

WIPO Workshop on Building Respect for IP for the Judiciary, Public Prosecutors, Police and Customs

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Serrekunda, The Gambia
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Selected Topics in Trade Marks

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Outline

- types of trade marks
- classical infringement
- extended form of infringement
- well-known marks
- parallel imports

Trade Marks

- **capable of being represented precisely**
 - the mark
 - the goods or services

- **capable of distinguishing**

Types of Trade Marks

- **word marks / stylised word marks**
- **figurative / device marks**
- **non-standard marks**
 - shapes
 - colour
 - smells

Word Marks / Stylised Word Marks

- plain script

DREAMS - need for acquired distinctiveness?

- fancy script



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Figurative / Device Marks



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Non-standard Marks



PANTONE 2627C
CMYK 84/100/0/18
RGB 72/34/124



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Classical infringement



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Classical infringement



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Extended infringement – needs a reputation



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Passing-off



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Well-known marks

■ Article 6*bis* Paris Convention 1883



Harrods



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Parallel imports

■ exhaustion

- local
- regional – Fortress Europe
- world-wide

■ conditions

- altering the quality
- notice periods

Selected Topics in Copyright

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Outline

- subsistence
- ownership
- infringement
- defences
- internet use
- related rights

Subsistence

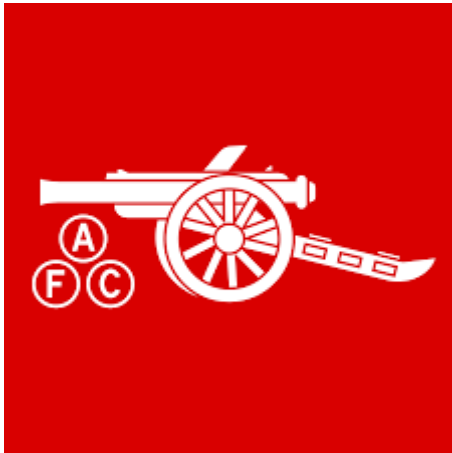
- **Berne Convention 1886**
- **almost any literary, artistic, dramatic or musical work**
- **industrial design exceptions**
- **50 years is usually the shortest period of protection**

Ownership

- commonly unregistered
- legal vs equitable title
- different countries, different rights

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Ownership



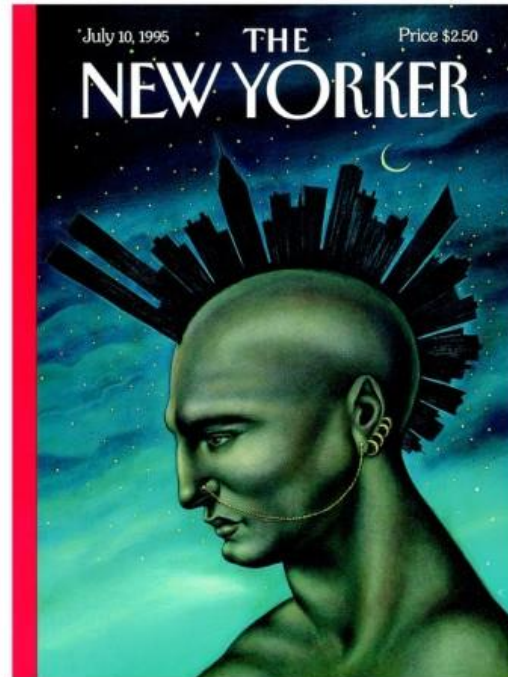
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infringement



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infringement



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Defences

- lack of guilty knowledge for secondary acts
(not really a defence, just incomplete tort)
- permitted acts – narrow in scope
 - news reporting
 - education
 - private study
 - incidental inclusion

Related Rights

- designs – registered / unregistered
- moral rights
- performance rights
- database rights
- data protection

Civil Remedies

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Types of Remedies

- **jurisdiction**
- **interim (interlocutory) vs final**
- **injunctions**
- **declarations**
- **financial**
- **costs**
- **miscellaneous**

Jurisdiction

■ jurisdiction

- subject matter
- parties
- first seized / stays

■ scope of powers

- geographical
- temporal

interim vs final

■ interim remedies discretionary

- balance of justice / injustice
- preservation of the *status quo ante*
- aid resolution of dispute

■ final remedies

- some discretionary, some as of right
- all must be exercised judicially

Injunctions

- **mandatory / prohibitory**
- **interim / final**
- **special forms**
 - freezing orders
 - preservation of evidence / search orders
 - anti-suit
 - *ne exeat regno*

Declarations

- **infringement / non-infringement**
- **validity / invalidity**
- **ownership**

Financial

- enquiries as to damages
 - compensate the CI for loss and damage
 - lost sales
 - lost licence fee
 - royalties
- account of profits
 - deprive the Df of unjust enrichment
 - apportionment

Costs

- scale costs
- standard basis
- indemnity basis
- wasted costs
- *pro bono* costs

Miscellaneous

- disclosure of information
- appointment of receiver
- publication orders
- constructive trusts
- delivery-up / destruction
- Seizure of specially adapted machinery
- certificate of contested validity
- additional / exemplary damages
- internet providers / blocking orders

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■ MA (Natural Sciences) (Cantab), DPhil (Biophysics) (Oxon)

- All areas of IP law and practice, in particular trade marks, patents, copyright and designs. Over a 100 cases reported in the law reports since 2000, of which two thirds were appeals or judicial reviews.
- Appeared often before the General Court and Court of Justice (Luxembourg) in appeals from OHIM and Article 267 references (over 40 cases in all), and in the European Patent Office (Legal and Technical BoA and Opposition Division). Appeared in over 275 matters before the Registry, and over 60 appeals before the Appointed Person.
- Acted for the Comptroller-General of Patents, the Registrar of Trade Marks, the UK government, ITMA, CIPA and AIPPI UK Group.

IP Juniors at Serle Court



Dan McCourt Fritz (2007)



Gareth Tilley (2007)



Thomas Elias (2008)



Sophie Holcombe (2009)



Adil Mohamedbhai (2010)



Adrian de Froment (2013)