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Intellectual Property, Entertainment Law and Information Technology Specialist Group

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Greetings!

Welcome to the latest E-Newsletter from the Intellectual Property, Entertainment Law and Information Technology Specialist Group of Consulegis, an International Association of Lawyers. Consulegis is comprised of more than 90 law firms with over 100 offices in 39 countries. This E-Newsletter has articles by attorneys from Austria, Brussels, Cuba, Germany, Spain and the United States.

Consulegis members specializing in intellectual property, entertainment law and information technology law each provide professional services in their own specific country, and can collectively provide a unique, international team approach to issues involving multiple countries. Our comprehensive services can range from litigation to contract negotiations as well as protection of intellectual property rights and strategic planning.

Please contact us if you would like to receive further information on Consulegis, our Specialist Group, or how to obtain specialized assistance from any of our members.

Best regards,

Jeff

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CURRENT AUSTRIAN COURT RULINGS ON THE PROTECTION OF PRIVACY RIGHTS VS. FREEDOM OF THE (CROSS-BORDER) PRESS

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A newlywed couple lost an unborn child in a relatively early stage of pregnancy. Although in most cases this incident would not be highly unusual, it made headlines in the Spring because the couple consisted of a popular high-up member of the Austrian government and a member of one of the most well known business families. Not only does the media constantly report on the political and business doings of the husband and wife, but national and international media also frequently throw a spotlight on them. The husband and wife often make appearances on TV talk shows and the like.

Because privacy is relatively strongly protected in Austria by European comparison, the incident I just mentioned concerning the loss of a pregnancy was originally not reported by the Austrian media. It was an illustrated magazine from a neighboring country that pioneered the way with a trivial exposé. After that, almost all the Austrian print and broadcast media jumped on the bandwagon with their own reports on the couple's misfortune.

As part of the cascade of lawsuits subsequently brought against all the news media that reported on the story, an intense legal discussion swelled up on the question of whether a couple in the public eye, namely a couple that even seeks the limelight, has to tolerate being the subject of such media attention. The media argued in part that the reports concerned public and political life, particularly that of the baby's father. A miscarriage could undoubtedly lead the public to conclude that the minister's political work would suffer, something the public had a justifiable interest in knowing. In its defense the media also contended that the husband and wife regularly make media appearances and make public shows of their affection for each other and their relationship.

The final ruling recently handed down in these proceedings picks up on the recent ruling by the European Court of Justice, particularly in the Von Hanover/Germany case (EuGRZ 2004, 404). According to Court of Appeal (Innsbruck), a clear distinction is to be made between private and public life. Persons who are constantly in the public eye are also entitled to absolute protection of their privacy. And it is not important whether parts of the person's private life are made public. Those parts of a person's private life that are not made public remain protected (6 Bs 394/06a). This legal protection, which was a matter of controversy in recent European rulings, also extends to politicians (and not only their families).

THE COMMUNITY TRADE MARK

Prior to the introduction of the Community trade mark, trademarks could only be protected throughout the European Union either nationally or internationally.

It is now possible to obtain one single community trade mark that covers all member countries of the European Union, meaning that the Community trade mark offers a uniform protection through a single registration procedure with the OHIM (Office for Harmonization of the Internal Market) in Alicante (Spain).

The OHIM examines the Community trade mark application: the trade mark must be a sign which can be represented **in graphic form**, and which must **distinguish** goods and services for which it is filled.

The Community trade mark application is filed either directly at the OHIM or at a national industrial property office in a member state of the European Union or for any of the Benelux countries with the Benelux Bureau for the intellectual property.

If a Community trade mark application is accepted by the OHIM, it is published in the Community Trade Marks Bulletin so that third parties have the opportunity to oppose. Such opposition should be filed within a period of 3 months. If the application is opposed in one Community trade mark country, the trade mark will be refused in the E.U.

The registration of a Community trade mark provides several advantages:

1. The Community trade mark should be used in only one country in order to retain protection throughout the EU.

2. Formalities for registration are simple: a single application, a single language of procedure, a single administrative centre and validly in all 25 E.U. countries.

3. The cost of filling is significantly less than multiple fillings in each country of the E.U.

4. When filing a subsequent application for a Community trade mark, an applicant with a prior identical national trade mark, may claim “priority”.

Trade mark rights may however be revoked following a revocation proceeding or may be declared invalid following an invalidity proceeding. Both actions should be brought exclusively before the OHIM.

Protection afforded by the Community trade mark may be enforced by the Community Trade Mark Courts (CTMC) designated in each member state of the European Union, either the CTMC of the member state in which the infringement was committed or the CTMC of the member state in which the defendant is domiciled.

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SOME CRITICAL ISSUES IN INTERNATIONAL LICENSING

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International licensing involves issues that are unique. Choice of laws is perhaps the most obvious as differences in laws can have a critical impact. Bankruptcy of either party, for example, would seriously affect not just the transaction, but potentially the trademark itself. Parties must understand how bankruptcy impacts their contract under the selected law. There are also practical consequences to selecting a jurisdiction for dispute resolution. Where a case is litigated governs the level of legal representation needed. One wants its general attorneys involved, and therefore redundancy in representation when dispute resolution occurs elsewhere. A foreign forum will require travel, shipping documents, lodging expenses for all participants and other extraordinary costs – plus dealing in a foreign language, operating under a totally different system and possible local bias.

A contract must address exchange rates. Dealing with numerous currencies can be an administrative nightmare, and leave uncertainty as to revenue expectations and value. There is the possibility of devaluation and potentially significant adjustments in relative currency values, making the economics of a deal problematic. Designate a currency and a time set for conversion for purposes of calculations to achieve consistency and predictability.

Consider, too, the costs of registration of the trademark in new countries. Who decides where to register and who pays for registration, should be decided up front. Simply stating that the licensor will register everywhere in the territory can open a Pandora's box, especially as the licensee may not enter into a country, or may not generate enough sales to warrant the cost of registration. Imposing the cost on the licensee who wants to be able to sell throughout its territory may not be fair in that the license term may be short, and the licensor will own all registrations. Full consideration is needed. Creative options should be considered to find mutual fairness.

SEVERE CHANGE IN GERMAN TRADEMARK JURISDICTION CONCERNING THE NAME "POST"

In Germany we have currently a tremendous trademark '"fight'" about the right on the name "Post." It is possible that the current holder, Deutsche Post AG, will lose their (registered) rights on the sole trademark "Post."

Deutsche Post AG got this identification registered (again) only several years ago. In December 2005 the German Patent and Trademark Office decided to delete this trademark, arguing that the name "Post" primarily describes a general provision of services, which solely cannot be protected as a trademark.

Deutsche Post AG used to regularly initiate legal measures against potential competitors, which wanted to establish brands using (amongst others) the word "Post." Through a final decision against Deutsche Post AG, competitors could be given an easier chance to promote their services and arrange their position in this market.

This whole issue is the result of a special situation in Germany. The postal system was state-run until 1990. Thereafter, it was privatised, but Deutsche Post AG received an almost monopole position. Competition was only possible for certain (postal) services, but not for the wide range of the daily delivery of common letters. It is aimed that at the end of 2007 another main part of the monopole position will be set free for the open market. This might be the reason for the current changes in our jurisdiction. To maintain its position beyond 2007 Deutsche Post AG got hundreds of trademarks registered within the last couples of years. The one(s) with only the name "Post" are the target of the current court case.

The decision (expected within the next couple of weeks or months, either way will be very important for the whole market of postal services in Germany. Also, the undersigned is involved in a case, in which a trademark including the word "Post" was registered and against which Deutsche Post AG filed an objection.

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FUNDAMENTAL CHARACTERISTICS OF CUBAN LEGISLATION IN FORCE IN THE AMBIT OF INDUSTRIAL PROPERTY

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This legislation covers various legal institutions protected by the state, thereby Cuba tries to adapt to the fact that it depends on the international trade. The fundamental characteristics are the following:

1. The protection of being incorporated in a register is conceded to all manufacturers and traders, irrespective of their nationality, if they comply with the requirements established by law. The internationally acknowledged principle of "national treatment or assimilation" is applied, in order to guarantee the no discrimination of foreign legal representatives.

2. The rights in the ambit of industrial property are restricted in time and the extent of protection, in accordance with the nature of each of the different modalities of industrial property.

3. The acquisition, the modification and expiration of the rights of industrial property depend obligatorily on their previous inscription in the Register. Cuba does not accept the acquisition of these rights based on their previous application, so that rights that have not been registered properly are not being awarded any protection by the Register.

4. The possession of rights, assigned through the licence of the different modalities, that the law refers to, does not affect the rights of third parties, reserving the number of rights and actions necessary for someone that submits and proves the necessary instruments of avoidance. The priority of the rights is conceded from the moment of presentation of the application at the "Oficina Cubana de la propriedad Industrial."

5. The protection by the Register allows the performance of all legally provided administrative, civil or penalty actions.

6. The protection by the Register is applied to the industry, the agriculture, the commerce and all other fields of trade in all its manifestations.

7. The Cuban legislation protects the following implementations of Industrial Property:

- Inventions
- Scientific discoveries
- Industrial models
- Trademarks
- Trade names
- Business signs
- Commercial slogans
- Appellations of origin
- Indications of source

8. The legally protected rights in the ambit of Industrial Property might be ceded or transferred through all legally recognised instruments. This transmission must be certified by the legally necessary documentation, in order for such a transfer to take effect regarding third parties. Acts of cession or transmission, that have been carried out abroad are valid as well, as long as these procedures are in accordance with the laws of the country in which they took place.

NOTORIOUS AND RENOWNED BRANDS PROTECTION IN SPAIN

Industrial property is one of the most important corporation's asset. This assertion is as much true as this kind of property includes notorious or renowned brands.

Thus, despite how important they are, the truth is that in Spain only recently this kind of brands do deserve finally an effective protection.

The old "Estatuto de la Propiedad Industrial" (1929) only prohibited the mere identical brand's inscription – whether the goods or services were identical or not – but didn't include a precept aimed to notorious or renowned brands protection. Furthermore reality showed that despite the prohibition, identical brands inscription to other already inscribed occurred.

Spain's ratification of the 1883 Paris Convention for the Protection of Industrial Property – as revised at Stockholm on July 14, 1967 – entered into force in 1974 and supposed the first step in this kind of brand protection by virtue of its article 6bis 1), which provided well-known marks with a special protection and also by virtue of its article 8 that gave protection to trade names in all country members, even though trade names were not filed.

Nevertheless, Spanish Courts interpretation of these articles were too restrictive and its practical application was barely successful.

We had to wait the Law 32/88 to find notorious brand strongest protection – basically for the trademarks not filed – thanks to the third transitional disposition and article 3.3 of the referred Law. The notorious and renowned filed brands were protected through article 13.1.c) but generally the Courts made a restrictive interpretation and limited the application of such article to brand's identity cases[1]

This Law was approved before the Council Directive 89/104/EEC of 21 December 1988 entered into force and, even though it was clearly inspired by the same, it didn't reach the same protection's level. Spanish law, one more time, was far below the minimum's EC level.

Nevertheless, the mentioned Council Directive and its following Council Regulation (EC) 40/94 of 20 December 1993 on the Community Trademark obliged the Spanish legislation to be reformed in order to harmonize it with the European legislation, which carried us to the current Law 17/01, which establishes a notorious and renowned brand firm defense, avoiding the use and registration of either similar or identical brands, breaching in its favor the "specialty rule," which means that it is not any more possible to plead about goods or services difference, because now the law clearly establishes that the greater the notoriousness is, the broader the protection a brand enjoys.

A hundred years have had to pass by (the first Spanish law comes from 1902) to obtain a legal protection for notorious and renowned brands. Better late than never.

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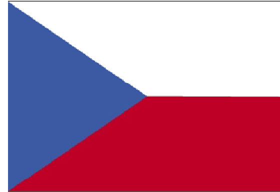

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