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Mindful trademarking can prevent registration headaches

Nicholas Holmes of Caldwell discusses the importance of filing for protection quickly in the world of social media due to the speed at which trends can become popular and the risk this runs for content creators when trademark applications are reviewed on a “first to file” basis by the USPTO.

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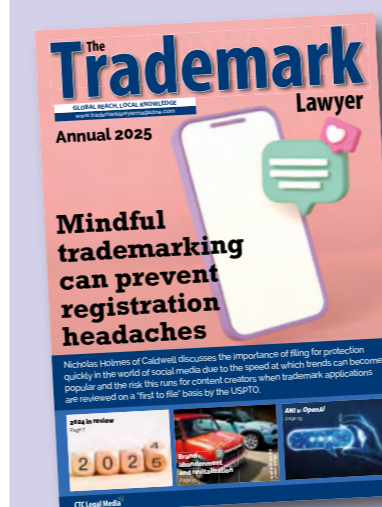


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THE TRADEMARK LAWYER

Annual 2025

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Editor's welcome



Welcome to *The Trademark Lawyer Annual 2025*, where we delve into the ever-evolving landscape of IP practice. As we navigate the complexities of 2024, our dedicated Editorial Board members have provided invaluable insights that will shape our industry for the years ahead.

In this issue, we feature a diverse range of articles that address the pressing issues facing brand owners and IP practitioners today, starting with considerations for mindful trademarking in relation to social media trends in pursuit of the best

**Invaluable
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industry.**

practice for protection. Further, we examine the complexities of trademark cancellation litigation in China; detail the recent legal battle between *ANI v. OpenAI*; address the filing requirements for a declaration of actual use in Mexico; highlight key considerations for crafting a design and protection strategy in the gaming industry; explore the rise in dupe culture and the implications of social media; and assess the current status of IP in Russia. From here, we dive into the essentials of non-use cancellation in Japan; discuss the complexities of Greece's trademark system and the challenges multinational companies need to navigate; assess strategies for reviving abandoned brands; and review the current status of generic trademarks in the US in light of the *Fantasia Dist. Inc., v. Myle Vape Inc. et al.* case.

Lastly, we reflect on the importance of fostering a Culture of Happiness within teams, sharing valuable insights on creating a positive and collaborative work environment.

All the very best for 2025 and beyond!
Enjoy the issue!

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

Sustainability pledge

We pride ourselves on using a sustainable printer for our hard-copy magazines. Halcyon is committed to using only FSC-certified papers, the world's most trusted mark for sustainable forestry. FSC paper ensures responsible management of forests, and, verifying the use of recycled materials, the FSC system can help secure a long-term source of sustainable paper.



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Irene Kyriakides, Niovi Plemmenou and Terpsithea Papanikolaou of Kyriakides Georgopoulos Law Firm discuss the complexities and challenges faced by multinational corporations in navigating Greece's trademark system, highlighting the need for further alignment with EU laws and improved judicial performance to enhance investment and trademark protection in the country.

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Lindsey Annable - Brand Protection Manager, Potter Clarkson. UK

Lindsey is responsible for the management and development of the *iProvidence* service. She joined the company in 2020 with a background in intellectual property and brand protection. Lindsey has extensive experience in protecting brands across online marketplaces, domains and websites, social media, app stores, and NFT marketplaces.

**Francesco Bonini - Of Counsel, R.K. Dewan & Co. Italy.**

Francesco has 28 years of 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. Francesco has his office in Vicenza, in the North-East of Italy. He has been helping several Italian and foreign companies to protect their IP rights.

**Enrique A. Diaz - Senior Partner, Goodrich Riquelme. Mexico**

IP Latin American expert Enrique joined the firm in 1998, finished law school in 2001, and by 2010 he became the youngest lawyer to have ever been made senior partner in the firm's history. He is currently a foreign expert on Latin-American intellectual property, managing the prosecution of over 3500 trademarks and more than 1000 patents per year.

**Catherine Hillaert-Prevost - Expert IP Strategist, Consultant & Advisor. Switzerland**

Catherine has 35+ years' expertise leading IP strategies & portfolios in 160+ jurisdictions, and worked as French INPI Examiner, IP Counsel at law firms, Senior IP Counsel at major international companies Rhône-Poulenc, Rhodia, Nestlé, prior to being Global Head of IP & Anti-counterfeiting at Stoli Group for 12+ years. She now advises on IP protection, litigation, enforcement.

**Misum Hossain - Founder & Head, Lincoln Legal Chambers. India**

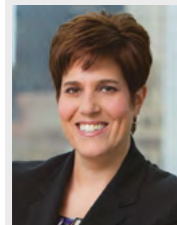
Misum has 18 years' trademark experience in registrations, dispute resolution and licensing. Misum, an alumnus of the University of London LLM programme, has advised clients for IP India, UKIPO, EUIPO, USPTO, IP AUS & CIPO. He is also currently Hon. VP at an academic non-profit. He has designed trademark courses, chaired seminars clocking 6K+ speaking hours, and trained 2.5K+ lawyers.

**Gang HU - Deputy General Manager, China Patent Agent (H.K.) Ltd. China**

Gang is a senior Chinese IP specialist and practitioner. He is good at solving difficult and complicated trademark litigation and non-litigation cases. Some of the influential cases he handled were widely reported on by media, and recent IP litigation cases represented by him were awarded by the Supreme People's Court as the annual guidance cases.

**Stacey C. Kalamaras - Founding Partner, Kalamaras Law Office, LLC. US**

Stacey is the founding partner of Kalamaras Law Office LLC, an IP boutique providing full-service brand protection services to SMEs. Stacey spent most of her career in Big Law representing well-known brands in over 150 countries. Prior to law school, she worked as a marketing and advertising executive. Stacey is a devoted trainer of other lawyers, having trained more than 6,500 on brand protection topics since 2018.

**Barbara Leitao-Johnson - Associate General Counsel, Intellectual Property, IABBB. Latin America/USA**

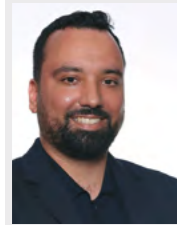
Barbara is a US based Brazilian Trademark Lawyer, having worked in several large Brazilian IP offices. With an LL.M. from George Washington University, DC, and after working at the IP protection areas of Facebook Reality Labs and Corsearch, she is currently taking the position of Associate General Counsel for IP at the International Association of Better Business Bureaus.

**Rachael Lodge Corrie - Partner, FOGA DALEY. Jamaica**

Rachael Lodge Corrie is a Partner of Foga Daley with a passion for Intellectual Property law, focused on brand portfolio management, trademark prosecution, non-routine trademark matters and advertising law. She is an active member of the Jamaican Bar Association, INTA's Right of Publicity Committee and a member of the Women's IP Today Steering Committee.

**Yasir Masood - IP Manager, Rouse & Co. Dubai**

Originally from Germany, Yasir moved to Dubai in 2016 and spent several years with an international IP firm before joining Rouse in 2023. Specializing in trademark law, he advises diverse clients across the UAE and MENA region. His expertise includes trademark portfolio management, filing strategies, and prosecution. As an active member of INTA and other professional organizations, Yasir stays ahead of IP trends and best practices.

**Chris Mitchell - Member, Dickinson Wright. US**

Chris Mitchell, a member of Dickinson Wright, has practiced exclusively in the area of intellectual property law for over 25 years, handling trademark matters - from procurement to licensing and litigation - for clients throughout the world.

**Santiago R. O'Connor - Managing Partner, O'Connor & Power. Argentina**

Santiago is an attorney and trademark and patent agent advising domestic and foreign companies on local and international IP law in Argentina and across Latin America with extensive experience. He is the managing partner at O'Connor & Power in Buenos Aires, Argentina.

**Peter Sloane - Partner & Co-Chair of the Trademark and Copyright Practice, Leason Ellis LLP. US**

Peter Sloane is Partner and Co-Chair of the Trademark and Copyright Practice at Leason Ellis LLP, an IP boutique law firm in White Plains, New York. His practice includes trademark prosecution, U.S. and international, and federal court litigation.

**Charlotte Wilding - Partner, Keltie LLP. UK**

Charlotte Wilding is a partner of the trademark practice at Keltie LLP. An expert in her field, she specializes in providing strategic IP advice, as well as the prosecution, maintenance, and enforcement of IP rights. Charlotte is also an active member of the International Trademark Association's Publication Committee.

**Beata Wojtkowska - Partner, Kulikowska & Kulikowski. Poland**

Beata is a practice-oriented IP specialist, focused on Client's needs. Beata's key areas of activity are trademarks, trade names, geographical indications, combating unfair competition, and managing disputes.



2024 in Review

As we enter a new year, we asked our Editorial Board to share their insights on the key takeaways from 2024 that will shape important developments in IP practice for 2025 and beyond.

These overviews highlight significant developments in intellectual property law across various jurisdictions:

China's trademark legal services industry is being transformed by the rise of digital intelligence, improving efficiency and accuracy while presenting new business opportunities. India has also experienced notable trademark advancements, particularly with the establishment of dedicated IP benches in its High Courts. Meanwhile, the Italian PTO is providing renewed financial support to small and medium-sized enterprises SMEs by offering reimbursements of up to €25,000 for those who registered EU and IR trademarks in the past three years.

Jamaica's trademark practice is adapting to the implications of the Trade Marks (Amendment) Rules, 2022. In Poland, the Patent Office has ruled that plant-based meat substitutes are akin to traditional meat products, which suggests a trend toward a more inclusive approach to plant-based terminology in food products.

The UAE is enhancing trademark protection and administrative processes, including upgrades to the Trade Mark Office's online services and the introduction of a National Economic Registry. In the UK, recent challenges include rising counterfeit sales alongside the enactment of the DMCC Bill. Additionally, the UK IPO has issued Tribunal Practice Notice 1/2024, imposing stricter guidelines on the clarity and relevance of specification restrictions in trademark applications.

In the US, the USPTO has announced a new rule aimed at strengthening its post-registration audit program to address issues related to digitally altered specimens and specimen farms. The ongoing legal battle over the trademark application for "TRUMP TOO SMALL" has brought attention to the USPTO's refusal based on the Lanham Act's consent requirement, which was ultimately upheld by the Supreme Court, clarifying the balance between trademark rights and free speech. Finally, the US Supreme Court case *Dewberry Group Inc. v. Dewberry Engineers Inc.* will address whether a trademark infringement award can include profits from non-party corporate affiliates.

We would like to take this opportunity to thank our Editorial Board for their continued support and hard work throughout the year. Please visit page 6 to familiarize yourself with each member's profile.

If you would like to learn more about our Editorial Board or apply for 2026, please visit www.trademarklawyer-magazine.com/editorial-board-applications

A review from China

Gang Hu, China Patent Agent (H.K.) Ltd.

In 2024, the world is facing greater challenges and uncertainties. But life and work still need to continue. As the French writer Alexandre Dumas said, all human wisdom is contained in two words: waiting and hope. During this year, a noteworthy trend in China is that the impact of digital intelligence on trademark legal services has attracted wider attention within the industry. The so-called digital intelligence refers to the ability to use digital technology and data-driven methods to achieve intelligence, automation, and optimized decision-making. It combines technologies such as artificial intelligence, big data analysis, and machine learning to provide deeper insights and intelligent decision support for enterprises through the collection, organization, and analysis of large amounts of data. On the one hand, the application of digital intelligence has replaced many basic tasks in the trademark legal services industry, reducing human errors and improving efficiency. On the other hand, the wave of digital intelligence has also brought new formats, scenarios, and technologies to the trademark legal services industry. These matters have profoundly changed the traditional industry landscape. For example, to improve the efficiency and accuracy of trademark similarity comparison and analysis by applying new technologies such as artificial intelligence and big data; to use the tamper-proof nature of blockchain technology to track and fix evidence of trademark and copyright infringement more effectively on the Internet; to provide customers with market trend analysis and brand strategy planning services through big data analysis. It can be said that in the era of digital intelligence, the emergence of new formats and scenarios has provided more business opportunities and development space for China's trademark legal service industry. At the same time, it also urges trademark practitioners to continuously learn and master new technologies in order to actively adapt to the development needs of the industry.





A review from India

Misum Hossain, Lincoln Legal Chambers

2024 has been an exciting year with many trademark developments like dedicated IP benches in High Courts, new rules, judges exploring AI challenges and courts recognising well-known marks to ensure traditional brands are not thwarted.

IP bench was set up in Calcutta High Court making it the third court after Delhi and Madras. A key step for efficiency in dispute resolution was taken with the introduction of Trade Marks Rules 2024. Delhi High Court passed a direction for formation of a Code of Conduct for trademark agents.

2024 saw the first of its kind case involving AI for voice cloning in which Bombay High Court restrained parties from violating personality rights of Bollywood singer Arijit Singh.

Bombay High Court also made a key ruling on deceptive similarity in pharmaceuticals by declaring that marks which are structurally and phonetically similar to a registered mark could not be registered for drugs that treat the same ailment but have different composition.

Madras High Court held that pharmaceutical marks require lesser degree of confusion and hence the onus to prove is more on the party arguing honest adoption of a mark.

Elon Musk's EV maker Tesla pursued a case in Delhi to seek injunction against Tesla Power India Pvt. Ltd.

2024 also witnessed an intriguing case as one of Netflix's most watched TV series, Squid Game, was taken to court in New York by Indian filmmaker Soham Shah with a claim that the survival thriller was plagiarised from his Hindi film Luck which narrated a story of a group of people in debt competing in lethal games for money.

Amul, India's most popular dairy brand created in 1946, sought legal action in Delhi where they challenged the use of Amul by a defendant in pharmaceuticals. The Court declared that Amul deserved broader protection transcending all classes.

2024 also saw Courts in India recognise various popular business marks as well-known marks including Boroline and Haldiram among others. This year some global brands like Adidas, Puma, and Lacoste also managed to secure trademark wins in Indian courts.

India's focus is on creating a vigorous IP ecosystem that will not only foster IP growth among Indian brands but also signify a secure jurisdiction for global brands wanting to venture into one of the world's largest economies.

A review from Italy

Francesco Bonini, R K Dewan & Co.

The Italian PTO has issued a renewed financial support for SMEs that have registered their EU and IR trademarks in the last three years.

Economic support (reimbursement) is granted for the expenses related to said two kinds of registrations only and it is issued yearly.

This year the budget is of €2 million (Euro) and each Italian SME can obtain a maximum of €25,000 reimbursement.

An SME can claim up to 80% and 90% of EUIPO and WIPO official fees; interesting amounts can be obtained for search expenses and for attorney fees when facing oppositions or office actions.

There are cap limits of reimbursement per trademark and the overall limit of €25,000 per enterprise. However, this measure is a good help for the SMEs committed to export and to protect their brands by trademark registrations with EU TM or IRs.

Notably, this year the reimbursement percentage of EUIPO and WIPO official fees has increased to 85% and 95% respectively, for those SMEs showing gender parity certification.

A review from Jamaica

Rachael Lodge Corrie, Foga Daley

The past year has brought numerous changes to the Jamaican trademark practice. September 30th marked one year since the Trade Marks (Amendment) Rules, 2022 came into effect, also marking one year of Madrid Protocol in Jamaica.

Unsurprisingly, Jamaica has seen an influx of applications through Madrid, however very few applications with Jamaica as the Office of Origin. The amended Rules require a local agent to respond to any objections or oppositions, in an effort to maintain the integrity of the Register.

Last year, we noted that despite signing on to Madrid, Jamaica remains a top choice for stealth filings. A year later, this statement still rings true. Effective March 1, 2024, the Jamaica Intellectual Property Office (JIPO) launched a new search platform which restricts access to pending applications. New Applicants in Jamaica that are desirous of conducting a trademark clearance search should therefore bear this in mind. While a search will reveal published and registered marks, it will not reveal earlier pending and unpublished applications. As such, it is possible that when conducting a clearance search, an identical or similar mark, which may operate as a bar to an Applicant's proposed mark is omitted from the search results.

This year also brought exciting developments for Geographical Indications (GIs). On October 2nd, JIPO issued a ruling on a four-year battle over the GI for "Jamaica Rum".

JIPO's decision makes it clear that to be designated as "Jamaica Rum", ageing must be carried out in Jamaica, using specific barrels and water from limited geographical zones. The JIPO Tribunal amended the Register to read "Ageing shall be carried out *only* in Jamaica". The Applicant, National Rums of Jamaica, was in the practice of distilling a significant portion of its rum in Jamaica, and then ageing it outside of the country. JIPO therefore found this to be a violation of the registered GI.

However, this battle is far from over, as an appeal has already been submitted to the Supreme Court. We therefore continue to track the matter as it progresses.

A review from Poland

Beata Wojtkowska, Kulikowska & Kulikowski

In 2024, CJEU was not the only official body to address the issue of products such as soy cutlets, plant-based sausages, or vegetarian meatballs.

While CJEU ruled that Member States could not impose a general prohibition on the use of terms traditionally associated with animal products to designate products containing plant protein, the Polish Patent Office (PPO) was tasked with deciding on similarity of plant-based substitutes to meat or products containing meat. This issue arose in the context of opposition proceedings in which Applicant, already an owner of trademarks registered for processed vegetable products, had intended its mark specifically to designate plant-based meat alternatives, against which Opponent cited its own trademark, which designates meat and meat products.

In its decision of 27/09/2024, PPO analyzed whether the public might consider the two categories of products similar.

Though Applicant submitted an expert report showing differences in raw materials and production technology to prove that plant-based substitutes are a food group separate from meat, in PPO's view other factors were decisive. PPO indicated that the public can buy a wide range of vegetarian sausages, steaks, meatballs, gyros, burgers, pork chops—typical products known from meat sector, which both look like and have names typical of meat or meat-based products. Aiming to offer the consumer the experience of eating meat, they use seasoning and spices that mimic the flavors of meat dishes and their texture. They are seen as complementary to meat products, they compete on the same market and satisfy the same consumer needs.

On this basis PPO found that plant-based meat substitutes were goods competing with meat-based products and those two groups were similar.

Although, as of the date of writing this review, the decision is not yet final, given global trends, the popularity of plant-based meat alternatives and the practice of EU bodies to date, it is probably fair to assume that this is the direction in which case law will develop.

Co-authored by Karolina Szafarowicz of Kulikowska & Kulikowski.



A review from the UAE

Yasir Masood, Rouse & Co.

As we close the year, the UAE continues to make substantial strides in enhancing its trademark protection and administrative procedures, underscoring the country's commitment to a robust intellectual property framework.

The Trade Mark Office (TMO) is actively developing an improved online portal designed to streamline trademark services. Expected features include a more user-friendly interface, simplified Power of Attorney requirements, multi-class filing activation, and bilingual trademark certificates. Additionally, the TMO aims to shorten the examination timeframe from 90 days to 30, potentially offering a fast-track option for urgent applications. Further anticipated updates include possible daily publication of accepted applications, enhanced search options, an e-wallet for seamless payments and a fully automated online process for handling oppositions and appeals. A trial period will likely be implemented to gather feedback from users before the official upgrade.

Another positive development is the launch of the National Economic Registry, "Growth." This unified database allows for comprehensive company and trade license searches in a single location, improving on previous systems that required searching multiple separate databases.

With the implementation of the new Trade Mark Law in 2022, responsibility for handling trade mark cancellation cases has shifted to administrative actions filed initially with the Trade Mark Office (TMO). Grounds for cancellation include prior use – which reaffirms the UAE's status as a first-to-use jurisdiction – bad faith, non-use, or wrongful registration. However, the TMO has temporarily paused these cases pending the formation of a dedicated committee. The timeline for establishing this committee and its relationship to the existing Grievance Committee remain unclear.

These updates showcase the UAE's proactive efforts to refine its trademark system, making it more supportive for rights holders. Looking ahead, it is evident that the UAE is dedicated to raising the standard for intellectual property protection across the region.

A review from the UK

Lindsey Annable, Potter Clarkson

2024 saw interesting brand protection developments in the UK. The Digital Markets, Competition and Consumers (DMCC) Bill became an Act of Parliament in May, with the Department for Business and Trade announcing in September its plan for the next 18 months. The Act will focus on regulating digital markets, strengthening enforcement and protecting consumers. The Competition and Markets Authority (CMA) will be able to issue greater financial penalties to combat infringements.

The Government also addressed the sale of counterfeit car parts. Fake tyres, wheels, brakes and airbags were the most common infringements of this type in 2024 according to the Intellectual Property Office (IPO). A survey of 1,394 motorists investigated consumer behaviour, with 14% admitting to buying fake airbags and 12% purchasing counterfeit brake pads. 31% stated that cost considerations lead to them buying fake parts. These figures emphasise the need for brand protection to ensure public safety.

The IPO, City of London Police and Border Force reported that the UEFA Euros increased the volume of counterfeit football merchandise in the UK. Fake football apparel worth an estimated loss to industry of £98,300 were seized by police leading up to and during the semi-finals. Border Force also seized goods at an estimated loss of £348,381. Counterfeit merchandise is often poor quality, and its production has links to further criminal enterprises.

The use of AI by counterfeiters also continued. AI is used for deepfakes, to forge documents, produce fake currency, and create replicas of genuine products. Machine Learning (ML) is being used by brand protection providers to detect infringing activity. ML algorithms identify inconsistencies in digital content, locating infringements which counterfeiters attempt to conceal.

Looking forward to 2025, developments in the DMCC Act are expected in January and April. The use of AI by brand protection providers to combat counterfeiting will potentially progress even further, and the risk to public safety posed by fake goods will continue to be addressed by the IPO, Border Force and Police. As counterfeiting evolves, so too do the methods used by brand protection professionals to fight against infringing activity.

A review from the UK

Charlotte Wilding, Keltie

On 17 July 2024, the UK IPO published "Tribunal Practice Notice 1/2024: Restricting specifications of applications and registrations subject to Tribunal proceedings" ("TPN"), setting out the position on restricting specifications of UK trademark applications and registrations subject to Tribunal proceedings (albeit that it is likely in practice that the TPN will apply to any restriction of specification). This was implemented with immediate effect, and we have seen a number of rejections for specification limitations that would previously have been accepted.

The UK IPO's concern here is that specification restrictions are not always clear and precise and, in some cases, may not be relevant to the specification being restricted.

Accordingly, the TPN sets out that restrictions must:

- 1) Be clear and precise;
- 2) Not identify a characteristic of goods/services;
- 3) Make sense within the context of the specification.

The popular amendment "none of the aforesaid goods/services being related to ..." is no longer considered clear or precise. Instead, the focus appears to be more on what is intended to be protected by the trademark specification, rather than what is excluded.

The TPN also notes that a specification restriction may not always be relevant and that alternative ways of settlement should be considered, such as a co-existence agreement. Whilst this should be considered, it is not always the outcome that the parties want or need. In many cases, a simple specification restriction has been sufficient to settle matters. This may well become harder to achieve.

Should a refusal notice be issued, the TPN confirms that a further response may be necessary. Should the discussions with the UK IPO be too lengthy, an *ex parte* hearing may be convened. The TPN also confirms that proceedings may be suspended pending the outcome of the specification restriction.

Given the new complexities surrounding specification restrictions, we recommend seeking professional advice in order to reduce the risk of refusal by the UK IPO.

A review from the US

Stacey C. Kalamaras,
Kalamaras Law Office

On October 28, 2024, the USPTO announced a new rule for how it will conduct post-registration audits. In January 2017, the post-registration random audit program came into effect for trademark registrants filing Section 8 or Section 71 Declarations of Continued Use. The purpose of the audit program is to maintain the integrity of the USPTO register. The audit program applied to one-class applications with four or more listed goods/services or two or more classes that contain two or more listed goods/services in the registration.

Since that rule was enacted, there has been a rise in digitally altered specimens, which has led to an amendment to the TMEP and the Trademark Rules. The Trademark Modernization Act of 2020 added two new post-registration proceedings that allow the USPTO to examine whether a registered mark is, or was at the time of registration, in use in commerce for goods or services covered by the registration. New discoveries have led to what the USPTO calls the "disturbing discovery" of specimen farms, websites that do not sell any goods or services, but whose primary purpose is to provide trademark registrants with documents to submit to the USPTO that appear to satisfy their continued use requirements.

With this latest change, the USPTO is strengthening the audit program to maintain the integrity of the USPTO register. An audit can be directed by the USPTO if "certain attributes that call into question whether a mark is in use in commerce in the ordinary course of trade," including altered specimens, the use of a specimen farm, or any other activity that does not conform with the Trademark Rules of Practice. The random audit program will still be in place. To avoid a random audit, registrants should submit a specimen for each and every listed good/service in its registration to delete the goods/services not in use in the US. Failure to do so at the time you submit the declaration not only has financial penalties, but also could result in the registration being cancelled.



A review from the US

Chris Mitchell, Dickinson Wright

In 2018, Steve Elster filed to register the mark TRUMP TOO SMALL for certain clothing items. The USPTO refused registration in view of Section 2(c) of the Lanham Act (or, if you prefer the alternative ego, Section 1052(c) of the Trademark Act), which prohibits registration of marks that consist or comprise a “name, portrait, or signature identifying a particular living individual” unless the applicant has the individual’s written consent. A “particular living individual” in this context is someone either “so well known that the public would reasonably assume a connection between the person and the goods or services” or “publicly connected with the business in which the mark is used.” In *re Nieves & Nieves LLC*, 113 USPQ2d 1639, 1650 (TTAB 2015). Here, that was Donald J. Trump, the US president at the time (and whose consent Elster didn’t have). Elster argued to no avail before the USPTO that the mark constituted “core political speech” under the First Amendment to the US Constitution and that this right “trumps” (pun intended) the prohibitions of the Lanham Act. A two-year administrative appeal yielded affirmation of the examining attorney’s refusal to register, after which Elster appealed to the Court of Appeals for the Federal Circuit. In a thoughtfully-reasoned opinion, the appeals court struck down Section 2(c)’s “consent” requirement, at least insofar as politicians and public figures are concerned, on the grounds that no justification for the statutory section could survive any applicable legal analysis for government prohibitions on free speech. *In re Elster*, 26 F.4th 1328 (Fed. Cir. 2022). The prohibition was held to be an unjustified content-based restriction on speech.

The USPTO appealed to the US Supreme Court. In another thoughtful opinion, the Supreme Court reversed the Federal Circuit and upheld the Lanham Act provision. *Vidal v. Ester*, 602 US 286 (2024). Though finding trademark law implicates “speech” that is content-based in nature, and as such is at least presumptively subject to heightened scrutiny, the Court declined such analysis and concluded that the content-based prohibitions of Section 2(c) did not violate the First Amendment.

The *Elster* decisions in the Supreme Court and the Federal Circuit are worth reading for those curious about the intersection between trademark rights and free speech in the US. And I commend them to anyone with a client looking to sell TRUMP-branded goods in the next four years!

A review from the US

Peter Sloane, Leason Ellis LLP

The trademark lawyer’s case to watch in 2025 is *Dewberry Group Inc. v. Dewberry Engineers Inc.*, Case Number 23-900, in which the US Supreme Court will decide whether an award of the “defendant’s profits” under the US Trademark Act can include an order requiring the defendant to disgorge the profits of its non-party corporate affiliates. In *Dewberry*, the Fourth Circuit Court of Appeals affirmed a decision of the district court finding defendant to be a trademark infringer and ordering it to disgorge nearly \$43 million damages in profits attributable to the infringement. The parties disagreed about which revenues belonged in the damages calculation. Defendant argued that its corporate structure was such that all the profits using the infringing branding were made by its affiliates, which were not named as defendants. Plaintiff argued that plaintiff could not so easily evade damages because it structured its business so that it promoted, managed, and operated all of the properties owned by the infringing affiliates. Persuaded by plaintiff’s position, the district court treated defendant and its affiliates as a single corporate entity for the purpose of calculating revenues subject to damages. A split decision of the Fourth Circuit affirmed the award and the Supreme Court granted certiorari.

In an amicus brief filed with the Supreme Court, the International Trademark Association took the position that the text of the Trademark Act does not support the Fourth Circuit’s disgorgement award. It argued that the unambiguous text of the Act provides that a plaintiff is entitled to recover a disgorgement of “defendant’s profits.” It noted that, as the dissent in the Fourth Circuit decision recognized, there are other ways that could have respected corporate formalities and still have reached defendant’s affiliates including (i) the possibility of obtaining attorneys’ fees as an exceptional case if the corporate structuring was undertaken in bad faith, (ii) naming the affiliate entities as co-defendants, and (iii) piercing the corporate veil. The brief warned that to uphold the appellate decision would undermine the bedrock rule of corporate separateness and contravene the purpose of corporate insulation from liability.

Arguments are scheduled for the Court’s 2024-2025 term.

Mindful trademarking can prevent registration headaches

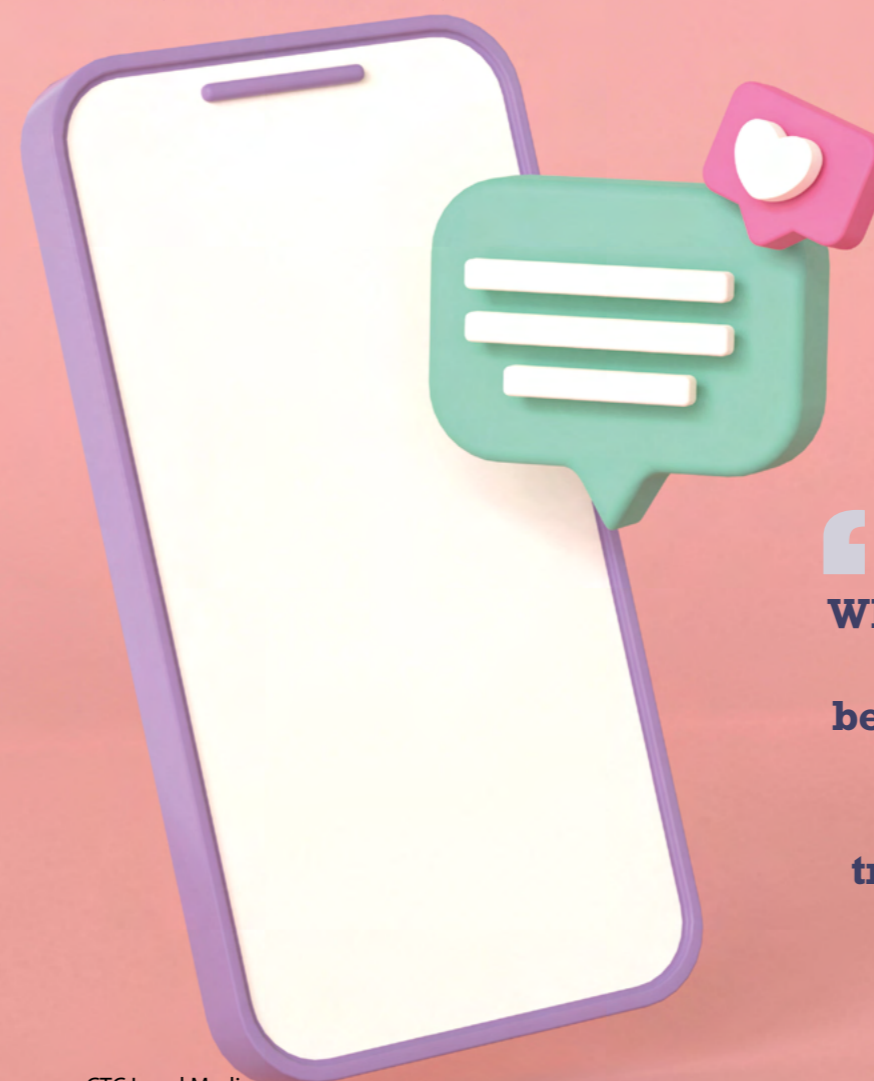
Nicholas Holmes of Caldwell discusses the importance of filing for protection quickly in the world of social media due to the speed at which trends can become popular and the risk this runs for content creators when trademark applications are reviewed on a “first to file” basis by the USPTO.

With the widespread use of social media in today’s modern age, internet personalities can go from unknown to widely popular in a matter of days, simply for “starting” a new trend and reaching the millions

of screens used daily. While it is nearly impossible to know when a trend will become popular, it is always good practice to consider how best to protect these trends from the perspective of the trendsetter.

In the United States (US), trademark rights generally belong to the first user of a mark. However, at the United States Patent and Trademark Office (USPTO), trademark applications are reviewed on a “first to file” basis, meaning an individual who files a trademark application receives a filing date, and this filing date is put into a queue for examination by a Trademark Examiner. Unfortunately, situations arise where the first individual to file is not the rightful owner of the applied-for trademark and was not the first person to use the mark. This is the crux of the issue presented below.

“While it is nearly impossible to know when a trend will become popular, it is always good practice to consider how best to protect these trends from the perspective of the trendsetter.”





Résumé

Nicholas Holmes is the Director of Trademarks at Caldwell. His practice focuses on developing, defending, and enforcing domestic and foreign trademark portfolios with an eye toward monetization. He has provided advice to companies in a variety of industries, including Digital Media and Entertainment, Cleantech, Consumer Technologies, Retail, and Games. Nicholas understands that the impact of a brand does not begin and end with just a trademark registration and provides a comprehensive analysis of a client's IP portfolio and how to position them for success.



Nicholas Holmes

Enter Jools Lebron, a TikTok creator who coined the now-famous slogan "very demure...very mindful." This slogan is used to describe how to act in various situations, from going on a date to participating in a job interview. While slogans on their own cannot be trademark protected, if the slogan is associated with goods and/or services (acting as a source identifier and thus a trademark), then it is trademark eligible. Examples of slogans are "We are Farmers" for insurance and "The Power to Do More" for computers and hardware. Unfortunately for Lebron, trademark protection was not at the top of her mind, and she did not take any steps to protect her slogan, such as filing a trademark application.

The first-to-file examination process at the USPTO has its drawbacks, such as the ability for squatters to file trademark applications for marks they do not use but know have become popular. Jefferson Bates filed a trademark application for VERY DEMURE, VERY MINDFUL in connection with "Advertising, marketing and promotional services related to all industries for the purpose of facilitating networking and socializing opportunities for business purposes." As discussed above, Bates now has a filing date for his application, which means his application would be examined first and could bar registration of Lebron's application if she were to file one in connection with the slogan she popularized. As discussed below in further detail, simply having this filing date can and will cause Lebron financial and administrative headaches.

When filing a trademark application, there are two options: (1) use-based applications, meaning the mark being applied-for is already being used in the regular course of business, and (2) intent-to-use, meaning the mark being applied-for has not yet been used in the regular course of business, but the Applicant has the *bona fide*

intention to do so. For intent-to-use applications, if the mark is allowed, the Applicant will need to prove they are using the mark in connection with the goods and/or services they applied for, or the mark will be abandoned.

Based on Bates' history of trademark filings, it is very likely he filed this application for the purpose of holding the slogan "hostage" to effectuate a settlement deal with Lebron and profit off the filing. Lebron has several remedies to either gain control of the trademark application or to remove the trademark application from the USPTO entirely.

As an initial matter, Bates' application will first be examined by a Trademark Examiner and will either be approved or issued an office action. An office action will explain to the Applicant why the application has been rejected and provide options for remedying the issues raised. It is not a guarantee, however, that the application will be allowed if an office action is issued. If the application does not overcome the office action, then the mark will be abandoned and no longer bar Lebron from potentially receiving a trademark registration.

However, if the mark is allowed, the first option for preventing the mark from moving forward to the next step in the registration process is filing a "Notice of Opposition" with the USPTO's administrative board, the Trademark Trial and Appeals Board (TTAB). During the Opposition period, which lasts 30 days from the date of publication, any individual or company who believes they will be "harmed" by the mark registering can file a Notice of Opposition with the TTAB. A Notice of Opposition is an administrative proceeding where the Opposer presents evidence and arguments as to why the application should not be allowed to proceed to registration.

Lebron's best arguments are that (1) she has priority in the mark and thus has earlier trademark rights than Bates (who has yet to use the mark), and (2) Bates' application was fraudulent.

Even though Lebron has yet to file a trademark application with the USPTO, she can argue that she has "priority" in the mark. As discussed above, the first-to-use trademark system in the US can prevent a trademark application from registering if the Applicant's usage of the mark is proved to have been later than the Opposer's usage of the mark. Lebron claims that she has used the slogan in connection with advertising and marketing material. If she can prove that this claim is true, then she would indeed have priority over Bates, who has not yet used the mark.

Secondly, Lebron could claim that the trademark application submitted by Bates was fraudulent and should be void. Bates' trademark application was filed as intent-to-use, which means Bates signed, under the penalty of perjury and fraud,

“For intent-to-use applications, if the mark is allowed, the Applicant will need to prove they are using the mark in connection with the goods and/or services they applied for, or the mark will be abandoned.”



that he had a *bona fide* intent to use the mark at the time the trademark application was filed. Bates has a history of filings that appear to be fraudulent, and thus, Lebron has a strong argument on this ground.

A third option, which is outside the scope of TTAB, is to initiate settlement discussions with Bates and attempt to secure rights in Bates' trademark application. It is assumed that Bates would require compensation for this to occur, and likely at an inflated price point. This scenario occurred when Tiger Woods' new company, "Sunday Red," purchased the SUNDAY RED trademark from the rights holder and assigned the mark to Woods' new company.

If Bates' trademark application is allowed by the Trademark Examiner, Lebron will, unfortunately, need to spend time, resources, and energy in preventing the mark from registering, even though she was the first to use the mark. Trademark opposition proceedings can take upwards of one to two years to complete and can cost tens of thousands of dollars. Further, there is no guarantee Lebron's opposition would be successful, even though the arguments are biased towards her.

For most businesses and individuals, it is sometimes impossible to know when a slogan

“What could have been a \$250 trademark application has now turned into a potentially costly and time-consuming headache.”



or product can become a worldwide trend popularized by social media. However, what could have been a \$250 trademark application has now turned into a potentially costly and time-consuming headache. In the world of intellectual property and social media, you can never be too cautious or too quick in filing for protection.

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China: why we appeal after prevailing in cancellation proceedings

Bo Li, Director of the Domestic Trademark Department of CCPIT Patent and Trademark Law Office, examines the complexities of trademark cancellation litigation in China, highlighting the author's decision to appeal a specific determination, and emphasizes the importance of formally voicing dissatisfaction with all aspects of a ruling to preserve the right to appeal.

Recently, in a cancellation proceeding represented by the author, we alleged that the registration of the disputed trademark violated the provisions of Article 19 of the China Trademark Law, "a trademark agency shall not apply for registration of other marks than those necessary for its agent service," and fell within the illegal behaviors of "... obtaining registration by other improper manners" as provided in the first paragraph of Article 44 of the China Trademark Law. The China National Intellectual Property Administration (hereinafter referred to as "the CNIPA") supported the cause under the first paragraph of Article 44 in its decision, declaring the disputed trademark being canceled, but did not support the cause under Article 19. In this situation, it is natural for the owner of the disputed mark to initiate an administrative action in the hope of overturning the cancellation decision. However, as the prevailing



Bo Li

party, we still filed a separate administrative action against the seemingly favorable decision, requesting for denial of the wrong determination with respect to Article 19 of the Trademark Law. The question arises: is it necessary for the prevailing party to appeal for the cause(s) that was not supported?

It can be attributed to the specific nature of the trademark prosecution, opposition, or cancellation litigation. These types of litigation cases usually take the CNIPA as the defendant because of dissatisfaction with the decisions made by the CNIPA. Under the current legal framework, they are classified as administrative litigation. Article 87 of the Administrative Procedure Law of the People's Republic of China stipulates that the People's Court shall conduct a comprehensive review of the litigation case being appealed, reviewing all the causes raised in the verdict of the previous instance. This is called the Principle of Comprehensive Review in administrative litigation. However, trademark opposition or cancellation litigation is more of a kind of dispute between the civil parties, while the CNIPA's role is approximating a judicial adjudicator rather than an administrative authority. Therefore, this type of litigation is not utterly administrative. Considering the private nature of the trademark rights, the People's Court usually limits its review to the plaintiff's claims in accordance with the Civil Procedure Law for heightened judicial efficiency. The second article of the Provisions of the Supreme People's Court on Several Issues Concerning the Trial of Administrative Litigation Involving Trademark Prosecution, Opposition,

or Cancellation, which came into effect on March 1, 2017, provided, "the people's court shall, in principle, limit its review to the plaintiff's claims and grounds when it reviews a trademark prosecution, opposition or cancellation litigation. If the CNIPA's decision involves any material mistaken findings or holdings other than what the plaintiff contests, the people's court may adjudicate on those after hearing all the parties' arguments." According to this judicial interpretation when the court is reviewing a trademark prosecution, opposition, or cancellation dispute, it is subject to the principle of "no trial without complaint". The exception is that when there is any obviously untenable finding in the administrative decision, the court may adjudicate on the issues out of the plaintiff's claims after fulfilling the hearing procedure.

Regarding the litigation at issue, although we prevailed in the administrative proceeding, we were not satisfied with the determination of Article 19 of the Trademark Law. If we did not file an action against the decision but merely participated as the third party in the administrative lawsuit filed by the opponent against the first paragraph of Article 44 of the Trademark Law, the court would have likely limited its review to the plaintiff's pleading on the first paragraph of Article 44 and refused to recall the issue related to Article 19. We had experienced a similar situation in the other case before, where the judge asked us to contest what we were dissatisfied with in the administrative decision by launching a lawsuit separately. If the first instance court supported the opponent's pleading and reversed the decision restoring the validity of the disputed trademark, is it still possible for us to appeal Article 19 to the second instance court? According to the Administrative Procedure Law, when the appeal court hears an appeal case, it only conducts a comprehensive review of the trial court's verdict. Without involving Article 19 in the first instance judgment, we would have little chance to reclaim that in the second instance. How can this dilemma be resolved? Plausible advice is that the third party should assert its dissatisfaction with any findings of the decision, at least in brief, in the first instance, showing it does not forfeit its right to appeal. This might save the possibility of reclaiming what the plaintiff did not contest in the second instance. However, this approach seems to lack a solid legal basis, resulting in uncertainty. In the litigation at issue, we were able to accept anything but failing the cancellation. To diminish the risk to the lowest extent, we decided to take an unusual approach, that is, filing an action against the unsupported ground despite a favorable conclusion of the cancellation. We believed that the cause under Article 19 was more justified than the first paragraph of Article 44 in this case.

“ Considering the private nature of the trademark rights, the People's Court usually limits its review to the plaintiff's claims in accordance with the Civil Procedure Law for heightened judicial efficiency. ”

As such, the first instance court received two complaints from both parties against the same cancellation decision. One party asserted to negate the determination in Article 19 while affirming the determination in the first paragraph of Article 44, whereas the other party held the opposite, though both claimed to revoke the decision. So, how should the court make a judgment? Finally, the court dismissed the trademark owner's complaint by finding the decision tenable in the first paragraph of Article 44. As for the lawsuit, we filed as the requesting party of the cancellation, the court concluded that the disputed trademark fell under the circumstances as defined in the fourth paragraph of Article 19, and the defendant, the CNIPA, had made a wrong finding at this issue that needed to be vacated. At the same time, it affirmed the CNIPA's holding regarding the first paragraph of Article 44. On such a basis, the court ruled, "part of the findings of the decision is unjustified and should be overruled. The plaintiff's pleadings are affirmatively established. But in view of the disputed mark being declared canceled appropriately, the sued decision is ratified while pointing out its mistakes in order to avoid waste of administrative and judicial resources and settle the dispute sooner." In the end, the court also dismissed our complaint and burdened us with litigation costs. We achieved our goal of prevailing on two grounds, though we appeared to have failed the suit.

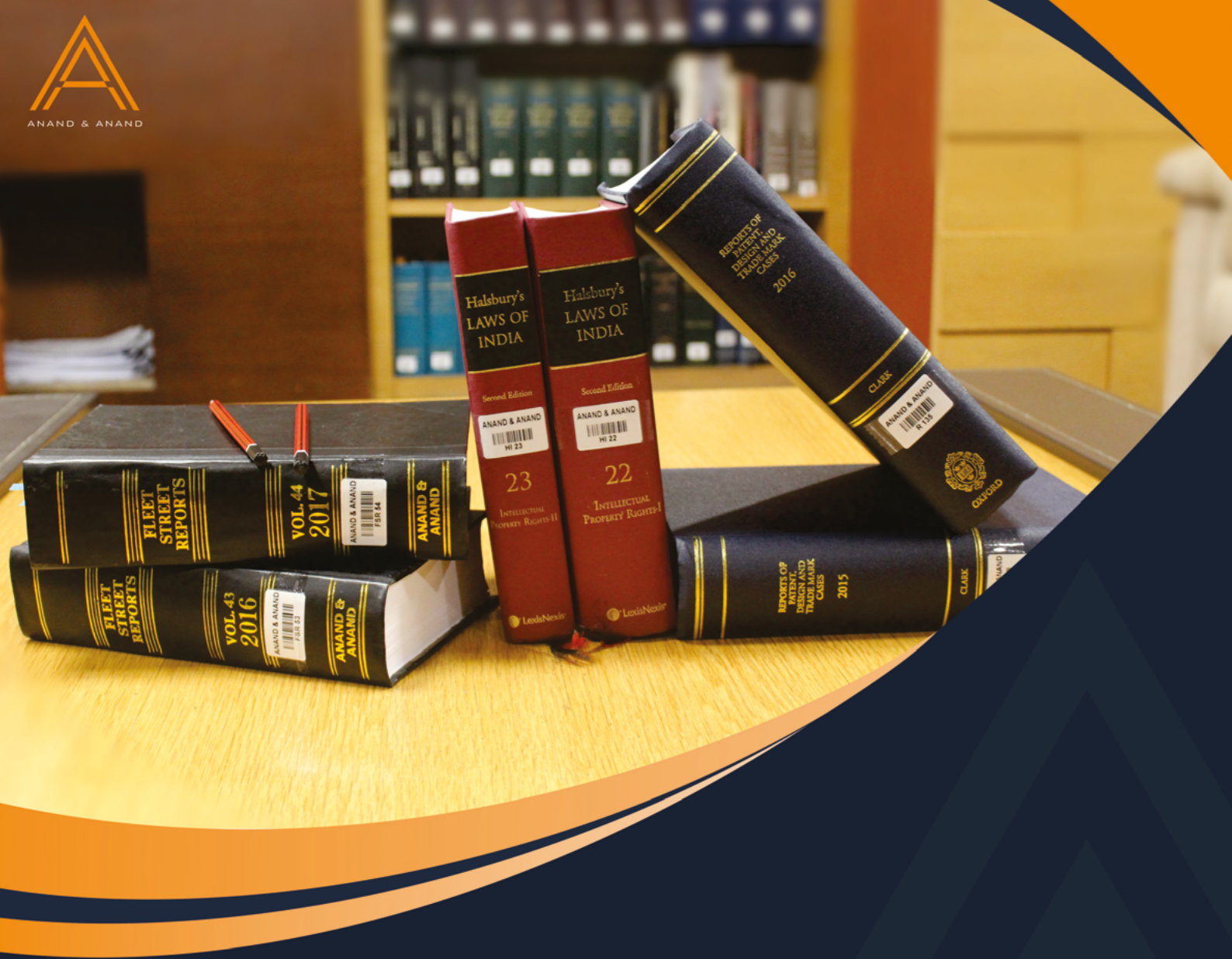
In the end, due to the specific nature of the administrative litigation involving trademark prosecution, opposition, or cancellation, they are influenced by both the principle of no trial without complaint as outlined by the Civil Procedure Law and the principle of comprehensive review as outlined by the Administrative Procedure Law. For those where the outcome must be guaranteed, we suggest appealing the adverse determinations or findings to assure a judicial review. In terms of legislation, we suggest permitting the third party to make counterclaims on the dissatisfied parts of the decision for the court's review instead of resorting to a separate action, as a result reducing unnecessary parallel litigation suits.

Résumé

Bo Li has been the director of the domestic trademark department of CCPIT Patent and Trademark Law Office since 2016, which has been rated a top-tiered market leader in China by Chambers, MIP, and others for decades. He has been engaged in trademark filing, prosecution, as well as *ex parte* and *inter partes* proceedings before the CNIPA and courts, and is often asked to work on commercially sensitive cases for very high profile companies. He advises clients on a national and international basis, helping make prospective and comprehensive strategies, protecting their brands, and offering a wide range of bespoke and effective services to enhance their IP assets.

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ANI v. OpenAI: a legal dispute over copyright, AI training, and false attribution

Pravin Anand and Vaishali Mittal of Anand and Anand details the recent legal dispute between Asian News International and OpenAI, examining whether using publicly available data to train large language models constitutes copyright infringement.

ANAND AND ANAND

PRACTICE AREAS

- Patents | Litigation and Dispute Resolution | Trademarks | Designs
- Art and Antiquities | Competition | Antitrust | Compliance | Regulatory
- Plant Variety | Biodiversity | Contractual and Commercial IP | Copyrights
- IT law and Domain name disputes | Sports law | Fashion and Luxury law
- Media and Entertainment law | Licensing and Franchising | Advertising law
- Anti-Counterfeiting | Criminal law | Customs and Border Enforcement

On November 19, 2024, Asian News International (ANI), a prominent Indian news agency, filed a significant lawsuit against OpenAI, the creators of ChatGPT, over allegations of copyright infringement, false attribution, and improper use of ANI's content. This case touches on pressing issues surrounding the intersection of artificial intelligence (AI), data ownership, and intellectual property (IP) law in the rapidly evolving digital landscape. It raises crucial questions about the boundaries of copyright protection in the context of generative AI technologies and how such technologies can access and use publicly available data.

Plaintiff's arguments: ANI's case against OpenAI

ANI asserts that OpenAI's use of its copyrighted materials, without permission, for training its large language model (LLM) ChatGPT constitutes a violation of copyright law. The case centers on several key allegations that ANI has raised.

Sources of data for ChatGPT

ANI claims that OpenAI's AI model, ChatGPT, has used data from various sources, including publicly available data, third-party partners, and data that OpenAI has directly





researched. ANI asserts that its content falls within these categories and that OpenAI has improperly used it to train the AI model, which would amount to a breach of copyright protections.

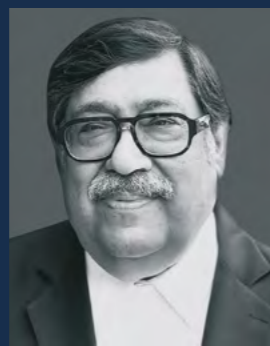
Content not publicly available

While some of ANI's content may be publicly accessible, the company maintains that other materials – such as specific news reports, interviews, and exclusive reports – are behind paywalls or are only available to subscribers. These materials, according to ANI, are protected by copyright and cannot be used by OpenAI for training without a proper license or authorization.

Three buckets of cause of action

ANI's complaint is built on three primary legal claims:

- Storage and usage of copyrighted material: ANI argues that OpenAI has infringed its copyright by storing, using, and making copies of ANI's content without permission to train its AI models. The fact that ANI's content may be publicly accessible does not absolve OpenAI of the need to obtain permission to use the material for training.



Pravin Anand



Vaishali R Mittal

- Verbatim or substantially similar responses: ANI asserts that ChatGPT sometimes produces responses that are either verbatim or substantially similar to ANI's copyrighted content. This raises concerns that OpenAI's model is directly replicating ANI's work without authorization.
- False attribution: ANI has also raised concerns about false attribution, claiming that ChatGPT sometimes generates responses that attribute interviews or reports to individuals or organizations misleadingly or falsely. For instance, ANI claims that ChatGPT inaccurately credited Rahul Gandhi with giving an interview to ANI when no such interview had occurred, damaging ANI's reputation and undermining the integrity of news reporting.

OpenAI's justification

In response to ANI's cease-and-desist notice, OpenAI argues that its actions are legally justified. OpenAI maintains that ANI's content is publicly accessible and can be used for training purposes without violating copyright law.

OpenAI also asserts that if ANI does not want its content accessed, the company can block OpenAI's crawlers from scraping its website using the "Robots.txt" protocol, a widely used method for restricting web crawlers from indexing certain content.

OpenAI's defense: key arguments

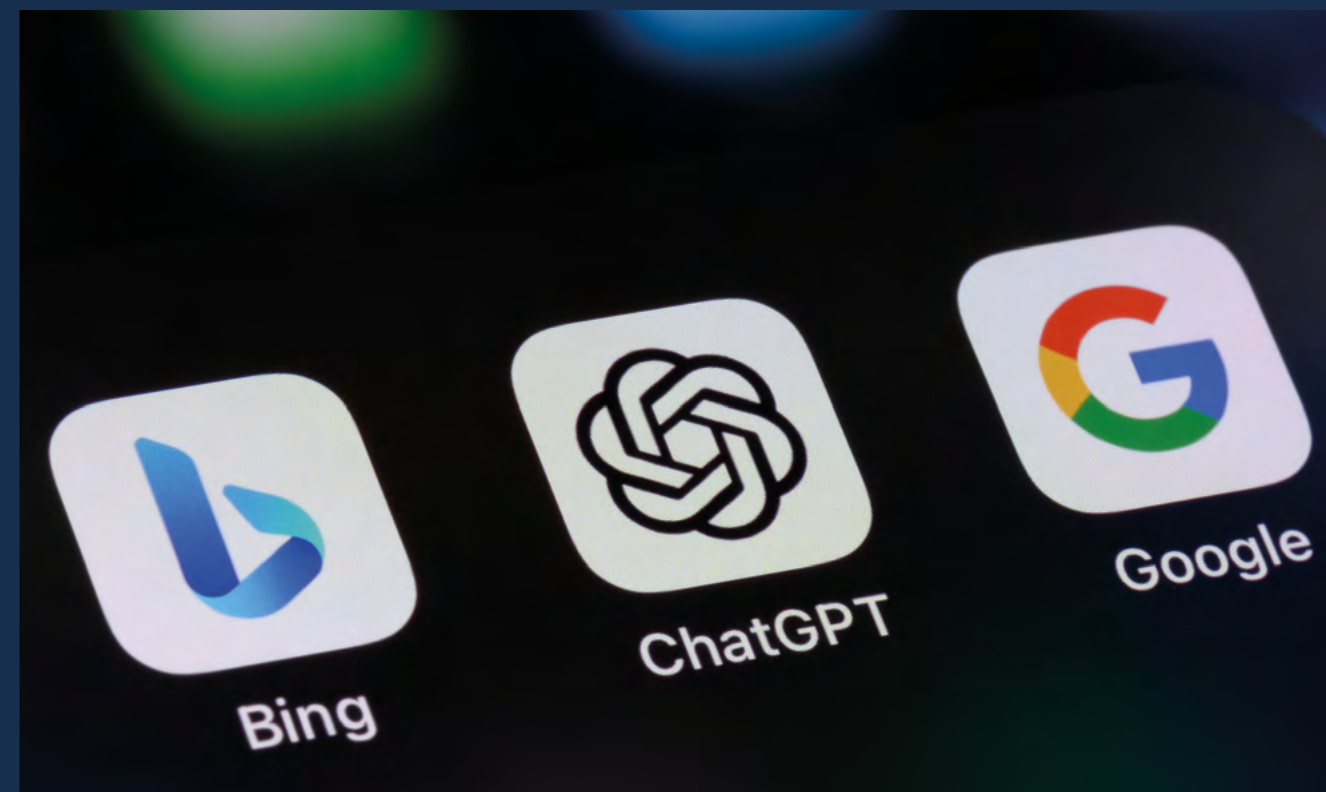
OpenAI has mounted a robust defense, asserting that its practices are not only legal but also transparent. The defense includes several important arguments:

No infringement in other jurisdictions

OpenAI points out that while it is facing lawsuits in various jurisdictions, including the US, Canada, and Germany, no court has granted an injunction or found OpenAI guilty of copyright infringement. This includes similar cases brought by other media organizations that allege misuse of their content.

Transparency and data usage

OpenAI argues that it has been transparent about its data usage practices. The company claims that it does not store specific instances of ANI's copyrighted material. Rather, the AI model generates responses based on patterns learned from a vast array of data sources, which include publicly available content but not the direct storage of copyrighted content.



No reproduction of ANI's content

OpenAI denies that it has reproduced ANI's copyrighted material. The defense asserts that ANI has failed to provide evidence that specific instances of content have been copied or directly reproduced by ChatGPT. The company argues that the content used in training is not stored in a way that would allow it to be directly reproduced during interactions with the model.

Access to paywalled content

OpenAI categorically denies that it has accessed ANI's exclusive content behind paywalls or subscription barriers. The company asserts that it does not scrape or use paywalled content for training unless it is publicly available elsewhere, thereby respecting content that is not meant to be freely accessible.

False attribution claims

OpenAI also denies the allegations of false attribution, claiming that errors of attribution are rare and have been promptly addressed when brought to the company's attention. OpenAI maintains that while errors may occasionally occur, they are not reflective of systemic issues with the model's operations.

Opt-out mechanism

OpenAI acknowledges that ANI has opted to block its crawlers from scraping its website using the blocklist feature. However, OpenAI contends that it still may produce content that



OpenAI maintains that ANI's content is publicly accessible and can be used for training purposes without violating copyright law.



appears similar to ANI's materials, though this could be sourced from other publicly available data or third-party partners.

Territorial jurisdiction

OpenAI has also raised a significant issue regarding territorial jurisdiction, asserting that the company does not have a physical presence in India and that its servers are located outside the country. As training of the model takes place outside of India, OpenAI argues that the Indian courts may not have jurisdiction over the matter.

Court's interim order

On November 19, 2024, the Delhi High Court issued a notice and summons to OpenAI, allowing the case to proceed despite the jurisdictional challenges raised by OpenAI. The court's interim order included several important points:

Résumés

Pravin Anand is the Managing Partner at Anand and Anand. In a career spanning over four decades, Pravin has emerged as an IP trailblazer with an experience of appearing in over 2500 cases.

He has strengthened India's IP jurisprudence with a practice encompassing all areas of IP litigation including patents, copyright, design, trademarks, enforcement, and dispute resolution.

Pravin joined Anand and Anand in 1979 as an extension of the law firm established by his grandfather in 1923. From a one-room office in Old Delhi, he took the firm to new heights with offices in four major cities and a diverse gene pool of 400 professionals.

His approach in and out of court has broken new grounds in Intellectual Property Rights and today, from Christian Louboutin to Cartier, from pharma to tech majors to policymakers and from art to entertainment, Pravin represents most famous brand owners, leading industries and eminent personalities who rely on his matchless experience for protection of their Intellectual Property.

Vaishali R Mittal is a litigation partner and strategist at Anand and Anand. In 21 years of practice, Vaishali has engendered some of the most ground-breaking judgments, including recent works such as the order protecting personality rights of celebrities against misuse of Generative AI and dark patterns (*Anil Kapoor v. Simply Life India*); India's first judgment on Product-by-Process Patent (*Vifor International v. MSN Labs*); India's first pro tem security order (*Nokia v. Oppo*); India's first Anti-Anti Suit injunction, India's first final judgment on SEP; order directing an implementer to deposit pro-tem security in favor of an owner of SEP, before determination of infringement, validity etc. (*InterDigital v. Oppo (2022-24)*; *Nokia v. Oppo (2022)*).



- Territorial jurisdiction: The court acknowledged OpenAI's objections regarding jurisdiction but decided to allow the case to proceed, with the jurisdictional question to be addressed at a later date.
- Blocklist confirmation: The court confirmed that ANI had placed OpenAI's crawlers on a blocklist, ensuring that OpenAI's web crawlers would no longer access ANI's website.
- *Amicus Curiae* appointment: To assist in the legal proceedings, the court appointed an *Amicus Curiae* (friend of the court) to ensure that the case was considered from all relevant perspectives.
- Next hearing date: The court scheduled the next hearing for January 28, 2025, giving both parties additional time to prepare their arguments and evidence.

Potential impact of the case

The outcome of *ANI v. OpenAI* could have profound consequences not only for the parties involved but also for the broader field of AI, copyright law, and data usage in the digital era. The case raises critical questions about how copyright law applies to generative AI technologies and how AI companies can access and use publicly available data.

Copyright law and AI models

If ANI's claims are upheld, it could establish that the unauthorized use of copyrighted material for training AI models constitutes infringement. This would compel AI developers to obtain licenses or permissions from content owners before using their data to train models. Conversely, a ruling in favor of OpenAI could expand the scope of "fair use" in the context of AI training, allowing developers to use publicly available content without specific permissions and fostering innovation at the potential cost of the copyright holders' control over their content.

Regulation of data usage in AI

This case could set a precedent for how data scraping and the use of publicly available copyrighted material in AI model training are regulated worldwide. A ruling in ANI's favor could lead to stricter data governance, requiring AI companies to secure consent before using copyrighted material for training. Conversely, a decision in favor of OpenAI could solidify the practice of using publicly available data in AI training, pushing for more permissive data usage standards.

Impact on AI innovation

A decision restricting the use of copyrighted

“
A restrictive ruling could limit the variety of content available to train AI models, potentially reducing the breadth and depth of knowledge that models like ChatGPT can provide.
 ”

content for training could slow the pace of AI innovation by increasing licensing fees and legal complexity. On the other hand, a ruling that allows broader access to publicly available data could accelerate the development of AI technologies, enabling companies to train their models on a larger pool of information and drive faster advancements.

Global impact on AI and copyright laws

While the case is being heard in India, its outcome could have significant implications for jurisdictions around the world. A decision by the Indian courts could influence similar legal battles in other countries, particularly in the US and Europe, where the regulation of AI and copyright is still being defined.

Media industry and data monetization

If ANI wins the case, it could encourage other media companies to more aggressively monetize their data, licensing it for AI training purposes. This could create new revenue streams for media organizations but could also raise costs for AI developers.

Public access to AI models and information

A restrictive ruling could limit the variety of content available to train AI models, potentially reducing the breadth and depth of knowledge that models like ChatGPT can provide. Conversely, a ruling in favor of more open data usage could heighten tensions between public access to information and private control over data.

Conclusion

ANI v. OpenAI has the potential to reshape the landscape of copyright law, artificial intelligence, and data usage. Whether it strengthens copyright protections or broadens the legal rights of AI developers, its implications will be felt across multiple sectors.

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Requirements for filing a declaration of actual use by owners of International Registrations designating Mexico

Alonso Camargo and Diego Ballesteros of OLIVARES detail the requirements of Mexican registrations derived from International Registrations when filing a declaration of actual use, identifying the problems with the process, and examining how successful the introduction of the Federal Law for the Protection of Industrial Property (FLPIP) has been in fixing these issues.

As of August 10, 2018, a declaration of actual and effective use was introduced as a maintenance requirement for trademark registrations granted in Mexico. The purpose of this introduction was to clear up the register of trademarks that were no longer of interest to their owners and block the registration of new marks.

The declaration of use requirement is established in two stages:

- A one-time declaration of actual and effective use, which must be submitted within three months after the third anniversary of the date of grant of the registration in Mexico.
- A declaration of actual and effective use of the registered mark to be submitted along with each renewal application (every 10 years).

The above regulation also applies to International Registrations derived from the Madrid System designating Mexico.

No evidence of use should be filed with the Mexican Institute of Industrial Property (IMPI) at the time of filing the declarations of use. In both



“
No evidence of use should be filed with the Mexican Institute of Industrial Property (IMPI) at the time of filing the declarations of use.
 ”



Résumés

Alonso Camargo joined OLIVARES in 1995 and became a partner in 2008. Alonso's clients "draw confidence from his complete dedication to their cause," according to World Trademark Review's WTR 1000. He is a highly experienced trademark attorney who represents many of the firm's key clients and their well-known brands. His team serves as the heartbeat of OLIVARES' trademark practice. Alonso studied in Alicante, Spain, where he received his Masters in Intellectual Property. He has extensive knowledge of the European trademark system and is thus able to make comparisons between the European and Mexican systems in order to more effectively explain legal issues to his clients.



Alonso Camargo



Diego Ballesteros

Diego Ballesteros joined OLIVARES in 2017. Since then, he has been an enthusiastic and effective member of the OLIVARES trademark team, participating in multiple matters of the highest relevance. Diego intervenes in all kinds of matters related to distinctive signs, such as the processing of consultancies, the supervision of the presentation of applications, assignments, name changes, and other trademark procedures before the Mexican Institute of Industrial Property (IMPI), as well as in the preparation of trademark registrability and availability searches, the preparation of franchise or license contracts, the negotiation of coexistence agreements for our clients, among many others.

cases, the IMPI has published official forms that are to be executed by local representatives on behalf of the trademark owners, stating the specific goods or services on which the trademark owner confirms actual and effective use in Mexico.

Regarding what is considered trademark use in Mexico, Mexican law establishes that the use of a trademark exists when the products or services identified with the mark are available for Mexican consumers.

While the mere availability of a given mark may not suffice to successfully defend a non-use cancellation action, for the purpose of a declaration of use, such use should be sufficient.

In the case of a one-time declaration of actual

and effective use, which must be submitted within three months after the third anniversary of the date of grant of the registration in Mexico, the scope of protection of the registration will be restricted to the goods on which the actual use is declared. On the other hand, regarding renewals, the renewal certificate will be issued reflecting the restriction of the protection according to the submitted declaration of use.

The provision in law intends that the registrants declare use only in connection with the goods or services used. However, no evidence of use is required and in practice, there are no sanctions for those declarations specifying all the goods or services covered by the registration. The only consequence foreseen if the declaration specifies all the registered goods or services – but it turns out that the mark is used with some, but not all of the specified services – is that upon request of a third party, a partial non-use cancellation would be successful in respect to those goods on which the registrant is not able to demonstrate use. No additional consequences have been foreseen in practice for the false or inaccurate statement *per se* that may impact negatively the validity of the registration in its entirety.

It is important to highlight, however, that failing to file the declaration in both cases within the established terms results in the automatic lapsing of the registration.

While the law establishes an exemption for canceling a registration based on non-use when such non-use derives from circumstances beyond the control of the registrant, such as governmental restrictions, similar treatment was not provided concerning the declaration of use.

Concerning the one-time declaration of actual and effective use, this applies to all registrations granted in Mexico as of August 10, 2018, despite the date of filing, whether such registrations were obtained through the National route, or the Madrid System.

Regarding the declaration of use that needs to be filed at the time of renewing Mexican trademark registration, the law establishes that it must be filed along with the renewal application.

When dealing with Mexican National registrations, the declaration of use that needs to be filed along with the renewal is not an issue since the renewal application form contains the so-called declaration of use. Therefore, the party applying for renewal automatically declares the use of the mark when executing the form, and it is only required to specify the products/services used within such form.

However, in cases of Mexican registrations derived from International Registrations which are renewed directly before the World Intellectual Property Organization (WIPO), it becomes quite confusing (or even uncertain) for the trademark

“ While the mere availability of a given mark may not suffice to successfully defend a non-use cancellation action, for the purpose of a declaration of use, such use should be sufficient. ”



owners. This is because the renewal application form filed through the WIPO does not contain any section, nor any indication on how to comply with this legal requirement derived from Mexican Trademark Law.

After the declaration of use requirement was introduced in 2018, the IMPI issued an internal Administrative Agreement whereby it was specified that for those registrations renewed by the Madrid System, the declaration of actual and effective use should have been filed before the Mexican Trademark Office within two months of the date the WIPO notifies the renewal of the IR.

Following this, the Federal Law for the Protection of Industrial Property (FLPIP) came into force on November 5, 2020, and introduced a new provision to fix this situation. Article 237 of the FLPIP establishes in its fourth paragraph that in cases where the declaration of use is not filed along with the renewal petition, the IMPI will issue an office action, granting a non-extendable two-month term to comply with such requirement.

This change was specially addressed and relevant for the trademark registrations obtained through the Madrid System because the renewal format used in the Madrid System does not include a declaration of use (as required by the FLPIP), causing uncertainty about the deadline to file the declaration of use. However, although this provision was intended to provide clarity to the Madrid System users as to when it is necessary to file a declaration of actual and effective use after applying for renewal before the WIPO, there are still problems with these cases. In practice, the office actions issued by the IMPI to grant the two-month term to registrants to comply with the declaration of use requirement are exclusively published in Mexico in the Mexican Industrial Property Gazette. Therefore, those

“ In cases where the declaration of use is not filed along with the renewal petition, the IMPI will issue an office action, granting a non-extendable two-month term to comply with such requirement. ”

international trademark owners who designated Mexico through an International registration but didn't appoint a local representative will never become aware of the existence of these office actions, and will likely lose their rights.

According to the FLPIP, it is compulsory to indicate a domicile for service in Mexico in all applications filed with the IMPI, a situation that is not considered in the Madrid System but gives the IMPI the authority to make effective the two-month term mentioned above.

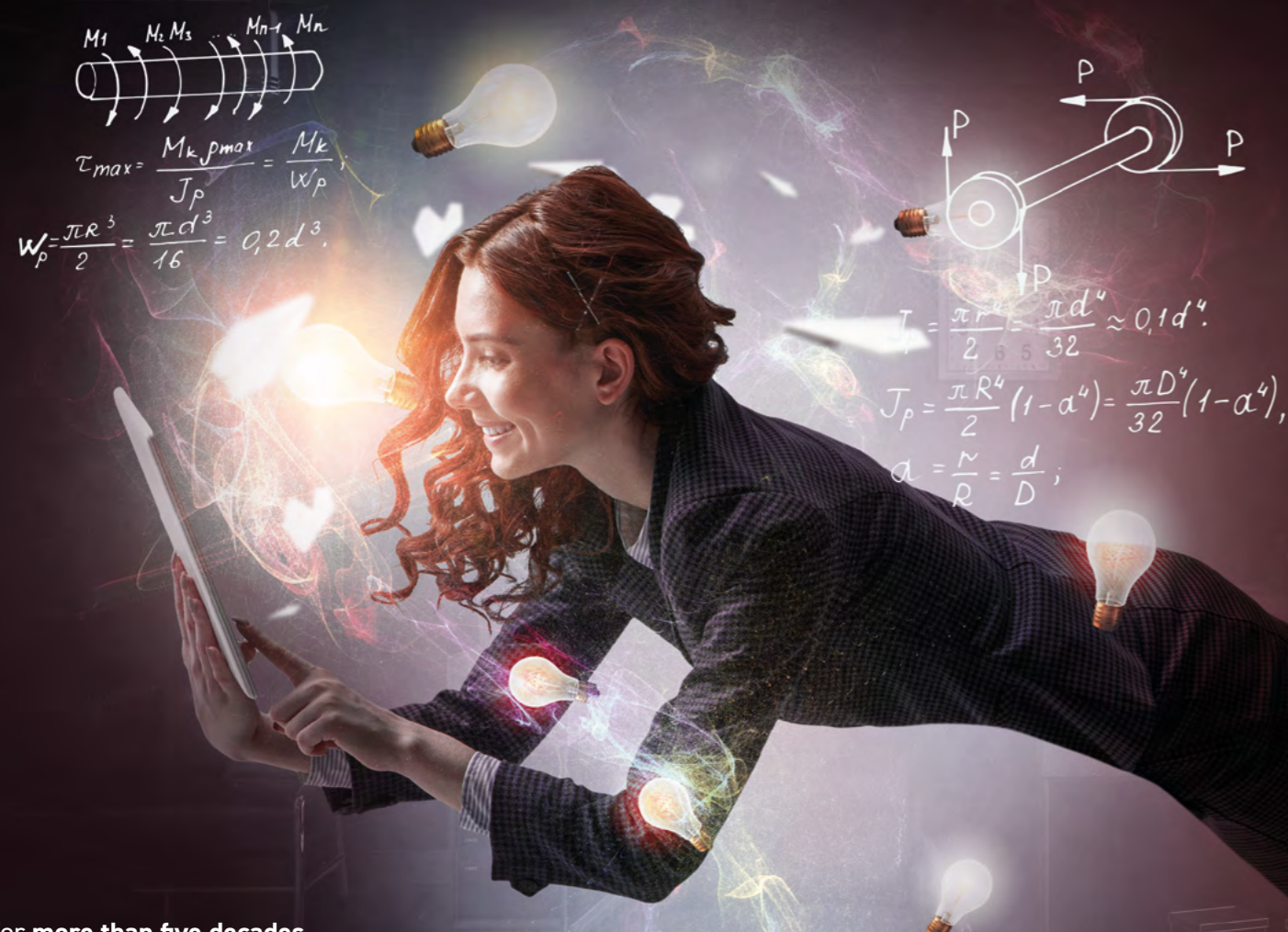
In light of this situation, and until a new way to communicate the deadline for complying with these requirements to trademark owners is implemented through the WIPO, a practical recommendation for all international users of the Madrid System who designate Mexico in their International Registrations is to appoint a local representative once served with the Statement of Grant of Protection from the WIPO, to avoid the risk of losing their trademark rights in Mexico.

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Reinventing trademarks and designs in the gaming industry

Dr. Tomasz Gawliczek of JWP Patent & Trademark Attorneys highlights key considerations for crafting a trademark and design protection strategy in the gaming industry. Drawing on past lessons, he discusses essential factors to keep in mind and offers insights on how upcoming legal changes could be leveraged to strengthen IP strategies in this sector.

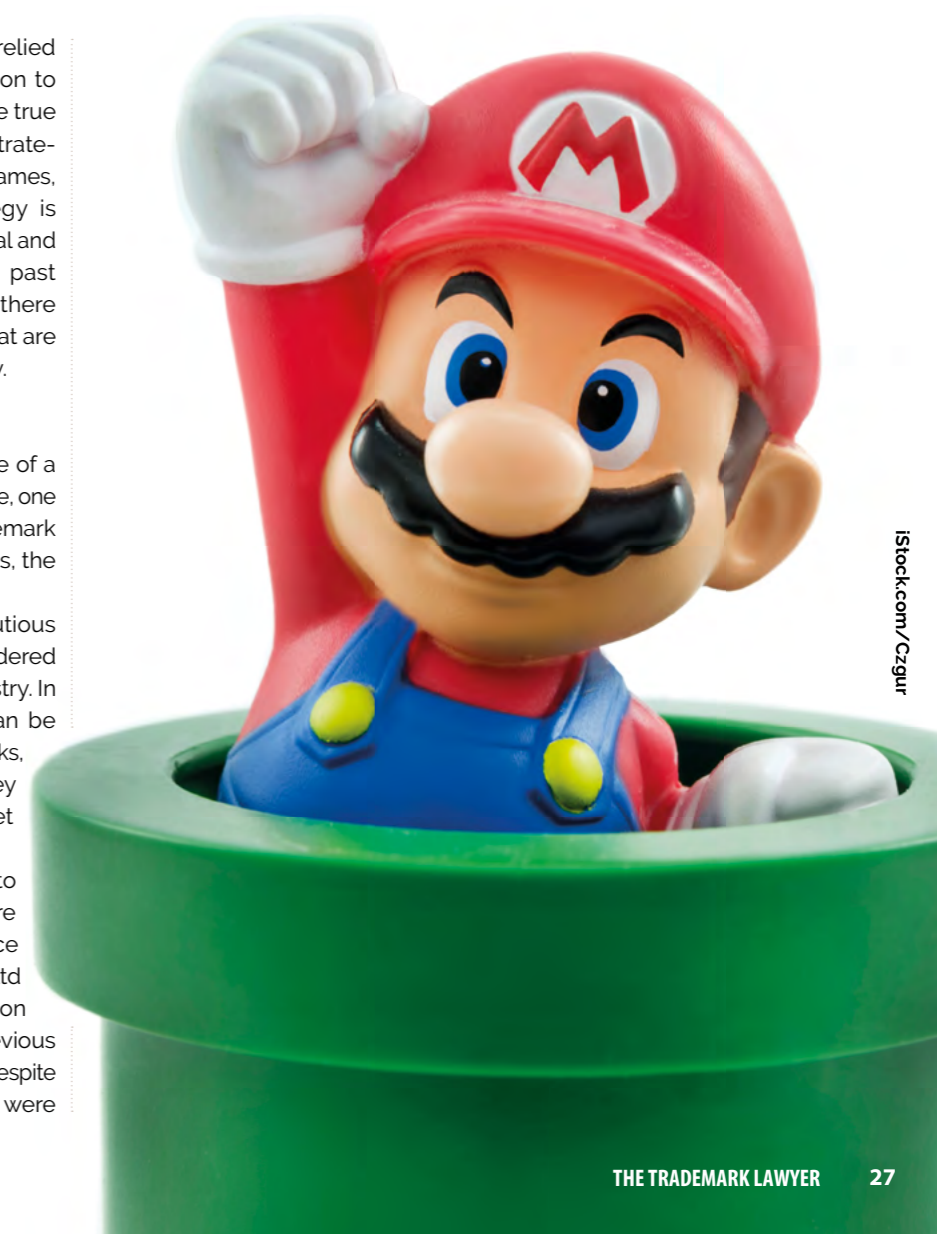
For years, the gaming industry has relied on trademark and design registration to safeguard its creations. However, the true impact of these protections lies in how strategically they are applied. Much like in RTS games, a carefully crafted IP protection strategy is crucial, one that adapts to the evolving legal and technological landscape. The industry's past experiences offer valuable lessons, and there are also new challenges on the horizon that are worth anticipating and preparing for today.

Be distinctive

When thinking about protecting the name of a game, a character's identity, or even a console, one should recall the guiding principle of trademark law. The more distinctive your trademark is, the more protection it can benefit from later.

In this respect, one must be more cautious about verbal elements that may be considered descriptive or commonly used in the industry. In some cases, acquired distinctiveness can be demonstrated in relation to certain trademarks, but this only becomes possible when they have been used extensively on the market for many years.

Within this framework, it is valuable to reflect on a case that was decided before the European Intellectual Property Office (EUIPO) some years back. Nintendo Co., Ltd filed an opposition to the EUTM application No. 002586980 "Fire Boy," claiming its previous registrations of the GAME BOY trademarks. Despite the similarity of the goods for which they were



iStock.com/Czguir



Résumé

Dr. Tomasz Gawliczek is a partner at JWP Patent and Trademark Attorneys and a dual-qualified patent and trademark attorney and attorney-at-law in Poland. With over 10 years of experience in intellectual property, he specializes in strategic planning and litigation. Tomasz has represented clients in numerous cases before the Polish Patent Office, Polish IP courts, and EU institutions. He is among the most seasoned Polish attorneys in handling trademark and design disputes before the EU General Court.



Dr. Tomasz Gawliczek

intended, the EUIPO did not identify any similarity between the trademarks themselves. The grounds for the decision indicated that "(...) both signs contain the English word »boy« which is likely to be understood in all relevant territories. However, it is not a striking element applied to computer games which are meant for children and boys in particular" (decision No. 2091/2005 of 15/16/2005). Ultimately, registration of the contested trademark was not granted due to its withdrawal by the applicant at a later stage. Nevertheless, this case shows how reliance on distinctive word elements is important when assessing the risk of confusion.

Moving beyond the scheme

Current efforts to secure protection through trademark registrations also face challenges concerning the evaluation of distinctiveness. One excellent example is the application for a multimedia EU trademark 017282203, which resonated with the market. Seven years after the application had been filed with the EUIPO, a decision was finally made this year to refuse its registration. The EUIPO argued, among other reasons, the insufficient distinctiveness of the game fragment intended to function as a trademark.

As for the reasoning behind this decision, we can read that "the Office does not doubt that the specific »slow motion X-ray kill cam« is somewhat unique. However, in the light of the above, the relevant public will merely perceive it as a newly combined and possibly improved feature of the game at hand, still resembling features known from other games or previous versions of the same game" (refusal of application for a European Union trademark of 08/07/2024).

There are at least two lessons to be learned from this case. Firstly, the EUIPO confirmed that the same rules for assessing distinctiveness can be applied to multimedia trademarks as had previously been developed in case law concerning

shape marks. Secondly, it is apparent that a mere fragment of a game can constitute a trademark if it deviates from the market standard. Therefore, it is also worth considering this form of protection if the game scene is indeed so distinctive (fanciful), that it will, from the consumers' perspective, succeed in indicating the origin of this product from one particular company.

Importance of graphic elements

A compelling approach to establishing protection for gaming-related products is to register specific graphic elements as trademarks. At the same time, it must be borne in mind that such an element must fulfill the functions of a trademark in the game itself if the right holder wishes to claim protection against infringements on that grounds at a later stage.

In addition, the way in which the graphic element is presented remains an important issue. In today's games, reality is depicted multi-dimensionally and players are becoming increasingly immersed in the game via augmented reality. This means that registering a graphic element (e.g., a specific game asset) as a trademark in only one dimension limits its protection. This is because a comparison with other similar assets that have a three-dimensional form may reveal a lack of similarity between them.

In existing litigation concerning the infringements of purely figurative EU trademark registrations, the likelihood of confusion on the part of the relevant public has not always been established, even when the compared goods were identical. In this regard, an interesting case was decided by the Austrian Supreme Court in 2020 (ref. 4 Ob 27/20d). The case concerned the infringement of a figurative trademark for a book (EUTM-12414975) which was compared with another book appearing in a competitive game. The Court highlighted that trademark law does not grant protection to simple motifs. Consequently, simply depicting the same object does not automatically create graphic similarity between the compared signs.

On the other hand, in this type of case, the assessment of conceptual similarity and the question of whether the graphic sign contained in the game actually appears as a trademark in the game remains a separate issue.

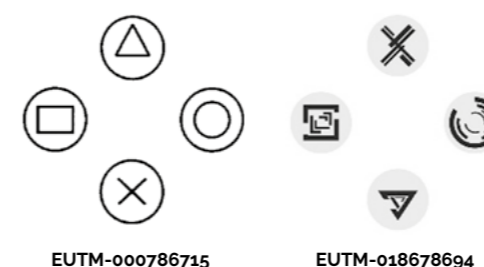
IP reaches outside the game itself

In the gaming industry, graphic signs can be used to identify not only the gameplay elements themselves but also, for example, consoles or other devices. Thus, they can be identified by players even before they start playing the game.

This was the protection that Sony Interactive Entertainment Inc. thought of when it registered the EU figurative trademark 000786715 back in



1998. On this basis, an opposition was filed to the application for another figurative mark No. 018678694. A graphical comparison of the two signs was as follows:



When deciding the case, the EUIPO Board of Appeal noted in its decision of March 14, 2024 that "the differences in the marks are additional ornamental strokes added to the contested sign, showing the same easily recognizable symbols of a triangle, a circle, an 'X' and a square or rectangle in the same pattern, order and location. The Board also finds that when contemplated in their entirety, notwithstanding some stylistic differences, the marks have an identical graphic arrangement and overall convey a somewhat similar look" (ref. R 1951/2023-2).

This decision stands out for two key reasons. Firstly, the EUIPO's earlier assessment of the similarity between these signs differed. Moreover, when evaluating the likelihood of confusion, the

Board of Appeal noted that companies today often make adjustments to previously used marks, which, in this instance, could suggest that the products bearing both marks come from the same source.

What to protect?

As noted above, when planning to protect a trademark in the gaming industry, it should not be limited to the game itself or even to gaming-related devices. Indeed, the gaming market encompasses many more goods or services that are dedicated to fans of a particular game.

According to the figures reported by the Independent in the context of the widely presented online gaming stats for 2024, the most connected and also revenue-generating markets are toys; film, TV, and soundtracks; books; and events and venues. This shows that thinking about the protection of intellectual property must be based on a broader perspective and, at the same time, it must anticipate the behavior of consumers who, encouraged by playing the game, may also be inclined to purchase other products "from the series."

As a result, it is essential to establish the scope of protection of the trademark to be registered as early as possible. Delays can lead to future conflicts with other signs, making it impossible to secure protection later on.

“ One must be more cautious about verbal elements that may be considered descriptive or commonly used in the industry. ”

“ A mere fragment of a game can constitute a trademark if it deviates from the market standard. ”

Who is targeted by the gaming market?

The answer to this question is just as important as the previous one. Knowing who you want to sell your goods and services to makes it much easier to create the right offer. In addition to the business perspective, this question is also significant in terms of assessing whether there may be a risk of misleading part of the public. This depends, among other things, on the level of attention of the relevant consumers.

Nowadays, it is reasonable to say that anyone can play a game. Does this align with the perspective shown in case law? Indeed, it does. In this respect, the position taken by the General Court of the European Union in the dispute involving the trademark "Dungeons and Dragons" cannot be ignored.

The judgment of October 10, 2019 in case T-700/18 addressed this issue by indicating that "the categories »games« and »computer games« cover a fairly large number of different goods, which are not luxury or niche products reserved for a limited number of people. On the contrary, those goods are available both online and on a self-service basis, they are widely promoted on different television channels, depending on the target age group, their price is relatively low, and special skills or knowledge are not essential or required for their purchase. In other words, games and computer games are easily accessible to all, including those without special knowledge, and may therefore be assimilated to everyday consumer items" (p. 36). This is an important observation, because the higher the level of attention of the target audience of the goods bearing the compared marks, the greater the chance that there will be no confusion between them.

The EU General Court's position encourages even more prudent and forward planning for trademark protection in this sector. Indeed, where there is a conflict between a trademark appearing in a game and another one for goods such as toys or books, for example, this can lead to difficulties.

Digital designs and the games market

It is not only trademarks that are allies in the gaming industry's struggle to gain a monopoly on particular elements of the game or the gaming world in general. Designs have also been successfully used for this purpose to date. Now, however, it seems worth taking a closer look at the strategy for their protection, as the forthcoming legislative changes may introduce a new quality in this area.

This year, the European Union has finalized its efforts to reform design law in order to address

“ **This year, the European Union has finalized its efforts to reform design law in order to address the demands of evolving business landscapes more effectively.** ”

the demands of evolving business landscapes more effectively. It is already clear at this point what changes will be introduced as part of the EU Design Legislative Reform Package. One of them is the revised definition of a product which will mean any industrial or handicraft item other than computer programs, regardless of whether it is embodied in a physical object or materializes in a digital non-physical form.

Until now, the most common approach in the industry has been to register a design to protect the graphical user interface. Will the introduction of digital designs prompt the gaming sector to start protecting individual virtual assets also through the use of this exclusive right? Certainly, as it provides additional opportunities for increased monopoly. What remains an open question, however, is how this protection will be enforced in practice.

On a final note

In recent years, much has shifted regarding IP protection in the gaming industry. Advancements in case law and legal reforms are paving the way for expanded possibilities in this area.

What is important to remember is that protection is not given once and for all, and the exploration of new solutions should never end. Once you have reached one level, you need to be ready for the next. This could be reminiscent of the famous quote from the *Super Mario Bros.* game: "Thanks, Mario! But our princess is in another castle!"

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Jurisdictional Briefing, US: Dupe culture clash: strategies for brand owners

Michelle Ciotola of Cantor Colburn explores the rise of “dupe culture” and the role social media plays in marketing dupe products, providing strategies for brand owners to protect their intellectual property in this space.

“Dupe culture” is on the rise. “Dupe culture” refers to the trend of creating and marketing products that closely mimic or “dupe” high-end branded goods – available at a fraction of the cost. There was a time when buying the “cheap” version or knockoffs would have been kept quiet by the consumer. Now, these “dupe” products are often highlighted by influencers on social media. Products are zealously touted as a “dupe – brand name,” for example, the “dupe – Stanley” (water bottle). Finding and purchasing a dupe product is often discussed as a point of pride. The landscape of “dupe culture” is riddled with potential issues for consumers and brand owners alike.

For consumers, the issues with “dupe” products are similar to counterfeit products. The product quality is often not the same as the quality of the original product being imitated. The lower price points can give rise to sustainability issues. Like “fast fashion” (clothing and accessories that are sold at low costs), “dupe culture” can be riddled with sustainability and ethical concerns. As a result of their low price point, products are often produced using manufacturing techniques and materials that are not environmentally friendly. More products being purchased at lower quality results in more products going to landfills. The manufacturing of dupe products may also involve unsafe labor practices. Finally, there are safety concerns for the consumer: with little to no oversight in the safety of the materials used or quality testing, products can be made with unsafe chemicals.



Michelle Ciotola

Dupes are not necessarily counterfeit – the products are not always intended to trick consumers into believing they are purchasing the branded products they mimic. Trademarks and logos of the original product are not typically used. As a result, enforcement options for brand owners may be limited. For example, preventing the import of counterfeit products by recording trademark registrations or copyright registrations with US Customs and Border Protection (CBP) may not stop the import of “dupe” goods because these goods do not bear the brand owners’ trademarks.

Five strategies for brand owners to combat “dupe culture”

1. Protect your intellectual property

While dupe products often avoid crossing the line into intellectual property infringement, having robust protection for your product can make it more difficult for dupes to be successful. Ensure that the main trademarks are registered, including all wordmarks, any stylized version of that mark, and any design elements. Carefully consider whether any non-traditional trademarks can be protected. While there are hurdles to obtaining protections (lack of inherent distinctiveness, functionality, etc.), it is always worth considering what can be protected. For example, is there any trade dress like the shape of the product that can be registered as a trademark?

Or can it be protected as a design patent? Is there a unique color that can be protected? Is there anything associated with the product that can be protected through copyright? What about through a utility patent?

2. Create and maintain a strong brand identity; build brand loyalty

Work with your marketing team to consider whether engaging with influencers for social media campaigns will help reach target consumers, inspire brand loyalty, and combat the appeal of dupe products. Build loyalty with your consumers that will make them want the branded product over dupes.

3. Educate the consumer

Utilize the same platforms that make dupe products appealing to educate consumers on the risks of purchasing dupes over branded products. Highlight the steps your company takes to ensure quality control measures are in place. Emphasize the dangers of dupe products which may lack these same standards. Identify the common shortfalls of dupe products and the possible environmental impact as well as ethical concerns.

4. Be vigilant and strategic in monitoring

Develop a strong brand protection policy and workflow. Be ready to identify cases where dupe products cross the line into counterfeits or where there is trademark infringement. Having a robust trademark portfolio will provide more options for enforcement.

Résumés

Michelle Ciotola counsels clients on protecting and enforcing their trademark, trade dress, copyright, and related IP rights, including unfair competition, Internet, advertising, and promotions law. She counsels clients in developing and exploiting their trademark and copyright portfolios, including clearance, prosecution, and identifying important overseas jurisdictions and filing or coordinating with local counsel overseas. Michelle develops strategies for the enforcement of her clients’ IP rights. She also develops strategies for the enforcement of her clients’ intellectual property rights online, including handling Uniform Domain Name Dispute Resolution Policy proceedings. Michelle attends and speaks at the International Trademark Association (INTA), MARQUES, European Communities Trade Mark Association (ECTA), and the Asociación InterAmericana de la Propiedad Intelectual (ASIFI).

5. Legal measures

In extreme cases, consider taking legal action to stop dupe products.

While not all dupe products rise to the level of counterfeit or infringe on the original products, dupe culture poses many risks for brand owners. Having a clear strategy in place to both proactively combat the appeal of dupe products and implementing targeted and strategic enforcement can help minimize the impact dupe culture has on your brand.

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Jurisdictional Briefing, Russia: IP in Russia is still beyond politics

Dr. Alexey Vakhnin of Vakhnina and Partners summarizes the current state of IP in Russia amidst geopolitical turbulence, highlighting the growth in Russian trademark filings.

During the last decade, politics and geopolitical events have become a part of our life, and, unfortunately, have significantly affected the IP community. There have been many publications in foreign media, fake news, rumors, restrictions, and sanctions against nationals of Russia regarding IP. According to some publications, "the IP in Russia has long been destroyed and dead." Having been asked at various IP conferences about IP in Russia, this article will summarize its current state.



Dr. Alexey Vakhnin

The most important message to our colleagues is that the Russian Patent Office and the judicial

system remain separate from politics and continue to protect and register the intellectual property of all rights holders from all countries impartially and without discrimination.

The Rospatent and Eurasian Patent Office (EAPO) have continuously confirmed their approach to protecting the IP rights of owners. This is one of the reasons for the growth of applications within the Rospatent from both Russian and foreign applicants.

The highest volume of filing came from applicants based in China, with a combined domestic and abroad applications count of around 7.4 million; followed by United States (US) applicants (849,876), those based in the Russian Federation (543,692), and applicants from India (496,293), and Germany (441,293). (See Figure 1: IP facts and figures)

For some readers, this may seem surprising. Despite the restrictions and sanctions of some countries, Russian businesses have set records in the filing of new trademarks in 2022-2023.

The full statistics for 2024 are yet to come, but it is anticipated that the growth will be even more impressive. This is due to various reasons, including:

- The increased number of applications in October 2024 due to the increase in official fees
- Many innovations in IP and the possibility for individuals to register trademarks
- The rapid growth of Russian businesses, and Asian and Latin American countries

seeking to quickly become part of the Russian market which has been vacated by European companies

- Trust by foreign and local applicants in Russia's system to protect their IP.

What does this mean for businesses?

Russian businesses and companies from Asia are actively seizing market niches after businesses from the European Union (EU) and the US hastily withdrew.

According to the Rospatent, the most popular field for registration of new trademarks in 2023-2024 was clothing and footwear, making up 21.9% of applications. The next was software, electronics, and smartphones, making up 17.5%. Among the leaders are household chemicals, perfumes and cosmetics, printed products and stationery, and confectionery and bakery products.

As previously mentioned, the intellectual property of foreign applicants, despite their citizenship and origin, is protected and registered.

We regularly participate in court hearings in Russia, at the Intellectual Property Court and the Chamber of Patent Disputes, representing Russian clients as well as small Western companies or large international corporations, pharmaceutical giants, leading oil companies, and manufacturers of well-known brands of clothing and cars. No discrimination of applicants' rights in the Patent Office or Courts was faced by our lawyers (unlike the discriminatory approach to our Russian applicants' rights which, to our regrets, became legal in Europe).

Moreover, the Rospatent has repeatedly stated that Russia continues to observe all international treaties and conventions and would not discriminate against any applicants on national or other grounds to register and protect IP on

Résumé

Dr. Alexey Vakhnin is Partner and Managing Director of Vakhnina and Partners, Russian and Eurasian Patent and Trademark Attorneys Firm. He is a Eurasian Patent Attorney, and a Patent and Trademark Attorney of the Russian Federation, with extensive experience in IP since the 1990s. Dr. Vakhnin is a member of the Eurasian Patent Attorneys Assembly (EPAA), FICPI, AIPPI, LESI, INTA, ECTA, PTMG, etc. Having PhD in Medicine (Biochemistry and Immunology), while working on patent matters, Alexey specializes in Medicine, Biotechnology, Biochemistry, and Pharmacology

The most important message to our colleagues is that the Russian Patent Office and the judicial system remain separate from politics.

equal rights and from owners from Western countries – Germany, the USA, France, Spain, Italy, Canada, etc.

IP growth in Russia

As the statistics show, IP businesses in Russia are quickly growing. There are several main reasons for this successful growth:

1. US and EU sanctions

The sanctions unexpectedly became an incentive for the growth of Russian business. To replace companies from the US and EU that had left the market, Russian businesses started developing new directions and their own production. For example, before 2014 most cheeses and dairy products in Russia were supplied from EU countries (Switzerland, Italy, Finland, etc.). After 2014, Russian businesses began to actively increase production and the sanctions forced the Russian market to grow and develop rapidly, resulting in explosive growth and expansion of the domestic market. Russian companies proved they could produce high-quality products and successfully supply them to the markets of other countries.

Business growth in other industries is developing in the same way. Factories and enterprises

Figure 1: IP facts and figures



of Western businesses, abandoned by their owners, are learning to produce high-quality products and gradually entering new markets, creating competition for their former owners.

As a result, these developing businesses are filing an enormous number of new trademarks, designs, and inventions, in an attempt to be recognizable in Russia and other countries.

2. Mimicry

Many large Western companies do not want to leave the Russian market due to its commercial profitability. For many Western companies, Russia brought in up to 50-70% of the company's total revenue. However, many companies have been forced to leave the market.

Some companies, to avoid leaving the market, establish new firms and file and register a series of new trademarks that differ from their popular Western brands. The 'new' companies continue to successfully operate in the market on behalf of the companies not 'officially' related to the EU, Canada, and the US. Furthermore, the number of trademarks filed in Russia by these 'new' companies from Europe and the US is also growing steadily.

3. 'Re-filing' old and well-known trademarks

Recently, we have seen a sharp increase in trademark filings from world-famous companies that officially left the Russian market in 2022-2023. These companies are concerned about the loss of the Russian market and seek opportunities to return.

In fear of losing their trademarks – due to the three-year non-use period – many companies are beginning to file new trademark series in Russia. This allows them the opportunity to obtain another three years and openly return to the Russian market without significant losses.

Having confidence in the IP protection system in Russia and planning to return, world-famous companies are filing dozens of new trademarks – from Japanese manufacturers to French fashion houses and luxury brands.

4. Asia

Asia entered the Russian market long ago. Now, Asian businesses are consolidating and strengthening. The development of production and the supply of Asian equipment is the reason for this growth in the filing of trademarks and inventions by applicants from different Asian countries.

The activity of Chinese and Indian businesses has increased by an order of magnitude. The market is being actively occupied by modern and high-quality products from Asian countries, resulting in an increase in applications from Asian countries.

“
The activity of Chinese and Indian businesses has increased by an order of magnitude. The market is being actively occupied by modern and high-quality products from Asian countries.
 ”

What does it sum up to?

The IP in Russia is being actively protected, regardless of the nationality of applicants. All international treaties and conventions in Russia are being observed and respected.

Businesses and the economy are actively growing, and cooperation with the BRICS countries is strengthening. The professional community of IP experts and attorneys is actively developing: the number of patent attorneys in the Russian Federation already exceeded 2500 attorneys, and they are actively uniting in professional communities – such as the rejuvenated Chamber of Patent Attorneys of the Russian Federation and the Assembly of Eurasian Patent Attorneys established in 2023.

We look forward to the end of geopolitical turbulence, and the active growth and development of the Russian and Eurasian patent and trademark systems.

Let's have IP without politics

To help applicants and attorneys from different countries independently cooperate with the countries of Eurasia, a dedicated association was established in 2023 – the Eurasian Patent Attorneys Assembly (EPAA).

The new association allows us to hold independent conferences in the countries of Eurasia, and to invite colleagues from around the world – regardless of country, nationality, and political views. There will be no place for discrimination in the new association – and we are glad to see professionals from anywhere in the world who want to cooperate with us. In 2025, the EPAA conferences are planned in the Eurasian countries of Armenia and Kazakhstan.

We look forward to seeing you among the participants of our conferences!

If you have any questions regarding participation, please contact ip@vakhnina.ru.

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Extraterritoriality in IP: insight from the US

Max Vern of Amster, Rothstein & Ebenstein LLP discusses the rule of 'presumption against extraterritoriality' in relation to intellectual property law, specifically trademarks, and how the Supreme Court's recent decision in *Abitron Austria GmbH et al. v. Hetronic International, Inc.* has provided guidance on the extraterritorial application of the Lanham Act.

As law students learn early enough, the prerogative to pass and administer the law of the land is the core right of each sovereign nation, defining supremacy and independence of law. Whether a country professes the common or civil system of law, and even with the continued global tendencies towards synergy between these two systems, this does not upend the principle of the territoriality of law. This rule is also known as the 'presumption against extraterritoriality,' meaning that, subject to narrowly tailored exceptions, a country's legislative and judicial systems should not cross over or interfere with those in other countries, allowing for 'harmonious discord.'

The United States (US) is no exception, and this principle permeates the system in all areas of law, including intellectual property (IP) and, in particular, trademarks. While the US Congress has the power to pass laws that explicitly rebut the presumption against extraterritoriality, courts (in particular in view of the US being part of the 'precedential' common law system, affording courts a broader leeway for interpretation of legislative intent) always pose this question before considering other factors that could rebut this presumption.

An interesting preliminary question is whether there is a distinction in the treatment of different types of IP rights.



Max Vern

In the field of patents, the US Supreme Court unambiguously held in 2007 in the *Microsoft Corp. v. AT&T Corp.* case, directing towards a narrow extraterritorial application of the Patent Act, which provides the statutory definition that an infringement occurs when one 'makes, uses, offers to sell or sells any patented invention, within the United States, or imports into the United States any patented invention during the term of the patent therefor.' The primary exception to this presumption against extraterritoriality is a specific regulation in the Patent Act focusing on patented invention components manufactured in the US being shipped abroad to be combined there, leading to an actionable extraterritorial infringement. Application of the above exception, as focused by the Supreme Court in its 2018 decision in *WesternGeco LLC v. ION Geophysical Corp.*, effectively proves the rule.

Similarly, in the field of copyrights, courts have traditionally held that the Copyright Act does not explicitly rebut the presumption against territoriality. To counter it, Circuit Courts adopted a doctrine of 'predicate-act,' which, *inter alia*, dictates the need for certain elements of a domestic infringement to occur in the US in order to make a foreign infringing activity actionable in US courts.

Notably, the US Congress may (even if doing so rarely and in narrowly tailored situations) indeed pass laws that apply extraterritorially. A very recent example is the 2024 decision in the *Motorola Solutions Inc. v. Hytera Communications Corp.* by the US Court of Appeals for the Seventh Circuit, where the panel held that The Defend Trade Secrets Act of 2016 applies to acts occurring abroad, and the apparent rationale could be the protection of national security interests.

Now, on the issue of trademarks (unlike patents and copyrights, the only area of the 'big three' IP

rights not encompassed by the US Constitution and, therefore, almost exclusively protected by a single Trademark Act of 1946, a.k.a. the Lanham Act), for many years there was no clear-cut guidance from the Supreme Court on the issue of sovereign intent for extraterritorial application of the Lanham Act and the applicability of the presumption against extraterritoriality.

The source of guidance until recently was the 1952 Supreme Court verdict in the *Steele v. Bulova Watch* case, where the plaintiff was permitted to sue in Texas for peddling counterfeit watches in Mexico. Since then – silence, and to fill the inadequacy in direction, the US Circuit Courts developed six different tests for interpreting the extraterritorial application of the Lanham Act and the prerequisite elements for making a case against foreign infringement actionable in US courts.

In 1956, in *Vanity Fair Mills Inc. v. T. Eaton Co.*, the Second Circuit considered whether the impugned conduct affected US commerce, whether there was a conflict of rights under laws between the countries involved, as well as the citizenship of the defendants.

In 1976, in *Timberlane Lumber Co. v. Bank of America*, the Ninth Circuit considered, for the purpose of applying the antitrust laws extraterritorially, the impact of infringing activity on US foreign commerce.

In 2005, in *McBee v. Delica Co.*, the First Circuit looked at the effect of the foreign defendants' foreign activity on US commerce.

Probably the last straw in this proliferation of tests, which led the US Supreme Court to step in, was the 2021 decision by the Tenth Circuit in the *Hetronic International Inc. v. Hetronic Germany GmbH et al.* case.

In that instance, the Circuit Court interpreted, more broadly than the earlier fora, the presumption against territoriality and found for application of the Lanham Act to foreign conduct when foreign defendants' conduct involving alleged trademark infringement had a 'substantial effect on US commerce,' even though it was asserted that more than 97 percent of the alleged activity took place abroad and that nobody affiliated with the defendants was based in the US.

At the same time, the Circuit Court has tacitly 'invited' the Supreme Court to interfere, *inter alia* referring to the inadequacy of application of the 1952 *Steele* decision, holding that the latter 'leaves much unanswered about the extent of the Lanham Act's extraterritorial reach.'

Against this background, and in juxtaposition to the discord between Circuit Courts, the growing line of judgments by the US Supreme Court consistently indicated support of the presumption against extraterritoriality in a broad spectrum of legal fields.

With IP becoming one of the more important and fast-evolving pillars of global society, economically and politically, the US Supreme Court was long overdue to address the lack of judicial clarity on the topic in the field of trademarks.

As one of the first harbingers of the overall trend, in the 2010 landmark *Morrison v. National Australia Bank* decision, the US Supreme Court held against the extraterritorial effect of US securities legislation, unanimously finding that a longstanding principle of American law is that 'legislation of Congress, unless a contrary intent



Résumé

Max Vern works with brand owners to secure and enforce their intellectual property around the world. His focus is trademark rights and protection of global trademark portfolios - all facets and stages of domestic and international trademark portfolio management.
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appears, is meant to apply only within the territorial jurisdiction of the United States.'

In 2013, in *Kiobel v. Royal Dutch Petroleum Co.*, the Supreme Court found that the presumption against extraterritoriality applies to claims under the Alien Tort Statute (ATS), one of the historically oldest federal laws still in effect in the US that gives federal courts jurisdiction over actions brought by foreign nationals for violations of international law. The Court held that 'it would reach too far to say that mere corporate presence suffices' to rebut the presumption against extraterritoriality when all the alleged wrongful conduct takes place outside the US.

Then, in 2016, the Supreme Court found in the *RJR Nabisco, Inc. v. European Community* case against the extraterritorial application under the Racketeer Influenced and Corrupt Organizations Act (RICO), and, in 2021, in the *Nestlé USA, Inc. v. Doe* case, the Supreme Court reiterated the *Kiobel* findings, holding that 'general corporate activity' on the US soil leading to the use of forced child labor does not overcome the presumption against extraterritoriality to support liability under the ATS.

Against this background, it was sensible to anticipate the Supreme Court to focus on the IP field, and the appeal on the Circuit Court's decision in *Hetronic* could not come up for the Supreme Court's review at a more opportune moment. The Supreme Court ruling was given in June 2023 as *Abitron Austria GmbH et al. v. Hetronic International, Inc.*

The Supreme Court has unanimously vacated the Tenth Circuit's decision, yet the key to understanding the magnitude of the decision is the rationale behind the split between the majority and minority opinions. The five Justices' majority opinion, meticulously going through its earlier decisions on the issue of presumption against extraterritoriality, reiterated and adopted for the trademark field the same two-step analysis that the Supreme Court applied earlier, for example, in the *RJR Nabisco* case. It was held that, at step one, a court should determine whether the presumption has been rebutted, i.e., if the law gives 'a clear, affirmative indication' that the US Congress intended to apply the statute extraterritorially. If the presumption is rebutted, then the court must assess the law's extraterritorial scope based on the limits Congress has, or has not, imposed on its foreign application.

The first step in the *Abitron* majority opinion was to decide whether the Lanham Act applies beyond the US borders. The majority, specifically rejecting *Hetronic International's* (appellee's) argument that 'commerce' may refer to all commerce that may lawfully be regulated by Congress, including foreign conduct, held that the Lanham Act bears no indication of the legislative intent to rebut the presumption against extraterritoriality.

“**The minority opinion, supported by four justices, weighed heavily on the ‘consumer confusion’ factor, holding that it is the focal point of the Lanham Act and not the use in commerce.**”

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Under step two of the extraterritoriality standard, the majority held that it is 'use in commerce' that provides the dividing line between foreign and domestic applications of the Lanham Act, effectively emphasizing the issue of use in commerce, which leads to infringement, rather than putting the focus on the consumer confusion effect. *De facto*, the majority opinion reiterated the postulates of the US law and practice that trademark rights are derived from use in commerce.

The minority opinion, supported by four justices, weighed heavily on the 'consumer confusion' factor, holding that it is the focal point of the Lanham Act and not the use in commerce.

Yet, probably of equally high significance in the majority decision is the critique of the minority position. The majority held that, under the minority approach, not only 'expansive understanding of the Lanham Act's domestic applications threatens to negate the presumption against extraterritoriality,' but 'the trademark system would collapse,' which would then threaten 'international discord.' In other words, the minority position could lead to an upheaval not only in the presumption against extraterritoriality but question the principles of territoriality of trademark rights and lead to precarious developments in trademark law and practices well beyond the US borders.

Last but certainly not least, while many commentators correctly noted that the *Abitron* decision would perpetuate the need for the protection of trademarks abroad (but isn't this what 'trademark territoriality' is about from the practical standpoint?), little attention was paid to the 'domestic' aspect of trademark protection under the Lanham Act, namely, the use in commerce requirement for the purposes of trademark protection and maintenance.

The prerequisite use in commerce is the bane of trademark owners under the Lanham Act, whether foreign or US-based. Even if foreign owners of rights may initially secure trademark protection by forgoing the duty to establish use in the US, using the foreign registration (§44(e)) or the Madrid Protocol IR (§66(a)) mechanisms under the Lanham Act, all owners must file a Statement of Use between the fifth and sixth years and every 10th year after registration. The almost universal answer given to the duty of use in commerce is that such use must be regulated by the US Congress, i.e., use occurring in the US and not abroad.

Yet, had the decision in *Abitron* been different, there is little doubt that the 'use in commerce' (i.e., in the US) clause would have been subjected to scrutiny from the trademark registration and maintenance angle, opening yet another avalanche of challenges to the Lanham Act. At least for now, this question has been allayed.

Trademark protection in Japan: the essentials of non-use cancellation

Kazutaka Otsuka of Asamura IP delves into the regulations and practices surrounding non-use cancellation trials, outlining eligibility, evidence, and recent precedent decisions.

Résumé

Kazutaka Otsuka is an experienced patent attorney and a lawsuit counsel who focuses his practice on domestic and international trademark and design prosecution. He incorporates global policies for intellectual property protection in his daily work related to IP rights acquisition and client counseling.

As a member of a patent attorney private organization, Kazutaka was involved in the management of the Intellectual Property Foreign Training Department for four years, starting in 2006. In 2011 and 2012, he was a member of the Trademark Committee, a special committee of the Japan Patent Attorneys Association (JPAA).



Kazutaka Otsuka

The trademark non-use cancellation trial is a system that can be used by anyone to file before the Japan Patent Office (JPO) to cancel all or part of a trademark registration on the grounds that the trademark registration has not been used continuously for a three-year period. This system is often used in Japan in relation to cited trademark registrations for the petitioner's trademark application or as a countermeasure when a third party asserts exclusivity of a trademark right.

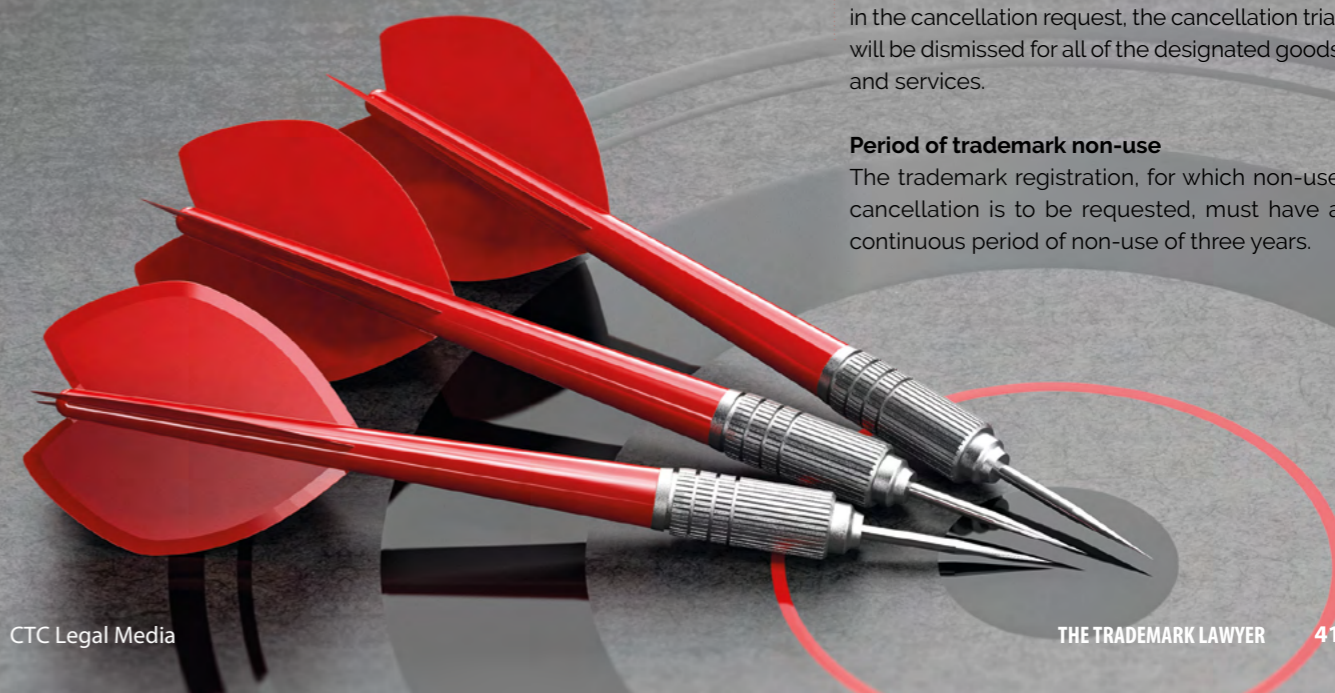
Overview of trials for non-use cancellation of trademark registrations in Japan

Eligible trademark registrations

A cancellation request can be made to cancel all or part of the designated goods and services of a trademark registration. However, if the defendant proves actual use of the registered trademark for any of the designated goods and services raised in the cancellation request, the cancellation trial will be dismissed for all of the designated goods and services.

Period of trademark non-use

The trademark registration, for which non-use cancellation is to be requested, must have a continuous period of non-use of three years.



**Plaintiff eligibility**

Anyone can make a claim, and eligible plaintiffs are not limited to interested parties.

Where to file a cancellation request, and who will examine this

Trademark non-use cancellation trials in Japan are an administrative procedure that should be filed and addressed to the Commissioner of the Japan Patent Office, and a panel of trial examiners shall review the request.

How the trial proceeds

Once a request for a trademark non-use cancellation trial is filed, a copy of the request is forwarded to the respondent, who may submit a counterargument. Following a response, the requester may file a rebuttal argument against the counterargument. In usual practice, the trial examination is conducted with an oral hearing, but the chief trial examiner may choose to, or at the request of the parties concerned, conduct the trial examination by documentary examination.

Average trial period

The average trial period for a trademark non-use cancellation trial in Japan is approximately six to seven months.

The decision of the trial and its effects

If a decision on the cancellation trial is made in favor of the plaintiff and it becomes final and conclusive, the trademark registration is deemed to have been extinguished on the date of the registration of the request for the cancellation trial.

If the request for the cancellation is not granted and a decision is made to dismiss the request, the trademark registration will be maintained.

Appeal against the trial decision

If a decision granting the request for the cancellation trial is made, the defendant may file a cancellation action to the Tokyo High Court within 30 days from the date of the notification of the trial decision.

How to prove trademark use

If a trademark non-use cancellation trial is requested, it is necessary to provide proof of use of the registered trademark in line with the below requirements to avoid cancellation of the trademark registration:

The period during which evidence of use of a registered trademark is required

In response to the cancellation action, evidence proving the use of the registered trademark three years prior to the date of registration of the request for trial (date of advance notice) is required. The date of registration of the request for trial (date

“ It also ruled that the trademark was not used in a manner socially considered to be identical to the registered trademark. ”

”

of advance notice) is often set within a one-month period from the date of the request for cancellation trial. Note that the registration date (date of advance notice) is not the “filing date of the request for trial before JPO.” In addition, if the plaintiff proves that the registered trademark was used after they knew that the request for trial was made, the use of the registered trademark shall not be deemed to be the use of the registered trademark.

Who should use the registered trademark?

The registered trademark must be used by either the trademark owner, exclusive licensee, or non-exclusive licensees. A non-exclusive licensee does not have to be registered on the JPO register.

The manner in which the registered trademark should be used and the related scope

The trademarks should be used in a manner socially considered to be identical to the registered trademark. The use of a similar trademark to the registered trademark is not considered to be the use of the registered trademark in relation to the trademark non-use cancellation trial.

Geographical areas where the registered trademark should be used

It is necessary to use the registered trademark within the territory of Japan.

Evidence of trademark use

Photographs, trade documents, advertisements, articles introducing the goods or services, documents kept by government agencies related to the distribution of goods or the provision of services, etc., may be available as evidence to prove the use of a trademark, but whether or not such evidence is appropriate will be determined on a case-by-case basis depending on the characteristics of the goods or services.

Formal requirements of evidence

From the viewpoint of protecting trade secrets and personal information, partially masking documentary evidence may be permitted within certain circumstances, but it is useful to be mindful of preparing evidence that can be submitted in an unmasked state as much as possible.

Precedent decisions**Acceptable trademark use on the website [Tokyo District Court Cases 2016 (Wa) No. 23327 and 2016 (Wa) No. 38566] [Bromaga Case]**

In this court action regarding the infringement of a trademark right relating to a registered trademark consisting of characters, namely “Bromaga”, the court found that when providing the service on a platform for posting blog articles on a website (which has a function, “Bromaga”,

that allows users to view and post blog articles only if they have paid a subscription fee), when users view an article in a blog magazine that they have not purchased on the webpage of the service provider, the service provider’s act of displaying the beginning of the article (along with a message saying “Read more by purchasing the blog magazine!” and a button indicating “Purchase the blog magazine” constituted the provision of services via visual screen by electro-magnetic means) and that the act of displaying the mark similar to the registered trademark consisting of the characters “Bromaga” on the visual screen constituted use of the registered trademark under Article 2, Paragraph 1, Item 7 of the Trademark Law.

Even though this court action is “infringement lawsuit” but not “cancellation action against administrative decision regarding non-use cancellation trial”, this case is introduced with the reference material posted on the official website of Japan Patent Office as a reference for proving actual use of a registered trademark in relation to trademark non-use cancellation trial in Japan.

Unacceptable trademark use on the website [Supreme Court Case No. 217 of 2009 (Gyo-Hi)] [ARIKA Case]

The request was made for the trial to cancel the registered trademark owned by the company that plans, produces, and sells game software, but there was no fact of use with respect to some of the designated services, e.g., “provision of information regarding the sale of products.”

The trademark owner argued that it had used the registered trademark for the designated services subject to the cancellation trial, namely “provision of information relating to the sale of products” by introducing game software and other products that it had been involved in developing, to consumers through its website which the registered trademark is displayed.

In response, the court ruled that “provision of information regarding the sale of products” should be interpreted as a service of providing information to business entities engaged in commerce to assist in their management, operation, etc., and that introducing products to consumers who are the final users of the products does not constitute “provision of information regarding the sale of products,” and did not recognize that there was the “use of a registered trademark in connection with the designated services related to the cancellation trial.”

Trademark identity (identity between the registered trademark and the trademark in use) was not recognized [Tokyo High Court 2000 (Gyo-Ke) No. 422] [MAGIC Case]

Regarding the registered trademark with the word

“ It is important for trademark owners to be able to obtain information about their trademarks in a timely manner. ”

”

“Magic” written horizontally in Roman letters, the owner of the trademark argued that using the letters “ALOE” and “MAGIC,” written horizontally in two lines one above the other, constitutes use of the registered trademark.

In response, the court ruled that the appearance of the letters “ALOE” and “MAGIC,” those written horizontally in two lines one above the other, should be recognized as a coined word, “ALOE MAGIC,” combining the word “ALOE” which comes from the raw material with the word “MAGIC,” and that the whole words are recognized as constituting a single trademark. It also ruled that the trademark was not used in a manner socially considered to be identical to the registered trademark.

The trademark use on the sales promotion articles was not recognized as use of a registered trademark [Tokyo High Court 2000 (Gyo-Ke) No. 335] [HERTZ Case]

The request was made for a trial to cancel a registered trademark featuring the words “HERTZ” written horizontally in two lines in relation to all the designated goods, e.g., stationery.

The trademark owner argued that the registered trademark (which is the same as the company name) was used on the designated goods because the licensee operating a car rental business had affixed the registered trademark to ballpoint pens and document holders (clips) as promotional articles for the car rental business.

The court determined that a company’s name included on promotional items is primarily for advertising purposes related to products or services offered by the company, which differ from the promotional items themselves. The name does not serve the same distinguishing function as a trademark does, which helps traders and consumers identify a company’s specific products or services. Consequently, consumers did not perceive that the company had utilized the registered trademark for the relevant goods in question.

Practical Advice

It is important for trademark owners to be able to obtain information about their trademarks in a timely manner in order to reduce the risk of cancellation of the trademark registration through a trial for non-use cancellation and to regularly check whether the trademark registrations have consistency with the trademarks in use in relation to the business of the trademark owner.

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Greece's trademark system and its impact on international companies

Irene Kyriakides, Niovi Plemmenou and Terpsithea Papanikolaou of Kyriakides Georgopoulos Law Firm discuss the complexities and challenges faced by multinational corporations in navigating Greece's trademark system, highlighting the need for further alignment with EU laws and improved judicial performance to enhance investment and trademark protection in the country.

Navigating the Greek Trademark System effectively has proven to be a complex endeavor for multinational corporations throughout the years due to several factors. Progress is being made in this regard by certain initiatives introduced in recent years, among which is the alignment of Greek Trademark law with the European Union Trademark law. However, several challenges persist that need to be overcome for international companies to be able to advance their interests and protect their trademark rights efficiently in the Greek territory, such as trademark enforcement and the overall performance of the Greek judicial system.

“ Navigating the Greek Trademark System effectively has proven to be a complex endeavor for multinational corporations throughout the years due to several factors. ”





Résumés

Irene Kyriakides, Partner

Irene is a recognized leader in intellectual property law, dedicated to safeguarding innovations and maximizing the value of intangible assets. Her extensive expertise includes securing and enforcing patents, trademarks, copyrights, and domain names, ensuring her clients' creative and technological advancements are fully protected.

She is a trusted advocate in high-stakes disputes, frequently representing clients before the Trademarks Committee, Administrative Courts, and the EUIPO in cases involving oppositions, cancellations, infringement claims, and domain name disputes. Beyond litigation, Irene crafts sophisticated licensing agreements enabling technology transfers, support collaborative research, and foster innovation, ensuring they align with her clients' long-term business objectives.

Her deep understanding of cross-border operations and multinational business complexities allows her to provide strategic advice on managing intellectual property risks globally. Irene anticipates challenges in the evolving IP landscape, addressing digital transformation, regulatory changes, and emerging technologies (AI and blockchain). By combining technical expertise with strategic foresight, Irene helps clients unlock the full potential of their intellectual property as a driver of innovation, growth, and competitive differentiation.

Niovi Plemmenou, Associate

Niovi is an associate at KG's intellectual property department. Her focus is on IP law matters concerning trademarks, copyright, design and patents. She is engaged in the strategic handling, expansion and enforcement of worldwide trademark portfolios of international corporations while providing related consulting in terms of brand development. Further, she has an expertise in IP related transactions and Due Diligence; is involved in the drafting and negotiation of various types of IP related contracts and licenses. She has also published several legal articles covering contemporary IP Law issues and holds an LLM in Intellectual Property Law from the University of Aberdeen.

Terpsithea Papanikolaou, Junior Associate

Terpsithea is a member of KG's intellectual property and data protection & privacy practice group. She contributes to the effective management of intellectual property rights (trademarks, industrial designs, designs, copyrights, etc.) regarding both consulting and litigation matters. In addition, she deals with data protection issues (GDPR compliance, drafting and review of contracts and policies, advisory services, etc.), cybersecurity, and Artificial Intelligence (AI). She participates regularly as a speaker or lecturer in conferences and seminars and publishes articles on the above-mentioned areas of law. She is also an Advisor of the Institute of Artificial Intelligence, Personal Data and Digital Governance Law.

Global brand owners need to be provided with additional incentives in order to decide to invest in the Greek market and pursue the registration of their trademarks in Greece with the aim of securing their valuable global brand image against imitators and competitors. Greece should further adapt to the ever-evolving landscape, the challenges posed by globalization,

and the subsequent trademark crowding and depletion.

Greece's position in the EU and the global trademark system

The Greek Trademark System is comprised of the Greek Trademark laws, the Greek judicial system, and authorities such as the Greek trademark office (the Hellenic Industrial Property Organization (in Greek "OBI")). The harmonious intersection of each component of the system is what leads to the cultivation of an efficient system.

Greece's current position in the European Union (EU) is impacting the performance of the Greek trademark system and how multinational corporations view Greece. In general, the advancement of the Greek economy in recent years has led to the steady betterment of Greece's position in the EU. This is directly correlated with the decision of multinational corporations on whether to ultimately proceed with trademark registrations in the Greek territory. In this regard, the distribution of the number of trademarks of a multinational corporation between certain countries relates to the different income levels of each country and the relevant conditions of each market. Therefore, the trademark filings of each multinational corporation can be seen as a way of investing in intangible assets, which indicates the magnitude and profitability of a corporation as well as its brand value.

Global brands have become immensely powerful in recent years due to the technological advancements and interconnectivity attributed to globalization, and thus, they place great value in protecting their brand identity and associated goodwill by devising strategies regarding the expansion of their trademark portfolio and its enforcement across the globe. Tools such as the Madrid Protocol are great examples that aid global owners in securing the registration of their trademarks simultaneously in many jurisdictions, including Greece, in a more cost-efficient way. Further, the number of unauthorized trademark uses by third parties poses concerns for global brand owners. In this regard, international corporations need to perceive that their trademark rights will be efficiently protected and enforced against any third parties that could be violating their rights so that they can decide to pursue the registration of their trademarks in Greece and expand in the Greek market.

In this respect, a multinational corporation needs to have an incentive to proceed with the registration of its trademarks in the countries where it is distributing its products. In terms of registrations in multiple jurisdictions, international corporations weigh in on multiple factors. The effectiveness of the trademark system, and in this case, Greece's trademark system, constitutes

an integral part of this decision. For example, important factors include how fast and smoothly a trademark could be registered in Greece, whether proper examination of each trademark application is performed by the examiner, as well as any bureaucracy regarding the trademark registration process.

The current high levels of trademark depletion and trademark crowding in the global trademark system also constitute a deciding factor for the trademark strategy of multinational corporations. The global trademark system and the position of Greece in it are further challenged by globalization and constant market integration. Therefore, multinational corporations, before entering the Greek market and deciding to acquire trademarks with effect in the territory of Greece, devise strategies on how to navigate the Greek trademark landscape and the challenges it presents, such as the levels of trademark enforcement attributed to the overall performance of the Greek judicial system.

Further, to combat the spread of counterfeit products in Greece, which harm international companies, a multifaceted approach is essential for effective protection. This approach will strengthen laws and enforcement through the closer alignment of national laws with EU and international standards. Specialized intellectual property (IP) enforcement teams within customs and police departments can focus on detecting and seizing counterfeits at borders and in domestic markets, while the fast-tracking of IP cases before the competent courts can streamline legal processes for businesses to address the circulation of counterfeits quickly and effectively. In this direction, Greece, in 2020, established "DIMEA," an interagency structure with the aim of addressing illicit trade in counterfeit goods. Said unit is comprised of the Financial and Economic Crime Unit of the Ministry of Finance, the Coast Guard, the Police, and customs authorities.

Another significant milestone was the removal of Greece from the Special 301 Watch List in the same year, which highlighted the progress in terms of IP protection and enforcement. It is noteworthy that according to the 12th edition of the International IP Index, which measures the IP framework globally, Greece has received an overall score of 71.42, while in terms of trademark matters has received a score of 56.25.¹

Greek trademark law and the role of the trademark authorities

In terms of the Greek landscape, the introduction of Law 4679/2020 in the Greek trademark system, which implemented changes for Greece to align with the rest of the EU (transposed Directive (EU) 2015/2436), can be considered a positive change in the right direction regarding the modernization



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and reform of the Greek trademark system and the operation of international corporations. An example of beneficial changes is the introduction of additional types of trademarks and certification marks into the Greek trademark system as well as the institution of the application for proof of trademark use before the Administrative Trademark Committee ("ATC") and the civil courts.

Another positive change was the fact that OBI has been competent since 2022 for the administration of the Greek trademark register, whereas prior to that, the competent authority was the General Secretariat of the Ministry of Development and Investment. The rationale for the transfer of the trademark-related competencies to OBI was the designation of a single authority for the registration of all industrial property rights (trademarks, patents/utility models, and industrial designs) according to the European and international practice, since Greece was one of the few countries where different stakeholders were responsible for different industrial property rights. This legislative reform aimed to provide higher-quality services to trademark owners.

In this respect, it should be noted that the official fees regarding the registration of Greek trademarks remain low, which further constitutes an incentive for multinational corporations to acquire trademark protection in the Greek territory. Further, one notable difference due to the transfer of the trademark-related competencies to OBI has been the acceleration of the time between the filing of the application and the publication of the Examiner's decision accepting or rejecting the application.

However, challenges remain. It is observed that OBI is generally not strict in the examination of absolute grounds, and this could lead to the acceptance of non-distinctive or descriptive signs. This inconsistency in the application of absolute grounds for refusal could cause the saturation of the trademark register and further trademark crowding and depletion. It is noted that OBI does not yet have a digitally accessible trademark register in place. All the data of Greek trademark registrations and applications are currently available only through the public trademark database "TMView." Further, OBI only publishes certain decisions of the ATC online and not in their entirety (e.g., in a dedicated section of its website), and thus, unnecessary delays occur for trademark applicants and holders regarding the reporting of the decisions that concern them.

Additionally, it has been observed that the ATC, which is competent for examining recourses against decisions of examiners refusing trademark applications, oppositions, cancellation, and invalidity actions, could at times deliver decisions with insufficient reasoning and without proper application of the EU and Greek trademark

¹ US Chamber of Commerce Global Innovation Policy Center, "International IP Index", 2024, Twelfth Edition, https://www.uschamber.com/assets/documents/GIPC_IPIndex2024_Full-Report_v4.pdf, pages 5 and 13.



case-law, which could cause uncertainty to multinational corporations wishing to protect their Greek trademarks. Although Law 4679/2020 stipulates that, instead of OBI's employees/legal advisors, external legal practitioners specializing in trademark law may be members of the ATC, this option is not frequently utilized. The participation of those legal practitioners in the ATC could positively impact the quality of decisions.

The role of the Greek judicial system in handling trademark cases

A closer examination of the handling of trademark conflicts in Greece and how the judicial system impacts multinational corporations could shed light on the present challenges that need to be overcome, considering the duration of the proceedings and the quality of the judgments delivered in each case.

In the Greek trademark system, the administrative courts are competent for adjudicating recourses against ATC decisions on oppositions and recourses against decisions of examiners refusing trademark applications. Civil courts are competent for trademark infringement cases based on unfair competition provisions and recourses against ATC decisions on invalidity/cancellation actions, whereas criminal courts hear cases regarding trademark-related criminal offenses.

Regarding civil proceedings, pursuant to a requirement set forth in EU law, Articles 6-10 of Law 2943/2001 stipulate that specialized sections within civil Courts of First Instance and Courts of Appeals in Thessaloniki and Athens are designated as EU trademark courts, with all competences provided for in EU trademark law. Those judicial formations are comprised of judges with experience and expertise in trademark and, in general, IP law and may also hear cases concerning infringements of national trademarks.

Due to the expertise of those judges, the judgments delivered on trademark infringement cases are, in general, of good quality, with sufficient reasoning and a considerable effort in applying EU case law. According to the 2024 EU Justice Scoreboard published by the European Commission, Greece is in the 24th place out of 26 Member States for which data is available regarding the time needed to resolve litigious civil and commercial cases (approximately 800 days for first court instances and 400 days for second-instance courts according to the data for the year 2022), and when it comes to the average length of EU trademark infringement cases, Greece is in the 14th place out of 22 Member States for which data is available (approximately 600 days according to the data for the year 2020)². Therefore, there is considerable room for improvement in terms of the speed of justice in the Greek judicial system.

“
The harmonious intersection of each component of the system is what leads to the cultivation of an efficient system.”

”

² European Commission, “The 2024 EU Justice Scoreboard”, Luxembourg, Publications Office of the European Union, 2024, https://commission.europa.eu/document/download/84aa3726-82d7-4401-98c1-fee04a7d2dd6_en?filename=2024%20EU%20Justice%20Scoreboard.pdf&prefLang=el, pages 11 and 17.

³ European Commission, “The 2024 EU Justice Scoreboard”, Luxembourg, Publications Office of the European Union, 2024, https://commission.europa.eu/document/download/84aa3726-82d7-4401-98c1-fee04a7d2dd6_en?filename=2024%20EU%20Justice%20Scoreboard.pdf&prefLang=el, page 12.



It is noteworthy that administrative courts do not have dedicated judicial formations in place for hearing trademark-related cases, and this factor has a negative impact on the quality of the judgments delivered in trademark-related cases compared to the judgments delivered by civil courts. In addition, while there is no available data regarding the speed of justice in resolving such cases, according to the 2024 EU Justice Scoreboard, Greece occupied the 24th place out of 25 Member States for which data is available regarding the estimated time needed to resolve administrative cases at all court instances according to the data for the year 2022³.

Final thoughts

Overall, the attempted legislative reforms in recent years have positively impacted the protection of trademarks owned by international corporations in Greece. However, there is still considerable room for growth in terms of the modernization of Greece's trademark system, which will provide sufficient incentives for multinational corporations. The deficiencies, delays, and inconsistencies in the delivery of decisions both on an administrative and judicial level are challenges that ought to be overcome. Greece's attractiveness as a jurisdiction regarding the effective protection of trademark owners and global brands could be significantly enhanced if additional changes are implemented by the stakeholders in all pillars of the Greek trademark system.

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Strategies for brand abandonment and revitalization

Giovanni Orsoni of Dennemeyer & Associates, Italy, identifies the complexities surrounding faded corporate identities, weighing up the benefits and risks of reviving legacy brands.

Brands are not always built to last. As consumer interests shift, some eventually outgrow their relevance, becoming stale or outdated. Others lose their appeal through neglect, fading from recognition or even, on the contrary, morphing on account of extreme popularity without proper oversight¹ into generic terms. Sometimes, sudden blows, such as a health scandal, a risky brand extension, or an unfortunate association, can tarnish them overnight.

Without active investment and protection, even once-iconic names may lose their distinctiveness or cease to function as symbols of origin. At times, brand owners decide to move on, choosing



Giovanni Orsoni

not to renew or refile trademark registrations. However, in many jurisdictions, they do not always have a choice: after a grace period, they may be required to prove genuine use to retain their rights.

Specific national intellectual property (IP) laws should also be considered on a case-by-case basis, such as the Italian Intellectual Property Code, Article 12 Paragraph 2², which states that a prior trademark that has expired for more than two years does not affect the novelty of a subsequent application for a similar or identical mark.

Rising again

When one story ends, another can begin. Abandoned brands can be resurrected, refreshed, and introduced to new audiences. The drive to restore an old name may stem from a nostalgic appeal, a bid to tap into lingering loyalty, or a sense that the brand can resonate with a new demographic. Financially, it can also be a savvy move, as building on existing goodwill may be more cost-effective than creating, protecting, and promoting an entirely new identity. Investors, too, may acquire brands at a low cost following bankruptcy or insolvency proceedings.

There are three main ways in which a brand can be rekindled. First, the original owner may decide to use the name for a new product or range, particularly if it has residual IP rights that are still valid. Second, the brand may be sold or licensed to a third party that is interested in taking it in a different direction. Third, an independent business may seek to adopt a brand that has been abandoned for a period of time.

There are successful examples of all three approaches. However, each raises particular legal

and business issues that need to be navigated to avoid loss of protection or the risk of disputes.

The first approach encompasses a range of revitalization efforts, such as the recent announcement by ITA Airways that it will start to incorporate the legacy Alitalia brand³, last used in 2021, as a consequence of the latter's most recent bankruptcy.

An older example is that of Ben & Jerry's ice cream, founded in 1978. After suffering lackluster sales since the late 1980s, which almost resulted in its demise, the brand was resurrected by Unilever after it acquired the frozen dessert company in 2000.

Several car brands have also been brought back after periods of decline or lost popularity, including the Mini Cooper and VW Beetle. Others have a surprisingly varied backstory of brand reinvention, for example, the Mazda company in Japan, once a cork-making factory, later produced machine tools and motorized rickshaws before eventually becoming associated with passenger cars, as it remains today. In Finland, Nokia started as a paper and rubber manufacturer before it became globally renowned for mobile phones and later attached to a network equipment and licensing business.

In one example of the second approach, MG cars, a once-luxury brand that has been through

“**The drive to restore an old name may stem from a nostalgic appeal, a bid to tap into lingering loyalty, or a sense that the brand can resonate with a new demographic.**”

several changes of ownership, is now used by Chinese company SAIC Motor for electric vehicles. In another, POLAROID is now used on instant cameras and other technology products after the Polaroid Corporation was declared bankrupt and the brand sold in the early 2000s. Similarly, the Palm brand of personal digital assistants (PDAs) and its associated operating system, webOS, changed hands frequently. Shooting to fame in the 1990s and early 2000s, the IP was sold from the wound-up Palm Inc., first to Hewlett-Packard and then separately to different companies. The operating system went to LG, who put the trademark to use for their smart TVs “powered by webOS,” while the Palm name was bought by the TCL Corporation, which in 2018 introduced a new small form factor (SFF) smartphone under the historic mark.

The third approach encompasses brands such as Treets, formerly maintained by Mars for peanut chocolate sweets in France but phased out in favor of M&M's. The Treets brand is now used by Piasten (distributed by Lutti) for peanut chocolate sweets – but with orange rather than yellow packaging. Mars took its rivals to court in France for unfair competition, disparagement, parasitism, and deceptive commercial practices, with the Court of Cassation ruling in favor of Piasten and Lutti⁴.

Résumé

Giovanni Orsoni is qualified as a lawyer in Italy and as a solicitor in England and Wales. He has worked in Venice, London, and Milan, specializing in trademarks, copyrights, domain names, designs, and trade secrets, with extensive experience in prosecution, litigation, and contract negotiation. He serves as a panelist for .eu domain disputes at the Czech Arbitration Court and provides IP services for clients in hospitality, food & beverage, entertainment, mobility, and web sectors, advising leading Italian producers and cultural institutions. Giovanni is also passionate about the creative and digital industries, focusing on technology's impact on IP issues.

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¹ <https://www.dennemeyer.com/ip-blog/news/too-much-of-a-good-thing-when-trademarks-die/>

² https://wipo.int/edocs/lexdocs/laws/en/it/it219en_1.pdf#page=6

³ <https://www.businesstravelnewseurope.com/Air-Travel/ITA-Airways-to-resurrect-Alitalia-brand>

⁴ <https://www.courdecassation.fr/decision/65833fa63ea7c8c1129c058f>





No surviving reputation

Disputes such as those involving Treets can arise when a third party resurrects a legacy brand without authorization from the original owner. If the third party files a trademark application for a dormant or defunct brand, the question arises whether it was made in bad faith.

This was illustrated by a case concerning the Nehera brand for clothing and other goods. Established in the 1930s in Czechoslovakia by businessman Jan Nehera, it distributed through more than 130 outlets by the Second World War. Following the communist takeover of Czechoslovakia, the business was nationalized, and the Czech trademark was deleted in 1946.

In 2013, Slovakian businessman Ladislav Zdút applied to register an EU trademark (EUTM) for a figurative sign depicting the Nehera name. After the mark's registration in October 2014, Jan Nehera's grandchildren sought to invalidate the mark on the grounds of bad faith.

In a March 2021 decision, the Second Board of Appeal of the European Union Intellectual Property Office (EUIPO) found that Ladislav Zdút was aware that Jan Nehera and the former Czech trademark "retained a certain surviving reputation." The Board of Appeal found that the applicant had attempted to create an unjust association by taking advantage of this reputation and, therefore, acted in bad faith.

However, in its judgment in July 2022 (Case T-250/21)⁵, the EU General Court reversed this decision. It said that, on the date when the EUTM application was filed, the former Czech mark and Jan Nehera's name were no longer registered, protected, used, or even widely recognized in connection with clothing. It concluded:

"In those circumstances, in the absence of surviving reputation in respect of the former Czechoslovak trademark and of current celebrity in respect of Mr Jan Nehera's name when the application for registration of the contested mark was filed, the subsequent use of that mark by the applicant was not, in principle, capable of constituting free-riding behavior indicating bad faith on the part of the applicant."

This finding was not undermined by the fact that Ladislav Zdút claimed that his business "revived" or "resurrected" the Nehera brand. The Court reasoned that "far from merely having exploited in a parasitic way the past reputation of the former Czechoslovak trademark, and the name of Mr Jan Nehera, the applicant made his own commercial efforts in order to revive the image of the former Czechoslovak trade mark and thus, at his own expense, to restore that reputation."

Moreover, he did not create a false impression of continuity or inheritance, if anything, drawing



istock.com/Alphatographic

If the third party files a trademark application for a dormant or defunct brand, the question arises whether it was made in bad faith.

attention to an interruption. Crucially, Jan Nehara's descendants did not own any rights at the date of the application, and it was not established that Ladislav Zdút was "driven by a dishonest state of mind or intention" when filing the application.

Free-riding on reputation

The outcome in the Nehera case contrasts with that in another, older instance involving cars because of different premises regarding the legal rights at stake and the behavior of the parties. This case concerned an application to register the word "Simca" for goods in class 12, which was filed in 2007 and registered in 2008. GIE PSA Peugeot Citroën then applied to invalidate the mark on the grounds of bad faith, arguing that it maintained trademark rights in "Simca," although it admitted the name had not been used in recent years. It also argued that the applicant had no genuine desire to use the mark but merely wanted to obtain leverage.

In April 2012, the Board of Appeal reversed the decision by the EUIPO⁶ (then known as the Office for Harmonisation in the Internal Market) not to

invalidate the third-party mark and sided with GIE PSA Peugeot Citroën. Then, the EU General Court upheld that Board decision in May 2014 (Case T-327/12)⁷. It said the Board was entitled to infer "that the real purpose of the former proprietor's application for registration of a Community trademark was to 'free-ride' on the reputation of the intervener's registered marks and to take advantage of that reputation."

The Court added that "the evidence in the present case establishes that registration of the sign at issue was deliberately sought in order to create an association with the earlier marks and to take advantage of their reputation on the motor vehicle market, even to compete with those earlier marks if they were re-used by the intervener in the future." Even though GIE PSA Peugeot Citroën was not using the Simca mark at the time, the Court noted that it might do so in the future – especially as there were other examples of car brands being revived, such as Dacia.

Factors to consider

There are several points for businesses to consider when it comes to legacy brands, both from the

point of view of seeking to enliven them and protecting existing rights.

For owners of historic brands that have fallen out of favor, the main question to decide is whether or not to maintain them. Many IP departments are under pressure to cut costs, which may lead to talk about abandoning unused marks. However, before any rash decisions are made, consideration should be given to whether the mark is still being used for selected goods/services or in certain territories. Even when the proprietor has no interest in using the trademark at all, it may be possible to extract some value by selling or licensing the IP rights associated with it.

Even limited use in some markets may be enough to maintain a mark. In its judgment in Joined Cases C-720/18 and C-721/18⁸ concerning the Testarossa mark, the EU General Court said that a mark registered in respect of goods and their replacement parts must be regarded in principle as having been put to use for those goods even if it has only been used in respect of some of the goods or replacement parts/accessories. A mark is also capable of being put to genuine use when the proprietor resells second-hand goods or provides certain services connected with the goods, said the Court.

For third parties looking to take up old brands, the cases discussed above provide three main lessons. First, it is important to establish if there are any valid IP rights in force that can be licensed or acquired before launch.

Second, if there are trademark registrations that have not been put to genuine use for a long period, then consideration should be given to filing an invalidation action based on non-use. If successful, that will clear the field to file new applications.

Third, when it comes to assessing whether applications are made in bad faith, the specific facts will be critical. In the Nehera case, there was no bad faith as the trademark applicant was found to be paying tribute to a legacy brand, but in the Simca case, the applicant's behavior, combined with the different residual fame of the unused name, led to a finding of free-riding.

Legacy brands can be powerful marketing tools, but the IP issues surrounding them may be complex. Decisions about when and how to use them (or not to do so) should, therefore, be carefully considered, weighing up all the benefits and risks.

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⁵ <https://curia.europa.eu/juris/document/document.jsf?text=&docid=262324&pageIndex=0&doclang=EN&m ode=lst&dir=&occ=first&part=1&cid=1114969>

⁶ https://euiipo.europa.eu/eSearchCLW/#key/trademark/APL_20120412_R0645_2011-1_006489371

⁷ <https://curia.europa.eu/juris/document/document.jsf?text=&docid=151948&pageIndex=0&doclang=EN&m ode=lst&dir=&occ=first&part=1&cid=1131247>

⁸ <https://curia.europa.eu/juris/document/document.jsf?text=&docid=232724&pageIndex=0&doclang=EN&m ode=lst&dir=&occ=first&part=1&cid=10248555>



What can happen to a generic US trademark: how *Fantasia* provides a roadmap

Amanda Hyland of Buchalter examines the *Fantasia Dist. Inc., v. Myle Vape Inc. et al.*, case which provides a framework for a successful cancellation based on genericism, offering considerations that mark holders and mark challengers should make in cases involving a potentially generic mark.

On August 28, 2024, the District Court for the Eastern District of New York canceled two trademark registrations for the term “ice” that had been registered in connection with various hookah and e-cigarette products. In *Fantasia Dist. Inc., v. Myle Vape Inc. et al.*, Case No. 1:20-cv-02378-KAM (EDNY), the Court canceled these registrations on the basis that the term “ice” was generic for a popular cooling flavor additive used in many e-cigarette flavors.

Successful cancellation of a registered trademark due to genericism occurs infrequently,



Amanda Hyland

For a roadmap on how it can be achieved, the *Fantasia* summary judgment order points to some practical tips to consider in any United States (US) case involving a potentially generic mark, both for the mark holder and the defendant.

Background

Fantasia owned two trademarks for the term ICE, registered with the United States Patent and Trademark Office (USPTO). Both registrations covered hookah and e-cigarette products, and both were incontestable.

In May 2020, *Fantasia* filed suit asserting claims for federal trademark infringement against six defendants and filed an additional lawsuit against seventeen additional defendants several months later (*Fantasia Dist. Inc., v. Megellan Tech, et al.*, 20-cv-4340 (KAM)(VMS)). Several defendants in the initial case moved for summary judgment on the issue of genericness, arguing that the defendants themselves used the term in a purely descriptive manner and that the registrations should be canceled because the term “ice” had become generic in the e-cigarette industry to describe “cooling” flavors of e-liquid.

Irrelevance of incontestable status

When a US-registered mark has been used continuously for five consecutive years after registration and is still in use in commerce, the mark is “incontestable.” See 15 U.S.C. § 1065. An incontestable mark “shall be conclusive evidence... of the registrant’s exclusive right to use the registered mark in commerce.” *Gruner + Jahr USA Pub. v. Meredith Corp.*, 991 F.2d 1072, 1076 (2d Cir. 1993).

The *Fantasia* Plaintiff argued that the incontestable status of its trademark registrations was reason alone to end the inquiry into the cancellation claim. This argument, however, ignored the US Supreme Court decision in *Park ‘N Fly, Inc. v. Dollar Park & Fly, Inc.*, 469 US 189, 194-95 (1985), in which the Supreme Court held that “[g]eneric terms are not registrable, and a registered mark may be canceled at any time on the grounds that it has become generic.” The *Fantasia* Court therefore proceeded with its analysis of the genericness of the term “ice.”

Genericism factors

Many US courts have outlined lists of possible evidence of genericism. See *In re Merrill Lynch, Pierce, Fenner & Smith, Inc.*, 828 F.2d 1567, 4 U.S.P.Q.2d 1141, 1143 (Fed. Cir. 1987) (“Evidence of the public’s understanding of the term may be obtained from any competent source, such

“**The *Fantasia* Plaintiff argued that the incontestable status of its trademark registrations was reason alone to end the inquiry into the cancellation claim.**”



as purchaser testimony, consumer surveys, listings in dictionaries, trade journals, newspapers, and other publications.”) In the *Fantasia* case, the Court analyzed several categories of such evidence, including social media, which has not been widely cited in genericism cases.

Evidence of third-party use

Perhaps the most compelling evidence of genericism is the volume of use of the particular term by third parties. In the *Fantasia* case, the Defendants produced images of 58 third-party uses of the term “ice” or “iced” used descriptively on e-cigarette products, along with an affidavit from counsel authenticating that the images were captured on retailer websites.

The Court noted that the numerous third-party uses of “ice” indicated not an “indication of its origin” or source, but rather an “indication of

Résumé

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the nature or class of" the non-party manufacturers' products. Moreover, the Court pointed to the Plaintiff's failure to take any action against those uses, finding that "a competitor's generic use of a mark that the trademark holder has not challenged "strongly supports a finding of genericness."

Survey data

The Defendants' use of a survey was also helpful in showing genericness. The survey expert concluded that "82% of respondents believed that "ice" is a common word and not a brand name and that 87% of respondents believe the word "iced" is a common word and not a brand name." The Court found the survey to be persuasive and noted that "(1) the population of survey participants was limited to members of the relevant consumer group, and that (2) respondents were prompted to draw explicit comparisons between the relevant terms as 'common words' and as 'brand names.'" Notably, the Court rejected the Plaintiff's argument that survey results should be viewed in the inverse – that 14.5% of respondents did identify the term "ice" as a source identifier.

Social media evidence of consumer usage

The *Fantasia* case provides a framework for the use of online bulletin boards as evidence of genericism. The Court overruled the Plaintiff's hearsay objection and considered evidence from social media, namely, Reddit posts where users were discussing e-cigarette products. The Court determined that the Reddit posts were "not offered by Defendants for the truth of any matter asserted in the statements; instead, they show how consumers use the term "ice" when discussing smoking product flavors." The Court also determined that the posts were admissible under the state-of-mind hearsay exemption under Fed.R.Evid. 803(3). After allowing the posts into evidence, the Court took note that numerous posts referred to "ice" in a generic manner.

News articles

The Court again overruled the Plaintiff's hearsay objections and considered numerous newspaper articles that referred to "ice" -flavored e-cigarette products generically. The Court was clear that such articles were not "proof" of genericness but were an "indication" worthwhile of consideration.

Lack of an alternative term

A major consideration in any genericism case is whether a "commonly used alternative" term exists for the word. Notably, the law does not mandate that only one generic term may exist for a product, nor is the standard whether there may exist another possible word to describe the product. *In re 1800Mattress.com IP, LLC, 586 F.3d 1359, 1364, 92 U.S.P.Q.2d 1682 (Fed. Cir. 2009)* (Rejecting applicant's argument that there can be only one generic name of a product or service.)

The *Fantasia* Court noted that the use of the term "ice" by nearly five dozen competitors was proof enough that a "commonly used" alternative did not exist.

Plaintiff's unpersuasive evidence

The *Fantasia* Plaintiff relied on three declarations from its distributors who stated in "nearly identical" language that they believed the term "ice" to be source-identifying of Plaintiff's products. The Court was not persuaded, noting that the critical inquiry is whether the "buying public" recognized the term as a source identifier. The distributors were industry professionals and, therefore, did not represent the opinions of the appropriate class of consumers. Additionally, the Court cited cases where such declarations raised credibility and objectivity concerns. *See, e.g., Jewish Sephardic Yellow Pages, Ltd. v. DAG Media, Inc., 478 F. Supp. 2d 340, 370 (E.D.N.Y. 2007)* ("Unlike a survey of disinterested consumers,

affidavits from a handful of individuals doing business with one of the parties pose issues of objectivity; understandably, courts have concluded that "testimony from persons closely associated with the plaintiff does not adequately reflect the views of the buying public.")

In this case, without any objective evidence to weigh against the survey, third-party use, Reddit posts, and newspaper articles, the Court concluded that the Plaintiff had failed to create an issue of fact for a jury and ordered that the registrations be canceled. The Court further held, alternatively, that no issue of fact existed as to infringement because the Defendants made purely descriptive uses of the term "ice," constituting fair use.

Takeaways

The *Fantasia* case provides a framework for a successful cancellation based on genericism, even in the case of an incontestable trademark.

For the mark holder

The Plaintiff in *Fantasia* relied far too heavily on the incontestable status of its registrations. Incontestability is simply irrelevant when genericism has been asserted. Any mark holder who plans to assert a registration that could be generic should think carefully about whether it has adequately policed its mark in the past, whether significant competitors' generic use of the mark might be identified, and how the mark is used by the media and in internet forums. If these factors point to genericism, the registration would likely be challenged in any infringement action. It's also clear from *Fantasia* that a handful of declarations from friendly distributors is insufficient to create a jury issue.



The Court determined that the Reddit posts were "not offered by Defendants for the truth of any matter asserted in the statements; instead, they show how consumers use the term "ice" when discussing smoking product flavors."



For the mark challenger

Fantasia demonstrates that the key to a successful cancellation is evidence and lots of it. No one factor is dispositive, so summary judgment can only be achieved through a "piling on" strategy. The Defendants in *Fantasia* did not rely on third-party use alone or a survey alone, but on both, alongside real-world use by consumers themselves. The use of social media posts easily overcame the Plaintiffs' hearsay objections and provided the clearest picture of real people using the term in a generic sense.

The *Fantasia* Defendants also appropriately - fair use, which provides insurance even if the cancellation was overturned on appeal. This strategy should also be considered by any defendant in a similar position.

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The culture of happiness

Diane Silve, Director & Senior Trademark Counsel at Mondelez International, shares insights on fostering a positive and productive team culture through the lens of happiness and collaboration.

Have you paused, even for a short moment, to consider your team's culture and the importance it has for you and your colleagues?

Over the years, I realized that culture could have a huge impact on how a group functions. While not intending to provide HR guidance as to how the culture of IP teams should be, I would like to share some of my own reflections based on observations made throughout my experience of 25 years in the IP profession, having worked in different IP structures (IP firm, in-house), team environments, and countries.

"Team Culture" is commonly defined by various authors with a few recurrent keywords such as Values, Goals, Beliefs, Behaviours, and Work Environment, all shared by a team. Team Culture may be used in combination with terms like "high



Diane Silve

performing," "achieving," and "competitive," or even sometimes having negative connotations such as "toxic" or "culture of fear". The culture of a team will not only influence a team's performances but, first and foremost, how each member of that team may feel daily. This, to me, is of the utmost importance as it will determine how a team will eventually work as an entity. I will not discuss here what could make a "high-achieving team" or a team with a "culture of excellence." Nor will I talk about what we would not want to see in a team. Instead, I will focus on simple and affordable steps we could all take, should we want, to build and foster a happy, kind, and positive culture within IP teams, which I would refer to as the *Culture of Happiness*.

While I am very privileged to work within a team where I feel happy, cared for, valued, and heard by leaders and my colleagues, I have also experienced during my career different types of culture. Rich off these different experiences, I can appreciate the effect team culture has on how I, and my IP colleagues within each team, feel and have felt overall.

Because people spend most of their time at work, feeling happy there, or at least being in an environment that is not detrimental to their mental health, will have a major impact on their life and their wellbeing. I believe that happy and valued employees will sleep better and will have more energy to practice physical activity or, for instance, to make conscious food choices. Also, there is evidence supporting the link between employees' happiness and their performances and productivity – on their own and/or within a group – focus, and sense of commitment to their team.

I have observed that leaders that wanted to build a culture of happiness for and with their team were intentional and authentic about it. It was not enough for them to think this would be the right type of culture they wanted for their team to make it happen. I noticed the team culture

was at the top of those leaders' strategic roadmaps. They understood that a strong culture would be the cement to all the other priorities of their team. These leaders were walking the culture talk. For instance, they would not only say that caring was important, but they would actually care, asking questions and wanting to know more about their colleagues, their struggles, and happy moments. They would also have their colleagues' back when needed, which would inspire trust. For those leaders, a culture of happiness would not be just a box to tick. I could see how they would be strongly committed to their team, investing time and energy in the team's culture, but above all, they would be interested to understand their team, its members, and their needs.

As individuals, we all have different needs, preferences, or, for instance, work rhythms. With all these differences, it can be tricky to appreciate what makes a team's identity, its essence. Especially when the team is spread over different functions (e.g., Trademarks and Patents), offices, countries, and even sometimes in different parts of the world and/or with different mother tongues across team members. Compared to other fields of law, the IP world is quite particular as teams often work internationally and with colleagues across the globe. I observed over the years that leaders who wanted a culture of happiness equally appreciated the differences and the commonalities existing within their team. Building on those as strengths to bring their team together and, with everyone, to create a strong culture based on the uniqueness, shared values and sense of purpose of their team.

The culture of a team should not sit solely on

“**Knowing that everyone's contribution to the team's culture is important and equally valued irrespective of the role and the seniority of the person.**”

”

its leaders' shoulders. Creating and fostering a culture of happiness is the responsibility of each team member, for their own good first, for their colleagues, and broadly for the group. From the leadership team to individual contributors, everyone has an important and unique role to play.

There are so many aspects that could create a strong team culture. I will not go through all but will share what are, to me and based on my observations, the essential pillars of a culture of happiness (the different Cs of Culture), which can be nurtured by individual members and/or as a group:

- *Care* – caring for others with simple gestures such as bringing a coffee to a colleague who is not at their best, asking for news about a colleague's sick child, being especially kind and attentive when a teammate is going through hard times, or handing over a birthday card.
- *Connect* – organizing regular touch points with the team as a whole but also within smaller groups to discuss work projects or new case law, but also to share about how people are, what they are looking forward to, what makes them happy, what they find difficult and also to have fun and celebrate together.
- *Celebrate* – cheering on the greatness of the team and its members with special moments which don't need to

“**There is evidence supporting the link between employees' happiness and their performances and productivity.**”

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Résumé

Diane Silve is Director & Senior Trademark Counsel at Mondelez International. She has more than 20 years' experience as an IP lawyer. She has worked both in-house and in IP firms for various industries and in different countries. Diane is also a registered Yoga teacher and qualified in personal performance coaching and naturopathy. Diane is passionate about wellbeing and generally wants to understand and promote how IP professionals could take more care of themselves.



be formal and could be as easy as taking some time at the end of a meeting to mark recent successes like a team award or a big win in a complex litigation, celebrating birthdays and work anniversaries, welcoming newcomers; gathering around a home-baked cake before a colleague's wedding or celebrating the different cultures and traditions within the team; it could also simply be sending a sincere congratulation or thank you note to a colleague who did a great job.

- *Cohesion* – promoting unity amongst team by doing/creating together beyond pure work, like undertaking a group volunteering activity, working together towards helping others, having a group pro bono project with a special IP focus, learning a new skill as a group, or just having fun together around some good pizza.

- *Communicate* – discussing with as much transparency as possible about the team's priorities and goals, coming changes, and budget; asking for feedback on what works or not for the team, what could be changed/improved/stopped, or, for instance, talking about the latest survey results and sharing insights.

- *Culture champions* – when the size of the team allows, creating accountability within the group by having dedicated and voluntary "culture stars" who will help drive the team's culture agenda and organize related activities (from training to fun events).

- *Casting* – carefully considering the team's culture in a recruitment process to anticipate what the new hire could bring to the team and/or how they would blend in.

“As I heard recently about a great team's culture example, "It all starts with Me."”

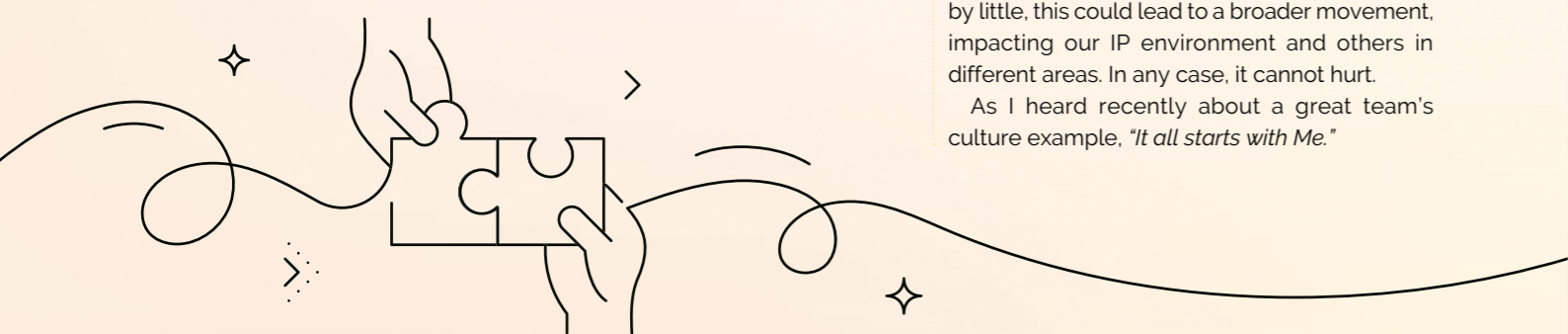
- *Contribute* – knowing that everyone's contribution to the team's culture is important and equally valued irrespective of the role and the seniority of the person and remembering that not everyone contributes in the same way, which also makes the strength of a team, making culture a team goal for everyone and recognizing all individual contributions.

- *Cost-free* – creating a culture of happiness does not require any budget, but it implies everyone's commitment and intention.

We are lucky to have different tools and technologies available to bring a team together. It could be as varied as the classic in-person team meeting/training but starting with an informal "bring your own coffee and croissant," virtual coffee chats talking about last holidays, special recognition/awards, celebration slides, online trivia, virtual tour of the other side of the world office, monthly "getting to know your colleague" interviews, having a picnic all together at lunchtime in the park nearby or quarterly newsletter. There is no limit to a team's creativity when wanting to promote a culture of happiness.

The above might help to reflect on what we value in our team culture and maybe to consider at least one thing we could do differently, at our own level – being an individual contributor, a manager, or a leader – to build, improve, or foster our team's culture. In the current turmoil of our world with all the uncertainties it carries and the various pressures we may experience as an IP professional, one can see it as a shared responsibility to try all we can to create a happy place for ourselves and for those around us, also at work. There is no magic formula that could be applied to all and any teams across the IP profession (nor generally). There may be work environments where any of the above ideas might not be applicable. However, we can all attempt to cultivate a certain sense of culture of happiness at work. And create consequently a virtuous circle. Happy teams may inspire others in the same organization or beyond. Little by little, this could lead to a broader movement, impacting our IP environment and others in different areas. In any case, it cannot hurt.

As I heard recently about a great team's culture example, "It all starts with Me."



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