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Lawyer Annual 2023

Statutory damages provide key enforcement mechanism to curb counterfeiters

Nicholas J. Nowak, Matthew M. Zuziak and Will Rodenberg of Sterne, Kessler, Goldstein & Fox PLLC and Charles Hawkins, General Counsel, Intellectual Property & Litigation at Volkswagen Group of America, Inc., report on the *Verotec Wheels, Inc.* case that has solidified the structure for statutory damages.

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THE TRADEMARK LAWYER Annual 2023

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Editor's welcome



Welcome to *The Trademark Lawyer Annual 2023*. This year has seen an explosion of new issues for brands with the developments in and predictions for the metaverse, as well as many changes to regulations in jurisdictions across the globe with territories becoming increasingly blurred. We expect this to continue throughout the year ahead.

Our cover story this issue sees GC of IP and Litigation at Volkswagen Group of America, Inc., and experts at Sterne Kessler examine the implications *Volkswagen*

Grp. of Am., Inc. v. Verotec Wheels, Inc will have on statutory damages following a case filled with disingenuous behavior and risks to public safety.

“
**Following a case
filled with
disingenuous
behavior and risks
to public safety.**
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This issue also presents articles on: whether virtual fashion is the answer to sustainable fashion; the US trademark law's global reach; answers for trademark nullity in Argentina; the push for the protection of culture for Mexican people; the insufficiency of providing proof of reputation in Poland; secondary meaning analysis in Brazil; and much more.

Special thanks to our *Women in IP Leadership* segment sponsor, Innocelf, featuring Virginia Wolk Marino of Crowell & Moring and Prudence Jahja of Januar Jahja and Partners.

Also find a special feature on disability, authored by Megan Rannard of Marks & Clerk, as part of our ongoing DEI focus.

Thank you to all of our contributors and readers this year, we wish you a very happy and healthy year ahead.

Faye Waterford, Editor

Mission statement

The Trademark Lawyer educates and informs professionals working in the industry by disseminating and expanding knowledge globally. It features articles written by people at the top of their fields of expertise, which contain not just the facts but analysis and opinion. Important judgments are examined in case studies and topical issues are reviewed in longer feature articles. All of this and the top news stories are brought to your desk via the printed magazine or the website www.trademarklawyermagazine.com

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**Francesco Bonini - Studio Bonini. Italy**

Francesco has 20 years' experience in Italian and EU trademark and design prosecution. He has had successful cases in oppositions, appeals and cancellations both before the EUIPO and the Italian PTO. Studio Bonini, established in 1980, has its head office in Vicenza, in the North-East of Italy. It has helped several companies of the Venetian area to protect their IP rights, dealing with IP prosecution.

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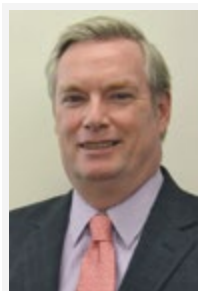
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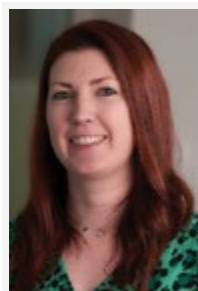
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The Trademark Lawyer would like to thank the Editorial Board for their time and support.

Statutory damages provide key enforcement mechanism to curb counterfeiters

Nicholas J. Nowak, Matthew M. Zuziak and Will Rodenberg of Sterne, Kessler, Goldstein & Fox PLLC and Charles Hawkins, General Counsel, Intellectual Property & Litigation at Volkswagen Group of America, Inc., report on the *Verotec Wheels, Inc.* case that has solidified the structure for statutory damages.



In *Volkswagen Grp. of Am., Inc. v. Verotec Wheels, Inc.*, No. 19-24838-CIV, a federal magistrate judge in the Southern District of Florida ordered a counterfeiter to pay more than \$1.1 million in statutory damages, attorney's fees, and costs to Volkswagen and Audi for willful trademark infringement, false designation of origin, counterfeiting, and trademark dilution under the Lanham Act. The court also awarded additional damages upon finding the defendants liable for design patent infringement.

I. Background

Volkswagen and Audi filed suit against Verotec Wheels, Inc., and its CEO, Andy Varona, in November 2019, alleging that Verotec and Mr. Varona used an eBay account to sell counterfeit Audi wheel sets bearing the world-famous Audi rings logo. After more than a year of fact discovery, Volkswagen and Audi moved for summary judgment on all counts. Their motion also sought a finding that, under 15 U.S.C. § 1117(c), they were entitled to statutory, rather than actual damages, as well as a finding that the case was "exceptional" under subsection (a) of that statute, entitling Volkswagen and Audi to attorney's fees. The court granted the motion with respect to the question of Verotec and Mr. Varona's liability for trademark infringement, counterfeiting, false designation of origin, and trademark dilution, citing "overwhelming" photographic and documentary evidence demonstrating



that the defendants used the eBay account in question to sell wheel sets that bore marks that were identical to Audi's trademarked rings. The court tabled Volkswagen and Audi's request for statutory damages and attorney's fees, deciding to resolve these issues after a bench trial, in order to have an "opportunity to observe first-hand Mr. Varona's credibility (or lack thereof) for those factual issues on which he did not contradict his prior testimony with a later-filed affidavit."

II. Statutory damages

Following a bench trial on the issue of damages and fees, the court found that statutory damages under § 1117(c) were "particularly appropriate" in this case. As the court explained, Congress implemented § 1117(c)'s statutory damages provision for trademark counterfeiting cases "because evidence of a defendant's profits in such cases is almost impossible to ascertain." That was especially true here, the court remarked,



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Résumés

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because Verotec and Mr. Varona not only "failed to produce any records of sales or revenue data in response to [Volkswagen and Audi's] discovery requests," they "repeatedly denied such records exist[ed]" in the first place. The defendants' intransigence, the court observed, forced Volkswagen and Audi "to obtain sales records through third-party discovery of eBay and PayPal," which, due to the retention policies of these entities, were limited to the years 2018-2020—even though Verotec and Mr. Varona started selling the counterfeit wheels on eBay at least as early as 2016. Because Volkswagen and Audi "exhausted all efforts to obtain records from Defendants throughout the case but were unable to do so," the court reasoned, "[s]tatutory damages [we]re therefore the only viable method of recovery available" to Volkswagen and Audi.

The court then turned to the issue of calculating the appropriate amount of statutory damages Verotec and Mr. Varona owed Volkswagen and Audi under § 1117(c). Here again, the court emphasized the fact that the defendants "produced no evidence of sales or profits" and that "the only [sales] evidence available... [w]as incomplete and unreliable," which "favor[ed] awarding a significant statutory damages award to [Volkswagen and Audi]." But the court's damages calculation did not end there. Borrowing from cases in the copyright infringement context, the court considered a number of additional factors in its damages analysis, such as the need to deter the defendants and other counterfeiting entities, the willful nature of the defendants' activities, the defendants' litigation behavior throughout the case, and whether the defendants' counterfeit goods posed public safety risks.

Deterrence: The court doubled the statutory damages amount in view of the "strong need" to deter the defendants and other like-minded parties from engaging in this unlawful conduct in the future. It was undisputed, the court remarked, that "all infringing offers for sale and sales in this case took place via the Internet," which gave Verotec and Mr. Varona access to a "virtually limitless number of customers." Citing evidence of the increasing trend of counterfeiters turning to online marketplaces to sell infringing goods, the court concluded that a "significant statutory damages amount [w]as necessary here... to the curb the proliferation of counterfeiting operations on online marketplaces such as eBay."

Defendants' Willfulness: The court tripled the statutory damages award in light of the willful nature of Verotec and Mr. Varona's infringement of Audi's trademarks. The court observed that it was clear from the record that Verotec and Mr.

Varona "clearly aimed to cash in upon the reputation and goodwill associated with the Audi Trademarks." Verotec and Mr. Varona further admitted, for example, to intentionally using misleading keywords such as "Audi," "OEM," and "authentic" in their eBay listings, which were "flagrant attempts at deceiving customers into believing that the counterfeit products were indeed authentic Audi wheels."

Defendants' Litigation Behavior: Mr. Varona's "uncooperative and disingenuous" behavior throughout the case also "militat[ed] in favor of a higher statutory damages amount," the court reasoned. Besides refusing to produce any sales records for the counterfeit wheels, and outright refuting their existence, Mr. Varona, at deposition and in a sham declaration submitted to the court during the summary judgment phase, repeatedly denied owning the eBay account in question. He also refused to cooperate during discovery by either failing to respond to or submitting contradictory responses to Volkswagen and Audi's written discovery requests, resulting in extensive and unnecessary motion practice and wasted time and resources.

Public Safety Interests: The court lastly considered the safety risks Verotec and Mr. Varona created

“**Based on these factors and available information, the court assessed statutory damages at \$609,227.10.**”

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by selling counterfeit car wheels to the public, noting that courts have heightened statutory damages where the counterfeit goods also posed a danger to public safety. The court credited testimony offered by Audi demonstrating that, while genuine Audi wheels must adhere to strict internal testing and government regulations designed to ensure the structural integrity of the wheels under various driving conditions, there was no evidence that Verotec and Mr. Varona's counterfeit wheels were subject to such safety standards. This was further supported by the fact that Audi's investigator, after purchasing a set of the counterfeit wheels, determined that the wheel caps did not properly fit the wheels and could potentially detach while on the road. In sum, the court reasoned that the risks to public safety posed by the defendant's unregulated and untested counterfeit wheels "further supported a larger statutory damages award."

Based on these factors and available information, the court assessed statutory damages at \$609,227.10.

III. Attorney's Fees and Costs

As for attorney's fees and costs, the court concluded that Verotec and Mr. Varona's behavior, both inside and outside the court, "l[wa]s exactly





the type of intentional, non-accidental conduct that warrants the imposition of [attorney's] fees" under § 1117(a). To start, they willfully infringed Audi's trademarks by "knowingly us[ing] identical marks on counterfeit products appearing to be identical to those sold by Audi, a world-famous automobile maker." That alone, the court remarked, mandated an award of attorneys' fees under § 1117(b). Verotec and Mr. Varona also continued to act in bad faith during litigation by, for example, repeatedly and falsely denying, under oath, their ownership of the eBay account despite overwhelming evidence to the contrary, further justifying an award of attorney's fees. For these same reasons, the court concluded, Verotec and Mr. Varona were also obligated to pay Volkswagen and Audi for the costs of the action under § 1117(a)(3), which, combined with attorney's fees, amounted to \$509,695.53.

IV. Takeaways

The advent of e-commerce sites like eBay has enabled counterfeiters and trademark infringers to create virtual platforms for selling their infringing goods globally. The actual damages trademark owners suffer at the hands of these online counterfeiters can be significant, but can often times be impossible to prove in the first instance. In addition, actual financial losses are, in most instances, significantly outweighed by the reputational harm these infringing entities inflict by capitalizing on the goodwill, social trust, and brand name recognition that trademark owners have spent considerable time and resources cultivating over the years.

That is why seeking statutory damages under 15 U.S.C. § 1117(c), rather than actual damages under § 1117(a), may prove a far more effective strategy for deterring counterfeiters of valuable, universally-recognized trademarks. The district court's decision in Verotec therefore offers useful insight into what plaintiffs should keep in mind when seeking statutory damages against counterfeiting entities:

Early and aggressive third-party discovery strategy: Plaintiffs should consider going the extra mile by diligently seeking sales records from third parties in the likely event the counterfeiting entity either does not have records or refuses to turn them over. That Volkswagen and Audi exhausted their discovery options by subpoenaing eBay and PayPal for sales records, for example, only reinforced in the court's mind that a heightened award of statutory damages against Verotec and Mr. Varona was warranted by showing some evidence of the large amount of money flowing through the defendants PayPal account resulting from the sale of counterfeit goods.

“
Verotec and Mr. Varona also continued to act in bad faith during litigation by, for example, repeatedly and falsely denying, under oath, their ownership of the eBay account despite overwhelming evidence to the contrary.
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Setting a good example: The defendant's litigation behavior will likely factor into the court's statutory damages calculus, which bodes well for plaintiffs if the evidence of infringement is overwhelming and the defendant's incentive to protract litigation is therefore high. Plaintiffs should therefore consider capitalizing on this advantage by expeditiously meeting discovery obligations, making reasonable demands of the other side, and compromising when appropriate.

Proving willfulness: Where willful trademark infringement is shown, § 1117(c)(2) raises the ceiling for statutory damages to \$2,000,000 per counterfeit mark. In Verotec, the district court tripled the statutory damages award based on the willful nature of the defendant's conduct while starting its calculation based on the sales figures that were made available by PayPal. Willfulness can be shown by a multitude of factors in these actions, including defendants aiming to cash in upon the reputation and goodwill associated with authentic goods, litigation misconduct, and continuing to operate their counterfeit operations even after litigation has been initiated.

Well-documented test buys of the counterfeit goods: A well-documented test buy and inspection of the counterfeit goods by qualified corporate representatives during the pre-suit investigation phase is crucial.

Meticulous accounting of attorney invoices and efficient use of attorney time: § 1117(a) allows for the plaintiff to recover reasonable attorney's fees for "exceptional" cases. A thorough and consistent record-keeping of reasonable legal expenses incurred throughout the case can assist the court in assessing the appropriate amount of attorney's fees and costs owed to the plaintiff if the circumstances of the case warrant such an award. In Verotec, the court found the fees reasonable given the large amount of resources that the Volkswagen and Audi were forced to expend during discovery and from dealing with uncooperative and deceptive defendants.

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IP and the steeplechase to sustainable fashion – is virtual fashion an answer?

Charlotte Wilding, Emilia Petrossian and Nawel Chemali of Wedlake Bell LLP review the current state of sustainable fashion, questioning whether virtual fashion could overturn the damage caused by fast fashion in spite of it being less green than it seems.

According to Geneco, the fashion industry is the second-most polluting industry after oil and gas and is responsible for 1.2 billion tonnes of greenhouse gas emissions annually and “an average British person today buys 60% more clothes than someone did 15 years ago – and keeps these clothes for only half the period of time”.

This is largely due to the rise in fast fashion, albeit that consumers are slowly but surely taking a stance due to its incompatibility with sustainability.

That said, is green, eco-friendly fashion really a walk in the park? Whether it's ensuring consumers are not misled through greenwashing practices or adapting physical fashion to fit the virtual world, making fashion 'sustainable' comes with its own set of hurdles brand owners and IP rights holders must consider.

I. Fast fashion and greenwashing risks

The fashion industry has been transformed by the 'fast fashion' model over the past decade, a model driven by trends, fast production, and ever-changing consumer behavior often seeking cheaper copycat versions of the latest trends. However, the success of this model has been tainted by its alarming impact on the environment and consumers' increasing awareness of the fast fashion industry's carbon footprint.

Fashion companies, in an effort to adapt to this change in consumer behavior, have been quick to promote “green” or “sustainable” lines. However, how valid are these claims?

Recently, fast fashion brands including ASOS, Boohoo and Asda have been the subject of investigations by the UK's Competition and



Charlotte Wilding



Emilia Petrossian



Nawel Chemali

Markets Authority over claims of ‘greenwashing’². What is greenwashing? Greenwashing is when companies mislead consumers by making them believe that they are doing more to protect the environment than they really are. It can be considered a form of false advertising as these claims are often not backed up.

Indeed, H&M came under indictment in the United States for the misleading marketing of “sustainable” products³. Here, a scorecard attached to a dress under H&M's Conscious Clothing line indicated that it was made with 20% less water on average. Whereas an independent investigation revealed that the dress “was actually made with 20% more water than conventional materials”. The two statements clearly do not add up and consumers do not appreciate being “hoodwinked”.

II. The role of IP in reassuring environmental conscious consumers

To avoid being accused of greenwashing, and the negative publicity that will undoubtedly follow, there are practical steps that brand owners can, and should, take in relation to their IP.

For example, some brand owners have looked at trademark protection to highlight their (hopefully valid) green claims, or at least communicate them to the public. According to a study conducted by the EUIPO, the filings of “green” trademark applications accounted for 11% of all EU trademark applications in 2020⁴ and this number has been consistently increasing since.

It is important to note that obtaining protection for a green trademark, and being recognized by the public as such, usually through extensive marketing campaigns, is not an overnight process

and might not be compatible with fast fashion.. however integrating environmental protection and sustainability into a company's brand protection strategy can add financial value. Trademarks are valuable property assets for brand owners to own, and eventually contribute to their business growth. Trademarks will help a business gain reputation, which will add commercial value to the products offered and will increase their marketability. Moreover, trademarks can be an additional revenue stream for brand owners through licensing, for example⁵.

Additionally, there are other types of trademarks that brand owners should consider, such as certification marks, collective marks, or guarantee marks, which indicate to consumers that a product complies with certain standards or characteristics. These marks in the fashion sector are still sparse, but it will be interesting to see whether they gain in popularity given the increasing interest in green fashion labels.

Trademark protection is not the only option available to brand owners. Brand owners should also consider applying for design protection, following in the footsteps of Adidas and Parley. As a result of their eco-innovation collaboration, embracing the concept of circular fashion (where a garment is produced, sold to, and worn by a consumer, then returned to the production cycle), their design of a sustainable shoe obtained registered protection at the EUIPO.

Investing in “green” IP rights in the fashion industry is profitable for brand owners in the long run given the potential high returns on investment in today's market.

However, are there other options? A shift has been occurring placing the virtual world at the forefront of IP concerns recently with the rise of NFTs and the metaverse. Therefore, should brand owners conscious of the environment and their carbon footprint consider going virtual? If so, what are the IP implications?

III. Virtual Fashion and IP

Virtual fashion is 3D designed clothing that can be worn by online avatars or on a person using augmented reality. It is made of data and code and is typically sold as an NFT. It is big business.

According to Vogue Business, “The first recorded sale of a fashion NFT was the iridescent dress created by The Fabricant and sold for the equivalent of \$9,500 in May 2019. The first luxury brand entrant was Gucci's Aria film, auctioned for \$25,000 in May 2021”⁶.

Résumés

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As virtual fashion grows, brand owners need to go the extra mile to stand out. For example, Dolce & Gabbana's NFT Collection Collezione Genesi not only provides its customers with an NFT dress for use in the metaverse, but also with a physical version. The customer also receives a two-year access to D&G's Alta Moda, Alta Sartoria and Alta Gioielleria couture events in Italy⁷.

D&G are not alone in this as there are now many brands which provide both digital and physical goods.

Further, there are a growing number of virtual stores located in the metaverse. For example, Selfridges has built the world's first NFT department store in Decentraland where users can view exclusive NFTs and browse Selfridges products⁸.

It is clear that 'going digital' not only helps brand owners reach more customers globally and create and develop a larger revenue stream, but it can also provide brand owners with a wealth of data as it can track customer behavior in real time. This helps brand owners to understand what trends are popular in the moment and react accordingly, updating its fashion lines almost instantly if required.

This leads to the question as to what additional considerations do brand owners and IP rights holders need to be aware of before entering into the digital world.

Firstly, trademark protection for physical fashion owners will need to extend to cover the digital world. Recent guidance suggests that Class 9 is a must have for NFTs and the like, as well as Classes 36 (if cryptocurrency is involved), 41 (it is a form of entertainment) and 42. Secondly, if digital fashion owners extend their reach into the physical world, they will need to extend their trademark coverage to the relevant class for the physical item.

In terms of registered protection, designs should also be strongly considered as a cheap means of obtaining fast IP protection as, in the UK at least, they are quick to obtain and can be filed up to 12 months after first becoming



available to the public. This means that brands can understand what designs are worth protecting via registration.

IV. Virtual fashion: a sustainable alternative?

On to the question of sustainability, is virtual fashion really more sustainable than traditional fashion?

When comparing virtual fashion to physical fashion, one would assume that virtual fashion produces no waste as it does not need water and therefore creates no water pollution, does not require physical samples, reducing fabric

and paper wastage, and does not need to be returned and potentially destroyed if it does not fit or is damaged.

However, virtual fashion works on the basis of use of digital data, which means there is energy usage which, if from non-renewable sources, will undoubtedly create a carbon footprint. The minting of a single NFT using a proof of work blockchain uses the same amount of electricity an average American household uses in about 47 days. This is huge.

At the moment there is limited data available to show the exact environmental impact of virtual fashion, but it is clear that it is not as eco-friendly as it may suggest. That said, as the digital age is growing and getting faster, it is only a matter of time that it will use less, but more sustainable, energy in order to be more eco-friendly.

V. Summary

Despite this, it is clear that virtual fashion is fast increasing in popularity and fashion brands must rethink their IP strategies to ensure they are legally protected at all times. Be this via trademark protection, design protection and/or keeping detailed records of use to back up unregistered rights claims.

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The minting of a single NFT using a proof of work blockchain uses the same amount of electricity an average American household uses in about 47 days.
”

Whilst some critics may consider NFTs to be a fad, we suspect the trend is here to stay and, once it has settled into some normalcy, grow.

We leave you with the prediction of James Joseph, cited by Forbes, who stated that 'In four years we imagine that everyone will walk around with AR glasses on, and you will have the digital world imposed on reality for millions of people constantly. So, then you're walking down the street in a black hoodie and some black jeans, but then you've bought a digital fashion garment, and every single person that walks past you wearing AR glasses is gonna see you wearing that garment, in real life, in real time'⁹.

However, the Wedlake Bell team would rather wear the real thing than pretend!

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¹ Fast Fashion and Its Impacts : <https://www.geneco.uk.com/news/fast-fashion-and-its-impacts>
² <https://www.bbc.co.uk/news/business-62344564>
³ Commodore v. H&M HENNES & MAURITZ LP, 7:22-cv-06247 (SDNY) : H&M is Being Sued Over "Misleading" Sustainability Marketing: <https://www.thefashionlaw.com/hm-is-being-sued-over-misleading-sustainability-marketing-product-scorecards/>

⁴ EUIPO – Green EU trade marks: Analysis of goods and services specifications, 1996-2020 (2020)
⁵ WIPO – Trademarks, Branding and Business Growth: C:\Users\chemn\AppData\Local\Microsoft\Windows\NetCache\Content\Outlook\12TQZVO\Link to article
⁶ The Vogue Business NFT Tracker | Vogue Business: <https://www.voguebusiness.com/technology/the-vogue-business-nft-tracker>
⁷ <https://www.shopify.com/uk/enterprise/fashion-ecommerce-nfts>

⁸ Inside world's FIRST metaverse department store where shoppers buy virtual designer gear | The Sun : <https://wwwthesun.co.uk/tech/18095407/inside-worlds-first-metaverse-department-store/>
⁹ NFTs and the Environment : <https://www.investopedia.com/nfts-and-the-environment-5220221>
¹⁰ The Sustainable Side Of Digital Fashion: <https://www.forbes.com/sites/forbesagencycouncil/2022/09/09/the-sustainable-side-of-digital-fashion/?sh=2be325ad6002>

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The territoriality myth: U.S. trademark law's global reach

Chris Mitchell, Member at Dickinson Wright, evaluates the extraterritorial applicability of the Lanham Act to assess if damages should be increased on the grounds of having a substantial effect on U.S. commerce.

Catchy title notwithstanding, there is no real question that trademark rights are territorial in nature. The principle is enshrined in the Paris Convention, for instance, which specifies that trademarks registered in a member country according to its' domestic legislation are independent of marks registered in other member countries. **But** are there ever circumstances where extraterritorial conduct should be subject to liability under a country's domestic trademark laws? If so, what are they and how far do they extend before conflicting with the fundamental territoriality of trademark rights?

Not long after passage of the Lanham Act (15 U.S.C. § 1051 *et seq.*) – the United States' federal trademark law – the Supreme Court had its' first opportunity to consider these questions in the matter of *Steele v. Bulova Watch Co., Inc.*, 344 U.S. 280 (1952). In that case, Bulova, a U.S. watch company, sued a U.S. citizen (and resident of the State of Texas) who was making and selling BULOVA-branded watches from Mexico using parts acquired in the U.S. and elsewhere. Some of these watches found their way back into the U.S. following sale abroad, causing reputational harm to Bulova. On these facts, the Court has little trouble coming to the conclusion that the reach of the Lanham Act was at least

sufficient to extend to the defendant's conduct, remarking that "the United States is not debarred by any rule of international law from governing the conduct of its own citizens upon the high seas, or even in foreign countries, when the rights of other nations or their nationals are not infringed." 344 at pp. 285-86 (*quoting Skiriotes v. Florida*, 313 U. S. 69, 313 U. S. 73 (1941)).

In the succeeding decades the *Steele* case spawned decisions in many lower courts articulating various tests for the Lanham Act's extraterritorial reach. Some of these tests cast a wider net than others. The Second and Eleventh Circuits, for instance, consider whether the defendant's conduct had a substantial effect in the U.S., whether the defendant is a U.S. citizen, and whether there is a conflict with trademark rights under foreign law. *See, e.g., Vanity Fair Mills, Inc. v. T. Eaton Co.*, 234 F.2d 633 (2d Cir. 1956) (finding no extraterritorial application to conduct by a Canadian defendant using a mark registered under Canadian law); *International Café, S.A.L. v. Hard Rock Café Int'l (U.S.A.), Inc.*, 252 F.3d 1274 (11th Cir. 2001). In these jurisdictions, the absence of any one of these factors may be dispositive. In the First Circuit, in contrast, extraterritorial application of the Lanham Act is automatic if the defendant is a U.S. citizen. *McBee v. Delica Co., Ltd.*, 417 F.3d





107 (1st Cir. 2005). Where the defendant is a foreign citizen, on the other hand, the Lanham Act applies extraterritorially only if the foreign conduct has a "substantial effect" on U.S. commerce. *Id.*

Now, 70 years on from the *Steele* decision, the Supreme Court has agreed to again consider the Lanham Act's extraterritorial reach. The specific question presented: Can U.S. law be applied to stop, and recover damages for, a foreign defendant's wholly foreign activities under an "infringing" trademark?

The dispute, *Abitron Austria GmbH et al v. Hetronic Int'l, Inc.* (Petition 21-1043¹), has its origins in 2006, when Hetronic's (the U.S. plaintiff) predecessor entered into an agreement with



Chris Mitchell

Hydronic Steuersystem GmbH, an Austrian company, concerning the assembly and distribution of Hetronic's industrial remote controls. Not long after that, Hetronic Germany GmbH, a company with the same ownership as Hydronic, entered into a similar agreement with Hetronic. Shortly afterwards, the relationships fell apart when Hydronic and Hetronic Germany began selling reverse-engineered Hetronic parts under Hetronic's trademark. These objectionable activities continued after the agreements ended. The common owner of Hetronic Germany and Hydronic then established two new companies, Abitron Austria GmbH and Abitron Germany GmbH (together "Abitron"), to purchase Hydronic and Hetronic Germany and carry on the sale of the same reverse-engineered, Hetronic-branded products both abroad and in the U.S.

In 2014, Hetronic sued Abitron in federal court in the State of Oklahoma, ultimately prevailing and securing both a **worldwide** injunction and a \$114 million (USD) damages award. Of that sum, \$90 million was Lanham Act damages representing Abitron's **worldwide** revenues from infringing sales, though evidence at trial demonstrated only that about \$1.1 million² worth of infringing sales ended up in the U.S. Legal justification for this award, per the trial court, was the extra-

territorial applicability of the Lanham Act on the grounds of having a substantial effect on U.S. commerce. On this basis, the global injunction against Abitron was likewise justified.

Appealing to the Tenth Circuit Court of Appeals, Abitron argued that the Lanham Act could not be applied to its' strictly foreign activities. Citing the Supreme Court's 1952 decision in *Steele*, and canvassing the approach of other judicial circuits, the appellate court affirmed the extra-territorial reach of the Lanham Act on non-U.S. defendant Abitron, finding a "substantial effect" on U.S. commerce not only from the \$1.1 million in "knockoff" product sales reaching the U.S. market, but also in the evidence of actual consumer confusion in the U.S. market and the millions in global sales that Abitron's conduct diverted from Hetronic.³

And so Abitron appealed to the U.S. court of last resort, persuasively arguing (at least, it appears, for purposes of having the petition for review granted) the existence of confusion over the reach of the Lanham Act among the lower federal courts and the impropriety of the relief in view of the basic principle of trademark territoriality.

For its part, Hetronic asserted that the relief awarded was justified as being tied to the substantial effect on U.S. commerce flowing from Abitron's infringing conduct outside the country. It also downplayed the existence of divergent tests for deciding when and whether the Lanham Act applies to extraterritorial conduct.

Prior to granting the request for review, the Court invited the U.S. government to submit a "friend of the court" brief setting forth its' views. By and large, it advocated in favor of Abitron's position and more limited application of the Lanham Act which focuses on the question of domestic confusion.

Complicating the case at this juncture is the fact that the Court's own jurisprudence for assessing the extraterritorial application of domestic legislation has changed since *Steele* was decided in 1952. Presently, the Court's analysis asks "whether the statute gives a clear, affirmative indication that it applies extraterritorially." *RJR Nabisco, Inc. v. European Community*, 579 U.S. 325, 337 (2016). As Abitron posits in its petition seeking the Court's review, the Lanham Act may not even have extraterritorial application under this new jurisprudence (though the Court's decision in at least one more recent case has at least referred to *Steele* with approval in these regards).

While U.S. law has become somewhat muddled in recent years when it comes to the intersection of U.S. and foreign trademark activities, no one can seriously contend that the principle of trademark territoriality articulated in the Paris

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The grey area between the law's applicability to purely domestic and purely foreign conduct is seemingly in disarray and in need of course correction.”

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Convention should be abandoned. But the grey area between the law's applicability to purely domestic and purely foreign conduct is seemingly in disarray and in need of course correction. If the Lanham Act even has extra-territorial reach, what "effects" on U.S. commerce justify its application? And what relief do they support? Should, as in *Abitron*, some degree of cognizable infringement in the U.S. support a "diversion of sales" theory of relief, permitting the trademark owner to recover the infringer's global profits and obtain a worldwide injunction? Or should relief be tailored to those offenses comprehended by the Lanham Act; namely, actual or likely consumer confusion in the U.S.? Should different results obtain where the infringer is a U.S. citizen, or must the reach of U.S. law over its' own give way to the territorial nature of trademarks in all circumstances where there is no injury in the U.S.? If the Court intends to fashion better guidance on the extraterritorial reach of the Lanham Act, these and other questions must certainly be considered. Only time will tell, but it does seem certain that the Court intends to at least provide some clarity on this issue and, possibly, to even hand off the matter to the U.S. Congress by finding that the Lanham Act lacks any extraterritorial reach.

Résumé

Chris Mitchell, Member

Chris focuses his practice on intellectual property procurement, licensing and enforcement in the areas of consumer products, automotive products, life sciences and medical devices. He has represented biochemical producers, manufacturers of food products, sporting goods and building products, food service franchisors, consumer product companies, medical device manufacturers, automotive parts suppliers, clothing manufacturers, national consumer products' retailers and online service providers.



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¹ The online docket, including all briefs, may be found here: <https://www.supremecourt.gov/docket/docketfiles/html/public/21-1043.html>

² The sum established at trial was about 1.7 million euros, which was approximately \$1.1 million USD in early 2020.

³ The appellate court did limit the global injunction to extend only to those countries where Abitron was doing business.

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Cultural misappropriation: protecting the culture of the Mexican people

Laura Collada, Managing Partner at Dumont, details the differences between the indigenous cultures in Mexico to express the importance of protecting these cultures against exploitation and infringement.

Intellectual Property is quite a dynamic subject. There is always something new: a different approach, new technologies to protect, innovation, trending topics, precedents, etc. Many of these approaches pretty much depend on each jurisdiction. During the pandemic and after it, we have heard about vaccines, new inventions, metaverse, web 3.0, crypto, and others, but in my country, Mexico, besides that, we have heard a lot about cultural heritage and cultural misappropriation.

The background is mainly historical. You might recall that Mexico has millenary cultures, the most well-known being the Aztec and the Maya cultures. However, Mexico is the second most important country in terms of cultural diversity, just after India. It has 62 indigenous cultures with their own languages and their variants (+350) which, speaking in terms of population, is approximately one-fifth of the population.



Laura Collada

Culture overlaps different historical periods, languages, and religions and the result of it is therefore diverse: food, clothing, beverages, religions, rituals, art, embroidery, tapestry, ceramic, etc. Mexico is diverse and identity and customs pretty much depend on every single region of our country. People are different, weather affects the population in terms of economy, and the northern and central regions are much more industrialized than the south. Language is spoken differently, with different accents and sometimes mixed with regional languages or influences, for example, northern states bordering with the United States speak Spanish with many anglicisms. Yucatan also has its own language, Spanish mixed with Mayan expressions and a bit of Arabic due to a large population of Lebanese and Syrian descent.

Our country is divided by the tortilla, the north is flour tortillas and the south is corn. The Northeast regional dish is the goatling due to a Sephardic population that came with Spanish conquerors, the northwest is strong in cattle ranches and the south loves pork. Moreover, and politically speaking, the north is more conservative and the south believes in a more social-democratic way of government. The north is wealthier than the south. However, it is not only north or south, the east and west coasts are also completely different. Mexico is a country of syncretism, a melting pot of the indigenous peoples, peoples of European descent and a smaller Afro-Mexican population that developed from slaves fleeing to Mexico to be free in the XVIII and XIX centuries.

With that said, you can imagine the cultural diversity of Mexico and the challenges it represents. There are some communities that are governed by communal ancient ways, and this is accepted

by our Constitution. Minorities are recognized and protected by it (article 4) and so is their structure including the ancient legal frameworks.

On the other hand, there is a trend to recognize the cultural heritage of indigenous peoples in ways such as inspiring and paying homage to fashion houses, fast fashion manufacturers, and many other entrepreneurs who identify that today it is fashionable and trendy to wear clothes that look ethnic or stylish in a way that resembles items which imitate cultural heritage. Obviously, these two worlds undoubtedly clash.

The *Federal Law for the Protection of the Cultural Heritage of Indigenous and Afro-Mexican Peoples and Communities* has been published this year (2022) with the purpose of recognizing and protecting the collective rights of ownership by indigenous and Afro-Mexican peoples and communities over their cultural heritage, knowledge, and traditional cultural expressions as well as the collective intellectual property in connection with such heritage/patrimony.

As mentioned before, our Constitution establishes (article 4) that the government will promote the knowledge and development of the culture considering cultural diversity and its expressions with the utmost respect to creative freedom.

It is important to point out that protection of the expressions/manifestations will cover them even if they have been communicated in a continuous or discontinuous manner, have been practiced and transmitted to them by members of their own community from previous generations, regulating their interaction with third parties interested in obtaining authorization to exploit the rights derived therefrom.

The different levels of government, when applying and enforcing the law, should observe the following principles: biculturalism, communality, fair and equitable distribution of benefits, gender equality, equality of cultures and non-discrimination, self-determination and autonomy, free expression of ideas and manifestations of culture and identity, legal pluralism, pluriculturalism and interculturality and last as regarding cultural diversity. As you can see all these principles will favor the communities.

When applying and enforcing this legislation, the different levels of government will respect the ancient ways and customs of the populations protected by it, meaning that how they solve controversies, their legal frameworks as well as their self-determination and autonomy will have to be respected. The government will recognize the persons named by the communities as their representatives. We will comment later on the several issues that these provisions bring along when they clash with federal legislation.

Résumé

Laura Collada, Managing Partner

Laura joined Dumont in 2000, when she was hired to spearhead the launch of the firm's litigation department. In 2008 she was named Managing Partner and has since helped to fully digitize the firm's systems and improve efficiencies and capabilities to better meet clients' needs. She has more than 30 years of experience in Intellectual Property and was Deputy Director of Unfair Competition Prevention at the Mexican Institute of Industrial Property (IMPI). Laura's broad expertise enables her to work on an array of IP matters. She advises clients on how to enhance protection of their trademark portfolios and helps to plan both patent and trademark litigation strategies. She is the main contact with the firm's clients and oversees all teams to deliver quality IP legal services.



This property right is recognized as: **inalienable, imprescriptible, unwaivable, unseizable, and collective.** The communities are recognized as subjects of public law.

This new law recognizes and introduces concepts which overlap with federal legislation regarding intellectual property, the reason for which it has turned the scene very complicated for anyone trying to commercialize products which in any way resemble cultural heritage.

The *Federal Law for the Protection of the Cultural Heritage of Indigenous and Afro-Mexican Peoples and Communities* recognizes that all cultural heritage from the communities is their property and its use and exploitation will be forbidden, except where consent exists. There will be special protection for traditions, customs, spiritual ceremonies, sacred places, ceremonial centers, symbols or any other sensitive actions or places. This means that cultural patrimony doesn't require any administrative proceeding to be established and that property rights are recognized for any legal purposes.

This new law establishes the way in which agreements with communities will have to be entered into, and declares that prior agreements will be null and void. It also establishes that all authorizations will be temporary and limited to a maximum of five years.

The communities have the right to initiate legal actions against any third party in cases of use, exploitation and/or misappropriation, in cases in which there is no consent. The right to claim will not be subject to any statute of limitations and may be exercised at any time through the competent authorities.

Disputes arising in connection with issues regarding the framework of this law will be resolved by the *National Copyright Institute* through **mediation** or **complaint procedure**, at the choice of the community or people related to the concerned matter. Also, the Attorney General Office can prosecute and ban the sale of copied goods.

The new law **defines** and **regulates** the misappropriation of these assets by conducts that imply their unauthorized use. It also **includes a catalog of infringements and offenses.**

The law creates several new governmental bodies:

- a. The *System for the Protection of the Cultural Heritage of Indigenous and Afro-Mexican People and Communities*, as a permanent mechanism of **concurrence, collaboration, coordination, and inter-institutional agreement** of the federal government, with the participation of the people and communities; and

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Under the new law, penalties, fines, and even prison are established for infringers who illegally reproduce, copy, imitate, and appropriate cultural heritage without consent or proper authorization.”

- b. The *National Registry of the Cultural Heritage of Indigenous People and Communities* as an instrument for **identifying, cataloguing, registering, and documenting** the cultural manifestations of the people and communities. Due to the latter, *registrations* may be requested, *even when there is a dispute with third parties*, simply by making the corresponding annotation.

Taking into consideration this description of the provisions of the law, we understand the issues that arise from it. First and foremost, their legal frameworks are not coded but passed through generations orally. This can cause misinterpretations.

The government will recognize the representation of the person named by the community. This is a new type of legal representation introduced to our legal framework that most probably will not follow the general principles of civil law and thus it is not clear to which extent they may act and which limitations such representation may have.

A very important issue is that there is no good solution for the public domain elements and this is serious because then the rights will be valid with no time limitations, which goes against general standards provided by international treaties on copyright.

The governmental bodies that were provided for have not yet been created, meaning that even when they are established by law, no work has been done. It is important to highlight that identifying, cataloging, registering, and documenting the cultural manifestations of the people and communities is a titanic task and so far there is no progress whatsoever.

Finally, there are two major issues to consider: communities do not know how to proceed. There has not been any socialization of this law meaning that government entities communicate the content and the extent of this new law to the communities and explain to them how it works. The consequence is that, so far, many communities aren't aware of it. On the other hand, there is no legal certainty for fashion houses, fast fashion manufacturers, and other kinds of businesses due to the overlapping of rights and actions between this law and federal laws. Even when there is certainty that it will be enforced, depending on the case, by the National Copyright Institute, there is nothing on how the actual rulings will be and which procedures will prevail, since many of them will also require principles of the Federal Law for the Protection of Industrial Property and concepts as similarity, and others in the turf of the latter.



It is important to point out that this new legislation tries to fight plagiarism, especially by the fashion industry. In recent years there have been many cases of embroidery and textile patterns allegedly copying those originally created by Mexican communities.

Under the new law, penalties, fines, and even prison are established for infringers who illegally reproduce, copy, imitate, and appropriate cultural heritage without consent or proper authorization.

There is a very blurry and thin line between paying homage and inspiration and copying or imitating patterns, symbols, etc., which are considered part of the cultural heritage. Major fashion houses, as well as fast fashion companies have allegedly copied, without consent, elements of the Mexican Cultural Heritage with their designs, but no actions have been taken against them, and communities aren't acknowledged or compensated.

This new law is being sold as a solution to the problem and tries to fight back against plagiarism. It is not working due to issues and problems with its implementation. It is broad and vague.

In the past year, there have been a couple of cases that have allegedly copied cultural heritage designs, motifs, and embroidery of certain communities. Rather than taking legal action,

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It is important to point out that this new legislation tries to fight plagiarism, especially by the fashion industry.”

authorities of very high profile have litigated them on social media trying to tarnish the reputation of major fashion houses and on-line stores. Companies have apologized or stated that they were inspired by these elements – despite the lack of any legal actions – to try to avoid damage to their goodwill and high reputation. This is not right, if there is an alleged infringement or misappropriation, claims must be filed but the reality is that legislation as it is, has no teeth.

The intention of the law is good but needs improvement. Many communities make a living out of the products they sell, all of them belonging to their cultural heritage. The fashion industry can work with the communities and compensate them, which would be a win/win.

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The Court of Justice rules to destroy genuine goods if parallel import

Klaudia Błach Morysińska, advocate, trademark and patent attorney at Zaborski, Morysiński Law Office, reviews a recent judgment that witnessed the order of destruction of genuine goods having been placed on the EEA market without permission after import.

In its judgment dated October 13, 2022 (C-355/21), the Court of Justice decided that a protective measure in the form of the destruction of goods may be applied to the genuine goods which have been manufactured and to which a European Union trademark has been affixed, with the consent of the proprietor of the trademark, but which were placed on the market in the European Economic Area without their consent. The case focuses on the issue of original products illegally sold in the European Union without the rightsholder's consent.



Klaudia Błach Morysińska

This judgment was issued in a case between Procter & Gamble International Operations SA (further: Procter & Gamble), a producer of perfumery products, and Perfumesco.pl sp. z o.o. sp.k. (further: Perfumesco.pl), an owner of an online perfumery shop. The case refers to the test products that were not intended for sale. The case has the following background:

Procter & Gamble is authorized to use the EU word mark HUGO BOSS ('the HUGO BOSS trademark') under a licensing agreement granted by HUGO BOSS Trade Mark Management GmbH Co. KG. (further: Hugo Boss Co.). The Hugo Boss trademark was registered for the following goods in Class 3: Fragrant sprays; perfumes, deodorants for personal use; soaps; articles for body and beauty care.

Hugo Boss Co. makes available free of charge to the sellers and authorized distributors samples of products or testers solely to present and promote cosmetics. The testers come in bottles identical to those used for sale under the HUGO BOSS trademark. There is clear information stating that the samples are not intended for sale, for example, by one of the following indications: 'not for sale', 'demonstration' or 'tester'. The samples are not placed on the European Economic Area (EEA) market either by HUGO BOSS Co. or with its consent.

Perfumesco.pl is an online perfumery shop. It offered for sale samples of perfumery products bearing the HUGO BOSS trademark and marked 'tester'. The company stated that the samples do not differ in scent from the original product. Some of the offered goods had removed or covered bar codes. Perfumesco.pl did not

remove or cover the bar codes. It also did not check the lawful origin of the goods and relied on contractual partners in this scope.

Procter & Gamble sued Perfumesco.pl for the HUGO BOSS trademark infringement. It stated that testers with HUGO BOSS trademarks were not for sale and that the manufacturer intended to place them on the market outside the EEA. The rightsholder obtained the interim injunction, including the seizure of the perfumes, eau de toilette, and scented water in packaging bearing the HUGO BOSS trademark. All the seized goods were testers not intended for sale, products designated by codes indicating, according to Procter & Gamble's statement, that the manufacturer intended them to be placed on the market outside the EEA and products in respect of which the bar codes affixed to the packaging had been removed or obscured.

In a case before the civil courts, courts of both instances ordered, among other measures, Perfumesco.pl to destroy perfumes, eau de toilettes, and scented water whose packaging bore the HUGO BOSS trademark, in particular testers, which had not been placed on the market in the EEA by HUGO BOSS Co. or with its consent. The appeal court found that Article 286 of Polish Industrial Property Law should be interpreted by Article 10(1) of Directive 2004/48, which it transposes into Polish law, and that all goods infringing intellectual property rights had to be considered to be illegally manufactured within the meaning of Article 286 Polish Industrial Property Law.

Perfumesco.pl disagreed with the verdict and filed an appeal in cassation to the Supreme Court. Its main argument was based on the wording of Article 286 of the Polish Industrial Property Law. Under this provision, the court hearing a case alleging infringement of the rights may, at the proprietor's



VidEst / Shutterstock.com

request, rule on goods belonging to the infringer which have been illegally manufactured or marked and on the means and materials used to manufacture or mark them. It may, in particular, order that they are withdrawn from the market, allocated to the rightsholder in the amount of money assigned to them, or destroyed. In its decision, the court shall consider the seriousness of the infringement and the interests of third parties.

Perfumesco.pl argued that under Article 286 of Polish Industrial Property Law, it is not possible to order the destruction of the original goods. Procter & Gamble did not dispute that the perfumes seized were authentic products. It just argued that HUGO BOSS Co. had not consented to the goods being placed on the market in the EEA and that Perfumesco.pl had not proved the existence of such consent. As a matter of that, there was no doubt that the goods were original. If the goods were authentic, they could not be deemed as illegally manufactured or marked. Ergo sum Article 286 of the Polish industrial law was not applicable in this case.

In those circumstances, the Supreme Court decided to refer the question to the Court of Justice for a preliminary ruling. By its inquiry, the referring court asks, in essence, whether Article 10(1) of Directive 2004/48 must be interpreted as precluding the interpretation of a national law provision according to which a protective measure in the form of the destruction of goods cannot be applied to goods which have been manufactured and to which an EU trade mark has been affixed, with the consent of the proprietor of that mark, but which were placed on the

market in the EEA without their permission. To answer this question, the Court of Justice interpreted the concept of infringing an intellectual property right within the meaning of Article 10(1)

of Directive 2004/48. According to the wording of this article, the competent judicial authorities may order, at the applicant's request, that appropriate measures be taken about goods that they have found to be infringing on intellectual property, including the destruction of goods. The Court of Justice noticed that this provision does not limit the application of the corrective measures it provides to certain types of infringement of an intellectual property right. Moreover, the competent judicial authorities must consider that the seriousness of the infringement and the remedies ordered must be proportionate and in the interests of third parties. Keeping to the above principles, they may decide on the measure to be adopted in each case.

The Court of Justice referred to Article 46 of TRIPS, as examined Article 10 of the Directive 2004/48, is the transposition of the TRIPS mentioned above regulation to the EU law. Under this regulation, the judicial authorities may order that goods that they have found to be infringing be, without compensation of any sort, disposed of outside the channels of commerce. TRIPS agreement has a general wording that covers all goods found to be infringing an intellectual property right, irrespective of the form of infringement.

The Court of Justice underlined that the Member States may not provide for less protective measures than foreseen in Directive 2004/48. In particular, it is impossible to restrict the application of the measures provided for by that directive to certain types of infringement of intellectual property rights. It is clear from the wording of Article 2(1) of Directive 2004/48 that it covers any infringement of intellectual property rights as provided for by Community law and/or by the national law of the Member State concerned.

Bearing the above in mind, Article 10 of Directive 2004/48 covers all goods found to be infringing intellectual property rights, irrespective of the form of infringement, without excluding a priori the application of the corrective measure of destruction. As a matter of that, Article 10(1) of Directive 2004/48 must be interpreted as precluding the interpretation of a provision of national law according to which a protective measure in the form of the destruction of goods may not be applied to goods which have been manufactured and to which an EU trademark has been affixed, with the consent of the proprietor of that mark, but which were placed on the market of the EEA without their permission. Therefore, genuine goods that infringe intellectual property rights, in this case a trademark, may be destroyed because they were unlawfully imported into the EEA. The Court of Justice underlined that the measures imposed in response to an

“
Genuine goods that infringe intellectual property rights, in this case a trademark, may be destroyed because they were unlawfully imported into the EEA.
 ”

infringement of intellectual property must be determined on a case-by-case basis by the competent judicial authorities.

The ruling is favorable to owners of intellectual property rights, in this case, trademarks. If a product infringes the intellectual property rights, regardless of the form of the infringement, and thus whether we are dealing with counterfeit goods or original goods but marketed in the EEA without the consent of the rightsholder, at the request of the right holder, the court may order their destruction. It is up to the court each time to assess case-by-case whether the application of such a measure is justified, whether it is proportionate in the circumstances of the case and whether it does not infringe on the rights of third parties, and therefore whether it can be applied.

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FAQs: Trademark nullity in Argentina

Diego Palacio, Partner at Palacio & Asociados, answers important questions about nullity in the Argentinian trademark system to provide handy tips.

The latest changes in the Trademark Law (2019) established important modifications to the operation of the trademark nullity system. We understand that staying updated on these matters is key to properly looking after your trademarks or in case you wish to enter the Argentine market. We hope these tips will come in handy!

1. What trademarks may be declared null and void?

Trademarks registered in violation of the provisions of the Argentine trademark law may be declared null and void.

For instance, those registered trademarks that do not have distinctive capacity, trademarks that are identical or similar to other trademarks previously petitioned for covering the same products or services, trademarks that encompass GIs and appellations of origin, trademarks that are likely to induce consumers to errors, trademarks contrary to morals and good customs, trademarks indicating the name, pseudonym or portrait of a person without their consent or that of their heirs up to the fourth degree inclusive, among others.

Other reasons include serious flaws that



Diego Palacio

cannot be corrected, such as the lack of signature in the application or of legal capacity, lack of or error in the indication of goods or services, erroneous publication, or likelihood of confusion, etc.

2. Can a trademark application be nullified?

Only registered trademarks may be declared null and void by the Trademark Office. A trademark application pending registration cannot be nullified.

3. What are the requirements for filing a nullity action?

For a nullity action to proceed at the request of a party, the plaintiff must invoke the affectation of a subjective right or a legitimate interest, and that the action is not prescribed.

4. What nullity actions must be filed directly before the courts?

The request to declare a trademark null and void due to bad faith, by someone who, when applying for registration, knew or should have known that it belonged to a third party, as well as against whoever requests the trademark for its

commercialization, carrying out the registration of trademarks for sale as a habitual activity, are not dealt with by the Trademark Office. For these two specific situations, the nullity of the trademark is ruled by the national justice in federal civil and commercial matters. The action will be treated according to the rules of the ordinary process.

Judicial nullity due to bad faith would apply both against registered trademarks and trademark applications since it would not make sense to have to wait for the same to be granted to initiate the nullity.

5. When does the nullity action prescribe?

According to the Argentine trademark law, the nullity action prescribes after 10 years. However, when it comes to nullity due to bad faith, our jurisprudence has established that they do not prescribe.

6. Who has standing to file a nullity action?

Any person or entity may file a nullity action on the grounds of infringement of a subjective right or a legitimate interest.

In addition, the Trademark Office may request it *ex officio* in the event of detecting a serious non-remediable defect in the trademark registration procedure.

7. What requirements must the nullity action meet?

The nullity request must indicate:

- Petitioner's name and address.
- Name and address of the owner of the registration.
- The subjective right infringed (or the legitimate interest).
- The trademark for which nullity is sought, the grounds for nullity, and supporting evidence thereof; and
- Payment of the required fees must be made.

Résumé

Diego Palacio is Partner at Palacio & Asociados, one of the most experienced Intellectual Property Law Firms in Argentina that in 2023 celebrates its 90th anniversary. Graduated from the University of Buenos Aires, School of Law. Used to be a Commercial Law professor at the University of Buenos Aires.

He is a Patent and Trademark Agent, a member of the Argentine Association of Industrial Property (AAAPI) and other renowned international associations such as the International Trademark Association (INTA) and Associação Brasileira de Propriedade Industrial (ABPI).

He also attends the European Communities Trade Mark Association (ECTA), the Asian Patent Attorneys Association (APAA) as an observer participant, and the ABPI Annual Congress each year.

His work mainly focuses on trademarks, patents, utility models and designs, domain names, copyrights, transfer of technology, customs (IP), and data protection.

He was a panelist on "Non-conventional Trademarks: issues related to the protection of three-dimensional marks in the era of 3D printing" on August 22, 2017, at the International Congress of ABPI (Brazilian Association of Intellectual Property) in Rio de Janeiro.

He was a speaker in the "Interplay between Designs, Copyright and Trade Dress (Trademarks) -Overlapping or Coexisting?" session at the INTA Annual Meeting in Boston on May 20, 2019.

He served in the INTA Unreal Campaign Committee (2016-2017), the INTA Geographical Indications Committee (2018-2019), and the INTA Emerging Issues Committee (2020-2021). He has been recently appointed to the Famous and Well-Known Marks Committee.

Diego speaks fluently Spanish, English, Portuguese and French.



Only registered trademarks may be declared null and void.



Judicial nullity due to bad faith would apply both against registered trademarks and trademark applications.





8. Can the Trademark Office reject a trademark nullity action?

The Trademark Office may reject a petition for trademark nullity that:

- a) Does not comply with any one of the above-mentioned petitions requirements.
- b) Has already been settled as to the same grounds for nullity.
- c) Has been lodged and/or settled within Administrative Opposition Proceedings.

9. What are the steps in a trademark nullity process before the Trademark Office?

The nullity process can be an ancillary proceeding, or a matter dealt with within an opposition proceeding.

Ancillary proceeding

Once the request for nullity has been submitted, the owner of the registered trademark will be notified, so that, within a period of 15 working days, they can answer and submit evidence.

When the nullity is initiated *ex officio*, the Trademark Office must invoke the serious non-remediable defect of the procedure on which it is based, which will be notified to the owner, for the same period, with the same purpose.

Once the notice has been answered or the term to do so has expired, the Trademark Office will decide on the merits of the evidence, the facts, and grounds stated by the parties.

Within an opposition proceeding

If the nullity action is initiated in the context of an opposition, it must be filed in parallel. The Trademark Office may deal with it in a single resolution, or issue two separate resolutions.

10. Can the resolutions of the Trademark Office be appealed?

All decisions made by the Trademark Office within the nullity process may be challenged through a motion for reconsideration (10 working days) and/or an appeal before a higher administrative authority (15 working days). The final decision may be challenged through a motion for reconsideration or an appeal before a higher administrative authority, or a motion may be filed before the Federal Court of Appeals in Civil and Commercial Matters (30 working days) set forth by Section 24 of Law No. 22362, which shall be filed before the local TMO.

If a motion for reconsideration and/or an appeal is filed before a higher administrative authority and the original decision is upheld, the motion or appeal may later be filed before the Federal Court of Appeals in Civil and Commercial Matters.

Applicable Laws:

Trademark Act No. 22362, Section 24. (Section replaced by section 73 of Law No. 27444).
Executive order 242/2019, Section 24.
(Regulation Act 22362)

Argentine Trademark and Patent Office
Resolution 183/2018, annex III (incorporated by Resolution P279 / 2019, annex I).

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Is all publicity good publicity?

Claire Jones, Trademark Director at HGF, summarizes recent trademark disputes that have caused a stir in the media to evaluate whether public disputes are good for exposure or rather a risk to a brand's reputation.

There have been a number of trademark cases recently that have been seen in mainstream news outlets, sparking debate and discussions on social media.

This includes the battle of the oat drinks in *Oatly AB v Glebe Farm*, and the *David v Goliath Bentley Clothing v Bentley Motors* proceedings, or comedian Joe Lycett changing his name to Hugo Boss.

Enforcement of trademark rights is a core element of any brand protection policy, and whilst PR risks may have always been a consideration, the risks of a cease and desist letter or enforcement correspondence to a third party being released on social media has been on the rise in recent years.

Match Group v Muzmatch

Match Group, which owns the popular dating app TINDER, filed an infringement action at the Intellectual Property Enterprise Court against the mark "MUZMATCH". The IPEC decision was in Match Group's favor, holding that Muzmatch had infringed the earlier "MATCH" rights and taken an unfair advantage that could lead to consumers believing there to be a connection between the two entities.



Claire Jones

The case has some interesting comments on the suitability of the IPEC forum for what was quite a complex set of issues, but the amount of publicity generated by the case, through journalists and social media, is also thought-provoking. Muzmatch's founder also received a rebuke from the courts after sending an embargoed press release to journalists.

Zara v House of Zana

Fashion retailer ZARA was recently unsuccessful in UK opposition proceedings against a Darlington-based independent boutique *HOUSE OF ZANA*. The case received a lot of media attention; probably more than UK opposition proceedings usually do, resulting in a lot of negative press against Zara for their 'tactics', including a petition of more than 70,000 people demanding that the action was withdrawn.

Condé Nast v Cornish pub

A number of mainstream news outlets earlier this year reported on fashion magazine *VOGUE* sending a cease and desist letter to *The Star Inn at Vogue* in Cornwall, a pub in a Cornish hamlet that has existed for over 200 years, requesting that the pub ceased use of 'VOGUE' as it could confuse readers or assume a creation between the two businesses.

The Cornish pub initially thought that the correspondence was a joke being played on them by a regular and shared their response to Condé Nast on social media. In response, Condé Nast acknowledged that 'further research' would have identified that such a letter was not necessary in the circumstances.

Caterpillar Wars

The reporting of court proceedings being filed in this case started monumental engagement across social media platforms, in part due to Aldi's media team's immediate reactions over the days following the filing.



Pippilongstocking / Shutterstock.com

The two companies had very different approaches to social media engagement, with Aldi going full throttle with a number of posts, tweets, and hashtags. M&S's approach was more low-key, with Colin declining to make a statement, but thanking consumers for their support and a brief tongue-in-cheek meme following the first week of trending on Twitter.

Commentary

Whilst reports like the Vogue pub have been taken relatively light-heartedly, this is not always the case, as can be seen from instances such as the public petition for Zara to withdraw the opposition, and the sheer amount of Tweets shared in the caterpillar wars.

In some instances, the filing of an objection, whether an opposition, infringement, or a cease and desist letter can generate more publicity for a competitor or third party than is really warranted (or that they would get on their own). There can also be significant reputational damage, with consumers being 'against' a brand or backing a competitor.

The risk of negative publicity is something to be considered at the initial stages, together with the strength of the earlier rights, the nature of the use being complained about (and whether the user of the mark may have prior rights or a good defense) and the potential impact of publicity vs not taking any action.

Condé Nast could have avoided any publicity on its enforcement strategy if the use and history of the Star Inn had been investigated in more depth. Unresearched actions can sometimes be associated with overeager lawyers, as has previously been the case with Brewdog, when it requested a Birmingham family-run pub *The*

Lone Wolf to change its name, even though it had been using the name before Brewdog intended to launch a spirit company under the same name. Brewdog backed down, amid public outrage.

All risks needed to be balanced; if there is a high possibility of confusion or damage to reputation by the existence of a third-party right, the risks of negative publicity may be outweighed by the need to take steps against those rights.

Alongside the legal perspective, the commercial value of threatening action needs to be considered; what are the implications of such vast media coverage, even if the judgment is in the objector's favor?

It can also be useful to check the tone of any correspondence sent. Whilst correspondence often is formal in nature, there are ways of modifying the tone, especially if there is scope for amicable resolution or negotiations.

And is there such a thing as bad publicity? Whilst the publication of enforcement requests may have some initial negative connotations, it can assist in generating knowledge of a brand, and may in some ways dissuade others from infringing the rights in the future. There needs to be a balance between enforcement and damage; carefully reviewing each instance of potential infringement before sending correspondence.

“ There can also be significant reputational damage, with consumers being ‘against’ a brand or backing a competitor. ”

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Brazil looks into the future: secondary meaning analysis during trademark prosecution

Laura Marques of Vaz e Dias Advogados & Associados gives her perspective on secondary meaning set to be introduced at the BTO in 2023 which is bringing hope of a valuable tool for securing registration.

On October 27, 2022 the Trademark Director of the Brazilian Trademark Office (BTO) – Mr. Felipe de Oliveira – delivered a speech at the Bar Association (OAB/RJ) in a seminar related to the applicability of secondary meaning in Brazil¹.

The content of his speech was very much anticipated, since it addressed an existing but unapplied project to regulate the application of the secondary meaning by the BTO's examiners during the trademark examination procedure. Accordingly, the Director stated that the regulation is in the final stage of elaboration and will most likely be in force in the second semester of 2023. Such regulation will permit



Laura Marques

the examiners to acknowledge the secondary meaning of signs and grant registration during trademark prosecution when their ability to distinguish products and services in a specific market is duly evidenced.

This asserting statement is regarded as a positive development of the trademark prosecution system in Brazil due to the BTO's persisting reluctance to accept secondary meaning arguments when examining the distinctiveness requirement for trademark registration.

This paper will address this issue and some of the criteria that the examiners will most likely need to take into consideration during the secondary meaning examination. The examination criteria described in this paper strictly follows the content of the Director's speech and discussions in the Seminar event of October 27, 2022.

Secondary meaning concept under Brazilian Law and its legal treatment

"Secondary Meaning"² is understood by Brazilian scholars and under case law as the ability of an undistinguished sign or feature under the Brazilian Industrial Property Law (IP Law) to obtain the distinctiveness through the continued commercial use of the sign in that market. This commercial phenomenon highlights the conquest of the distinguishing features of a product/service by means of intense advertising investments to promote the mark. The expected consequence is that the mark starts to be recognized without

the necessary association to the products/services that it identifies. It is only applied to common/generic marks that achieve the ability to detach from the generic features of the items identified.

Since the secondary meaning is not expressly included in the existing IP Law, attorneys and scholars advocating in its favor use a broad interpretation of Article 122 of the Brazilian IP Law³ to permit the BTO's examiners to apply the secondary meaning during the examination of the registration requirements. Accordingly, said Article 122 demands the fulfillment of the distinctiveness requirement to secure registration signs and features, and states that "Any distinctive visually perceivable signs that are not included in legal prohibitions shall be eligible for registration as a mark". Since Article 122 states that what is not included in the legal prohibitions can be registered as a trademark, there are legal and reasonable arguments to support the registration of a trademark that is able to prove its distinctive character obtained through repeated use by the public.

The secondary meaning during trademark prosecution is further supported by the fact that Brazil is a signatory country of the Paris Convention and the TRIPS Agreement, both duly incorporated into the legal system. We recall in this matter Article 6 *quinques* of the Paris Convention⁴ that interpreted together with Item VI of Article 24 of the IP Law gives grounds to register a mark when it is "endowed with a sufficiently distinctive form".

Further to that, Article 15.1 of the TRIPS Agreement recognizes the registration of a mark through the secondary meaning phenomenon when acquired through use.

However, the reality is that currently the BTO does not accept any distinctiveness request through "secondary meaning" during trademark prosecution. Such reluctance leads businessmen to undergo a time-consuming and costly court procedure at the federal courts to obtain the recognition of the distinguishing characteristics of their sign. This raises a scenario of legal uncertainty due to the non-existing rules and established criteria for the acceptance of secondary meaning even at the court procedures.

Historically, the BTO has always opposed the acceptance of the secondary meaning because Brazil adopts the attributive system based on the examination of the registration requirements during the administrative procedure. This attributive system does not allow the analysis of facts that occurred before the filing of the application. Further to that, there is a clear BTO's opposition to apply this legal institute due to the fact that examination under secondary meaning would delay the registration process, jeopardizing the credibility of the agency's work. This is alleged to be due to the special difficulty in the probative analysis of secondary meaning.



Résumé

Laura Marques is an attorney at the Brazilian law firm Vaz e Dias Advogados & Associados. She holds a law degree from the Pontifical Catholic University of Rio de Janeiro (PUC-Rio), and a post-graduate degree in Intellectual Property and Competition Law at Candido Mendes University (UCAM). She is an expert on trademark prosecution and litigation. She also possesses broad expertise in matters related to unfair competition and counterfeiting, as well as issues related to domain names, software, and internet law.

¹ <https://www.youtube.com/watch?v=yfLP6bANqXE>

² A secondary meaning is an additional meaning acquired by a non-distinct trademark through its commercial use. To acquire federal trademark protection, a non-distinctive mark must become associated with a single commercial source in the minds of consumers. (See, e.g., the term "apple.") Secondary meaning can be measured in a variety of ways—from consumer surveys to sales volume to quantity of advertising, among others. (https://www.law.cornell.edu/wex/secondary_meaning)

³ "Article 122 - Any visually perceptible distinctive sign, when not prohibited under law, is susceptible of registration as a mark."

⁴ (1) Every trademark duly registered in the country of origin shall be accepted for filing and protected as is in the other countries of the Union, subject to the reservations indicated in this Article. Such countries may, before proceeding to final registration, require the production of a certificate of registration in the country of origin, issued by the competent authority. No authentication shall be required for this certificate. (2) Shall be considered the country of origin the country of the Union where the applicant has a real and effective industrial or commercial establishment, or, if he has no such establishment within the Union, the country of the Union where he has his domicile, or, if he has no domicile within the Union but is a national of a country of the Union, the country of which he is a national.



Turning point: the BTO's change of position

Notwithstanding the aforementioned BTO's practical and legal arguments against using the secondary meaning concept through trademark prosecution, it seems that a new mentality has been dominating the examiners that led to the tailoring of a specific regulation on secondary meaning at the administrative level.

As stated by the BTO's Director, it was a great challenge overcoming the enormous backlog in trademark decisions over the past few years. 10 years ago, the BTO was taking over five years to render decisions on applications without opposition, whereas now they are taking around 12 months or less. This is indeed a great achievement that had an undeniable impact on this upcoming possibility of invoking the secondary meaning during the trademark prosecution phase.

After such a successful achievement, it is time now to move further and consider the insertion of the secondary meaning into the trademark examination procedure. This would also integrate Brazil into the global value chains with regard to intellectual property, favoring business services and the productive sector. For this purpose, the Director reported that the BTO is undertaking strong work of international benchmarking, studying foreign rules, and seeking to adopt appropriate successful practices in Brazil, in addition to incorporating a marketing vision on the consumer's use and recognition concerning products and services identified by registered trademarks.

According to the BTO's Director presentation, the granting of registrations based on secondary meaning will take place by means of a specific applicant's request comprising the following information:

- Consumer perception survey: a survey considering the marks' target audience would need to evidence the preponderance of the recognition of the secondary meaning of the mark, to the detriment of its primary (and generic) meaning.
- Sales volume (quantity and value).
- Intensity of use/prolonged use in the market. The longer the mark has been in use in the market, the greater chance it has of obtaining distinctiveness under the secondary meaning. However, as we have also seen a few cases of fairly new marks that are able to achieve a considerable degree of recognition by their target audience, the topic of defining if a specific term of the mark's use will be necessary is still under analysis.
- Consumer testimonials comprising documentary evidence that the sign has changed from the consumer's point of view. We once again face the necessity of trademark owners to prove the preponderance of the

“ There are legal and reasonable arguments to support the registration of a trademark that is able to prove its distinctive character obtained through repeated use by the public. ”

recognition of the secondary meaning of the sign, to the detriment of its primary/generic meaning. Applicants would need to present a vast amount of evidence and testimonials showing the newly-acquired distinctiveness of the mark.

- Testimonials and endorsement of Trade associations and professionals in the area attesting the newly-acquired distinctiveness of the mark.
- Discourse analysis: the necessity of verifying if the mark is indeed being used as a product/service identifier and if it is recognized as such in the media, or if the mark is still viewed as merely generic and non-distinctive;
- Advertising investments to promote the signal (effectiveness).
- Geographic extent covered by the signal: the mark aiming for secondary meaning should be recognized as such throughout the national territory.

These are a few of the criteria addressed by the BTO's Director who is confident that the regulation will be able to open up the possibility for recognizing acquired trademark distinctiveness without demanding immense information to the applicant.

Notwithstanding the importance to prevent excessive bureaucracy, the BTO should further take into consideration some of the criteria constructed by the case law under the federal courts. The most relevant one is the evaluation of the situation actually taking place in the market, and among the trademark's target audience. This should clearly evidence the distinctiveness requirement of the sign or feature that has been exploited in the market and recognized by consumers and general public as distinguishing a peculiar product from the competitors'.

Challenges for incorporating the secondary meaning

Yet, there are many challenges to be faced by the BTO. One of them would be defining the moment the secondary meaning request would take place and be examined. In this regard, the BTO's Director sustained that secondary meaning requests should take place only in the appeal phase of the administrative process, not in the filing for registration. Such a statement is justified under the BTO's viewpoint due to the fact that a secondary meaning request from the outset of trademark application could lead to an undue use of this institute and overload the examiners with unreasonable requests for market recognition.

Therefore, the BTO has leaned on accepting the examination of the applicant's intention of distinctiveness acquired by means of secondary meaning only in case it rejects the application and also when the rejection is grounded on



the lack of distinctiveness (i.e., the mark is initially considered generic).

At this stage, the process would return to the first administrative instance for a specific technical opinion and analysis of secondary meaning's evidence and arguments, making it possible to appeal after another BTO decision. The BTO's Director argued that this procedure is already adopted in other countries and avoids "accidental tourism" of company owners of generic trademarks which are not vastly recognized by their target audience.

For the time being, the BTO does not consider allowing the filing of secondary meaning evidence in advance, or even its occurrence together with the filing of the application, although it is on the BTO's radar to enable this in the future.

The agency is studying the increase of the official fees for the filing of trademarks with a secondary meaning request. It is possible that this surcharge comes to serve as a disincentive to less viable and less significant trademark applications, helping the BTO's Examiners to better organize the decision system in parallel to potential new backlog issues.

The BTO's Director claimed that the introduction of the secondary meaning as a basis for an appeal might not really be ideal, but it would be the most viable way at this time for a smoother adaptation of the BTO and its examiners to the institute.

Another important challenge would be the incorporation of technological advances to the BTO's database and analysis process regarding the distinctiveness through continued use of the trademark.

Concerning the use of digital platforms and their contents as proof of secondary meaning, in particular social media, specialists agree that the acceptance is imperative. Certainly, the speed in their marketing fluidity, evidence of digital purchases and recognition should deserve greater consideration, which might be challenging in the near future. The trademark's intangible asset is a valid concern for any company, so evidence given in a digital environment must be legitimized.

Responding to questions from the public at

“ Concerning the use of digital platforms and their contents as proof of secondary meaning, in particular social media, specialists agree that the acceptance is imperative. ”

the event, the BTO's Director identified that among possible concerns would be the need for compatibility between the right of precedence and the Secondary Meaning. Since the secondary meaning institute only applies to marks formed by common/generic expressions, potential problems might arise if such wording is in use by two, or more, companies at once and if these companies seek the secondary meaning recognition. The BTO should then analyze not only which company has prior rights over the mark, but also which of the companies were actually able to successfully induce the secondary meaning to its sign.

The possibility of the right of precedence colliding with the recognition through use and investments in the market should and will deserve a concrete factual analysis. What will prevail will depend on the specific case and the application of legal principles.

The validity of distinctiveness granted under the secondary meaning is an issue yet to be resolved. However, the BTO has set that, in order to renew the condition, trademark owners shall be required to present new and current evidence indicating that the mark is still impacted by the secondary meaning.

Brazilian specialists and interested companies are certainly all hopeful of a quick and effective adjustment from the BTO to secondary meaning possibility since they will have a valuable tool for securing registration. Further to that, it will raise the BTO to a new level in the highly competitive global market, where the notoriety of a previously generic signal, acquired through its continuous use, deserves to be granted protection as a registered trademark.

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Innocelf is proud to sponsor this segment as a women-led organization. The world of intellectual property is constantly evolving, and women are leading the way with different skills and perspectives. We need more women in leadership positions in the world of IP to support rising female entrepreneurship across the globe.

Women have much to offer the world of IP, from law practices to legal tech. Increasing diversity in IP will reflect diversity in innovation and inventorship. Innocelf will continue to support them in their efforts to make a difference.



If you would like the opportunity to share your experiences with *Women in IP Leadership*, would like to nominate an individual to be involved, or would like to learn more about sponsorship, please contact our Editor.

Virginia Wolk Marino: Partner, Crowell & Moring

An interview: inspirations, experiences, and ideas for equality.

Virginia is a partner in Crowell & Moring's Technology & Brand Protection Group in Chicago. She focuses her practice on all aspects of domestic and global brand protection, copyright, and unfair competition law. Virginia's extensive trademark prosecution, counseling and litigation practice includes the acquisition, maintenance, licensing, enforcement, and transfer of intellectual property. Her clients operate in a wide variety of industries, including biopharmaceutical, consumer goods, food and beverage, hospitality and travel, technology and luxury goods.

What inspired your career?

My career was inspired by an internship I completed during college, when I had an opportunity to work at the Australian Embassy in Washington D.C. While there, I worked at the Embassy's museum. This work touched on various aspects of museum law, as well as various national and international laws relating to artwork. The artwork being displayed at the museum was shipped on a regular basis from Australia, so I was exposed to issues related to artist attribution and provenance, particularly as it related to Aboriginal artists, and matters of that nature. My interest in IP law piqued there.

How have you found the pathway to your current position? And can you offer advice from your experience?

Despite being intrigued by IP law at the outset, I did take somewhat of a circuitous route through law school. I interned with the U.S. Department of Justice and I took a summer position working in-house for a large investment bank, so I did try on a couple of different hats on my way toward intellectual property law. That said, I was taking trademark and copyright classes because of my continuing interest in soft IP law. I knew that getting a job dedicated to soft IP would be difficult, as it is more of a niche field. Eventually, I found my way to an intellectual property boutique in Chicago where I was really fortunate to be offered a job in exactly the field I wanted to be in, focusing on trademarks and copyrights and other soft IP issues.

I would certainly advise people to try on various hats and really feel their way out when they're choosing which area of law they want to focus on. It's worth experimenting while you have the time and the bandwidth. This is particularly the case for law students, and lawyers, who don't have a technical degree, of which I am one, as it's important to realize that there are many pathways to practice intellectual property law. Those pathways exist outside of the soft IP realm. For example, you can still be a patent litigator even if you don't have a particular technical degree and aren't qualified to sit for the patent bar.



“
There are so many things that we can be doing as individual attorneys to both improve retention and decrease attrition of women and diverse lawyers.”

Otherwise, I would advise that the people whom you surround yourself with matter. If you are in a position to have a choice in who your colleagues are, including mentors and sponsors, choose wisely. Not only will these people have a significant impact on your career, but consider how much time you will be spending with them over the course of your day-to-day working life. There are absolutely benefits to spending that time with folks you actually want to be around, on a personal level. Prioritize your mental and emotional well-being, in addition to your professional pathway.

What challenges have you faced? And how have you overcome them?

One personal challenge that I face - and I wouldn't trade this challenge for anything - is having three children, all of whom are quite young. So, certainly, balancing my home and career obligations was, and continues to be, a challenge. I'm hesitant to say that I've overcome that challenge because it's something I wrestle with on a daily basis, but I do think that I've found ways to manage that challenge. This includes relying on the support of my fantastic colleagues. I also work with wonderful clients who are likewise supportive, many of whom also have significant obligations outside of their jobs. I think working with supportive folks makes all the difference in the world.

I want to clarify that this is a caregiver role challenge, not a challenge that's unique to women or parents. There are many caregiving and personal obligations that people have outside of the office, and I think law has changed over the past 10-15 years, since I've been practicing, and has become more flexible. This flexibility promotes diversity by encouraging openness in terms of the way people talk about the various challenges that they are having at home. I've found that people can be very creative in addressing these challenges - this creativity should continue to be encouraged.

What would you consider to be your greatest achievement in your career so far?

Making partner has been my greatest professional achievement thus far, particularly in light of the fact that I am a working mum and I have significant obligations outside of the office. Being able to hit that milestone really meant a lot to me personally because it was something that I had worked very hard to achieve for a very long time. But it wasn't something I was able to accomplish in a vacuum, there were a lot of people who helped me along the way. I've always been fortunate in my career to have strong mentors, sponsors, and peers who have helped to boost me up.

What are your future career aspirations? And how will you work to achieve them?

I really love the type of work that I do; I'm passionate about working with trademarks and copyrights. I want to continue my work, particularly with solving complex and novel issues, as I find that to be very rewarding. One of the fun things about working with intellectual property is that you're working with people's ideas - somebody's sweat equity - it's their baby and they're trusting you to protect it, to enforce their rights, and really provide them with their pathway to move forward. It's incredibly rewarding work.

Another thing I want to continue doing is focusing on my own mentorship and sponsorship of junior attorneys, agents, and staff at the firm. Again, I've been so fortunate to have sponsors and mentors in my life who really care about me and my career, and it's very important to me to pass that forward. Even as a junior associate I realized that there were senior folks out there who were really looking out for me, on both a personal and professional level. I tried to start doing that early on in my career, really paying attention to new attorneys coming into the office and laterally in my professional network, even with new attorneys who were joining my clients in-house. I think about how can I help them achieve their career goals separate and apart from any particular matters that we might be working on together. I definitely want to continue to devote time to those initiatives and relationships moving forward.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

Certainly, representation needs to improve - period. I think there's a lot of conversation about that issue, particularly in our field. The bottom line is, we as an industry need to do better. The number of diverse IP attorneys and practitioners - whether by racial or ethnic identity, gender, sexual orientation, ability, or otherwise - in this industry simply needs to improve, significantly. A lot of it comes down to accountability - of individuals, leaders, and clients. The industry is certainly moving in the right direction at a macro level, but I think real, meaningful change will come down to individuals taking accountability as well. There are so many things that we can be doing as individual attorneys to both improve retention and decrease attrition of women and diverse lawyers. We need to think about what we are doing as individuals to attract diverse talent and, equally as important, what we can do to welcome our new colleagues and promote them (at our firms, at our client organizations, or even through our professional organizations). I think that's a really important part of the

conversation, what are we doing in leadership roles or in our own capacities to help those lawyers' careers move along in a positive direction? Recruitment efforts don't mean much if you hire women and diverse attorneys as first-year associates or laterally, but a lack of mentorship, sponsorship, and advancement drive them to leave two or three years later. That's a pretty strong signal that something is awry.

When paying attention to the recruitment and retention of women and diverse talent, particularly in the IP industry because of the need for a technical degree to be able to sit for the patent bar, I think attention has to be paid at an undergraduate level because that's where the pipeline begins. Realizing that our attention as a community needs to be shifting even earlier, to be looking at what's going on at an undergrad level, will be crucial for diversifying the industry.

That said, education and outreach at the law school level is obviously necessary, as there are many pathways to practicing in the IP industry that don't involve a technical degree, and that may not be apparent to law students. There are various ways to integrate women and diverse talent on intellectual property service teams irrespective of whether there's a technical degree involved. That's where outreach and creative thinking need to come into play so that we can showcase these alternative pathways in our industry.

How do you think the empowerment of women can be continued and expanded in the IP sector?

Again, I think it comes down to accountability, and I think that accountability comes from different places. What's been really interesting over the past couple of years is seeing clients holding law firms accountable as to the number of women and diverse lawyers that are put on client teams. And not only that the numbers reflect a certain percentage of the team, but clients are demanding to interface with those women and diverse lawyers as integral members of the team. I think the push for equity has been accelerated by the folks who are buying legal services by making these demands known to law firms in a very vocal way, and law firms have had to step up to the plate and respond accordingly. It is crucial that clients continue to hold us accountable by not only communicating their commitment and standards for more diverse teams, but also closely scrutinizing our diversity data and following up with us to ensure we are providing substantive opportunities to our women and diverse team members. We all know at this point that research shows diverse teams perform better overall, so having a diverse client service team is a goal that both law firms, as well as the

clients that they're serving, will benefit from.

I think that law firms are doing a better job now in terms of the promotion and retention of women talent, and again it comes down to accountability. Having specific metrics in place that are transparent and measured, such as how many women attorneys are being promoted, how many are being considered for leadership positions, how many are being retained, etc., and then having easy and transparent access to those metrics is important because law firms need to hold themselves accountable. It is also imperative that law firms consider intersectionality in their discussions about women talent - only by understanding the experiences of women of all backgrounds can we begin to make real progress toward empowering women in IP and the legal industry more broadly. I think law firms that set goals based on these metrics, and hold their leadership accountable to those metrics, should see more success. For example, through my firm's Crowell Rule, a supplement to our Mansfield Rule participation on the recruitment side, my firm has various requirements in terms of how diverse and female talent is interviewed for lateral associate, counsel, and partner positions, where the interview pool must be at least 50% composed of women and diverse attorneys. Likewise, through our Diversity Pledge, Crowell has committed to adding 150 women and diverse lawyers to the firm within five years, by 2026. In the spirit of transparency, my firm's leadership have also reported internally on the progress of both aforementioned initiatives periodically. Making and enforcing these types of transparent metrics inspires accountability from all corners of our firm community.

Another way that firms can continue to increase retention and promotion of women attorneys is by making sure that when women and diverse attorneys are added to client teams, they're being credited accordingly. Being credited for contributions acknowledges the value of their talent and insights. And being valued, in a way that can be objectively measured, is a crucial retention tool.

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We all know at this point that research shows diverse teams perform better overall, so having a diverse client service team is a goal that both law firms, as well as the clients that they're serving, will benefit from.”



Prudence Jahja: Managing Partner, Januar Jahja and Partners

An interview: inspirations, experiences, and ideas for equality.

Currently Managing Partner of the boutique IP firm Januar Jahja and Partners based in Jakarta, Indonesia, Mrs. Prudence Jahja is widely recognized as one of the leading IP lawyers in Indonesia. As both a Registered IP Consultant and licensed attorney, her practice focuses both on trademark prosecution and IP litigation, as well as enforcement matters, including infringement matters and website takedowns. She also has experience advising on and prosecuting patent, industrial design, and copyright matters as well. Mrs. Jahja's work has been recognized by various outlets such as the Legal 500, WTR 1000, Managing IP/ IP Stars, and Chambers Asia Pacific. She has been named one of the Top 250 Women in IP and one of Indonesia's Top 100 Lawyers.

What inspired your career?

Law and IP were not strange things to me when I was growing up. My late father was an IP lawyer (he began practicing IP law in 1974) and was the founding partner of the firm. My mother actually decided to pursue a law degree and become an IP Consultant to help my father with his career and his firm. My brother also went to law school, though he then realized that it was not really for him and instead chose a career in IT. Despite this background, my parents never forced me to go to law school; however, my father and I had a lot of discussions about IP since I was young and he also encouraged me to learn English as well. Perhaps that was what led to my decision to go to law school and specialize in IP. Although some people may think that I'm "privileged" to continue my father's business, it has not always been an easy journey.

How have you found the pathway to your current position? And can you offer advice from your experience?

Even though my late father was the founding partner of the firm, to be where I am right now

did not come instantly; I only made partner after 10 years, which I think is normal in this industry. During that time, I had to work hard to demonstrate to him that I could positively contribute to the firm, bring in clients, and also make the firm better than it used to be. When he got sick and then later passed away, I felt like I already had a lot of experience and exposure on how to manage the firm because he brought me along very deliberately. I like to think that he would be very proud of how the firm is doing now.

To tell a bit about my career journey, I started with my father's firm after I graduated from law school and essentially became a paralegal for a few years. Two years later, I moved to Munich, Germany for a Master's Program in IP based at the Max Planck Institute. It was an excellent program, and we had the chance to learn about different legal systems, such as the EU and US legal systems as well as Japanese patent litigation, for example. I got to spend four weeks interning at a German IP Firm, which was a great experience and I even still work with them to this day. As soon as I graduated from Munich, I moved to New York and Washington DC to do an internship at an IP firm in Manhattan, New York and then at the Court of Appeal for the Federal Circuit in Washington D.C. I met my husband in New York (who is also a lawyer) and we decided to move back to Indonesia in 2012 and have been actively involved at the firm ever since.

These educational and professional opportunities really opened me up to a lot of new learning experiences and helped me make connections with a wide variety of IP professionals that have been very useful to my career. If I could offer some advice based on my experience, it would be to be brave and try to take on new challenges. Doing new and challenging things is not easy for me, but it helped me grow from these experiences and allowed me to start to develop my own personal network.

“My advice is to follow your instinct and pursue those dreams, focus on what you enjoy doing and things will happen.”

What challenges have you faced? And how have you overcome them?

After spending three years living abroad in Europe and the United States, I came back to Indonesia with the hope that I could help my father with his firm. Of course, there are both advantages and disadvantages to this approach. But even though the firm had already been established for 26 years at that time, I could still see a lot of room for improvement. My father was a great lawyer, but he only wanted to do the legal work. He did not like networking, business development, public speaking, etc. For me, that created a great opportunity so in the early years, I spent a lot of time traveling to conferences all over the world to try to further develop the firm's network and to learn more about the IP field. From this, I learned that it is important to talk to anyone and everyone because you really never know who might need your assistance, especially in a country like Indonesia which may not be at the top of everyone's list of most important IP jurisdictions.

When not traveling, I found that managing people could be very challenging, and sometimes frustrating as well. As our firm grows, we want to make sure that we only hire competent people who have the same vision and mission. While Indonesia has a large population, there are still deficits in education and IP can be a very specific field, so finding the right people has taken time. To help with this challenge, I relied on the people I trust the most – my

“Having people I really trust in important positions within the firm has allowed me to, in turn, focus on the legal work.”



husband, who also works at the firm, and my best friend from middle school, who switched careers to IP and is now our Head of Operations. Having people I really trust in important positions within the firm has allowed me to, in turn, focus on the legal work side of things, which helps keep the firm moving along and growing.

Another challenge that is faced daily is my jurisdiction, Indonesia. It's a large, spread-out country with a lot of diversity and beauty. But legal enforcement here can be difficult and unpredictable. Regulations can be vague, conflicting, or sometimes non-existent. As an IP Lawyer, we must explain to the client how the situation is in reality so they understand that what works in another country might not work in Indonesia. Despite those challenges, we can see that our governmental institutions are trying to improve themselves, which is reason for optimism.

What would you consider to be your greatest achievement in your career so far?

Honestly, this is a difficult question, but if I have to answer there are two things that stand out: 1) We won an important trademark cancellation case for a client against an Indonesian trademark squatter in a highly publicized case that went up to the Indonesian Supreme Court; and 2) Being able to move to a bigger and nicer office space in 2019. This has created a far more comfortable working environment for all of us and allowed us to add more employees as needed, instead of worrying about where we were going to fit them. One other, more recent thing that I'm proud of is that during the pandemic, we worked hard to take care of our employees, both emotionally and physically, and then later gave them the flexibility to adjust to the new working conditions that have arisen. I am thankful that we never had to lay anyone off and in fact, have added 15 new employees since the start of the pandemic.

What are your future career aspirations? And how will you work to achieve them?

I want to be considered one of the best IP lawyers in Indonesia. But at the same time, I would like to keep the firm size manageable so we can keep our focus on meeting our clients' Intellectual Property needs in Indonesia by providing them with the best service possible. To achieve that? I think hard work is the key, but it is also important to surround yourself with hard-working and honest people.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years?

I think that women are already starting to drive equality and diversity forward in the IP industry.

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“ I hope that by providing [women] with a safe yet challenging work environment, it will encourage them to do the same in the future when they become leaders of their own. ”

We realize that we really need to support each other both personally through friendships and also professionally through sharing work, referrals, etc. I have been lucky enough to have joined a few of these female-focused groups that have already formed and are active within some of the larger IP organizations and associations. This could be a model for other groups as well to band together to support and promote each other because, while there are barriers, the IP community overall seems like a supporting and caring place.

How do you think the empowerment of women can be continued and expanded in the IP sector?

It may be surprising but in the IP field as well as in the legal field more generally in Indonesia, it is common to see women as partners, managing partners, and in other positions of power. Of course, there are still issues to overcome but the infamous "glass ceiling" that certainly exists in other countries seems to either be much higher or perhaps gone altogether in Indonesia. As a female-led IP firm, we have focused on hiring (and retaining) smart, honest and professional women across all levels of our firm. As a result of those efforts, I can say that over 80% of our firm is female. I hope that by providing them with a safe yet challenging work environment, it will encourage them to do the same in the future when they become leaders of their own.




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Jurisdictional Briefing, Poland: merely providing proof of reputation is not sufficient

Dr Anna Sokołowska-Ławniczak and Kaja Seń of Traple Konarski Podrecki and Partners provide key guidance for protecting trademarks with a preexisting reputation.

The Supreme Administrative Court in Warsaw has confirmed in a judgment that in a court case there is a requirement to prove that a trademark is a trademark with reputation – the judgment comes in a case concerning a claim for invalidation of a trademark. The court also said that to rely on the protection of trademarks with reputation, one of the types of infringement of reputation has to be demonstrated, which means proving that **registration of the disputed trademark would give the proprietor unfair advantage or be detrimental to the distinctive character or repute of the trademark.**

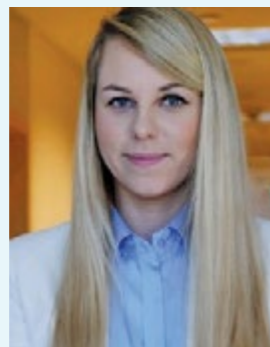
The judgment was issued in a case concerning the pharmaceutical market, and specifically popular OTC painkillers in class five of the Nice Classification. The claim concerned the trademark Ibovit C, and claim for invalidation was filed with the Polish Patent Office, citing grounds which included the earlier trademarks IBUM and JUVIT.

The applicant argued that the disputed trademark was similar to earlier trademarks, and that the goods bearing the trademarks being compared were also similar or even identical. He also claimed that the earlier trademarks were renowned trademarks.

The Polish Patent Office compared in a global manner the trademark "IBUVIT C" and the earlier "IBUM" and "JUVIT" trademarks, and found that there was a common element between the



Dr Anna Sokołowska-Ławniczak



Kaja Seń

trademarks "IBUVIT C" and "IBUM", which was "IBU-", while even though the trademarks "IBUVIT C" and "JUVIT" shared the element "-VIT", **the trademarks being compared also contained different elements, which overall rendered the compared trademarks sufficiently distinctive.** The Office also found that the applicant had submitted evidence confirming reputation, but **had not proven that registration of the disputed trademark would give the proprietor unfair advantage or be detrimental to the distinctive character or repute of the IBUM trademarks.** In the view of the Polish Patent Office, these types of infringement had not been proven, for example by demonstrating the unfair advantage gained by the proprietor, or a decline in sales of the applicant's goods as a result of presence on the market of goods bearing the disputed trademark.

The applicant only stated that *'proprietor must have encountered goods bearing the IBUM marks with reputation before applying for the disputed trademark'*. As it follows, the applicant had evaluated the level of awareness of the proprietor, and not facts relating to the position of the applicant's goods on the market. The Polish Patent Office also concluded that the applicant had not demonstrated that the proprietor had acted in bad faith when applying for the disputed trademark. **As a result, the Office found the claim for invalidation of the disputed trademark to be**

unfounded. Both the Voivodship Administrative Court, which reviewed an appeal lodged against the Polish Patent Office's decision, and the Supreme Administrative Court as the highest instance, concurred with the Polish Patent Office.

The Supreme Administrative Court emphasized that the proprietor of the earlier trademark with reputation was required to present substantiation of a future, non-hypothetical, likelihood of unfair advantage or detriment. According to CJEU case law: *'the proprietor of the earlier trademark must adduce proof that the use of the later mark 'would take unfair advantage of, or be detrimental to, the distinctive character or the repute of the earlier trademark'*¹.

Thus, the proprietor is required to demonstrate that use of the later trademark **does indeed have an adverse effect on the earlier mark with reputation, or that there is a likelihood that this will occur in the future.**

Consequently, **it is also not sufficient to merely suspect that the use of the later trademark might result in the taking of unfair advantage of the distinctive character or the repute of the earlier trademark**². Moreover, in Intel Corporation Inc. C-252/07, the CJEU pointed out that *'proof that the use of the later trademark is or would be detrimental to the distinctive character of the earlier trademark requires evidence of a change in the economic behaviour of the average consumer of the goods or services for which the earlier trademark was registered consequent on the use of the later trademark, or a serious likelihood that such a change will occur in the future'*³.

In conclusion, the owner of an earlier reputed trademark should demonstrate one of the three forms of interference with the right of protection of a reputed trademark, i.e., the likelihood of unfair advantage, damage to the distinctive character or reputation of the earlier trademark, as it is the owner who bears the burden of proof under the provisions of the Polish Act.

The ruling is further confirmation of the extent of the burden of proof that rests with a proprietor that relies on provisions on protection of trademarks with reputation. Merely providing proof of reputation is not sufficient.

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Résumés

Dr Anna Sokołowska-Ławniczak, Partner

Anna advises on every aspect of industrial property rights, from developing strategies through protecting individual items of industrial property to maintaining and enforcing industrial property rights under Polish, European and international procedures.

Anna has extensive experience in litigation before the Polish Patent Office and the EU Intellectual Property Office, as well as in court disputes concerning industrial property, combating unfair competition, and copyright law. She manages complex projects aimed at obtaining and maintaining industrial property rights.

Kaja Seń, Trainee Attorney-at-Law

Kaja's practice focus is copyright and industrial property law, and specifically trademark disputes. Kaja also has extensive experience in defending personality rights, influencer marketing, and combating unfair competition.

She developed her professional experience at law firms in Lublin and Warsaw, providing corporate housekeeping for clients in the FMCG, cosmetics, automotive, apparel, and other sectors. Kaja has worked on cases before the European Union Intellectual Property Office (EUIPO), the Polish Patent Office, common courts, and the World Intellectual Property Organization (WIPO) on international trademark registration cases.



¹ Judgment of the Court (First Chamber) of 27 November 2008.

² Intel Corporation Inc. v CPM United Kingdom Ltd, EU:C:2008:655, point 37.

³ R. Skubisz, System Prawa Prywatnego. Prawo własności przemysłowej, volume 14B, Warsaw 2017, p. 810.

⁴ Judgment of the Court (First Chamber) of 27 November 2008.

⁵ Intel Corporation Inc. v CPM United Kingdom Ltd, EU:C:2008:655, point 81.

Jurisdictional Briefing, Spain: trademark and copyright protection

Federico Jover García of H&A explains the difference in protection between industrial and intellectual property rights.

In Spanish legislation, as in many other countries around us, it is well known that the legislator has historically differentiated between Industrial and Intellectual Property rights.

In order to correctly identify the first group, we must refer to the main body of law on this subject at international level, namely the **Paris Convention**. This Convention establishes that its scope of protection extends, among others, to patents, trademarks, and trade names.

With regard to the second group of rights, Spanish legislation finds its fundamental basis in the **Berne Convention**, which extends its protection to all productions in the literary, artistic and scientific fields, whatever their form of expression. In addition, it also provides for the protection of the so-called neighboring rights.

Although each of these blocks protects rights that have well-defined objects, it can sometimes happen that the same sign can be the object of



Federico Jover García

trademark protection and, in addition, of Intellectual Property (meaning, copyright).

First of all, it should be noted that neither the European Trademark Directive nor the Spanish Trademark Law in force makes any mention of the cumulability of protection between trademarks and copyrights. Therefore, we must turn to Intellectual Property Law to find the first references to the aforementioned cumulation of protection.

Thus, the Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the Harmonization of Certain Aspects of Copyright and Related Rights in the information society, establishes in its Article 9 the following:

"This Directive shall be without prejudice to provisions concerning in particular patent rights, trademarks, design rights, ..."

Furthermore, the current Spanish legislation on intellectual property (Royal Legislative Decree 1/1996 of 12 April 1996, approving the revised text of the Law on intellectual property) clearly establishes in Article 3 the accumulation of the aforementioned rights:

"Copyright is independent, compatible and may be accumulated with:

2. The industrial property rights that may exist over the work."

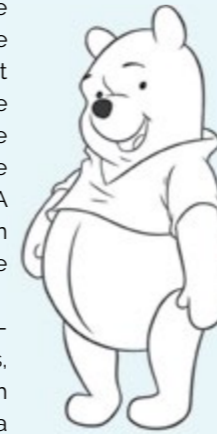
Once the possibility of accumulating both rights has been defined, the question arises: on what occasions can this double protection occur?

Firstly, we would have word signs. The main requirement for a word mark to be eligible for copyright is that it must be sufficiently distinctive for consumers to be able to identify it as a

trademark and to be able to relate it to a specific company, which is the main purpose of the trademark. And, in addition, the word or set of words in question must also be sufficiently original, which is the main requirement of Copyright. This is neither easy nor the most common scenario, but it may be the case.

In second place, we would have figurative marks. There is no doubt that a drawing can be configured as a figurative mark and at the same time be copyrighted. A common example is an animated character like Winnie the Pooh.

There are also non-conventional trademarks, such as sounds, which consist exclusively of a sound or combination of sounds, or multimedia signs, which consist of a combination of picture and sound. In both cases,



There is no doubt that a drawing can be configured as a figurative mark and at the same time be copyrighted.



both signs could also be considered copyrightable musical or audiovisual works, provided they are sufficiently original.

In many cases, it is advisable to opt for this dual form of protection, in order to give greater security to our signs and creations. A clear example would also be the title of a Copyright work (film, book, etc.), which in Spain is protected as part of the work, but which are also registered as trademarks to prevent them from falling into a lack of originality.

In short, we can affirm that Spanish law contemplates the accumulation between trademark rights and intellectual property, being the main requirements for this that the sign or work in question must be sufficiently distinctive and original.

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Résumé

Federico Jover García is responsible for the Intellectual Property and Audiovisual Law Area of H&A Abogados.

Throughout his years of experience, he has had the opportunity to advise large companies in the energy and technology sectors, both nationally and internationally. Likewise, his regular clients include small and medium-sized companies (SMEs) in the entertainment industry, as well as individuals and/or artists to whom he provides the personalized attention that each case requires.

Due to his broad academic and professional background, Federico also actively collaborates with the other practice areas of H&A Abogados, advising on trademarks, patents, industrial designs and new technologies.



New frontiers in open source enforcement and compliance

George Zalepa, Of Counsel at Greenberg Traurig LLP, explains the difficulties surrounding open source licensing and copyright infringement highlighted by the *Software Freedom Conservancy vs. Vizio* case.

Since its creation, the GNU Public License ("GPL") has arguably been a vexing open source license for lawyers and engineers alike. In addition to what some consider ambiguities in the license terms, many aspects of enforcement of the GPL are untested and thus subject to commentary and conflicting interpretations within the open source community.

In brief, software developers can incorporate software licensed under the GPL into their software provided that, in most circumstances, they also license the resulting combination under the GPL. The effect of this so-called copyleft restriction is frequently referred to as the "virality" of the GPL. That is, proprietary code that is "infected" with GPL-licensed code must then be open sourced to comply with the terms of the GPL license.

Historically, GPL violations were enforced by the copyright holder of the GPL-licensed code. In general, such cases would be asserted as copyright infringement claims since a breach of



George Zalepa

the GPL (e.g., not providing access to corresponding source code) would terminate the copyright license granted to the licensee. Thus, the licensee would be copying copyrighted material without such a license.

While litigation risks due to GPL non-compliance exist, this specific means of enforcement can often blunt risk analyses of such non-compliance. Much GPL-licensed code is developed and maintained by independent developers, not larger organizations. As such, the practical likelihood of litigation is small, and when compared to the costs of replacing GPL code, these risks may be improperly ignored due to the unlikelihood of detection and enforcement. Further, the ultimate remedy for infringing the copyright of GPL-licensed code is primarily monetary. While damages (including treble damages) are a deterrent, they frequently can be abstracted as a cost of doing business and not as visceral as being forced to release proprietary source code, which, in some circumstances, represents the entire market value of an organization.

Thus, the historical development of GPL enforcement has given rise to two assumptions that many organizations use to assess the risk of GPL code in the absence of a formal legal review. First, many copyright holders lack the necessary resources to enforce the GPL, and second, the ultimate remedy is purely monetary and there is no mechanism to "force" open sourcing of their code.

In *Software Freedom Conservancy vs. Vizio*, the Software Freedom Conservancy ("SFC") is challenging both of these assumptions, which, if successful, may have wide-ranging impacts for developers of software that distribute products that include open source code.

In October 2021, the SFC filed suit in the Superior Court of California (Orange County), alleging that Vizio had breached the terms of the GPL. Specifically, the SFC alleged that Vizio's smart televisions included various common GPL-licensed software packages without providing the corresponding source code.

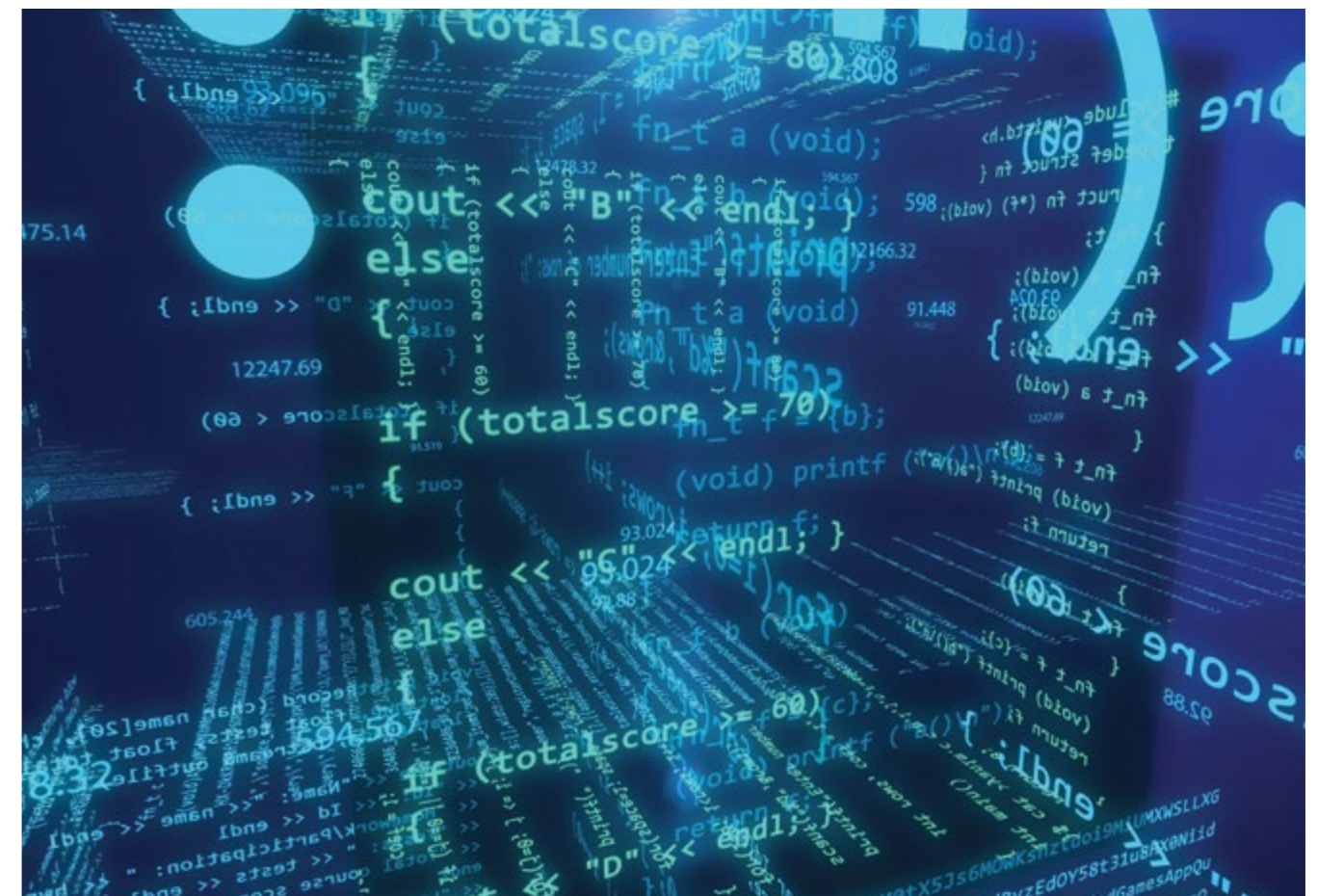
Notably, the SFC did not develop any of the GPL-licensed packages identified in the complaint and, as such, has no standing to bring a copyright infringement action against Vizio. The SFC's basis for standing, unlike previous GPL cases, is based on the theory that the GPL represents a valid contract between the copyright holder and Vizio, and the SFC is a third-party beneficiary of that contract due to its purchase of smart televisions from Vizio. As stated in the complaint, the SFC purchased various Vizio smart televisions from a major retailer, examined the televisions, and determined Vizio was using the identified GPL-licensed libraries. The SFC further alleges that Vizio did not provide the corresponding source code in a manner compliant with the GPL. The SFC acknowledged it was not a party to the GPL as applied between Vizio and the copyright holders but contends it falls within the class of persons for whose benefit the GPL was created. Under this interpretation, the SFC contends it is

“**Thus, the licensee would be copying copyrighted material without such a license.**”

a valid third-party beneficiary with standing to bring an action against Vizio for breaching the terms of the GPL.

In addition to this theory, *SFC v. Vizio* is notable for the remedy requested. Unlike most previous GPL cases, the SFC's cause of action is for breach of contract and seeks specific performance. Thus, the SFC's prayer for relief explicitly requests the release of all corresponding source code from Vizio to the SFC.

Shortly after the SFC's complaint, Vizio moved to remove the case to Federal court. Vizio's basis for removal is that copyright law completely preempts the SFC's breach of contract and declaratory judgment claims. In response, the SFC argued that the obligation to produce source code does not fall within the enumerated rights of § 106 of the Copyright Act. As such, there is no "preemption" of a right that does not arise under the Act. In its decision to remand the case to state court, the district court stated that the SFC's claims arose from an "additional contractual promise separate and distinct from any rights provided by the copyright laws." Thus, the court remanded the case to state court and agreed with the SFC's argument that the right to receive source code does not fall under the enumerated rights of copyright and thus is an "extra element" to the SFC's claims.



Résumé

George David Zalepa is of counsel at law firm Greenberg Traurig, LLP, focusing his practice on intellectual property and technology matters. He regularly advises clients on software licensing and IP and open source due diligence in connection with mergers and acquisitions. In addition to his legal experience, George is an experienced software developer, specifically with web applications.



As of December 2022, the state court dispute between the SFC and Vizio is pending, but the denial of removal by the district court is a significant development in the interpretation and enforcement of GPL violations. Further, should the SFC prevail in its causes of action, the risk calculus for GPL code consumers will change significantly.

As an initial procedural development, the remand to state court represented a repudiation of the general rule of thumb that GPL violations are purely copyright claims. As discussed above, this rule of thumb enabled a simple calculation of risk when using GPL software: only copyright holders could bring suit and only monetary damages were at risk. Such a general rule reduces the universe of threats for non-compliance. The denial of removal and remand to state court places this rule in flux. That is, breach of contract claims for GPL violations now appear to be established "fair game."

However, the SFC still must prevail on its theory by showing that it is a third-party beneficiary and that specific performance is a reasonable remedy for violations of the GPL.

With respect to the first showing, the SFC must prove that the motivating purpose of Vizio using the GPL-licensed code (and thus contracting with the copyright holder) was for the SFC (as a purchaser) to benefit from the use of the GPL. While this is an open question, it seems to skew in favor of the SFC.

The GPL is replete with references to the "all users" of source code, stating, for example, in its preamble that the purpose of the GPL is to "make sure [a GPL-licensed program] remains free software for all its users." Thus, when looking at the terms of the agreement itself, it is fairly clear that downstream consumers of code that includes GPL-licensed software are the intended beneficiaries of the GPL, including the SFC.

A more open question is perhaps the second showing: that specific performance is an appropriate remedy in resolving GPL disputes. In general, courts disfavor the use of specific performance as a remedy except in narrow instances, primarily, the sale of real property. However, the SFC's status as a third-party beneficiary may tip the scales in favor of awarding an equitable remedy. In a traditional suit, the plaintiff and copyright holder would be one in the same. That is, a copyright holder is accusing its licensee of violating the terms of the GPL agreement. In such scenarios, a court may reasonably determine that monetary damages may be adequate to compensate the copyright holder.

However, what is less clear is whether any monetary damages would compensate a third-party beneficiary as plaintiff. Such a plaintiff

“**The SFC argued that the obligation to produce source code does not fall within the enumerated rights of § 106 of the Copyright Act.**”

does not suffer damages from the use of its own code (as it likely has none). Such a plaintiff may also likely still be able to obtain the GPL-licensed code from other sources (notably the copyright holder). Such a plaintiff also does not suffer monetary losses after purchasing a product that includes code violating the GPL. What such a plaintiff does suffer is the lack of freedom that the GPL guarantees. Such a violation appears difficult to quantify in dollars and cents. As such, specific performance in the narrow context of GPL violations could turn out to be a suitable remedy specific for third-party beneficiaries. Time will tell.

If the SFC is successful in both of the foregoing showings, future users of GPL software will have to consider the effect on potential litigation threats. It should be noted that the only true way to comply with the GPL is to honor the terms of the GPL, and all users of GPL code should endeavor to do so. However, in many practical scenarios, the identity of GPL code may not be known or other considerations may cause software developers to roughly evaluate the known or unknown risks of non-compliance with the potential damages.

Under current compliance perspectives, a user of one GPL-licensed software package may face one lawsuit from one party for, primarily, one cause of action (i.e., copyright infringement) asserting monetary damages. Such a risk is easier to quantify, especially when the identity of GPL-licensed code is known.

If the SFC is successful, this same user would instead consider a potentially infinite number of plaintiffs. That is, any user of their proprietary software may have standing to litigate the unauthorized use of GPL-licensed code. Such a change necessarily means the risk of litigation expands dramatically. An organization considering potential GPL violations (either known or unknown) may now have to take a wider range of potential plaintiffs into consideration. Further, if the SFC prevails, the current risk of "forced open sourcing," which has historically not been the legal remedy for GPL violations, may become very real.

Further, the landscape of GPL enforcement may significantly change if the SFC is successful. If, after *SFC v. Vizio*, any purchaser or consumer of software has standing to assert a breach of contract claim against a software distributor, such an environment may give rise to "GPL trolls" similar to non-practicing entities suing for patent infringement being labeled "patent trolls". That is, any party may file a complaint (or threaten such a complaint) alleging breach of contract in an attempt to force a quick settlement. Indeed, the SFC's complaint itself can easily be viewed by some as similar to the

actions of non-practicing patent assertion entities: it obtained products, analyzed them to identify intellectual property violations, negotiated with Vizio to reach an agreement prior to litigation, and, failing that, ultimately filed suit. A more unscrupulous entity may use the SFC's negotiation step to try to force a monetary settlement rather than compliance given the expense of litigating, identical to the cost-of-litigation playbook of many non-practicing entities. Specifically, the potential costs of complying with the GPL (if even possible) may also drive entities to prefer low-value settlements over litigation. On the other hand, a settlement with one third-party beneficiary does not necessarily foreclose other such third-party beneficiaries from repeating such enforcement (either individually, or as a potential class action) if the GPL violations are not cured.

Given that most projects include numerous packages, including GPL packages, the result of *SFC v. Vizio* may represent a significant change in risk analysis when considering GPL code. While the ideal solution is complete compliance, the ambiguities in the open source world often result in risk analysis based on incomplete information. The increased potential for litigation would necessarily result in closer attention paid

“**However, what is less clear is whether any monetary damages would compensate a third-party beneficiary as plaintiff.**”



to compliance to avoid a highly unknown arena of potential litigation.

For those concerned with open source compliance, close attention should be paid to the outcome of *SFC v. Vizio*. While the immediate outcome may increase risks of GPL non-compliance, the case may also generate new forms of litigation that should be considered when evaluating open source risk.

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How to deal with trademark infringement in China

Zhang Bin and Yang Yifan of CCPIT Patent and Trademark Law Office explain the four pathways available for tackling trademark infringement in China.

In recent years, China's social and economic level continues to develop and its economic fields continue to expand. In particular, there are more and more participants in various economic fields and the competition is becoming more and more fierce. In the process of enterprises participating in market competition, the role of the trademark is also increasing. The trademark has become an important intangible asset of the enterprise, which is the symbol of the enterprise and the expression form of the enterprise culture. Due to the role played by the trademark and the unlimited value it can show, the trademark owners pay more and more attention to the protection of the trademark. At the same time, as China is vigorously promoting scientific and technological innovation at the national level, the protection of trademark rights and other intellectual property rights can better reflect China's emphasis on scientific and technological innovation, which provides a good opportunity for trademark owners to fully protect their registered trademarks. For trademark owners, how to deal with trademark infringement? This article will be combined with China's relevant laws and regulations to make a brief interpretation.

As a kind of property right, trademark rights can be protected by several laws in China. But as a special legal norm in the field of trademarks, Trademark Law plays the most important role in trademark protection.

China Trademark Law was first enacted in 1982. After several revisions in 1993, 2001, 2013 and 2019, the current Trademark Law provides more comprehensive protection to trademark owners and shows stronger deterrence against trademark infringement. What situations in trademark infringement can be relieved by law?



Zhang Bin



Yang Yifan

According to Article 57 of Trademark Law, there are mainly six situations:

1. Using a trademark identical to a registered trademark on identical goods without being licensed by the trademark registrant;
2. Using a trademark similar to a registered trademark on identical goods or using a trademark identical with or similar to a registered trademark on similar goods, without being licensed by the trademark registrant, which may easily cause confusion;
3. Selling goods which infringe upon the right to exclusively use a registered trademark;
4. Forging or manufacturing without authorization the labels of a registered trademark of another party or selling the labels of a registered trademark forged or manufactured without authorization;
5. Replacing a registered trademark without the consent of the trademark registrant and putting the goods with a substituted trademark into the market;
6. Intentionally providing facilitation for infringement upon others' rights to exclusively use a registered trademark or aiding others in committing infringement upon the right to exclusively use a registered trademark.

Of course, if the above six circumstances do not correspond to the infringement encountered by trademark owners, it can also invoke the fallback provision in Article 57, namely "causing other damage to the exclusive right to use the registered trademark of others".



In order to make the claims of trademark infringement conform to the requirements of the law, so as to achieve the purpose of protection, it also involves the preliminary judgment of trademark infringement. The judgment of trademark infringement is generally considered from the following aspects:

1. Determining the scope of the exclusive right to use a registered trademark. The scope of the exclusive right of a registered trademark is the primary basis for identifying trademark infringement.

According to Article 56 of the Trademark Law, "the exclusive right to use a registered trademark and the goods approved for use." That is to say, the exclusive right to use a registered trademark is limited to the trademark approved for registration and the goods approved for use by the registered trademark. Infringement claims beyond the scope of the exclusive right to use a registered trademark cannot be supported by law.

2. There are specific objects accused of infringement, including the trademark accused of infringement and the goods used by the trademark accused of infringement. This point is equally important as the above-mentioned determination of the scope of the exclusive right to use a registered trademark.
3. The trademark accused of infringement shall be compared with the registered trademark to determine whether the trademark accused of infringement is

“When encountering trademark infringement cases, choosing an appropriate trademark attorney can also achieve twice the result with half the effort to deal with trademark infringement and reduce detours.”

Résumés

Zhang Bin is the deputy director of the legal department of CCPIT Patent and Trademark Law Office. He graduated from Wuhan University with an LLB in international law in 1989 and obtained his LLM in intellectual property law from the UNH School of Law in the US in 2003. Since joining the firm in 1989, he has successfully handled a great number of IP cases covering trademark, copyright, licensing, unfair competition, customs protection, trade name, cyber-squatting through litigation, administration or negotiation. He has published many articles in periodicals or newspapers. He is also a co-author of the textbook "Practice of IP Lawyers".

Yang Yifan is a trademark attorney at CCPIT Patent and Trademark Law Office in Beijing. He joined the firm after graduating from the University of International Business and Economics, where he obtained a Master of Laws degree. Yang is specialized in handling trademark infringement and unfair competition cases. His expertise also includes copyright infringement, domain name disputes, legal advice on IP licenses, and other IP-related contracts.



the same or similar to the registered trademark, and whether the goods used by the trademark accused of infringement belongs to the same category or is similar to the goods approved for use by the registered trademark.

If the answers to the above three points are positive, the trademark owner will have a great certainty to stop the trademark infringement in time.

The above several considerations may be a little cumbersome for the trademark owner, but for professional trademark attorneys, they are customary workflow. Therefore, when encountering trademark infringement cases, choosing an appropriate trademark attorney can also achieve twice the result with half the effort to deal with trademark infringement and reduce detours.

After the above analysis of the case, the next step is to choose the path to solve the trademark infringement, which is the main focus of this article. In accordance with Article 60 of the Trademark Law, where any dispute arises from any infringements upon the right to exclusively use a registered trademark, the parties concerned shall resolve the dispute through negotiation; and if they are reluctant to resolve the dispute through negotiation or the negotiation fails, the trademark registrant or an interested party may institute an action in a people's court or request the administrative department for industry and commerce to handle the dispute. This provision lists three ways to resolve trademark infringement disputes.

In addition, according to Article 67 of the Trademark Law, it also stipulated the criminal liability of trademark infringement, namely "where a party uses a trademark identical with the registered trademark on identical goods without being licensed by the trademark registrant, or where a party forges or manufactures without authorization the labels of a registered trademark of another party or sells the labels of a registered trademark forged or manufactured without authorization, or where a party knowingly sells goods on which a registered trademark is falsely used, if any crime is constituted, the party shall be subject to criminal liability according to the law." Therefore, we can regard this provision, that makes the trademark infringer subject to criminal prosecution, as another way to solve the trademark infringement.

Next, we will explain the four paths mentioned in the Trademark Law respectively:

1. Negotiation

Negotiating with the infringer, including face-to-face conversations and sending letters to the

“ However, the trademark owner can use this ignorance and continuation as a factual basis to argue bad faith on the infringer's part and claim punitive damages in subsequent civil litigations. ”

infringer, and asking the infringer to stop all acts of infringement and compensate for all losses incurred in the process of infringement is relatively simple and easy. The advantage of this method is that if negotiation or communication skills are used skillfully and pressure is applied properly, trademark infringement disputes can be resolved cheaply and efficiently. However, the results of this approach often depend on the cooperativeness of the infringer.

If the infringer is bona fide and trustworthy, negotiation could, to a certain extent, achieve the results of stopping the infringement or at least establish a channel for further communication and final dispute resolution.

If the infringer is, on the other hand, of malicious intent, and due to the lack of pressure from law enforcement agencies and the government, the reasonable claims put forward by the trademark owner are likely going to be ignored and the infringement continued as the way it was. However, the trademark owner can use this ignorance and continuation as a factual basis to argue bad faith on the infringer's part and claim punitive damages in subsequent civil litigations.

2. Administrative protection

Administrative protection has been proved particularly useful and effective in China in light of China's characteristics, i.e., having a strong, effective, and encompassing-all-aspects-of-life government. However, the obvious downside of this approach is that it does not address the issue of compensation. Trademark owners must negotiate with the infringer separately or file a lawsuit if they wish to recover losses resulting from the infringement.

When a trademark owner (or a relevant party) suspects their rights are being infringed upon, they can draw the matter and preliminary evidence to local law enforcement authorities (Administration for Market Regulation, or AMRs, 市场监督管理局) by filing a complaint and request the AMR to investigate and punish the infringer once trademark infringement is established.

For the AMRs' part, they would review the complainant's documents and refuse to take those apparently non-infringing cases. If they decide to take the case, they are entitled to take necessary measures prescribed by the laws for the purpose of investigation, including inspecting and/or reproducing the relevant documents, and sealing up and/or seizing the allegedly infringing products. Once infringement is established, AMRs would impose on the infringer a permanent injunction and economic punishment.

In addition, AMRs could also take *ex-officio* actions against IP infringements. In such cases,

AMRs would often contact the trademark owner for verification and authentication, and the latter could then step in for following up.

3. Civil litigation

Compared with the first two approaches, civil litigation is the most expensive and time-consuming. But the preliminary reliefs provided by the Chinese courts make that up to some extent. On the other hand, compared with the administrative law enforcement authorities, the courts are more flexible and tend to be more lenient in practice when determining the establishment of trademark infringement, which could result in better chances of success for trademark owners to obtain protection.

Trademark owners can obtain damages and have the infringers bear the reasonable expense of enforcing the trademark, which is not available or very difficult to get under the first two approaches.

In a civil litigation, the courts apply one of the following three methods when determining the amount of damages:

- *Statutory:* In practice, when trademark owners were unable to submit evidence on either their own losses or the infringer's profits, they could apply for the statutory damages and leave the determination of the damages completely under the court's discretion, which is no more than RMB five million (about USD 741,500).
- *Evidence proved:* With sufficient evidence of their own losses or the infringer's profit, trademark owners could apply for higher damages on the basis of evidence proof.
- *Punitive:* Punitive damages can be applied when there is sufficient evidence proving the infringer's bad faith and the serious circumstances of the infringement. The punitive damages could be one to five times the amount of the trademark owner's losses or how much the infringer's profit is, provided that the trademark owner can prove the same by evidence.

4. Criminal action

If the trademark owner wants the infringer to be held criminally responsible, they should first submit the case to the administrative law enforcement department as elaborated in above Path 2. After the administrative law enforcement department accepts the case, and finds that the amount involved in the case reaches the filing standard of a criminal case through on-site

“ Trademark owners can obtain damages and have the infringers bear the reasonable expense of enforcing the trademark. ”

forensics investigation, the trademark owner may push the administrative law enforcement department to transfer the case to the public security organs. In the process of promoting the transfer of cases from the administrative law enforcement department to public security organs, professional trademark attorneys may play a bigger and more effective role with their own professional knowledge and resource characteristics, so as to finally achieve the purpose of investigating the infringer's criminal responsibility.

After accepting the case, the public security organ will control the suspect and initiate criminal investigation. As soon as the criminal investigation is completed, the public security organ will transfer the case to the procuratorate, who will then prosecute the suspect.

Articles 213 to 215 of the Criminal Law of China also list the same acts that are subject to criminal liability as listed in the Trademark Law. Depending on the severity of these acts, possible criminal liability includes fixed-term imprisonment of not more than three years or fixed-term imprisonment of not less than three years but not more than 10 years and also a fine.

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Trade Dress in Mexico: Some considerations about their protection in our jurisdiction

Carlos Reyes, Senior Attorney at OLIVARES, reviews the progress of trade dress trademark applications in Mexico following on from the adaptations implemented in the Mexican Industrial Law.

The modifications to the former 1991 Mexican Industrial Property Law - implemented on May 18, 2018, and in force since August 10 of said year - included an additional paragraph, number VII in article 89, related to the signs that can constitute a trademark, referring to the trade dress.

This regulation, for the first time in our Industrial Property Laws, officially opened the possibility to protect the so-called trade dress trademarks, defining them as the plurality of operational or image elements, including size, design, color, shape arrangement, label, packaging, decoration, or any other element that, when combined, can accomplish a distinctive function regarding products or services.

The protection of these signs was also conditioned by the very definition of a trademark, regulated in the precedent article 88 of said IP Law, as an inherently distinctive sign and, consequently, a sign serving to designate the origin of the products or services. This is to be conceptually separated or arbitrary from the products or services (e.g., not the name or usual name of the products or able to be understood as mere information about them or their characteristics) and then able to accomplish the guarantee of origin trademarks' essential function.

Additionally, the 2018 modifications changed the trademark's definition in the former Industrial Property Law text, which changed from "a visible sign distinguishing products or services from others of the same kind or class in the market" to



Carlos Reyes

“Which opened the possibility to also register other non-conventional marks like sound and odor marks.”

"a sign perceptible by the senses and capable of being clearly and precisely identifiable as to the subject matter of protection, distinguishing goods or services from others of the same kind or class in the market" in the new 2018 text, which opened the possibility to also register other non-conventional marks like sound and odor marks.

On the other hand, the possibility to register trade dress trademarks, traduced as "commercial image", was immediately opened by the Mexican Industrial Property Office (IMPI), whose databases contains - to this date- 3,414 applications for the registration of different commercial image trademarks. In fact, on the very first effective day (August 10, 2018) of the above-mentioned long-awaited modifications in the Industrial Property Law, 35 trade dress mark applications were filed, of which 31 related to product packaging and four to the commercial image of service stations (in general terms this proportion between trade dress constituted by product packaging and commercial establishments has been maintained in the short life in Mexico of trade dress trademarks).

This protection was confirmed in the new Industrial Property Law, in force since November 05, 2020, in which article 172, listing the signs that can constitute a trademark, included paragraph VII with an identical definition (i.e., the plurality of operational elements; image elements, including size, design, color, shape arrangement, label, packaging, decoration, or any other element that, when combined, that can accomplish a



“A sign perceptible by the senses and capable of being clearly and precisely identifiable as to the subject matter of protection, distinguishing goods or services from others of the same kind or class in the market”.

distinctive function in regard to products or services).

Prior to 2018, we can mention the existence of Court precedents in which the "commercial image" was first considered for protection as an ornamental or complementary - non-independent - element of a registered trademark, in occasions of unfair competition litigation matters and, later, as combinations of colors, packaging, and other elements that can by themselves accomplish a distinctive function.

The later Court definition of commercial image is, more or less, in agreement with the usual international standard for trade dress distinctive signs, referring to the visual appearance or commercial look and feel of a product or service that can accomplish a distinctive function, derived from a combination of elements that can include 3D features, designs, and shapes that are used to present a product or a service.

In this regard, the mention of a commercial image, i.e., trade dress, in paragraph VII of article 89 of the former Mexican Industrial Property Law and, in paragraph VII of article 172 of the new Mexican Industrial Property Law, relating both articles to "signs that can constitute a trademark" leaves no doubt about the protection assured to these signs as trademarks and not as ornamental or complementary elements of a registered trademark.

In relation to the criteria of the IMPI regarding the distinctiveness of trade dress, it is interesting to note that trade dress trademark applications

- presented as combinations of said different elements - have been granted in the majority of cases and that, when refused registration, the refusals have been based on absolute grounds for lacking distinctiveness under considerations of mere descriptiveness.

This criterion of the IMPI, relating to the impossibility of a trade dress trademark accomplishing a distinctive function, is interesting because it has allowed the protection of shapes of products that, if filed as 3D trademark applications, would have been refused by IMPI for lacking distinctiveness. In fact, 3D trademark applications are more often refused under considerations that tacitly relate to high distinctiveness or even originality, even if explicitly

Résumé

Carlos Reyes, Senior Attorney

Carlos joined OLIVARES in October 2008 and has more than 25 years of experience in intellectual property prosecution and litigation. His practice is now mainly focused on the areas of counseling and trademark registration. In summary, he provides counseling regarding trademark registrability and brings his experience on trademark prosecution and litigation, answering objections related to absolute and relative grounds of refusal, and preparing and filing trademark oppositions before the Mexican PTO (IMPI).

As a senior attorney in the OLIVARES trademark team, he has helped to secure trademark protection in Mexico for several important trademarks, in particular relating to trademark distinctiveness and the likelihood of confusion.



bearing in considerations relating to shapes that exclusively result from the nature of the goods or are required to obtain a technical result.

In both cases, it is important to mention that it is possible in Mexico to register both 3D and trade dress trademarks considered as lacking distinctiveness according to the IMPI criteria if the applicant is able to prove acquired distinctiveness, i.e., the proposed trademark - initially non-distinctive - has secondary meaning derived on its use.

It is also important to mention that the IMPI provides some information about the protection of trade dress on its webpage¹, with the title "Commercial Image: Protect the unique characteristics of your product or service". However, the information is related therein to combined and complementary - non-independent - elements of a trademark, always linked to a conventional trademark right, and not to a kind of trademark or non-conventional trademark. This derives from the inclusion of the phrase, *"if you already have a trademark for your product or service, register also its commercial image and avoid that others can copy its appearance"*.

Nevertheless, for the registration of trade dress, it is not a requirement to mention or to link the application to a registered trademark, and said same above-mentioned webpage mentions trade dress as a non-traditional trademark. In fact, IMPI refuses or requires the applicants to exclude trademarks that are visible in the images of the trade dress they are applying for, requiring them to limit the claimed protection to only the operational or image elements that combined constitute the trade dress.

On the other hand, the applicants are required by IMPI to include in the trade dress trademarks' applications an accurate description of the trade dress / commercial image they are applying for, indicating in words - additionally to the images - the operative and image elements that combined constitute their trademark.

Also, the IMPI requires the applicants to submit images of the trade dress from all views (above, sides, frontal, and behind views), as it is also needed for the case of 3D trademarks.

In fact, most of the official requirements from IMPI relate to formalities that must be accomplished when filing a trade dress trademark application: applicants are requested to include these elements and to exclude as elements those which do not request protection. Excluded elements are those that, even if visible in the exhibited images, cannot constitute distinctive operative and image elements of the requested trade dress trademark.

We have in this regard reviewed some refusals from IMPI in relation to trade dress trademark applications and find that most of these relate to the lack of distinctiveness, specifically to

“**The later Court definition of commercial image is, more or less, in agreement with the usual international standard for trade dress distinctive signs.**”

considerations of the descriptiveness of the applied-for sign. This refusal clause is regulated in paragraph IV, article 173 of the current Industrial Property Law, relating to signs that, considering all their characteristics, are descriptive of the goods or services they are intended to distinguish.

The arguments of IMPI are that the proposed trade dress trademark lacks "unique and distinctive characteristics" that could distinguish it from other similar products or services in the market. In other words, the proposed sign is not appreciated differently enough from the usual representation of the common or essential elements of the product or the commercial establishment (i.e., store, gas station, etc.).

It is also important to remark that in some cases, the IMPI refuses the registration requested for trade dress marks bearing the refusal in paragraph XV of the Industrial Property Law, relating the prohibition to register deceptive signs or signs that are likely to induce the consumers to error as constituting false indications about the nature, composition, qualities or the origin of the products or services, arguing that *"it cannot be determined how this sign could be used in distinguishing such product or service"*. This phrase leads us to believe that the refusal actually relates to the lack of distinctiveness of the proposed sign and not to deceptiveness.

But, additionally to these quite generic considerations, there is no word or further explanation in the IMPI refusals that may clearly explain the factors that should be considered as implying a lack of distinctiveness of a trade dress trademark. For example, when the trade dress trademark consists exclusively in commonly used forms, or in forms imposed by the nature of the goods, or are necessary to obtain a technical result.

Of course, these arguments may be tacitly considered in the trade dress refusals from IMPI based on the lack of distinctiveness, so we will need to wait for relevant Court precedents to explain more explicitly why a trade dress applied sign can be considered as lacking or having distinctiveness.

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¹ <https://www.gob.mx/impi/articulos/imagen-comercial-protege-las-caracteristicas-unicas-de-tu-producto-o-servicio?idiom=es>



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An update on trademark licenses in Brazil

Igor Simões & Jessica Carvalho of Simoes IP Law examine the protection offered to intellectual property owners when licensing their trademarks to protect their brand's identity, values, and reputation.

The world is more connected than ever before, and technological innovations have been changing the business landscape. Commercial transactions are a click away for foreign customers, which means that products and services can be easily commercialized globally. Therefore, it is crucial to protect businesses' intellectual property outside of the country in which it is created, mainly in countries with existing business relationships.

Protecting trademarks and other intellectual property rights is a key to building brand loyalty,



Igor Simões



Jessica Carvalho

which will create recognition alongside tangible and intangible value for companies or trademark owners. Moreover, registered trademarks can prevent piracy and unfair competition.

Marketing studies affirm that customers are willing to pay more for products and services that they already know and/or can identify the brand. These studies highlight how essential it is to have brand strategies, and brand protection should be in the core of business strategy.

Brazilian IP particularities

Intellectual property protection is territorial, every nation can regulate the legal protection in its territory. Some International Treaties unify rules and laws of intellectual property and facilitate the registration of trademarks in different territories. But it is up to each national territory to examine, allow, or reject the trademark application.

Even though Brazil is a party to some International Treaties and Organizations, such as the World Intellectual Property Organization (WIPO) and the Paris Convention for the Protection of Industrial Property, Brazilian Intellectual Property Law has important particularities. For example, Brazil is not yet a multi-class jurisdiction, so it is necessary to file an individual trademark application in each class of interest to the Applicant, except for designations made via the Madrid protocol that can use the multi-class filings.

Résumés

Igor Simões is the Managing Partner at Simoes IP Law firm and a registered Brazilian IP agent, and a lawyer since 1999. Igor has extensive experience in both IP prosecution and litigation matters in Brazil.

Jessica Carvalho is an experienced Trademark Attorney at Simoes IP Law firm. She helps clients by providing guidance and advice in trademark matters, such as filing, office actions, oppositions, and forfeiture actions.



Furthermore, Brazilian IP Law does not request proof of intent to use for registering a trademark application. However, a third party can object to a trademark with a forfeiture action due to the non-use of the corresponding trademark in Brazil in the subsequent five years counted from the grant of registration or the interruption of the use for more than five consecutive years. In order to avoid trademark cancellation for non-use, it is recommended for the owner or authorized Licensee to keep records of proof of use.

It is worth mentioning that, in accordance with article 128 of Brazilian IP Law, the applicants may only apply for the registration of a trademark related to the activity effectively and legally carried out either directly or through companies directly or indirectly controlled. This condition is declared on the trademark filing. A false declaration of this condition is subject to legal penalties.

The Brazilian trademark system is attributive and does not protect unregistered trademarks. It is also a first-to-file system, which means that the first applicant to file a trademark application will have the priority right to register it. However, there are two exceptions to the Brazilian attributive and first-to-file system. The first exception is based on Article 129 of Brazilian IP Law, which states that every individual or entity who was using a similar or an identical trademark for at least six months before the date of filing or priority in good faith, will be entitled to take the priority on the registration process. The second expectation is related to well-known trademarks, this exception is based on Article 126 of Brazilian IP Law, which mentions Article 6bis of the Paris Convention. This provision grants the protection of well-known trademarks in its field of activity regardless of previous filing or registration in Brazil.

Case Law on trademark licenses

In an important decision, the Superior Court of Justice, after judging the case of the companies *QuickFood Lanches e Refeições LTDA v RP Alimentação e Diversões LTDA*, ensured the possibility of the trademark holder, when granted a license, to prevent trademark use by the licensee when there is no compliance with the standardization of products and services, even if the trademark use has been authorized with no condition or limiting effects.

The Superior Court of Justice (STJ) is the court responsible for standardizing the interpretation of the federal law throughout Brazil, being the last instance of the Brazilian justice to the infra-constitutional causes, not directly related to the Constitution. As an entity of convergence of the common Justice, it judges causes originating from the entire national territory, in all non-specialized jurisdictional strands, and its decisions have the power to guide other courts and judges.

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Marketing studies affirm that customers are willing to pay more for products and services that they already know and/or can identify the brand.”

The granting of authorization is equivalent to the licensing of the trademark use, in view of the purpose of enabling the trademark use as trade name of the licensee, without transferring the ownership of the industrial property, and the licensor remaining in the same business activity, using the trademark in many other places.

In Brazil, the trademark holder has the prerogative to assign, with or without charges, or to license the trademark use to third parties, upon payment of royalties, from the execution of the trademark license agreement subject to registration at the BPTO, under article 130 of the IPL.

As the best doctrine explains, the license grants operation rights to a third party, without transferring the property, resembling a lease contract. Thereby, the licensor remains as the registration holder, and, at the same time, can expand the reach of their business, earning additional income with their trademark without the need for direct dedication to manufacturing, distribution, marketing, and sales activities. On the other hand, the licensee acquires the use of an already known trademark, obtaining the public's acknowledgment and appreciation, association to concepts and values connected to the foregoing trademark, and the increase in sales provided by the automatic identification of the product or service.

The license of use has, as the main element, the faculty of the holder to authorize the economic use of the trademark, without prejudice to their right of exercising control over both the specifications and the nature and quality of the goods and services provided by the licensee, pursuant to article 139 of the IPL.

Through the license of use, the licensee undertakes, by the law, the material integrity and reputation of the trademark, forcing themselves to watch over it and its products and services in solidarity. The licensor has the right to exercise effective control over the licensee's attention to the zeal of the trademark used since the reputation, uniqueness, and consistency of the sign's use are determining factors for the value in the goodwill of the company. Thus, even if the trademark exploitation is authorized, the registration holder has the right to require the licensee to make adjustments that are necessary to maintain the adopted standards.

In the mentioned situation, when the licensee chose to adopt a new concept to the trademark, they wanted to overcome that one previously adopted. To that extent, maintaining the old standard by the licensee has hampered the new identification proposed by the promoted amendments, since the layout of the store was different from the one suggested by the owner, as well as the menu and the logo itself.

Thereby, there was a clear disfigurement of the trademark, which led to the granting of the

injunction to prevent the use, as the exploitation of forms that are alien to the other premises creates obvious injury to the joint work carried out by the licensor and other licensees.

In this sense, the notion of trademark dilution is related to the offense to the integrity of a distinctive sign, either moral or material, whose effect is the decrease of economic value thereof. Among the types of dilution, there is obfuscation which consists of the loss of "brightness" or distinctiveness of a trademark. From the moment in which the same expression starts to identify goods from several sources, it is understood as an infringement of the sign's uniqueness. The question imposed is the protection to the legal interests against the loss of their distinctiveness.

Since the trademark is more than a name or a logo, being a set of perceptions or feelings of consumers towards a product, service, or company, the confusion of clients and suppliers due to the non-standardization by the licensee, *in casu*, hindered the fixation of a single image to the memory of the consumer, which negatively affects its power of sale.

The distinctive sign, with the passage of time, eventually adds its own value to the offered product, which involves a new dynamic of consumption, in which the quest is no longer the commodity itself, it becomes what that particular trademark represents.

Moreover, the visually noticeable signs used to distinguish a product or service from others that are equal, alike, or related reveal to be an essential instrument to guarantee healthy reputable consumption relations. The ability of distinction must be inherent to the sign since the trademark acts as a signature to be identified by its target audience. In this way, the uniqueness of subjective elements that involve the trademark allow the consumer to correlate it with the product or service, consequently avoiding unfair competition and the trademark weakening and diluting.

In this case, the justice, in the first instance, understood that the inadequacy to maintain the trademark standards could result in a penalty, but not in inhibiting the use of the name. The Federal Court of Justice of DC reversed the earlier decision, understanding that the defendant (licensee) should maintain the trademark standards.

On an appeal to the STJ, *QuickFood* argued that the conditions of the trademark use, to produce limiting effects to the licensee, should be included in the agreement, which did not happen.

However, Reporting Judge João Otávio de Noronha, in his vote, consigned the understanding that the trademark, more than a mere title, brings the concept of the products or services that it offers, identifying it and assuring its performance and efficiency. Besides, it has competitive features, since it is distinguished from competitors; it makes

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Even if the trademark exploitation is authorized, the registration holder has the right to require the licensee to make adjustments that are necessary to maintain the adopted standards.”

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easy the recognition and attraction of clients; it reduces the risk to the consumers, which includes the standardization of products, services, treatment, and other attributes that surround the trademark.

Therefore, there is no need to talk about the mandatory existence of conditions or limiting effects in the license of use for compliance purposes as to the specifications imposed by the registration holder, since it is inherent to the trademark that the use by third parties must comply with its characteristics.

The final decision of the STJ ruled that:

1. The entrepreneur is only considered the holder of the exclusivity right, in relation to the trademark, after the registration certificate, which has a constitutive nature, has been issued.
2. The legal protection of the trademark has the objective of repressing unfair competition, avoiding enrichment with the efforts of others, and preventing confusion among customers.
3. Confusion between customers and non-compliance with the standards of products and services by the licensee demonstrates the misuse of the trademark, which authorizes the injunction to prevent its use.

The trademark, much more than just a name, brings the concept of the product or service that carries it, identifying it and guaranteeing its performance and efficiency. Furthermore, it has a competitive feature: it distinguishes it from competitors; facilitates the recognition and acquisition of customers; reduces the risk for customers, who rely on the standardization of products, services, and other attributes that surround the trademark.

Conclusion

Given the understanding settlement by the Brazilian Court, it is evident the necessary compliance with the standards required by the licensor under trademark use agreements, under the penalty of misuse configuration thereof. The ruling then authorizes the injunction to prevent the use of trademarks operated by third parties, since the licensee has limitations to fulfill, even if they are not listed in their license agreement.

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The intangible assets of the future: NFTs and cryptocurrency in the metaverse



Joshita Davar Khemani, and co-authors Kajal Sinha and Ragini Ghosh, of L.S. Davar & Co. evaluate the developments of NFTs and cryptocurrency in the metaverse to assess the impact they could have on the IP industry.

The metaverse and associated concepts, such as NFTs (non-fungible tokens), blockchain, and cryptocurrency have become very trendy topics for discussion in recent days, mostly owing to their meteoric rise in popularity over the course of the last couple of years. With the third generation of the World Wide Web, commonly known as "Web 3.0", being touted as revolutionizing the way we communicate, interact and live our lives virtually, the role of their foundational concepts, such as blockchain-based currencies, or cryptocurrencies, and digital assets such as NFTs, have also generated a great deal of interest, especially in the space of opening up novel avenues for investment and revenue generation.

As the metaverse and its related concepts have been much debated in recent times, We shall not examine definitions or its basic principles here. We are looking, instead, to engage in a conversation regarding the fluctuating perception and public trust in these concepts over the last two years.

Role of Cryptocurrencies and NFTs in the Metaverse

The core of Web 3.0 is built on the blockchain. Therefore, blockchain-based digital assets, such as cryptocurrencies and NFTs, which are unique, indivisible and immutable, and are accordingly a logical progression into tapping the unlimited



Joshita Davar Khemani

trading opportunities offered by the metaverse.

Although NFTs and cryptocurrency function on the same basic principles, they are not exactly interchangeable. At the outset, while cryptocurrency units are fungible (i.e., any unit of Bitcoin or Ethereum can be substituted or replaced by any other unit), every NFT needs to be unique, or non-fungible, in order to have value. NFTs, due to their intrinsically unique nature, can have multiple uses as source identifiers or verifiers, while the intention behind cryptocurrency remains as a medium of exchange.

Nevertheless, cryptocurrencies (or perhaps a more advanced future version of them) are intended as being the sole operative currency in the metaverse. At the moment, one can use one's own cryptocurrency, either mined or bought against the value of actual fiat currencies, but the eventual intention within the metaverse space is to make cryptocurrency independent of actual fiat government-backed currencies so that the metaverse will essentially have an independent, alternate functioning economy.

Metaverse, NFTs and IP

The metaverse and its potential in marketing and commerce is something no company can afford to ignore. Even before it has fully taken off, the metaverse looks set to reshape the fundamentals of consumer culture, and by extension, marketing.

Everything we have come to accept in the physical space will have a digital iteration or avatar. From user identity (transmuting into a digital avatar for the online space) to collaborating in a digital workspace with colleagues who may be half a world away, to shopping, to attending events, to owning virtual assets, etc. Ownership and experiences will move online, and in order to grant them legitimacy, they will need to be adequately protected and guarded against misuse and misappropriation. Given that the metaverse exists exclusively in the virtual space, all properties and assets acquired therein will similarly be virtual, i.e., intangible. Intellectual property law, therefore, has a unique opportunity to broaden its scope to provide protection in respect of what is likely to become extremely valuable assets in the near future.

While the basic principles of IP law are set to operate even in the metaverse (IP has been dealing with digital encroachments for a couple of decades now), the virtual space does throw up its own set of unique challenges facing any form of legal enforcement within it. For example, the primary question of jurisdiction. In whose jurisdiction does policing the metaverse fall? In the case of a wrongful acquisition of a digital asset, who can be blamed, what is the actual severity of the crime, and what are the likely consequences going to look like? With such a nascent technology, no specific laws have yet been set in place, as lawmakers are only beginning to understand the nature of the entity they are expected to regulate.

The still ongoing MetaBirkins dispute, raised by the premium luxury brand Hermès against a content creator, Mason Rothschild, against digital variants of their famous designer Birkin bags,

“**NFTs, due to their intrinsically unique nature, can have multiple uses as source identifiers or verifiers.**”

will stand as a pioneering judgment in terms of defining legal jurisdiction with respect to NFTs in the metaverse vis-à-vis intellectual property rights. Conflict within the metaverse, for example, Nike suing the virtual online sneaker exchange, StockX, for displaying NFTs of Nike branded sneakers without securing adequate permissions from Nike, on the grounds of trademark infringement and dilution, underline that prominent brands are intent, from the very outset, on protecting their intellectual property in virtual goods in the metaverse. Precedents arising out of other digital content, such as those prevalent in video games or on websites, can serve as guiding lights in deciding IP disputes in the metaverse. For example, in the famous *Humvee case*¹ the Rogers test², established to determine whether the use of a trademark requires prior authorization, was upheld and applied to the dispute regarding the representation of the famous Humvee military

Résumé

Dr. Joshita Davar Khemani is the Managing Partner at L.S. Davar & Co. with a demonstrated history of working in the legal services industry for 33-plus years. Skilled in client relationships, litigation, management, intellectual property and trademarks.

Dr. Davar Khemani, granddaughter of the Founder Partner, the Late Mr. L.S. Davar, is an experienced Legal Professional with a Degree in Law. A keen philanthropist with an interest in education and healthcare for the poor and the underprivileged.

Dr. Davar Khemani can communicate fluently in English, French and many Indian Languages. She has been adjudged not only as one of the Top 100 Powerful Women in Law but also holds a Certificate of Excellence and several Awards from Forbes India for her invaluable services in the field of Innovation & IP.

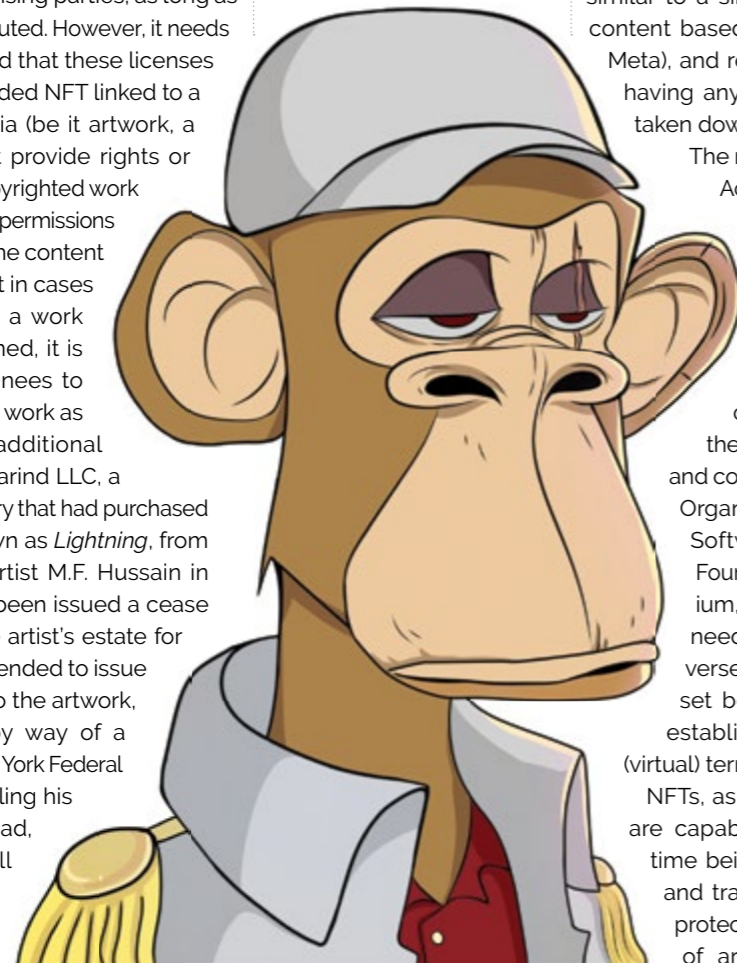


vehicle in the video game, *Call of Duty*. The court ruled in favor of the defendants, citing that the game aimed to realistically simulate modern warfare, and therefore the authentic depiction of equipment, including their associated trademarks, had artistic value and could be allowed.

Problem areas, such as identity theft, sexual harassment in the metaverse, and fraudulent scams featuring cryptocurrencies, have already been identified. Further, the terms governing the privacy of user data in the hands of companies acting in the metaverse are another grave concern.

NFTs operate on the immutable structure of blockchains. As a result, once information has been fed into it, it can never really be deleted, without compromising the entire structural integrity of the chain, which will risk all other sensitive information contained within it. However, possible and tangible practical solutions to these problems, especially as may be prescribed by future legislation is not yet at hand. It is a notable area of concern and attention for law and policymakers in both developed and developing economies.

One solution to regulate NFT transactions between private parties is by way of open-source standard licensing. The licenses, already being offered by several entities/organizations, can quite easily be customized to suit the specific requirements of the licensing parties, as long as due accreditation is attributed. However, it needs to always be kept in mind that these licenses will be regulating the coded NFT linked to a particular piece of media (be it artwork, a video, etc.), and cannot provide rights or license to amend the copyrighted work in itself. For that, additional permissions must be obtained from the content creators themselves. But in cases where the copyright in a work has already been assigned, it is now open for the assignees to mint NFTs linked to such work as a way of generating additional revenue therefrom. Tamarind LLC, a New York-based art gallery that had purchased a 60 ft. long mural, known as *Lightning*, from late renowned Indian artist M.F. Hussain in 2002, and had recently been issued a cease and desist from the late artist's estate for announcing that they intended to issue a series of NFTs linked to the artwork, contested the claim by way of a complaint before the New York Federal Court stating that by selling his artwork, the late artist had, in fact, relinquished all ownership, including of the intellectual property incumbent in it. The



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The metaverse looks set to reshape the fundamentals of consumer culture, and by extension, marketing.
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case remains pending, as of date.

Until formal legislation comes into place, the metaverse, as it is, stands governed solely by terms and conditions laid down by private and corporate players currently involved in building the infrastructure of the metaverse. For example, Meta's Terms of Service for Horizon Worlds, its curated metaverse, which does not adhere to a public blockchain, or allow the private purchase of virtual domains or plots within it, are built upon the general guidelines in place for infringement of intellectual property otherwise, and leaves Meta with sole discretion to disable or remove user content or accounts found to be in violation of the terms. This also limits the availability of different reliefs for an affected party.

Another structure providing recourse is a DAO, or a Decentralized Autonomous Organization, whereby instead of authority being confined to a single entity, decision-making is also distributed among the members of the metaverse by way of votes, allotted on the basis of ownership of assets (which opens another set of questions regarding diverting to a digital feudal authority structure). Decentral and, one of the most popular metaverses available today, has a DAO in place to govern potential issues of IP infringement. For the time being, however, their role and parameters of operation appear to be similar to a single entity deciding to remove content based upon sole discretion (such as Meta), and relief remains restricted solely to having any offending content removed or taken down.

The major tech players, such as Meta, Adobe, Microsoft, Epic Games, Ikea, Sony, Nvidia, etc. have come together in June 2022 to create the Metaverse Standards Forum (MSF) aimed at fostering the development of open standards for interoperability of systems creating the metaverse. While their stated principal goal is promoting and coordinating Standards Developing Organizations, such as the Academy Software Foundation, Spatial Web Foundation, Open Geospatial Consortium, etc., in developing the standards needed to actually build the metaverse space, their efforts are likely to set benchmarks for interpreting and establishing rights, accreditation and (virtual) territoriality within the metaverse.

NFTs, as non-fungible unique identifiers, are capable of being protected, for the time being, under the laws of copyright and trademark. However, this range of protection is limited to their comprising of artistic or literary works, or an

otherwise known or registered trademark. When, for example, deeds for virtual property are converted into NFTs, the situation becomes complicated. Can such NFTs be identified as contracts and come under the ambit of commercial contract law? Plots of virtual land in the metaverse are identified by coordinates (similar to a radio frequency); therefore, the Uniform Domain Name Dispute Resolution Policy (UDRP) process as applied to domain name disputes is not likely to apply to the metaverse, because metaverse lands do not use a naming convention such as a URL that would include a trademark.

Conclusion

Within the metaverse, NFTs act as non-interchangeable, unique assets or even identifiers while cryptocurrency is the accepted medium of exchange and commercial transaction. The problems start in trying to correlate the concepts of the metaverse to real life as we know it. The truth is, the metaverse is likely to require a complete re-imagining of our notions of space, money, commerce and engagement. IP law has experience in handling questions and disputes arising out of ownership of intangible rights and is therefore a logical starting point to govern the metaverse space. However, IP law in itself is unlikely to be adequate in formulating sufficient safeguards against potential abuses that may be anticipated in the unique space of the metaverse and we will require our law and policymakers to come up with creative solutions to properly and democratically govern this space, for the benefit of all, users and companies alike.

We must not forget that we are still in the formative stages of creating the metaverse and experiences within it. Our encounters now will form the basis of learning how to navigate the brand new worlds within it, and trial and error must be expected and not rejected with finality just yet. The metaverse a few decades from now is bound to look very different, once we have the advantage of hindsight. We await landmark judgments, creative law-making, and corporate responsibility in this nascent arena and hope that the wonders promised by the metaverse can be allowed to come to fruition.

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Instead of authority being confined to a single entity, decision-making is also distributed among the members of the metaverse by way of votes.
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In a word: foreign language trademarks in Poland

Joanna Pilka of Patpol evaluates the registration process for a foreign language word mark in Poland with consideration for descriptiveness and distinctiveness.

Attempting to register a descriptive word mark as a trademark is neither a good idea nor a simple matter. Nevertheless, from the point of view of many applicants, such marks are perceived as the most attractive due to the fact that they easily convey information about the product, encouraging consumers to purchase them.

However, since these signs convey information about a product or service, obtaining a monopoly on their use by registering them as a trademark for one entity is not possible.

For approximately 11,000 word trademarks filed in Poland under the national procedure in the years 2020-2021, nearly 26% were refused registration.

When facing the dilemma of whether to try to obtain registration for such a trademark or create/invent some other sign with better chances of registration, applicants in Poland often decide on the first option.

Also, quite often, being aware that a given sign formulated in Polish, due to its descriptive nature, has a low chance of obtaining registration, applicants decide to submit a sign formulated in a foreign language for registration, hoping that such a sign will have a better chance of being registered.



Joanna Pilka

The most frequently chosen foreign language in this case is English, less often languages such as French, Italian or German.

Word trademarks formulated in a foreign language in the majority of cases are refused registration in Poland due to their descriptive nature in relation to goods or services.

Pursuant to the industrial property law in Poland, signs consisting only of elements that may be used in trade to indicate, in particular, the type of goods, their origin, quality, quantity, value, purpose, method of production, composition, function, or suitability are considered devoid of distinctiveness.

Signs devoid of distinctive character are therefore all signs that merely describe the goods or services claimed.

A sign is descriptive if it has a sufficiently direct and specific link with the goods or services indicated in the application. Such a link will exist if the relevant public immediately and without hesitation recognize in such a sign a description of the goods or their characteristics. At the same time, the descriptive nature of such a sign must be obvious to the average recipient and not raise any doubts.

As a rule, it is assumed that the provisions on the exclusion from registration of descriptive signs do not constitute an obstacle to the registration of signs formulated in a foreign language as such. However, this does not mean that such signs are automatically considered non-descriptive.

It all depends on whether a significant part of the relevant circle of domestic recipients of goods or services bearing a trademark written in a foreign language would be able to read its meaning and recognize its purely descriptive character.

When evaluating a sign formulated in a foreign language, the level of knowledge of a given language among the group of recipients to whom the goods or services marked with this sign are addressed is taken into account.

It is estimated that about 60% of Poles over 25 know at least one foreign language. Among the

most popular foreign languages in Poland are English, Russian and German. Other, though less popular, languages are French, Italian and Spanish.

Statistical data show that in the case of English, which is the most frequently used foreign language in trademarks filed in Poland, about 30% of Poles have communicative knowledge of it. In the case of German, it is 14% and in the case of Russian - 22%. In the case of other languages, knowledge is not greater than 1-5%.

Taking into account the above statistical data, it seems that in the case of the best-known foreign language in Poland, i.e., English, it is known by a smaller part of the society, nothing should stand in the way of effective registration of trademarks containing word elements in a foreign language.

However, it should be kept in mind that it is assumed that in order to know some simple and frequently used words in trade, it is not necessary to have an in-depth knowledge of a foreign language or communication skills.

Therefore, even though the knowledge of English among consumers in Poland is not very high, if simple words are used in a trademark, it is assumed that the average consumer will not have difficulty understanding these words. As a consequence, if a word from the English language used in a trademark has a meaning that will indicate some characteristics of goods/services, it will be accused of being descriptive.

“
Word trademarks formulated in a foreign language in the majority of cases are refused registration in Poland due to their descriptive nature in relation to goods or services.
”

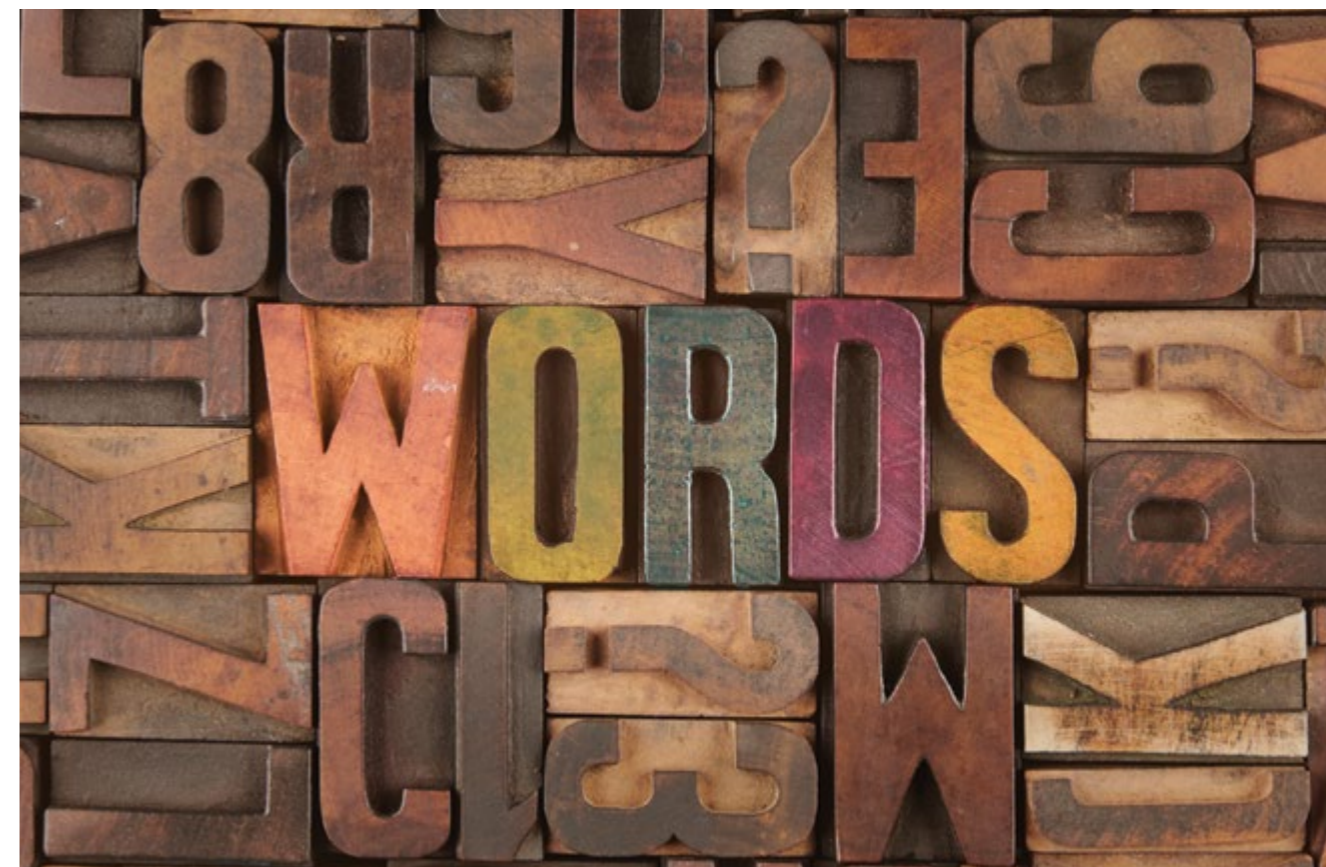
For example, the following trademarks were refused registration due to the descriptive nature of the sign: RENTFLAT for real estate rental services (class 36), OPTIC SENIOR for dietary supplements (class 5), PURE WHITE for paints, adhesives and concrete (class 1, 2, 19), Sleek Line for hair cosmetics and related services (Classes 3, 35, 44).

On the other hand, the following trademarks have been registered: BLACK CAT for food products in class 30, RAPIDO for courier services in class 39, GUARDIAN for cleaning products in class 3, PRESTIGE for mowers in class 8.

Therefore, when deciding to apply for registration of a word mark formulated in a foreign language in Poland, it is necessary to analyze whether the selected sign in a foreign language will be at significant risk of being considered descriptive of goods/services.

Interestingly, even in the case of signs formulated using foreign languages that are very poorly known to consumers in Poland, such as Italian, there have been cases of examiners' arguing that even if the knowledge of such a foreign language in Poland is negligible, the consumer can check the meaning of such a sign in translation, which everyone who uses smartphones usually has installed.

Such justification for the refusal to grant registration for a trademark containing a descriptive element in a foreign language is surprising and



Résumé

Joanna Piłka is a Patent Attorney in the Trademark and Industrial Design Department in Patpol.

She deals with issues related to the protection of trademarks, industrial designs and internet domains. Joanna develops strategies and provides advice on the protection of brands and industrial designs, draws up legal opinions, examines the registrability of trademarks and industrial designs.

On a daily basis, she cooperates with clients from the pharmaceutical, cosmetic and IT industries, as well as serving companies in the field of new technologies and banking.

She is a member of INTA and the ECTA Design Committee.

definitely too far-reaching. Firstly, it is difficult to agree that the majority of consumers in Poland using smartphones actually have a translator installed. Secondly, that they actually use it, and thirdly that they have a habit of checking foreign names in such a translator. Such arguments are fortunately raised incidentally and this is rather the approach of individual experts and not a common practice of the Polish Patent Office.

What options do the applicants have if their trademark formulated in a foreign language is at risk of refusal due to descriptiveness?

A common practice in the case of filing trademarks containing descriptive elements formulated in a foreign language is filing them as word and figurative marks. In this way, a trademark devoid of distinctiveness or descriptive in its verbal layer gains a chance to avoid refusal of registration.

It is worth remembering, however, that even if such a descriptive sign is filed as a word-figurative mark, it is not possible to avoid such an allegation of descriptiveness in every case. The key factor in assessing whether the graphic forms used in a word-figurative mark are sufficient to consider that the descriptiveness of the force elements contained in the mark does not preclude registration is whether these graphic forms are able to distract the consumer from the descriptive meaning of the word element.

Thus, in a situation where the descriptive sign is simply presented in a standard or handwritten typeface such a procedure may not be sufficient to avoid refusal on the basis of the descriptive nature of the mark. Also, other treatments such as adding color, punctuation marks or special characters, or using a non-standard arrangement of word elements may still not be enough to give the mark a distinctive character.

If all the above-mentioned treatments are not enough, maybe the best approach is to add a graphic element? Apparently, such a procedure seems to give the best chance of avoiding the objection of descriptiveness. However, whether the addition of such an element will actually be effective still depends on whether such a figurative element will actually distract the consumer from the descriptive meaning of the word element.

Such an additional figurative element in the mark, which includes word elements of a descriptive nature, must be of such a size and position that it is clearly recognizable. When choosing such a graphic element, you should also avoid elements that represent or have a direct relationship with goods or services. Also, the use of graphic elements commonly used in trade in relation to the goods or services covered by the application will not be helpful in avoiding the accusation of being descriptive.

Another option in case of refusal of the trademark formulated in a foreign language due

“ There have been cases of examiners’ arguing that even if the knowledge of such a foreign language in Poland is negligible, the consumer can check the meaning of such a sign in translation. ”

to descriptiveness is to claim acquired distinctiveness.

The provisions of the industrial property law make it possible to “get out” of a situation where a sign formulated in a foreign language is accused of being descriptive by the possibility of referring to the fact that a given sign has acquired a secondary distinctiveness.

A mark acquires secondary distinctiveness as a result of long-term use in the course of business of the sign for which protection is to be granted.

Special circumstances supporting this permissibility may include intensive use of the mark, intensive advertising of goods/services marked with the mark, associating the mark with a specific producer by a significant group of buyers, or a long time of using the mark on goods/services.

Therefore, in order to be able to effectively invoke the fact that a given sign has acquired secondary distinctiveness, it is necessary to submit evidence that will confirm such a circumstance.

Importantly, in the case of a trademark application in Poland, whether directly as part of a national application or by designating Poland in an international registration, all circumstances and evidence of the acquisition of secondary distinctiveness must refer to the territory of Poland.

The secondary distinctiveness of signs should apply to the entire territory of Poland and not only to the local or regional market.

In addition, it should be noted that the reference to the acquisition of secondary distinctiveness in the territory of a country other than Poland will not be effective. The fact that secondary distinctiveness is acquired in one country does not automatically result in recognition of that distinctiveness in other countries.

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Diversity, equity and inclusion: disability

Megan Rannard, Associate at Marks & Clerk and member of IP Inclusive, provides an insight into the difficulties facing those with disabilities when entering and integrating into the workforce and offers some first steps for promoting inclusivity.

Interviewing for a new job or a promotion can make even the bravest among us quiver in their boots. The desire to make a good first impression and the uncertainty of how others may perceive you can cause sleepless nights and weeks of nerves. We all have questions that we hope we will be asked so that we can put our best foot forward and hopefully get the job.

Speaking from my own personal experience, the uncertainty of people's perceptions can be a huge worry for those with disabilities and many will unfortunately have had unpleasant encounters with strangers or even friends. When it comes to events such as job interviews, the question of when to disclose a disability, or whether to disclose at all, often has no clear answer and the fear of the potential impact this may have on career opportunities (even if simply as a result of unconscious bias rather than active prejudice) should not be underestimated by interviewers and employers. The fear of being viewed as "less capable" and therefore



Megan Rannard

missing out on opportunities for career progression affects not only disabled individuals at the interview stage - figures suggest that around 80% of people with disabilities acquired these conditions later in life, and so the difficult questions and worries around disclosure and its impact can affect individuals at any time during their career and often without warning.

For those with visible disabilities, the choice to disclose is often automatically taken away but for those with invisible disabilities, or disabilities that can fluctuate between being visible and invisible, it can be much easier to hide symptoms and avoid disclosure in order to try to prevent the risk of experiencing negative bias in the workplace. The act of disclosure avoidance can itself have an adverse effect on an individual's wellbeing. Those hiding their disabilities may often work extra hours to somehow compensate for this, which itself will lead to exhaustion and burnout. Without appropriate adjustments, working practices may exacerbate symptoms and make it much more difficult for an individual to maximize their potential.

It is therefore crucial to acknowledge and openly discuss the difficulties that can surround the disclosure of disabilities and resulting requests for reasonable adjustments if required. It is almost inevitable that discussions about disability will be deeply personal and often quite uncomfortable for the individual concerned. As interviewers and employers, companies should therefore take active steps to make hiring and promotion processes more accessible to individuals with disabilities and to counteract the notion that the disclosure of a disability may have negative implications for employment opportunities and career progression.

To do so requires a change in the way that we address disability as well as the promotion of a safe environment in the workplace in which individuals feel comfortable to disclose their

disabilities, if they choose to do so. A culture of inclusivity and equal opportunity must be clear and visible throughout a business, including to those external candidates interviewing for positions.

Unfortunately, there is no single solution to creating a safe and inclusive workplace environment in which individuals will feel comfortable or even empowered to disclose their disabilities if they wish to do so. The process will take time and requires consistent effort at all levels of a business. To get the conversation started, some ideas for businesses to improve inclusivity and equality of opportunity for those with disabilities could include (a non-exhaustive list!):

- Becoming a Disability Confident Employer under the UK government scheme and promoting this status in job advertisements (as well as internally);
- Acknowledging or including accessibility considerations in job advertisements;

“ A culture of inclusivity and equal opportunity must be clear and visible throughout a business, including to those external candidates interviewing for positions. ”

- Regular training on unconscious bias and inclusive practices for all employees, including those with hiring or promotion responsibilities;
- Having a clear and readily accessible policy for requesting reasonable adjustments so that individuals do not feel that they are requesting something unusual.

Ultimately, the decision to disclose a disability is a deeply personal one and there is no legal obligation to do so. Therefore, when a person chooses to disclose, they should be treated with respect and a collaborative approach should be taken with regard to their personal requirements. Studies have shown that diverse and inclusive workforces are advantageous to businesses and so we should aim to promote a workplace culture in which those who wish to disclose their disabilities feel more secure in doing so.

Résumé

Megan is an Associate and Chartered Trademark Attorney at Marks & Clerk - she joined the IP profession in 2017 having completed a law degree at the University of Kent. Megan is committed to raising awareness, and promoting inclusion and equality for disabled professionals in particular based on her personal experiences with an invisible disability. She is actively involved in IP Inclusive, being a member of the Advisory Board and sitting on the committee for IP Ability (the IP Inclusive community for disabled people, carers and their allies).

“ The act of disclosure avoidance can itself have an adverse effect on an individual's wellbeing. ”





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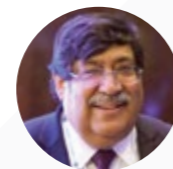
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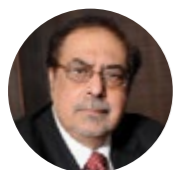
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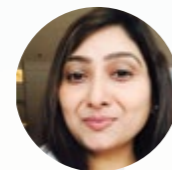
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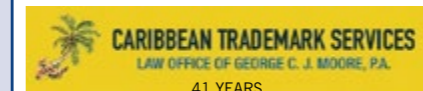


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