

News in brief

● A **German** Federal Supreme Court ruling in three cancellation actions involving trademark applications filed by the same company (Cases I ZB 8/06, I ZB 5/08 and I ZB 9/06, April 2 2009) has clarified that a trademark application may have been filed in bad faith if it is likely the mark owner will use unlawful means to persuade third parties to obtain a licence from it. The court has also affirmed decisions of the Federal Patent Court (Cases I ZB 53/07 and I ZB 55/07) in which the latter ordered that Lego Group's three-dimensional trademark for its toy brick be cancelled.

● The Commercial Court of Zaragoza in **Spain** has held that Almacenes Kaymo SA's use of two and four-stripe designs on its sports shoes infringed adidas's well-known three-stripe mark. The decision is significant in that it implies that the protection of adidas's three-stripe mark extends to two and four-stripe designs.

● The High Court of **South Africa** has held that the applicant in *Mayo Foundation for Medical Education and Research v Theatre Mayo Clinic Company (Pty) Ltd* (Case 1428/2006, September 14 2009) was not entitled to rely on the landmark 1998 *Caterham* decision because the alleged unlawful conduct of the respondents commenced prior to 1998. The decision established that *Caterham* is not retrospective in effect.

● WIPO member states have moved to simplify the **international** design registration system under the Hague Agreement, which comprises three independent acts. At an extraordinary meeting of the 14 contracting parties to the London Act, a decision was made to freeze this legislation with effect from January 1 2010 and focus on the Geneva Act.

● In *LVMH Group v eBay Inc* (September 18 2009), a Court of First Instance in **France** has held that eBay Inc and eBay International AG were liable for trademark infringement in

connection with the use of trademarks owned by the LVMH Group as keywords to trigger sponsored links.

● The White House has nominated Victoria Espinel for the role of IP enforcement coordinator (IPEC) within the **US** Office of Management and Budget. The IPEC covers all IP rights and, on the trademark side, is expected to have a hand in developing new approaches to anti-counterfeiting.

● The ECJ has concluded that Austria can be regarded as a 'substantial part' of the **European Community** for the purposes of establishing whether a mark has a "reputation in the Community" in the sense of Article 9(1)(c) of the Community Trademark Regulation [40/94] (*PAGO International GmbH v Tirolmilch registrierte Genossenschaft mbH* [Case C-301/07, October 6 2009]).

● The Beijing First Intermediate People's Court in **China** has upheld a decision of the Trademark Review and Adjudication Board in which the latter had allowed the registration of the trademark AIRBUS for goods in Class 30 of the Nice Classification.

● Following the announcement that Rio de Janeiro will host the 2016 Olympic Games, a new bill (4.667-A) to protect official event sponsors against ambush marketing has been presented to the **Brazilian** House of Representatives.

● In *Chocolaterie Guylian NV v Registrar of Trademarks* ([2009] FCA 891, August 18 2009), the Federal Court of **Australia** has held that Chocolaterie Guylian NV's chocolate seahorse shape was not registrable as a trademark. This case demonstrates the problems faced by applicants seeking to register shapes of products as trademarks in Australia. Even where the shape is well known and entirely non-functional, applicants still face an uphill battle to convince the registrar that the shape is recognized by consumers as a badge of origin.