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EUGIPP
EU Georgia Intellectual Property Project

IP Enforcement Forum

Benjamin Fontaine | Alicante | 16/06/2021

გამარჯობა და მოგესალმებით!

EU Georgia project, funded by the European Union and implemented by the European Union Intellectual Property Office (EUIPO)

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Case no. 2. Administrative case regarding violation of trademark rights

FAKE or AUTHENTIC ???

That is the evidence…

Case no. 2. Administrative case regarding violation of trade mark rights

Case no. 2. Administrative case regarding violation of trade mark rights

- BASIC FACTS:

Administrative Panel of Tbilisi City Court, case No. 4/5054-20, October 30, 2020

- Alleged counterfeiting goods seized by Revenue Service
- Confirmation by right holder that goods are counterfeit: detailed explanation in writing
- Defendant submitted purchase document from third party. No evidence on alleged genuine character
- Court ruled in favor of defendant: the statement of right holder reflects position of the latter as an interested party

Case no. 2. Administrative case regarding violation of trade mark rights

- DISCUSSION TOPICS:
- (a) Standard of Proof: may Revenue Service rely on right holder's statement regarding originality of the goods, would such statement suffice?
- (b) Burden of Proof: Is respondent obliged to prove that goods in question are genuine?
- (c) Is retailer responsible for selling counterfeits or only importers / wholesalers may be hold responsible for putting goods in commerce/civil circulation?
- (d) Does retail of the goods qualify as "putting goods in commerce/civil circulation" according to Georgian legislation?

Case no. 2. Administrative case regarding violation of trademark rights

- Statement of right holder
- Probative force of the customs reports
- Presumption of bad faith when the material element of the customs offence is characterized
- in case of criminal offence :
  - the burden of proof is reversed
  - The defendant must prove the statement is inaccurate
- LIABILITY of all players in the chain

Case no. 2. Administrative case regarding violation of trademark rights

- (d) Does retail of the goods qualify as "putting goods in commerce/civil circulation" according to Georgian legislation?

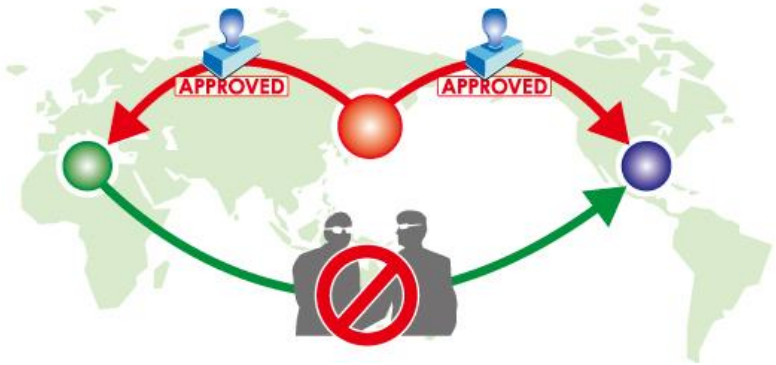
  – Article 10 §3 b) Directive 2015/2436 : "*offering the goods or putting them on the market, or stocking them for those purposes, under the sign, or offering or supplying services thereunder*"

  – Article L.716-10 b) of the French CPI : "*Offering for sale or selling goods presented under a counterfeit trademark*"

Case no. 2. Administrative case regarding violation of trade mark rights

- THE EXTRA MILE

- (e) What about the exhaustion of the rights of the right holder, in this case?



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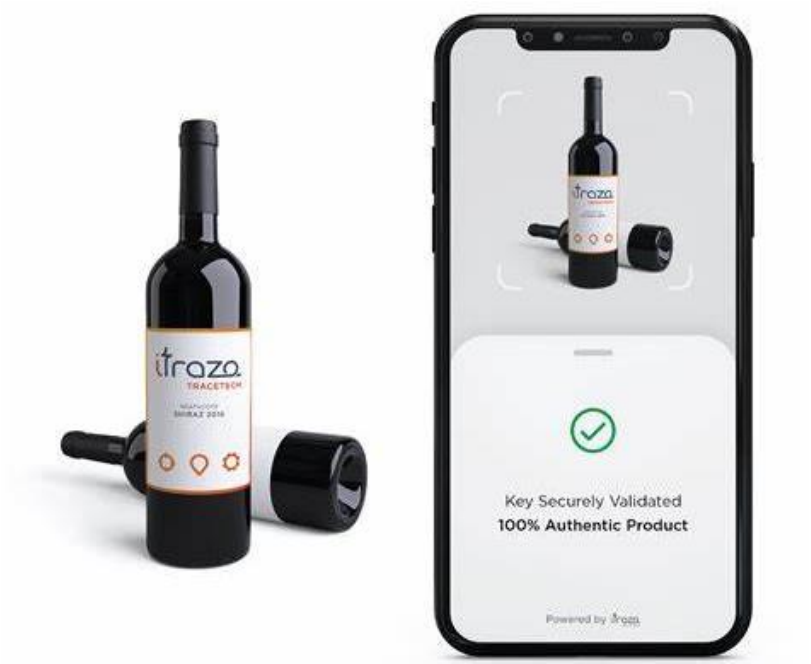
Case no. 6. Civil case regarding trade mark infringement and decoded product

FAKE or AUTHENTIC ???

Let’s scan it…

Case no. 6. Civil case regarding trade mark infringement and decoded product



Case no. 6. Civil case regarding trade mark infringement and decoded product

- BASIC FACTS:

Civil Panel of Tbilisi City Court, case No. 2/27788-15, August 17, 2017

- Claimant accused Defendant of counterfeiting its products and asked for the destruction of the stocks
- Burden of proof of the genuine character of the product:
  - Claimant proved that all genuine bottles bear ornamental codes
  - Defendant did not show that the products were genuine
- Court ruled in favor of claimant

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Case no. 6. Civil case regarding trade mark infringement and decoded product

- DISCUSSION TOPICS:
- (a) Standard of Proof in trademark infringement cases, including possible parallel import cases
- (b) Does concept of “Parallel Import” covers the right of the importer / supplier on relabeling of genuine goods, i.e. to remove front label, delete production code and affix new label (as old one is damaged and useless)?
- (c) Does removing of technical protection tools from the product and ceasing opportunity of right holder to identify genuine goods is qualified as trade mark infringement?

Case no. 6. Civil case regarding Trademark infringement and decoded product

- (a) Standard of Proof in trademark infringement cases, including possible parallel import cases
  - Principle : burden of proof of parallel import on the defendant
  - Exception : *if defendant demonstrates a risk of partitioning national markets* → up to the trademark owner to establish that the goods were initially put in the market by himself or with his consent outside EU/ EEA
  - Exception to the exception : *if goods put in the market outside* → up to the defendant to establish the existence of the proprietor's consent to the subsequent marketing of the goods in the EU/EEA

Case no. 6. Civil case regarding Trademark infringement and decoded product

- (b) Does concept of "Parallel Import" covers the right of the importer / supplier on relabeling of genuine goods, i.e. to remove front label, delete production code and affix new label (as old one is damaged and useless)?

Article 15 Directive 2015/2436 + Article 13 Regulation 2017/1001 + Article L.713-4 CPI

CJUE, May 17, 2018, C-2018/322, Junek:

- principle : trademark owner may legitimately oppose an external packaging with an additional label
- 5 exceptions

+ new exception : small label, presentation of the packaging not affected

Case no. 6. Civil case regarding Trademark infringement and decoded product

- (c) Does removing of technical protection tools from the product and ceasing opportunity of right holder to identify genuine goods is qualified as trademark infringement?

  YES : CJCE, April 23, 2002, C-145/00, Boehringer

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Case no. 7. Civil case regarding new regulations concerning provisional measures

CEASE or be SEIZED

That is the question

Case no. 7. Civil case regarding new regulations concerning provisional measures

Case no. 7. Civil case regarding new regulations concerning provisional measures

- BASIC FACTS:

Civil Panel of Tbilisi City Court, case No. 2/25070-19, October 19, 2019

- Claimant filed lawsuit for trade mark infringement and requested provisional measures in view of threat to “irreparable damage due to the dilution of its reputation”
- Dispute on applicable law: art. 191 (general rules of measures securing the claim) –v- art. 363 (preliminary measures in IP related disputes)
- Provisional measures rejected by the Court : claimant did not prove impossibility to enforce judgement and to obtain damages

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Case no. 7. Civil case regarding new regulations concerning provisional measures

- DISCUSSION TOPICS:
- (a) Which provisions of the Civil Procedural Code shall be used in IP related disputes? Only Article 363, only article 191 or both?
- (b) What standard of proof is needed to justify imposing of provisional measures under article 363?
- (c) Is it possible in IP related disputes to impose measures securing the claim identical to the main claim?

Case no. 7. Civil case regarding new regulations concerning provisional measures

- (a) Which provisions of the Civil Procedural Code shall be used in IP related disputes? Only Article 363, only article 191 or both?

    - Article 131 Regulation 2017/1001 : "*Application may be made to the courts of a Member State, including EU trade mark courts, for such provisional, including protective, measures in respect of an EU trade mark or EU trade mark application*"
    - Article 9 Directive 2004/48/EC
    - Article L.716-4-6 of the IPC : special procedure allowing to obtain from the judge seized in summary proceedings or on request provisional measures
    - Article 834.s and 873 of the CPC : common law

CA Paris, February 14, 2017, n°16/09728, Albisetti International c/ Kenzo

Case no. 7. Civil case regarding new regulations concerning provisional measures

- (b) What standard of proof is needed to justify imposing of provisional measures under article 363?

  - Considering 22 Directive 2004/48/EC : "*ensuring the proportionality of the provisional measures […] where any cause irreparable harm to the holder of an intellectual property right*"
  - Article 9.3 Directive 2004/48/EC : "any reasonably available evidence … *with a sufficient degree of certainty*"
  - Article L.716-4-6 §3 of the IPC : "*only if the evidence, reasonably available to the plaintiff, makes it likely that his rights are being infringed or that such infringement is imminent*"
    - CA Versailles, December 11, 2014
    - CA Paris, March 18, 2016, No. 14/16050
    - CA Paris, February 14, 2017, n°16/09728, Albisetti International c/ Kenzo

Case no. 7. Civil case regarding new regulations concerning provisional measures

- (c) Is it possible in IP related disputes to impose measures securing the claim identical to the main claim?

  - Article L.716-4-6 of the IPC :
    - only for trademark infringement actions
    - Not applicable to acts of unfair competition, even if related to acts of infringement

  - CA Paris, April 11, 2013, n°12/12213, New Look

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Case no. 7. Civil case regarding new regulations concerning provisional measures

- THE EXTRA MILE

- (e) What about the measures provided for by the Directive 2004/48/EC of April, 29th 2004 on the enforcement of intellectual property rights?

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Case no. 4. Civil case regarding copyright infringement

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Case no. 4. Civil case regarding copyright infringement

Case no. 4. Civil case regarding copyright infringement

- BASIC FACTS:

Civil Panel of Tbilisi City court, case No. 2/76-13, July 23, 2020

- Claimant filed lawsuit for software infringement: translation in Georgian and adaptation
- Defendant were former employees of the claimant's company: alleged access to the files
- Identical mistakes in the alleged infringing software (150+)
- Defendant claimed the software had been created independently
- Court ruled in favour of the claimant: defendant was due to pay damages (global incoming in retail of software)

Case no. 4. Civil case regarding copyright infringement

- DISCUSSION TOPICS:
- (a) What is the role of existence of same technical mistakes (even minor mistakes) in conflicting works (software) while determining copyright infringement?
- (b) Standard of defense: what is required from the respondent to prove independent creation of the work?
- (c) When calculating income gained by sales of infringing works, what conditions should be taken into account? Are there any costs that should be deducted from gross income of the infringer?

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Case no. 4. Civil case regarding copyright infringement

- THE EXTRA MILE

- (d) What is the subject-matter of the copyright protection?
- (e) What are the other possible infringing acts of a software?
- (f) Was there also room for a claim based on unfair competition?
- (g) What about the protection of “trade secrets”, of patents?

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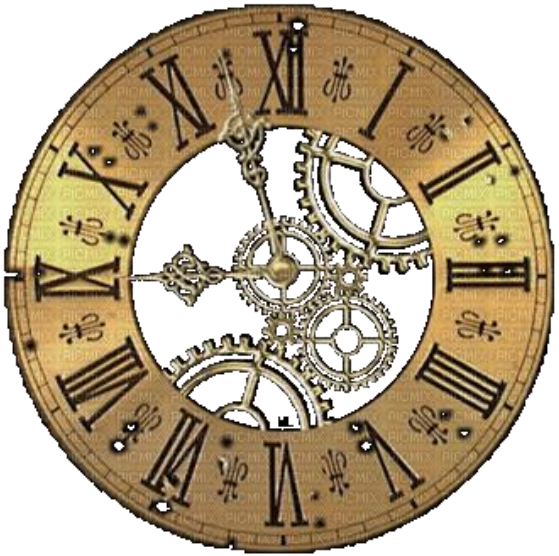
Case no. 5. Civil case regarding revocation of trade mark for non-use

USE it or LOSE it

…any due cause though?

Case no. 5. Civil case regarding revocation of trade mark for non-use



Case no. 5. Civil case regarding revocation of trade mark for non-use

- BASIC FACTS:

Civil Panel of Tbilisi City Court, case No. 2/10565-2019, June 27, 2019

- Defendant was legally unauthorized to use the trade mark which he registered, as per Insurance law
- Claimant filed cancellation action based on bad faith registration and preliminary measure i.e. sequester of the trade mark
- After 5 years, the claimant filed a revocation action based on non-use: sequester restricts the ability to transfer the trade mark, not to use it
- The Court ruled in favour of the defendant: preliminary action in the form of sequester of the mark prevented defendant to use its trade mark.

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Case no. 5. Civil case regarding revocation of trade mark for non-use

- DISCUSSION TOPICS:

- (a) Standard of Proof of actual use of the trade mark
- (b) Exceptions which may be used as an excuse for non-use of the trade mark

Case no. 5. Civil case regarding revocation of trade mark for non-use

- THE EXTRA MILE
- (e) Does the Covid-19 crisis constitute a due cause for non-use of a trade mark?

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Case no. 1. Administrative case regarding recognition of trade mark as well-known

So famous !

But…to what extent?

Case no. 1. Administrative case regarding recognition of trade mark as well-known

Case no. 1. Administrative case regarding recognition of trade mark as well-known

- BASIC FACTS:

Administrative Panel of Mtskheta District court, case No. 3/89-13, December 16, 2013

- Claimant was refused trade mark application which it had used for more than 10 years, because of an ex-officio citation
- Claimant submitted various types of evidence notably public opinion survey to show the well-known character of its trade mark prior to the filing of the citation
- Recognition of its well-known character by the Court of the First Instance, but the Court of Appeal reversed the decision: the survey suffered a lack of representation of the whole population of Georgia as survey conducted “only” in the four major cities

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Case no. 1. Administrative case regarding recognition of trade mark as well-known

- DISCUSSION TOPICS:
- (a) What should be the standard of public opinion survey for establishing whether trade mark is well-known in the country?
- (b) To determine well-known status of a trade mark, is public opinion survey a MUST or only other evidence(s) may also suffice?
- (c) Shall sectoral opinion survey be relevant in certain cases for determining well-known status of the trade mark, or it should always reflect opinion of general public?
- (d) Does Supreme Court ruling contradict the Joint Recommendations of WIPO in the context of recognizing public opinion survey as a MUST?

Case no. 1. Administrative case regarding recognition of trade mark as well-known

- THE EXTRA MILE

- (e) What about the spill-over effect in the present case?
- (f) What were the other possibilities of the parties (letter of consent, buying the earlier trade mark…)?
- (g) The present case in the light of Article 6bis of Paris Convention
- (h) Bad faith of the applicant?

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Case no. 3. Civil case regarding misleading use of trade mark

Za sdarovia !

Give Russia what belongs to Russia…

Case no. 3. Civil case regarding misleading use of trade mark

Case no. 3. Civil case regarding misleading use of trade mark

- BASIC FACTS:

Civil Panel of Tbilisi City court, case No. 2/21348-18, November 27, 2019

- Defendant had registered more than 20 trademarks used in Georgia with the expression "Russian vodka"
- Alleged misleading use of the trade mark as the goods were produced in Latvia
- Complainant submitted a survey showing 99,9% of Georgia's relevant consumers thought the goods were produced in the Russian federation
- Defendant claimed the back label on the bottle indicated their real origin
- The Court ruled in favour of the complainant

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Case no. 3. Civil case regarding misleading use of trade mark

- DISCUSSION TOPICS:

- a) What is the standard to prove that trade mark is used in a misleading manner?
- (b) Is existence of the name of geographical location or indication thereof necessary precondition for deciding that use of the trade mark misleads consumer to the true origin of the goods?
- (c) What should be optimal way to prove that use of the trade mark does not mislead consumer?

Case no. 3. Civil case regarding misleading use of trade mark

- THE EXTRA MILE

- (e) The protection of country names under Paris Conve
- (f) The present case in the light of Consumer law
- (g) The present case in the light of European Union tra
- (i) The present case in the light of geographical indications law

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THANK YOU

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