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Merck & Co. Legal Rights Objections Dismissed By WIPO

GENEVA- In two WIPO decisions that came out recently, Merck & Co., Inc. objections to the applications of Merck KGaA to .Merck and .eMerck were thrown out. Those filing legal rights objections have now lost all 27 decisions that have been issued by WIPO. However, these cases differ from many of the previous cases dealing with front running trademark application. In this case, the objector is the global drug company “Merck”, one of the largest drug companies in the world.

Here are the relevant parts of the decision:

Objector contends that Applicant cannot operate the disputed gTLD String without infringing Objector’s trademark. Objector contends that this Objection is valid and should be upheld because the potential use of the disputed gTLD String by Applicant:

1. (i) takes unfair advantage of the distinctive character or the reputation of Objector’s registered trademark; and/or
2. (ii) unjustifiably impairs the distinctive character or reputation of Objector’s registered trademark; and/or
3. (iii) otherwise creates an impermissible likelihood of confusion between the Disputed gTLD String and Objector’s mark.



If Applicant is granted the disputed gTLD String necessarily, as contended for by Objector, Applicant will be using “EMERCK” in the course of trade; it will thus be using in certain territories in the course of trade a sign, which is similar to Objector’s trademark in relation to identical or similar services.

This is the essence of this dispute between the parties. Objector has rights to use MERCK in certain parts of the world and Applicant has rights to use MERCK in other parts of the world. As a result, Objector could infringe Applicant’s rights using MERCK in those last mentioned parts of the world and Applicant could infringe Objector’s rights when it uses MERCK in those first mentioned parts.

The starting point of this case is that the Objector and the Applicant are both bona fide users of the MERCK trademark, albeit for different territories.

The question is whether a bona fide trademark owner that owns trademark rights in certain countries but does not have rights to a certain trademark in all countries of the world, should for that reason be prevented from obtaining a gTLD. In the view of the Panel, such a proposition does not make sense. If the opposite view would be accepted, it would be expected from any trademark owner interested in a gTLD to have trademark registrations in all countries of the world as otherwise another party could register one trademark in an “uncovered” country and thus prevent the first trademark owner from applying for and using its own gTLD.

In essence, there should not be a significant difference between the criteria for the legal rights objection as included in the Guidebook on the one hand and the provisions included in the Uniform Domain Name Dispute Resolution Policy (“UDRP”). If the applicant for a new gTLD is bona fide, it will not be likely that one of the three criteria will be met. It might be that advantage of the distinctive character or the reputation of the objector’s registered trademark is taken, but it is then likely not unfair. It might be that the distinctive character or reputation of the objector’s registered trademark is being impaired, but it is likely justified. It might be that a likelihood of confusion between the disputed gTLD String and the objector’s mark is created, but it is not necessarily impermissible.

Of course a rejection of the Objection does not preclude Objector from taking regular legal action should the use of the Disputed gTLD String by Applicant be infringing. It is, however, not for this Panel to anticipate on all the possible types of use Applicant could make of the Disputed gTLD.

It is also not for this Panel to interpret the existing coexistence agreements and arrangements between the Parties. Should the application of a new gTLD allegedly violate any such agreement or arrangement, it will be for the Parties to settle their dispute by means of dispute resolution provisions of the contracts governing their relationship or as provided under applicable law.

Source: The Domains



2,176

Arrested for IPR Infringement in China

BEIJING - A total of 2,176 suspects were arrested for Intellectual Property Rights (IPR) infringements in China in the first half of 2013, the Supreme People's Procuratorate (SPP) mentioned recently in a statement. Procuratorates nationwide prosecuted 3,805 people involved in 2,253 IPR violation cases in the same period, according to the SPP.

The SPP said IPR-related crimes have increased gradually and trademark infringement has become the most serious violation, accounting for 80 percent of the total cases.

The difficulty in cracking down on IPR violations has increased as sophisticated means are being deployed by suspects, said the SPP, adding that IPR crimes committed in economically-developed regions remain at a high level.

Procuratorates across the nation arrested 19,786 suspects in 11,723 cases concerning IPR infringement, and prosecuted 29,481 people involved in 17,062 cases from 2008 to 2012, the SPP said.

Source: Xinhua

ICANN New gTLD Committee Kills Off Dotless Domains

LOS ANGELES - The new gTLD Committee of ICANN just killed off Dotless Domains according to a resolution published newly. Google notified ICANN that it has modified its application to operate .Search new gTLD from a closed model to an open model operating it as a Dotless Domain.

Whereas, dotless domains consist of a single label and require the inclusion of, for example, an A, AAAA, or MX, record in the apex of a TLD zone in the DNS. Whereas, Section 2.2.3.3 of the Applicant Guidebook (AGB) prohibits the use of dotless domain names without evaluation of the registry services and ICANN's prior approval.

The NGPC acknowledges the security and stability risks associated with dotless domains as presented in SAC053, the IAB statement and the Carve Report and affirms its commitment to its security and stability mandates as the New gTLD Program is implemented.

In light of the current security and stability risks identified in SAC053, the IAB statement and the Carve Report, and the impracticality of mitigating these risks, the NGPC affirms that the use of dotless domains is prohibited. "The SSAC expressed concern about the use of dotless domain names for gTLDs in SAC 053 and recommended against their use. During the public comment on SAC053, some members of the community supported the position of the SSAC and noted that due to the security and stability concerns posed by dotless domains, they should not be allowed."

"Others in the community have argued that dotless domains should be allowed for technical innovation and that the risk assessment is overly conservative as there are ways to mitigate the risks to not unduly upset the security and stability of the Internet."

Source: The Domains





Russian IP Court Opens its Doors

MOSCOW- Following July resolutions of the Plenum of the Supreme Commercial Court of the Russian Federation (No. 50 and 51), and upon the appointment of 15 judges, the new Russian Intellectual Property Court (IP Court) officially opened its doors and started hearing cases.

According to the Federal Constitutional Law adopted in 2011, which amended the court system in the country, the IP Court is a specialized court within the system of arbitrazh (commercial) courts that considers IP cases as a court of first instance and cassation instance.

Thus, as of July, the arbitrazh courts cannot accept for consideration the lawsuits falling under the exclusive competence of the IP Court; such lawsuits will be returned to applicants or, in case they were mistakenly accepted, transferred to the IP Court.

The lawsuits, containing a few different but related requirements, will be heard in the IP Court if at least one of those requirements falls within the jurisdiction of the IP Court.

The IP Court will act as a court of first instance reviewing Russia's Federal Service for Intellectual Property (ROSPATENT) decisions, including patent and trademark registration issues and revocation actions, after the cases are considered by the Chamber for Patent Disputes. The IP Court will also consider the non-use cancellation actions, revise the decisions of Russia's Federal Antimonopoly Service (FAS) on unfair competition due to IP rights transferring and deal with other similar cases.

In case the trademark and commercial name disputes fall within the jurisdiction of the arbitrazh (commercial) courts, the cassation claim (second appeal) should be filed with the IP Court. Such claim will be heard by the panel of judges and not by the Presidium of the IP Court.

The IP Court is located in the center of Moscow at 13 Mashkova Street.

Source: Petosevic



Croatia Amends Patent Legislation

ZAGREB- Earlier this summer, the Croatian Parliament passed the Patent Act and the Act on Amending the Patent Act (Official Gazette No. 76/2013) on an urgent basis ahead of Croatia's EU accession, which took place in July.

The amendments were made with respect to the provisions on supplementary protection certificates and compulsory licensing. The amending Act establishes a competent body and its tasks relating to the implementation of the:

- Regulation (EC) No. 469/09 of the European Parliament and of the Council of 6 May 2009, concerning the supplementary protection certificate for medicinal products intended for humans or animals, as amended (Official Journal of the EU (OJ) L 152, 16.6.2009, containing all the amendments);
- Regulation (EC) No. 1610/96 of the European Parliament and of the Council of 23 July 1996, concerning the creation of a supplementary protection certificate for plant protection products, as amended (OJ L 198, 8.8.1996, containing all the amendments); and
- Regulation (EC) No. 816/2006 of the European Parliament and of the Council of 17 May 2006, on compulsory licensing of patents relating to the manufacture of pharmaceutical products for export to countries with public health problems, as amended (OJ L 157, 9.6.2006, containing all the amendments).

In line with the new amendments, the minister responsible for the work of the Croatian IPO passed the new Patent Regulations and Regulations on Amendments to the Patent Regulations (Official Gazette No. 85/2013) that entered into force in July 2013.

Source: Petosevic



Romanian Customs Seize EUR 2M Worth of Counterfeits

CONSTANTA - The Romanian customs' officials seized various goods believed to be counterfeit in the period from July 24 - August 5, the total value of which is approximately EUR 2 million (USD 2.7 million).

The seized goods include:

- 27,216 pens, 3,080 agendas and 18,000 sets of labels bearing Hello Kitty, Angry Birds and Disney marks;
- 2,799 energy drinks bearing Monster Cuba-Lima, Monster Rehab, Monster Energy, Coca-Cola Cherry and Dr. Pepper marks;
- 355 bracelets and chains bearing Paul Frank, Chanel, Louis Vuitton and Versace marks;
- 20,207 sportswear items, 108 sneakers and 118 leatherwear items bearing Adidas, Diesel, Polo, Nike, True Religion, Armani, Burberry, Tommy Hilfiger and Dolce & Gabbana marks; and
- 11,200 pairs of men's shoes bearing Freeland and Discovery marks.

The seizures were made at the port of Constanta, eastern Romania, and the port of Bechet, southern Romania. The goods originated in China and were intended for the Romanian and Czech Republic markets.

Source: Petosevic



Talal Abu-Ghazaleh Organization Opens Office in Malta: TAG-Org's 81st Office

VALLETTA -Talal Abu-Ghazaleh Organization (TAG-Org), the global organization for professional services and education, is proud to announce the opening of a new fully functional office in Valletta, the capital of Malta, its 81st office in the world.

The office is located in the vibrant, central-eastern capital of the island; it will offer various services such as Intellectual Property consultancy and diverse business related studies in addition to other professional services.

HE Dr. Talal Abu-Ghazaleh, chairman of TAG-Org said: «We are extremely excited to open a fully functional office in this great island as part of our expansion strategy around the world. We are looking forward to strengthening our professional relations with different organizations and entities in addition to various businesses and sectors in this great country, which is close to the Arab region».

Malta, in the heart of the Mediterranean, is a melting pot of civilizations with a history stretching back thousands of years. The national language is Maltese, which is part of the Semitic language family that also includes Arabic. English is also recognized as an official language, and many Maltese also speak Italian. Tourism is important in Malta but the island also has an expanding services sector. Malta is known as the Switzerland of the Mediterranean and is located geographically in Africa but politically European; Tunisia and Libya are also close by.

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