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NEWSLETTER EMPRESARIAL

Marzo 2011 – *Includes an IP Section in English*

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I.- JURISPRUDENCIA

1. **DERECHOS INTELECTUALES.** Cobro de regalías. SADAIC.

En “*Ferrer c Sadaic s Rendición de cuentas*” la Sala F de la CNCiv resolvió el 18.10.10 que la existencia de un mandato o representación necesaria, ejercido por un ente de gestión colectiva fiscalizado por el Estado y que a su vez es administrado, controlado y supervisado por sus asociados con derecho a voz y voto a través de los órganos estatutarios, somete a los representados a dichos mecanismos y órganos de control y **releva de rendir cuenta en los términos del art. 1909 del Código Civil** ya que las cuentas se rinden a través de la Memoria y Balance anual -art. 96 del Estatuto. Y

sostuvo que resulta inadmisibles la petición de rendición de cuentas por las supuestas regalías no abonadas al Sr. Ferrer, lo que sella la suerte adversa de este agravio. Si bien el juez de grado apuntó que de la prueba reunida en autos se desprende que el actor aún no percibió parte de las regalías de los derechos intelectuales derivados de la explotación o utilización en la República de Chile, en modo alguno ello permitiría una decisión condenatoria. Por un lado, porque *no hay elemento probatorio alguno que demuestre que esas sumas ingresaron a las arcas de la demandada en virtud de los acuerdos logrados con su par chilena*. Si se hubiera aquilatado ese extremo, se impondría la condena de pago, con más los intereses pertinentes, pero se infiere que en realidad por diversas dificultades aún no se percibió el cobro, como bien destacó el juzgador al valorar la declaración testimonial y la documental. En

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suma, el actor tiene derecho a percibir ciertas regalías generadas en la República de Chile **una vez que resulte satisfactorio el reclamo de la demandada en el país vecino**, sin perjuicio de las acciones que en su caso entienda procedentes en tren a proteger el derecho que le asiste, lo que desde luego excede el marco de la presente decisión. Fuente: www.eldial.com.ar

2. PROPIEDAD INTELLECTUAL. Obra televisiva. Daño moral.

En “*Segovia c Dori s Daños y Perjuicios*” la Sala G de la CNCiv resolvió, el 18.10.10 que la cesión instrumentada por los demandados ha infringido los derechos intelectuales – susceptibles de apreciación pecuniaria– de los actores, **al exceder el alcance de la anterior transmisión de sus derechos**. El incumplimiento con-

tractual imputable ha resultado, entonces, suficientemente acreditado. De allí que *las formas de explotación de los capítulos o libros escritos por los actores cedidos por los demandados que excedían el aprovechamiento de la telenovela, no se hallan contemplados en la cesión concretada entre las partes* de este pleito. En el caso, se encuentra suficientemente demostrado que los capítulos de la obra en cuestión escritos por los actores –y aprobados por la otra parte– fueron 120 y estos se corresponden con los emitidos en el país; mientras que los cedidos a un tercero según el contrato agregado, fueron 150. Se ha expresado, en este sentido, **que el autor tiene derecho a que su obra no sea fragmentada, desnaturalizada y ni siquiera mejorada**, que toda difusión de la obra debe ser efectuada sin modificaciones, en la forma que el autor la creó, aun si el autor se ha desprendido de sus derechos patrimoniales, y

hasta que no sería posible efectuar algún tipo de cambio, por insignificante que pudiera parecer, sin alterar el espíritu que se pretendió insuflarle. Por otra parte, también se halla acreditado que **los demandados modificaron el título de la novela televisiva sin haber estado habilitados para hacerlo**. Vale decir que se ha verificado una vulneración del derecho moral de la propiedad intelectual de los demandantes al afectarse la integridad de la obra. Fuente: www.eldial.com.ar

3. MARCAS. Condominio. Enajenación sin consentimiento del resto.

En “*Camuyrano s La Orquídea Shop Argentina SA s Cese de Uso*” la Sala II de la CNCiv-ComFed la actora demandó el cese de uso de **marca LA ORQUÍDEA**. El 19.02.10 el Tribunal consideró lo normado

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por el texto del artículo 2676 del Código Civil, que reza: “Cada condómino goza, respecto de su parte indivisa, de los derechos inherentes a la propiedad, compatibles con la naturaleza de ella, y puede ejercerlos *sin el consentimiento de los demás copropietarios*”. Y es que si los derechos respecto de la cuota indivisa estuvieran condicionados por la conformidad de los otros condóminos, se desmentiría la proclamada amplitud de derechos de los condóminos en ese plano, pues precisamente ese ejercicio de derechos por cada uno de los condóminos con independencia de la conformidad de sus pares, es el que denuncia el molde romanista adoptado por Vélez Sarsfield. Por su parte, el artículo 2677 del Código Civil dispone: “Cada condómino puede enajenar su parte indivisa, y sus acreedores pueden hacerla embargar y vender antes de hacer la división entre los comuneros”. En armonía con el

principio general contenido en el artículo 2676, el Código faculta expresamente a los condóminos a enajenar su parte indivisa, o sea que **sin cortapisa alguna** pueden transferir su proporción a terceros, o a otro condómino. Estimó que en el caso bajo análisis las propietarias sobre su parte indivisa y están autorizadas a **disponer libremente de ella sin el consentimiento del resto** de los condóminos. La postura propuesta halla sustento en calificada doctrina citada y en jurisprudencia del fuero. En este sentido, la Sala III de esta Cámara ha dicho al respecto que el **artículo 9° de la Ley 22.362 establece que los titulares de una marca deben actuar en forma conjunta para licenciar, transferir y renovar la marca**, pero esa imposibilidad de que un propietario transfiera unilateralmente la marca **no debe confundirse con la situación aplicable cuando tal copropietario desea enajenar su parte indivisa** del tal signo.

visa del tal signo. En tal caso, **por aplicación analógica del artículo 2677 del Código Civil, la enajenación será por regla general válida**, sin perjuicio de los casos en que se hayan impuesto restricciones contractuales lícitas a tales actos, circunstancia ésta última que no acontece en el sub examine. Fuente: www.eldial.com.ar.

II.-

IP Section in English

**1. DOMAIN NAME.
Recent Decision by WIPO.**

In “Banco Macro c Affordable Webhosting Web Inc. Advertising” decided on 11.12.10, the WIPO Arbitration and Mediation Center denied complaint, presented by Banco

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Macro S.A. of Buenos Aires, Argentina where the Respondent was Affordable Webhosting Inc. Advertising of Oregon, United States of America. The disputed domain name, (the Domain Name), is registered with Namezero (the Registrar). The Complaint was filed with the WIPO Arbitration and Mediation Center (the Center) on October 18, 2010. On October 18, 2010, the Center transmitted by email to the Registrar a request for registrar verification in connection with the Domain Name. On October 19, 2010, the Registrar transmitted by email to the Center its verification response confirming that the Respondent is listed as the registrant and providing the contact details. The Center verified that the Complaint satisfied the formal requirements of the Uniform Domain Name Dispute Resolution Policy (the Policy or UDRP), the Rules for Uniform Domain Name Dispute

Resolution Policy (the Rules), and the WIPO Supplemental Rules for Uniform Domain Name Dispute Resolution Policy (the Supplemental Rules). In accordance with the Rules, paragraphs 2(a) and 4(a), the Center formally notified the Respondent of the Complaint, and the proceedings commenced on October 26, 2010. In accordance with the Rules, paragraph 5(a), the due date for Response was November 15, 2010. The Response was filed with the Center on November 15, 2010. The Center appointed Tony Willoughby as the sole panelist in this matter on December 2, 2010. The Panel finds that it was properly constituted. The Panel has submitted the Statement of Acceptance and Declaration of Impartiality and Independence, as required by the Center to ensure compliance with the Rules, paragraph 7. The Complainant is an Argentinian bank. It commenced business as

a financial institution in 1985 and has operated as a bank in Argentina since 1988 when it obtained a banking licence from the Central Bank of Argentina. The Complainant is the registered proprietor of a number of Argentinian trade mark registrations of marks comprising or including the name Banco Macro including Argentinian trade mark registration no. 2008264 dated March 5, 1990 BANCO MACRO (words) in class 36 for banking services. It is also the registrant of the domain name, which it registered on October 17, 2001. **The Complainant is also the registered proprietor of a number of Argentinian trade mark registrations of logos featuring the name Macro Bank Limited.** They were all applied for on April 14, 2008. **The Domain Name was registered on June 4, 2003.** It is connected to a Sedo parking page featuring sponsored listings some of which are

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concerned with banking services and some of which are not. The parties contentions were as follows. The Complainant contends that the Domain Name is identical or confusingly similar to a trade mark in which it has rights, that the Respondent has no rights in respect of the Domain Name and that the Domain Name *was registered and is being used in bad faith*. The Complainant contends that the Respondent registered the Domain Name with knowledge of the Complainant and its trade mark rights and with a view to exploiting those rights to its own commercial advantage and, in the process, causing disruption to the Complainant's business and consumer confusion. The Respondent denies that the Domain Name is confusingly similar to the Complainant's trade marks, asserts that it has rights and legitimate interests in respect of the Domain Name, **having used the Domain Name for bona**

fide advertising services for the last 7 years and on the same basis contends that the Domain Name was not registered in bad faith and is not being used in bad faith. The Respondent contends that the Complainant is guilty of Reverse Domain Name Hijacking and seeks a finding from the Panel to that effect. These were de **Discussion and Findings.** A. General. According to paragraph 4 (a) of the Policy, for this Complaint to succeed in relation to the Domain Name, the Complainant must prove each of the following, namely that: (i) The Domain Name is identical or confusingly similar to a trade mark or service mark in which the Complainant has rights; and (ii) The Respondent has no rights or legitimate interests in respect of the Domain Name; and (iii) The Domain Name was registered and is being used in bad faith. If the Complaint fails, the Panel has to have regard to paragraph 15(e) of the Rules

and in particular the following sentence, namely: If after considering the submissions the Panel finds that the Complaint was brought in bad faith, for example in an attempt at reverse domain name hijacking or was brought primarily to harass the domain name holder, the Panel shall declare in its Decision that the Complaint was brought in bad faith and constitutes an abuse of the administrative proceeding. **B. Identical or Confusingly Similar.** The Domain Name comprises macrobank and the generic .com domain suffix, but for the purpose of assessing identity and confusing similarity under paragraph 4 (a) (i) of the Policy it is permissible to ignore the domain suffix. It is also permissible to ignore the absence of spaces, ampersands etc which cannot feature in domain names for technical reasons. *The Complainant claims trade mark rights in respect of the name Macro, but*

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produces nothing in support of that claim. It does, however, produce evidence of Argentinian trade mark registrations of **BANCO MACRO** and logos featuring the name Macro Bank Limited (see section 4 above). The Domain Name (absent the generic domain suffix) is recognizably Macro Bank and the Complainant's BANCO MACRO trade mark is recognizably the Spanish for Macro Bank. **The Panel finds that the Domain Name is confusingly similar to a trade mark in which the Complainant has rights.** C. Rights or Legitimate Interests. The Respondent claims to have selected the Domain Name for its meaning of big bank and that it has used the Domain Name in good faith for the last 7 years without any intervention from the Complainant in relation to advertising services. It contends that it has never received any indication of confusion on the

part of Internet users. **The Domain Name is connected to a website featuring sponsored links to a variety of other websites** (many of which are for financial services through which the Respondent no doubt generates referral or pay-per-click revenue. The Respondent contends that this activity constitutes a *bona fide* offering of advertising services for the purposes of paragraph 4(c)(i) of the Policy. In light of the Panel's finding under the next heading, it is unnecessary for the Panel to address this issue. **D. Registered and Used in Bad Faith.** Ordinarily, to succeed in a complaint under the Policy a complainant has to prove to the satisfaction of the panel that, at the very least, the respondent had the complainant (and/or the complainant's trade mark) in mind when registering the domain name in issue, the respondent's bad faith objective being to take unfair advantage of or to cause unfair damage to

the complainant or its trade mark. While the Complainant asserts that this is what the Respondent had in mind when registering the Domain Name, what is there in the way of evidence before the Panel to support that assertion? **The Complainant relies solely upon the fame of its trade marks, but produces no evidence to show why the Respondent based in Oregon should have been aware of the existence of those marks,** the use of which (on the evidence before the Panel) has been restricted to Argentina. The Complainant places Banco Macro in the same category as Coca-Cola, American Express and McDonalds, **but does not show any use of Banco Macro outside Argentina.** Additionally while the Complainant has Argentinian trade mark registrations of logos featuring the corporate name Macro Bank Limited, those marks were all applied for in 2008, several

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years after registration of the Domain Name. There is nothing before the Panel to show that the Complainant was using the name Macro Bank prior to registration of the Domain Name. As indicated above, while the Complainant claims trade mark rights to the name Macro (*solus*), the Complainant has produced no evidence of those rights. If it were the case that the term macro in relation to banks or banking services was a term used exclusively by the Complainant, then that would provide the Complainant with an arguable starting point. However, as the Respondent has pointed out, macro is well-known both as a dictionary word and a prefix; moreover, a simple search engine search shows that the Complainant is not the only entity using the name Macro in relation to banking services. **The Complainant has failed to satisfy the Panel that the Domain Name was registered**

in bad faith. E. Reverse Domain Name Hijacking. The Respondent contends that the Complainant's bad faith in bringing this Complaint is obvious. The Respondent points to the delay in bringing the Complaint, the Complainant's failure to obtain other equivalent and available domain names (e.g. the .net equivalent) and the Complainant's failure to ensure that search engine searches for macro bank will land searchers at its site. In other words, the Complainant has no serious concern to protect its brand. The Panel disagrees. The Panel accepts that the Complainant and its trade marks will be very well-known in Argentina in the fields of banking and financial services. Moreover, the Panel is also ready to accept that if the Respondent had been shown to have Argentinian connections, the result of this Complaint might have been different. The matters to which the Respondent refers in support of this

allegation indicate (perhaps) shortcomings in the Complainant's approach to protection of its brand, but do not, in the view of the Panel, indicate any bad faith on the part of the Complainant. While the Complaint has failed, the Panel has no reason to doubt that the initiation of this Complaint was governed solely by a *bona fide* desire on the part of the Complainant to protect its trade mark rights. On these grounds the **Panel rejected the allegation of Reverse Domain Name Hijacking.** Source: www.eldial.com.ar

**2. Flying without wings:
smart-Wings v EuroWings.
By Deborah Sewagudde.**

The Firm has the HONOUR to reproduce the complete text of this interesting article –with the

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author's permission- already published by the *Journal of Intellectual Property Law & Practice*, Vol. 6 (2) February 2011. Oxford University Press. Judgement of the General Court (Case T-72/08), 13 September 2010; *Travel Service v Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) - Eurowings Luftverkehrs (smartWings)*. Luxembourg. **Summary:** The Doctrine of Precedent sprang into action last month when the General Court supported the decisions of the Opposition Division and the Board of Appeals at OHIM, to rule against the low-cost airline service, Travel Service registering a figurative Community trademark. **Legal context.** This was an opposition action brought for trade mark infringement, alleging a likelihood of confusion between the mark applied for by Travel Service and previously registered trade marks by

Eurowings Luftverkehrs. **Facts.** The trade mark applied for, smartWings, was specifically created by Travel Service in Czech Republic, to be used for the provision of good and services referred to in classes 16, 21, 37, 39, 41 and 43 of the Nice Agreement. Eurowings Luftverkehrs' opposition to Travel Service's application for registration of the mark part succeeded before the Opposition Division of OHIM (opposition proceedings No: B782351 of 29 September 2006) and was further held by the second Board of Appeal of OHIM (Case R 1515/2006-2) on the basis that there was a likelihood of confusion as the mark applied for was similar to earlier marks, EUROWINGS and EuroWings, registered by Eurowings Luftverkehrs, and similar goods and services, in particular, those referred to in classes 16, 39, 41 and 42, provided under these

marks. Travel Service then further appealed to the General Court. **Analysis.** The General Court dismissed this appeal in Case T-72/08, *Travel Service v Office for Harmonisation in the Internal Market (Trade Marks & Designs) (OHIM) - Eurowings Luftverkehrs (smartWings)*. The mark Travel Service sought registration for was of a complex nature; comprising of two word elements written in italics in blue and in the succession of terms 'smart' and 'wings', and a figurative element, which was the combination of those terms and an orange decorative element in the form of a zigzag, to the right of the term 'wings'. The mark is shown below:



The opposition by Eurowings Luftverkehrs was based on Article 8(1) (b) and (5) of

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Regulation No 207/2009), alleging a likelihood of confusion between the mark applied for and previously registered national and international figurative trade marks, EuroWings and the word marks EUROWINGS and WINGSCLASS. The earlier opposing figurative marks comprise of a combination of the terms 'euro' and 'wings'. They contain, first, the two word elements represented with a slight gap between them and written in lower case, with the exception of the first letter of each term and, secondly, a figurative element, which corresponds to the use of italics on the word 'wings'. The sign EUROWINGS, for its part, only consists of a single word element. The figurative marks are shown below:

EuroWings

and

EuroWings

The OHIM Opposition Division upheld Eurowings Luftverkehrs' opposition in part, specifically ruling that there was a likelihood of confusion with regards to the marks at issue and to similar goods and services provided under these marks, specifically, with EUROWINGS and EuroWings, but not with the word mark WINGSCLASS because of the differences in the mark and in their assigned opposite goods and services. Dissatisfied with this decision, Travel Service appealed to OHIM, only to be further disappointed when the Board of Appeal supported the Opposition Division's decision that there was indeed a likelihood of confusion because of the identity of the word 'wings'. It ruled that the word 'wings' was the dominant

element of each sign, whereas the words 'euro' and 'smart' only played secondary roles, and that the slight differences 'between the style of font and the negligible figurative element' in the smartWings mark do not serve to 'override this similarity'. Accordingly, consumers would pay less attention to the secondary elements, believing that the goods and services derive from the same trader, who is defined by the word 'wings', and assume that the marks at issue are mere variations of the same mark. Lastly, even if it held that the word 'wings' had weak distinctive character, that nevertheless does not rule out a likelihood of confusion. The General Court noted that Travel Service argued in opposition that there are visual, phonetic and conceptual differences between the marks at issue; visually, that consumers attach more importance to the first part of words ('euro' and 'smart')

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and phonetically and conceptually, that the pronunciation of the word elements at the beginning of the marks produces a more direct impact in the mind of consumers than the second part. The Court supported part of this contention and in response submitted that:

- when assessing the similarity of the marks in question, the overall impression given by the marks must be based on the distinctive and dominant components.
- notwithstanding, a mark should be considered as a whole and not merely in components as the composite produces the overall impression conveyed to the relevant public. The assessment of the similarity is only exclusively based on the dominant element of a mark if that component is solely liable to dominate the

image of that mark which the relevant public keeps in mind, so that all the other components of the mark are deemed negligible in the overall impression produced.

- where the applicant relies on the case-law according to which the average consumer pays more attention to the initial part of a mark, it is settled case-law that that argument cannot hold in all cases since the average consumer looks at the entire trade mark as opposed to its components. Accordingly, it must be held that the marks at issue have an average degree of phonetic similarity.
- the fact that the ‘wings’ element is the same in the marks at issue makes the marks visually similar, and phonetically and conceptually similar ‘to a medium degree’, at least for

the part of the relevant public which understands English.

- according to case-law, it must also be noted, from the conceptual point of view that even if the comparison between the signs at issue is of limited relevance with regard to some consumers, particularly those who do not understand English, this does not prevent the consumers who understand English from considering the conceptual similarities between the signs at issue.

Travel Services also argued that the term ‘wings’ cannot be regarded as the dominant element of the marks since it is descriptively used to refer to goods and services in the air transport services sector. It is used in many registered and unregistered marks in the European Union and therefore has limited capacity to distinguish those goods and

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Marzo 2011 – *Includes an IP Section in English*

services. In response to this, the Court submitted that:

- according to case-law, the mere fact that earlier registered marks containing this word element exist is not enough to establish that it lacks distinctive character.
- furthermore, the 'wings' element appears in a larger font and its first letter is in upper case and thus holds a more important position than the 'smart' element, which appears in smaller fonts. The latter therefore appears as a negligible addition while the size and position of the former may make a lasting impression on consumers.
- it must thus be concluded that the terms 'euro' and 'smart' are not distinctive and are secondary in nature in relation to the term 'wings', the term 'euro' as reasoned by the applicant and the

term 'smart' as it expresses a quality attached to the term 'wings'.

Where the applicant argued that the visual elements of the mark applied for, the wave and colours, draw additional attention of the relevant consumer and must thus be considered to be dominant and distinctive, the Court ruled that these assertions must also be dismissed as there was no evidence submitted in support of this. In the light of those considerations, the Court thus held that the Board of Appeal was correct to conclude that the marks were similar for the purposes of Article 8(1)(b) of Regulation No 40/94 and ruled that the mark applied for was not to be registered because there exists a likelihood of confusion and, possibly, association with the earlier trade marks. **Practical significance.** The decision of the General Court demonstrates that the possibly weak distinctive

character of an element of a complex mark does not necessarily imply that that element cannot constitute a dominant element, especially if, in particular, its position in the sign or its size may make a lasting impression on consumers. This significance may further override the more obvious features of a figurative trade mark, such as colour, and lead to the rejection of a mark registration application where the application is made in respect of these features. ©

Deborah Sewagudde. Estudio Villano is sincerely grateful to Deborah and deeply acknowledges her enlightening contribution.

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