

# The Trademark

Issue 1 2024

GLOBAL REACH, LOCAL KNOWLEDGE

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## Lawyer

## What's a Mouse to Do?



Michael K. Friedland, Partner at Friedland Cianfrani LLP, addresses trademark lessons from the expiration of the copyright on the world's most famous mouse.

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## THE TRADEMARK LAWYER

Issue 1 2024

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# Editor's welcome



**O**n January 1, 2024, the copyright to two original Mickey Mouse films  
expired, rendering the films and all the characters within, to some  
extent, free to use. However, with Mickey Mouse being among the  
most famous characters in history, and a very well-renowned trademark for  
a number of categories, the character is arguably not under threat. So, how  
will Disney handle the expiration of this copyright? Our cover story this issue  
investigates.

Our guest interview this issue is with Dana Brown Northcott, the 2024 INTA  
president. As well as providing insight into her role as Vice President and

Associate General Counsel of IP at Amazon,  
Dana discusses her excitement for the year  
ahead, the key evolving challenges faced by  
the IP community, and what to look out for at  
the INTA Annual Meeting in Spring.

Further, we delve into the evolution of ICANN,  
detailing the developments surrounding  
generic Top-Level Domains to provide advice  
and guidance for keeping IP protected in this  
evolving space followed by a timely review of  
a trademark squatter case that saw the  
attempted exploration of the BBC's notorious  
TOP GEAR mark by a Russian entrepreneur.

Our *Women in IP Leadership* segment features Dorota Rządewska, Managing  
Partner at JWP.

There is still time to book for our INTA Special Edition, contact  
katie@ctclegalmedia.com to reserve your space today.

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  
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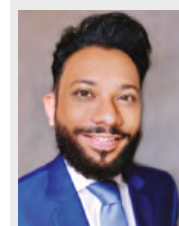
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Francesco has 25 years of experience in Italian and EU trademark and design prosecution. He has had successful cases in oppositions, appeals, and cancellations both before the EUIPO and the Italian PTO. Francesco has his office in Vicenza, in the North-East of Italy. It has helped and helps several companies of the Venetian area to protect their IP rights, dealing with IP prosecution.



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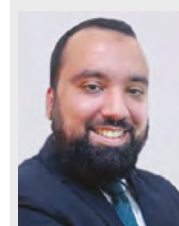
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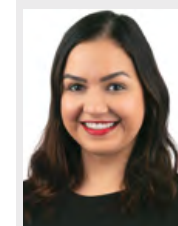
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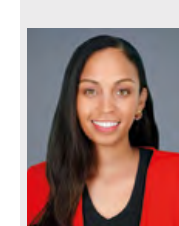
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# What's a Mouse to Do?

Michael K. Friedland, Partner at Friedland Cianfrani LLP, addresses trademark lessons from the expiration of the copyright on the world's most famous mouse.

The copyrights on the two original Mickey Mouse cartoon films expired on January 1, 2024. As with any other copyrighted work, the expiration of the copyrights means that the works are now in the public domain. Thus, the original Mickey Mouse films, and all the characters in them, are, to some extent, free for all to use. The marketplace has quickly responded. In the month since the copyright expired, consumers can find unlicensed Mickey Mouse products all over the internet.

But Mickey is more than just a cartoon character; he's also one of the world's most famous trademarks. Thus, we bring a critical question into focus: is there anything that Disney can do to stop the proliferation of goods bearing Mickey Mouse and save Disney's most valuable trademark? The lessons apply across the entertainment and copyright landscape.

Mickey as a trademark

Mickey made his debut in the cartoon *Steamboat Willie* in 1928. His life as a trademark began almost immediately thereafter. The first Mickey Mouse dolls appeared in 1930. The first Mickey Mouse watches appeared in 1933. Since then, he's been on books and clothing, food, toys, kitchen appliances, electronics, and more. Mickey has appeared on virtually every product imaginable.

The Lanham Act defines a trademark as "any word, name, symbol or device" that is used to identify and distinguish goods from those made or sold by others and indicate their source. 15 U.S.C. § 1127. Mickey undoubtedly qualifies. Generations of consumers have become accustomed to seeing Mickey on everything from



Michael K. Friedland

The copyrights on the two original Mickey Mouse cartoon films expired on January 1, 2024.

hats to handbags. When consumers see that iconic Mickey Mouse character on a product, they undoubtedly believe, after a lifetime of experience, that the product is made, sold, or authorized by Disney.

Now, however, unlicensed Mickey products are easy to find. Figure 1 & 2 are just a few examples.

Because of Disney's trademark rights in Mickey, enforcement of those rights against such third-party users should be an easy matter. But it's not so easy, because Mickey Mouse is not only a trademark, he is also a copyrighted character.

If Disney had only used Mickey as a character in copyright-protected works (for example, books, artwork, and films), the analysis would be straightforward. The copyright expired, and the character would be on the open market. The world would be free to copy or create its own Mickey works, just as anyone is free to copy or make their own Sherlock Holmes or Tom Sawyer works. At the same time, if Disney had used Mickey only as a trademark, the analysis would be just as straightforward. Mickey would continue to be Disney's to use exclusively.

With this background, we turn to the question: What are Disney's options?

Do nothing

Disney could simply ignore the third-party uses, but this option has several severe negative consequences.

Disney would lose millions of dollars in sales and royalties. Consumers would have the option of buying Mickey products from unlicensed manufacturers instead of genuine Disney products. Disney could lose profits from the sales it would have made, perhaps billions of dollars' worth, over time. At the same time, manufacturers would have the option of making and selling Mickey-branded products without having to pay a license fee, causing Disney to lose royalties from those sales.

Reputational damages could follow. Disney would have no way to prevent flammable Mickey pajamas or lead-painted Mickey drinking cups from entering the market, and many consumers would mistakenly believe that the pajamas and cups were genuine Disney products. In addition, if the products



Figure 1



Figure 2

carried a message inconsistent with Disney's carefully cultivated image, Disney would suffer further reputational harm, as consumers could mistakenly believe that Disney endorsed the message.

The long-term consequence of the unauthorized use could be even more damaging. If unlicensed Mickey Mouse products continue to proliferate, Mickey would lose its secondary meaning. Consumers would become accustomed to seeing Mickey as a character who appears on products from a wide variety of companies, and consumers would no longer identify Disney as the source of Mickey Mouse products. Mickey could become no different than Santa Claus or the Easter Bunny. Consumers recognize those characters, but they do not associate them with any particular brand. If Disney does nothing, Mickey Mouse as a trademark might cease to exist.

Surgical enforcement

A second option would be for Disney to make a

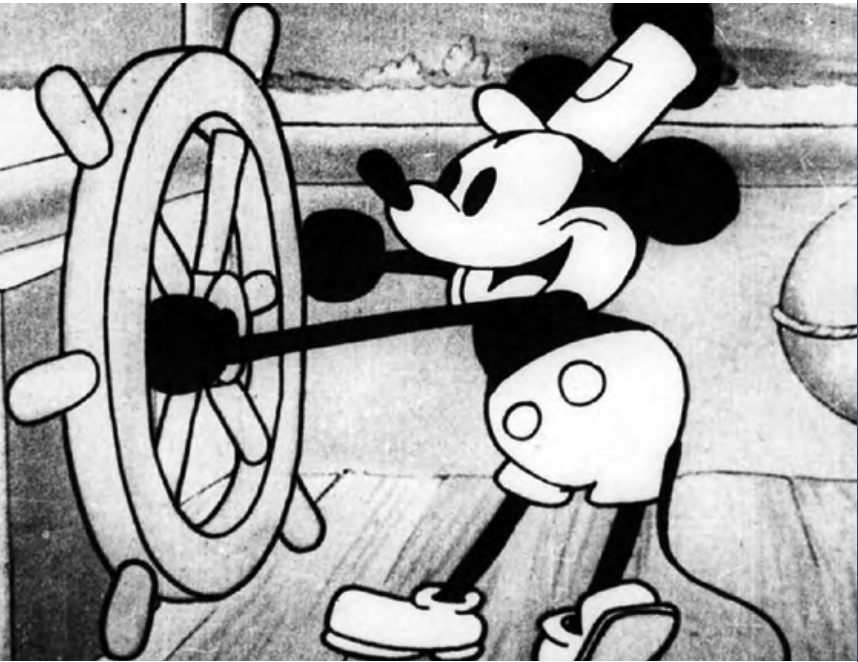


Figure 3

Résumé

Michael K. Friedland is a partner of Friedland Cianfrani LLP, a California intellectual property boutique. He focuses his practice on patent, trademark, copyright, and trade secret litigation, and has handled hundreds of such cases in trial and appellate courts around the country. Prior to founding his firm, Michael was a senior partner at Knobbe Martens in Irvine, California, and was co-chair of Knobbe's litigation department. Michael is a graduate of Harvard Law School and U.C. Berkeley. Author email: michael.friedland@fciplaw.com





tactical concession. Disney could ignore uses of Mickey that strictly resemble the Steamboat Willie version of Mickey Mouse. At the same time, Disney could continue to aggressively enforce its rights against uses of more modern versions of Mickey Mouse.

The limitations of that approach are made plain by review of the Steamboat Willie character, reproduced in figure 3.

The Steamboat Willie version of Mickey is immediately recognizable as Mickey Mouse. To devoted fans, the differences between Steamboat Willie and his modern variants are immediately discernable. To more casual consumers, however, Steamboat Willie is just as much Mickey as any other version. Particularly where the Steamboat Willie Mickey is used in different poses or with different backgrounds, there is no reason to think ordinary consumers would readily distinguish between a product bearing an image of Steamboat Willie and a product bearing an image of "modern Mickey." As a practical matter, the differences between the versions may be too subtle for ordinary consumers to distinguish between them.

Even if the differences between the versions were clear enough to allow ordinary consumers to distinguish between different versions of Mickey, another version of Mickey will fall into the public

“  
**Now, however, unlicensed Mickey products are easy to find.**  
”

domain every few years. The Steamboat Willie version expired earlier this year. The next version expires in 2027, and the one after that in 2032. Thus, with each passing year, even if a campaign of surgically limited enforcement were successful for each iteration of Mickey, another version will periodically expire and lapse into the public domain. And because each newly expired version more closely resembles the current version, Mickey's value as a trademark will continue to erode.

**Damn the copyright, and full speed ahead**

Disney's most aggressive option is probably the most appealing. Disney could simply disregard the expiration of the copyright and sue third parties for trademark infringement as though the copyright limitation had never existed.

Each regional federal appellate circuit has its own articulation of the test for trademark infringement. Application of any of the tests strongly favors Disney. For purposes of this discussion, the Ninth Circuit's *Sleekcraft* factors are applied. See *AMF Inc. v. Sleekcraft Boats*, 599 F.2d 341, 348-49 (9th Cir. 1979.) The relevant factors weigh:

- The similarity of the trademarks;
- The similarity of the goods;
- The strength of the trademark;
- Evidence of actual confusion;
- The similarity of marketing channels;
- The defendant's intent in selecting the trademark; and

- The degree of care exercised by consumers.

Every one of these factors would weigh heavily in favor of Disney. The Mickey images are the same or nearly the same; the goods are the same; the Mickey trademark is enormously strong; Disney could easily show actual confusion, either through consumer complaints or through a survey; the evidence would show that defendant chose to use Mickey knowing that consumers associate the character with Disney; and, because the goods are often impulse purchases, consumers tend not to exercise a high degree of care.

Even though Disney could easily prove a likelihood of confusion using the *Sleekcraft* factors, there is still no guarantee that Disney would ultimately prevail. A defendant would likely raise the expiration of the copyright as the focus of its defense. The defendant would argue that the expiration of the copyright meant that the defendant could use the Mickey Mouse character, regardless of whether the character is also Disney's trademark.

That argument would be similar to one recently addressed by the Supreme Court in *Jack Daniel's Properties, Inc. v. VIP Products, LLC.*, 599 U.S. 140 (2023). There, the Supreme Court held that the

“  
**Mickey Mouse is not only a trademark, he is also a copyrighted character.**  
”

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First Amendment did not allow a company to sell a parody dog toy version of Jack Daniel's whiskey bottle design. The defendant labeled its parody dog toy version "Bad Spaniel's." The Supreme Court held that the issue turned on whether the defendant was using "Bad Spaniel's" as a trademark. There, the defendant admitted in earlier court proceedings that it believed the phrase "Bad Spaniels" was its trademark. Accordingly, the Supreme Court found that the First Amendment did not protect the defendant. In a dispute regarding Mickey Mouse, the inquiry would likely have the same focus. A court would need to determine whether the defendant's particular use of Mickey constituted use as a trademark.

Although the determination would vary from product to product, and there is no guarantee that Disney would prevail in any particular case, the enormous potential loss entailed in allowing third parties to continue to use Mickey on products far outweighs the risk of doing nothing or pursuing a limited enforcement campaign. Doing nothing would deal a relatively quick death to Mickey as a trademark. A limited enforcement campaign would still allow Mickey to die as a trademark, albeit at a slower pace. Aggressive enforcement would at least give the world's favorite mouse a chance.

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# Meeting the 2024 INTA President: an interview with Dana Brown Northcott

Dana sat down with *The Trademark Lawyer* at the start of her presidency to discuss her excitement for the year ahead, the key evolving challenges faced by the IP community, and what to look out for at the INTA Annual Meeting in Spring.

## Can you introduce yourself and your role in the IP industry?

My current role is Vice President and Associate General Counsel of IP at Amazon. I lead the team that supports all of Amazon's brands globally, including trademarks, domain names, gTLDs, internet governance, copyrights, content protection, and a lot of IP policy work. I've been at Amazon for 16.5 years, and, prior to that, I've held roles in law firms in Silicon Valley and London, as well as in-house.

Beyond Amazon, my most important (and exciting) role this year is to serve as INTA's 2024 president. It's a terrific organization of talented IP professionals who are deep in brand protection and with broad scope and global reach. INTA does so much for the IP community through talent development and policy advocacy, of which I am also a recipient. This is what truly makes this Association the premier global branding organization.

I have been a member of INTA for 23 years now, and am lucky to have served in a variety of roles, from committees to presidential task forces to the Board of Directors. I'm so appreciative of the organization – in addition to everything else, it makes my life more fun every day!

## Did any particular cases or developments stand out for you in 2023?

There are a number of cases that come to mind but let me highlight two: one was in the US with international implications, and the other in the EU.

The first one was the Abitron case (*Abitron Austria GmbH v. Hetronic International, Inc.*) before the United States Supreme Court. The US Supreme Court has been hearing a lot of trademark cases lately, and it's been exciting to watch our cases make it to the highest court for definitive review. As with many Supreme Court cases, INTA filed



Dana Brown Northcott

“I’m so appreciative of the organization – in addition to everything else, it makes my life more fun every day!”

an amicus brief in 2022. The reason why this case is important here in the US – but also internationally – is that it limits the ability of trademark owners to obtain damages to only domestic infringing use in commerce in that country. This is also important because the US Senate is debating legislation around the decision soon.

INTA argued for a system that could function reciprocally, consistent with international treaty systems. Specifically, INTA's position on this is that the Lanham Act may stop only foreign conduct that causes substantial impact in the US. The Lanham Act covers domestic consumer confusion, harm to brand owner reputation, mistakes about sponsorship, affiliation, and dilution. In the case of a foreign actor that is causing substantial injury in the US in any of these ways, there's action available here, but otherwise, not. However, the Lanham Act cannot subject foreign companies to suit in the US for foreign conduct that has no likelihood of confusing consumers or other substantial impact in the US. So that helped clarify what is going on with the territorial debate.

Turning to the EU and the *EU IPO v. Nowhere* case: INTA filed a brief for this case last year which is still pending before the Court of Justice. It concerns the timing of grounds for EU trademark applications. INTA's position, with regard to opposition or cancellation proceedings, is that where the relevant petitioner in the case relied upon a right that for no reason no longer exists when the decision is taken, then the petitioner no longer has an interest in the case, and the opposition or the cancellation should fail. The timing there is really important. In that case, the right relied upon was no longer valid at the time a decision was due to Brexit, but the outcome of the litigation might have an impact on any future cases that involve the “disappearance” of an earlier





right (cancellation, expiry, etc.), and this is why it is important to INTA.

The International Amicus Committee does such an impressive job of drafting all their briefs, then they explain it thoroughly to all of us on the Executive Committee so that we truly understand the issues.

**What do you believe are the key evolving challenges in the IP community and how is INTA working to help support these challenges?**

Have you made it through a day in the last six months where somebody has not mentioned generative AI? No, right? So, we should probably start there! One challenge would be AI and its implications on society, IP, and the IP profession itself. It's certainly top of mind for IP practitioners. INTA is hosting The Business of AI Conference in New York in March. It offers a great opportunity to explore exactly this. I love the March conferences. They are a great example of how INTA is a source of future-facing idea exchanges and best practices. I'll definitely be attending the conference with some of my team members. That's where I'd start – AI – because it's in the zeitgeist.

Second, the continuing iteration of IP rights. Global trade is increasingly complex, and technology is accelerating change. As a result, the needs of businesses and brand owners are changing. This will continue to be a key issue for INTA in the coming years because the law can't keep up with the pace at which technology is evolving and developing. INTA's advocacy team is engaging with all of the IP offices and the legislative bodies to talk about harmonization and how they can come together with best practices that work to the benefit of the consumers who rely on and trust brands.

Another issue that deserves mention is the increasingly complementary nature of IP rights. Brand portfolios like Amazon's are more and more complex, and as new products and services come on board, they require a variety of protections. As a result, INTA continues to expand its scope, especially to complementary IP rights, as you can see with the new committee inaugurated this year on trade secrets. I am very excited to see what transpires in their first term.

Beyond that, INTA has ongoing focus on its policy priority issues such as counterfeits, brand restrictions, Internet governance and the expansion of the domain name system, as well as the evolution of the IP profession – and with this, evolving and growing expectations from both in-house and outside counsel.

Personally, I can speak from experience that brand owners have growing portfolios that demand (and expand) professional capacity necessitating a lot of substantive skills, such as financial, marketing, and IT implications. I'm really pleased

“ I think about this a lot, how we can lean into INTA immediately to help with training new hires, and the Trademark Administrator Certificate will be such a valuable starting point. ”

to see INTA stepping in to address this with the recently launched certification programs. One is the Finance for Non-Finance Legal Professionals – a game-changer for helping us develop our budgets. Then, an International Certificate, focused on the broader lifecycle of the trademark, was launched at the end of 2023. And in this first quarter of 2024, INTA is launching the Trademark Administrator Certificate.

I think about this a lot, how we can lean into INTA immediately to help with training new hires, and the Trademark Administrator Certificate will be such a valuable starting point.

**What aspect of being INTA president excites you the most?**

Advancing the strategic mission of the organization. I'm also really excited to connect with the INTA members globally. I'm looking forward to participating in this year's delegations where I'll get to hear about what our members need and play a part in figuring out how INTA can best address those needs. INTA has a really important role to play with policymakers and regulators, as well, so I hope to advance some of the incredibly important conversations around INTA's perspectives and priorities.

**What are your main goals as president?**

My goals are centered around supporting all that makes INTA so very important and relevant to us Legal Professionals, including INTA's strategic mission, continued engagement with the membership, ensuring advocacy with policymakers and regulators.

Another goal that is at the top of the list is my Presidential Task Force – I'll give you a sneak peek! We are going to focus on brands and sustainability, communications, and the impact of customer trust on brand value. We are also in the initial stages of planning to have that through-line on sustainability via round tables, speakers, policy analysis, ensuring the issue will be addressed beyond the task force.

I have a lot of energy about the presidency! Mid-January, I had the pleasure of working in the New York office with all of the INTA staff where we began the initial brainstorming for the 2026-2029 strategic plan. We started to look at the committee structure for overlap synergies, outcome transparency, better communication, and what we do next with the overall structure of the organization and how it will evolve. Then, we looked at ways to continue our strong financial growth and explored other sources of revenue. We also looked at Internet governance positions and how we're going to take that forward this year. Finally, we spent a lot of time crystalizing what our advocacy priorities are – there is so much legislation and important discussion

happening with regulators in the trademark offices, and INTA must be at the center of that. We have a lot on our collective minds as we move forward with our advocacy plans.

**Which aspect of the 2022-2025 strategic plan are you most passionate about?**

The core of INTA, as mentioned, will remain the same – it's the purpose of who we are and what we do and that's fostering consumer trust, economic development, innovation, and a better society through brands. So, it's hard when you ask what am I “the most” passionate about because that limits me to one. They all have value and speak to the heart of what INTA does.

One is promoting and reinforcing the value of brands. We'll continue to champion brands and brand issues to the policymakers, the consumers, the regulators, the entrepreneurs, the trademark offices, and anyone who will listen to us talk about the entire brand cycle and why it's important. Part of that will include policy discussions around harmonization, complementary trademark rights, commercialization, iteration, and how it is we embrace technology and change.

The second is Building a Better Society Through Brands. This was part of the Presidential Task Force a few years ago, the focus of which was DEI and its implications in the branding community, and to look at trust and transparency of brands. In addition, it also moved forward discussions on ESG and CSR and what the impact is on brand value. I've also already given you a sneak peek at where we're headed with the 2024 Presidential Task Force, which also speaks to this.

This brings me to the third pillar, the development of IP professionals, which was also the focus of a previous Presidential Task Force. I want to value and bring forward the fantastic work done by previous presidents so it's not just one and done. The development of IP professionals, keeping people fresh on how we navigate change, how that affects our practice, and how we refine our dynamic skills.

Overall, I will spend the year looking for ways I can participate in improving the member experience, which ties back to what I'm most excited about: spending more time with members and identifying ways to keep INTA important, practical, and relevant.

**How do you think the global nature of your day-to-day role will benefit you as INTA president?**

Amazon's mission overall is to surprise and delight customers and that exhibits itself in several different businesses from tech to retail, from consumer goods to fashion, from web services to digital devices, to publishing, to movies, television, games, and more! It's a collection of so many different

“ I’m looking forward to participating in this year’s delegations where I’ll get to hear about what our members need and play a part in figuring out how INTA can best address those needs. ”

business areas.

With that, I bring to the table a wide range of experience in both safeguarding some of the most famous brands in the world as well as working in a wide range of practice areas. It's from this global, multi-lens perspective of experiences and industries that I hope will help augment all of what INTA is and does.

**What aspect of the INTA Annual Meeting in Atlanta are you most looking forward to and why do you think professionals should attend this year?**

As it stands, we have more than 5,750 registrations from more than 100 jurisdictions and 1,500 organizations.<sup>1</sup>

My favorite part of the annual meetings year after year is the content – discovering all the new issues through the extensive educational offerings. Also, connecting with our outside counsel to address and work through some thorny issues and benchmarking with other brand owners and our peers. We predict that there will be more than 10,000 brand professionals, business owners and leaders, government officials, and academics joining us in Atlanta this May, so the potential for networking is fantastic. It's really exciting.

The overall theme of the meeting this year is the Business of Innovation, which offers the opportunity to deep dive into IP rights and how they're iterating. There's going to be an IP Innovation Track and a Business Track and it's going to be a full meeting, with more than 25 educational sessions as well as so much more.

**What advice would you give to young practitioners who are attending their first Annual Meeting?**

If you are coming to the Annual Meeting for the first time and you're a young practitioner, focus on building connections and building your network. Be sure to challenge yourself to explore new content areas that you know nothing about by attending as many educational sessions as you can get to, and also, no matter how early in your career you are, you have a lot to share, so share what you know with others.

**If you could set a New Year's resolution for the IP community, what would it be?**

That is a really hard question! Every year I lean into one of Amazon's leadership principles and this year's is, 'learn and be curious.' Good leaders are never done learning, they're always seeking ways to improve themselves, and they're curious about new opportunities and how to explore them. That goes for the company, for my team, and for myself personally. That is what I hope the IP community can strive for in 2024 and beyond. Learn and be curious!

<sup>1</sup> As of February 26, 2024

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# The evolution of ICANN: a new landscape for IP protection

**Stuart Fuller, Director of TLD Services at Com Laude, details the developments of ICANN's generic Top-Level Domain program to provide advice and guidance for keeping IP protected in this evolving space.**

The history of the Internet continues to teach us that tomorrow's growth is going to be fuelled by disruption to the norm. Some of today's most ambitious, digitally focused, market-leading, and most valuable brands are organizations that have relatively short histories and have taken advantage of economic conditions to transform their business models.

The global pandemic was a major tipping point for many brands to rethink and reimagine their strategies and business models, and also gave rise to new market entrants who could adapt quickly to the new ways of the world. The FinTech industry, which encompasses and facilitates the growth in ecommerce, is projected to become a \$1.5 trillion industry by 2030 according to Boston Consulting Group<sup>1</sup>.

As far back as 1999, organizations such as KPMG were focused on the opportunities that the Internet could deliver to organizations, noting in their research paper on Electronic Commerce and Internet<sup>2</sup> that:

*"More companies than last year now see the internet as a profitable way of making sales, compared to traditional methods. Unsurprisingly, perhaps, it is the more e-commerce mature businesses, like the retail/wholesale companies, which are particularly impressed with the internet as a selling tool."*

*There are, of course, still obstacles to be overcome before the global digital revolution can really take off. These are more formidable barriers – security fears, particularly – than some e-commerce evangelists would like outsiders to believe. But when a massive 81% of respondents believe that electronic trading will*



Stuart Fuller

**There are, of course, still obstacles to be overcome before the global digital revolution can really take off.**

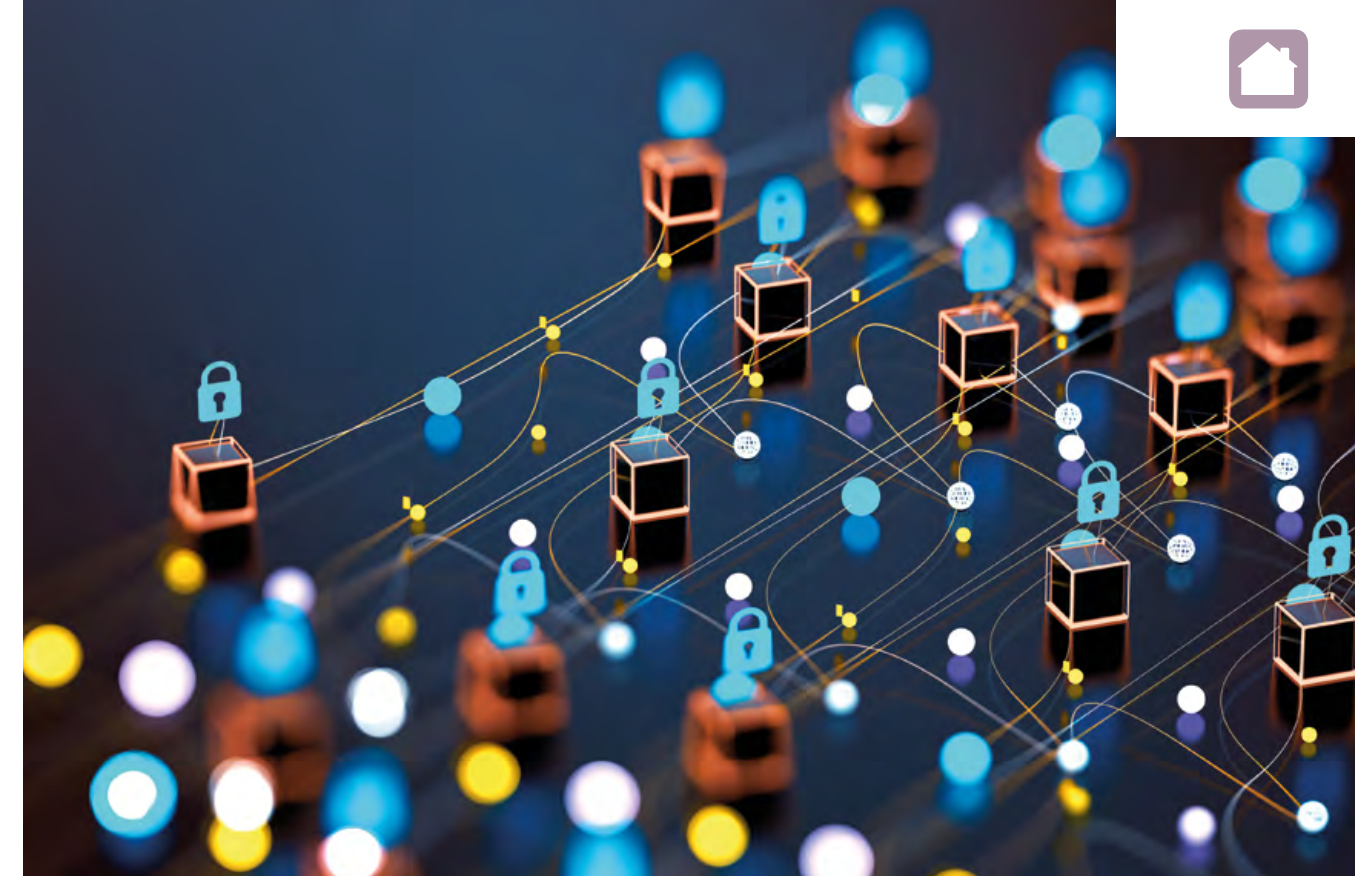
*revolutionize their dealings with customers – and 31% say that the internet has already increased total sales – it is clearly a revolution that is unstoppable. E-commerce companies that are lagging now only have a brief window before they fall irretrievably behind."*

In 2012, the Internet Corporation for Assigned Names and Numbers (ICANN) launched the New gTLD (generic Top-Level Domain) program, representing the biggest and most significant expansion of the domain name system since its creation. The program marked a substantial departure from the limited availability of domain suffixes, such as .com, .net, and .org, allowing for a much broader range of Top-Level Domains to enhance competition and choice, promote innovation, and foster and support global internet diversity.

The liberalization of the domain name space was a chance for organizations to acquire their own slice of the internet in the form of a dotBrand Top-Level Domain, and to revolutionize how web users interacted with them and each other online. This limited opportunity saw over 500 global entities apply for their own dotBrand Top-Level Domain.

Rather than seeing a revolution in the domain name space it has been more of an evolution. Whilst there have been notable successes of some new gTLDs, we are yet to see a real step change for brands that applied for, and have launched, their own dotBrand TLDs.

The clamor for a second application round started almost immediately as the applicants were announced in June 2012, with many organizations enviously seeing their competitors



had applied for their own dotBrand. Behind the scenes, the ICANN community started working on a comprehensive review of the whole program, from application to launch, spending years debating the details. In the last 12 months, over a decade since the first round was launched, the finalization of some of the most important elements of that work has been published. Whilst there are still some issues to resolve, ICANN has pushed ahead with preparation for the next round, not allowing "perfect to be the enemy of good", according to ICANN's Interim President and CEO, Sally Costerton.

ICANN's 1 August 2023 announcement that it's targeting April 2026 for the next gTLD and dotBrand application round has sent a ripple of excitement across the brand holder and intellectual property space. Organizations that have been waiting for over a decade to make an application for their own dotBrand Top-Level Domain, having already seen competitors apply, or those that have formed their business since 2012 can now start to plan in earnest for the opportunity to join an exclusive group of Internet pioneers. Some of the biggest disrupter brands of recent times did not even exist or were in their infancy when the first-round application window was open – consider instantly recognizable brands such as Uber, Airbnb, Tesla, TikTok, and Slack.

But before everyone gets too excited about charging ahead with ambitious usage plans for their dotBrand, there are some rules that potential applicants need to be aware of. Whilst there is no crystal ball that will allow an applicant to foresee who else may apply for a generic Top-Level Domain – for instance in the first

**Ensuring that any potential dotBrand TLD meets the current AGB criteria is a key first step in the application process.**

application round there were 10 applications for a dotMusic TLD and seven for dotWeb – in the dotBrand space there are at least some criteria in place that reduces the risk of contention over an application, including the requirement to own a valid trademark for the term applied for.

The ICANN Applicant Guidebook (AGB) is the document that outlines the "rules of engagement" for any new Top-Level Domain application. Whilst the final, approved updated version is not due for publication until 2025, it is unlikely that the core application criteria for dotBrands will change significantly from the 2012 round.

Ensuring that any potential dotBrand TLD meets the current AGB criteria is a key first step in the application process. Whilst the second

<sup>1</sup> FinTech projected to become a \$1.5 trillion industry by 2020 - <https://www.bcg.com/press/3may2023-fintech-1-5-trillion-industry-by-2030>

<sup>2</sup> The Truth about Online Consumers - <https://assets.kpmg.com/content/dam/kpmg/co/pdf/co-17-01-05-cm-the-truth-about-online-consumers.pdf>

## Résumé

**Stuart Fuller** is Com Laude's Director of TLD Services. Stuart has nearly 20 years of experience in the domain name and brand protection industry, having previously held senior commercial positions at NetNames, CSC, CentralNic, and OpSec Security.

Stuart played a big role in the first round of the new gTLD program in 2012, working with a number of global brands in creating dotBrand strategies and use case scenarios whilst he was at NetNames, and brings that expertise and experience to Com Laude.

Stuart is a published writer, both on subjects around domain names and intellectual property protection but also on football culture.





round is still two years away, it is prudent to start this work as soon as possible. The ICANN evaluation process will look at the technical, operational, and financial capabilities of an applicant, but it is the feasibility and business case for a specific string that ultimately underpins the application.

The necessary steps in determining whether a specific string can be applied for should start as soon as possible. ICANN's rules on who can apply and what they can apply for are complex so it is prudent to collaborate with a partner who not only understands the process and the criteria but also has experience of managing similar applications to determine whether an application will be successful. First and foremost, to operate a dotBrand exclusively for the organization's use, the applicant must have a registered trademark matching the term.

Any prospective applicant that currently does not have a registered trademark has time to make a trademark application which would satisfy the necessary requirements to support their dotBrand, though they will need to demonstrate proof of use.

There will be instances where there are conflicting, valid trademarks for a specific string. For instance, there are hundreds of registered trademarks for the term "Polo," including those from global brands such as Nestle, Volkswagen, Ralph Lauren, and the United States Polo Association. Whilst all may have a valid claim to an application for a dotBrand TLD, there can only be one successful applicant.

Organizations will need to create a compelling internal business case before they will get the necessary sign-off to take an application forward. The feasibility work is the starting point for that internal justification and needs to consider the likelihood of applications being made by other parties for the same string. This is not an exact science, nor will it provide a fail-safe answer, but it will provide visibility on the risk of an application not being successful, and some context and understanding of who potential competitors could be for the dotBrand.

The feasibility assessment also needs to cover other aspects of the potential application string. History can teach a lot and so, it is important to look at whether similar strings were applied for in the previous round. This includes an analysis of any strings that may be considered confusingly similar (dotUnicorn and dotUnicom for instance), or any previous applications that were withdrawn, terminated, or have not yet been launched. Furthermore, some geographic strings are permitted but require additional approvals from local authorities.

There are unsurprisingly a number of terms that cannot be applied for, even if there is a

**The ICANN evaluation process will look at the technical, operational, and financial capabilities of an applicant, but it is the feasibility and business case for a specific string that ultimately underpins the application.**

trademark registered. There are keywords or terms that are blocked by ICANN for technical stability purposes, geographic terms protected at the behest of national governments, and terms corresponding to Intergovernmental Organizations such as the Red Cross or the International Olympics Committee. The ICANN process allows for national governments to raise objections to any applications through their ICANN representative body, the Governmental Advisory Committee (GAC). Typically, such objections will be based around a particular national sensitivity, or a sensitivity shared by multiple governments, so again a look at what history has taught us can be insightful.

Once the feasibility of the term has been determined, the organization can start to think about the creation of a strategic business plan for the dotBrand application. This will include the formation of the team that will create, shape, and ultimately manage the application. Due to the complex nature of the ICANN environment and the processes involved, many applicants choose to work with a specialist organization that can navigate the entire process, from carrying out the initial feasibility assessment, to creating a successful TLD application.

The registrar will work with the organization to ensure all relevant areas of the business are involved in the project as well as developing uses for the dotBrand which will generate value for the business. This work will form the core components of the business plan for the organization – giving all relevant decision-makers and budget holders a clear vision for the application itself and how it will be an asset to the business on an ongoing basis.

It is unclear when the next application opportunity will take place post-2026, so the time is now for ambitious brands that want to join a very exclusive club of internet real estate owners. Preparation is the key to ensuring the necessary investment is aligned with the organization's strategic long-term goals and there is no time like the present to start that process.

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# Women in IP Leadership

**Celebrating achievements and continuing the empowerment of women**







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.

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.

# Dorota Rzażewska: Managing Partner, JWP

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

**F**or 30 years, Dorota has been advising Polish and international companies on all aspects of IP law. Since 2007, she has been the Managing Partner at JWP Patent & Trademark Attorneys.

She combines extensive knowledge and experience as an attorney at law with the competences of a Polish and European patent and trademark attorney, successfully representing clients in contentious and court litigation proceedings resulting from infringement of exclusive rights, including complicated patent disputes.



## What inspired your career?

I originally planned to pursue the career of a judge, as both my mother and grandfather had been in this profession. It seemed a natural choice to continue the family tradition. In Poland it is necessary to complete a three-year judicial training and pass a judge's exam in order to become a judge. After passing the exam, I was offered a job at the court where my mother used to pass judgments. At this point, I felt the need to start building my own career and to follow my own professional path. I decided to complete an additional apprenticeship and train as a legal advisor, which allows you to represent entrepreneurs and individuals in legal matters both as a legal counsel and as an attorney.

One day I was approached by a patent attorney who was looking for a plenipotentiary to help him with a court case involving trademark infringement and committing acts of unfair competition. I took it on and in the course of the case I saw how interesting and inspiring intellectual property law is.

The industrial property law currently in force in Poland comprises a number of open-ended concepts and definitions which, in relation to specific cases, might be interpreted in different ways. This is both a challenge and an inspiration for lawyers. It sparked my interest and prompted me to extend my knowledge on the subject. I decided to specialize in industrial property protection. In the next three years of my apprenticeship as a patent attorney I learned more about the field of industrial property protection. This was followed by the qualifying examination which allowed me to obtain the title of a professional patent attorney.

In 2004, the year when Poland joined the European Union, I also got my qualification as a European patent attorney.

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

My road to becoming professionally qualified as a patent attorney and entering the world of intellectual property protection may seem long,



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Equality and diversity are the values that characterize the whole IP world, and they apply to exclusive rights owners as well as to legal advisors or attorneys.”

but in my case it has been consistent – I do believe in specializing and improving my knowledge and skills within the field of law I deal with on a daily basis.

I entered the world of patent attorneys as a qualified legal counsel, which gave me a slightly broader perspective on the rules of litigation and court proceedings before the Patent Office, administrative courts, and common courts.

Initially, I specialized in litigation and court cases, but with time, the know-how and experience gained allowed me to start providing advisory services in the fields of IP protection strategy and management of an exclusive rights portfolio.

All the knowledge and expertise I have gained in the course of my three apprenticeships: as a judge, legal advisor, and patent attorney, have led to me being recognized as a person able to conduct litigation, whether it involves infringement of patent rights, trademarks, industrial designs, copyrights or cases related to protection against unfair competition. My long-standing practice in this field also gives me the ability to provide advice and determine strategies for handling cases before courts. Of course, each case requires a strategy that takes into account its specific character and hard facts. It is necessary, however, to keep up to date with the changes in the applicable legislation and follow the case law on an ongoing basis.

My work experience does not only include managing intellectual property cases. As the managing partner of a law firm, I had to extend my knowledge and gain managerial expertise. This sphere of my professional activity requires keeping abreast of market changes and constantly updating my know-how of management, psychology and soft skills. It is a challenge I face every day, as it involves not only actively developing my company and building its market position, but also – or perhaps above all else – working with people and building our team. This means bringing together professionals in the field of intellectual property and those skilled in cooperating with the clients who are able to form strong relationships both with the clients and with colleagues.

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

For me as a lawyer, the biggest challenge was to acquire the technical know-how necessary to pursue the career of a patent attorney. This profession is interdisciplinary by nature, combining both legal and technical aspects, and in order to practice it properly, it is necessary to study technical issues.

Patent attorney apprenticeships involve dealing with complex technical problems. Understanding them to the extent that one can provide clients

with strategic advice has become the key to good and responsible patent infringement litigation. Nevertheless, it was clear to me that learning about the field to which the patent relates is a prerequisite for success. This required establishing the right course of action. The solution turned out to be litigating patent infringement cases in cooperation with patent attorneys who had technical experience in the fields concerned.

This working formula allowed me to acquire technical know-how and to develop the so-called soft skills in terms of cooperation, communication, and task delegation. These are all very useful both as regards substantive work related to intellectual property protection and in management.

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

It is difficult to give a definite answer to this question, as my career has consisted of multiple stages. At the beginning, my greatest achievement was gaining the knowledge and experience necessary in the field of IP protection. Once I started my professional career, I might say the biggest achievement was setting up and developing my own patent law firm which grew steadily from the office of 15 people in 2006 to employing 120 members of staff in 2023. As JWP grew in numbers, we also expanded the catalogue of the services provided, as well as the territorial outreach of our operations. As of today, JWP has offices in the four largest Polish cities and helps Polish companies protect their intellectual property in nearly 100 jurisdictions. My major success is also the establishment of the JWP Foundation and Law Firm which form the JWP Group, allowing us to provide comprehensive services to our clients.

Pro bono undertakings are at the heart of my professional activities. The adopted strategy of my foundation is based on the sharing of know-how. We carry out educational activities on intellectual property protection in secondary schools, give lectures to students, doctoral students, entrepreneurs, and startup companies.

For the past eight years, I have also been actively involved in a professional association. I have been the President of the Polish Chamber of Patent and Trademark Attorneys for the second term running, which makes me involved in pro bono activities related to building the position of the patent attorney community in Poland.

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

My goal is to further develop JWP Patent & Trademark Attorneys, both in terms of expanding the range of intellectual property protection

services it provides and creating more branch offices, also outside of Poland.

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

Equality and diversity are the values that characterize the whole IP world, and they apply to exclusive rights owners as well as to legal advisors or attorneys.

Changes concerning the IP industry should follow our changing reality. As we are living in the digital era, I think that we should approach innovation and invention in a slightly different way, so that more exclusive rights could be obtained for novel digital solutions. Let us remember that an innovative company does not necessarily have to use technical solutions in order to be modern and innovative. Many a time, solutions of an organizational nature are the ones that help build competitive advantage. This proves that having various possibilities for protecting novel solutions is key to building an innovative economy.

It is also necessary to raise awareness of what intellectual property rights are, what an important business tool they make, and how they can help build competitive advantage. In Poland, it is also necessary to create a system for small and medium-sized entrepreneurs and startup companies that would assist them in obtaining proper protection and support the financing of such protection.

I would also like Poland to sign the Unified Patent Court Agreement and for the UPC regional division to be established here. If our country were to participate fully in the unified patent protection system, it would contribute to the unification of the principles of patent protection throughout Europe.

Equality and diversity in the IP industry pertain also to those who, as patent attorneys, provide counseling within this field. In different countries, the profession of a patent attorney is different in nature and scope. The rules and procedures for obtaining professional qualifications also vary, which seems obvious, given the different regulations in force in each jurisdiction. Equality in this respect should be maintained with regard to the requirements for becoming a European patent attorney.

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

The world of intellectual property, both in Poland and worldwide, is dominated by men, particularly as far as managerial positions at patent law firms are concerned. This trend is particularly visible during international conferences, where

the majority of CEOs and managing partners who participate in such conferences are men.

I am happy to say that our law firm constitutes an opposite example. I manage a company that started with just 15 employees and now employs 120 people. It is also important to emphasize that the partners are predominantly women, as is the majority of our staff. However, as far as team development is concerned, the gender criterion is not taken into account. It is the competencies, education, and experience that matter.

The key to empowering women in the IP sector is to create the conditions that would allow them to grow professionally, both in terms of gaining knowledge and experience and in their managerial roles, while at the same time allowing them to pursue their plans and dreams in relation to family life. Over the years, I have observed many women who possess not only managerial and organizational skills, but also the empathy necessary to build good relationships in the teams they lead. Combined with good subject matter expertise and professional handling of the cases entrusted to them, these skills provide them with the authority to build their own brand and the firm reputation.

In many patent law firms, men are solely responsible for protecting the solutions of a technical nature. This is due to the fact that in Poland most graduates of technical schools are men. However, this situation has begun to change, with an increasing number of female patent attorneys with technical education employed in our law firm. The constant development of one's know-how and competencies is absolutely crucial, as is taking into account changes happening in the fast-paced world around us. It also implies the need for continuous professional improvement in order to be able to provide services in the sector of intellectual property protection. One must be open to gaining knowledge and expertise in the newly emerging branches of the economy.

In order to maintain parity, it is therefore necessary to understand that any professional activity can now be performed by both women and men and to implement this knowledge on day-to-day basis. The secret to empowering women in the IP industry lies in not dividing positions and tasks into typically female or typically male.

The world of intellectual property is also the world of creators of innovative solutions – here too men still dominate, although recently more and more women are creating innovative solutions. I would like to see their number grow steadily in Poland; after all, we do have a glorious tradition in this area, as Maria Skłodowska-Curie was an inventor.

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The constant development of one's know-how and competencies is absolutely crucial, as is taking into account changes happening in the fast-paced world around us.”







# LAW FIRM RANKINGS 2024

South America

A comprehensive list of the  
10 most well-respected law firms  
from South America







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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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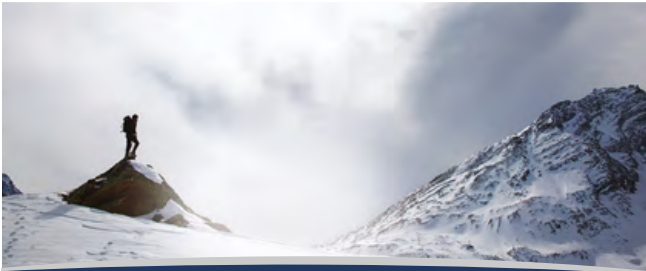
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# Trademark squatter eliminated by the BBC after attempted exploitation of the TOP GEAR mark

**Vladimir Biriulin, Partner, Russian Patent Attorney, Head of Special Projects, of Gorodissky & Partners evaluates the recent case that almost saw the loss of the TOP GEAR mark for the BBC!**

The BBC registered TOP GEAR in 2015 under No 538851 with priority of December 10, 2013, in Class 38.

There was also another TOP GEAR trademark (No 339837 in Classes 38, 41, 42.43) registered by a Russian company in December 2007 with priority of October 25, 2005. That company was in the process of liquidation but immediately before that came into effect a Russian entrepreneur, who is notorious for cybersquatting, acquired the trademark in August of 2016. The entrepreneur dealt with immovable property only.

On November 20, 2017, he filed a cancellation action at the Chamber of Patent Disputes (CPP)



Vladimir Biriulin

against the BBC's trademark No 538851 because his trademark pre-dated the BBC's trademark. The BBC argued that the complainant was not an interested person, and his actions should be regarded as unfair competition. The BBC used its trademark extensively while the complainant did not use it at all.

Notwithstanding, the BBC's trademark was canceled on formal grounds (CPP's decision dated March 30, 2018). We do not discuss the reasons behind the registration of the BBC's trademark though an identical trademark No. 339837 had been registered years before.

The BBC filed a cancellation action against trademark No. 339837 because of non-use. The BBC argued that the trademark owner was not an interested person and that the only goal of the trademark owner was to do harm. In the meantime, the disputed trademark was withdrawn by the trademark owner but before that, he had filed and obtained another TOP GEAR registration No. 623091 with priority of April 2016. This registration interfered with the *bona fide* use of the trademark by the BBC. Indeed, the BBC intensively used TOP GEAR in Russia. There was a TV show in Russia and a magazine under the same name.

The BBC applied to the IP court seeking to reverse the decision of the Chamber of Patent Disputes canceling its trademark No. 538851. The IP court explained that the acquisition of a trademark and subsequent revealing of confusingly similar trademarks is a routine and reasonable practice in business activities, and this can be used for the purpose of canceling junior trademarks.

As a result, the decision of the Chamber of Patent Disputes was upheld by the IP court. The BBC appealed the judgment at the Presidium (cassation instance) of the IP court. The basis for

the appeal was that in the opinion of the BBC, the appeal against the registration of the BBC's trademark had not been filed by an *interested* person as required by Article 1513(2). Besides, the entrepreneur abused his right to initiate the cancellation of the BBC's trademark. The IP court agreed that the 1st instance of the IP court had made premature conclusions regarding the BBC's arguments. The judgment was handed down by the 1st instance court without regard to all circumstances surrounding the case.

The IP court put forward important considerations regarding the similarity of trademarks. The probability of confusion does not depend only on the degree of similarity of the designations in the eyes of the consumer but also on other factors, i.e., whether the trademark is used for specific goods, duration, and the scope of use of the trademark, whether the trademark is recognizable by consumers. If the trademark is not used, the consumers do not have associative links with that trademark or allegiance to its owner, therefore there is no possibility of confusion of the compared trademarks in the eyes of the consumer.

Hence, since the cited trademark is not used, this should be viewed in such a way that there should be no confusion between the disputed and non-used trademark. The IP court did not issue a judgment but sent the case to the 1st instance court for reconsideration by a different panel of judges.

The court of 1st instance recognized that the previous panel of judges had not examined the behavior of the entrepreneur who sought to cancel the BBC's trademark. If one of the parties behaves unfairly, the court may refuse protection of its claims. It was stated that the entrepreneur had registered his trademark No. 623091 for the only purpose of making the use of trademark No 538851 by the BBC difficult. This was confirmed by the proposal of the entrepreneur to sell his trademark No. 623091 to the BBC.

It was stated during the hearing that the patent office, when it canceled the BBC's trademark, was guided by Part IV of the Civil Code while the evaluation of the behavior of the appellant would go beyond its competence. In its judgment, the court obliged the patent office to reinstate the registration of trademark No. 538851.

One might think that this was the final outcome of the case. Not so. The entrepreneur filed a cassation appeal to the IP court but the appeal was dismissed.

This case was important in that it was included in the Review of Judicial Practice dated November 15, 2023, occasionally issued by the Supreme Court.

It is worth noting that the entrepreneur, whose name is Azamat Ibatullin, is a character well-known to many. He registered 725 trademarks in

**The BBC argued that the complainant was not an interested person, and his actions should be regarded as unfair competition.**

”

his name. There were 232 court cases initiated by Ibatullin and, in many cases, his behavior was recognized as an abuse of right.

In one of the cases (A40-59474/2020) he sued a company allegedly infringing its rights for a trademark. In doing so he claimed compensation in the amount of 50,000 rubles and paid a court fee in the amount of 2,000 rubles. Later he raised his claim for compensation to 375,000,000 rubles but scrimped on payment of a larger court fee. The court dismissed his claims on the grounds of abuse of right by the plaintiff.

Ibatullin appealed the judgment at the appeal court without success and further at the IP court in its capacity as cassation instance. The IP court found some flaw in the previous judgment and sent the case to the 1st instance commercial court without obliging the court to issue a specific judgment. During the hearing, Ibatullin argued that he had the right to 909 952 000 rubles of compensation (initially he claimed 50,000 rubles). He submitted evidence to the court according to which he had concluded a license agreement with another person. Nevertheless, the case was dismissed. Ibatullin again appealed the judgment at the court of appeal.

The case was bandied back and forth again through several court instances. Ibatullin reduced his demands to 10,000 rubles of compensation. And here, the judge made an unexpected and wise move: she called evidence from the patent office and obtained the mentioned license agreement. It transpired from the license agreement that the license was royalty-free. The judge rightly concluded that the plaintiff evaluated the right of use of the trademark at "0" rubles which means that the trademark has no value for the plaintiff.

Finally, the judge issued a judgment on February 1, 2023, dismissing even that meager claim for 10,000 rubles.

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# Safeguarding innovation: Maddock & Bright's unwavering commitment to ethical excellence in IP law

**In celebration of their approaching 75th anniversary, Maddock & Bright express their dedication to the protection of innovation throughout the Mena region.**

**M**addock & Bright IP Law Office is a unique law firm. It is ranked amongst the most professional law firms in Egypt, long-established for 74 years, specializing in the protection of Intellectual & Industrial Property Rights in Egypt, the Middle East, and North Africa. The firm fills a market gap by cleverly combining services in the field of intellectual property law and market entry support. Maddock & Bright provides customized and comprehensive services catered to the specific needs of foreign companies and law firms in the Mena Zone.

In the dynamic realm of intellectual property law, where innovation meets legal protection, Maddock & Bright stands as a beacon of unwavering commitment to ethics, core values, and a client-centric service. Renowned for delivering tailored and all-encompassing services finely tuned to the specific needs of foreign companies, the firm stands as a pivotal entity in serving a diverse clientele. As a leading IP law firm in the world, Maddock & Bright safeguards the interests of its clients and upholds a distinctive set of core values that sets it apart in the competitive landscape. At the heart of the firm's mission is a belief in the transformative power of intellectual property. As guardians of innovation, the firm actively contributes to the creation of an environment where groundbreaking ideas can flourish.

Maddock & Bright leverages its expansive scale, diversity, and cutting-edge technological tools to provide comprehensive legal services to foreign companies and law firms. The firm combines its existing expertise with aggressive management and expansion tactics to bring a wider range of integrated legal solutions and a greater regional footprint to the legal field.

## The essence of Maddock & Bright's core values

At the heart of Maddock & Bright's ethos lies a deep-rooted commitment to ethical practices. The firm recognizes the transformative power of intellectual property and understands the pivotal role it plays in shaping the world. In an industry where ethics can be challenged, Maddock & Bright places integrity at the forefront, ensuring that every legal solution provided aligns seamlessly with the highest standards of professional code of conduct, ethics, and clients' privilege. Maddock & Bright's dedication to its core values, including transparency, accountability, integrity, and client satisfaction, forms the core of its success. Maddock & Bright sees its role not just as protecting the interests of clients but as a safeguard to the very fabric of innovation that drives societal advancement.

Maddock & Bright's core values are guiding principles that shape every facet of the firm's operations. At the core is a profound commitment to integrity, which permeates through every interaction, decision, and strategy employed and implemented by the firm. This commitment to ethical conduct is not just an ideal but a fundamental pillar that upholds the trust bestowed upon Maddock & Bright and their clients.

Transparency forms the cornerstone of the firm's approach, as Maddock & Bright believes that open communication is essential for fostering trust. Clients are kept informed at every step of the legal process, ensuring a collaborative relationship that goes beyond the traditional attorney-client dynamic. This dedication to transparency reflects Maddock & Bright's belief that informed clients are empowered clients.

Accountability is another pillar that supports Maddock & Bright's commitment to excellence. The firm takes responsibility for its actions, ensuring that clients receive not just legal solutions but a sense of security in knowing that their intellectual property concerns are handled with the utmost care and diligence. In an industry often characterized by complexity, Maddock & Bright stands out for its straightforward, accountable, and client-centric approach.

## Preserving global innovation: Maddock & Bright's crucial role in safeguarding intellectual property

Maddock & Bright's philosophy recognizes the global challenge of enforcement. The firm possesses strategic and tactical tools that enable the effective execution of court orders. The absence of vigorous Intellectual Property (IP) enforcement can have profound and far-reaching implications for global innovation, economic stability, and societal progress.

Offering tailored services designed to meet the specific demands of foreign companies and law firms entering the Middle East and North African Market, the firm delivers a meticulously customized and comprehensive array of services. Utilizing diverse expertise and a state-of-the-art technological capability, Maddock & Bright offers comprehensive legal assistance to foreign legitimate IP rights holders and foreign companies seeking protection and/or enforcement in the Mena region.



## Résumés

As a managing partner at Maddock & Bright IP Law offices, overseeing operations in Egypt and several Mena region countries, **Abdel Wahab Moustafa** assures the development of Maddock & Bright IP Law Office (MBO), the management of a team of patent, trademark, design attorneys, lawyers, and translators. Mr. Moustafa's legal strategies, including administrative and court proceedings, undercover investigations, and border seizures, have enhanced MBO's credibility. He is responsible for managing investigators focused on disrupting the production and distribution of counterfeit goods and prosecuting counterfeit purveyors, trademark and copyright enforcement, and anti-diversion strategies. He collaborated with the Japanese Patent Office on a project titled, "Data Bank for Intellectual Property Information from Emerging Nations", and authored articles on IP in Egypt and the Mena region. Notable works include Copyright Law in Egypt, Patent Enforcement in Morocco, Trade Secrets Protection in Egypt, and Fatal Pill. Mr. Moustafa's multifaceted expertise, strategic leadership, and many contributions to international intellectual property initiatives underscore his pivotal role in shaping Maddock & Bright's success in the dynamic landscape of legal practice.

**Nada Ghazy Nasser** is presently overseeing the Business Development Department and managing responsibilities within the Prosecution Department at Maddock & Bright. With an extensive academic background, she earned her PhD from Cairo University in the Department of English Language and Literature, showcasing her dedication to scholarly pursuits and academic excellence. Building upon this, she pursued her MA degree from the American University in Cairo in 2015. Her tenure at Maddock & Bright exemplifies her proficiency in business development, where she combines her academic ability with practical skills to fortify the firm's standing in the realm of intellectual property rights. She actively engages in initiatives that promote education, language proficiency, and the advocacy of intellectual property rights within the broader community.

“  
**This dedication to transparency reflects Maddock & Bright's belief that informed clients are empowered clients.**  
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According to the above and beyond conventional and traditional practices of IP law firms, we have extended specialized services that encompass, but are not limited to:

1. Custom proceedings
2. White-collar crimes
3. Investigation and undercover operation
4. Trademark use and non-use investigation
5. Online monitoring and takedowns
6. Track and trace procedures
7. IP survey
8. Tests purchases (online & offline)
9. Company research
10. Surveillance
11. Factory/Warehouse findings
12. Raid support
13. Anti-counterfeiting program management
14. Police customs cooperation
15. Police customs training
16. Civil and criminal prosecution

**Gray market investigation services:**

Gray market pirated/counterfeit/infringed products are costing manufacturers millions of currency losses annually and it eventually may decrease the longevity of the original market. Maddock & Bright's investigators deliver an extensive range of services and advice on brand protection, enforcement, and vital IP matters. The firm understands the value of brands and goes to great efforts to protect them.

Maddock & Bright IP investigators can conduct investigations to obtain concrete evidence, identify sellers/resellers, and undertake critical issues. Our strategy:

- Market survey to locate the stock and to find the supply chain;
- Finding the network of counterfeiters broadly;
- Sample/trap purchases to collect samples;
- Extensive research on interval schedules

“  
**Maddock & Bright’s investigators deliver an extensive range of services and advice on brand protection, enforcement, and vital IP matters.**  
”

to know the status of the level of gray marketing products.

The firm can also locate witnesses and set up undercover operations wherever required to get into the nerves of the supply and manufacturing chain.

**Parallel trade investigation services:**

Maddock & Bright's IP investigators understand the problem of parallel trade which is a growing issue in the field of violation of IP rights. Only the owner of the IP rights can use the trademark to sell their products, but in the case of parallel trading, the firm investigates from the manufacturers to retailer and seller to find the loopholes while manufacturing the products. The firm considers doubts about the manufacturing of the product but on the other hand, it also doubts or expects the counterfeiters to manufacture the price caps and stickers to make the products seem as genuine as possible. Maddock & Bright conducts their investigations on the following factors:

- Identifying the chain from the seller to reseller, to collect evidence to expose the legal manufacturers or illegal manufacturers;
- Sample/trap purchases to collect samples;
- Conducting market surveys to identify the counterfeiting stock;
- Identifying counterfeit or infringing products on the internet;
- Network of counterfeiters.

Maddock & Bright's services are customized and tailored to address the specific situations at hand, providing solutions to uncover the truth of the real scenario and safeguard brands from potential violations.

**Protecting the world: a distinguished mission, countering counterfeiting through strategic investigation and undercover operation**

Lack of IP protection contributes to an environment where counterfeit products and unauthorized use of intellectual property thrive. This not only erodes the market share of legitimate businesses but also hampers economic growth, creating economic disparities on a global scale. Counterfeiting and unauthorized use of intellectual property can flood the market with substandard or potentially harmful products. In this arena fraught with challenges, Maddock & Bright not only serves as a guardian of intellectual property



but also as a shield for consumers. The firm ensures that consumers are protected from the dangers posed by inferior or unsafe products.

It is important to note that there is a major global impact of counterfeiting, a menace that undermines the industries and economies of our world. The Anti-Counterfeiting Department at Maddock & Bright takes a formidable stance against this threat. By employing a combination of legal expertise and strategic foresight, the firm actively combats the proliferation of counterfeit goods, contributing to the creation of a safer and more authentic marketplace through a strategic anti-counterfeiting management program, an investigation management program, and an enforcement management program to support and assist Maddock & Bright's litigation department in combatting counterfeiting effectively.

**How can your investigators support your litigators?**

It is worth mentioning that working as a private investigator is not relaxing, the journey is not always easy because they often have to deal with several types of activities and carry out such **investigations locally & internationally**, which is a difficult task to perform for a lawyer and/or investigator if she or he are not well experienced and with very specific personal skills and/or a law enforcement background.

**The Anti-Counterfeiting Department and Investigation & Undercover Operation**

“  
**Maddock & Bright’s IP investigators understand the problem of parallel trade which is a growing issue in the field of violation of IP rights.**  
”

**Department support the Litigation Department in their case-building through the following process subdivided into two steps: 1. academic and technical step (internal support) and 2. practical step (external support).**

**Academic & technical step (internal support)**

**Establish a concrete Internal Support Department:**

- Database: to build a proactive, systematic, and collaborative process;
- Understand the finance, economy, and how business works;
- Know enough about intellectual property to perform necessary field work and gather evidence;
- Have a team with a law enforcement and/or governmental procedures background;
- Efficient team for non-field work;
- Acting as the bridge between the Legal, Marketing, Sales Departments, and/or Security Departments.

**Practical step (external support)**

- Identify who can do the undercover work;
- Support of local units is mandatory;
- Eyes and ears in the market;
- Support of our undercover operation by local units;
- Track & trace;



- The game plan, activity, etc., is the who, what, where, when, and how.

In this regard, with the steadfast support of the Egyptian government, the Managing Partner of Maddock & Bright, Mr. Abdel Wahab Moustafa, who leads a dedicated investigation team, has been closely monitoring and addressing various counterfeiting activities in Egypt and/or facilitated through Egypt for numerous years. The dedicated investigation team has actively been managing substantial counterfeiting cases, notably in pharmaceuticals, vehicle spare parts, agrochemicals, and tobacco. In this respect, Mr. Moustafa has successfully collaborated with the relevant Egyptian authorities to devise solutions related to counterfeit products. This strategic initiative empowers the firm to comprehensively control international counterfeiting activities through a systematic track and trace process. This was established years ago and was implemented with great success in the recent years of COVID through the collaboration between the Investigation and Undercover Operation Department, the Anti-counterfeiting Department, and as well as the support of the local units together with the cooperation of the concerned authorities.

The Investigation and Undercover Operation Department at the firm employs cutting-edge techniques to unearth potential threats to intellectual property. This proactive approach ensures that clients' innovations remain shielded from any potential harm. The Investigation and Undercover Operation Department is a testament to the firm's proactive beliefs, employing unique strategies to identify and neutralize potential threats to intellectual property and counterfeit goods. By remaining ahead of the curve, Maddock & Bright consistently secures its clients' innovations from unforeseen risks. The commitment to innovation protection is ingrained in the firm's ethos and is exemplified by the dynamic efforts of its Investigation and Undercover Operation Department in preserving the integrity of intellectual property in a rapidly evolving world.

A vital arm of the firm, Maddock and Bright's Anti-Counterfeiting Department and the Investigation and Undercover Operation Department adopt a strong position not only against the spread of counterfeit goods, but also support and aid the Litigation Department in a strategic manner in their case buildings to enable them to set up all the clients' cases in an organized manner to leverage and maximize the likelihood of success. Recognizing the global impact of counterfeiting on industries and economies, the firm employs strategic measures to combat this threat head-on, contributing to a safer and more authentic marketplace.

**Maddock & Bright not only protects your ideas but fosters a legacy that redefines industries and inspires future generations of innovators.**

### Choosing Maddock & Bright: a collaborative partnership

In a world where progress relies on innovation, Maddock & Bright stands forth as a reliable partner. Beyond legal expertise, the firm's distinct core values create a cooperative relationship with clients. The collaborative relationship ensures that the innovative spirit continues to thrive, safeguarded by a legal team that is not proficient but passionately dedicated to preserving the integrity of intellectual property. Maddock & Bright stands as a beacon of ethical excellence in the realm and field of intellectual property law. Through its unwavering commitment to transparency, accountability, and client satisfaction, the firm not only protects the interests of clients but actively contributes to safeguarding innovations on a global scale. In a world that needs guardians of intellectual property, Maddock & Bright emerges as a formidable force, standing tall on a fortress of ethics, innovation, and legal ability. The firm upholds its guiding motto of "trust, consistency, and commitment is who we are" as a foundational belief. Maddock & Bright is committed to embodying justice in our daily lives, advocating not only for our clients but also for our communities, our fellow individuals, and the future caretakers of our planet.

Maddock & Bright is not just a law firm – they are strategic partners in safeguarding innovation and creativity. Their passion lies in navigating the dynamic world of intellectual property with a blend of expertise, innovation, and unwavering commitment. Maddock & Bright not only protects your ideas but fosters a legacy that redefines industries and inspires future generations of innovators.

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We handle our clients' cases in Armenia, Russia, Kyrgyzstan, at Eurasian Patent Office, and cooperate with partners and associates in other Eurasian countries: Georgia, Belarus, Kazakhstan, Azerbaijan, Turkmenistan, Uzbekistan, Moldova, Tajikistan.

Our attorneys are members of INTA, FICPI, AIPI, LESI, ECTA, PTMG.

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The firm is widely acknowledged for its pioneering endeavours in the areas of intellectual property, technology, and competition law practice.

OLD BAILEY's international clientele includes number of Fortune 300 and 500 companies, and renowned brands. OLD BAILEY also represents number of local companies and brands that are market leaders in their respective fields, and number of net-worth individuals, socialites and several leading celebrities representing the local music, film and TV industries.

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