

# The Trademark

Issue 1 2023

GLOBAL REACH, LOCAL KNOWLEDGE

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## Lawyer



## Unwrapping key factors for building a strong brand: an interview with **Bence Bozóki, Senior IP Counsel at Mars**

Bence sits down with *The Trademark Lawyer* to discuss the global reach of his role at Mars, the importance of a strong IP portfolio, and the changing expectations of consumers.



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# Editor's welcome



**W**e kick off this issue by unwrapping the key features of a strong brand with our guest interview featuring Bence Bozoki, Senior IP Counsel at Mars. We discuss Bence's key responsibilities, strategies for building a strong trademark portfolio, and the importance of stand-alone branded products – one not to miss!

Further, this issue explores IP rights available to celebrities in relation to their persona following Usain Bolt's attempt to trademark his signature

“**Unwrapping the  
key features of  
a strong brand.**”

'Lightning Bolt'. Many celebrities, including R&B sensation Rihanna, have encountered problems with their likeness being exploited by companies, fashion retailers in particular, but where do they stand?

With Brexit in the rear-view mirror and its impacts well and truly visible, find a reflective analysis of the differing experiences relating to the likelihood of confusion and association of registration marks before the UKIPO compared to the EUIPO.

With a new year comes a new INTA president, and this year Jomarie Frederick brings a unique standpoint as Deputy General Counsel, Chief Intellectual Property and Brand Counsel for a non-profit – a standpoint she hopes will enrich her service throughout her term. Find out about Jomarie's and INTA's year ahead.

Special thanks to this issue's *Women in IP Leadership* segment sponsor Zuykov and partners, which features Hazel Tunney, Partner at Tomkins, and Karen Elburg, Partner at Herzog Fox & Neeman.

This and much more! Enjoy the issue.

*Faye Waterford*  
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](http://www.trademarklawyermagazine.com)

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MEET THE EDITORIAL BOARD



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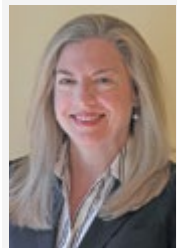
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Rachael Lodge Corrie is a Partner of Foga Daley with a passion for Intellectual Property law, focused on brand portfolio management, trademark prosecution, non-routine trademark matters and advertising law. She is an active member of the Jamaican Bar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



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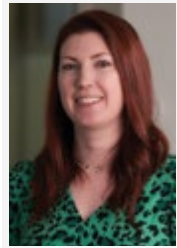
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# An interview with Bence Bozóki, Senior IP Counsel at Mars

Bence sits down with *The Trademark Lawyer* to discuss the global reach of his role at Mars, the importance of a strong IP portfolio, and the changing expectations of consumers.

## How long have you been with Mars and what attracted you to the company?

I have been with Mars now for over seven years. Mars is a great company with some of the world's most famous brands. The opportunity to support brands like SNICKERS®, MARS®, or TWIX® globally does not present itself very often. Mars is also widely known for its collaborative culture which helps attract and retain talent. When I was offered the job back in the summer of 2015, I did not hesitate too much, even though it meant I had to relocate from Hungary to the UK.

## Can you describe your key roles and responsibilities as Senior IP Counsel?

Our team is there to help protect, maintain, exploit, and enforce our valuable brand assets. We are much more than just legal professionals; we are business partners who advise on all aspects of brand intellectual property. We support all business initiatives globally as long as these involve our distinctive assets; whether the project has to do with innovation, branding, licensing, or business expansion, we are there to navigate and help. Our goal is to be a trusted team that provides quality advice in an efficient and proactive manner.

## What strategies do you put in place to build a strong trademark portfolio? And, how does the global nature of Mars affect your approach to developing a trademark portfolio?

Our IP portfolio must be fit for purpose in all countries where we operate. This means we have a responsibility in enabling our business teams to execute their plans, as well as to grow and expand with the least possible IP risk involved. We have robust clearance and filing strategies in place to ensure a smooth decision-making process. It is also crucial that we are not afraid of enforcing our trademark rights

when this becomes necessary. Successful enforcement is a key contributor to enhancing the value of our brand assets.

## Many of Mars' trademarks also stand alone as single brands, why do you think this is important?

Along with our people, our brands are our most valuable assets. Mars has various business segments (including the two largest segments: confectionery and pet care) where the products on offer differ greatly. The history and heritage of these brands also varies; many were created and first produced by Mars while many others have been acquired over the years. In order to protect their heritage and unique brand identities, these brands must have the capability to stand alone. The fact that these are Mars brands further ensures that both the products and the brands are ready to evolve sustainably and pass the test of time.

## In your experience, how have the global events of the past few years affected brands in the confectionery space?

Digitization and Covid increased the pressure on all companies (confectionery included) to come up with new ways of reaching consumers. Our brands had to start appearing on more platforms more frequently, and our business had to introduce new routes to market. The consumer is at the heart of what we do, and we must always bear this in mind. Consumer expectations and behaviour have changed significantly in recent years. Not only do consumers want products to be accessible quicker and easier than ever, but they also expect companies and brands to operate sustainably and have a clear purpose that they stand for. We at Mars like to think we are leaders and not followers in this space.

## Under what circumstances do you use outside counsel at Mars?

We are a global team that works extremely closely with our network of outside counsel. They are our trusted and knowledgeable advisors on the ground. Our team handles a substantial number of matters in-house, but whenever local legal expertise is needed (e.g., complex disputes and litigation), or if we do not have the internal resources to handle a larger project efficiently, we get in touch with our outside counsel.

## What parameters do you apply when deciding on which outside counsel to use?

We are lucky to have a global network of external partners with a wealth of experience and long-standing knowledge of our business.

Whether the project has to do with innovation, branding, licensing, or business expansion, we are there to navigate and help.



Bence Bozóki

We have excellent relationships with these experts and are only rarely forced to consider other options (e.g., due to a conflict of interest). Our outside counsel should be proactive and practical in their advice at all times. They must drive for results and take ownership of everything they do on our behalf. We value law firms for acting with diversity, sustainability, and innovation at the forefront of their minds.

## What would you consider to be your greatest achievement in your role at Mars?

We have achieved significant results with strong determination and resilience against look-alike products and other infringements globally. I am proud to continue playing a part in developing a reputation for Mars as a leader in strategic IP enforcement. With the value of our brands and business front of mind, we strive to act in a determined but fair and sensible way against the infringements we come across.

## What is your go-to chocolate bar?

It has to be SNICKERS®. Whenever I taste it, I am always positively surprised by how amazing it is.







# Action, association & asses: 2022 at the UK Intellectual Property Office

**Luke Portnow, Senior Trademark Attorney at Novagraaf, reviews his differing experiences before the UKIPO in comparison to the EUIPO when it comes to likelihood of confusion and association of registered marks.**

Looking back on my 2022 year of practice, with enough time passed since the end of the Brexit Transition Period, led me to reflect on how the UK opposition enforcement landscape is shaping up. It gave me some good food for thought. Hopefully you will enjoy my sharing some experiences and anecdotes with you.

As a general background: the UKIPO Tribunal Section has remained very busy since the UK departed the EU bloc and I have noticed a significant increase in my overseeing oppositions running in parallel at the UK and EU Intellectual Property Offices. Of course, this is nothing novel, as it was normal to see, i.e., a UK trademark filed to become a basis for an IR being opposed in the UK and then later seeing its EU designation opposed by the same party. The ever-differing decision outcomes, however, have been stark. As you can imagine, there has also been a directly linked and steady increase in holders of Comparable Rights (the UK008 and UK009 'Brexit Clones') enforced in the UK, many doing so for the first time. This bequeathed some real take-home lessons for many.



Luke Portnow

“The ever-differing decision outcomes, however, have been stark.”

We all know harmonization is not uniform and differences have long existed between opposition procedures at the EUIPO and IP offices of EU Member States. With the UK for example, the strategy and deadlines to oppose are different, as are the procedural timeframes and availability of extensions of time, and of course, formal in-person hearings are common at the UKIPO. Not paying a UKIPO cost award can also have real consequences for the unsuccessful party.

Some purporting to have a genuine UK 'Address for Service' found out about these procedural differences very quickly and, in many cases, deservedly harshly so. Applicants were suddenly incurring a lot of unnecessary time and costs defending oppositions being filed and/or prosecuted wholly incorrectly. Applicants started needing to defend oppositions that felt nothing more than frivolous suits. The UKIPO became increasingly frustrated, resulting in an unforeseen rise in the number of 'Preliminary Indications' issued by the Tribunal Section (these state an initial view that an opposition based on likelihood of confusion *solus* will very likely fail and encourages withdrawal, otherwise costs for the unsuccessful party can be extremely high). Many Opponents quickly realized the UKIPO does not find a likelihood of confusion exists simply because two trademarks start with the same first few letters.

To give some context here and a useful example: a few years ago, I was running parallel oppositions before the UK and EU IPOs relating to the same word mark (the trademark was a first name). The UKIPO ruled these were different names, the marks were different and so there was no likelihood of confusion; the EUIPO ruling was that both words commenced MATE- and so they were confusingly similar, and we lost.

In almost all cases this different approach to

assessing likelihood of confusion gave rise to the Preliminary Indications mentioned above. Again, for context, during 2022 I saw over a dozen such Preliminary Indications issues (in favor of my clients of course!) but up until then, from memory, I had seen only a couple in over a decade of practice before the UKIPO. Many opponents were left with 'egg on their faces' and an undoubtedly high invoice to pay for the privilege.

The take-home here? All national IPOs are different, and even with decades of harmonization, oppositions before the UKIPO are never purely tick-box and cannot be left to simply run to a decision. These are also never low-cost enforcement options because UK oppositions are prosecuted with formal requirements and a mindset closer to judicial proceedings rather than administrative. There also exist very different (and far more burdensome) deadlines and requirements relating to evidence, pleadings, and specific counterstatement admissions or denial requirements. A surprising turn of events, but many needed to learn the importance of careful consideration before embarking on oppositions in different legal jurisdictions, especially if you previously elected to always enforce in the UK via the quite different forum that is the EUIPO.

Taking a step back to that initial decision-making process, on whether to oppose an application and considering a likelihood of confusion, led me to reflect on another interesting 2022 experience which was the increase in UKIPO decisions in which oppositions succeeded based on likelihood of association.

Perhaps on a quieter backburner of legal discussion, the concept of likelihood of association has recently come to the fore in written decisions of the UKIPO Tribunal Section, again in sharp contrast with identical proceedings running in parallel at the EUIPO, where decisions have gone the complete opposite way because of this.

When we say 'likelihood of association' we initially think of a person perceiving a particular sign and being reminded of another trademark. Both the UK Trade Marks Act 1994 and the European Union Trade Mark Regulation prohibit the use and registration of a trademark that provides a likelihood of confusion on the part of the public "which includes the likelihood of association".

The differences in practice at the UK and EU IPOs appear to stem from how the landmark CJEU case of *Sabel*<sup>1</sup> was interpreted and then trickled-down irrespective of any other EU legal harmonization. Prior to *Sabel*, the finding of a likelihood of association was sufficient to assume there also existed a likelihood of confusion (such as in the Benelux and the UK). However, likelihood of association does not really have a meaning in terms of Article 8(1)(b) of the EU Regulation and does not sit comfortably within

“The UKIPO ruled these were different names, the marks were different and so there was no likelihood of confusion; the EUIPO ruling was that both words commenced MATE- and so they were confusingly similar, and we lost.”

its wording. Indeed, the *Sabel* ruling stated: “The criterion of 'likelihood of confusion which includes the likelihood of association [...] is to be interpreted as meaning that the mere association which the public might make between two trade marks as a result of their analogous semantic content is not in itself a sufficient ground for concluding that there is a likelihood of confusion within the meaning of that provision.”

This means likelihood of association is not an alternative for finding a likelihood of confusion, so in practice a "likelihood of association" is arguably simply ignored in CJEU and EUIPO jurisprudence and decision-making. In many cases likelihood of association has only been assessed as being about a sign with "characteristics which were capable of creating an association between the sign applied for and 'any series of earlier marks'".<sup>2</sup> To succeed under likelihood of association at the EUIPO, it therefore appears necessary to show that a series of earlier registrations exist, to then argue that the later-filed trademark looks like an extension of (or associates with) that family of marks.

This interpretation, along with what I see as the ever-increasingly simplified reading of *Sabel*, appears completely at odds with modern commerce and marketing practices.

That is in stark contrast to the position in the UK. We are instead seeing likelihood of association increasingly explored and forming part of UKIPO Tribunal Section decisions (in many cases providing for the opposition to succeed) whereas at the EUIPO the same case would fall at that first hurdle.




A recent example is the success my fantastic colleague had acting before the UKIPO Tribunal Section for the sportswear multinational Asics<sup>3</sup>.

Asics opposed the following applications at both the UK and EU IPOs based on its swirl logo. The actions included claims to reputation (and in the UK, unregistered rights under the common law tort of 'Passing Off') but the assessments and decisions based on likelihood of confusion are amazing to compare and contrast here.

<sup>1</sup> C-251/95  
<sup>2</sup> See for example T-369/20 and C-552/09  
<sup>3</sup> Decision O/949/22 of 01 November 2022

## Résumé

**Luke Portnow, Senior Trademark Attorney, Novagraaf UK**  
A UK Chartered Trademark Attorney at Novagraaf, UK, Luke Portnow's practice covers all aspects of trademark selection, prosecution, enforcement, and exploitation, both in the UK and abroad. He takes pride in providing clear, practical, and commercially focused advice.

| Opposed Trademark Applications   | Earlier Marks EU006383574 & UK00001476670   |
|--|---|
| <br> |  |





At the UKIPO, we submitted under Section 5(2)(b) that the applications' device elements shared high visual similarity with the earlier marks, as such the impression was that the marks are similar to, and would be seen as associated with, the opponent's marks leading to a likelihood of confusion. Section 5(2)(b) provides that there exists a likelihood of confusion on the part of the public which includes the likelihood of association with the earlier trademark.

The principles from the important *Sabel* decision were then gleaned and applied by the Tribunal Division – alongside settled CJEU case law that mere association, in the strict sense that the later mark brings the earlier mark to mind, is not sufficient. There is indeed no scientific formula to apply in determining whether there is a likelihood of confusion; rather, it is a global assessment where a number of factors need to be considered. Confusion can also be direct or indirect.

The Tribunal Division held that although the differences between the marks are sufficient to avoid consumers directly confusing the marks, there was a likelihood of indirect confusion in this case, in relation to the opposed goods. Although the facts did not fit squarely into any of the categories of indirect confusion exemplified in the famous UK *L.A. Sugar*<sup>4</sup> ruling, the examples of indirect confusion discussed in that case are not exhaustive.

It was held that a likelihood of *association* existed, and Asics succeeded in its actions. The decision ran to almost 60 pages (really worth a

“**We are instead seeing likelihood of association increasingly explored and forming part of UKIPO Tribunal Section decisions.**”

<sup>4</sup> L.A. Sugar Trade Mark, BL 0/375/10

<sup>5</sup> Opposition Nos. B 3 142 170 and B 3 142 186

read if you have the time or inclination!).

The decisions of the EUIPO Opposition Division<sup>5</sup> were handed down a few months later. These each ran to only five pages under which the oppositions were each refused with short shrift. The decision was that the opposed marks were figurative, consisting of verbal elements whereas the earlier marks were abstract figurative elements, so they could not be compared and thus could not be confused.

It was held that: visually, the only connection between the signs was that they both consisted of curved lines; aurally, the opposed applications included words that could be pronounced while the earlier marks were purely figurative so they could not be compared; conceptually, owing to the earlier marks being purely figurative they had no meaning and as such could not be compared. This conclusion was reached even if (or in spite of) the verbal element of the opposed signs were to be considered non-distinctive.

It was the Opposition Division's view that the level of abstraction in the earlier marks was so high that they were not similar under any of the aspects of the comparison, so it was held that no likelihood of *confusion* could exist, and therefore the oppositions failed at that first point.

These starkly different outcomes are perhaps best reflected in the lengthiness (UKIPO) versus brevity (EUIPO) of the decisions. The EUIPO was sticking to assessing the marks to the letter of *Sabel*.

All of these experiences and comparisons coming out of 2022 will hopefully have made for some entertaining and perhaps enlightening reading for you! They also provide useful lessons that multiple actors must be consulted and aligned when looking to enforce (whether opposition or infringement proceedings) across different jurisdictions. We are also reminded that, even with decades of harmonization in many areas, as is the case with many EU Member State IP offices, an English proverb remains a useful warning when looking to enforce for the first time at the UKIPO: “*When you assume, you make an ass out of u and me*”. I wish you a happy and successful 2023!

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# Celebrities, is your persona unique enough?

**Rachael Lodge Corrie, Partner at Foga Daley, assesses the current circumstances for protecting celebrity names and their likeness in the Commonwealth Caribbean spurred by Usain Bolt's attempt to trademark the “Lightning Bolt”.**

Earlier last year, the eyes of the IP community were on Jamaican sprint legend Usain Bolt after it was reported that he filed a trademark application with the U.S. Patent and Trademark Office for his “Lightning Bolt” victory pose (Figure 1).



Figure 1 - Usain Bolt's 'Lightning Bolt'

While many were of the view that this was the first time Usain was applying to trademark this pose, a review of his trademark portfolio reveals that this victory pose, along with a family of other “Bolt” related marks have been registered in numerous jurisdictions worldwide from as early as 2009.

It is not unusual to see trademarks registered for a celebrity's name, signature, celebratory poses, and gestures. Some examples include English footballer Jesse Lingard's “JLinz” goal celebration pose (Figure 2), Mo Farrah's “MoBot” silhouette trademark (Figure 3), Michael Jordan's “Jumpman” logo (Figure 4) and his signature jersey number “23” among many others, all of which immediately bring the celebrity in question to mind.



Rachael Lodge Corrie

## Résumé

**Rachael Lodge Corrie** is a Partner of Foga Daley with a passion for Intellectual Property law. She is an active member of the Jamaican Bar Association, INTA and is a member of the Women's IP Today steering committee.



Figure 2 - Jesse Lingard's 'JLinz' trademark



Figure 3- Mo Farrah's 'MoBot'

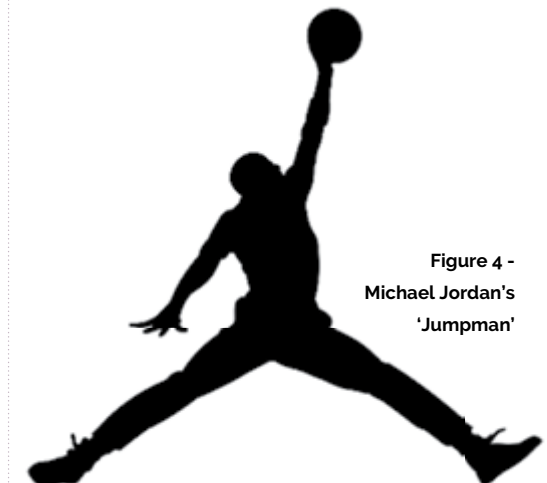


Figure 4 - Michael Jordan's 'Jumpman'

<sup>1</sup> <https://trademarks.ipo.gov.uk/ipo-tmcase/page/Results/1/UK00003314293>





In many jurisdictions, including the Commonwealth Caribbean, there is no statutory right of publicity and as such, many celebrities (and sometimes their Estates) have relied on trademark law as a way to protect their persona and prevent others from taking advantage of their goodwill.

Presently, only two cases have been before a court in the Commonwealth Caribbean which address personality rights in the form of the tort of appropriation of personality. In the case of *The Robert Marley Foundation v. Dino Michelle Limited*<sup>2</sup> the Defendant, Dino Michelle produced and sold T-shirts and other merchandise bearing the image of Reggae music icon, Bob Marley. The Marley Foundation was responsible for issuing licences for the use of Bob's image and brought a claim against the Defendant for passing off as well as the tort of appropriation of personality – a first in Jamaica. The claim was based on the argument that the public would be misled to believe that branded merchandise was being manufactured and sold by the late singer's Estate or that there was a commercial arrangement between the Marley Foundation and the Defendant.

The court ruled in favour of the Marley Foundation reasoning that celebrities ought to enjoy an exclusive right to use their images and likeness, even after death in that just as the law recognizes

property in the goodwill of a business, so too should the law recognize property rights attached to the goodwill generated by a celebrity's personal. Further, that those rights would be violated where the indicia of a celebrity's personality are appropriated for commercial purposes and the principles of unjust enrichment demand that a person should not unjustly benefit at the expense of another.

A subsequent case in Jamaica saw the court going a step further to rule that a Claimant in an action for appropriation of personality need not be a celebrity as the tort targets the wrongful commercial use of the personality and the loss of marketing of an individual's image, whether or not they are a celebrity.

Furthermore, when the Cricket World Cup was hosted in the West Indies in 2007, sunset legislation was introduced that specifically prohibited the use of World Cup images, including the image of any squad member for commercial purposes. However, post World Cup, no further action was taken to implement permanent legislation related to the protection of image rights.

Although the Jamaican court has recognized the common law tort of appropriation of personality, it is important to note that these two decisions have not been affirmed by any

appellate court in Jamaica, nor by the Judicial Committee of the Privy Council in the United Kingdom, which is currently the final Court of Appeal for Jamaica. Cases from the U.K. have made it abundantly clear that there is no “image right” *per se* and it is not possible for a celebrity to claim a monopoly in their image as if it were a trademark or a brand (See *Douglas v. Hello! Ltd.* (No. 3 [2007] UKHL 21 at 293). Instead, celebrities must rely on other causes of action such as privacy rights, trademark infringement, passing off, data protection, and breach of confidence among others.

This was reiterated by the UK courts in the case of *Fenty v. Arcadia Group Brands Ltd. And Topshop/Topman Ltd.*<sup>3</sup>, whereby the Defendant, British fashion brand Topshop, was selling t-shirts featuring a photo of Rihanna, taken from a video shoot for her “Talk That Talk” album. Although Topshop had received a licence for use of the image from the photographer who owned the copyright in the image, Rihanna initiated a claim for passing off, claiming that a substantial number of people buying the product would think she had endorsed it when she had not. Topshop countered that Rihanna was seeking to assert an image right by attempting to control the licensing of her name or likeness and that this was not recognized in English law. Ultimately, the UK Court of Appeal unanimously affirmed the High Court's decision and held that the sale of the item without Rihanna's approval amounted to passing off. While the court reiterated that there is no “image right” which allows a celebrity to control the use of their name or image, in this instance, the court found that the elements of the common law tort of passing off had been met. Rihanna was able to show that she had goodwill in the UK and was well known in both the music and fashion industries and by their actions, Topshop had made a misrepresentation to the purchasing public that would lead them to believe Rihanna had endorsed the products herself or that it was official merchandise, particularly because Rihanna had previously had an association with Topshop. Further, Rihanna was able to prove that the sale of the t-shirt was damaging to her goodwill and directly affected her own business in the fashion industry.

Although ruling in Rihanna's favor, the court reiterated that the use of a celebrity's image on a commercial good does not automatically amount to an actionable case of passing off, as the court was of the view that there is no expectation from the public that the goods bearing the celebrity's image actually originate from said celebrity. Therefore, should a case from Jamaica regarding the tort of appropriation of personality be appealed to the Privy Council, it is unclear how the tort would be treated.



In the absence of a statutory regime that guarantees the protection of persona, trademark protection has proven to be one of the predominant ways for a celebrity to assert ownership and prevent the exploitation of one's image. Of course, to do so, these poses and images must still satisfy the requirements for trademark registrability; particularly, they must be applied for in relation to specific goods and/or services, must have distinctive character, and must be capable of functioning as an indicator of origin and distinguishing the applied for goods and services applied for from other undertakings.

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<sup>2</sup> (1994) 31. JLR 197

<sup>3</sup> [2015] EWCA Civ 3





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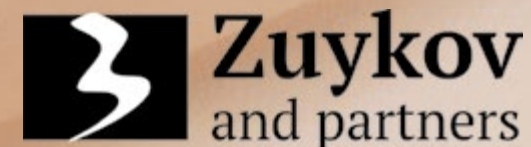
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# Women in IP Leadership

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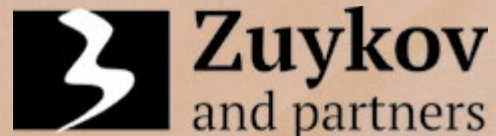


This segment is dedicated to women working in the IP industry, providing a platform to share real accounts from rising women around the globe. In these interviews we will be discussing experiences, celebrating milestones and achievements, and putting forward ideas for advancing equality and diversity.

By providing a platform to share personal experiences we aim to continue the empowerment of women in the world of IP.

This segment is sponsored by Zuykov and partners, who, like *The Trademark Lawyer*, are passionate to continue the empowerment of women. Zuykov and partners' sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Zuykov and partners for supporting this project and creating the opportunity for women to share their experiences, allowing us to learn from each other, to take inspiration, and for continuing the liberation of women in IP.

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

# Hazel Tunney: Partner, Tomkins

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

**H**azel qualified as an Irish and EU Design and Trademark Attorney in 2003. With her background in both science and law, Hazel has a particular interest in agri-industry and pharmaceuticals, as well the food and beverage industries. Having served as Vice President of APTMA in 2018 she is an active member of APTMA's Executive, and is involved at a committee level with ECTA and INTA. Determined that no trainee gets left behind, Hazel has tutored candidates for the Irish Trademark exams for over a decade. She lectures to Trinity College Dublin, The Law Society of Ireland, and GMIT. Hazel has also had the honor of providing expert opinion to the

Seanad Public Consultation committee on the Status, Treatment and Use of the National Anthem. Hazel has written articles for the World Trade Mark Law Report, INTA "Trade Mark Reporter", the ECTA Bulletin, and is co-author of the Irish chapter of the Thomson West publication 'Trade Secrets Throughout the World'.

## What inspired your career?

I had a circuitous approach to my career in intellectual property. My primary degree is in Agricultural and Environmental Science, then I went on to do a Master's in Environmental Science which had a strong focus on environmental law. One focus was to use metrics to see whether specific changes in the law impacted changes in the environment.

I went on to work in environmental science which I had a love/hate (mainly hate) relationship with! But I'd been in college for six years and didn't want to go back, to start another degree, so I began looking for alternatives – especially those that involved aspects of the law. I saw an advertisement in the newspaper for a trainee trademark attorney position which sounded very appealing. I've always quite liked brands and had studied a little law already so I decided to give it a shot. I duly got the job, completed my apprenticeship and qualified as an attorney. I've been in the profession 20 years this year and really enjoy the combination of law and practical application.

Working as a trademark attorney is not theoretical, you can see the direct result of your work, e.g., protecting a brand and seeing it in store (or *vice versa*!). So you do have the benefit of seeing real time results of what you're actually doing and if, like me, you've got a practice where you're doing work for everybody – from farmers down the road, to people setting up their own gin distilleries, to large multi-nationals – you can have an impact on people's lives. People can have huge amounts of time, money, and love invested in their brands, especially the smaller, local places. We can really help them by





“While you can point at achievements on your LinkedIn profile and the awards you receive – which are all great – I actually think just being happy in your career and in your life is the greatest achievement you can have.”

registering their IP, or by stopping people from copying them and that can be very fulfilling.

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

It's been quite linear in that I trained and qualified and then I moved to another firm and worked there for nine years as an associate. I moved to my present firm, where I joined as a senior associate and then a partner. Having said that, unless you stay in the same firm where progression happens at strategic intervals, nobody's career path is directly linear because there's always variants, politics – and a little luck, too!

Like me, if you have had children, you're out of the office for multiple sets of maternity leave and the reality is that the world doesn't stand still and wait for you to come back. As a woman these are the things that get in your way and slow down your career progression somewhat. Broadly it's been relatively straight forward – not necessarily easy because it doesn't come easy to anybody, really – but I've been lucky in that the next step in my career progressions has always been obvious and open.

I've also been very lucky to have worked in quite supportive environments all during my career. And I've been very lucky to work with some other strong, encouraging women who have been through it before and know what it's like. They know that when you're a young mother, (and then as a not quite so young mother), that there are these impediments in the way. One of the benefits (if we can say that) of covid has been that it's quite clear that you can work from home efficiently and effectively. Like many Attorneys, I used to have to take the day off when my children were sick and I'd be sitting at home stressed because I knew that work was building up and feeling impotent about that. Working from home was of course a bit tricky at the beginning, especially if you were trying to home school, or care for anyone at the same time, but I think that remote working has just brought such flexibility to people's lives and has made everything so much easier. It's definitely made life a lot easier for a lot of people. It's been eye-opening.

I could offer loads of advice! Whether it's good or not – who knows! My biggest regrets in my career have come from not backing myself. So, my advice to myself 15 years ago would have been to back myself. Of course, at the same time, you need to stay realistic and be self-aware. Keep your ego out of the way, but back yourself. And trust your gut.

I also think that women suffer from imposter syndrome far more than men – self-doubt seems to plague many of us. I reached a certain point in my career, probably when I hit my early 40s,

when I realized that we're all kind of the same. The more you see what other people do, the more you realize that everyone makes mistakes, everyone has doubts and that's normal. So, if you back yourself and are self-aware you don't need to have imposter syndrome – in fact, you're probably doing a really good job.

The other thing apart from backing yourself is to be yourself. There's no point trying to hammer yourself into a mold that you believe a good attorney fits. If you're the kind of person who is slightly less formal and enjoys a bit of humor in the everyday then just lean into it. It's like that saying, 'be yourself, because everyone else is taken'. My feeling is that your clients and peers appreciate you just being yourself. It's easy to say when you're in your mid-40s but when you're 25 and looking at all these very serious and important knowledgeable people you want to be that way too, but you can while still being yourself.

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

Reintegrating back after both my maternity leaves was tricky because you suddenly have these new, uncontrollable different pressures, other than those presented by your Inbox! If somebody's sick, you're at home. If you have to leave at a certain time to be at the crèche, you're leaving. That lack of time flexibility was a massive challenge. Everything just got squashed into a much smaller time frame. I remember my boss at the time, a woman, passing on her view that women with children were always the most efficient workers because they have these rigid time pressures. What happened was, all the 'water cooler' time, and unnecessary meetings just... had to be cut. I became surgical about my time. You're in to do your job and become quick and efficient. It absolutely influenced me. My children are older now and that initial intense pressure, especially now with working from home, has gone but I'd like to think that the efficiency has remained.

Like most women, in most industries, I have encountered assumptions, prejudices and biases from professionals around the world. It's easy to be dismissed as a woman – especially one who's maybe not all that serious in their manner – but the way you can deal with that challenge is being really good at your job, and letting the work speak for itself.

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

I suppose it depends on how you define achievement: there are things that I've achieved personally, there are things I've achieved for clients, there are things that I'm known for – I would struggle to pinpoint the 'one'. While it can be easy to point at the more famous, or

publicized of the cases you have been involved in, that doesn't equate to being that of which you are most proud.

To be perfectly honest, I am as happy with successes that reach the news, as with many other, "smaller" ones – especially for my local clients. Such small successes can make a really big difference to them.

I think my greatest achievement is to find myself now working with a great team in a very supportive environment – my fellow partners and colleagues are great and we have a really good balance. I think achieving happiness and balance between work and life, doing work you enjoy with people you respect is success in itself. I feel really lucky. While you can point at achievements on your LinkedIn profile and the awards you receive – which are all great – I actually think just being happy in your career and in your life is the greatest achievement you can have.

I think that the IP community is wonderful. I was back at my first conference post-covid in November and it made me realize that IP has introduced me to great friends around the world and I get to see them a couple of times a year. Conferences are of course hard work but I get to sit down with friends, for a drink and a chat about our families, and it counts as work! I was out for dinner one of the nights and there were people from Finland, the United Kingdom, Norway, Australia, the US, South Africa all at the same table, having some fun, talking about work, learning a bit about trademarks but, ultimately, building relationships. Which, in many ways, is what the role of a Trademark Attorney is! Sometimes I feel I have the best career ever!

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

Tomkins is a relatively small firm and we'd like to grow our team. I'd like to raise the profile of Ireland when it comes to IP, especially as some are yet to realize that Ireland remains part of the EU!

I'd like to get to a place where I have more time to be involved in committee work for the various organizations I am a member of. Related to this, I would like to try to get more involved locally with education work. Pre-covid, I was involved with a charity called *Inspiring the Future* which arranges visits to local schools, with the aim to encourage and inspire people in under-privileged schools to stay in the education system. It's a charity whose aim and message I have a close affinity with.

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

I'd like for it to get to a point where equality and

diversity don't need to be separate agenda items – where they are no longer a big, separate issue or buzzword, and where their inclusion is natural, automatic, and built into the decision-making process. The job is to do the job and people should be assessed based on their merit, contributions, and behavior, not on outdated presumptions about gender, race, sexual orientation, and the like.


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

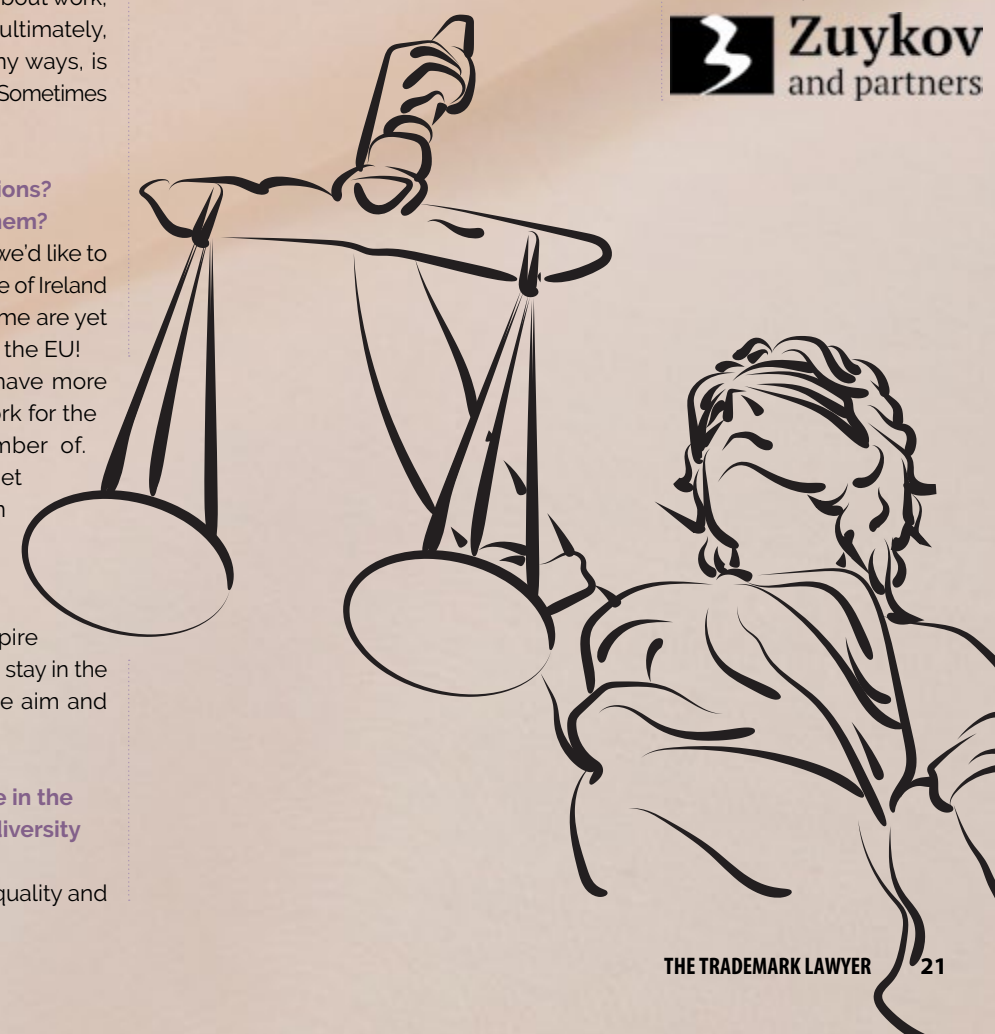
I think there are some incredibly impressive, inspiring, and humbling women in the IP sector.

People are working extremely hard at the association/committee level so the next steps need to be made by the foot soldiers, the people on the ground like me and you – people who aren't high profile, or experts in the field. I think it's now for all of us to keep an eye out for, and to call out biases, when and where we see them, and where and when we can. I think it's up to everyone – not just women – to be aware and to call out instances where unfair practices are happening. I think the tools are all with us now with people leading the way and showing us the light so it's for us to follow and actively participate in making sure that women continue to be seen and heard, and empowered to help them achieve their potential.

“The job is to do the job and people should be assessed based on their merit, contributions, and behavior, not on outdated presumptions about gender, race, sexual orientation, and the like.”

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## Karen Elburg: Partner, Herzog Fox & Neeman

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

**K**aren heads the Herzog Fox & Neeman Intellectual Property Practice. Karen has extensive experience in the contentious and non-contentious aspects of intellectual property, including advising on strategic and day-to-day aspects of trademark portfolios and the trademark/domain-name interface, and managing worldwide trademark portfolios for her clients.

Karen advises on the acquisition, disposal, protection, and exploitation of IP rights, as well as trademark clearance, all aspects of brand protection and trademark & domain-name disputes, with a unique specialty in IP issues in the online gaming industry. She specializes in negotiating and drafting all types of IP transactions, with extensive experience in the IP aspects of corporate and commercial transactions. Her work focuses on transactional IP and on licensing, development, technology transfer, and other commercial agreements for clients ranging from start-ups to multi-national corporations, in a broad range of industries and fields.

#### What inspired your career?

Many years ago I was asked to define professional success. I said success would be when, if someone had a question in my area of expertise, I was the person they turned to for answers. Many years later I feel that by my younger self's criterion, I have indeed succeeded. I did not know, while juggling childcare, law school, and a part-time job with a boutique IP law firm, that I would one day be a partner in Israel's most prestigious law firm, ultimately heading its Intellectual Property department. My inspiration came from a combination of having been told, ever since I was a very small child, that I could be whatever I wanted to be, with perseverance bordering on stubbornness.

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

During the first 10 years of my legal career I held a number of different positions, starting with a job in the legal department of a hi-tech

company and ending up in a specialized IP boutique, coming full circle from my first job as a student and returning to my first legal love. Since that boutique merged into Herzog Fox & Neeman in 2001, I have never looked back. I have been very lucky with the people whom





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I said  
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for answers.”

I have been privileged to work over the years, people who taught me, mentored me, encouraged me, and pushed me to excel; people who reinforced that early message that I could do whatever I wanted to do and be whatever I wanted to be.

My best advice is to find those people, those mentors, who are willing to teach you and push you ahead. There is a lot of motivation from professional women to support and to mentor young professional women, and while I see no reason not to have both men and women as mentors, I do think there's a benefit to women being mentored by women who may have faced the same challenges and biases and have a more intuitive understanding of some of the issues young women face in pursuit of a legal career.

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

The famous “work-life balance” that we hear so much about these days is not a new invention. While today it's entirely accepted that both men and women want and need that balance, women juggling families and careers still face different challenges than men do, and when I was starting out that difference was even more stark. Over the first 15 years or so of my legal career I worked in various combinations of part-time positions in order to be able to devote time and energy to my family, and my ability to invest in professional advancement was limited. There was no real overcoming that challenge; it was a matter of patience, perseverance, and doing my best in both the personal and the professional spheres.

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

I'm very proud to be head of the Herzog Fox & Neeman IP Department, as well as a senior editor on INTA's *The Trademark Reporter*, and a member of the Board of Trustees of the Israel Internet Association, ISOC-IL.

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

The wonderful thing about being an IP lawyer is that I learn something new every day. Over the next few years I look forward to continuing to learn new things, and to contributing to the advancement of young IP practitioners, both men and women.

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

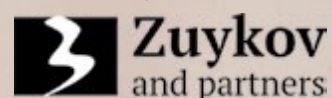
I would like to see more women in senior positions in the legal profession in general, and in IP in particular.

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

That's a tricky question. I think we need to continue encouraging and supporting women to choose legal careers; in IP, we need to encourage them to choose to specialize in patents, which still feels pretty much like a male-dominated field. We also need to foster the social acceptance of men taking an equal part in parenting and childcare and make away with the concept that women – and only women – have to choose between career and family; particularly after covid, with so many people around the globe working remotely, there really is no excuse not to share both the challenges and the joys of parenthood between the parents. I tend to be an optimist by nature, and I feel we are moving in the right direction, albeit not fast enough.



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# LAW FIRM RANKINGS 2023

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A comprehensive list of the  
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Throughout the next few pages, you will view a comprehensive list of the 10 most well-respected law firms from South America, in alphabetical country and company order. Our focused list is derived from a multifaceted methodology, which uses months of industry research and feedback from our readers, clients, and esteemed connections around the world. All firms are ranked top 10 in their jurisdiction but are displayed alphabetically to avoid bias.

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# THE BUSINESS OF INNOVATION

INTA's 2023 Annual Meeting will focus on innovation. With two tracks, **IP & Innovation** and **The Business of Brands**, we will explore what the latest advances in technology could mean for brands in the future. Join us for networking opportunities, learn about cutting-edge ideas, and reconnect with colleagues from around the world.

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## Trends in Italian oppositions and appeals: an overview

Francesco Bonini reviews the recent trends highlighted by the UIBM Activity Report published in 2022 to better understand the success rate of trademark oppositions and appeals.

The Italian trademark opposition procedure is consolidating its good standing at the Italian PTO (UIBM) and it is gaining positive feedback from the users.

The UIBM Activity Report 2021 (2022 is still not available) shows a stable trend of filed oppositions in the range of about 1,800 oppositions per year. (See Figure 1)

Almost all the oppositions were filed online, with just 1% of them sent by postal service or through the Chambers of Commerce.

The UIBM has also streamlined its internal workflow and has enhanced digitalization: this has allowed it to complete 2,267 opposition procedures in 2021.

This progress has generated not just more productivity in the Opposition Division, but also a better quality of the decisions which is confirmed by the figures reported below.

On 48,789 fresh applications for trademarks in 2021, UIBM received 1,805 oppositions, that means

“

**If one of the parties is dissatisfied with the decision, they can file an appeal against it.**

”

just 3.5% were opposed (consider that 5% of all oppositions are against International Registrations designating Italy and some national applications receive more than one opposition).

In detail, 65% of them were ended by extinction (agreement between the parties or withdrawal of application); 20% were upheld in whole or in part; 8% were rejected; 7% were withdrawn, declared inadmissible or archived. (See Figure 2)

The provision for a conciliation or mediation opportunity between the parties (the 'cooling-off' period) is effective because two thirds of them are solved by an agreement between them and do not go to a decision by the Office.

This allows the Opposition Division to concentrate its work on a reduced number of cases that go to a decision.

If one of the parties is dissatisfied with the decision, they can file an appeal against it.

The responsible body for receiving appeals on oppositions is the 'Commissione dei Ricorsi'

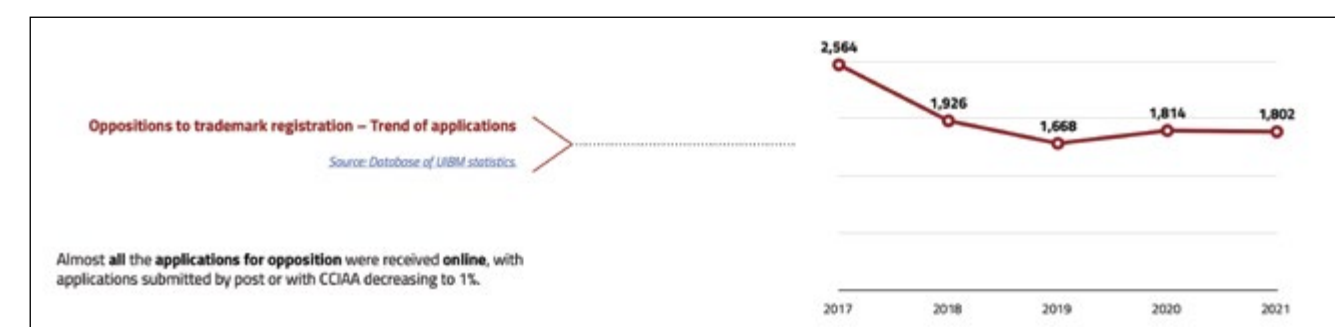


Figure 1: Oppositions to trademark registration – Trend of applications, Source: UIBM Activity Report, 2021



Figure 2: Oppositions to the registration of trademarks, Source: UIBM Activity Report, 2021





“ It could be interesting to see also the decisions issued by this newly established division as a further development in the Italian IP scenario. ”

while fresh applications decrease to 39,295. These figures would give a growing rate of 5% of oppositions/applications, which has to be confirmed by an official report.

Also, the number of appeals, related to oppositions and filed in 2022, is still to be disclosed.

The Italian opposition system shows its consistency and good health also at the appeal stage: it is working properly as a fast, reliable and cost effective administrative procedure, for solving conflict between registered trademarks and subsequent applications.

From 29 December 2022, the UIBM has also started to receive applications for cancellation (invalidation and revocation) requests for trademarks: it could be interesting to see also the decisions issued by this newly established division as a further development in the Italian IP scenario.

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Résumé

Francesco Bonini

Francesco has 25 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 helped and continues to help several companies in the Venetian area to protect their IP rights, dealing with IP prosecution.



Francesco Bonini

(Board of Appeals), that is a judicial civil board, before which a dissatisfied party sues the UIBM in connection with one of its decisions.

Therefore, the plaintiff is one of the opposition's parties; the UIBM defends its decision and the other party can participate as an intervener.

The appellant has to submit written grounds and documents, challenging the decision; the other parties are allowed to reply. The debate however happens during a hearing in Rome, where the case is discussed.

Let us consider, however, that only 28% of oppositions went to a decision in 2021, i.e., 505 cases, and let us count another 2% of them (i.e., 36 cases) that have been declared inadmissible.

The overall sum of them, 541 decisions, was the possible basis for the involved parties to file an appeal.

The provision for a hearing could be argued as a significant filter for reducing the number of appeals: they were indeed 46 in all, in 2021; that is, only 8.5 % on first instance decisions.

However, it should be noted that each appeal decision may award €3,000.00 of compensation

“ The provision for a hearing could be argued as a significant filter for reducing the number of appeals. ”

to the winning party: a high amount that can balance travel and hearing expenses.

Therefore, the mixed procedure of a written part and a hearing is not, by itself, a sufficient reason to justify a reduced rate of appeals on first instance decisions.

Instead, it is likely that these decisions are drafted and issued after careful work by the examiner: indeed, the involved attorneys could confirm that the most recent decisions are extensively grounded, with careful analysis of the conflicting trademarks, their claimed g/s, the relevant public and all the factors that can confirm or deny a risk of confusion.

This could be a more likely reason why the number of appeals is so limited.

Another interesting table shows us the breakdown of the different outcomes of appeals in 2021:

| Breakdown of results; Appeals on oppositions; 2021 |    |        |
|--|----|--------|
| Rejected   | 28 | 60.8%  |
| Upheld full  | 10 | 21.70% |
| Upheld part  | 5  | 10.8%  |
| Withdrawn, Suspended, Extinguished                 | 3  | 6.3%   |
| Total  | 46 | 100.0% |

**Cartel 1, Source: Italian IPO (<https://uibm.mise.gov.it/index.php/it/>)**

As you can see, six in 10 appeals, related to oppositions, have been rejected; however, three in 10 were upheld in full or in part.

This seems to confirm the above-mentioned hypothesis, i.e., that a good part of the opposition

decisions were based on good argumentations.

On the other hand, the Board of Appeals has considered reversing the first instance decisions, considering that they needed to be reviewed in whole or in some parts.

For the recently ended 2022, the number of oppositions show an increase and goes to 1995.

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# A different standpoint for 2023 INTA President Jomarie Fredericks

Jomarie Fredericks, Deputy General Counsel, Chief Intellectual Property and Brand Counsel at Rotary International, sits down with *The Trademark Lawyer* to talk about her year ahead as INTA President, discussing the alternative perspective she brings to the position as a result of her non-profit background.

## Can you start by introducing yourself and your role in the IP industry?

I'm Deputy General Counsel and Chief IP and Brand Counsel for Rotary International, a worldwide association of member rotary clubs established in 1905. We're headquartered in Evanston, Illinois, and we have clubs in over 200 countries and territories with around 1.4 million members. I've been with Rotary International for over 25 years. We've got a lot of really dedicated volunteers all over the world who try to do good and make things better for different societies. It's an honor to be affiliated with a brand like that.



Jomarie Fredericks

## Was there a particular case or development that stood out for you in 2022?

As a long-term member of INTA's Executive Committee, having started as an officer in 2018, I get exposure to every amicus brief that INTA files. That's a great position to be in because it offers an inside view into the major cases in development and that I may not otherwise know about.

But one stands out in particular to me, having been a First Amendment lawyer before I was a trademark lawyer, is *Jack Daniel's Properties, Inc. v. VIP Products LLC*, a case which has finally now reached the US Supreme Court. INTA filed an amicus brief before the Supreme Court in January, marking the association's fifth amicus brief in this case which involves a balancing of interests between the first amendment and trademark law arising in the context of a consumer product, namely a dog toy resembling a bottle of Jack Daniels Old No.7 Black Label Tennessee Whiskey. The Ninth Circuit held that Jack Daniels' marks

were used on the dog toy in a humorous way and was therefore entitled to first amendment protection. In doing so, the Ninth Circuit applied *Rogers v. Grimaldi* to a consumer product under which the District Court was required to conclude that the dog toy did not infringe Jack Daniels' trademarks. The Ninth Circuit also referenced the humor of the dog toy to conclude that any trademark used in this way was noncommercial and therefore could not constitute trademark dilution.

The Ninth Circuit's decision is significant as it departs from the law and all other circuits. Traditionally, the *Rogers* analysis is reserved for expressive works, rather than consumer products, and no other circuit has previously extended *Rogers* beyond artistic works. INTA's brief urged the Ninth Circuit to reconsider the application of *Rogers v. Grimaldi* to the use of trademarks on any commercial product and to realign with other Circuit courts. INTA also argued that a review is appropriate to clarify the noncommercial use exception to trademark dilution under the Lanham Act. So, we'll see where that goes.

## You have been an INTA member for more than two decades. How will your experiences shape your strategy for the year ahead?

I have been involved in the association for a long time, as is the case with any INTA president, but I'm only the second non-profit president and I think this offers an alternative standpoint. While my role at my company is similar to the equivalent role at any other company, the emphasis at a non-profit is different. Rather than selling

products, we're involved in services and we protect marks for slightly different use cases. This alternative lens makes what I do slightly different, and I bring this approach with me to INTA.

## What aspect of being INTA President excites you most?

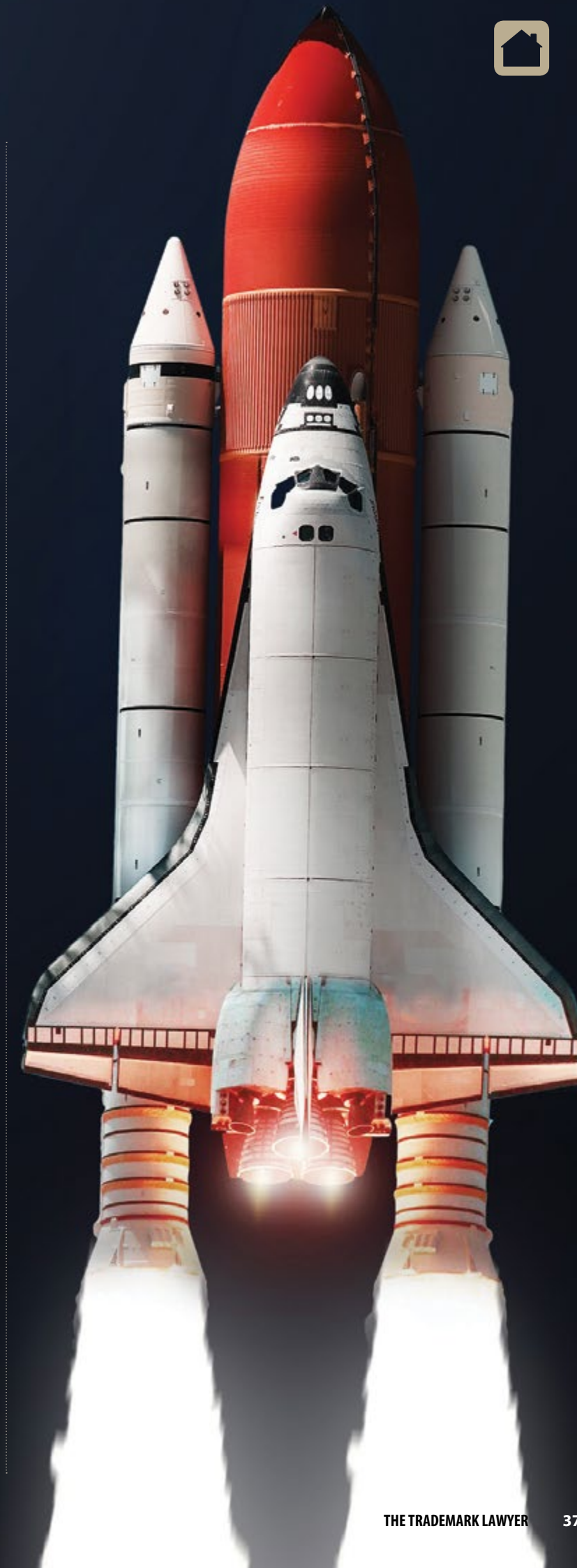
That's a hard question because I am very excited! I believe in this organization. I've been in it for over 25 years, and I've certainly dedicated a lot of time and resources to INTA, and I've done so with the support and endorsement of Rotary International. Having them behind me as a brand owner member of INTA has made such a difference.

I'm excited about the fact that my experience as president will be different in that it'll be shaped by my non-profit background: my role as president will increase visibility not just for the Rotary brand but for the Rotary as a non-profit brand, which in turn will increase awareness of the importance of, and issues surrounding, brand protection for non-profits. So many people think of trademarks as related solely to consumer products, and that's certainly an enormous part of trademark law. But some trademarks are in the services area, for both for-profit or non-profit organizations. I don't think a lot of people understand trademark use as service marks and, more to the point, I think there is an added lack of understanding for IP in non-profits in general. While I don't expect the general public to understand this nuance, I am amazed how many trademark lawyers are surprised to learn I'm with a non-profit. I hope the indirect exposure that I will bring to this issue will help to raise awareness and understanding.

## INTA Presidents in recent years convene a Presidential Task Force. Will you do the same and, if so, what will it focus in on?

We're in the process of putting together my presidential task force with a working title of 'Unlocking IP'. We're focusing on the fact that many people don't understand what a trademark is, or what the difference between a trademark, copyright, and patent is. With this task force, we aim to demystify the concepts and terms by 'unlocking IP'.

We plan to start with the mainstream media, which has direct access to the consumer public. We are looking into developing tools that INTA can make available to the media for use when reporting on IP issues. In addition, we will look to raise awareness through increased coverage, as the general media does not cover IP much at present. Hopefully, the task force can put together an agenda and outline that can be utilized to increase awareness so that the media can A) know the tools exist, B) have an increased





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The educational programming for the Annual Meeting will have two tracks around the theme of The Business of Innovation.”

desire to cover IP topics, and C) report more broadly and correctly.

At present, consumers don't necessarily know about trademarks, they're not necessarily interested in them except for how it looks in the form of a logo on their shirt or purse. On the other side of that coin is brand awareness in general, when, for instance, starting a small business, many don't think about IP protection or setting aside budget for IP protection. Entrepreneurs think of the name and logo for their company, but I don't know that they think about protecting them. I don't know how much thought is put into the domain name or searching to see if someone else has the same or similar mark. We need to increase awareness, starting with the media and then with the general public, about these issues, and increasing educational opportunities with respect to IP would be a good place to start. For example, I think every paralegal program should have a course on IP as well as every MBA program, given how integral IP is to running a business.

I don't believe all of this is going to be accomplished by this one task force in one year but it's about getting started and coming up with a plan for producing more educational tools, not just for lawyers, but for the public as well.

**One year in, can you tell us about the developments for the 2022-2025 strategic plan?**

It is not possible for me to speak about all the accomplishments of our various committees, task forces, and project teams so I'll share a few highlights.

Strategic direction one is *Promote and Reinforce the Value of Brands*. This year three teams of volunteers have developed three white papers that serve to advance our understanding of the global - and indeed galactic - IP system. These white papers include a new IP in Space report, now available for download. How do we protect marks and brands that are in space? Maybe the traditional ways don't work and, given the recent rapid commercialization of space, it's important to examine these initiatives now, through the lens of IP law. The report focuses on trademarks but also contemplates other IP, exploring concrete and practical legal approaches to reaching a workable IP system in space between now and the year 2050, by which time we anticipate commercial activities in the low Earth orbit as well as on the Moon and Mars. It seems crazy to be talking in these terms but that's fewer than 30 years from now. INTA also has white papers looking at NFTs and another which explores trademarks in the metaverse. These will be published in early 2023.

In addition, in November, INTA published a checklist to accompany the IPO of the Future

Report. The original report provides a comprehensive resource for all IPOs to future-proof operations and structures and to proactively engage with their planning, positioning, and environment requirements.

Turning to strategic direction two, to *Build a Better Society Through Brands*, the DEI presidential task force report has now been published. It analyzes INTA's status and footprint in the DEI space and provides recommendations, some of which have already been acted upon, on how the association might improve and expand its DEI efforts and outreach. INTA also published an update to the Women's Leadership Initiative report in September which continues to facilitate necessary dialogues within and beyond the INTA community. It includes several pertinent topics such as providing research on women's representation in the workforce in the IP field, women's career advancement opportunities, the scope of work-life integration, as well as identifying further critical data gaps in this space. The update highlights trends observed since the original report, published in early 2021, and demonstrates the unique challenges women continue to confront in the workplace including those resulting from the global Covid-19 pandemic, which seems to have hit women disproportionately hard.

Strategic direction three, *The Development of IP Professionals*, has seen a lot of exciting developments. INTA just launched a new career center which is designed to help INTA members, job seekers, and employers find the right talent. Also, we're currently developing INTA's first certificate programs: the first, entitled Finance for Non-Finance Legal Professionals Certificate Program, is launching in early 2023 and will provide critical foundational information on the topic of finance for all IP professionals and students. The second program, the Trademark Administrators Certificate Program, offers beginner, intermediate, and advanced options and covers foundational aspects of trademark law and practice and it will launch in the second quarter of 2023.

**The INTA Annual Meeting is due to take place in Singapore, May 16-20. Can you give an insight into what to expect? And why do you think the meeting is so valuable for industry professionals?**

As you may recall, INTA was expected to be in Singapore in May 2020 but that didn't happen due to the pandemic, so we're very excited to be heading there in May 2023. We already have more than 4,350 registrations, and registration is tracking higher than the 2022 Annual Meeting, which is very encouraging.

This Annual Meeting will have a new, Live+, format: there's going to be the in-person event

in May which will be followed by a separate virtual event in June. The virtual meeting will include some totally new sessions as well as some recorded in-person sessions so that attendees have time to focus on one and then the other. Registration for both has a small price difference (US \$50) to allow registrants to fully engage in the networking and new business building that can be done in person in Singapore and then allow them to focus on education during the virtual event, giving each registrant wider opportunities.

The educational programming for the Annual Meeting will have two tracks around the theme of The Business of Innovation. The first is the IP and Innovation Track which will cover traditional IP topics and issues registrants expect from an INTA Annual Meeting, such as trademarks, brands, trade secrets etc., as well as patents, with an additional focus on future trends. This is especially useful as Asia is extremely patent-intensive, with 70% of all patents filed coming from the region. Then there is the Business Track which will focus on topics such as the economics of brands, IP valuation, ideas to assets, IP as a financing tool, and cooperation between public and private sectors to support entrepreneurship, plus keynote speeches on SME success stories.

There's going to be a terrific amount of business development opportunities including committee meetings, excursions, table topics, speed networking, over 10 different social receptions, a grand finale at Universal Studios, and opportunities to meet with counsel from the Asia Pacific region who are going to be in attendance.

Singapore in itself is a terrific destination; it's clean, safe, modern, and exciting, and it has amazing food. With English being widely spoken, it's a fantastic destination for those visiting the Asia Pacific region for the first time.

**What advice would you give to professionals hoping to become active with INTA as a committee member/volunteer?**

You will get out of INTA what you put into it and in time you will find that what you put into INTA will come back to you tenfold – this speaks the truth of what my INTA experience has been.

I encourage everyone to join a committee. All members are invited to join committees. It's fantastic that INTA receives a very high number of committee applications, but unfortunately, this means that not every applicant will be put on a committee - but please apply. If you don't get a place, apply again. Keep trying, because the committee experience will help to deepen your involvement in INTA and enrich your experience as well as help you develop as a trademark lawyer. Committee selection occurs every two years for

the following committee term, and the next selection period begins June 2023 for the two-year committee term beginning in January 2024.

There are other ways for you to participate in INTA, such as hosting roundtables or contributing articles to the *INTA Bulletin*. I would also recommend attending all the educational sessions and INTA events that you can take advantage of opportunities with the accessible and truly welcoming INTA staff and the member leadership. Express your desire to get involved and show what you can offer, it will be heard.

Hard work is recognized; if you do good work for INTA it will get noticed and the staff are always looking for new talent. I was plucked from a committee and given more responsibility which led to more leadership opportunities, and now I'm president! I won't be involved in INTA forever and we're always looking for the next group of leaders to bring up within INTA who will eventually take over. So, don't be afraid to speak up, make yourself heard, and engage with opportunities that come up, if you're not getting the opportunities, ask for them. I think that's the best advice I can give.

INTA has changed my practice and my life. I have friends all over the world because of my involvement in INTA and, with respect to my company, it's given me such an advantage. When I started practicing my foreign counsel was a name on the other end of an email; then I started going to INTA events and meeting them in person. Once you meet somebody in person your relationship is forever changed, you understand each other on a different level, and they understand my company's risk level differently. I think things just get done in a much more efficient, and certainly a more friendly, manner. Being part of INTA is good professionally and personally as well as for your company. I know I sound like a cheerleader for INTA but that's kind of my job right now, right?!

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I have friends all over the world because of my involvement in INTA and, with respect to my company, it's given me such an advantage.”

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# Switzerland: sometimes it is good to return to the basics and fundamentals!



**Catherine Hillaert-Prevost advises on the available forms of trademark protection and legal registrability criteria in Switzerland ahead of the implementation of official fees reduction from 1 July 2023 and 1 July 2024 respectively.**



According to the Swiss Federal Act on the Protection of Trade Marks and Indications of Source of 28 August 1992 (Status as of 1 January 2022), a trademark is defined in Article 1 as a sign capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Trademarks (or services marks) can accordingly be in particular words e.g. OCEAN HARRY WINSTON for goods of international class 3 in the name of Harry Winston SA, MATERNA for goods of international class 5 in the name of Société des Produits Nestlé S.A.; letters e.g. ERSF for goods of international class 11 in the name of Mitsubishi Electric Corporation, numerals e.g. 5514 for goods of international class 14 in the name of Rolex SA; figurative marks, e.g.  for international class 34 goods in the name of Philip Morris Products S.A.,  with claim of colours orange and red, for goods and services in classes 9, 41, 42, 44 in the name of F. Hoffmann-La Roche AG,  with claim of colours blue and turquoise for goods of class 5 in the  name of Novartis AG; holograms e.g.  for goods and services of international classes 2, 9, 28, 38, 41 in the name of Your Stories Sàrl; motion marks e.g.  with the following description "The mark consists of a 1.22 second moving image sequence; it begins with a logo consisting of a green parallelogram in which the word PUMA is written in white capital letters; from this logo comes a stylized white puma running to the right; this puma is inserted in a red parallelogram which also moves with it to the right; in the last image of the sequence, the red parallelogram containing the white stylized puma reaches a size equal to the green

**In the course of the examination process, the Swiss Federal Institute of Intellectual Property does not search for earlier rights, e.g. if other identical or confusingly similar rights of third parties are already in existence.**

parallelogram containing the word PUMA", for various goods and services of international classes 9, 35-37, 39, 43 in the  name of Puma Energy International SA;  with description "the motion mark consists of a 3.3 second animation depicting the silhouette of a feline seen in profile moving from left to right. The sequence reads from left to right and from top to bottom", for goods and services of international classes 3, 9, 14, 16, 18, 25, 34-35, in the name of Cartier International AG; position marks e.g.  for international class 25 with a specified list of goods, in the name of All Star C.V.; colors marks e.g.  with color claim Red (RAL 3003), for specific products of international class 8 specially "pocket knife" was registered as established brand commerce, in the name of Victorinox AG,  with color claim standing for the association of blue color (Pantone 2747 C) with silver color (Pantone 877 C) in a ratio of 50:50, for specific products of international class 32 goods "non alcoholic beverages, namely Energy Drinks" was registered as established brand commerce, in the name of Red Bull GmbH,  (Pending appl.) described as "a gradient, i.e. a combination of a linear gradient going from yellow (R:225, G:220, B:128) to orange (R:252, G:175, B:69) to R:247, G:119, B:55 to R:88, G:81, B:216) and Red (R:236, G:72, B:76) and Pink (R:225, G:48, B:108) gradient and a linear gradient where blue (R:5, G:10, B:230) and R:88, G:81, B:216) to violet (R:131, G:58, B:180) and Pink (R:193, G:53, B:132) runs. The colors mentioned above always appear in the order mentioned and as shown in the stamp", for goods and services of international classes 9 and 42 in the name of Instagram, LLC – it will be interesting to see whether this application

will mature to registration as such; sound marks, e.g. in international classes 1, 5, 31, 44 in the name of Syngenta Participations AG; three dimensional marks, e.g.  with color claim white, green, blue, in international class 33 in the name of Sire Spirits LLC,  with color claim Pantone 7401 C, Pantone 200 C, Pantone Reflex Blue C, Pantone 872 C and white, and words FIRE & ICE VODKA GOLD PREMIUM Bottled in SWITZERLAND 40% alc./vol. 700 ml, in international class 33 in the name of F&I Beverages AG;  for goods of class 14 in the name of Patek Philippe SA Geneve; or, combinations of such elements with each other or with colors.

Marks can be classified in four main categories: individual marks, collective marks, e.g.,  for goods and services of classes 9, 35, 38, 41 in the name of Staatssekretariat für Bildung, Forschung und Innovation SBFI, geographic marks e.g. Swiss for goods of class 14 in the name of Fédération de l'industrie horlogère suisse FH, certification marks (guarantee), e.g.  for various goods and services of classes 3, 5, 16-17, 20, 29-32 in the name of Rainforest Alliance, Inc.

According to Article 2 of the Federal Act, the following are excluded from trademark protection on the basis of absolute grounds for refusal:

- signs that are in the public domain e.g. **WORLD META FORUM, METAVERSE, METAWORLD, metaverse, FIRST IN CRYPTOFINANCE, LA GRANDE MAISON, XPRESS YOUR UNIQUENESS Fig., hydrogen Fig. greenlaw, SIGNATURE, GOLDEN LABEL, EcoPlus, respect nature**, were rejected in 2022. When signs of the public domain may have become established as a trademark through use for the goods or services for which their protection was sought, they are allowed registration. Here below are examples of word marks which have been registered over the years on the basis of acquired distinctiveness or partial acquired distinctiveness through use: **FETE DES VIGNERONS, LA 2028, SUPER LEAGUE, PATAGONIA, M, LA POSTE SUISSE, ROYAL CARIBBEAN, AMERICA'S CUP, CHAMPIONS LEAGUE, THE HARLEM GOSPEL SINGERS, SAVE THE CHILDREN, WWF, MASTERCRAFT, 501, MOON BOOT, CO-AXIAL MASTER CHRONOMETER, LONG ISLAND, CASABLANCA, GOLDEN SQUARE, INTERNATIONAL WATCH, A DIAMOND IS FOREVER, WEIGHT WATCHERS, CITIBANK...** Similarly, shape marks (three dimensional) can be registered on the basis of acquired distinctiveness or partial acquired



distinctiveness for specific categories of goods or services. As an illustration of such shape marks, we can cite:



- shapes that constitute the nature of the goods themselves or shapes of the goods or their packaging that are technically necessary, e.g.



Catherine Hillaert-Prevost

## Résumé

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- c) misleading signs, e.g. POWER, especially for goods of classes 33 and 34 was considered as misleading sign and refused to registration on the following grounds: "for alcoholic beverages, cf. art. 12 al. 2 let. h of the ordinance on foodstuffs [ODAI; RS 817.02], according to which brands designating alcoholic beverages must not contain indications referring in any way to health, and article 34 paragraph 3 of the ordinance of the DFI concerning information on foodstuffs [OIDAI; RS 817.022.16], which prohibits health claims for alcoholic beverages containing more than 1.2% alcohol by volume, or for tobacco products because Article 17(2) of the Tobacco Ordinance [OTab; RS 817.06] prohibits any advertising statement suggesting any beneficial effect of tobacco products on health".
- d) signs contrary to public policy, morality, or applicable law. These are basically simple signs, abbreviations, indications and coats of arms – it is worth noting that the Swiss Federal Intellectual Property Office publishes (to date) a list of 5615 emblems (Swiss protected public signs and foreign signs protected in accordance with Article

**In sum, a sign intended as a trademark must be neither generic, usual, descriptive, deceptive, nor be contrary to public policy.**

6ter of the Paris Convention for the Protection of Industrial Property) which cannot be protected as a trademark or as an element of a trademark. The sign FIT was refused for all goods and services of classes 1-45 because it was considered as descriptive in the sense of "appropriate", "right-sized" or "physically fit", as misleading for alcoholic beverages and tobacco products on the grounds of art. 12 al. 2 let. h ODAIOUs and art. 34 al. 3 OIDAi as well as art. 17 al. 2 OTab, and in addition, because it is a protected abbreviation (Federal law concerning the protection of the names and emblems of the United Nations and other intergovernmental organizations; RS 232.23).

In sum, a sign intended as a trademark must be neither generic, usual, descriptive, deceptive, nor be contrary to public policy.

With regards to Article 3 of the Federal Act, signs that are also excluded from trademark protection on the basis of Relative grounds for refusal include signs that are:

- a) identical to an earlier trademark and are intended for the same goods or services;
- b) identical to an earlier trademark and intended for similar goods or services such that a likelihood of confusion results;
- c) similar to an earlier trademark and intended for the same or similar goods or services such that a likelihood of confusion results.

In this context, an earlier trademark is: a) an applied or registered trademark that gives rise to a right of priority under this Act (Art. 6-8); b) a trademark that is well known in Switzerland within the meaning of Article 6bis of the Paris Convention for the Protection of Industrial Property of 20 March 1883 (Paris Convention) at the time of filing the sign referred to here in paragraph 1.

The grounds for refusal under this Article 3 may only be invoked by the proprietor of the earlier trademark right. In the course of the examination process, the Swiss Federal Institute of Intellectual Property does not search for earlier rights, e.g. if other identical or confusingly similar rights of third parties are already in existence. The intended trademark holder is responsible to not infringe or to not offend such earlier rights. This is what is unique to Switzerland trademark examination process and shall be kept in mind. This is also why advanced checking and searches as to existing earlier rights are key for a peaceful and legally safe products or services go-to market launch or with a brand of any kind.

Considering that trademarks (and other intellectual property rights) are more than ever valuable assets in trade and online for many companies and individuals, to assert uniqueness, exclusivity and capacity to defend against infringers in the widest sense, registering such rights is crucial.

It is worth noting that starting from summer 2023, filing costs for Switzerland are set to decrease. It will become less costly to file and renew a trademark, for identical gain and competitive advantage as was before. The Swiss Federal Council approved the amended Fee Ordinance of the Swiss Federal Institute of Intellectual Property (IPI) at its meeting on 16 December 2022. As announced, a trademark filing in 3 classes and its renewal which were amounting to 550 Swiss francs will be reduced progressively as follows.

From 1st July 2023, a national trademark filing in 3 classes will only cost 450 Swiss francs.

In addition, the fee for protecting an international trademark in Switzerland for 3 classes of goods/services will be reduced by 50 Swiss francs, namely 400 Swiss francs.

There will be additional reduction, namely electronic filings are encouraged and enable

**It is worth noting that starting from summer 2023, filing costs for Switzerland are set to decrease.**

Applicants to save a further 100 Swiss Francs fee (the e-filing discount).

From 1 July 2024, renewal fee of a Swiss trademark will be decreased from 700 to 550 Swiss francs. Further the individual fee with regard to the renewal for Switzerland of an international mark will be 500 Swiss francs.

This announcement shall be good news for anyone seeking to apply, register or renew, and therefore to protect its intellectual property for Switzerland.

Sources:  
<https://www.news.admin.ch/news/message/attachments/74521.pdf> <https://www.ejpd.admin.ch/ejpd/en/home/latest-news/mm.msg-id-92238.html>

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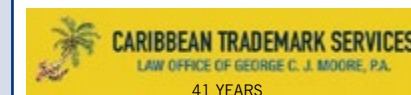


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*Greetings from  
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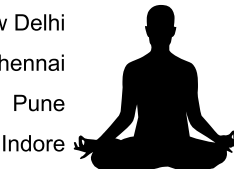


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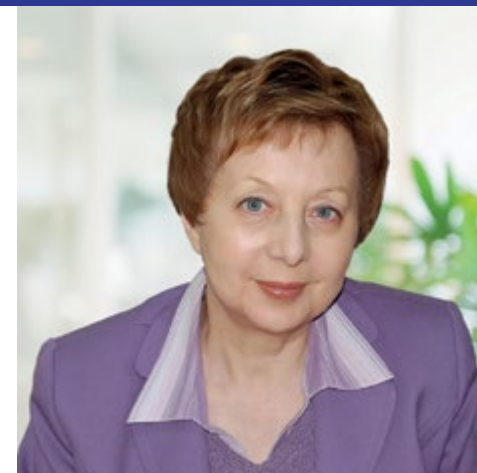
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