

Patents

Unified Patent Court

Twenty-four members of the European Union signed the international agreement for establishing the Unified Patent Court (UPC) on February 19, 2013. Bulgaria did also last March 5 but Poland and Spain have not already signed, even though they can accede at the agreement at a later date. The new court will avoid the occurrence of multiple Law-suits with regard to the same patent infringement in different member states. Nowadays, national courts and authorities of the contracting states of the European Patent Convention are competent to decide on the infringement and validity of European patents giving rise to a number of difficulties when a patent proprietor wishes to enforce a European patent in several countries. The new Court will reduce costs of patent litigation and well as avoid contradictory and diverging decisions ruled on same issues. The UPC will be a court common to the contracting member states and consequently subject to the same obligations under Union law as any national court. However the new system still has many doubts regarding costs, effectiveness, accessibility and uniqueness.

Design Infringement

Famous Spanish film producer found liable of Community Design infringement in film promotion

"Torrente 4 Lethal Crisis" was the fourth part of the famous Spanish saga "Torrente", a story of a corrupt former policeman, which achieved number one in audience ranking in 2011 (about 20 mill. euros turnover). Last week, the Community Trademark and Design Court of Alicante No. 2 has found the company Amiguetes Entertainment, S.L. (the producer) liable of the violation of a registered Community Design for a particular T-Shirt consisting of the drawing of a gun, used as icon to promote the film before the premier. Producer will have to pay now 1% of the profits made by the film as compensation for damages, in addition to other sums. The Court found that the differences existing between the designs were not relevant enough to produce a different impression. The producer was not the only one defendant, Coca Cola Spain and Telepizza were also sued since the T-Shirt was sold along with their own products during the promotional weeks of the film. According the Court, none of them can be considered responsible of the first commercialization, so they don't have an objective liability. Notwithstanding, the fourth defendant was the manufacturer of the infringing T-Shirts, has also been considered liable of the violation, and will have to pay damages in accordance to the economic volume of the services contract executed.

More information [click here](#)



Domain Names

Trademark Clearing House

The new domain names gTLDs also called "trademark domain" are very closed to become active. Under this category, it will be possible to apply for domain names identical to registered trademarks and also to generic names such as lawyers. In order to enhance the protection of the owners of registered rights, the ICANN has established a trademark database called Trademark Clearing House (TMCH). The main role of TMCH is to include all registered trademarks, regardless the country in which they are protected, in order to avoid that any third party attempts to register the domain name that matches up with a trademark existing in the TMCH. The owners who register their marks in the TMCH will benefit from the watching system enabling them to take the necessary legal actions against infringers.



Internal Abril

Colaboraciones

LEXOLOGY Abril Abogados collaborates with the prestigious publication Lexology submitting news and articles related to Intellectual Property and Copyright www.lexology.com

Rankings

Managing Intellectual Property **World Trademark Review** The renowned and distinguished publications Managing Intellectual Property and World Trademark Review have published the new world ranking regarding IP firms and attorneys and Abril Abogados has been once again included, even improving its former position. [Access to publication](#)

Congresos: INTA

Abril Abogados will be represented at INTA by Ignacio Temiño, Carlos Gonzalez and Carolina Montero at the Annual Meeting that will take place in Dallas from May 4th to 8th, 2013



Customs

EU Customs Action Plan to combat IPR infringements

The European Commission and the EU Member States are active to ensure a proper enforcement of Intellectual Property rights (IPR) at the external border. On 10 December 2012 the Council adopted a Resolution on the EU Customs Action Plan to Combat IPR Infringements for the years 2013-2017. The strategic objectives of this Action Plan are the following:

- Effectively implementing and monitoring the new EU legislation on customs enforcement of IPR.
- Tackling major trends in trade of IPR infringing goods.
- Tackling trade of IPR infringing goods throughout the international supply chain.
- Strengthening cooperation with the European



Observatory and law enforcement authorities on infringements of IPRs.

Among the implementing measures, the most significant are: the development of guidelines for right owners and custom officials, promotion of meetings between custom authorities and IP rights holders, exchange of information regarding fighting methods and obtained results regarding infringement in Internet, reinforcing the collaboration between community and third countries customs... To sum up, this new Plan enlarges the former one but bearing in mind the current context of economic crisis we would have appreciated a lesser bureaucracy in order to reduce costs.

[Access to publication](#)

Copyright

Moral right integrity of a sculpture work

Our copyright law recognizes the author, amongst other moral rights, the right to demand respect for the integrity of the work and to prevent any deformation, modification, alteration or attack against it that would prejudice his legitimate interests or threaten his reputation. However, does this right includes the location of the work itself? Should it prevail before others? These questions have been answered by the recent Judgment of 18 January 2013 issued by the Plenary of the judges of the Civil Chamber of the Supreme Court, when the renowned sculptor Andrés Nagel sued the city hall of the Spanish city of Amorebieta when the latter decided to move a work of art from its initial placement. However the Supreme Court has concluded that not every change in the location of a work automatically produces an infringement of author's moral right to the integrity of his work, but only when the new placement affects the dialogue between the author and the public through the work of art. Anyhow, our Supreme Court tries to balance the author's right and those others affected (in this case, the general public interest) and then concludes that even if the latter shall prevail, the author must be compensated for the suffered damages

More information [click here](#)



The European Commission intends to harmonize copyright levies

In the attempt of the European Commission to harmonize a single market for Intellectual Property Rights, António Vitorino, a former European Commissioner responsible for Justice and Home Affairs, has launched a mediation process on private copying and reprography levies in the European Union. In his recommendations the mediator only foresees a system where the obligation to pay the levy is limited to those devices for the storage and reproduction of contents. However, in Spain by the end of the year 2011 the existent copyright levy was amended. The former one was applied to all storage and reproduction devices subject to be protected by copyright whereas the current one consists in a compensation at the end of the year through an asset foreseen in the General State Budget, however this regulation has produced a significant decrease in the collected amount. According to the Spanish Government, this system is transitory until the European Union clarifies this matter.



More information [click here](#)

¡Curiosities!

A Seattle bar prohibits Google glass

A US bar has been the first to ban in its facilities the use of the augmented reality glasses from Google, colloquially known as Google Glass, even if they are not already available in trade. The bar owner has declared that "People come and do not want to be recognized ... and definitely do not want to be recorded secretly to upload the video to the Internet". Up to date these are not prescription glasses, however it may soon collide the right of users to wear such spectacles and the copyrights of cinemas, museums and theatres.



3D printing machines

The most recent technological developments allow the average consumer to obtain a 3D printing machine for 1000 Euros. 3D printing is a process of making three dimensional solid objects. Hence the user having a 3D printing will be able to easily manufacture products at home. However this will entail a new controversy among IP right holders bearing in mind that users can manufacture any good protected under registered design or patent rights.

[Click to watch printing 3D video](#)

Piracy

Convention on the counterfeiting medical products



The Spanish Government has moved on and requested the approval of the Parliament of the so called 211 Convention performed by the European Council. This Convention intends to remove from trade any counterfeiting medical and sanitary product not only for infringing Intellectual Property rights

but also for endangering public health. The main goal is to prepare an international instrument which is based on the aspects linked to prevention, protection of victims and criminal law in combating all forms of counterfeiting of medical products and similar crimes involving threats to public health. For this purpose, the close collaboration between member states and the adoption of new policies is encouraged

Data Protection

Publication of fraudster data

The Spanish Government intends to amend the Tax Law in order to make possible the publication of the most relevant fraudsters' data. Regardless of the fact that such measure can be dissuasive, attention should be paid on whether it can affect other laws. Indeed this kind of publications entails the communication of personal data which is regulated by the Data Protection Act and according to it, such information can only be disclosed under the conditions foreseen in the Act. Of course, one of those conditions is that such disclosure is authorized by any other Act

Apple

Apple obtains registration for its stores

Apple obtained a US registration for the design of its retail stores. The trademark application was initially refused due to its lack of inherent distinctiveness, since the Examiners of the USPTO considered that the three-dimensional configuration the application consists of would not be perceived as a mark, but only as decoration or ornamentation by the average consumer. Therefore, in order to overcome such refusal Apple claimed that the mark had acquired distinctiveness through its intensive use in the course of trade for which purpose it submitted declarations describing the success of Apple's retail stores, consumer awareness of the store configuration trade dress, promotional materials, images, articles, web pages, and consumer surveys in order to demonstrate the United States awareness of the Apple retail stores



Samsung vs Apple

Within the frame of the worldwide litigation between these companies regarding the possible infringement of Apple's registered design by Samsung when commercializing the Galaxy Tab, the Community Trademark Court of Alicante has uphold the appeal filed by Samsung requesting the suspension of the proceeding until a decision will be ruled by the OHIM.



OMPI

Omán y Siria vs Israel



Even though Israel joined the Madrid Protocol on 2010, Oman and Syria's Trademark offices are rejecting all the International Trademarks designating Israel alleging

reasons of "public interest". Consequently, Israel has confirmed that a total reciprocity will be adopted. Therefore, International Trademark applications cannot simultaneously designate Oman and/or Syria together with Israel and should rather file a national application for one of those countries.

OAMI

Croacia

On July 1st 2013 the European Union will be enlarged due to the accession of Croatia. Therefore protection of all Community Trademarks and Designs will automatically be extended to this country. In addition to this, the exceptional right of opposition will also exist in this occasion, Community Trademark applications filed between January 1st and June 30th 2013 can be subject to oppositions based on earlier rights in Croatia



Collective Trademarks

BARCELONA fully rejected

The Spanish collective trademark "BARCELONA" applied for all 45 classes in the name of the City Council of Barcelona has been rejected by the Spanish Patent and Trademark Office (SPTO) incurring in Absolute Grounds of refusal. However, it is curious to note that such examination was only conducted after third interested parties appeal was filed against its granting decision since the SPTO did not perform any ex officio.

To put everybody in the picture, we should remember that a collective mark is such when the mark is capable of distinguishing the goods or services of the members of the association which is the proprietor of the mark from those of other undertakings. The applicant for a collective mark must submit regulations governing its use specifying the persons authorized to use the mark, the conditions of membership of the association and the conditions of use of the mark. The appellant alleged that according to Article 5. 1 g) of the Spanish Trademark Act 17/2001 of December 20, 2001 "Signs which may deceive the public for instance as to the nature, quality or geographical origin of the goods and services" shall not be registered. The appeal was upheld for two different reasons based on this Article.

Firstly, as far as the misleading character of the contested collective mark is concerned, the Regulation of Use indicates who is authorized to use this mark requiring a link with the city of Barcelona or with its metropolitan area, thus excluding the whole province of Barcelona. Therefore, it is extremely deceive since it does not allow its use to those persons and/or undertakings associated to the province, limiting its use only for the city of Barcelona, not complying with the provisions of the above cited Article.

Secondly, Article 64 of the Spanish TM Act ruling collective trademarks establishes that "An application for a collective mark shall also be rejected where it may mislead the public as to the character or significance of the mark, in particular where it may give the impression that it is something other than a collective mark". It should be noted that collective marks, as well as certification marks, are used by the companies upon authorization of their owners, as a second mark juxtaposed to the "house mark". However the use of the geographic term "BARCELONA" without any other distinctive character juxtaposed to the trademark of a company will be perceived by the average consumer as a mere indication of the location, an address or a post code, incurring therefore in the prohibition foreseen in Article 64.2.



In addition to the above mentioned, the here concerned trademark was applied for all 45 classes, seeking protection for any good or service distorting the nature and characteristics of a collective mark. The contested collective mark intending to protect all goods and services does not identify any characteristic product of a specific geographic area which is the main feature of collective marks. Thus the Regulation of Use of the collective mark "BARCELONA" pretends to establish a full control over the use of this mark, without promoting a specific product or service in the course of trade, but constituting a barrier for the entry of products and restricting free competition.

The appellant also alleged that the sign is devoid of any distinctive character and is a word of common use since there are at least 4000 earlier trademarks containing the term "BARCELONA". A collective mark is used to identify the goods and services of the members of the association, which is the owner of the mark, from those of other undertakings. In the here concerned case, being the applicant a public entity, only those goods and services authorized by the City Council will be distinguished from those lacking of any authorization. However, this collective mark consists exclusively in the geographic term "BARCELONA" without any other additional and/or verbal element that will increase its distinctiveness, therefore as a single word mark it will be hardly perceived by users and consumers as a mark distinguishing the goods and products authorized by the City Council from those coming from other companies. Consequently, it will just be perceived as a mere indication of the address or post code of the undertaking but not as a collective mark due to the lack of its distinctive character. This sign cannot serve to distinguish in the course of trade the products authorized by the City Council from those non authorized.

There is a large number of collective and certification marks owned by public entities including geographic terms such as AVILA AUTENTICA (for different products), SAL MARINA DE CANARIAS (for salt) or HORCHATA DE CHUFA (for a tiger nut milk-based beverage typical of Valencia). Notwithstanding, those marks have three common characteristics: The geographic term is always accompanied by additional characteristic elements.

The scope of protection of the collective mark is limited to determined goods and services.

The conditions of use are clearly established in the regulations.

Notwithstanding, bearing in mind that this collective mark exclusively consists in word mark, containing a geographic term of common use and does not specifically indicates which characteristic product or service is willing to be identified, the mark has been rejected in its entirety. This decision can only be appealed before the Spanish Courts.

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