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International Intellectual Property Committee Newsletter
Fall 2014

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Belgium
Christian Louboutin v. Van Dalen Footwear BV,
Tribunal de Commerce [Comm.] [Commerce Tribunal]
Brussels, Mar. 20, 2014
case number AR 2013-6154

Christian Louboutin lost his trademark infringement battle with Van Dalen Footwear, and the red sole fashion mark was deemed invalid on March, 2014 in a Brussels Commercial Court. The court refused to classify the mark as a color mark, and instead held that the mark constituted a shape mark. The court found persuasive that the red sole adds value and has become so common in the market that it is no longer distinctive.

Decision in Dutch:
uploads/file/IEFBE/IE-Forum_be%20Voorzitter
%20Rechtbank%20van%20Koophandel%20Brussel
%2002%200%20m%20a%20rt%202014%20.%%20IEFbe
%20738%20(Louboutin%20tegen%20Van%20Dalen
%20Footwear%20B_V_).pdf

Australia
D’Arcy v Myriad Genetics Inc [2014] FCAFC 115

On September 5, 2014 the Federal Court of Australia upheld an American company’s gene patent over isolated DNA sequences that “have been linked to various forms of cancer, including breast cancer and ovarian cancer.” Myriad argued that isolation of the gene “involves structural and functional changes that create a new compositional matter.”

judgments/Judgments/fca/single/2013/2013fca0065

Germany

On June 19th, 2014 the Court of Justice of the European Union (ECJ) addressed (1) what degree of acceptance in the trade circles concerned must there be for a contourless color mark to be regarded as having a distinctive character acquired through use, and (2) whether the mark at issue must have acquired a distinctive character through use on the date of which the application for registration is filed or the date on which the mark was registered.

As to the degree of acceptance for a contourless colour mark to attain acquired distinctiveness, the court held that “it is in every case necessary that consumer survey indicate a degree of recognition of that mark of at least 70%.”

As to the relevant date of distinctiveness, the court held that, “in the context of invalidity proceedings in respect of a mark which is intrinsically devoid of distinctive character, in order to assess whether that mark has acquired a distinctive character through use, it is necessary to examine whether such character was acquired before the date of filing of the application for registration of that mark.”

document.jsf?
text=&docid=153812&pageIndex=0&doclang=EN
&mode=lst&dir=&occ=first&part=1&cid=471684

Thomas Pink Limited (TPL), a men’s luxury shirts designer in London, sued a sub-brand of Victoria’s Secret called PINK (VSP), a retailer focusing on lingerie “and related goods into clothing at large” aimed at the “college girl,” after VSP opened its first UK store in 2012.

TPL became concerned as to the obvious confusion of the “average consumer” regarding: whose shop was whose, whether the two companies were linked, that customers would assume a connection, and inevitable post-sale confusion.

VSP responded with a claim for revocation of the Claimant’s mark on grounds of non-use, as the mark’s supposed absence in multiple categories of the “clothing” specification of goods. After considering the turnover in each category, the court held that there were substantial sales in a majority of the categories challenged.

VSP’s second argument for revocation rested on the premise that it was descriptive, and thus not inherently distinctive.

In the Chancery Division of the High Court, England and Wales Thomas Pink prevailed.

Decision: http://www.bailii.org/ew/cases/EWHC/Ch/2014/2631.html

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**United States**


After considering the topic of copyright protection as to fictional characters, the United States Courts of Appeals for the Seventh Circuit decided that Sir Arthur Conan Doyle’s ‘Sherlock Holmes’ was partially protected by Copyright, and partially public domain. Doyle’s publishing dates straddled the 1923 trigger date of the 1998 Copyright Extension Act. The unique aspects of the works that still fall under valid copyright protections are protectable under the derivative work doctrine.

The estate argued it was entitled to a judgment on the merits because “copyright on a “complex” character in a story, such as . . . Holmes . . . whose full complexity is not revealed until a later story, remains under copyright until the later story falls into public domain.”

The court held that “the copyrights on the derivative works . . . were not extended by virtue of the incremental additions of originality in the derivative works.” While the court held true that “original elements added in the later stories remain protected,” they concluded that there was no conflict with works based on materials in the public domain and what was still under a valid copyright. Warner Bros. Entertainment, Inc. v. X One X Productions, 644 F.3d 584, 596 (8th Cir. 2011).

Extending the copyright would “encourage authors to continue to write stories involving old characters in an effort to prolong copyright protection, rather than encouraging them to create stories with entirely new characters.”

China Ratifies the Beijing Treaty on Audiovisual Performances:

On 9 July 2014, the People’s Republic of China deposited its instrument of ratification of the Beijing Treaty on Audiovisual Performances. In a press release issued the same day (PR/2014/763), Francis Gurry, the Director General of WIPO praised China’s speedy ratification of the Beijing Treaty noting that “China not only showed leadership in the negotiations that led to the conclusion of the Beijing Treaty, but is among the first countries to ratify the agreement.” This, according to Gurry, “shows China’s commitment to securing legal protection to performers in their audiovisual performances.” The Beijing Treaty which strengthens the rights of performers in audiovisual works, such as films, TV series or musicals will enter into force after 30 ratifications or accessions. For additional information visit: http://www.wipo.int/pressroom/en/articles/2014/article_0011.html

India Ratifies the Marrakesh Treaty

In June 2014, India became the first country to ratify the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled. The Marrakesh Treaty was adopted on June 27, 2013 at a diplomatic conference Marrakesh, Morocco. The Treaty will take effect after 20 ratifications or accessions. The treaty aims to address the need of some 285 million blind and visually impaired persons in the world who lack access to published works in accessible formats such as braille. For the text of the Marrakesh Treaty visit: http://www.wipo.int/treaties/en/ip/marrakesh/

South African Draft National IP Policy:

In 2013, South Africa released a Draft National Policy on Intellectual Property. No such policy has been in place previously.

A criticism of the Policy from the U.S. Chamber of Commerce (Global Intellectual Property Center) compared the pharmaceutical patentability requirements to those of India’s Patent Act, “which continues to be concerning to industry.” Second, the Chamber of Commerce urged South Africa to remove the compulsory licensing mandate from the policy in order to make South Africa appealing to foreign investors. Third, a period of data exclusivity from clinical trials could be added to the policy to keep competitors from appropriating it after the patent expires. Fourth, a patent extension is encouraged to make up for time lost during the patent regulation approval period. Lastly, the Chamber recommended the Copyright Term of Protection be extended to 70 years, instead of the 50 years quote in the draft. For more information see: http://keionline.org/node/1945.

On June 17th, 2014 70 organizations from around the world submitted an open letter to the Department of Trade and Industry to express the urgency in finalizing the Policy. “The South African government must do all in its power to actively realize the right to health in line with their Constitutional obligations by rapidly finalizing and adopting South Africa’s National IP Policy without further delay.” The draft is still pending. (link to letter: http://www.tac.org.za/sites/default/files/Letter%202010%20Min.%20Davies%20%26%20Cabinet%20June%202014%20FINAL.pdf).

U.S. Customs Seizures of Counterfeit Fashion Items

Haven’t you ever thought: Are her red bottoms really Christian Louboutins? Are those Tory Burch flats real? Is that Coach purse really an authentic Coach purse? Are those UGG boots really UGGs? Is that Michael Kors wallet a knock-off?

Well, U.S. Customs and Border Protection (CBP) asks the very same questions. All the big designers register their trademarks with the U.S. Patent and Trademark Office. The more sophisticated trademark owners then also record their trademarks with CBP. CBP officers protect recorded trademarks by preventing the importation of merchandise attempting to enter the United States which may be counterfeit or otherwise infringe on the trademark rights of the trademark owner. Commonly counterfeited trademark examples are UL, HP, Apple, Microsoft, Wi-Fi, SD, Bluetooth, and HDMI. Counterfeiting is a $600 billion international business.

Both trademarks and copyrights are recorded with CBP through the Intellectual Property Rights e-Recordation online system. This system allows CBP to obtain information instantly which facilitates the seizure of fake goods. Customs officers investigate imports displaying the designer’s marks, and verifies if they are genuine. The cargo arrives in the United States and is detained by CBP officers. Often, the importer is asked to provide written licenses from the trademark owner authorizing the manufacture and importation of the items. Often, a sample of the detained items is shipped to the trademark owner for careful examination. Once the trademark owner confirms that the item is counterfeit, CBP seizes it.

A formal letter from CBP’s Fines, Penalties and Forfeitures Office is eventually sent to the importer. The importer can then file a Petition with CBP requesting the release of the items. Sometimes, the importer decides to go to Court to get its merchandise released. The trademark owner is then much more involved in the process.

Recent WIPO Administrative Panel Decisions


The Lancôme mark was first used in 1935 and it has consistently been used for skincare, makeup and fragrance products. The infringing domain, was www.lancomes.com, directed visitors to a page that sold diet products and featured Penelope Cruz, an actress associated with Lancôme. A panel held that it was “obvious” that Respondent exhibited bad faith and transferred the domain name to Lancôme.


The disputed domain names: cheapfreepeople.com, cheapfreepeople.net, and cheapfreepeople.org. Urban Outfitters made a variety of complaints, a few of which include: Ju Yu has no “rights or legitimate interests” in the domain, they “offer[ed] for sale goods purporting to be the Complainant’s clothing at prices that are much cheaper than the Complainant’s recommended retail price.”

The Panel held the domains to be confusingly similar, Ju Yu had no rights or legitimate interest in the domains, and they were registered and used in bad faith.


An e-cig sales website registered as marlboroeiggs.com was transferred to Marlboro after the Panel held that the ecig company registered for the domain either to disrupt Marlboro’s business, or used the domain for their own commercial gain based on the “likely confusion with Complainant’s mark.”

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Committee Announcements

Up-coming WIPO Seminars & Workshops

**Advanced Seminar on the PCT (WIPO/PCT/GE/14)**
October 9 to October 10, 2014 Geneva, Switzerland

**WIPO Mediation Workshop and Arbitration Workshop (WIPO/ARB/NYC/14)**
November 6 to November 7, 2014 New York, United States of America

**WIPO Advanced Workshop on Domain Name Dispute Resolution: Update on Precedent and Practice (ARB/DN/AWK/14)**
December 4 to December 5, 2014 Geneva, Switzerland

About the International Intellectual Property Committee:

The International Intellectual Property Committee of the American Bar Association Section of International Law (ABA-SIL) deals with intellectual property problems arising out of differences in the laws of various countries; issues concerning the negotiation and implementation of international agreements affecting intellectual property rights; the rights of United States citizens to obtain intellectual property protection in other countries and the rights of foreign authors, inventors and producers to obtain intellectual property protection in the United States.

To join or learn more about the ABA Section of International Law visit: [http://www.abanet.org/intlaw/membership/home.html](http://www.abanet.org/intlaw/membership/home.html).

If you have any difficulties, please contact the International Section office at 202-662-1660.

Interested in Contributing: We welcome voluntary contributions of case reviews, book reviews, proposed or pending relevant legislation, news items, useful links and relevant information concerning upcoming events of possible interest to members of the international intellectual property committee for inclusion in future issues of this newsletter.

Contributions may be sent by email to [uchee@uark.edu](mailto:uchee@uark.edu). Submissions must be received by **December 1, 2014**. Thank you for your participation!
ABA Section of International Law
Fall 2014 Meeting
Buenos Aires, Argentina:
Intellectual Property Agenda Highlights
Wednesday October 22, 2014:

• IP Licensing in Brazil and Argentina: Problems and Opportunities
  9:00 am -10:30 am    Pacara B

• Privacy and Data Protection: Business and Social Media
  11:00 am - 12:30 pm    Pacara A

• Global Distribution of Entertainment Content in the Digital Era: Rights, Action, Roll’em
  2:30 pm - 4:00 pm    Pacara B

• Cross-Border Enforcement of Court Judgments and Arbitral Awards: Opportunities, Pitfalls, Flaws, Remedies
  2:30 pm – 4:00 pm    Jacaranda

• Global Strategic Alliances and IP-Centric Product Development
  4:30 pm - 6:00 pm    Quebracho A

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Reminder:
The materials and information included in this newsletter do not reflect endorsement by the American Bar Association, the Section of International Law, or the International Intellectual Property Committee.

Ellen Tinnin, JD Candidate, University of Arkansas, provided editorial assistance.