Welcome to our IAG December 2016 Newsletter

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Welcome to the December edition of the International Associates Action Group Newsletter. We are still looking for contributors so please get in touch with me at david@gearhartlaw.com If interested in becoming an editor or just want to get involved in our Action group please do let myself or Cristina Guerra know. See you next Month!

Yours,

David Postolski

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Adidas Three-Stripe Trademark vs. Nike Blaugrana Stripes: Earn Your Stripes!

For more than one hundred years, generations of FC Barcelona fans have witnessed amazing players wearing the famous Blaugrana shirt with garnet and blue vertical stripes. Adidas’s three-stripe mark is also particularly well-known among professional soccer players, fans, and consumers of soccer apparel. Over the years, the German company made headlines for filing a number of lawsuits in connection with its famous trademark; and this time, it’s against Futbol Club Barcelona!

What’s the case all about?

It’s not a secret, with football kit partnerships large sums of money are involved. On October 30, 2016, FC Barcelona ratified the record-breaking 10-year Nike kit deal, which is worth up to 155 million Euro annually from 2018. And guess what, the day after (on October 31) Adidas filed its opposition with the U.S. Patent and Trademark Office (“USPTO”).

Coincidences of life or difference of opinion? Let’s take a closer look...

Adidas has been for years (and still is) one of the world’s leading manufacturers of athletic footwear, sportswear, and sporting equipment. According to the opposition document, over sixty years ago, German sportswear first placed three parallel stripes on its athletic shoes. Now, Adidas owns numerous federal trademark registrations for its (well-known) three-stripe mark.

In terms of U.S procedure, how does it work? Well, any entity that thinks it will be harmed by registration of a mark has thirty days from the day the mark is published in the Trademark Official Gazette in which to file an opposition (in our case, the mark was published on May 3, 2016). However, extensions of time may be granted, such as Adidas received.

What are the trademarks at issue?

FC Barcelona, founded in 1899, applied for a trademark (design only) described as follows: “The color(s) blue and garnet is/are claimed as a feature of the mark. The mark consists of a square containing seven vertical stripes. The 1st, 3rd, 5th and 7th stripes from the left are blue, and the remaining three stripes are garnet. The mark consists of a square containing seven vertical stripes. The 1st, 3rd, 5th and 7th stripes from the left are blue, and the remaining three stripes are garnet”.

In other words, it’s the classic and famous Blaugrana stripe motif for Barça shirt as Barcelona fans all over the world know it. It’s also the colors of the Blaugrana flags that are waved by the fans on match day at Camp Nou.

Adidas, created in 1924 (after Barcelona), began using the three-stripe mark on footwear at least as early as 1952, and as early as 1967 on apparel sold in the US and worldwide. According to the opposition document, the trademark is particularly well known among professional soccer players, fans and consumers of soccer apparel (for example, Adidas sponsors internationally famous soccer players, including Lionel Messi, Paul Pogba, and Gareth Bale) but also in connection with its frequent sponsorship of musical artists, pop stars (including Katy Perry, Selena Gomez, Pharrell Williams, and Kanye West).
What are the claims?

The German sportswear giant Adidas alleges that FC Barcelona’s pending application for registration should be denied for the following reasons:

Consumers familiar with Adidas are likely to assume that the footwear and apparel offered with the FC Barcelona trademark originate from the same source, or that they are affiliated, connected, or associated with Adidas.

Really? We are talking about shoes and sport wear with three stripes (mostly on the side of a sweater, jersey, or whatever) comparing to famous Blaugrana 7 stripes...

Barcelona’s trademark incorporates parallel stripes in a manner confusingly similar to Adidas’s mark in appearance and overall commercial impression.

Again, this argument is a bit odd. One could ask why is the trademark only confusingly similar today and why Barcelona has been waiting so long for registering the trademark?

The Class 25 and Class 28 goods identified in the application are identical and/or closely related to the goods and services Adidas long has offered in connection with the Three-Stripe Mark.

That’s a typical argument as, in trademark law, protection is only granted in relation to specific goods or services. Therefore, if your competitor is using the same Class and the same goods, then you might have a case.

Adidas also argues that Barcelona trademark is likely to cause confusion, deception, or mistake as to the affiliation, connection, or association with Adidas, with consequent injury to the German company’s reputation and the public.

It seems hard to argue that FB Barcelona fans have been confused with the kit from Nike that features wide, alternating blue-and-red stripes in deeper tones of the two colors, and suddenly believing that, in fact, it was made by Adidas because of the stripes.

Does anybody seriously believe that the relevant consumer will be confused between these two trademarks? There is no way in which Adidas having a monopoly on striped athletic footwear, sportswear, and sporting equipment can be of any benefit to anybody other than Adidas… It means that any company making any striped apparel now infringes Adidas’s trademark irrespective of the number of stripes used. An extensive monopoly of Adidas’s trademarks would definitely be incompatible with a system of undistorted competition, because it could have the effect of creating an unjustified competitive advantage for a single trader.

Last year, the shape of the shield/emblem (club badge) of the FC Barcelona football club, has been refused for registration (GC, 10 December 2015, Case T-615/14, Fútbol Club Barcelona / OHIM) because it lacks any “striking feature”. Whether the European soccer champions will also lose the famous Blaugrana trademark, that’s another question. Stay tuned!

Thomas Dubuisson, ULYS (Belgium, Brussels), thomas.dubuisson@ulys.net
The Supreme Court of Canada heard oral arguments on November 8, 2016 in an important appeal challenging the “promise of the patent” utility doctrine in Canada. In *AstraZeneca Canada Inc. v. Apotex Inc.* (Esomeprazole), Court File No. 36654, the Supreme Court is asked to decide on the question of whether the doctrine properly exists.

At issue is Canadian Patent No. 2,139,653 pertaining to esomeprazole, a compound which is used in reducing gastric acid. As of the filing date, the patentee had performed internal studies, but the drug had not yet been clinically proven in humans. The drug received market approval and became commercially successful. Nevertheless, in an action for impeachment, the Federal Court held the ’653 patent to be invalid on the basis that the patentee had not demonstrated or soundly predicted an improved therapy in patients at the filing date, which it found was promised in a statement on page 1 of the patent (2014 FC 638). The Federal Court of Appeal affirmed the holding (2015 FCA 158).

In the appeal to the Supreme Court, seven organizations were granted leave to intervene, namely the Intellectual Property Institute of Canada, the Intellectual Property Owners Association, the Fédération internationale des conseils en propriété intellectuelle, Innovative Medicines Canada and BIOTECanada (jointly), the Centre for Intellectual Property Policy, and the Canadian Generic Pharmaceutical Association.

The oral arguments started out with counsel for AstraZeneca discussing claim construction. In Canada, claims are construed purposively to determine the meaning of words in a claim and identify essential elements of the claim. Justice Abella asked how utility was measured. Counsel for AstraZeneca explained that if a claim recites a specific use, and the use is found to be an essential element, then that use must be delivered. If a use is not recited in a claim, then it is not an essential element and the claim merely needs to have some utility. Exemplary claims were claim 26 which recited use of omeprazole for gastric inhibition, and claim 8 which recited omeprazole.

Justice Brown asked when a court can look to the disclosure in construing the claims. Counsel for AstraZeneca answered that, while purposive construction focuses on the claims, it looks at the entire disclosure. Counsel for AstraZeneca later explained that focusing on the claims provides clarity to the public, apparently in reference to the notice function of claims.

Counsel for Apotex argued that the appeal should be limited to the issues that were argued in the courts below. Chief Justice McLachlin disagreed, indicating that where there is divergence in the law, the Supreme Court is free to clarify the law.

Next, counsel for Apotex argued that statements that AstraZeneca made in the patent about the problem that the invention solves cannot be ignored. Chief Justice McLachlin asked, “So if that statement is, let’s say, a bit extravagant, but the patent is nonetheless very useful – it cures the disease or provides relief – that extravagant statement will mean that this useful, novel, and in other respects totally compliant with the Patent Act patent fails, because of that one overstatement … isn’t that the logical conclusion of what you are putting forward?” Counsel for Apotex answered that it depends on the patent, and it could happen. Justice Karakatsanis echoed her question, asking about whether any invalid claims should not be severed from the valid claims. Counsel for Apotex answered the claims should not be severed in this matter. He argued that, while the claims define the monopoly of the invention, it is the description that defines the invention. In his view, the invention as disclosed in this matter included a promise that had to be met for the ’653 patent to be valid.
Overall, the Supreme Court appeared to be concerned that the promise doctrine was unworkable and severe. The Supreme Court reserved its decision. A decision from the Supreme Court in patent matters usually issues within 6 months. In the meantime, Applicants may consider reviewing the disclosure of their applications for any statements that may be interpreted as a promise of utility, with a view to possible amendment to soften such statements.

Jean-Charles Grégoire is a lawyer and registered Canadian patent agent at Marks & Clerk Canada. His practice focuses on securing patent and industrial design protection.
International IP Legal Updates

CJEU won't commit to pan-European injunction in trademark infringement case

In a recently issued judgment, the Court of Justice of the European Union (CJEU) has confirmed that a court order granting a pan-European injunction cannot extend to any part of the European Union where use of the sign in question does not amount to trademark infringement.

This judgment does not herald the end of pan-European injunctions and the CJEU did point out that "as a rule" it is for the defendant, rather than the court, to prove that the offending sign does not infringe the EUTM in certain member states (which doesn't appear to have happened in the present case to date).

Nevertheless, the judgment has practical consequences for brand owners looking to enforce their EUTM on a pan-European basis.

The judgment in summary

The judgment addressed questions raised by the EUTM Court in Duesseldorf in order to determine whether the granting of a pan-European injunction was incompatible with its findings that there was a likelihood of confusion between an EUTM for COMBIT and the sign COMMIT in "German-speaking" Member States but not in "English-speaking" Member States.

The CJEU followed the line of reasoning adopted in the DHL (WEBSHIPPING) case and confirmed that the territorial scope of an injunction should be restricted when a likelihood of confusion can be excluded in specific territories for linguistic reasons (primarily those concerned with phonetic or conceptual differences).

The Court also went on to say that an EUTM Court must identify with precision the part of the European Union that is not covered by the prohibitive injunction. With specific reference to the present case, it determined that if the court intends to exclude from "English-speaking" areas of the European Union from the scope of the injunction then it must "state comprehensively which areas it intends that term to cover".

Finally, the CJEU elegantly tackled the thorny issue of uniform protection by declaring that the Judgment "does not undermine the unitary character of the EU trademark […] since the right of the proprietor of the trade mark to prohibit all use which adversely affects the functions inherent in that mark is preserved".

Background to the Judgment

Combit Software, a Germany company, sells COMBIT branded CRM software products through its online store and provides support services in connection with its software. Back in 2013, it sued Commit Business Solutions, an Israeli company offering online CRM software to German consumers under the brand COMMIT, for trademark infringement.

The EUTM Court found that Commit Business Solutions had infringed combit Software's exclusive rights to its German registration for COMBIT for computer software but not its EUTM registration for the same mark in respect of support services on the basis that combit Software had failed to provide the requisite evidence of use for such services. The EUTM Court, in concluding that a likelihood of consumer confusion existed in Germany, found that the registered mark COMBIT and the offending sign COMMIT were visually and phonetically similar but conceptually neutral. In the Court's opinion, the German public would view both marks as neologisms deriving from the abbreviation for "computer" albeit
that the offending sign COMMIT would also bring to mind the English word "commitment".

Combit Software appealed this decision on the basis that it had shown the requisite use to enforce its EUTM registration and was entitled to a European Union wide injunction.

The Appeal Court accepted that combit Software had, in fact, shown the requisite use of its EUTM but, curiously, decided that a likelihood of confusion did not extend to "English-speaking Member States". The Court took the view that any similarities between COMBIT and COMMIT were outweighed by the conceptual differences – the English-speaking consumer readily associating the latter with the English verb "to commit" and recognizing the former as a combination of "Com" for computer and "bit" for binary digit.

In order to determine whether the granting of pan European injunction was incompatible with its findings, the Court referred the case to the CJEU.

**Practical points arising from the Judgment**

The possibility of a relatively cost effective pan-European injunction is always an attractive inducement when a brand owner decides to register a mark as an EUTM. However, the Judgment confirms that while this benefit is nice in theory, it may be difficult to achieve in practice.

The following (and inexhaustive) guidelines are designed to separate the fantasy from the reality:

**Have you done your homework?**

It is imperative that the prospective claimant identifies the scope of the claim and any potential limitation to the claim on linguistic grounds. At the very least, local advice should be obtained in respect of all member states where infringement is being alleged.

**Is an interim injunction with EU-wide effect a possibility?**

If any of the local advice indicates that the likelihood of confusion test is finely balanced in a given jurisdiction, it is almost certainly not practicable to get an EU-wide injunction. In these circumstances, consideration could then be given to restricting the territorial scope of the interim injunction to a Court in a Member State where the infringing acts are most harmful and the chances of success are in the brand owner’s favor.

**Is an injunction with EU-wide effect cost efficient?**

If there is doubt over the territorial scope of the claim due to linguistic grounds, then an EU-wide injunction is probably not cost efficient. In *Watson v Boots*, the case required, amongst other factors, that the distinctive character of SOLAIT and SOLEI be considered from the perspective of fourteen different member states (e.g. sun cream in France is *crème solaire* and it was submitted that SOLAIT would be pronounced very similarly) and the Judge decided that this was too complex to be heard by the Patents County Court (now the Intellectual Property Enterprise Court) in the UK. In these circumstances, the brand owner may need to get creative. The brand owner could pursue an injunction in a Member State where the facts are straightforward, and the chances of success favorable, then leverage any resulting
costs award or potential damages investigation to secure a settlement where the infringer undertakes not to infringe in the EU as a whole.

Is pre-action pan-European settlement possible?

Similarly, it may be better for the brand owner to use the perceived strength of their best Member State cases to reach an out of court agreement which prohibits the infringer’s use in the EU as a whole.

In summary, leaving an EUTM court to consider whether a likelihood of confusion exists within the territory of each and every EU member states is likely to be undesirable.

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The right to parody – German Federal Court of Justice Follows CJEU

Two years after the CJEU defined "parody" in its Deckmyn decision (C-201/13), the German Federal Court of Justice had to decide a case (I ZR 9/15) concerning the parody of a photograph of an actress. The photograph had been distorted as a result of an online competition where participants had been asked to change photographs of celebrities to make them look fat. The decision was eagerly awaited, as the judges had to clarify the interpretation of German copyright law including its relation to the respective provisions within EU law. This is the first case to be decided post-Deckmyn.

The law

Under the Directive 2001/29/EC (InfoSoc Directive), key areas of copyright law have been harmonized and have been subsequently transposed into national law by EU Member States. The Directive also covers the right to "parody", Art. 5 (3)(k) of the InfoSoc Directive, as an exception to the exclusive rights of the copyright holder. Not surprisingly, implementing EU law into national law differs from Member State to Member State. The German legislator even failed to incorporate an explicit exception on parody into the German Copyright Act. Therefore, under German law, parody has to be judged in the light of the general "free use" clause, by virtue of section 24 (I) of the German Copyright Act. Parody is just one area of case law under this provision. The clause stipulates specific requirements for "free use". The key requirement for all kinds of free use is the creation of an independent work.

The judgment

In its decision, the German Federal Court of Justice has now clarified that the legal standards given under European copyright law with regards to parody also apply to the corresponding German rules, even though the legislator failed to expressly implement the parody exception.

In essence, the Court established that:

1. Section 24 (I) of the German Copyright Act has to be interpreted in the light of Art. 5 (3)(k) of the InfoSoc Directive as far as it relates to parody.

2. The interpretation of the legal term "parody" under European law is therefore binding for the interpretation of section 24 (I) of the German Copyright Act. According to the CJEU’s Deckmyn decision, the parody defense has to only meet two conditions, namely to "evoke an existing work while being noticeably different from it" and "to constitute an expression of humor or mockery".

3. Resulting from the CJEU’s understanding of parody and against the explicit wording of section 24 (I) of the German Copyright Act, the creation of a work in its own right is no longer a requirement for the application of the parody defense under German law.

The German Federal Court, having established these useful principles, remitted the case back to the lower court (which applied the old 'free use' test) to decide.

Comment

The Court's judgment contributes to a harmonized interpretation of the legal requirements for parody within all EU member states. At the same time, the Court stretches the limits of legal interpretation by leaving out a legal criterion
expressly incorporated in the wording of the German Copyright Act. It will be interesting to see what the lower court decides.

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With special thanks to Martin Lose in our Hamburg office for his contribution to this article.
Anonymous Wi-Fi Services and Copyright Infringement

A recent decision of the EU’s highest court has confirmed that a Wi-Fi service provider is not responsible for copyright infringement that took place using the Wi-Fi services provided by them. However, the court said that the Wi-Fi service provider could be subject to an injunction which requires it to password-protect the internet connection, provided that users are required to reveal their identity in order to obtain the required password and may not act anonymously.

The Facts

Tobias McFadden runs a business selling and leasing lighting and sound systems in Germany. He also operates an anonymous access wireless local area network, free of charge in the vicinity of his business. Access to the network was intentionally not protected. Mr. McFadden is a strong proponent of the protection of personal data and against excessive state surveillance.

A musical work was made available on the Internet free of charge to the general public without the consent of the rights owner, Sony Music. Mr. McFadden clearly asserted that he did not commit the infringement but did not rule out the possibility it was committed by one of the users of his network.

Sony Music sent a formal demand to Mr. McFadden with respect to its rights. On receipt of the notice McFadden brought an action for a declaration of non-infringement. In reply Sony Music counterclaimed for damages against McFadden on the basis of direct liability for infringement and an injunction to prevent continuing infringement.

The action proceeded in the courts of Germany and consideration was given to case law on the indirect liability of wireless local area network operators to pay damages for not having taken measures to protect their wireless local area networks and prevent third parties from using it to infringe. Since the matter involved general matters that applied across the EU, a reference was made to the Court of Justice.

The court considered the effect of the directive that applied to the operation of information society services. Article 12 of the directive provides that when an information society service is provided that consists of the transmission in a communication network of information provided by a recipient of the service, or the provision of access to a communication network, EU members shall ensure that the service provider is not liable for the information transmitted. However, the article does not affect the possibility of a court, in accordance with a specific EU country legal system, requiring that the service provider terminate or prevent an infringement.

The court said that Article 12 must be interpreted as precluding a person harmed by infringement from claiming compensation from a provider of access to a communication network. However, the article does not preclude such person from claiming injunctive relief against the service provider to prevent the continuation of that infringement.

With respect to the ability of a court to issue an injunction, the court said that the grant of an injunction was not precluded in a case of this nature. The injunction could require the service provider, on payment of a fine, to prevent third parties from making a particular copyright-protected work available to the general public from an online exchange platform via the Internet connection available in the network. The provider could choose which technical measures to take in order to comply with the injunction even if a choice was limited to a single measure consisting in password protecting the internet connection so long as the users were required to reveal their identity in order to obtain the required password and could not act anonymously. In practice it appears that only password protection is possible.
The Canadian Position

The directive of the European Union was intended to implement the provisions of the WIPO Copyright and the WIPO Performances and Phonograms Treaties. The treaties provide that authors of literary artistic works and performances and phonograms owners shall enjoy the exclusive right to authorize any communication to the public of their works by wireless means. However, neither treaty provides that the mere provision of physical facilities for enabling or making a communication by itself amounts to a communication.

Canada has implemented these same treaties as have many other countries. As a result, the determination of the highest court of one country is of interest in other countries.

Section 31.1 of the Canadian Copyright Act provides that the person who in providing services related to the operation of the internet or another digital network, provides any means for the telecommunication or reproduction of works or other subject matter through the internet or that other network does not, solely by reason of providing the means infringe copyright in that work or other subject matter.

There is no Canadian provision which, in this context, would require a service provider to terminate or to prevent an infringement unless the service provider was providing the service primarily for the purposes of enabling acts of copyright infringement.

Section 41.25 of the Act provides that an owner of the copyright in a work or other subject matter may send a notice of claimed infringement to the provider. The recipient, or in this case the WiFi provider, must forward the notice electronically to the person to whom the electronic location identified by the location data set out in the notice belongs and inform the claimant of its forwarding or, if applicable, any reason why it was not possible to forward it. In addition, there is an obligation to retain records that will allow the identity of that person to be determined for a prescribed period. If a service provider fails to perform its obligations under the section, the claimant’s only remedy against a provider who did not perform its obligation under the section is statutory damages in an amount that the court considers just, but not less than $5,000 and not more than $10,000.

There have been no cases that have considered whether a WiFi service provider who operates on the basis of anonymous access has any obligations under this section.

Comment

While the statutory provisions involved in the McFadden case are substantially different than those of the Act the result is very interesting. It remains to be seen whether in a similar factual situation the provider, has any obligations under section 41.25.

John McKeown, Goldman Sloan Nash & Haber LLP, mckeown@gsnh.com
Passing Off and Product Shape

A recent U.K. decision provides a review of the law relating to a claim for passing-off based on the shape of a product.

The Facts

The plaintiff is a manufacturer and retailer of furniture. The first defendant was a manufacturer of sofas. The third defendant operates a furniture retail store immediately adjacent to one of the plaintiff’s stores.

The plaintiff alleged, among other claims, that the defendants had passed-off their sofas as the plaintiff’s sofas. The plaintiff said that passing-off was achieved by a combination of three means. First, the defendants sold three styles of sofas which were identical in shape to the plaintiff’s sofas. Second, the defendants used the same names as the plaintiff for those three set styles LOFT, MANAHANTAN and LINCOLN. Third, the external appearance of the second defendant’s store was repainted in a style that resembled the appearance of the plaintiff’s store next door. By a combination of these three means, or alternatively, two of them, customers were led to believe that the third defendant’s store was part of the same enterprise selling the same goods.

Passing-off

The three criteria necessary to establish a successful claim for passing-off are:

1. the plaintiff’s ownership of goodwill in its business, the goodwill being attached to a badge of origin;
2. a relevant misrepresentation on the part of the defendant by the use of a badge of origin or something similar to it; and
3. consequent damage to the plaintiff’s goodwill.

The badge of origin relied upon by the plaintiff was a combination of any two of the three elements; the shape of the sofas, the style names given to the sofas and the external store get-up. This was not the usual passing-off case concerned with a brand name nor was it purely a “get-up” case limited to the shape of the sofa. Nonetheless, the judge thought that the law relating to get-up claims was relevant.

The judge said that it was recognized that it is more difficult to acquire a sufficient reputation and goodwill in the shape or get-up of a product. While the principle function of a brand name was to denote origin, the shape and get-up of a product are not normally chosen for such a purpose. A member of the public seeing a product, for example a red cricket ball, which looks identical to another does not necessarily or even normally conclude they come from the same source. The plaintiff must prove that the shape of its goods has come to denote a particular source to the relevant public.

In short, a plaintiff must prove that customers rely upon the appearance of the product in issue to get the product of the manufacturer they want. This type of reliance is the acid test for the purposes of acquisition of goodwill in a shape for the purposes of the law of passing-off.

In addition, the judge said that there could be no misrepresentation by reason of the use of a get-up if a trade name overrides the get-up as a badge of origin in the mind of the relevant section of the public.

The plaintiff presented evidence but at its best it seemed to only support the position that the defendant was selling an identical sofa but for considerably less than the plaintiff but this did not mean that it was a sofa from the same source. As a result, the judge found that there was nothing in the evidence that sufficiently supported the alleged representations and as a result, the plaintiff failed to establish passing-off.
Comment

The decision provides a useful summary of the approach to be taken in cases involving claims for passing off relating to product get-up. The plaintiff must prove that the shape of the goods denotes a particular source to the relevant public.

John McKeown, Goldman Sloan Nash & Haber LLP, mckeown@gsnh.com
The Rubik’s Cube – invented by Erno Rubik in 1974 – is familiar in appearance, having sold more than 350 million pieces over the last 40 years. In 2010, Seven Towns Ltd. - the worldwide owner of IP rights subsisting in the Rubik’s Cube – together with its Indian manufacturer and distributor - Funskool (India) Ltd.) - brought an action for infringement of copyright and passing off against M/s. Kiddiland and M/s. Cybershop Marketing Pvt. Ltd. (the defendants) before the High Court of Delhi.

They had noticed that the defendants were marketing a cube closely resembling the Rubik’s Cube in appearance and packaging. Seven Towns claimed exclusive rights in the trade dress of the Rubik’s Cube – always of a particular size and comprising a combination of six particular colours within a cage consisting of black lines of a particular width. It also emphasised this trade dress was well known in India and use by the defendants of an identical colour combination was evidence of their malafide intent.

The defendants’ contended that the Rubik puzzle is essentially a memory and problem solving exercise. Primary colours provide the greatest luminosity and promote memory retention, making them optimal for the purposes of the present puzzle cube. Further, the use of the colour black for the cage acting as the base of each square face/tile provides the greatest contrast. All the colours claimed as proprietary to Seven Towns were actually a functional element of the puzzle cube and thus, could not be monopolized by virtue of trade dress.

The court disagreed. It held that a conscious imitation of colour combination by the defendants, in the absence of any explanation for its adoption, indicated a deliberate attempt to achieve the maximum proximity to, and ride upon, the plaintiff’s goodwill vesting in its trade dress. The court also commented that the defendants contention that no exclusivity could be claimed in primary colours or the colour black was misplaced as Seven Towns was seeking protection over the combination of all these features which together made the Rubik’s Cube’s appearance distinctive. And in judging whether trade dress is inherently distinctive, the overall look and appearance of a product and the general “impression and idea” it leaves behind on the minds of consumers was to be considered. The court further held that the issue of trade dress can be decided under the common law action for passing off.

Accordingly, it injunctioned the defendants from using any trade dress, get-up and colour combination similar to the one claimed by Seven Towns.

Samta Mehra and Pankaj Soni, Remfry & Sagar, India
Photocopy shop wins copyright case against publishers

In August 2012, eminent publishing houses including Oxford University Press, Cambridge University Press and the Taylor and Francis Group (the plaintiffs), brought an action for infringement of copyright against Rameshwari Photocopy Service (RPS), a small photocopy shop which had a license from the University of Delhi (DU) to make coursepacks for its students.

The lawsuit sought to restrain RPS from photocopying portions of copyrighted publications and distributing them as course packs/compilations. Obtaining a temporary injunction in October 2012, the publishing houses initially seemed to succeed and RPS was asked to restrain from making the photocopies under dispute during the pendency of the suit. This matter came to be regarded as one involving ‘access to education’ and also saw intervention petitions filed by groups of students and academics - ASEAK (Association of Students for Equitable Access to Knowledge) and SPEAK (Society for the Promotion of Educational Access) - both impleaded as co-defendants.

In the main suit, the plaintiffs argued that the lawsuit did not aim to curb photocopying altogether; RPS was free to offer their photocopying services after obtaining an appropriate license from IRRO (Indian Reprographic Rights Organization – the licensing authority in India for published literary works). RPS contended that obtaining a license was unnecessary for its actions fell within the exceptions to infringement of copyright.

The Delhi High Court recognised that copyright is a statutory right and according to the provisions of the copyright act, photocopying original literary work is an exclusive right of the copyright owner. However, this right is subject to statutory exceptions and Section 52(1)(i) of the Indian Copyright Act excludes the reproduction of a work by a ‘teacher/ pupil in the course of instruction’ from the scope of infringement. Emphasising that the said term needed to be construed broadly on account of the Indian socio-economic context where many pupils are unable to afford expensive course material, the court ruled that ‘course of instruction’ is not limited to personal interface between teacher and pupil but encompasses all reading materials prescribed under the syllabus including photocopied coursepacks such as those compiled by RPS.

The court also considered the matter from a technological point of view noting that if a student copied from a book issued from the DU library for personal use, it would be protected under fair dealing. Photocopiers simply make the process faster. If the act of copying for a particular purpose is not in itself regarded as illegal, merely adopting a superior technology to achieve the same result ought not to change the action to an illegal one.

Finding no cause of action, the plaintiffs’ suit was dismissed. The decision is regarded as significant from the perspective of promoting access to education in a country where large numbers of students are unable to afford expensive course books and educational materials. However, an appeal has been filed and all await the next chapter of this dispute with keen interest.

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BARBARA J. GISLASON’S HISTORIC TRIP TO ALGERIA

While at a United Nations Bar Briefing in New York in May 2016, two Algerian Bar Associations jointly invited me to visit Algeria. The request was extended to me through Ahmed Benantar, the President of the Union Internationale des Avocats (UIA) National Committee, on behalf of the Bar Association of Algiers (Barreau d’Alger), founded in 1848, and the Boumerdes Bar Association (Barreau de Boumerdes), more recently formed.

In preparing for the trip, I sought guidance from my hosts with regard to the subject of greatest interest to Algerian lawyers and judges and accordingly, my presentations were focused on the American legal system, with particular emphasis on the judicial system. Both lectures and Q&A last week lasted about five hours.

Although the Algerian leaders told me in advance of my journey about the significance of my lectures, I failed to fully appreciate the historic nature of them until I met with high profile and well-respected career diplomat, Ambassador Joan A. Polaschik, at the U.S. Embassy in Algiers. She impressed upon me the uniqueness and importance of this invitation. I was soon to learn that I was the first American ever invited to make a presentation to either the Barreau d’Alger or the Barreau de Boumerdes.

Both bar associations, comprised of lawyers and judges, were very warm, polite, and attentive to my presentations; the legal subject they were most interested in learning more about was biotechnology law. The lawyers and judges in Algeria asked challenging and well-articulated questions. A few expressed surprise about the similarities in our legal systems. Algeria, for example, utilizes jury trials for serious crimes. I noticed that the lawyers I met there seemed to have a moral axis. There was, for example, interest in abolishing the death penalty.

In addition to legal questions, there were questions about whether I felt safe visiting the country and about race relations in the United States. In answering the questions posed, I emphasized that the views I expressed reflected my personal, rather than an institutional, opinion.

Following my presentations, I received praise for both my sincere attitude and for explaining the American legal system so clearly. It is difficult to describe how honored I felt to be taken in to the People’s Democratic Republic of Algeria with open arms, not only for these formal presentations, but to observe scenic places along the Mediterranean. I also had the opportunity to visit Algeria’s El-Moudjahid National Museum, which stands atop Hamma Hill at the site of a consequential meeting. Algeria gained her independence from France in 1962.

Not only is Algeria the largest country in Africa, but also, the tenth largest country in the world. The Algerian people are predominantly Muslim and descendents of the Berbers; the influences of the Roman and
Ottoman empires are visually apparent. Algeria is known for its oil and natural gas resources and for being a member of the Organization of the Petroleum Exporting Countries (OPEC). More than 50% of the lawyers practicing in the country are female. The president of an Algerian women’s lawyer organization was proud to tell me that domestic abuse against women is now a criminal offense.

Algeria is a member of the United Nations and its National Committee is active in the Paris-based Union Internationale des Avocats (UIA). The country joined the World Intellectual Property Organization (WIPO) in 1975, follows patent cooperation treaty (PCT) procedures, and is a contracting party with the Berne Convention and the Madrid Protocol. It is my belief that this will be my first of many trips to Algeria and I look forward to using my best efforts to improve U.S. relations with this fine country.

Barbara J. Gislason serves on the American Bar Association Section of Intellectual Property Law Council (ABA-IPL). She is the President of the Biotechnology Law Commission and U.S. National Committee for the Paris-based Union Internationale des Avocats (UIA). She was instrumental in drafting the Memorandum of Understanding between the ABA-IPL and the UIA. Through her efforts, prominent American intellectual property lawyers have spoken at international UIA congresses and seminars in the past three years. They include: Ted Davis, Donna Suchy, David Postolski, Jay Erstling, MaCharri Vorndran-Jones, Mark Stignani, Warren Woessner, Carol Bidwell, and Sarah Kagan. To join the UIA, go to: http://www.uianet.org/en.

In the photographs below, Barbara J. Gislason is meeting with prominent lawyers and judges in Algeria, making a presentation, and attending a meeting at the U.S. Embassy.
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