



## Contents

Seminar invitation A practical guide to patent entitlement disputes in Europe	2
A new patent court system for Europe?	3
Germany: trade marks as meta tags	4
UK: single enantiomer patents at risk	5
Hong Kong: pubs sued for showing World Cup 2006 matches using overspill satellite signals	6
Europe: two key factors decide when a communication is made to the "public"	6
New rules on the protection of geographical indications in the EU	7
Dutch court reverses assignment of domain name	8
Taking action against music infringers in Russia	9
UK: Comptroller of patents has power to break deadlock	10
UK: Intel fails to stop INTELMARK	11
In Brief	12

## Criminal sanctions for patents - a step too far?

The Law Society of England and Wales expressed "serious concerns" about the EU Commission's proposed Directive on criminal sanctions for intellectual property rights<sup>1</sup>. In a position paper published at the end of August it recommends that any Directive should be limited to cover only counterfeiting and piracy (ie trade marks and copyright), not patents or designs.

### Scope of the proposal too wide

The Directive would oblige Member States to treat all "intentional infringements" on a "commercial scale" as criminal offences. Like the Enforcement Directive<sup>2</sup> this applies to all IP rights. In the UK criminal offences already exist for intentional infringements of trade marks and copyright but not for patents and designs. One of the main points made by the Society is that the complex nature of most patent proceedings make patents in particular an unsuitable area for criminal sanctions.

There are certainly considerable difficulties in applying criminal sanctions to patent infringement. For example, what intent and knowledge is required? Must the infringer simply intend to commit the act which is eventually established to be an infringement or must he also know of the existence of the patent? Must he know that the act falls within the claims of the patent and that the patent is valid?

Establishing an intention to infringe with the degree of certainty needed

in criminal proceedings will either be so difficult that prosecutions never happen or industry will be put in an impossible position. There will be colossal pressure to avoid risk by steering clear of all patents even those that are perceived to be invalid or not infringed.

### Commercial scale

Under the proposed Directive the offence would only be committed if the infringements are on a "commercial scale". Other than use of an invention for private or personal purposes it is difficult to see how this would exclude much at all.

As with much other European legislation in intellectual property the lack of specialist knowledge in the area is sadly apparent. More thought is required before this is taken any further.



**Robert Anderson**  
London

robert.anderson@lovells.com

<sup>1</sup> COM (2006) 168 Final 26 April 2006  
<sup>2</sup> Directive 2004/48/EC

# Seminar invitation

## A practical guide to patent entitlement disputes in Europe

Litigation on patent entitlement is bloody. The cases concern allegations that inventions have been taken unlawfully by one of the parties. Not surprisingly, where there is professional scientific pride at stake, settlement opportunities can be missed. Couple this with a recent flurry of UK Court of Appeal decisions and legislation which is less than detailed and you have a recipe for costly litigation.

### Volume of litigation unprecedented

The Court of Appeal has remarked that the current volume and value of UK High Court litigation over entitlement to patents is unprecedented. There are no signs of the volume of disputes diminishing. It is all too easy for disputes to arise as a result of the use of external organisations, including universities, to carry out research for industry. As the emphasis on the outsourcing of research continues to grow, the forecast is for these disputes to increase in frequency.

### The role of mediation

The UK is not the end of the story. The law on entitlement to patents is not harmonised - even within Europe. If things go wrong, one dispute can proliferate into litigation in multiple jurisdictions - with potentially varying outcomes. So what about binding mediation (as promoted by the English Court of Appeal) - can it deal with all the issues in one sitting?

### This seminar is an opportunity to look at and to discuss:

**Mitigating risk** - How to reduce the risk of costly litigation by correctly



*You paid for the work but your contractors say the patent is theirs*

structuring your contractual arrangements with suppliers of research services

**Managing a dispute** - Strategies for dealing with a dispute relating to patent inventorship and ownership including mediation and binding mediation

**Where best to run an action** - Jurisdictional differences in the law on entitlement across Europe and the recent developments as to when disputes should be heard in the English courts or UK Patent Office

**CPD Points:** 2 hrs

### Target Audience

In-house counsel, intellectual property specialists and others involved in research and development, design and testing of new products and services including those who have responsibility for drafting contracts that involve external contractors providing design, development and research services.

### Chair

Nicholas Macfarlane - Lovells, London

### Speakers

Guest Speaker - Peter Back, Divisional Director, The Patent Office  
Stephen Bennett - Lovells, London  
Klaas Bisschop - Lovells, Amsterdam  
Martin Chakraborty - Lovells, Düsseldorf  
Olivier Banchereau - Lovells, Paris  
Luigi Mansani - Lovells, Milan

### Date

Wednesday 8 November 2006

### Venue

Lovells, Atlantic House, London

### Registration

4.00pm

### Start of presentations

4.30pm

### End of presentations/drinks reception

6.30pm

**If you would like to come to this seminar, please email [astrid.arnold@lovells.com](mailto:astrid.arnold@lovells.com).**

## A new patent court system for Europe?

Two important judgments<sup>3</sup> issued by the European Court of Justice (ECJ) on 13 July severely limited the cross border jurisdiction of European national courts in patent litigation. In doing so they highlighted what many see as an urgent need for a pan-European patent court system. Such a system would provide a “one stop shop” for European patent holders to enforce their patents in more than one country. Following its recent consultation on patent policy the European Commission has now, at least conditionally, committed to “moving forward”<sup>4</sup> a proposal for a European Patent Court under the European Patent Litigation Agreement which was backed by Europe’s top patent judges at the end of last year.

### The two ECJ decisions

Both cases concerned the interpretation of the rules determining when the different European Member States have jurisdiction. They were both decided under the Brussels Convention, but are equally applicable under the Brussels Regulation which has now replaced the Convention for most Member States.

### The case of Roche/Primus - the spider in the web

This case concerned the situation where a number of companies within the Roche group were selling allegedly infringing pharmaceutical products in different European countries. Could the Dutch court grant injunctions against group companies which were domiciled in other European countries in respect

of the non-Dutch parts of the same European patent?<sup>5</sup> The ECJ said no. It rejected the Dutch courts’ practice known as the “spider in the web”. Under this approach the Dutch court had granted cross border injunctions in cases involving infringement by more than one company within a multi-national group provided that the controlling “spider” in the web of infringing activities was based in the Netherlands. This was based on Art 6.1 of the Brussels Convention under which co-defendants may be sued in the state in which one of them is domiciled if there would otherwise be a risk of conflicting decisions. In rejecting this approach, the ECJ said that Article 6.1 only applied where the legal and factual situation was the same. Even in a case where the defendants were members of the same group acting in concert so that one might be able to say that the factual situation was the same, the legal situation would not be the same because the European patent consists of different national patents governed by different national laws. This perhaps rather technical argument puts an end to cross border patent injunctions in Europe in most situations, though the court’s ability to grant interim relief is not affected.

### The case of GAT/LuK - the court may not judge the validity of foreign patents

This case raised the question whether the courts of one country (Germany) may decide on the validity of a patent registered in another country (France) where validity was raised only as a reason for non-infringement, not a claim to revoke the patent. The ECJ said no, rejecting the practice in some Member States of ruling on the validity of foreign patents as between the parties in the context of infringement actions. As invalidity is

almost always raised as a defence to infringement or as a ground for non-infringement on a declaration of non-infringement the issues of validity and infringement are in practice so interrelated that it is likely to be impossible for national courts to deal effectively with infringement of foreign patents at all.

### A pan-European patent court

These cases highlight the need for a pan-European patent court system to avoid the need to conduct parallel patent litigation in more than one country and the risk of conflicting judgments where, for example, a patent may be maintained as granted in one country, amended in another and revoked in a third. Currently the most likely route to achieving a pan-European system within the foreseeable future is the proposed European Patent Litigation Agreement (EPLA) developed by a working party of the European Patent Organisation. Although the EU Commission is still committed to its “pet” project – a single Community Patent covering the whole of the EU - it now appears to have acknowledged that the most immediate issue is the court system.

The draft EPLA provides for a common European Patent Court with jurisdiction to deal with infringement and revocation actions concerning European patents in more than one country and a European Patent Court of Appeal. The language regime would be that of the European Patent Convention (English, French and German are the three official languages of the EPO). Great care has been taken by the working party to ensure that the system complies with the Community legal order so that it can exist within a Community context.



Stephen Bennett  
London

stephen.bennett@lovells.com

<sup>3</sup> C-4/03 13 July 2006 Gesellschaft für Antriebstechnik v Lamellen und Kupplungsbau GAT available on www.curia.eu.int C-539/03 13 July 2006 Roche Nedeland BV v Frederick Primus and Milton Goldenberg available on www.curia.eu.int. These ECJ decisions were reported in a Lovells newflash to clients on the day the story broke. If you would like to receive such alerts on IP matters please email astrid.arnold@lovells.com

<sup>4</sup> Press Release 12 July 2006

<sup>5</sup> Although usually referred to in the singular, a “European patent” is really a bundle of separate, national patents covering the same invention but registered separately in each national patent office.

## Germany: trade marks as meta tags

The inclusion of a competitor's trade mark as an invisible "meta tag" in a web site can secure a high position for that web site in search results when users search using the competing trade mark. In this way a trader can ensure that its products are brought to the attention of potential customers who are looking for information about its competitor. The question whether this practice amounts to trade mark infringement or unfair competition has been the subject of debate in a number of European jurisdictions. In a long awaited judgment, the German Supreme Court has now decided<sup>6</sup> that under German law such use is not permissible. Loni Wagner of Lovells Frankfurt explains:

A meta tag is a piece of information in the source code of a web site. Meta tags are invisible to the internet user but can be revealed by clicking "view source". If the information contained in the meta tag is entered into a search engine, the search engine will also look for it in the meta tags of web sites which will then appear in the results of the search. The question arises whether it is lawful to use a third party's trade mark as meta tag.

### Prior to this decision the position under German law was uncertain

For a long time German case law was clear that the use of trade marks as meta tags was not permissible, either from a trade mark or from an unfair competition law point of view. According to this case law the trade mark owner's rights were infringed at the point when the search results appeared - the trade mark was regarded as having been used to distinguish the

<sup>6</sup> Judgment 18 May 2006 | ZR 183/03  
<sup>7</sup> I-20 U 195/05

## Meta data in a web site can include a list of keywords to increase the likely number of hits on the site

```
<HTML>
<HEAD>
<TITLE>Metadata - How to use Metatags</TITLE>
<META NAME="description" CONTENT="A quick guide for web designers on
how to use metadata in HTML documents.">
<META NAME="keywords" CONTENT="metadata, metatags, Dublin Core,
guidelines, web design, resources, HTML authoring">
<META NAME="Content-language" CONTENT="en">
<META NAME="author" CONTENT="mailto:iris@jarmin.com">
<META NAME="creation_date" CONTENT="February 1, 2000 00:00:01">
<META NAME="robots" CONTENT="all, index, follow">
</HEAD>
<BODY>
...
</BODY>
</HTML>
```

goods and to indicate origin. In addition claims could arise in unfair competition based on the fact that the web site owner using the meta tag was exploiting the reputation of the trade mark owner and obstructing it by diverting its customers. The unfairness arose out of the fact that by using the meta tag the web site owner was securing a position in the search results which it would not have had otherwise.

This analysis was called into question by the Düsseldorf Regional Court which - in a number of judgments culminating in its decision of 14 February 2006<sup>7</sup> - dismissed claims by trade mark owners against third parties who used their trade marks as meta tags. According to the Düsseldorf court there was no trade mark infringement because the marks were not being used in a "trade mark sense" - the use of the trade marks as meta tags was not perceived by users as a reference to the trade mark owner. On the contrary, the average, reasonably well informed consumer recognises that web site owners can manipulate search engines with the help of meta tags. From the appearance of the web site in the search results one can at most tell that the trade mark used as a meta

tag is mentioned in the text of the web site itself. The Court dismissed claims based on unfair competition on the grounds that internet users were not diverted away from the trade mark owner's site but simply also led towards the web site of the web site owner using the meta tag.

### The Supreme Court's decision restores legal certainty

Contrary to the view of the Düsseldorf Regional Court, the Supreme Court has now declared that the use of trade marks as meta tags is not permissible and so restored a desirable legal certainty. As yet we do not know whether the Supreme Court's decision was based on trade mark infringement or unfair competition, or both, as the full judgment has not yet been released.

The Supreme Court's decision opens up an opportunity for trade mark owners to challenge the use of their marks as meta tags by third parties - claiming both an injunction and damages - with a reasonable expectation of success.



Loni Wagner  
Frankfurt

loni.wagner@lovells.com

## UK: single enantiomer patents at risk

Following a Court of Appeal ruling<sup>8</sup> it appears that Ranbaxy Laboratories, the Indian generics company, is unlikely to be able to proceed with plans to introduce a generic version of Pfizer's best selling cholesterol drug, Lipitor, in the UK before 2011.

Ranbaxy had applied for a declaration of non-infringement in relation to Pfizer's main patent protecting atorvastatin which is the active ingredient in Lipitor. Ranbaxy argued that the main claim of Pfizer's patent covered only the

### There was no rational basis for supposing that the patentee would want to exclude the commercially important substance

The patent told the skilled person to make the substance by a method which could only produce a racemate and included a drawing which might be the pure enantiomer but might also be the racemate. The court applied the principles of construction in the Amgen case<sup>9</sup> which emphasised that the claims must be construed in the context of the patent as a whole including the specifications and drawings. Lord Justice Jacob agreed with the trial judge that it was clear that the claim covered the racemate and the individual enantiomers. There was

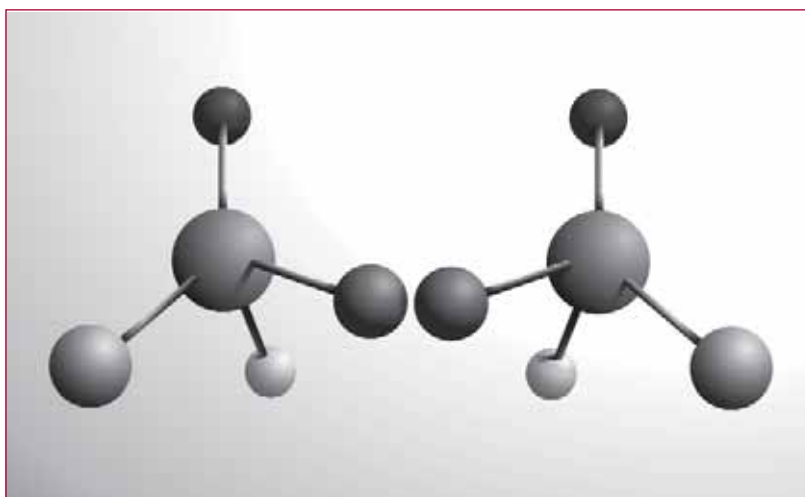
non-infringement was refused.

### Business common sense

This case is a good illustration of the application of the principles in the Amgen case which emphasise that the claims must be read in context. Jacobs quotes Lord Diplock in the Antaios case<sup>10</sup> who said "if detailed and semantic analysis of words ... is going to lead to a conclusion that flouts business common sense, it must be made to yield to business common sense." This applied to patent claims. Here it did not make business common sense to suggest that the patentee had intended to exclude the pure enantiomer.

### Increased generic activity in attacking single enantiomer patents can be expected

The Court of Appeal said that a second Pfizer patent covering the pure enantiomer of the calcium salt of Lipitor was anticipated and invalid in the light of the prior disclosure of the racemic mixture. Whilst the loss of the single enantiomer patent does not adversely affect Pfizer's position in this case the decision will be a good indicator of the court's likely hostile attitude to further single enantiomer patents. Given the large number of single enantiomer pharmaceutical products (such as Lundbeck's escitalopram and AstraZenica's Nexium) on the market, generic activity in attacking the patents protecting these products can be expected.



*A pair of enantiomers: disclosure of the racemate was held to disclose the commercially important pure enantiomer also*

racemate and that it would not be infringed by a product (such as Ranbaxy's product) containing the pure enantiomer which is the commercially important substance. (Enantiomers are molecular entities which are mirror images of each other and non-superposable. A racemate is a mixture of a pair of enantiomers.)

nothing to suggest that the patentee had intended to exclude the pure enantiomer and there was no rational basis for supposing that the patentee would want to do so - quite the opposite, it would be obvious to the skilled man that it was the pure enantiomer that mattered. Properly construed, in context, the Judge said that the claims would be infringed by a product containing the pure enantiomer. The diagram in claim 1 could also be regarded as referring to both the racemate and the pure enantiomer. The declaration of



**Daniel Brook  
London**

daniel.brook@lovells.com

<sup>8</sup> Ranbaxy UK Ltd and another v Warner-Lamert Company [2006] EWCA Civ 876 available on [www.bailii.org](http://www.bailii.org)

<sup>9</sup> [2005] 1 All ER 667

<sup>10</sup> [1985] AC 191

## Hong Kong: Pubs sued for showing World Cup 2006 matches using overspill satellite signals

Hong Kong Cable Television (HKCTV) obtained an exclusive licence from FIFA to broadcast World Cup 2006 matches in Hong Kong. Several pubs in Hong Kong chose not to subscribe for HKCTV and instead showed World Cup 2006 matches using “overspill” satellite signals originating from overseas broadcasters based in the Philippines and South Africa captured with decoders and SIM cards. In late July 2006, FIFA and HKCTV brought civil actions before the Court of First Instance of Hong Kong against a number of such pubs.

These civil actions were brought on the basis that the public showing of the matches using overspill signals and the possession of overseas decoders and SIM cards constitutes copyright infringement under various provisions of the copyright law in Hong Kong. In particular, the copyright law prohibits the following acts:

- playing or showing a broadcast (eg. the World Cup matches) without the licence or authorisation of the copyright owner. The overseas satellite broadcasters were only licensed by FIFA to broadcast their matches within their countries. Hence the public showing of the matches in Hong Kong using the signals of these overseas broadcasters were unauthorised activities.

- possessing in the course of business any article specifically designed or adapted for making infringing copies of the broadcast (ie. the decoders and SIM cards); and
- permitting such decoders and SIM cards to be brought onto the premises of the pubs, knowing that they would be used to infringe copyright in the broadcast.

FIFA and HKCTV are seeking injunction orders to stop the pubs from capturing overspill signals in the future and have requested delivery up of the decoders or SIM cards. These civil actions are meant to send a strong message to pubs and other food and beverage outlets in Hong Kong that proper licences should be obtained from local broadcasters before showing World Cup, English Premier League or other sports programmes.



**Gabriela Kennedy  
Hong Kong**

[gabriela.kennedy@lovells.com](mailto:gabriela.kennedy@lovells.com)

## Europe: two key factors decide when a communication is made to the “public”

European copyright law was partially harmonised by the Copyright Directive.<sup>11</sup> This Directive introduced the author’s right to control the “communication to the public” of his work. This is an important provision in a digital context among other things because it includes the making available to the public of copyright works “in such a way that members of the public may access them from a place and at a time individually chosen by them”, so that it clearly includes interactive (on demand),

on-line services and other situations in which users access the material. The Directive does not, however, define the term “public”. An opinion<sup>12</sup> issued by the European Court of Justice in July explores the meaning of “public”.

The case concerned television sets in hotel rooms for the guests’ use. The television signals were received by the hotel’s main aerial and then distributed to each of the rooms in the hotel by cable. So there was clearly a communication – but was it to the “public”? The Advocate General rejects the idea that “public” should be construed in accordance with national law. The harmonising effect of the provision would be a “dead letter” if Member States were free to define one of the fundamental elements in different ways. The question whether a communication was to the “public” would depend on two key factors, the extent of the circle of potential recipients of the communication and its economic significance for the author (of the copyright work). In the case of television sets in a hotel, only one or two people are likely to view each set at any one time. However, cumulatively the circle of potential recipients was extensive and was of economic significance.

There was in this case also clearly an economic benefit to the hotel. However, the Advocate General reserved her position on whether an economic benefit to the person making the communication was also necessary for the communication to be regarded as being to the “public”. The court is not obliged to follow the opinion of the Advocate General but it often does.



**Astrid Arnold  
London**

[astrid.arnold@lovells.com](mailto:astrid.arnold@lovells.com)

<sup>11</sup> Directive 2001/29/EC of 22 May 2001  
<sup>12</sup> Case C-306/05 13 July 2006 SGAE v Rafael Hoteles SL

## New rules on the protection of geographical indications in the European Union

The European Commission recently launched various new initiatives in relation to the protection of geographical indications (GIs) in the European Union. A new regulation on GIs for agricultural products and foodstuffs was adopted in March 2006, a proposal for a new spirits regulation providing for a GI registration system was published in December 2005, and a GI registration system for wines is being discussed in the context of the reform plans for the wine sector.

### A new GI regulation for agricultural products and foodstuffs

An adaptation of the EU's protection system for GIs for agricultural products and foodstuffs had become necessary as a result of WTO dispute settlement proceedings between the USA and Australia, on the one hand, and the European Union (EU), on the other, concerning the previous GI regulation (Regulation 2081/92). The EU had to change its GI system by April 2006 to ensure equal treatment of non-EU based entities and non-EU GIs and to abolish existing discriminations. The new Regulation (510/2006) entered into force on 31 March 2006. Applications for non-EU GIs and objections by non-EU entities can now be filed directly with the Commission without the need to pass through the authorities of the non-EU country of origin as had been required under Regulation 2081/92. So far, no non-EU GI has been registered, although there is a pending application (Café de Colombia).

For trade mark owners and traders using generic terms in the commercialisation of their products, Regulation 510/2006 raises certain concerns. It may lead to a higher potential for conflicts between GIs and the rights and interests of third parties, for instance, through the expansion of the definition of the protectable terms. The stakes for filing objections appear heightened as grounds for objections (except for the non-applicability of the conditions of a geographical indication or designation of origin under Article 2) will be evaluated in relation to the territory of the Community. However, the Regulation stipulates that in the case of intellectual property rights (such as trade marks), this refers only to the territory or territories where the rights are protected.

### A proposal for a new spirits regulation suggesting a GI registration system

On 15 December 2005, the European Commission presented a proposal on the definition, description, presentation and labelling of spirit drinks which is intended to replace the currently applicable Regulation 1576/89. Both the current regulation and the proposal contain a list of protected GIs. In addition, and this is new, the proposal aims at setting up a GI registration system for terms not on this list. The proposal contains detailed rules on a registration procedure (which appears to be available for non-EU GIs) and the scope of protection for GIs which resemble the protection system under Regulation 510/2006, although with some differences. It is noteworthy, for instance, that the grounds for objection appear to be framed more narrowly and that the existence of prior trade mark rights is not explicitly listed as a ground for objection. It remains to be seen whether this will be clarified in the course of the further legislative process.



### Reform plans for the wine sector suggesting a GI registration

In June of this year, the European Commission published plans for a comprehensive reform of the wine sector. In respect of wine GIs, the Commission favours an alignment of the wine rules with the horizontal quality policy for protected geographical indications and protected designations of origin. Concretely, the Commission suggests the introduction of two classes of wines: wines with geographical indication (further divided into wines with protected geographical indication and wines with protected designation of origin) and wines without geographical indication. It suggests the introduction of a procedure for the registration and protection of wine GIs. The Commission indicated that a legislative proposal will follow in the course of 2006 or in early 2007.

### GI protection still a priority issue for the EU

GI protection remains a core concern of the EU's agricultural policy, as the various initiatives of the Commission in this sector show. The trade mark community will follow with interest whether further provisions relating to third party rights will be added to the spirits proposal during the legislative process and how the relationship between trade marks and GIs will be defined in a possible GI registration system in a new wine market regulation. It also remains to be seen to what extent the use of generic terms will be affected by the new rules.



Constanze  
Schulte  
Madrid

constanze.schulte@lovells.com

## Dutch court reverses assignment of domain name

Which company would one think of when seeing the domain names: fortiscasino.com, fortispoker.com and fortisblackjack.com? In Benelux it is quite likely that Fortis N.V. ("Fortis"), the reputable Benelux-based financial services provider, would come to mind. The next thought to cross one's mind might well be: "Since when has Fortis expanded its activities to include casino gaming services? How inappropriate for a financial services provider." And that thought is exactly what bothered Fortis, as the three domain names mentioned above were actually not registered in the name of Fortis or even related to Fortis at all.

### The domain names were registered by a gaming concern

In fact, Club Cruise Entertainment & Travelling Services Europe B.V., a company that provides, among other things, casino gaming services, registered these domain names in June 2005. Moreover, nine other casino games related FORTIS-domain names were registered in the name of Club Cruise or its owner-manager Mr. Van Leest.<sup>13</sup>

Not surprisingly, Fortis also uses the designation 'FORTIS' in various domain names, for example: fortis.com, fortisbank.com and fortisfoundation.nl. It registered 'FORTIS' as a Benelux trade mark in 1991. As it is a well-known trade mark in Benelux, Fortis may oppose the use, in the course of trade, of a sign similar to this trade mark, if this use is without due cause and takes unfair advantage of or is detrimental

to the distinctive character or the repute of this trade mark.<sup>14</sup> Thus, Fortis decided to take legal action against Club Cruise and Mr. Van Leest.

### Club Cruise had assigned the domain names to a third party after receiving Fortis's letter before action

Fortis requested a cease and desist order that would prohibit Club Cruise and Mr. Van Leest from using its Benelux trade mark 'FORTIS' or any similar sign. It was also keen to have the infringing FORTIS domain names transferred to itself. However, six of the domain names had been transferred to a company called Domains by Proxy, Inc. ("Proxy") after the receipt of the letter before action. How could transfer to Fortis now be accomplished? The solution that Fortis found was as follows: it asked the court to order that 1) Club Cruise would reverse the transfer of its FORTIS domain names to Proxy and 2) Club Cruise and Mr. Van Leest would then transfer their FORTIS domain names to Fortis.

### The image of casino games was detrimental to the reputation of Fortis' trade mark for financial services

When assessing Fortis' claim, the court<sup>15</sup> considered the following. The most distinctive element of the domain names is the term 'FORTIS', since all the additional elements are common designations for casino games. As such, it considered the domain names similar to the Fortis' trade mark. Further, as Club Cruise and Mr. Van Leest did not succeed in establishing that they have a legitimate reason to use 'FORTIS', the court also assumed that their use was without due cause. Finally, according to the court, the domain names caused detriment to the repute of the 'FORTIS'-trade mark,



Logo of the Dutch financial services company Fortis N.V.

as 1) they suggested that Fortis is also active in the casino gaming industry, and 2) such a suggestion is harmful to Fortis, a financial services provider. The court therefore concluded that Club Cruise and Mr. Van Leest infringed Fortis' trade mark.

### Had the infringer escaped justice by assigning the domain names?

The remaining question was whether the fact of the assignment of six of the domain names would prevent the court from ordering Club Cruise to make sure that these domain names were transferred to Fortis. The court held that the domain name transfers to Proxy were unlawful as Club Cruise must have been aware of Fortis' rightful claims on these domain names at the time of these transfers, in view of the cease and desist letter it received from Fortis. The court therefore granted Fortis' claims, including the reversal of the transfer of the domain names to Proxy. Hence, a trade mark owner contesting a domain name is not necessarily left empty-handed when the contested domain name is transferred to a third party shortly before or during litigation.



Win Yan Lam  
Amsterdam

winyan.lam@lovells.com

<sup>13</sup> <fortisbingo.com>, <fortisbackgammon.com>, <fortisgames.com>, <fortissports.com>, <fortismahjong.com>, <fortismonopoly.com>, <fortiscasino.eu>, <fortisbingo.eu> and <fortispoker.eu>.

<sup>14</sup> Article 13A section 1 sub c of the Benelux Trademark Act / Article 2.20 section 1 sub c of the Benelux Treaty on Intellectual Property.

<sup>15</sup> District Court Utrecht 22 May 2006, DomJur 2006-263, Fortis / Club Cruise & Van Leest.

## Taking action against music infringers in Russia

In the middle of July the British Phonographic Industry (BPI), which represents the British recorded music industry, announced that it had been granted leave by the UK High Court to serve proceedings in Russia on AllofMp3.com, the popular music download site and its owner Media Services, a Moscow based company.

AllofMP3.com is reported to be the UK's second most popular download site, accounting for 14% of UK music downloads. Its prices are very much below other such sites - albums can be downloaded for as little as \$0.75. The BPI refers to AllofMp3.com as a "pirate" music site. In a letter to the British foreign secretary, Margaret Becket, in which he urges her to intervene with President Putin on this matter, Peter Jamieson, chairman of BPI says:

"The website is doubly damaging because it encourages consumers to believe that royalties are paid to artist and record companies. In fact, no such arrangements are in place with British rightsholders."

AllofMp3.com claims that it operates legally under Russian law (though this has been disputed). Its User Agreement appears to leave it up to users outside Russia to check whether downloading from the site is legal in their country. BPI's complaint concerns mainly what happens in the UK.

### How difficult would it be to pursue a claim in Russia?

It is unclear whether BPI really intends to pursue a claim in Russia. However, the question arises - how

difficult would it be to pursue such a copyright infringement claim in Russia?

It is questionable whether BPI would be successful in enforcing its rights in Russia. First, due to the lack of bilateral treaties between the UK and Russia, there is no efficient procedure which would allow a British-based claimant to seek enforcement of a British ruling in the Russian courts.

It is more likely that BPI would need to consider initiating a separate action in the Russian courts seeking relief under Russian copyright legislation. Secondly, while Russian copyright legislation is relatively advanced and provides for the possibility of stopping copyright infringement on the Internet (at least there are relevant precedents where compensation for copyright violations on web sites situated in the .ru domain has been given), it is unclear how easy it would be to enforce such a decision in practice and actually achieve the removal of the infringing materials from the web. The reason for this is that Internet-related violations are relatively unfamiliar for judges and bailiffs in Russia and are not always easily enforced in practice.

### Lack of experience and conservative approach of prosecutors

Previously, there have been attempts by major international companies - right holders and copyright associations - to initiate a criminal case against AllofMp3.com. However, the Russian enforcement authorities have so far not been of the view that present violations by AllofMp3.com are tantamount to criminally punishable copyright infringement.

This situation results mainly from the lack of experience and conservative approach of the police

and prosecutors in handling Internet-related violations. While the number of web disputes (such as domain name disputes) which have been considered efficiently by Russian courts under our civil procedure is substantial, the chances of success of potential criminal actions against cybersquatters and other infringers on the Internet would in most cases be doubtful.

Despite the above, it is possible that eventually BPI could nevertheless be successful in Russian based proceedings due to the fact that in the last few months the Russian government and enforcement authorities have repeatedly expressed their concern about counterfeit activity and expressed a willingness to enforce the legislation more actively.



Pavel Arieivich  
Moscow

pavel.arieivich@lovells.com

## UK: Comptroller of Patents has power to break deadlock

On 23 June 2006 the UK Court of Appeal upheld a first instance decision confirming that the Comptroller (a UK Patent Office representative) has jurisdiction on the application of a co-proprietor of a patent to order that a licence under the patent should be granted to a third party<sup>16</sup>. The case concerned the interpretation of section 37 Patents Act 1977, and in particular, the extent to which the powers granted to the Comptroller under that section go beyond the power to interpret the pure legal rights of the co-proprietors.

### Background

Mr Hughes and Mr Paxman are the registered co-proprietors of a patent for a beverage cooler. They formed a company to exploit the patent, but subsequently fell out leaving the company deadlocked. Mr Paxman wished to exploit his rights in the patent by granting a licence under the patent to a third party company to distribute and sell the coolers in the UK. However, section 36 of the Act provides that a co-proprietor of a patent needs the consent of the other co-proprietor(s) to licence a share in a patent. Mr Hughes refused his consent.

The consent requirement in section 36 is, however, expressly subject to section 37 which provides that, upon a referral from a person having an interest in a granted patent (in this case Mr Paxman), the Comptroller may determine whether any rights in the patent should be transferred or granted to another person. The Comptroller can make such order as he thinks fit, including an order granting a licence under the patent to a third party.

### Arguments

Mr Hughes argued that Mr Paxman's reference under section 37 should be struck out on the basis that section 37 is limited to determination of legal rights, and does not confer a wide jurisdiction for the Comptroller to grant, or order a co-owner to grant, a licence to third parties. Further, Mr Hughes argued that it was unlikely that Parliament would confer such a wide discretion on the Comptroller because the Comptroller is given no guidance as to what to take into account when exercising this discretion (unlike the other provisions permitting the grant of a compulsory licence where Mr Hughes argued the Comptroller's discretion is much more confined). Therefore Mr Hughes argued that the suggested jurisdiction was so vague that it was arbitrary, and that such an arbitrary jurisdiction should not be read into the Act because it violated the principle of legal certainty under the European Convention on Human Rights.

### Court of Appeal Decision

The Court of Appeal confirmed that the Comptroller does have jurisdiction to grant such a licence, and rejected Mr Hughes' arguments for the following reasons.

Firstly, Parliament could not have intended it to be possible that exploitation of an invention could be frustrated by a deadlock situation. The whole point of the patent system was and is to encourage innovation and the exploitation of inventions. That is why the Act provides a compulsory licence to deal with patented inventions that have not been exploited.

This is supported by the fact that, pursuant to an amendment to the previous legislation (which was in effect for 45 years without criticism), jurisdiction went beyond the mere

power to determine rights, and allowed the breaking up of a deadlock produced by insistence of one co-owner on his right to prevent the others from dealing with the patents.

Finally, the criteria listed in section 50 of the Act in relation to grant of compulsory licences did little more than list the factors the Comptroller would have to take into account if he was to act rationally, fairly and proportionately having regard to all the circumstances of the case. The only thing that section 50 added was, in effect, that the Comptroller should have regard to the very reason why the compulsory licence was to be granted, ie non-working of the invention in the UK. So in practical terms the Comptroller is given as much of a free hand under the compulsory licence sections as under Section 37. Therefore there was no basis for the argument that the Comptroller's discretion under section 37 is too wide.

Accordingly, the Court held that, so long as the Comptroller acts rationally, fairly and proportionately and has regard to all the circumstances of the case, there is no arbitrary power but merely the power to produce a fair commercial solution when co-owners cannot agree.



**Katherine  
McConnell**  
London

katherine.mcconnell@lovells.com

<sup>16</sup> Hughes v Paxman [2006] EWCA CHIV 818

## UK: Intel fails to stop INTELMARK

Global technology giant Intel Corporation Inc. failed in an appeal to overturn a decision allowing CPM United Kingdom Limited to retain the UK trade mark INTELMARK<sup>17</sup>. The decision is indicative of the level of protection which owners of ubiquitous global brands such as INTEL can hope to obtain from the UK Courts.

CPM registered its mark on 5 September 1997. Intel applied to the UK Trade Marks Registry to have it declared invalid under section 5(3) of the Act (see box) on the basis that it had a large number of UK trade marks and Community Trade Marks for INTEL covering a variety of goods and services in Classes 9, 16, 38 and 42 and that it had a very strong reputation in the mark INTEL. CPM's registration was for marketing and telemarketing services in Class 35.

### Intel said not enough weight had been given to its reputation

The Hearing Officer dismissed Intel's claim at first instance, being unconvinced that there would be any material damage to the distinctiveness or reputation of the INTEL brand. Intel appealed to the High Court, arguing that the Hearing Officer had failed to give due consideration to the strong reputation of the INTEL brand and its distinctive character and that the Hearing Officer had not properly applied section 5(3) in considering his decision.

Patten J held that the making of an association or link between the two marks is not in itself sufficient for detriment or unfair advantage. For "unfair advantage" to be proven, the perceived link between the two

## Section 5(3) Trade Marks Act 1994:

A [an identical or similar] trade mark shall not be registered if or to the extent that, the earlier trade mark has a reputation in the United Kingdom ... and the use of the later mark without due cause would take unfair advantage of or be detrimental to, the distinctive character or the repute of the earlier trade mark.

marks must have economic consequences which benefit the owner of the later mark. The concept of economic consequence and benefit attained by the link between the marks is integral to the concept of unfair advantage.

However in the case of "detriment", the position is more complicated. The link could cause detriment by diluting the earlier mark or by tarnishing it through association. The test in section 5(3) is written in the conditional tense whilst Article 5(2) of the EC Trade Mark Directive by contrast, from which the test derives, uses the present tense. CPM's counsel therefore argued that the absence of "would" meant that the test requires actual, as opposed to potential, unfair advantage or detriment to be demonstrated before any action can be taken. Patten J pointed out that it was important not to confuse the need to prove a particular consequence with the means of providing that proof and reiterated the Court's right to consider the factual evidence of strength of reputation and similarity between the marks and thus infer unfair advantage or detriment should such consequences be reasonably foreseeable.

### Intel's reputation not omnipresent

On the evidence presented to him in the Registry, the Hearing Officer held that whilst the reputation of Intel was pervasive, it was not omnipresent. While he accepted that some customers may make

an association between INTEL and INTELMARK, the numbers of such customers, and the nature and duration of any association that they may make, did not take unfair advantage of Intel's mark. No direct link was made and any link that could be inferred on the evidence available did not give such an economic advantage to CPM that it attracted more customers.

Detriment can take the form of dilution or tarnishing. Patten J agreed with the Hearing Officer that dilution could not be inferred given the dissimilarity between Intel's products and CPM's services and between INTEL and INTELMARK.

The judgment serves as a reminder that there are limits to the protection that major brand and mark holders are provided by the anti-dilution provisions of UK trade mark law.



Sahira Khwaja  
London

sahira.khwaja@lovells.com

<sup>17</sup> Intel Corporation Inc. and CPM United Kingdom Limited [2006] EWHC 1878 (Ch)

---

# In Brief

---

## Wasted costs do not justify stay

In an action<sup>18</sup> relating to a patent for intravenously injectable immunoglobulin the English High Court refused to grant a stay pending the outcome of opposition proceedings at the European Patent Office (EPO).

The patentees, Bayer, argued that a stay would avoid the substantial costs of the English proceedings being wasted if the patent was knocked out at the EPO. Sales of relevant products were not very large in pharmaceutical terms. Was it justified to risk the waste of a substantial sum of costs in respect of a comparatively modest trade? The EPO opposition proceedings would, at the very earliest, be decided at the end of 2007 whereas the English proceedings were due to be heard in March 2007.

### Earlier certainty balanced against extra costs

The balance was therefore between an earlier certainty in relation to the UK in March/April 2007 and a potential waste of a substantial sum in costs. Mr Justice Pumfrey decided against a stay. He acknowledged that such cases are difficult to decide, commenting "How one should trade the desire for certainty on the one hand against a potential waste of costs on the other is far from clear to me." However, he said that where both sides are able to pay the mere question of the wasted costs cannot justify a stay unless the potential

18 Baxter Healthcare and others v Bayer Corporation and others [2006] EWHC 1890

19 Scansafe Limited v Messagelabs Limited [2006] EWHC 2015 (Pat)

waste is so disproportionate to the interest to be protected that the refusal of a stay amounts to an injustice. The case underlines yet again the inconvenience and expense caused to patent holders by the slow progress of opposition proceedings at the EPO.

## Oh what a tangled web we weave....

An English High Court case<sup>19</sup> highlighted the difficult branding issues which can arise if a company provides its services on a "White Label" basis - ie allows others to sell them under their own trade marks.

The case related to an internet security service provided by the claimant, ScanSafe, for controlling employees' access to the internet at work. Under a reseller agreement between the claimant and the defendant, MessageLabs, the defendant, was permitted to sell the claimant's service as a package with the defendant's own email security service (which filters out spam, viruses and other harmful content). Both services were provided under the defendant's trade mark so that customers were mostly unaware of ScanSafe's involvement. All went well until, as permitted under the agreement, the defendant developed its own internet security service to replace ScanSafe for its customers. The claimant applied for an interim injunction. It argued, among other things, that statements made by the defendant suggesting that its new system was an updated version of the existing system amounted to passing off.

### No common technical origin

Was the defendant obliged to make it clear to customers that the new system was the first version of a web security service to be developed by the defendant - ie that it did not share a common technical origin with ScanSafe's existing, successful system? Although one can certainly see why the claimant might have felt that the defendant was "trading off its back" in presenting the new system as version two of the existing system, a difficulty in deciding whether there was passing off in this situation arose, among other things, out of the fact that ScanSafe had itself permitted the defendant to brand and sell the service as its own and so to build up goodwill for its own benefit.

### Difficult law

Mr Justice Patten said that a permission to brand goods as one's own does not, without more, carry with it the right to trade on the reputation of those goods in order to market a similar product from another source. Describing this as "difficult law", however, he said that whether such a misrepresentation could be actionable as passing off was a matter for the trial judge to consider: "it may be that the correct answer is that this is not passing off at all, but a species of injurious falsehood actionable on slightly different principles". We await the court's analysis with interest.

From a practical point of view the case highlights the importance of the exit arrangements in commercial agreements such as reseller agreements and the need to focus on branding and other

issues which may arise when the relationship ends. Such matters are often not in the parties' minds at the beginning of the relationship.

## A bag to go with your shoes?

Italian shoe designer Sergio Rossi lost its battle to prevent registration by another Italian fashion house of the word mark SISSI ROSSI, as a community trade mark for, among other things, ladies' bags.

In a judgment given on 18 July the European Court of Justice (ECJ) rejected Sergio Rossi's final appeal<sup>20</sup>. Sergio Rossi had argued that there is a likelihood of confusion between SISSI ROSSI for bags and its own earlier mark MISS ROSSI, registered in France and Italy, for footwear. The ECJ, however, refused to overturn the Court of First Instance (CFI) decision that there was insufficient similarity between the marks and goods for a likelihood of confusion to arise. As is often the case the ECJ emphasised in its judgment that it could not substitute its assessment of the facts for that of the CFI - the appeal lies only on a point of law. The ECJ will not review the CFI's appraisal of facts and assessment of the evidence unless there has been a distortion of the evidence, which was not the case here. The CFI decision attracted much criticism because of its finding that ladies' bags and shoes were not similar goods. It is worth noting, however, that the CFI did not rule out the possibility that had the marks been identical there would have been sufficient similarity between the goods for a likelihood of confusion to arise.

## Ghostly presence of the Community Patent Convention

The Community Patent Convention has never been implemented. Nevertheless it is referred to in the English Patents Act for interpretation purposes. S130(7) says, broadly, that certain provisions of the Act are to be construed in accordance with the Convention. In a patent entitlement dispute relating to a patent for a cancer treatment, the English Court of Appeal had to consider whether the Convention should be used for interpretation even though it is not yet in force.

The answer was yes. It would not make sense for this interpretation provision to be "switched on" only if and when the Convention came into force, not least because at that point cases already decided under the section would need to be re-considered.

The provision being considered in this case was a relatively minor one (section 37(5)) prescribing a two year limitation period for claims challenging the ownership of a granted patent. However, the judge, Jacob LJ, pointed out that cornerstone provisions of the Act were also subject to interpretation in accordance with the Convention, for example section 60 governing infringement. Other European countries had also enacted Convention provisions with the aim of harmonisation.

### Amendment of joint ownership claim to sole ownership claim was time barred

The case concerned a claim by Yeda Research and Development Company Ltd (which is responsible for technology transfer from Israel's Weizmann Institute of Science).

Yeda made a claim for joint ownership of the invention within the two year limitation period. However, after that period had expired they sought to amend the claim to one of sole ownership. Jacob LJ held that the claim for sole ownership was a new claim and time barred under Section 37(5). In coming to this decision he emphasised particularly the patentee's need for certainty. If the patentee has a claim against him for joint ownership, then from a commercial point of view, he knows that even if the claim is successful he can still exploit the patent so that his investment in that respect will not be wasted. If, however, a claim for sole ownership was successful, his investment would be wasted. The patentee therefore needs the certainty that no claim for sole ownership will be raised after the time limit.

### Amendment from sole ownership claim to joint ownership claim would not be time barred

By contrast Jacob accepted that where the original claim was for sole ownership, an amendment claiming joint ownership would not be regarded as a new claim and would therefore not be time barred if made after the two year time limit – the greater includes the lesser so that the original claim for sole ownership would be regarded as including within it a claim for joint ownership. The logic of this approach was questioned by one of the other judges, Sir Anthony Clarke, Master of the Rolls – how could it be right that a claim for sole ownership implicitly includes a claim for part ownership where the initial claim is one for sole ownership but where the initial claim is for joint ownership that claim is to be regarded as separate? However, he shied away from entering a dissenting opinion on this point as he deferred to the greater experience of Jacob LJ in this area.

<sup>20</sup> 20 LIB02/CM3AA/1991611.2

## A series of entitlement actions

This is one of a series of entitlement actions which have recently come before the English courts emphasising the acrimonious nature of many of these disputes which generally involve allegations that inventions have been taken unlawfully by one of the parties. The law on entitlement is not harmonised across Europe, so that if there is a cross border dimension - often the case in large projects - there is the potential for different outcomes in different countries. Lovells have organised a seminar on this topic on Wednesday 8 November 2006 to which you are invited - please see the announcement on the inside cover of this newsletter.

## European Commission consults on online content

The European Commission launched a public consultation on ways to stimulate the growth of a true EU single market for online digital content, such as films, music and games.

Its aim is to encourage the development of "innovative business models" and to promote the cross-border delivery of diverse online content services. It is also "keen to ascertain how European technologies and devices can be successful in the creative online content markets". Viviane Reding, the Information Society and Media Commissioner said: "Easy access to and secure distribution of, online content is a crucial challenge. I expect input to [the] consultation to identify clearly any remaining obstacles to a competitive pan-European online content industry which the EU needs to tackle. Only a cross-border market for online

content, in which authors, artists and creators are able to reap a fair reward for their talent and skills, will enable Europe's content sector to compete with other continents." The deadline for replies to the consultation is 13 October 2006

## UK Trade Marks Registry to end examination on relative grounds in October 2007

Following a recent consultation the UK Trade Marks Registry has announced that it intends to stop examining on the relative grounds.

Currently when an application for a UK trade mark is made to the UK Trade Marks Registry they examine it both on the absolute grounds – for example, is it too descriptive? – and also on the relative grounds – ie does it conflict with earlier marks? The search conducted by the Registry to identify conflicting trade marks includes all trade marks which are protected in the UK: UK national marks, Community Trade Marks (CTMs) and international marks under the Madrid system. This is in contrast to the Community Trade Mark Office in Alicante which only examines on the absolute grounds, leaving the owners of existing marks to raise objections on the relative grounds.

## Increasing tensions between the UK and CTM regimes

Following a recent consultation, the Registry has now decided to stop examination on the relative grounds. The primary reason given for this is to overcome the "increasing tensions between the UK and CTM regimes and the practical difficulties this creates." Under the new regime, which is

expected to enter into force in October 2007, the Registry will still carry out a search. Having carried out the search, however, it will simply inform both the trade mark applicant and any owners of conflicting trade marks. It will then be up to the earlier trade mark owners to oppose the application if they object to it. This approach overcomes one of the major objections raised by small business in particular that in the absence of examination on relative grounds they would not be aware of any conflicting marks before it was too late to oppose and they would be obliged to employ commercial trade mark watching services to alert them to potentially conflicting applications.

In our view it is not enough to rely on the Registry to inform you of potentially conflicting marks as they make take a much narrower view of what is acceptable. Watch services are relatively cheap and we would be happy to discuss setting them up with any client.



**Astrid Arnold**  
London

[astrid.arnold@lovells.com](mailto:astrid.arnold@lovells.com)



**India Forsyth**  
London

[india.forsyth@lovells.com](mailto:india.forsyth@lovells.com)



**Daniel Brook**  
London

[daniel.brook@lovells.com](mailto:daniel.brook@lovells.com)

---

# <.hk> Chinese Domain Name registrations - to be available soon -

---

## Chinese <.hk> domain names

Hong Kong Domain Name Registration Company (HKDNR) is soon to introduce Chinese language .hk domain names in the following categories: .hk, .個人.hk, .公司.hk, .組織.hk, .網絡.hk, .政府.hk and .教育.hk (which correspond to .hk, .idv.hk, .com.hk, .org.hk, .net.hk, .gov.hk and .edu.hk, respectively).

It will be possible to register .hk Chinese Domain Names in both simplified and traditional character forms as well as in a combination of both. Chinese Domain Names may also contain English letters, numbers or symbols. A .hk Chinese Domain Name registration will cover all character variations of the subject domain name. For example, the registration of '遊戲.hk' will also cover and preclude the simultaneous registration by a third party of '遊戲.hk', '游戏.hk', '游戲.hk' and '遊戏.hk'.

## Soft Launch

HKDNR is introducing a three-tiered priority period known as the 'Soft Launch Period', during which .hk Chinese Domain Names will be allocated to applicants not on the usual 'first come first served basis', but rather on the basis of prior trade mark and/or English <.hk> domain name registrations or on the basis of a random draw. Applications received during each phase of the Soft Launch Period will be processed together and allocated in accordance with the special requirements and procedures set out in the Soft Launch Period Rules (which supplement the original Rules). At the end of each phase of the Soft Launch Period, the

allocation results for that phase will be announced and members of the public will be given an opportunity to file objections before the registrations become effective. Dispute resolution services will be provided during the Soft Launch Period.

## Soft Launch Period

### Priority Period: 28 September - 10 November 2006\*

During the Priority Period, owners of Hong Kong registered trade marks containing one or more Chinese characters will be entitled to apply for a .hk Chinese Domain Name. Where two or more eligible trade mark owners apply for the same .hk Chinese Domain Name, priority will be given to the applicant holding an English <.hk> domain name in the same domain name category, or the applicant whose English <.hk> domain name has the earliest priority date. Where none of the applicants has an English <.hk> domain name in the same domain name category, the allocation will be made by random draw.

### Pre-registration Period: 4 December 2006 to 5 January 2007\*

During the Pre-Registration Period, holders of English <.hk> domain names will be entitled to apply for a .hk Chinese Domain Name in the same category as their existing English domain name. Where two or more holders of English <.hk> domain names apply for the same .hk Chinese Domain Name, priority will be given to the applicant whose intended .hk Chinese Domain Name is sufficiently similar, phonetically or semantically, to its registered English <.hk> domain name. Evidence of sufficient similarity, having regard to criteria specified in

the Soft Launch Period Rules, will need to be submitted at the time of making an application. Where two or more eligible domain name holders apply for the same .hk Chinese Domain Name, priority will be given to the applicant whose application is based on the English <.hk> domain name having the earliest priority date.

### Sunrise Period: 29 January 2007 - 9 February 2007\*

During the Sunrise Period, anyone may apply for a .hk Chinese Domain Name. The allocation of all .hk Chinese Domain Names applied for during the sunrise period will be by random draw.

## Who should register a Chinese Domain Name?

All brand owners with a presence in the PRC or Hong Kong should consider applying to register a .hk Chinese Domain Name to reflect their brand in Chinese. At the conclusion of the Soft Launch Period, on or around 8 March 2007, the registration of .hk Chinese Domain Names will be open to the public. Registration of .hk Chinese Domain Names by eligible applicants during the Soft Launch Period is therefore recommended to protect brand owners against the potential hi-jacking of their names and trade marks by cyber squatters.

## How Lovells can assist

Lovells can assist you in choosing a .hk Chinese domain name which accurately reflects your brand. Our fees for securing a Chinese Domain Name registration are US\$500 per domain name, inclusive of official registration fees.

\* dates are subject to change by the Hong Kong Domain Names Registrar.

For advice and information on Lovells Intellectual Property Practice please contact:

## ALICANTE

Verena von Bomhard  
verena.bomhard@lovells.com

## AMSTERDAM

Bert Oosting  
bert.oosting@lovells.com

## BEIJING

Horace Lam  
Horace.lam@lovells.com

## DUSSELDORF

Andreas von Falck  
andreas.vonfalck@lovells.com

## FRANKFURT

Sönke Ahrens  
soenke.ahrens@lovells.com

## HAMBURG

Andreas Bothe  
andreas.bothe@lovells.com

## HO CHI MINH CITY

Tu Dinh  
tu.dinh@lovells.com

## HONG KONG

Henry Wheare  
henry.wheare@lovells.com

## LONDON

Robert Anderson  
robert.anderson@lovells.com

## MADRID

Burkhart Goebel  
burkhart.goebel@lovells.com

## MILAN

Luigi Mansani  
luigi.mansani@lovells.com

## MOSCOW

Natalia Gulyaeva  
natalia.gulyaeva@lovells.com

## MUNICH

Matthias Koch  
matthias.koch@lovells.com

## PARIS

Marie-Aimée de Dampierre  
marieaimee.dedampierre@lovells.com

## SHANGHAI

Douglas Clark  
douglas.clark@lovells.com

## TOKYO

Lloyd Parker  
lloyd.parker@lovells.com

Other Lovells publications which may interest you:

### Life Sciences Newsletter

A quarterly update on issues of interest to the pharmaceutical and bioscience industries.

### Designs Quarterly

An illustrated quarterly review of cases and other legal developments relevant to European designs including both Community and national rights.

### Anchovy Newsletter

Monthly domain name news .

### iPunkt

Our two-monthly German language intellectual property newsletter.

### China IP Newsletter

A monthly round-up of the latest developments intellectual property law in China. Email Only.

### Internet & E Commerce Law Bulletin

A monthly round up of legal news relating to the Internet and E commerce. Email only.

### Media Newsletter

A monthly round up of legal media news. Email only.

### Telecoms Newsletter

A monthly round up of industry and legal news relating to telecoms. Email only.

### Newsflashes on IP topics

Email alerts highlighting important IP developments as they happen.

If you would like to receive any of these publications please email [astrid.arnold@lovells.com](mailto:astrid.arnold@lovells.com).

Lovells, Atlantic House, 50 Holborn Viaduct, London EC1A 2FG