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When the scotch is not Scottish....it's an infringing misnomer

On April 20, 2006 the High Court of New Delhi permanently prohibited an Indian company, Golden Bottling Ltd., from selling its whisky under the designation RED SCOT and any word similar thereto. The Scotch Whisky Association of the U.K. successfully contended that 'SCOT' or 'SCOTCH' is a geographical indication within the meaning of the World Trade Organization's Trade Related Intellectual Property Rights Agreement Article 22. The High Court's ruling is the first of its kind to be based on the TRIPS agreement. Article 22 defines geographical indications as "*indications, which identify a good as originating in the territory of a Member, or a region or locality in that territory, where a given quality, reputation or other characteristic of the good is essentially attributable to its geographical origin.*" Article 22.3 specifically refers to "*identifying spirits ...not originating in the place indicated*" and can be enforced "*even where the true origin if the goods is indicated*". The defendant whisky manufacturer was held guilty of passing off their product as Scotch Whiskey or as product otherwise originating in Scotland by using 'RED SCOT' as a misleading designation. The SWA, who were awarded damages and litigation costs, are also currently pursuing over fifty cases worldwide to protect SCOTCH as designation for whiskey originating in Scotland.

First .eu Domain Name Dispute settled by the ADR

On April 18, 2006 the first .eu domain name dispute was settled by the ADR Center for .eu domains. The controversy involved dueling applicants for the PST.EU domain, where the junior domain name applicant was the owner of a senior Benelux trademark registration for PST. The successful domain name applicant based its claim on a Benelux trademark registration that was filed on November 22, 2005 and issued to registration under Benelux's expedited registration system. The one-man panel confirmed that the successful applicant had met all of the criteria for registration and since EURid operates on a "*first come, first serve*" basis, the domain name was properly awarded even if the successful applicant was the junior trademark right holder. Interestingly, the panel noted that there were no outstanding challenges to the successful applicant's trademark registration and in saying so seemed to leave open the possibility that it might have ruled differently had an opposition been pending on the applicant's trademark registration at the time EURid awarded the domain.

SEPTEMBER 11, 2001 Deceptively Misdescriptive as a mark

In re Mori Shniberg (Serial Number 78083495), the TTAB upheld a refusal of an application for SEPTEMBER 11, 2001 under Section 2(e)(1) on the basis that the mark was deceptively misdescriptive of "*books in the field of history; and entertainment in the nature of radio programs in the field of news*" not relating to the events of September 11, 2001. The board noted that any mark would be deceptively misdescriptive where the mark misdescribes the goods or services to which it is applied and consumers are likely to believe that misdescription and consider it relevant to the purchasing decision. The board said that the mark would be outright deceptive if the misdescription were material to the purchasing decision. Here, the board found the mark misdescriptive in the context of the goods and services since "September 11, 2001" had become recognized as a shorthand for the tragic events of that day and given the numerous books and shows about those events, consumers upon seeing the mark would believe that applicant's goods and services were also on the subject of the terrorist attacks.

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