

Trademark Bulletin – October 2006

[www.brandvue.net](http://www.brandvue.net)

### **No trademark protection for "Fussball WM"**

In its recent decision (ruled shortly before the soccer World Cup in Germany and published shortly afterwards), the German Federal Court of Justice pointed out that the term "Fussball WM 2006" (Soccer World Cup 2006) can not be protected as a trademark. The expression "Fussball WM 2006" appears to be purely descriptive and can therefore not lead to a monopoly. This can be perceived to be a slap in the face for FIFA, which owns nearly 3,500 industrial property rights and which had started legal actions against more than 1000 entities and individuals. (BGH I - FUSSBALL WM 2006 - I ZB 96/05 und I ZB 97/05)

### **Will white become an omen for yellow?**

The European Court of First Instance (ECFI) has ruled that the expression "Weiße Seiten" ("white pages") is a generic term, in German language, for telephone directories for private individuals (T 322/03, 17.03.2006 "Weiße Seiten"). This decision can have a big impact on two German pending claims filed by GoYellow Media AG against Deutsche Telekom before the German Patent and Trademark Office, concerning the signs "Yellow Pages" and "Gelbe Seiten". The ECFI (on a European level) and also the GPTO has considered that both signs are not capable of protection and has therefore erased them from the Registry. Deutsche Telekom has already appealed against this decision.

### **New EU Directive to improve the enforcement of intellectual property**

The Directive 2004/48/EC on The Enforcement of Intellectual Property Rights (the "Enforcement Directive") which became effective a couple of years ago will now be implemented by the member states during the next month. The following table includes a concise list of the main provisions of the Enforcement Directive according to trademarks and other IP rights. Some of them can already be considered as "legal reality" in most of the member states. But there are also some remarkable steps of further EU harmonization. The Union of European Practitioners in Intellectual Property has drafted a matrix that will be completed soon comparing the level of implementation of the directive within the member states.

## List of the main provisions of Directive - 2004/48/EC

Licensee entitled to enforcement (art. 4.b)
Recognised IP collective rights-management bodies and professional defence bodies entitled to enforcement (art. 4.c, d)
Court order to alleged infringer to disclose specified evidence (art 6.1)
Court order to alleged infringer to communicate banking, financial or commercial documents (art. 6.2)
Preserving evidence by description or seizure of infringing goods (art. 7.1)
Seizure of materials or implements used in the production and/or distribution of these goods and documents relating thereto (art. 7.1)
Ex parte procedure for measures to preserve evidence + review (art. 7.1)
Measures to preserve evidence subject to security lodged by the applicant (art. 7.2)
Measures to preserve evidence revoked or void if proceedings on the merits are not started within prescribed time limit (art. 7.3)
Appropriate compensation if measures revoked or void because of applicant's fault or unfounded (art. 7.4)
Measures to protect witnesses' identity (art. 7.5)
Court order to infringer or other person involved in infringement to provide information on origin and distribution network (art. 8.1)
Interlocutory injunction (art. 9.1a)
Penalty against continuation of infringement, or continuation subject to lodging of guarantees (art. 9.1a)
Seizure or delivery up of infringing goods (art. 9.1b)
Precautionary seizure of alleged infringer's property including bank accounts (art. 9.2)
Ex parte procedure for provisional measures + review (art. 9.4)
Provisional measures revoked or void if proceedings on the merits are not started within prescribed time limit or (art. 9.5)
Provisional measures subject by lodging of security by applicant (art. 9.6)
Appropriate compensation if provisional measures revoked or void because of applicant's fault or unfounded (art. 9.7)
Corrective measures including recall, definitive removal from the channel of commerce or destruction (art. 10.1)
Injunction after infringement decision (art. 11)
Alternative pecuniary compensation if infringement in good faith (art. 12)
Damages assessed including lost profits, unfair profits by infringer and moral prejudice (art. 13.1a)
Alternative lump sum at least equal to royalty (art. 13.1b)
Legal costs born by losing party (art. 14)
Publication of judicial decision at the infringer's expenses (art. 15)

### Disclaimer

This BrandVue bulletin, published by World Link for Law, is not a substitute for professional advice which will take account of your specific circumstances. No responsibility can be accepted by World Link for Law or member firms for any loss occasioned by a person or organisation acting or refraining from acting on the basis of this newsletter. World Link for Law is a membership association that does not itself provide legal advice or other professional services. It provides no assurances or warranties in respect of its members, alliance partners, officers, consultants or employees past, present and future and disclaims any liability or responsibility for anything done or omitted to be done by anyone in reliance wholly or partly on advice or other services from such persons. © World Link for Law 2006.