСТОРОГ» («joy»), «ЛЕСНЫЕ ОРЕШКИ» («hazelnuts»), «СПОРТ» («sports»), «ЛЕСНАЯ СКАЗКА» («Forest Fairy Tale»), «ФАНТАЗИЯ» («fantasia»), «РУССКАЯ КРАСАВИЦА» («RUSSIAN BEAUTY»), «ЗОЛОТАЯ ОСЕНЬ» («Golden Autumn»), and so on. It is also known that the Plaintiff participated in a substantial number of law cases as a plaintiff and usually failed to produce evidence of genuine business activity or a bona fide intention to use the trademarks.

In the statement of defense Defendant submitted evidences of the above-mentioned facts and claimed that Plaintiff derives profit from selling registered trademarks, from monitoring the use of the trademarks owned by them or similar designations by different companies and from further claiming the payment of monetary compensation for such illegal use, or persuading them to conclude assignment and license agreements. At the same time the main goal of Plaintiff claims against Defendant is not the protection of the infringed rights, but obtaining of financial benefit. Therefore, the actions of Plaintiff shall be recognized as abuse of right, which is an independent ground for the court to reject his claims in full.

At the same time Defendant managed to cancel the Plaintiff trademark because of non-use.

As a result, commercial court decided to reject the claims of Plaintiff in full on the basis of the provisions of Art. 10 of the Civil Code (abuse of right). The decision of the first instance court was upheld by the Commercial Court of Appeal.



1. Case topic	Online trademark infringement in domain name and on website	
2. Country	RUSSIA	
3. Case citation (Title, Court and Case No.)	Moscow Commercial Court, case No. A40-247918/2019	
4. Date of order or judgment	Judgement of Intellectual Property Court (cassation) of October 08, 2021	
5. Type of infringing goods (categories)	Telecommunication equipment	
6. Parties		
	Right Holder (Plaintiff)	Mitel Networks Corporation, Canada
	Infringer (Defendant)	Mr. Vladimir Sapranov, Russia
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	MITEL	mitel.ru

8. Outline (summary) of the case

Plaintiff is the owner of the Russian word trademark MITEL registered for the goods of class 9 and services of class 42. He uses trademark in Russia and sells telecommunication equipment through his Russian subsidiary. He found out that Defendant has registered domain name mitel.ru and used trademark MITEL on the website www.mitel.ru. Defendant has filed court action to the Moscow Commercial Court based on the infringement of trademark rights and trade name and claimed to stop the infringement and transfer the rights to administer the domain name to the Plaintiff. Prior to this court action all required actions have been taken to prevent any transfer of the domain name to any third parties during the legal proceeding.

Plaintiff has proved that the domain name under dispute is confusingly similar to his trademark; there is a stable association between domain name and trademark, which results in their confusion in the consumer's (Internet user's) mind; the domain name mitel.ru and the trademark / trade name may be perceived as varieties of the same designation used by the same business entity (the right holder), which is not true to the facts; the Defendant has no legal rights and interests with regard to the domain name mitel.ru; the Defendant unfairly uses the domain name mitel.ru by supporting its registration.

In the course of court proceedings it appeared that Defendant has registered identical trademark MITEL for the services of class 35 which have nothing to do with telecommunication equipment or services of class 42 and tried to show that he had legal rights and interests with the domain name mitel.ru. Plaintiff has proved with evidences that Defendant never used his trademark for the services of class 35 but advertised and offered for sale goods and services of the Plaintiff on the website www.mitel.ru pretending that he is an authorized representative of the Plaintiff.

As a result, the court has satisfied the claims in full and the rights to administer the domain under dispute have been transferred to the Plaintiff.



1. Case topic		3D Trademark infringement and unfair competition	
2. Country		RUSSIA	
3. Case citation (Title, Court and Case No.)		Moscow Commercial Court, case No. A40-212216/2016	
4. Date of order or judgment		Judgement of Intellectual Property Court (cassation) of June 03, 2019	
5. Type of infringing goods (categories)		Food (spices)	
6. Parties			
	Right Holder (Plaintiff)	Kotanyi GmbH, Austria	
	Infringer (Defendant)	Limited Liability Company "Kamis-Pripravu", Russia, third party - McCormick and Company Inc., USA	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			



8. Outline (summary) of the case

Plaintiff is the owner of the 3D trademarks (IR-1083072 and IR-844345) registered for the goods of class 30 (spices). Plaintiff uses trademarks in Russia and sells spices through his Russian subsidiary. His goods are very popular in Russia and their market share is more than 13%. Plaintiff found out that Defendant started to sell the same spices in the packaging which is similar to the Defendant's registered trademarks. Earlier Defendant sold his spices in different packaging which was also registered as a trademark but suddenly has changed the packaging to the packaging which is similar to the Plaintiff's trademarks. Defendant's spices were sold in the same chain stores on comparable prices and were placed next to each other on the shelves.

Plaintiff has filed court action to the Moscow Commercial Court based on the infringement of trademark rights and unfair competition and claimed to terminate the infringement. In particular the Defendant claimed to stop importation and sale of the infringing goods, to stop their offline and online advertising and to pay compensation for infringement. The Defendant has presented the evidences of likelihood of confusion of the Plaintiff's trademarks and Defendant's goods that were accepted by the court. Among these evidences there were non-forensic examination of the professional designer which proved the similarity of 3D trademarks and the Defendant's packaging and sociological survey (1500 respondents across Russia) which proved similarity of the Plaintiff's trademarks and Defendant's packaging and confusion of consumers. As a result of the sociological survey majority of respondents (more than 70%) told that general similarity existed between the packaging of Defendant's goods and Plaintiff's trademarks. From 45% to 71% of respondents considered that they could confuse the goods of Defendant with the goods of Plaintiff when they made purchase. In accordance with position of the Supreme Commercial Court of the Russian Federation the significant result of the sociological survey is when from 20 % to almost 60 % of respondents were unable to draw a clear distinction between the competitors' trademarks. This significant result has impact on goods promotion in a certain market segment (The Ruling of the Supreme Commercial Court No. 3691/06 of 18.07.2006).

The findings of examination and sociological survey have been taken into account by the court. The case has been reviewed in the Court of Appeal and in the cassation instance (IP Court). Taking into account all evidences of the case IP Court has confirmed infringement and awarded compensation for the infringement of trademark rights. It is interesting that in the course of court proceeding Defendant filed two invalidation actions against Plaintiff's 3D trademarks on the basis of lack of distinctiveness (in Russia it is a separate procedure in the Chamber for Patent Disputes of Rospatent) but he did not succeed. Defendant also managed to register his packaging as design but patent for design was successfully invalidated by the Plaintiff.



1. Case topic		Likelihood of confusion	
2. Country		Spain	
3. Case citation (Title, Court and Case No.)		"HELLO KITTY" (Sanrio Company Ltd.) vs. "HOLA GATO" (Río Luna, S.L. and others), Resolution No 11/2018 decided by the Alicante Provincial Audience on 11 January, 2018	
4. Date of order or judgment		11 January 2018	
5. Type of infringing goods (categories)		Clothing, accessories, bags, costume jewelry, stationery	
6. Parties			
	Right Holder (Plaintiff)	SANRIO COMPANY LTD	
	Infringer (Defendant)	RIO LUNA, S.L., RIO STAR BISUTERÍAS, S.L., ISABEL BISUTERÍA S.L. and RIO SOL BISUTERÍA, S.L.	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case

SANRIO COMPANY LTD is a Japanese company that owns numerous Spanish and European Union trade mark registrations and international trade mark registrations with effects in Spain for the world-famous fictional character HELLO KITTY.

On October 2015, the company brought proceedings against the companies RIO LUNA, S.L., RIO STAR BISUTERÍAS, S.L., ISABEL BISUTERÍA S.L. and RIO SOL BISUTERÍA, S.L. for infringement of the rights in its HELLO KITTY trademarks, as they had been selling a series of products identified by the trademark reproduced above.

The companies argued in their defence that they were making use of the HOLA GATO mark under the coverage of Spanish trademark registration No. 2934333. Thus, the issue once again arose as to whether the owner of an earlier trademark may assert the *ius prohibendi* conferred by his registration against the owner of another trademark, registered subsequently, or whether, trademark infringement proceedings are conditional upon first or concomitantly invalidating the later registered trade mark. The judgment delivered at first instance ruled that the defendants had been infringing various well-known trademarks owned by Sanrio, by selling a series of products under the sign "HOLA GATO" and with figures very similar to the kitten of the "HELLO KITTY" trademarks, there being a likelihood of confusion in the marketplace. The companies RIO LUNA, S.L., ISABEL BISUTERÍA S.L. and RIO SOL BISUTERÍA, S.L. lodged an appeal, disputing the existence of an infringement on grounds that there was a trademark registration (owned by a third party not intervening in the proceedings) which would cover the use of the mark, and thus that since there was no bad faith, there should not be an order to pay any compensation.

The Alicante Trademark Court dismissed the appeal and upheld the first instance judgment, finding that "infringement of the trademark can arise as the result of the actions of the owner of a subsequently registered trade mark, which is confusingly similar to the former, without it even being necessary to have previously or simultaneously brought an invalidity action against the same". In this regard, it refers to the EU Court of Justice's interpretation of the Regulation 207/2009 on the European Union trade mark in its judgment of 21 February 2013 (case C-561/11) where it stated that, in the light of the priority principle, the earlier mark takes precedence over the later mark, since the mark registered first is presumed to have met the conditions required to obtain Community protection before the mark registered second, concluding that the infringing third party referred to in Article 9 of this Regulation can perfectly well be the owner of a later trade mark. Finally, in line with the change of approach initiated by the Supreme Court's judgment no. 520/2014 of 14 October 2014 (DENSO case, ECLI:ES:TS:2014:5089), the Court applies this interpretation of Community legislation to the national level in Spain: "The Spanish Supreme Court, reiterating said doctrine in the Judgment of 14 October 2014, has deemed it applicable to the case of national marks, meaning that it is not even possible for the owner of a subsequently registered Spanish trade mark to invoke the *ius utendi* stemming from a registration to dispute the infringement of the earlier mark".



1. Case topic	Trademark counterfeiting. Street sale of clear imitations of sports shoes. Economic compensation due to moral damage caused to the trademark holder	
2. Country	Spain	
3. Case citation (Title, Court and Case No.)	Judgment of the Provincial Court of Barcelona 9/2019 of January 8, 2019. Nike, Adidas and Public Prosecutor against D. Doroteo	
4. Date of order or judgment	8 January 2019	
5. Type of infringing goods (categories)	Sports shoes	
6. Parties		
	Right Holder (Plaintiff)	Nike Innovate CV and Adidas AG
	Infringer (Defendant)	D. Doroteo
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
	NIKE ADIDAS	NIKE ADIDAS (Counterfeit products)

8. Outline (summary) of the case

The defendant had on display for sale on the streets, on a blanket on the floor, a total of 49 pairs of sports shoes on which the registered trademarks "NIKE" and "ADIDAS" were reproduced without the authorization of the corresponding holders of the IP rights. As a result, he was arrested by the police and sentenced by the Criminal Court No. 4 of Barcelona for a minor crime against intellectual property.

The defendant appealed against this judgement, based on the non-existence of the objective requirements of the criminal action for which he was condemned in the appealed resolution, due to the absence of the requirement that the products available for sale were adequate to generate confusion in the consumer, as well as the inadequate specification of civil liability, since the crime against IP is a crime of mere activity, so that in order to derive a civil liability it will be necessary that at the same time there is an economic damage, a circumstance that does not occur in this case. Therefore, he requests that a judgment of acquittal be issued or, failing that, the elimination of the civil liability established in favor of the trademark owners.

The Court establishes that, given that the counterfeit products seized bore the trademarks "NIKE" and "ADIDAS", there was a clear risk of confusion with the original products, given the existing identity between the trademarks, without the low quality of the counterfeit products being a factor that reduces the risk of confusion or avoids the risk of taking unfair advantage of the reputation of the protected trademarks.



The legal property protected by the legislation (Trademark Act and Criminal Code) is the exclusive right of use of the owner of the trademark protected, not the protection of the consumer against a possible deception or confusion about the origin of the products. Accordingly, it is irrelevant whether the counterfeiting of the product is more or less obvious, since what is relevant is that a protected trademark has been used without the owner's authorization.

For an infringement of a trademark right to occur, it is sufficient that the possession for commercialization of products with a registered trademark, without the authorization of the trademark owner, is sufficient, since the exclusivity in the use of such trademarks is protected, thus allowing economic benefit to those who have invested dedication, effort and resources in the creation, commercialization and reputation of their trademarks.

In addition, the Court establishes the obligation to pay an economic compensation to the trademark holders for the moral damage caused to them, since its reputation is affected when under the use of the trademark, counterfeit products of a clearly inferior quality are sold.

The judgment is relevant because it clarifies that whenever the trademark of a third party is used without authorization, the poor quality of the counterfeit products is irrelevant for the existence of an infringement of the trademark. On the other hand, the judgment opens the door to the possibility of claiming moral damages for the damage caused to the trademark in crimes against intellectual property.



1. Case topic		Trademark infringement online. Likelihood of confusion. Infringement of a reputed trademark.	
2. Country		Spain	
3. Case citation (Title, Court and Case No.)		Judgment No. 37/2016 rendered by the Commercial Court of Alicante on February 11, 2016	
4. Date of order or judgment		11 February 2016	
5. Type of infringing goods (categories)		Telecommunications services and goods and services related to mobile telephony.	
6. Parties			
	Right Holder (Plaintiff)	Orange Brand Services Ltd.	
	Infringer (Defendant)	Orange Mobile, S.L.	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case

Orange Brand Services Ltd. is the holder of several well-known EU and Spanish trademarks containing the term ORANGE and covering services in Classes 35 and 38. A number of those trademarks are figurative.

The defendant, Orange Mobile, S.L., being a distributor of a competitor of the plaintiff's (Vodafone), offers goods and services relating to mobile telephony—in an establishment open to the public—using its company name “ORANGE MOBILE” and the website www.orangemobile.es.

The plaintiff brought proceedings for infringement of its trademarks on the basis of Article 9.1.a), b) and c) EUTMR in relation to Article 41 of the Spanish Trademark Act. The complaint was accepted.

First of all, the court rejects the argument that the defendant is using the infringing sign with due cause insofar as the plaintiff's trademarks have been registered and are well-known in the EU since long before the defendant was making use of the ORANGE MOBILE sign. Secondly, the court considers that even if the plaintiff's trademarks were not known by part of the public in Spain prior to a certain date, it cannot be ruled out that a commercially significant part of that public were familiar with the trademarks, and the defendant, as a company belonging to the telecommunications sector, would form part of that “commercially significant” public and could not be unaware of the existence of a link between the plaintiff's trademarks and the sign used to promote its products and services. Thirdly, with respect to the registration and use of the domain name, the court confirms that the plaintiff's trademarks have been infringed for the following reasons:

- The domain name hosted a website which offered products and services relating to a competitor of the plaintiff's (Vodafone), and such conduct is capable of giving rise to a likelihood of confusion;
- While the website was under construction, it displayed the infringing sign and thus led users to believe that it offered products and services relating to mobile telephony, with the likelihood of confusion with the products and services identified by the plaintiff's trademarks that this entailed;
- The cancellation of the domain name is not a disproportionate measure for avoiding the repetition of infringing conduct; and
- The fact that the defendant renewed the domain name and replied to the plaintiff's cease and desist letter by stating that any change would require an offer of financial compensation to be made shows that this is a “speculative”

domain name aimed solely at claiming monetary compensation from the trademark holder if that party requests its transfer.

Fourthly, the court refers to the registration and use of the company name Orange Mobile, S.L. and denies that it is being used solely for legal purposes and not in the course of the defendant's activities in the marketplace, insofar as:

- The defendant's website reveals that that party is using its company name to identify itself in trade (leaving out the letters “S.L.”);
- A figurative sign that coincides with the company name is used on the website;
- The defendant (under its company name) appears among the results of searches for mobile telephone establishments conducted on third party search engines; and
- The defendant's use of the company name is not made in accordance with honest practices in industrial or commercial practices: (i) the use of the company name Orange Mobile, S.L. denotes a link between the goods and services marketed by the appellant and those identified by the plaintiff's trademarks; (ii) the defendant could not ignore the fact that such a link could be established on the basis of that company name; and (iii) the connection between the company name and the plaintiff's marks is accentuated due to the latter's well-known character.

The judgment considers unquestionable the similarity between the ORANGE trademarks and the sign “ORANGE MOBILE” of the defendant, where “MOBILE” is a weak element that alludes to mobile telephony.

The Court considers that the use of the defendant's domain name in the course of trade constitutes an infringement of the earlier trademarks and that the registration makes such use possible, and therefore orders the defendant to cancel the domain name.

As for the adoption and use of the company name ORANGE MOBILE, S.L., the judgment considers, in accordance with the case law, that, although it does not use the sign directly on the products, the use of the company name generates a link between its products and the trademarks and name of the plaintiff.

Finally, the judgment establishes a compensation for damages of 1% of the turnover of the last five years to be settled at the time of execution of the judgment.



1. Case topic	Likelihood of confusion. Possibility of trademark infringement in cases where the similarity is only visual	
2. Country	Spain	
3. Case citation (Title, Court and Case No.)	Judgment No. 163/19 of the Provincial Court of Alicante. "BEEFEATER" (Allied Domecq Spirits & Wine Limited and Pernod Ricard España, S.A.) vs. "SOTA DE BASTOS" (Araba Foods 21, S.L.)	
4. Date of order or judgment	18 February 2019	
5. Type of infringing goods (categories)	Alcoholic beverages; gin	
6. Parties		
	Right Holder (Plaintiff)	Allied Domecq Spirits and Pernod Ricard España, S.A.
	Infringer (Defendant)	Araba Foods 21, S.L.
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark

8. Outline (summary) of the case

Allied Domecq Spirits & Wine Limited ("Allied") is the owner of the European Union (EU) trademarks "BEEFEATER", including figurative marks and the bottle as a three-dimensional mark for class 33, to which it claims reputation. Pernod Ricard España, S.A. ("Pernod"), is the distributor in Spain of "BEEFEATER" brand gin bottles.

As of 2016, the defendant Araba Foods 21, S.L. ("Araba") has been marketing bottles of "SOTA DE BASTOS" gin and offers on its website www.arabafoods.com the referred bottles that have a similar external appearance to "BEEFEATER" bottles.

Allied and Pernod filed an infringement action against Araba before the Commercial Court No. 1 of Alicante, in its capacity as European Union Trademark Court.

Allied brought two combined actions:

- 1) action for infringement of the aforementioned EU trademarks against Araba for likelihood of confusion and association and for enhanced protection of reputed trademarks;
- 2) invalidity action against Araba, owner of the Spanish trademark "SOTA DE BASTOS", for being incompatible with Allied's earlier trademarks.

The lower court decision partially upheld the action.

Allied and Pernod filed an appeal to the Provincial Court of Alicante against this judgment, the main allegations of which are: (i) error in the assessment of the evidence regarding the infringement of EU trademarks, acts of unfair competition and invalidity of the Spanish trademark "BEEFEATER"; and (ii) error in the determination of the compensation for loss of profits, acts of unfair competition and consequential damages.

The Court of Appeal (Provincial Court of Alicante) established that the sign used by Araba and the bottle marketed by this company together evoke a link or connection with Allied's trademarks and the bottle of gin distributed by Pernod.

The Court further considers that in this case the elements characterizing the risk of a possible unfair advantage of the distinctive character or reputation of the earlier mark are met, namely:

- (i) Allied's marks are reputed;

- (ii) from the market survey provided with the complaint, it can be deduced the high degree of knowledge by the target public of the most relevant characteristics of the trademarks and of the plaintiffs' bottle;

- (iii) there is a high degree of similarity between the signs due to the high number of coincidences and the overall visual impact;

- (iv) the goods are identical, in both cases, they are bottles containing gin.



On this basis, it concludes that the use of the graphic signs by Araba and the whole bottle marketed by it are intended to attract the consumer's attention in view of the reputation, fame and prestige of Allied's trademarks and the bottle marketed by Pernod, of which Araba takes undue advantage to obtain a commercial advantage without offering any economic compensation in return.

The Court concludes that the similar visual impact of the graphic element of the conflicting signs as a whole prevails over the different verbal element and the different figure of the character represented in both signs, especially when the infringing ground is based on the enhanced protection of the reputed marks, which only requires the existence of a link, connection or association and not a direct confusion.

The judgment is relevant because important conclusions can be drawn from it:

- Firstly, it highlights the possibility of trademark infringement in cases where there is no phonetic similarity, but only graphic similarity.
- Secondly, because it clarifies that, in the case of well-known trademarks, an infringement does not require the existence of a likelihood of confusion between the two signs, but neither is the mere risk of association sufficient, but rather the concurrence of one of the following three circumstances is required: (i) the detriment caused to the distinctive character of the earlier mark (dilution); (ii) the detriment caused to the reputation of said mark (degradation) and; (iii) the unfair advantage obtained from the distinctive character or reputation of said mark (parasitism).
- Likewise, it states that factors such as price, quality and points of sale are irrelevant in terms of trademark infringement when assessing the likelihood of confusion and is of the opinion that a lower price makes even more evident the concurrence of the requirements of dilution, degradation and parasitism.



1. Case topic		Infringement of the trademark online. Risk of confusion and association. Enhanced protection of the reputed trademark.	
2. Country		Spain	
3. Case citation (Title, Court and Case No.)		Judgment of the Provincial Court of Alicante, no. 750/2020, of June 30, 2020	
4. Date of order or judgment		30 June 2020	
5. Type of infringing goods (categories)		Energy drinks	
6. Parties			
	Right Holder (Plaintiff)	MONSTER ENERGY COMPANY	
	Infringer (Defendant)	TIETZ BEVERAGE, SL and ROBOT ENERGY LIMITES	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
			

8. Outline (summary) of the case

The plaintiff filed an action before the Mercantile Court of Alicante, in its capacity as EUTM Court, requesting the cessation of the use of the defendants' trademarks and their cancellation from the Register (Spanish PTO). Among the requests made by the plaintiff is also the closure of the defendant's web pages and its profiles in social networks, in order to cease the use of the conflicting trademarks by the defendant on the Internet.

The action was dismissed at first instance, so the plaintiff filed an appeal before the Provincial Court of Alicante.

On the one hand, the appeal court considers the reputation of the earlier trademarks to be proven, understanding that the set of documents and material provided by the plaintiff is sufficient to demonstrate that the trademarks are known to a significant part of the target public of the product (energy drinks). The factors that the court values to reach such conclusion are the great economic effort made by the plaintiff through sponsorship or collaboration in events of great relevance, the active presence in social networks, which demonstrate the interest that the plaintiff and its trademarks produce in Internet users, the relevant volume of sales and the good positioning in the Spanish market and the advertising and investment necessary to achieve all those commercial objectives.

On the other hand, and as far as the comparison of the trademarks is concerned, the appeal court concludes that there is a similarity between the trademarks, since there are coincidences in the structure and composition of the signs, in a part of their word elements and in the color, being those coincidences more than enough to conclude that there is a similarity or resemblance between the trademarks.

The court considers that there is a risk of evocation, given the similarity of the signs and the coincidence of the goods, thus there is a possibility that the consumer mentally associates, in a wrong way, the later mark with the earlier mark.

The appeal court concluded that the use made by the defendant of its trademarks is unfair, since it has the purpose of taking advantage of the reputation of the earlier trademarks, without providing the owner of the earlier trademark with any economic compensation and without having had to make a relevant investment to create and promote its trademark, maintain it in the market and make it known to the relevant public.

The appeal court partially upholds the appeal and agrees as follows:

- 1) Declares that the advertising of the product H HYBRID ENERGY through the web pages www.robotenergy.com and www.hybridrinks.com, and the accounts of ROBOT ENERGY LIMITED on Facebook and Twitter, constitute an infringement of the exclusive rights conferred to MONSTER by its earlier EUTM.
- 2) Consequently, the defendants are ordered to cease the use of the conflicting marks and refrain in the future from infringing the plaintiff's earlier trademark, and in particular to cease advertising the energy drink "H HYBRID ENERGY" on the websites www.robotenergy.com, www.hybridrinks.com and the accounts of ROBOT ENERGY LIMITED on Facebook and Twitter.
- 3) The Spanish trademarks no. 3.601.453 and no. 3.634.343 owned by the defendant are declared null and void, for having been registered in bad faith, ordering their cancellation.

7. United Kingdom Case 1



1. Case topic		Trademark infringement	
2. Country		United Kingdom	
3. Case citation (Title, Court and Case No.)		Interflora Inc v Marks & Spencer Plc ([2014] EWCA Civ 1403)	
4. Date of order or judgment		2014-11-05	
5. Type of infringing goods (categories)		Adwords/metatags used for advertising purposes	
6. Parties			
	Right Holder (Plaintiff)	Interflora	
	Infringer (Defendant)	Marks and Spencer	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		Interflora	Interflora (used as a metatag)

8. Outline (summary) of the case

This was a dispute between Interflora and Marks & Spencer (M&S) over the latter's use of the term 'interflora' as an AdWord to advertise its own flower business. Using a third parties' trade mark as a keyword in an advert can constitute a trade mark infringement but, after the decision in *Interflora v Marks & Spencer* [2009] EQHC 1095, a rights holder can only take action in limited circumstances:

The ECJ held that purchasing a keyword which is another parties' trade mark does constitute "use in the course of trade" of that trade mark.

A trade mark owner can, however, only object to the advertiser's use of the keyword if: (i) internet users may erroneously perceive it as emanating from the proprietor of the trade mark; (ii) it suggests an economic link between the advertiser and the trade mark proprietor; or (iii) where a user would be unable to determine whether the advertiser is linked to the trade mark proprietor or not.

In the UK High Court decision (following the ECJ ruling), the judge held that the onus of proof was on the advertiser to show that the use of the infringing sign in context was sufficiently clear that there was no risk of confusion on the part of the average consumer (i.e. the burden of proof had been reversed). However, this was rejected by the Court of Appeal so now the test is simply one of whether there is a likelihood of confusion.

7. United Kingdom

Case **2**



1. Case topic	Infringement dealing with Counterfeit Goods (bootleg recordings of well known bands) [criminal offence]	
2. Country	UK	
3. Case citation (Title, Court and Case No.)	Regina v Johnstone, SESSION 2002-03 [2003] UKHL 28 on appeal from: [2002] EWCA Crim 194, 2003 WL 21047526	
4. Date of order or judgment	2003-05-22	
5. Type of infringing goods (categories)	For having a number of unauthorised CD recordings of performances by well-known artists. The discs were marked with the names of certain bands which had been registered as trade marks.	
6. Parties		
	Right Holder (Plaintiff)	The Crown
	Infringer (Defendant)	Johnstone (Robert Alexander)
7. Mark	Inclusion on CD labels of Bon Jovi (count 1), U2 in the case of count 2, Rolling Stones in the case of count 3, and so on	

8. Outline (summary) of the case

The case concerns the use, in connection with 'bootleg' compact discs, of the criminal sanctions contained in the trade marks legislation.

Questions about trade marks arise in this context in the following way. When sold to the public each of these compact discs bears, in the usual manner, the name of the performer whose performance is recorded on the disc: Rolling Stones, or Beatles, or whoever it may be. This name also appears on the accompanying paperwork inside the disc's case. Nowadays leading performers register their professional names as trade marks in respect of recordings. So, it is said, sales of the discs labelled in this way constitute infringements of the performers' registered trade marks.

Mr Robert Johnstone's bootlegging activities only became known because of a misdirected parcel containing 519 compact discs and associated artwork. Further compact discs and audio cassettes were seized during the search of Mr Johnstone's home.

The defendant was charged and convicted under the criminal provisions of the Trade Mark Act 1994 (section 92) of producing counterfeit CDs [Judgement 31 January 2002] as labels on CDs included the names of well-known performers who had trade mark registrations for their names covering such goods.

He argued that the affixing of the name of the artist to the CD was not a trade mark use, and that the prosecution had first to establish a civil offence before his act could become criminal.

The prosecutor appealed the decision of the Court of Appeal which overturned the conviction, holding that Section 92 was designed to avoid the defence of describing goods as 'genuine fakes', but the offence must also amount to civil infringement to be caught by this section (i.e. where the offending sign had been used as an indication of trade origin).

This was upheld by the House of Lords (the highest court at the time, now called the UK Supreme Court).

The House of Lords confirmed that, in order to be convicted of a criminal offence under section 92, the offender's act must also amount to civil trade mark infringement.

The defendant argued successfully that he was using the performers' names not as an indication of trade origin but merely to indicate who the performers were - this was descriptive use and did not amount to trade mark infringement. If the name of the artist affixed to the disc or its packaging was exclusively an indication of the name of the performer whose performance was recorded on the disc, and if that use of the name was not likely to be understood as indicating any other connection between the performer and the disc, then such use would be descriptive only.

It is often more appropriate to deal with cases concerning bootleg CDs under the criminal provisions of the Copyright, Designs and Patents Act 1988.



1. Case topic		Passing off - case 2	
2. Country		UK	
3. Case citation (Title, Court and Case No.)		Claire Stone v Alexandra Wenman [2021] EWHC 2546 (IPEC)	
4. Date of order or judgment		2021-09-22	
5. Type of infringing goods (categories)		Training / coaching services	
6. Parties			
	Right Holder (Plaintiff)	Claire Stone	
	Infringer (Defendant)	Alexandra Wenman	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		ARCHANGEL ALCHEMY	The Archangel Alchemist Archangel Alchemy

8. Outline (summary) of the case

The case concerned a dispute between two spiritual and holistic therapists over use of the trade mark "ARCHANGEL ALCHEMY" to sell metaphysical/spiritual education and coaching courses.

The claimant owned a UK trade mark registration for the word mark ARCHANGEL ALCHEMY filed on 3 October 2019 for various holistic training services class 41. The claimant had started using the mark earlier in 2019 when she began promoting an online training course under the mark. In February 2020, the claimant became aware that the defendant had begun promoting a course using the same sign on website / social media in Autumn 2019.

The claimant alleged infringement of her registered trade mark through use by the defendant of an identical sign for identical services (a "double identity" claim under section 10(1) Trade Marks Act 1994 ("TMA")).

The defendant claimed earlier use of "The Archangel Alchemist" and "Archangel Alchemy" (in relation to herself and her business) dating back to 2010, and goodwill in those names. The defendant's case was that the claimant's trade mark registration was invalid under section 5(4) TMA because use of the mark was liable to be prevented by the law of passing off. The defendant counterclaimed for passing off and declaration of invalidity of the claimant's trade mark.

The dispute at trial was whether the defendant had sufficient goodwill in her signs "The Archangel Alchemist" and "Archangel Alchemy" and could show misrepresentation by the claimant through the use of the claimant's trade mark to defend the infringement claim on the basis of an earlier right under the law of passing off. The classic test for passing off requires: (1)

goodwill in the relevant signs; (2) misrepresentation; and (3) damage.

This case predominantly considered the "goodwill" element of the test. In assessing the defendant's use of her signs, the court bore in mind that reputation on a relatively small scale would still attract the protection of a claim in passing off, though this would be subject to a de minimis threshold; a claim in passing off could therefore not be sustained to protect goodwill that any reasonable person would consider to be trivial.



The evidence showed that the defendant's actual use of the signs in relation to her services was not consistent or extensive. However, the judge said it was hard to see how the claimant could not have found the defendant had she searched the name prior to filing her trade mark application. The defendant was able to rely on key witness statements from her clients who firmly associated "Archangel Alchemy" with the defendant. The Judge held that subjective evidence from a customer about the defendant's use of the her signs was valuable evidence of reputation, or "that attractive force that brings in custom", namely goodwill.

The court found that the defendant's use of her marks prior to September 2019 (the date when the claimant started using ARCHANGEL ALCHEMY) was more than trivial and had generated sufficient actual goodwill to be capable of damage by reason of a misrepresentation. Therefore the claimant's trade mark was declared invalid as it was held that the claimant did not have the right to register it in the first place. The counterclaim for passing off succeeded and the claimant ended up being liable.

7. United Kingdom

Case **4**



1. Case topic	Passing Off (case 1)	
2. Country	UK	
3. Case citation (Title, Court and Case No.)	Reckitt & Colman Products Limited v Borden Inc. & ORS [1990] RPC 341, 406	
4. Date of order or judgment	1990-10-25	
5. Type of infringing goods (categories)	Food packaging	
6. Parties		
	Right Holder (Plaintiff)	Reckitt & Colman Products Limited
	Infringer (Defendant)	Borden Inc. & ORS
7. Mark	Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		

8. Outline (summary) of the case

This case is widely referred to in UK trade mark text books and amongst practitioners as the “JIF Lemon” case. This is a leading decision on the common law tort of passing off, which means, in general terms, that no person may pass off his goods as those of another. The tort is similar to the law of unfair competition, which exists in some other territories, but it has a narrower application.



The claimant sold lemon juice in plastic containers that resembled the shape, size and colour of natural lemons under the brand name “JIF”. The defendant adopted a similar squeezezy plastic container for its own lemon juice (as shown above). The claimant sued the defendant for passing off its product as “JIF” lemon juice. The case went all the way to the UK’s highest court, then known as the House of Lords (now the UK Supreme Court). The Court reaffirmed the three-limb test for passing off, known as the “classical trinity”, which a claimant must prove in order to succeed in an action:

- (1) there is a goodwill or reputation attached to the goods supplied by the claimant in the mind of the public by association with their identifying get-up;
- (2) there is a misrepresentation to the public likely to lead the public to believe that the goods/services offered by the defendant were the goods/services of the claimant; and
- (3) the claimant suffers or is likely to suffer damage as a result of the defendant’s misrepresentation.

The court found that in using plastic lemons that were very similar to the claimant’s, the defendant had passed off its lemon juice as the claimant’s. This was because the claimant succeeded in demonstrating to the Court that it had persuaded the public that lemon juice sold in plastic containers resembling natural lemons had been manufactured by it.

7. United Kingdom Case 5



1. Case topic		Trademark infringement (use of marks in unofficial merchandise)	
2. Country		United Kingdom	
3. Case citation (Title, Court and Case No.)		Arsenal Football Club Plc v Reed (No.2) [2003] 2 CMLR 25 (Court of Appeal)	
4. Date of order or judgment		2003-05-21	
5. Type of infringing goods (categories)		Class 25	
6. Parties			
	Right Holder (Plaintiff)	Arsenal Football Club Plc	
	Infringer (Defendant)	Matthew Reed	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		'ARSENAL' word mark and the following device marks:  	[No graphics provided in judgment but defendant used identical signs to Arsenal's registered device and word marks]

8. Outline (summary) of the case

Defendant (Mr Reed) sold unofficial merchandise including hats and scarves which bore words and devices that were similar to the Arsenal marks. Arsenal commenced proceedings against Mr Reed for passing off and trade mark infringement.

The High Court judge held that Mr Reed was not guilty of passing off because there was no evidence of purchasers being confused as to the origin of the goods. On the issue of trade mark infringement, the judge held that the use of Arsenal logos on the goods was merely a badge of allegiance/affiliation to the football club.

When this matter was referred to the ECJ, the ECJ held that where a third party uses in the course of trade a sign which is identical to a registered trade mark on good which are identical to the registration, the trade mark proprietor is entitled to prevent use of that mark by the third party. It is immaterial that the third party's use of the mark is perceived as a badge of support or loyalty to the trade mark proprietor.

However, the High Court held that the ECJ had exceeded its jurisdiction when handing down its ruling with reference to the factual circumstances of the case, as the ECJ is not entitled to determine issues of fact on a reference from a national court. Accordingly, the High Court disregarded the ECJ ruling and found in favour of Mr Reed.

The Court of Appeal overturned the High Court's decision, taking the view that the judge should have followed the ECJ's view. Further, whilst Mr Reed's use of the marks can be considered to be badges of allegiance, trade marks also designate origin of the goods to a substantial number of consumers. It was accepted that Mr Reed did differentiate his goods from official Arsenal goods, but his goods were ultimately marked with identical Arsenal marks and therefore his use of the word 'Arsenal' would, absent any explanation, carry the same inference as similar to use of the trade mark by Arsenal. Consequently, Mr Reed had infringed Arsenal's trade mark.



1. Case topic		Trademark infringement (unfair advantage, comparative advertising)	
2. Country		United Kingdom	
3. Case citation (Title, Court and Case No.)		L'Oreal SA v Bellure NV [2010] EWCA Civ 545 (Court of Appeal)	
4. Date of order or judgment		2010-05-21	
5. Type of infringing goods (categories)		Class 3	
6. Parties			
	Right Holder (Plaintiff)	L'Oreal SA	
	Infringer (Defendant)	Bellure NV	
7. Mark		Examples of Infringed (Plaintiff's) Trademark	Examples of Infringing (Defendant's) Trademark
		Various of L'Oreal's marks including those for the brands Trésor, Lancôme, Miracle, Anaïs Anaïs and Noa.	[graphic display of defendant's infringement not available in judgment]

8. Outline (summary) of the case

The claimant (L'Oreal) produces fragrances and owns well-known trade marks in the UK. The defendant (Bellure) marketed imitation fragrances and provided comparison lists to their retailers which indicated which of their range of products smelled like each of L'Oreal's products. L'Oreal claimed that this comparison list infringed its marks under s.10(1) TMA 1994, and that Bellure's bottles and packaging infringed its marks under s.10(3) TMA 1994.

The Court of Appeal stayed proceedings and referred 5 questions to the ECJ concerning interpretation of the equivalent of the Trade Marks Directive, namely Articles 5(1) and 5(2). The ECJ's preliminary ruling can be found at Case C-487/07 (European Court of Justice - First Chamber).

Question 1: *If a trader uses a competitor trade mark to advertise his own goods/services for the purposes of comparing characteristics of the goods/services, in such a way as not to cause confusion or jeopardise the function of the mark as an indication of origin, does this fall within Article 5(1)?*

Question 2: *If a trader uses in the course of trade a well-known registered trade mark for the purpose of indicating a characteristic of his own product in such a way that does not cause likelihood of confusion, does not affect sale of products under well-known mark, does not jeopardise function of mark as indication of origin, does not harm reputation of registered mark, and plays a significant role in promotion of that trader's product, does this fall within Article 5(1)?*

Answering questions 1 and 2 together, the ECJ held that comparison lists may constitute trade mark infringements under Article 5. However, the proprietor of the registered trade mark is not entitled to prevent use of the mark if the comparison lists/comparative advertisements comply with all the conditions in Article 3a(1) of the Comparative Advertising Directive (Directive 84/450), under which comparative advertising is permitted. The ECJ concluded that the trade mark proprietor is entitled to prevent use of its mark in a comparative advertisement that does not satisfy these Article 3a(1) conditions, even where such use is not capable of jeopardising the essential function of the mark, provided one of the mark's other functions is affected/likely to be affected.

Question 3: *In the context of Article 3a(1)(g) of the Comparative Advertising Directive, what is the meaning of 'take unfair advantage of'? By comparing a trader's product against a product under a well-known mark, does this amount to taking unfair advantage of the reputation of the well-known mark?*

Question 4: *In the context of Article 3a(1)(h) of the Comparative Advertising Directive, what does it mean to 'present goods or services as imitations or replicas'? Does this cover situations where the trader truthfully states that a product has major characteristics similar to a well-known product which is protected by a trade mark?*

Answering questions 3 and 4 together, the ECJ held that 'unfair advantage' has the same interpretation as Article 5(2) of the Trade Marks Directive. Further, the Comparative Advertising Directive allows objective comparisons which highlight differences between products, so long as the object or effect of such highlighting is not to give rise to situations of unfair competition.

Question 5: *Where a trader uses a sign similar to a registered mark which has a reputation, and that sign is not confusingly similar to the trademark in such a way that impairs the essential function of the mark as providing a guarantee of origin, tarnishes the registered mark's reputation, impairs the proprietor's sales, deprives the proprietor of any reward of his mark, but where the trader gets a commercial advantage from use of his sign by reason of similarity to the registered mark, does this amount to taking 'unfair advantage' of the reputation of the mark within the meaning of Article 5(2) of the Trade Marks Directive?*

The ECJ held that it is not necessary to show detriment to the distinctive character or reputation of the mark for there to be unfair advantage. It is sufficient that advantage is taken by a third party as a consequence of using the identical/similar sign. A global assessment should be carried out, taking into account all relevant circumstances of the case, to determine whether the trader's use of the sign takes unfair advantage of the registered mark. Relevant factors to this global assessment include the strength of the mark's reputation, the degree of distinctive character of the mark, the degree of similarity between the marks at issue, and the degree of proximity of the goods/services concerned.

Based on the ECJ's ruling, the Court of Appeal held that Bellure's use of comparison lists infringed L'Oreal's registered marks. Bellure had obtained major promotional advantage from using such lists. Bellure's comparative advertisement failed to comply with Article 3a(1) of the Comparative Advertising Directive. Bellure had attempted, through the use of a sign similar to L'Oreal's marks, to ride on the coat-tails of L'Oreal's marks - this amounted to unfair advantage giving rise to a trade mark infringement.