



Carlos Moran

Elzaburu

PTMG Spring Conference 2024

International Case Round Up

Carlos Morán
26 March 2024



Nigeria

- **High Court of Nigeria, 10 July 2023, Suit No. FHC/ABJ/CS/188/2020**
- Sanofi S.A. v Sanofi Integrated Services Ltd et al.

BACKGROUND

- SANOFI trademark registered in 1987
- Company names:
 - Sanofi Nigeria Enterprises – 1992
 - Sanofi Integrated Services Ltd – 2011
 - Sanofi Nigeria Enterprises Limited - 2013

Judgement

- Infringement of SANOFI trademark by company names: trademark's priority over business names
- Different industry application irrelevant: potential harm to plaintiff's business reputation

sanofi

India

- **High Court of Madras, 8 December 2023, (T) CMA (TM) No. 72 of 2023**
- Indian Immunologicals Ltd. v. IPCA Laboratories Pvt. Ltd.

BACKGROUND

- Application of trademark “INIMOX” – medicinal and pharmaceutical preparations for veterinary use
- Opposition trademark “IMOX” – medical and pharmaceutical preparations

Judgement

- Marks derived from Active Pharmaceuticals Ingredients (APIs): weaker protection
- Amoxycilin – other registrations: “MOX”, “UMOX”, “IDIMOX”
- Use for veterinary purposes / humans
- No likelihood of confusion



European Union

- Court of Justice of the European Union, 7 September 2023, C-832/21
- Beverage City & Lifestyle GmbH et al v. Advance Magazine Publishers Inc.

BACKGROUND

- Energy drink “DIAMANT VOGUE” manufactured in Poland by Beverage City Poland
- Distributed in Germany by Beverage City & Lifestyle
- No corporate connection; exclusive distribution agreement



Judgement

- Action for infringement before the District Court of Düsseldorf
- Regulation No. 1215/2012 Brussels I recast
 - General principle Art. 4: court of the defendant's domicile
 - Exception Art. 8 several defendants, court of the domicile of any of them
 - Same situation of law – EUTM
 - Same situation of fact – identical infringement / exclusive distribution agreement

VOGUE

Spain

- **Spanish Supreme Court, 13 September 2023, No. 1222/2023**
- Schweppes, S.A. v. Red Paralela, S.L. et al.

BACKGROUND

- Schweppes trademark
 - Schweppes Ltd.: France, Germany, Italy, Portugal, Spain and other EU countries
 - Coca-Cola Group: UK, Bulgaria, Cyprus, Ireland, Greece and other countries
- Spain: more expensive
- Defendants: parallel imports from UK, Italy and Portugal



Judgement

- First instance: Preliminary ruling ECJ, 20 December 2017, C-291/16
- Exhaustion of rights:
 - Promotion of image of single global trademark
 - Coordination of commercial policies
- Second instance: No exhaustion of rights
- Supreme Court: Exhaustion of rights



European Union

- **Court of Justice of the European Union, 18 January 2024, C-367/21**
- Hewlett Packard Development Company v. Senetic

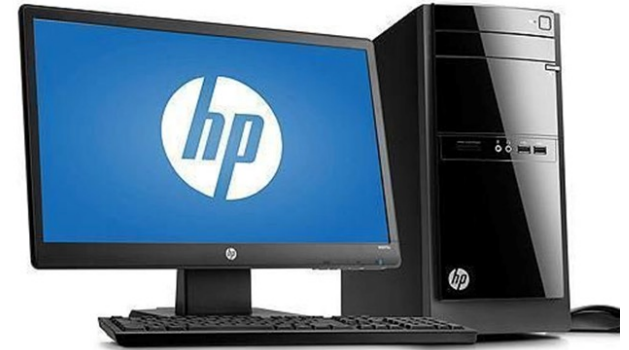
BACKGROUND

- HP Selective distribution system
- Computer hardware serial number → geographical market for sale
- Information not accessible to third parties
- Senetic resells in Poland HP computers purchased to vendors not part of HP distribution system
- The vendors declared in statements that the sale of the hardware would not infringe HP trademark rights
- Asked authorized agents for confirmation of possibility of marketing products – no response



Judgement

- Exhaustion of rights: burden of proof
- General rule: defendant
- Particular case: trademark owner – conditions:
 - Do not have any marking, which would enable third parties to determine the market on which they are meant to be sold
 - Distributed through a selective distribution system
 - Purchased by the defendant in the EEA after receiving assurances from the sellers that the goods may be sold there
 - Trademark owner refuses to carry out a verification at the buyer's request





United States



- **Trademark Trial and Appeal Board, 13 October 2023**
- Sage Therapeutics, Inc. v. Sagely Enterprises Inc

BACKGROUND



- Application for trademark SAGELY NATURALS
- Analgesics and related products, class 5
- Skin creams, lotions and related products containing CBD, class 3
- Opposition of trademarks SAGE THERAPEUTICS
- “house mark for pharmaceutical preparations”, class 5



Decision

- Marks similar
- Goods identical class 5
- Cosmetics containing CBD class 3 not similar to pharmaceutical preparations:
 - CBD not equivalent to a pharmaceutical
 - Consumers do not understand the similarity between pharmaceuticals and cosmetics containing CBD



Andean Community / Colombia



- **Andean Community Court of Justice, 13 January 2023, 45-IP-2020**
- **High Court of the Judicial District of Bogota, 20 April 2023**
- S. Tous, S.L. v. La Riviera S.A.S.

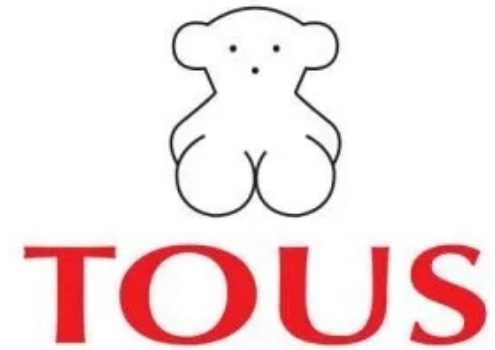
BACKGROUND

- TOUS trademarks
- Franchisee in Colombia
- Inclusion on the OFAC list ("Clinton list")
- Unilateral termination of the contract: damage to the prestige of the trademark
- Continued use of the trademarks by the franchisee



Judgement

- Action for infringement of the Tous trademarks
- Validity of unilateral termination of the contract?
- Preliminary ruling of the Court of Justice of the Andean Community
 - Determination of contract validity necessary
 - Dispute resolution mechanism set out in the contract
- Colombian High Court judgement
 - Contract correctly terminated → Barcelona court decision
 - Trademark infringement action upheld
 - Notoriety of trademarks not proved → Lower damages



Thank you!

Carlos Morán

Partner
Litigation Department
cmm@elzaburu.es

