

# The Trademark Lawyer

Issue 2 2024

GLOBAL REACH, LOCAL KNOWLEDGE

[www.trademarklawyermagazine.com](http://www.trademarklawyermagazine.com)

## Lawyer

# Welcome to Atlanta!



**Launch**  
interactive document

  
IP TrendMonitor



Celebrating INTA's 2024 Annual Meeting with our special bumper edition!

**An interview  
with PepsiCo**

Page 10



**Post-Sale Confusion  
Doctrine**

Page 24



**Ultimate brand  
protection play**

Page 60





THINKING BEYOND AS ONE



1 FIRM / 4 REGIONS / 29 OFFICES / 100+ JURISDICTIONS / 150+ PRACTITIONERS / 250+ EMPLOYEES

We think beyond today's possibilities to work as one and offer centrally managed super-regional IP solutions in secondary markets, leveraging tomorrow's technology and local know-how, through an unrivalled footprint of strategically located offices across Africa, Central Asia, East Europe and the Middle East.



CWBIP.COM



Twenty-five consecutive years as the number 1 in Peru



The International Legal Alliance granted Barreda Moller the Gold Award as the best Latin American IP Law Firm.

The Managing Intellectual Property magazine, the Latin Lawyer law directory, the Legal 500 law directory and the World Trademark Review magazine for twenty-five consecutive years have selected Barreda Moller as the number 1 IP law firm in Peru.



Av. Angamos Oeste 1200  
Lima 15073, Peru  
T (511) 2215715  
mail@barredamoller.com  
www.barredamoller.com

# .fenixlegal

INTERNATIONAL PATENT AND LAW FIRM

SWEDEN • SCANDINAVIA • EUROPE

European Patents  
EU Trade Marks  
Community Designs  
Copyright & Marketing Law  
IP Due Diligence & Business Law  
Domain Name Disputes & Internet Law  
Mediation  
Social Network Law  
Artificial Intelligence



Brahegatan 44 • 11437 Stockholm • Sweden  
info@fenixlegal.eu • www.fenixlegal.eu



## Editor's welcome



Welcome to our INTA Annual Meeting 2024 Special Edition! And for those attending, welcome to Atlanta! If you are picking up *The Trademark Lawyer* for the first time please know that our magazines are also available in digital format via our website, with the latest issue always free-to-read.

Our guest interview this issue is with Sergio Barragan, Senior Legal Director, Trademark Counsel LatAm at PepsiCo in which he discusses the importance of fostering friendships with outside counsel and provides advice for career progression in the IP space.

This issue is jam-packed with updates including: consideration of the correlation between business success and trademark registration; a comparative analysis of the handling of pre- and post-sale confusion; best practices for registering and protecting app products; an overview of GIs in the UK; the intricacies of business liability policies and insurances concerning IP; dotBrand domains as a signature of trust; USPTO specimen requirements; ambush marketing at the Olympic Games; strategies for navigating use-related issues in Russia; and much more!

Also find the latest IP Trend Monitor in collaboration with the Dennemeyer Group which focuses on projections for eight industries that are pivotal for the global economy.

Our *Women in IP Leadership* segment features Janice Bereskin, Partner at Bereskin & Parr LLP, and Donna Short, IP Partner and Head of the Trademark Practice at Addison's. Special thanks to Clarivate for sponsoring the segment and supporting a platform to encourage the continued empowerment of women in the sector.

We hope you enjoy the issue!

  
Faye Waterford, Editor

### Mission statement

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

### Sustainability pledge

We pride ourselves on using a sustainable printer for our hardcopy magazines. Pureprint Group was the first printer in the world to become CarbonNeutral® and has worked to remove non-recyclable materials from the manufacturing processes while creating dynamic allocations to reduce energy, waste, transport, and materials. Find out more at [www.pureprint.com/sustainability/](http://www.pureprint.com/sustainability/)



### THE TRADEMARK LAWYER

Issue 2 2024

Editor & COO

Faye Waterford  
faye@ctclegalmedia.com

Publishing Director

Chris Dooley  
chris@ctclegalmedia.com

Publishing Sales Manager

Katie Kerr  
katie@ctclegalmedia.com

Head of Digital

Ellen Peet  
ellen@ctclegalmedia.com

Finance Director

Carla Dooley  
accounts@ctclegalmedia.com

Subscription Enquiries

subscriptions@ctclegalmedia.com

Published by:

CTC Legal Media Ltd,  
23 Hedgers Way, Kingsnorth,  
Ashford, Kent TN23 3GN  
Tel: +44 7718 278253

Design and Repro by:

Design and Printing Solutions Ltd  
Unit 45C, Joseph Wilson Industrial  
Estate, Whitstable, Kent CT5 3PS

Printed by:

Pureprint Group, Crowson House,  
Bolton Close, Bellbrook Park,  
Uckfield, East Sussex TN22 1PH

Whilst every effort has been made to ensure that the information contained in this journal is correct, neither the editor, contributors or CTC Legal Media can accept any responsibility for any errors or omissions or for any consequences resulting therefrom. © CTC Legal Media 2020, and contributors. The contents of this journal are protected under the copyright law of the United Kingdom, the Berne Convention and the Universal Copyright Convention. Any unauthorised copying of the journal may be in breach of both civil and criminal law. Infringers will be prosecuted.

ISSN 2053-3829

CTC Legal Media



# Contents

## 5 Meet the Editorial Board

Meet our Editorial Board members who help determine the direction of this magazine.

## 10 Cover Story: An interview with Sergio Barragan, Senior Legal Director, Trademark Counsel LatAm, PepsiCo

Sergio sits down with *The Trademark Lawyer* to discuss brand and trademark strategy, the importance of fostering friendships with outside counsel and business partners, and provides valuable advice for IP professionals looking to progress in their careers.

## 12 The staying power of trademarks

Nick Guinn, Shareholder at Gunn, Lee & Cave, considers the effect of trademark registration on a business' success beyond the mere legalities of trademark protection.

## 19 The role of trademark strategy in business profit and brand success

Jing XIE and Jane LI of China PAT Intellectual Property Office strike a balance between the practicalities of trademark registration and the art of brand storytelling in China for overall business success.

## 24 Kicking around the post-sale confusion doctrine in English and US courts

Leigh Smith and H. Straat Tenney of Locke Lord provide a comparative analysis of the handling of pre- and post-sale confusion of trademarked goods by jurisdiction to draw interesting conclusions for corporations to consider when developing their branding.

## 28 Classification of app products in trademark infringement cases

Tianyuan Zhang, Trademark Attorney at Beijing Sanyou Intellectual Property Agency Ltd., examines recent infringement cases to determine best practices for registering and protecting app products in the Chinese market.

## 32 The latest updates to geographical indications in the UK

Cherry Shin, Senior Trademark Attorney at HGF, provides an overview of GIs and their variations under UK law to provide helpful comparative advice for the protection of jurisdictionally relevant IP.

## 37 IP Trend Monitor: IP FRONTIERS. Navigating innovation in eight key industries

The latest IP Trend Monitor study gathers the opinions of IP specialists to identify far-reaching research and legal trends in eight critical industries.

## 49 Enforcing rights in composite marks

Ranjan Narula and Shivangi Kohli of RNA, Technology and IP Attorneys evaluate the procedure for enforcing rights against a deceptively similar mark that uses components of other well-known marks in an attempt to capitalize on existing reputations.

## 54 If you think you are insured against trademark and copyright infringement claims, look again

Susan J. Lutzker, Senior Partner at Lutzker & Lutzker LLP, explains the intricacies of business liability policies and insurances concerning claims for IP infringement to provide key advice for protecting your portfolio.

## 60 The ultimate brand protection play

Stuart Fuller, Chief Commercial Officer at Com Laude, builds a case for the importance of dotBrand domains, expressing the undeniable value of trust between participating brands and their consumers.

## 63 The Canadian trademark ecosystem: what to consider for 2024

Micheline Dessureault, Caroline Guy, and Simone Ndiaye of Therrien Couture Joli-Coeur LLP provide their annual update with advice for navigating the Canadian trademark system for our INTA special edition.

## 69 Protecting unregistered overseas brands in China

Li Xiaohong and Tian Yu of ZY Partners examine the application of overseas prior use for the protection of high fame trademarks unregistered in China in the face of first-to-file bad faith registrations.

## 73 Women in IP Leadership:

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

**Featuring:** Janice Bereskin, Partner at Bereskin & Parr LLP, and Donna Short, IP Partner and Head of the Trademark Practice at Addisons.

**Sponsored by:** Clarivate

## 80 Jurisdictional briefing, Russia: 2024: 30th anniversary of the Eurasian Patent Office

Dr. Tatiana Vakhnina and Dr. Alexey Vakhnin of Vakhnina and Partners celebrate the upcoming 30th anniversary of the EAPO by detailing the much-anticipated developments of the Eurasian Trademark.

## 84 Jurisdictional Briefing, US: specimen requirements of the United States Patent and Trademark Office

Nancy Kennedy and Farzad Panjshiri of Cantor Colburn detail the requirements for goods and services alongside the rules for submitting specimens at the USPTO to protect trademarks and service marks.

## 87 The landscape of IP rights in Russia amidst geopolitical tensions

Riikka Palmos, European Trademark Attorney at Papula-Nevinpat, provides an update on the IP landscape for foreign filers in Russia, drawing on recent case decisions to answer important questions.

## 92 The Olympic Games and the protection of intellectual property

Vanessa Rondeau, Associate at Uthhoff, explains the principles of ambush marketing in advance of the 2024 Olympic Games to provide guidance on what to look for to protect and profit from relevant IP.

## 96 Current trends and practices for anti-counterfeiting in e-commerce in Russia

Anton Bankovsky, Counsel at Gorodissky & Partners, evaluates the current approaches to tackling IPR infringement through online sales across the Internet and marketplace platforms.

## 100 Country branding - COLOMBIA THE COUNTRY OF BEAUTY

Carolina Vera Martiz of VERA ABOGADOS ASOCIADOS details the reasons behind and the benefits of PROCOLOMIA's recent development and promotion of their country's brand.

## 102 Registration features of collective trademarks

Maria Dvornikova, Russian Trademark Attorney at Zuykov and partners, details the intricacies of the infrequently used collective trademark to express their valuable benefits.

## 104 Shine bright in Antwerp at the ECTA 42nd Annual Conference

Carina Gommers, ECTA First Vice-President responsible for the ECTA academic program, provides a glimpse behind the curtain for the upcoming conference that is set to inform and inspire attendees.

## 106 Crucial strategies for trademarks in Russia: navigating use-related issues

Anna Bobkina, Trademark Attorney at PATENTICA, discusses the adapted approach to trademark protection in Russia given the recent changes in the market with foreign brands suspending activity, rebranding, or facing challenges from Russian competitors.

## 110 Promoting business through trademark security in Brazil

Renata Roha of Vaz e Dias Advogados & Associados provides advice on the novelties of trademark security in Brazil to guide best practices for business success.

## 114 IP and the metaverse: a new world in focus

Rania Vrontdou and Socratis Socratous of Hadjianastassiou, Ioannides LLC (member of the Deloitte Legal network in Cyprus) evaluate the possible implications the metaverse may have on the protection of intellectual property.

## 119 Back to the Future revisited – NBCUniversal and DeLorean Motor Company settle case involving DeLorean trademark claims

Maya L. Tarr, Principal and Founder of Carob Law, P.C., summarizes the recent dispute over the rights of the DeLorean-related trademarks and the infamous Time Machine Car after the transfer of rights for the DeLorean Motor Company raised questions over granted rights.

## 123 Directory of services

An A to Z list of the international law firms who provide IP related services.

**Francesco Bonini - Studio Bonini. Italy**

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.



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

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



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

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



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

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



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

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



**Shelley Jones - Lawyer and Registered Trademark Agent. Canada**

Shelley is a Fellow IPIC and has worked with famous brands on trademark and copyright infringement, litigation, domain name disputes, and anti-counterfeiting issues. Her past practice involved managing global trademark portfolios. Shelley has been working in the not-for-profit sector on projects focused on increasing IP awareness.



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

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



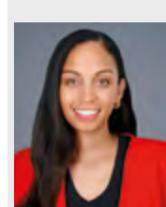
**Barbara Leitao-Johnson - Associate General Counsel, Intellectual Property, IABBB. Latin America/USA**

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



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

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



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

An experienced German legal advisor specializing in IPRs, particularly trademarks. Yasir is dedicated to serving a diverse clientele in the UAE and MENA region. With an in-depth understanding of IP laws and procedures in the UAE, GCC, Europe, and US, his expertise encompasses filing, enforcement, and drafting. As an active member of INTA and AIJA, Yasir is committed to staying at the forefront of IP.



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

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



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

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



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

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



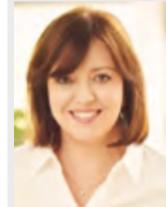
**Charlotte Wilding - Partner, Keltie LLP. UK**

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



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

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



For over 50 years our business is to empower the innovation of business all around the world.



For more than five decades, GLP has been offering a complete range of services for the structured protection of intellectual property.

Our Clients range from artisans to some of the Top Companies on the *Forbes 500* list, for whom we provide initial consultancy and support in lawsuits - both as plaintiff and defendant - throughout the world.

The quality of our services, commitment of our team and ability to achieve our Clients' highest objectives, led GLP to be a world-class leader in the IP business.

- Patents
- Trademarks
- Designs
- IP Strategy
- Online Brand Protection
- Legal Actions & Contracts

MILANO

+39 02 54120878  
glp.mi@glp.eu

UDINE

+39 0432 506388  
glp@glp.eu

BOLOGNA

+39 051 328365  
glp.bo@glp.eu

glp.eu

Other offices:  
PERUGIA · ZÜRICH  
SAN MARINO

Scan and download our app  
EU IP Codes:  
Get your IP toolbox now!





# An interview with Sergio Barragan, Senior Legal Director, Trademark Counsel LatAm, PepsiCo

**Sergio sits down with *The Trademark Lawyer* to discuss brand and trademark strategy, the importance of fostering friendships with outside counsel and business partners, and provides valuable advice for IP professionals looking to progress in their careers.**

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

This year will be 20 years. I started my professional career in a civil and commercial litigation firm with my brother, who soon after decided to join a new project and therefore recommended I find a new job in another firm. Then, I joined a great team in one of the most prestigious full service law firms in Mexico, Santamarina & Steta, where I worked for almost nine years in the IP area, being here where I had my first contact and fell in love with this profession.

I never felt the need to move from one firm to another because I believed that I was already at one of the best firms in Mexico, and moving to another to do the same thing did not make sense. But I always said that I could consider moving to a company where brands were relevant, and nine years after starting my career in IP, I received the invitation to join the PepsiCo family.

## **Can you describe your role and responsibilities at PepsiCo?**

I'm the Senior Legal Director for IP, responsible for Latin America, but I also provide general legal advisory to the global food group, which oversees all global initiatives of global brands such as Cheetos, Doritos, and Lay's.

## **What strategies do you put in place to build a strong trademark portfolio? And how do you work to implement this across Latin America?**

First, we seek to be a great business partner for our clients, always accompanying them in all



Sergio Barragan

projects from the beginning, making sure we launch strong brands, above all, with a consistent image around the world. For us, clearance and deep trademark searches and analysis are one of the most important and relevant pieces of what we do, ensuring that we can use, protect, and enforce the different brands that we use. Clearances are performed in-house in countries like Mexico, the USA, and Brazil, and in the rest of the countries we partner and work closely with our different outside counsel.

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

Stand-alone brands are the strongest kind of trademarks. When you can recognize a brand only by its name, it means it is a strong and distinctive asset. If you have many stand-alone brands and your word marks are strong, then you have a strong trademark portfolio.

## **What do you consider to be key factors for establishing a strong brand in the food and beverage industry? And how might this differ from other industries?**

I think it's the same for all industries. The only thing you need to do is to work closely with your marketing and innovation teams to identify and register strong brands avoiding the use of diluted, common use, or generic terms. What I have seen in recent years is that agencies and marketers are looking for simple and straightforward brands that are easily associated with the products they

want to identify with in order to stay at the top of consumers' minds; as in-house and trademark lawyers, we need to find a middle ground and work closely with our clients to accomplish both goals, which are brands that can be identifiable by our customers, but at the same time that are strong enough to be protected and differentiated from our competitors.

We achieve this by being creative. PepsiCo is definitely a brand company that has within its portfolio a significant number of well-known and famous brands. So it's about building around those brands, obviously creating new ones, and creating strong brands that have a connection with the product, consumers, and the philosophy of the company.

## **What qualities do you value most in your outside counsel?**

The most important thing – which is in every relationship and not just with outside counsel – is to look for honesty and for people who are engaged. What we have been building over the last 20 years is a deep connection and partnership with each and every one of our outside counsel. For me, they are friends with whom I have been fortunate to create a close relationship and to be able to work in what we love, which is Intellectual Property, they are also part of the PepsiCo IP team.

Recently someone asked me if I have met with all my vendors, and I responded that I don't have vendors, they are friends, business partners, and part of my extended team. If you can create this kind of connection and your counsel are loyal, honest, and ethical while providing a high level quality service, then I think you are very lucky. I am grateful to have the best outside counsel in the entire world.

## **What advice would you give to aspiring attorneys looking to move to an in-house position?**

When I moved from the law firm to PepsiCo, I always thought that I would only stay for a couple of years and I've been here for almost 20. So I think they need to be sure that this is what they want to do, they need to love what they do, and they need to have the same philosophy and code of conduct as the company they aspire to work with. Maybe that's the reason why I have been here for 20 years, because I share the values with this company and I love the brands that I work with. The best advice I can give is, if you are going to move from one place to another, or if you are outside counsel moving to an in-house position, be engaged with the company.

Another thing I would recommend is to always keep in mind that the position is borrowed, and

is not necessarily for life, so seek to make a name for who you are as a person and as a professional, and never for the privileged position you think you may have as in-house counsel of a company. Take advantage of that privileged position to create good personal relationships, which is what you will always take with you wherever you go.

## **What's your favorite PepsiCo product?**

I love all PepsiCo brands!!!! But if I need to mention one it would be Pepsi Max, which is called Pepsi Black or Zero in some countries. On the snack side – it's a hard one – but there is a product that I have to buy every time I visit the US...it's an old brand, but I love Funyuns! On the other side, Doritos is a brand that I love everything around it!





# The staying power of trademarks

**Nick Guinn, Shareholder at Gunn, Lee & Cave, considers the effect of trademark registration on a business' success beyond the mere legalities of trademark protection.**

**B**usinesses that invest in their brands and protect their trademarks are likely to succeed despite statistics telling us that most businesses are doomed to fail within a few years of launching. Anecdotally, the author realized that many clients (most of whom are entrepreneurs and small businesses) who register their trademarks go on to maintain their registrations five, 10, 20 years after registration. This consistent maintenance activity defies the doom and gloom statistics. Based on the statistics, one would assume that few clients (especially small businesses) would renew their trademarks - but that has not been the case. Expanding on this observation, the author consulted with the founder of the law firm, Ted Lee, who said that very few of his clients allow their registrations to lapse.

Perhaps there is a correlation between trademark registration and business success: business owners



Nick Guinn

who care enough about their business to invest in their brand and register their trademarks are more likely to succeed.

This article briefly addresses some statistics that support this thesis. The statistics are followed by several possible explanations.

## Statistics

Statistics concerning the success (or failure) of businesses are often thrown about haphazardly. The figures vary but the common theme is that most businesses are destined to fail. A 2022 article<sup>1</sup> from Inc. reports that "70% of [small businesses] will go out of business within 10 years of founding, according to the U.S. Bureau of Labor Statistics." Doom and gloom statistics like these are often shared to discourage entrepreneurial spirit.

USPTO records might tell a different story. For example, Table 18 of the USPTO's 2023 Workload Table<sup>2</sup> offers data concerning, in relevant part, the number of certificates of registration issued and the number of renewals, annually from 1986 through 2023. Recall that in the United States, trademark registrations are renewed after 10 years. By dividing the number of renewals for a given year by the number of certificates of registration issued for the year 10 years earlier, one can approximate the rate of renewal. This figure is an approximation, of course, given the window of time that registrants have to renew, as well as the fact that renewals occur 20, 30, 40 years, etc., after registration. As for the latter point, the number of registrations and renewals have increased significantly during the last several years, leading the author to believe that 20-plus year-old renewals are a small percentage of the renewals.

Nevertheless, the median and average rates during this time were 45.6% and 43.8% respectively. While the rates ranged from 13.2% to 72.9%, the middle 50% of the rates fell between 42.7% and 48.3%.

**The data above supports the thesis that there is a correlation between trademark registration and business success.**

## Résumé

**Nick Guinn** is a shareholder with the IP boutique, Gunn, Lee & Cave, in San Antonio, Texas. He assists clients in all aspects of intellectual property, with an emphasis on trademark litigation and prosecution.

Prior to joining the firm, Nick served as a law clerk to Chief United States District Judge Fred Biery of the United States District Court for the Western District of Texas. He drafted orders for the Court and assisted with preparing jury charges.

Nick immerses himself in the community. He enjoys helping charities that feed children and rescue neglected pets and other animals.

Author email: [nick@gunn-lee.com](mailto:nick@gunn-lee.com)



**The better trademarks, which are more apt for long-term success, are rewarded with registrations.**

While these figures are not overwhelmingly stronger than the 30% success rate reported in the Inc. article, these figures appear strong enough to warrant further consideration. Is there a correlation or is it mere coincidence? For now, we will continue to assume that a business registering its trademarks may fare better in the long term than a business that does not register its trademarks.

## Indicia of staying power

The data above supports the thesis that there is a correlation between trademark registration and business success. The author is not prepared to identify a definitive reason. However, this article proposes several explanations. Some of the explanations mirror the benefits of trademark registration (e.g., registration aids in anti-counterfeiting efforts). Other explanations are less obvious.

### 1. The registration process weeds out descriptive marks and prevents marks exhibiting a likelihood of confusion

Trademark professionals are well aware that not all trademarks are created equally. Distinctive trademarks are easier to protect and enforce than descriptive trademarks, much less generic terms. Trademark examiners review marks with this issue in mind. Registrations are awarded to

<sup>1</sup> <https://www.inc.com/michelle-seiler-tucker/70-percent-of-all-businesses-fail-make-sure-yours-isnt-one-of-them.html>

<sup>2</sup> <https://www.uspto.gov/about-us/performance-and-planning/uspto-annual-reports>

marks that are inherently distinctive or descriptive and have acquired secondary meaning. Similarly, trademark examiners review for likelihood of confusion. Although the analysis is more robust in the marketplace, the trademark office is a good start. Society does not want customer confusion and trademark offices help with this effort.

To summarize this point, examiners screen a large number of trademark applications. The better trademarks, which are more apt for long-term success, are rewarded with registrations. Whereas the applications with less certain futures are rejected.

### 2. The legal protection of registration brings stability

Registering a trademark provides legal protection, helps brand owners avoid litigation (or at least reduces the cost), and reduces the risk of rebranding. Registered trademarks provide exclusive rights to use the mark on specific goods or services, granting legal protection against infringement. This means a business can legally enforce its rights and prevent others from using similar marks that could confuse consumers.

By obtaining a trademark registration, a business minimizes the risk of being sued for trademark



infringement since the process includes a thorough examination to ensure the mark does not conflict with existing ones. This proactive step can save businesses from costly legal disputes.

Registration also mitigates the risk of rebranding. Without the protection of a registered trademark, businesses may face legal challenges that could force them to rebrand. Rebranding is not only costly but can also erode customer loyalty and brand equity. Trademark registration reduces this risk.

### 3. Foreign registration shows growth and expansion

The pursuit of foreign trademark registration indicates a business' ambition for growth and international presence. While established businesses with a proven track record are more likely to venture into new markets (and offer less support for the thesis), the early move by prospective and nascent businesses toward securing their trademarks internationally should not be overlooked. This proactive step is often driven by visionary entrepreneurs who recognize the global potential of their brand from the outset. Such foresight is not merely about protecting the brand but also about laying the groundwork for future expansion, signaling a commitment to becoming a global player.

“**Registering a trademark provides legal protection, helps brand owners avoid litigation (or at least reduces the cost), and reduces the risk of rebranding.**”

Moreover, seeking foreign trademark registration requires an understanding of international markets and the legal complexities involved. It suggests that these businesses are not only dreaming big but are also willing to invest in building strong relationships and capabilities essential for navigating the global marketplace. This strategic move can also be a powerful statement to potential partners and investors about the business' commitment to establishing a global footprint, enhancing its attractiveness as an investment prospect.

### 4. Asset value

The value of trademark registrations extends beyond immediate legal protections, transforming into significant assets that contribute to the overall valuation of the company. As a business grows, its registered trademarks can be leveraged in various ways, such as through licensing agreements or as collateral in financial transactions. This versatility adds value to the business' portfolio, which can be appealing to investors and financial institutions.

Investors often view a registered trademark as one sign of a company's commitment to protecting its intellectual property, a critical factor in securing and maintaining market strength. This is especially true for startups and emerging businesses, where the potential for growth and market capture is a key consideration for investment. A trademark registration communicates that the business is not only poised for expansion but is also taking strategic steps to safeguard its brand identity and market position. For investors, this signifies a well-managed, forward-thinking company with a clear vision for its future, making it a more attractive investment opportunity.

### 5. Communicates to the public

The presence of the registration symbol (®) acts as a deterrent to potential infringers. It serves as a clear warning that the business is not only aware of its intellectual property rights but is also prepared to enforce them. This can reduce the likelihood of infringement, as potential violators recognize the risk of legal action and the associated costs. By proactively signaling its readiness to protect its brand, a business can maintain a cleaner competitive space around its trademarks, ensuring that its brand identity remains distinct and unblemished.

Moreover, the registration symbol signals to the market that a business is established and serious about its brand protection. It reflects a level of professionalism and maturity, indicating that the business has taken the necessary steps to secure its intellectual property assets formally. This can enhance the brand's credibility and trustworthiness in the eyes of consumers, partners, and investors, who may view the mark's

registration as a sign of quality and reliability. For new or growing businesses, this perception can be invaluable in building customer loyalty and attracting investment.

### 6. Social media

The protection afforded by a registered trademark extends into social media and e-commerce, where the risks of impersonation and misuse are heightened due to the ease of creating and disseminating content. Social media platforms and online marketplaces have implemented policies that specifically favor registered trademarks, offering a suite of tools designed to protect these brands from infringement. These include mechanisms for reporting and removing counterfeit goods, addressing instances of brand impersonation, and even verifying accounts to affirm their authenticity to users. Such protective measures are indispensable for brand owners in safeguarding their reputation online, ensuring that customers' interactions with the brand are genuine and free from confusion or deception.

Additionally, the strategic advantage conferred by trademark registration in leveraging social media and online marketplaces cannot be overstated. It empowers businesses to build and maintain a strong, consistent brand presence across digital

“**Such foresight is not merely about protecting the brand but also about laying the groundwork for future expansion, signaling a commitment to becoming a global player.**”



platforms, enhancing their ability to engage with customers and expand their reach. The benefits provided by trademark protection foster an environment where businesses can innovate in their online marketing strategies without fear of dilution or misappropriation of their brand identity. This level of security is particularly significant in an era where digital platforms are integral to consumer discovery, decision-making, and loyalty. By securing their trademarks, businesses not only protect their intellectual property but also unlock new opportunities for growth and engagement in the digital marketplace, reinforcing the brand's reputation and connection with their audience.

### 7. Hiring an attorney to assist with registration reveals a business owner who seeks outside guidance/expertise/delegation

The journey of entrepreneurship is fraught with challenges and complexities that require not just passion and vision but also specialized knowledge and expertise. In this landscape, the decision to engage experts and consultants, particularly in matters as critical as trademark registration, is a testament to a business owner's acumen and understanding of the importance

K

**M. Sc. Konstantin Tahtadjiev**  
Bulgarian & European Patent Attorney (EQE qualified)  
Bulgarian & European Trademark & Design Attorney

# TAHTADJIEV

INDUSTRIAL PROPERTY

PATENTS

UTILITY MODELS

TRADEMARKS

INDUSTRIAL DESIGNS

**Invent hard, IP it smart** We offer an individually tailored approach for getting the best possible protection for your business inventiveness and creativity in Bulgaria and Europe

[www.ktpatent.com](http://www.ktpatent.com)



of laying a robust foundation for their brand. Seeking the advice of legal professionals or consultants does more than just streamline the registration process; it embodies a strategic approach to business management, recognizing that the intricacies of intellectual property law are best navigated with specialized knowledge. This collaboration ensures that the business' IP assets are protected effectively, mitigating risks that could derail future success.

Moreover, the act of delegating important duties to experts reflects a mature business philosophy that values efficiency, risk management, and long-term planning. It signals a shift from a solo, hands-on approach to a more sophisticated, collaborative strategy, where the focus is on leveraging the expertise of others to bolster the business's growth and sustainability. Entrepreneurs who embrace this approach can focus their energies on areas of the business where they excel, secure in the knowledge that critical aspects like trademark protection are in capable hands. This not only increases the chances of success but also facilitates scalability, allowing the business to adapt and evolve in response to market demands without being bogged down by avoidable legal challenges. In essence, seeking expert advice and delegating crucial

“  
**The act of registering a trademark transcends the legal realm to become a testament to a business' aspirations, ethos, and unwavering dedication to excellence.**  
 ”

tasks is a hallmark of visionary leadership, indicating a readiness to transcend the immediate and pave the way for enduring success and innovation.

**8. Businesses that register their trademarks are planners and care about their brands and how the public perceives their business**

As the heading states, businesses that register their trademarks are planners and care about their brands and how the public perceives their business. In a similar spirit, studies show that parents-to-be who purchase parenting books will make great parents regardless of whether they open any of the parenting books. The mere fact that they cared enough to buy the books is telling about the kind of parents they will be.

A distinction should be drawn between established businesses versus new and future businesses. For established businesses, the application follows already successful efforts and shows a successful business that wishes to continue planning and succeeding.

By contrast, for brand-new and aspiring businesses, registration evidences a business that plans. It also evidences a business that cares about its reputation. Consumers often associate registered trademarks with established,

reputable businesses. Registration suggests a level of seriousness and professionalism, fostering trust and confidence among potential customers. Similarly, businesses that register their trademarks want consumers to trust and have confidence in their brands.

**Conclusion**

The act of registering a trademark emerges not merely as a legal formality but as a strategic business decision that embodies foresight, commitment, and a desire for brand excellence and longevity. This process sifts through countless entities to spotlight those with the vision and resolve to transcend the ephemeral nature of market existence. This endeavor is significant, offering legal protection that nurtures stability, signaling readiness for expansion, enhancing asset value, and facilitating effective communication with the public and potential investors.

Further, the deliberate choice to invest in trademark registration echoes the traits of meticulous planning and a genuine concern for how a business is perceived by the public. It reflects a business ethos that prioritizes brand integrity, aiming for a legacy that withstands the tests of time and market volatility. In essence,

“  
**Rebranding is not only costly but can also erode customer loyalty and brand equity.**  
 ”

the act of registering a trademark transcends the legal realm to become a testament to a business' aspirations, ethos, and unwavering dedication to excellence. Thus, the correlation between trademark registration and business success is not merely coincidental but a reflection of the profound impact that thoughtful brand protection and strategic foresight can have on ensuring a business's enduring relevance and success in the competitive market landscape.

**Contact**

**Gunn, Lee & Cave**  
 8023 Vantage Drive, Suite 1500,  
 San Antonio, Texas 78230  
**Tel:** + 1 210 886 9500  
**Fax:** +1 210 886 9883  
<https://www.gunn-lee.com/>

# The role of trademark strategy in business profit and brand success

Jing XIE and Jane LI of China PAT Intellectual Property Office strike a balance between the practicalities of trademark registration and the art of brand storytelling in China for overall business success.

The primary goal of business operations is to achieve profitability, ensuring that the goods or services offered attract a growing number of consumers. Representing brand identity, trademarks are not just legal markers, they can be the silent salespeople speaking volumes about a brand's origin and quality, "here is something worth your attention," guiding consumers as they make buying decisions.

Hence, mapping out trademark strategies is akin to charting the course of a business' survival. Trademark strategy seeks to secure legal acknowledgment and shield the symbiotic bond between

“ Mapping out trademark strategies is akin to charting the course of a business' survival. ”

the trademark and the business, ultimately ensuring the company's bottom line. This article aims to strike a balance between the practicalities of trademark registration and the art of brand storytelling in China, finding the sweet spot where your trademark not only meets legal standards but also the expectations of your target audience. In essence, we are looking at how to make your trademark a key player in your brand's narrative, making sure it is not just seen but remembered.

### Trademark acquisition: the foundation of competitive advantage

Under the Trademark Law of China, protection is primarily extended to registered trademarks, with the unregistered only receiving protection under certain statutory conditions. Thus, achieving trademark registration represents the fundamental step and core of trademark strategy in China. Registration is the bedrock upon which businesses can sustain profitability. It also acts as a strategic asset enabling companies to build brand reputation, attractiveness, and consumer loyalty, thereby securing a competitive edge and winning in



## Unlock the Power of Your Intellectual Property in China!

Experience the excellence of intellectual property support at China PAT. We offer a full range of services, including patents, trademarks, copyrights, and beyond, covering every aspect from filing and prosecution to litigation. With an exceptional success rate of over 80% in disputes, we are equipped to craft, secure, and defend your innovations.

**500+**  
Elite Professionals

**270+**  
Patent Attorneys

**10,000+**  
Patent Applications per Year

**15,000+**  
PCT Filings in total

**80%+**  
Success in Contentious Matters



## Résumés

**Jing XIE** is a lawyer at China PAT Intellectual Property Office with over 10 years of experience in intellectual property law. Holding a Master's degree in Law, she specializes in trademark prosecution and litigation, and is deeply engaged in the practice. She has handled thousands of trademark cases for renowned global corporations. Her broad practice includes trademark application, prosecution, infringement, copyright issues, domain name complaints, administrative complaints, customs complaints, and unfair competition. With extensive experience in both trademark enforcement and strategy development, Jing excels in crafting comprehensive protection solutions and litigation strategies.

**Jane LI** is a partner of China PAT Intellectual Property Office, leading the Trademark Department. Jane has more than 15 years of experience in intellectual property law practice, with almost nine years of practice as an IP lawyer & attorney and six years working as in-house counsel managing all the trademark matters for one of the largest internet companies in China. She possesses a strong understanding of corporate trademark management practices and requirements, offering customized, focused, in-house friendly, and practical advice. She has rich experience in assisting domestic and overseas clients with their IP matters in China and many other jurisdictions.



Jing XIE



Jane LI

that the business might grow into. This foresight is particularly beneficial for companies whose revenue heavily relies on intellectual property, such as those in the entertainment or digital content sectors.

Take the case of an internet technology company we consulted for, specializing in movie ticketing services and reviews. Initially, their trademark registrations were confined to service-oriented categories, notably class 41 for entertainment, without considering goods. Over time, it realized significant market success as the company diversified into merchandising with movie character-themed products, like pillows, phone cases, and dolls. Consequently, the company shifted its operational focus toward merchandising movie characters, necessitating trademark registrations across multiple goods categories for these licensed characters. Given the high volume of trademark applications in China, applying at this later stage meant facing considerably more challenges than at the initial phase of service category trademark applications, resulting in more money, time, and human resources being invested.

The lesson here is clear: products that seem unrelated at the outset can unexpectedly turn into major sources of revenue down the line. While predicting every future business move may not always be possible, adopting a broader perspective in initial trademark strategy can facilitate smoother future transitions and reduce the need for costly, complex registrations later.

### 2) Prioritizing service applications

In today's market, app products are abundant, each with its specific functionalities, such as streaming film and television offerings, ride-hailing and food delivery, etc. The types of commodities or solutions these applications present are integral to their identity. Nonetheless, numerous apps extend beyond their primary scope, advertising and recommending products or solutions for third-party entities. Given their software nature, the services they provide are closely related to software services, communication services, and the like. This means App products are inherently closely related to service classes such as 35 (advertisement and business), 38 (telecommunication), and 42 (science and technology).

We do not support the viewpoint that disregards an app's specific functionalities and straightforwardly categorizes its trademark as being commercially utilized under classes 35, 38, and 42. The *"Beijing High People's Court Guidelines for the Trial of Internet Intellectual Property Cases,"* Article 28, suggests a more tailored approach. It states, "Determining whether the goods or services provided through application software via information networks constitute the same or similar goods or services as those for which

another's trademark is registered shall be made comprehensively based on the specific purpose, content, method, and target audience of the services provided by the application software. It should not be presumed that they constitute similar goods or services to computer software goods or internet services." In instances where trademark holders in classes 9 and 35 bring infringement actions against app providers, we maintain that decisions regarding in which category or categories an app's name and associated trademarks are commercially active should be informed by the app's designated purpose, content, functionalities, and audience.

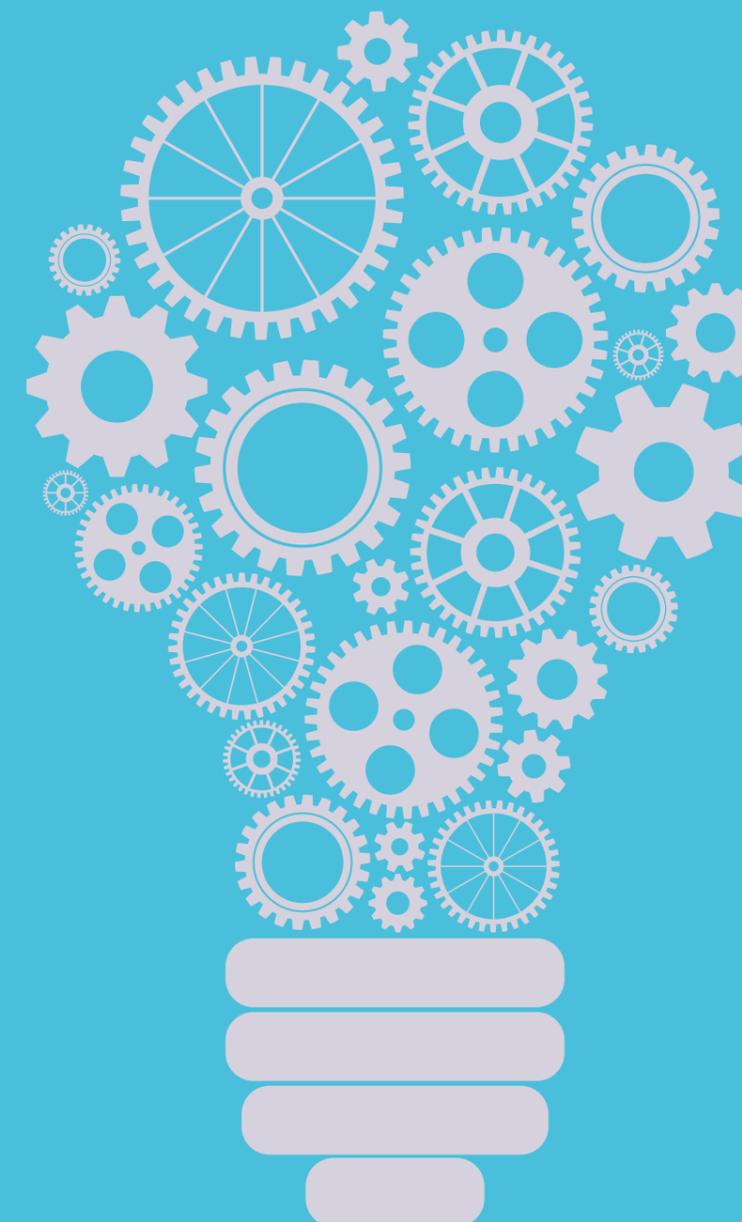
Despite this nuanced perspective, disputes over which trademark class an app belongs to can get tricky. For example, an entertainment app primarily fits class 41 for providing "entertainment information." But does it cross over into class 35 territory when it starts to feature ads? If an app provider has registered only in class 41 and faces a lawsuit from another party with the same trademark in class 35, does that constitute infringement? Judicial opinions on such matters are yet to converge, indicating that debates will likely persist for some time.

Although not necessarily deemed as infringement, such disputes or litigation can lead to significant investment of resources for app providers, particularly for internet companies facing financing or IPO opportunities, potentially having severe adverse effects on business development. Therefore, when planning trademark strategies, foresight is key. Businesses should anticipate potential trademark disputes and pay attention to applying for classes 35, 38, and 42, especially internet companies, to prioritize registering relevant trademarks in these categories. After all, in the high-stakes game of trademarks, it is better to be a chess master, thinking several moves ahead, than a checker player, reacting to each jump.

### 3) Securing brand signposts

The value of a trademark comes from its ability to direct consumer attention to a specific brand, which drives engagement and sales. Beyond the traditional scope of product branding, the digital age introduces fresh elements that serve as direct pointers to specific companies. These include app interfaces, domain names, and WeChat public account names, all carrying an inherent ability to guide consumers precisely to their intended business destinations.

Understanding the significance of these directional tools, it is crucial for businesses to actively seek legal protection for them. This step is essential in maintaining the connection between the brand and its digital identifiers, ensuring that consumers can reliably reach the business



market contests. Drawing from real-world client engagements, we wish to offer recommendations on strategic trademark acquisition and planning for businesses from the following three perspectives.

### 1) Forecasting your blueprint

Chinese official regulations mandate that trademark registration applications must clearly define the specific goods or services involved, categorizing them into 45 distinct classes. Many businesses, focusing on their immediate need to protect the main offerings, opt for particular categories for their trademark applications. However, beyond the present, it is advisable to reserve the room for potential business expansion by stockpiling trademark resources in categories

“  
When  
planning  
trademark  
strategies,  
foresight  
is key.  
”

“  
A strong  
trademark  
can further  
assist in  
profit  
generation.  
”

they're searching for. Without this protection, there's a risk that these valuable assets could be used by others, leading to confusion among consumers and potentially diluting the brand's presence in the market.

By protecting these key elements, businesses can and will safeguard their unique identity and interests. This is not just about avoiding legal disputes; it is about ensuring that your brand stands out in a crowded digital marketplace, now and in the future.

### Beyond acquisition: crafting a unique trademark identity

When crafting a trademark strategy, businesses need to weigh securing legal rights and ensuring the brand's visibility. This calls for a 'strong



trademark' strategy which focuses on enhancing the uniqueness of your mark to avoid blending in or causing confusion with others.

Trademarks are categorized based on their connection to the goods or services they represent: fanciful, arbitrary, suggestive, and descriptive. Descriptive trademarks, which directly describe a product or service, typically face registration challenges due to their lack of distinctiveness. Suggestive trademarks, offering a hint without directly describing the product or service, may be registrable but often tread close to being too descriptive, risking rejection. Arbitrary trademarks, which use common words in an unrelated context (think 'Apple' for tech products), bring a high level of originality. In practice, however, we have frequently encountered cases where such arbitrary trademarks were rejected. Often, this is because examiners believe that the trademark's inherent 'literal meaning' prevents it from being recognized as a distinct trademark. Conversely, fanciful trademarks, which are entirely invented with no previous meaning, usually enjoy a smoother registration process and are less likely to be confused with existing marks.

From a long-term business perspective, adopting a 'strong trademark' strategy with fanciful trademarks can increase differentiation from others, especially competitors' trademarks, thus reducing the risk of market confusion. Imagine that, if a trademark is a pre-existing word with a specific literal meaning, registering it may not prevent others from using the literal meaning of the word to describe their goods or services in certain specific circumstances. The line between 'illegal use' and 'proper use' is not always clear-cut.

The 'strong trademark' strategy not only focuses on the possibility of trademark registration but also emphasizes the trademark's 'uniqueness' in the market. A strong trademark can further assist in profit generation, commanding premium branding, and more. It requires continuous accumulation of goodwill, the establishment of a positive brand image, enhancement of trademark recognition, and reinforcement of the unique correspondence between the trademark and the enterprise through long-term use and management, helping the enterprise stand firm and succeed in competition.

**Trademark enforcement: detecting infringement is key**

While achieving trademark rights sets the cornerstone and inception of a brand's strategic map, it's also imperative for companies to harness legal avenues to enforce these rights, fending off adverse impacts from third-party actions. The essence of trademark enforcement lies in the adept identification of infringement. As the digital landscape and AI technology advance,

“ Trademarks go beyond being legal identifiers; they are the very essence of a brand's commercial life force. ”

the channels for promoting and selling products or services have multiplied, broadening the scope for infringers to operate under the radar, and making their actions more intricate and harder to trace, intensifying the potential harm to trademark owners.

The internet has become a fertile ground for such infringements in recent years, not limited to the sale of counterfeit goods on digital platforms but also including the cunning use of trademarks as keywords or tags to misdirect consumers originally searching for the trademark owner to the infringer's offerings. This kind of stealthy infringement extends to using someone else's trademark as a name for WeChat public accounts, apps, or even company registrations, showcasing the diverse methods of misuse. Therefore, uncovering these acts of infringement is pivotal for businesses in safeguarding their trademarks.

Companies should focus on regular, comprehensive monitoring to quickly identify any infringing activities and assertively employ legal tools, such as issuing cease and desist letters, filing platform complaints, and initiating legal actions, all aimed at preserving the unique identity of their trademarks and their brand's reputation.

Reflecting on our discussion, we can appreciate that trademarks go beyond being legal identifiers; they are the very essence of a brand's commercial life force. A well-thought-out trademark strategy that captures and keeps consumer interest can turn trademarks into vital assets for competitive advantage. Such a strategic approach can cement a more resilient market presence and consistent profit flow, steering businesses towards a path of brand growth and dominance. For companies aiming for durability and prominence, how can they afford to sideline trademark strategy?

**Contact**

**China PAT Intellectual Property Office**  
 Unit 503, 5/F, Daheng Scitech Building,  
 South Tower, No. 3 Suzhou Street,  
 Haidian District, Beijing, 100080,  
 P. R. China  
**Tel:** +86 10 5979 7750  
 intl@china-pat.com  
 http://en.china-pat.com/



**CARIBBEAN TRADEMARK SERVICES**  
 LAW OFFICE OF GEORGE C. J. MOORE, P.A.

**OVER 40 YEARS OF ONE-STOP TRADEMARK SERVICES, IN THE CARIBBEAN**

- |                        |                          |
|------------------------|--------------------------|
| Anguilla               | Grenada                  |
| Antigua & Barbuda      | Guyana                   |
| Aruba                  | Jamaica                  |
| Bahamas                | Haiti                    |
| Barbados               | Montserrat               |
| Belize                 | Puerto Rico              |
| Bermuda                | St Kitts & Nevis         |
| British Virgin Islands | St Lucia                 |
| Caribbean Netherlands  | St. Maarten              |
| Cayman Islands         | St. Vincent              |
| Costa Rica             | Suriname                 |
| Cuba                   | Trinidad & Tobago        |
| Curacao                | Turks and Caicos Islands |
| Dominica               | U.S. Virgin Islands      |
| Dominican Republic     |                          |

**WWW.CARIBBEANTRADEMARKS.COM**

**TELEPHONE:**  
 USA 1(561) 833-9000

**FACSIMILE:**  
 USA 1(561) 833-9990

**EMAIL:**  
 IP@caribbeantrademarks.com

**ADDRESS:**  
 2855 PGA Boulevard  
 Palm Beach Gardens, Florida 33410





# Kicking around the post-sale confusion doctrine in English and US courts

**Leigh Smith and H. Straat Tenney of Locke Lord provide a comparative analysis of the handling of pre- and post-sale confusion of trademarked goods by jurisdiction to draw interesting conclusions for corporations to consider when developing their branding.**

"Post-sale confusion", namely the extent to which the post-sale context of the use of a sign can and should be taken into consideration when assessing issues such as the likelihood of confusion, has been the subject of a recent case before the Court of Appeal of England and Wales. Post-sale confusion is not a new concept in English law, but the decision in *Iconix Luxembourg Holdings Sarl v. Dream Pairs Europe Inc & Anor* [2024] EWCA Civ 29 arguably goes further than previous cases in emphasizing the relevance of the consumer's perspective of the sign. The decision presents an opportunity to consider the approach taken by the English courts towards a post-sale context in trademark infringement cases, as well as to compare the approach to that taken in the United States of America.

## Post-sale confusion in the United Kingdom

Cases such as *Arsenal Football Club* [2002] EUECJ C-206/01 (12 November 2002) confirmed that a likelihood of confusion could occur after the sale of the goods to which the alleged infringing sign is affixed. In that case, unofficial merchandise for the football club Arsenal FC was being sold from a stall with a notice stating that the products were not official. The Court of Justice of the European Communities found that consumers encountering the goods after they had been sold may interpret the sign as designating that the goods had in fact been sold by or on behalf of Arsenal FC.

Equally, in *Thomas Pink Limited v. Victoria's Secret UK Ltd* [2014] EWHC 2631 (Ch), which concerned the sale of clothing bearing the sign PINK, post-



Leigh Smith



H. Straat Tenney

sale context of use was also taken into account in assessing the likelihood of confusion. There the judge (Mr. Justice Birss, who subsequently became Lord Justice Birss and was one of the appeal court judges in *Iconix*), found that the inclusion of the sign PINK on garments was meant to be seen by persons other than the wearer and was not purely decorative. The use continued to act as a badge of origin.

In *Iconix*, the dispute concerned the sports brand UMBRO, and its diamond-shaped logo (as registered as a series of two devices as United Kingdom trademark no. 991668):



Image 1 - Iconix

Dream pairs sold football boots and other footwear by reference to the following sign:



Image 2 - Other Footwear

Sales were made exclusively through online marketplaces where other DREAM PAIRS branding featured. The advertisements for the products also contained images of the products, taken square on, which showed the mark affixed to the products. At first instance, *Iconix* argued unsuccessfully that when seen in the post-sale context the viewer would see the sign on the footwear by looking down from head height. This would have the effect of presenting the sign at an angle, rather than it being seen square on. This



distorted view would elongate the sign such that it more closely resembled the UMBRO diamond. Lord Justice Arnold, whose judgment was approved by Lord Justice King and Lord Justice Birss, found that the trial judge had erred in failing to take this into account. He found that there was "nothing artificial or unrealistic" about comparing the UMBRO device mark to the sign in this manner. He noted that the average consumer encountering the sign for the first time on the products would not necessarily know what the sign looked like when seen square on. He overturned the trial judge's finding that there was no likelihood of confusion between the UMBRO diamond and the sign on this basis.

The case is another example of confirmation that the English courts are willing to find that there is a likelihood of confusion post-sale whilst there is no likelihood of confusion at the point of sale. Another area in which we have seen a number of interesting cases in the United Kingdom recently is in respect of "look-a-like" products. This decision favors brand owners in that it is a reminder that signs will be examined in their real-world context, taking into account changes in perspective and appearance that may result from their actual use. Additional materials, or an artificial perspective, presented at the point of sale will not prevent enforcement if the real-world use of the sign is in fact different.

It should also be noted that the English Courts have also considered post-sale confusion in respect of a different class of average consumer than the average consumer likely to make the

the general public) from the class of consumers whose perception was relevant to assessing the likelihood of confusion. In contrast, *Arsenal*, *Thomas Pink*, and *Iconix* are all concerned with the impact of the post-sale context with respect to the same class of average consumers.

## Résumés

### Leigh Smith, London Partner

Leigh has considerable experience in advising on all aspects of contentious and non-contentious intellectual property matters, with a particular focus on the protection and exploitation of brands. Leigh advises clients on brand protection strategies, including the clearance, registration, and enforcement of trademarks. Leigh has experience conducting disputes before the UKIPO (and EUIPO) as well as before the English High Court. He also advises on the licensing of brands, endorsement and sponsorship agreements, and on UK advertising law.

### H. Straat Tenney, New York Partner

Straat counsels clients on an array of intellectual property matters, including US and international trademark portfolio management, trademark clearance and enforcement, and anti-counterfeiting actions. Straat's domestic and international clients range from major manufacturing companies to startups in such industries as food, cosmetics, and luxury brands. He has also represented US and international clients before the federal district courts and the Trademark Trial and Appeal Board.

### Post-sale confusion in the United States of America

In addition to initial interest confusion and point-of-sale confusion, US trademark law has long recognized post-sale confusion. In most infringement cases, a plaintiff must demonstrate that direct purchasers are likely to be confused. Sometimes this is not possible, like in the Arsenal Football Club case, discussed above, where the purchasers understood that the product is not affiliated with the senior user. This is a “classic” example of post-sale confusion; the purchaser knows the offending products are spurious, but observers who see those products in the marketplace may be confused, thus damaging the trademark owner. See, e.g., *Yellowfin Yachts, Inc. v. Barker Boatworks, LLC*, 898 F.3d 1279, 1295, n.14 (11th Cir. 2018) (citing 4 J. Thomas McCarthy, McCarthy on Trademarks and Unfair Competition § 23:7 (5th ed.)). In these cases, in addition to proving the notoriety of its brand, a plaintiff must prove that the junior product is of inferior quality, compared to the senior product.

Proof that a product is inferior, however, is not always required. For example, US courts have held that post-sale confusion damages the exclusivity of the senior product. The Ninth Circuit decision in *adidas Am., Inc. v. Skechers USA, Inc.*, 890 F.3d 747 (9th Cir. 2018) is instructive. adidas sought to enjoin the sale of Skechers footwear that mimicked the Stan Smith and Cross Court brands. adidas showed it carefully limited the supply of Stan Smith footwear, and the court found that the sale of Skechers competing shoes harmed the value adidas derived from the scarcity and exclusivity of the Stan Smith brand. *Id.* at 761. In contrast, adidas could not establish that its Cross Court brand was similarly exclusive. The Ninth Circuit refused to extend the preliminary injunction to the product that tracked the Cross Court brand.

Proving post-sale confusion infringement is arguably easier when compared to point-of-sale confusion. In normal cases, the analysis focuses on purchasers and potential purchasers. Under post-sale confusion, the universe of those possibly confused expands to the entire public, so more people can be confused, and factors that may otherwise weigh against confusion are often inappropriate. Labeling is irrelevant in the post-sale confusion analysis because hangtags that were once affixed to the products are all discarded. Similarly, point-of-sale displays have no bearing because mere observers are unlikely to have seen the relevant sales environment. Differences in geographic distribution, market position, audience appeal, the sophistication of consumers, and price point have “little or no bearing” on the likelihood of post-sale confusion. See e.g., *Coty Inc. v. Excell*

“Labeling is irrelevant in the post-sale confusion analysis because hangtags that were once affixed to the products are all discarded.”

*Brands, LLC*, 277 F. Supp. 3d 425, 448 (S.D.N.Y. 2017).

Perhaps recognizing that the analysis can be too narrow, courts are sometimes hesitant to recognize post-sale confusion without concrete evidence showing observers are likely to be confused or that the senior users will be harmed. See, e.g., *Yellowfin Yachts, 898 F.3d at 1295, n.14*; *adidas Am., Inc.*, 890 F.3d at 1295, n.14. Merely asserting that post-sale confusion may conceivably exist is insufficient.

#### Conclusion

The doctrine of post-sale confusion recognizes that a trademark has an ongoing and valuable role to play as a badge of origin even after the initial purchase of the goods or services in question. Whether that serves as an inducement for further purchases amongst the same class of consumers or influences the decision-making in respect of a subsequent transaction, this ongoing role should be protected. As the *Iconix* case demonstrates, it is also a valuable tool for brand owners, particularly in cases of “copycat” products where the offending party can take additional steps to mitigate the risk of point-of-sale confusion.

The above comparison suggests there are many similarities in the approach by the US and English courts, notably that they both accept that the relevant consumer may be different for post-sale confusion than point-of-sale confusion. However, it also suggests that in the US additional factors, such as damage to value or concrete evidence of confusion and/or harm, are factored into the analysis of whether post-sale confusion has occurred. As the English courts seem to be showing a willingness to expand post-sale confusion, it will be interesting to see whether any of these factors start to be given more weight by the English courts when assessing the likelihood of post-sale confusion as well.

### Contact

#### Locke Lord London

201 Bishopsgate, Second Floor,  
London EC2M 3AB

**Tel:** +44 20 7861 9000

#### New York

Brookfield Place, 200 Vesey Street,  
20th Floor, New York, NY 10281-2101

**Tel:** +1 212 415 8600

[www.lockelord.com](http://www.lockelord.com)



COLMENARES  
& ASOCIADOS

120<sup>th</sup> Anniversary

A Century Plus Two  
Inspiring Minds, Preserving Ideas

Exclusivity in IP prosecution and litigation since 1904



# Classification of app products in trademark infringement cases

**Tianyuan Zhang, Trademark Attorney at Beijing Sanyou Intellectual Property Agency Ltd., examines recent infringement cases to determine best practices for registering and protecting app products in the Chinese market.**

**W**ith the rapid development of digital technology, the digital and physical economies are becoming deeply integrated, and the platform economy is increasingly permeating all aspects of daily life, including clothing, food, housing, and transportation, among others. Riding the wave of the platform economy, traditional entity enterprises have gone through a transformation and are upgrading to gradually march into the digital era led by smart marketing and manufacturing. According to data from the China Academy of Information and Communications Technology (CAICT), China online retail sales accounted for 20.7% of the total retail sales of consumer goods in 2019 and this proportion rapidly reached 24.9% in 2019 and 27.2% in 2022. According to the statistics of the Chinese app technology testing platform, as of June 2023, the number of active apps detected in the Chinese domestic market is 2.6 million and the number of mobile app developers is 830,000, including 250,000 Android developers and 580,000 Apple developers. In June, 69.6 billion apps were downloaded from the Android App Store. In China, B2C and O2O have surpassed C2C to become the mainstream commercial modes.

According to Articles 8 & 9 of the Trademark Law of the PRC, an app icon, as long as it does not violate the mandatory provisions of the trademark law and is of distinctive characteristics, can be registered as a trademark in China, and the app owner can obtain the exclusive right to use this mark.

(1) *Article 8: any sign that distinguishes the goods of a natural person, legal person,*



Tianyuan Zhang

*or other organizations from those of others, including any word, device, letter, number, three-dimensional sign, color combination, sound and combination thereof, may be registered as a trademark.*

(2) *Article 9: The trademark applied for registration shall have distinctive characteristics for identification, and shall not conflict with the prior legitimate rights of others.*

In practice, an app owner may use a mark already registered as an app icon, or register an app icon as a trademark to protect its legitimate rights and interests in the app product. However, the classification of app products is vague, based on the existing China Trademark Classification of Goods and Services, which creates obstacles in subsequent trademark infringement cases.

Currently, the apps we have access to can be broadly divided into two categories, namely, apps only of computer software attributes and apps combining software and other service attributes. Typical apps only of computer software attributes include anti-virus apps, calendars, etc. Apps combining software and other service attributes commonly seen include medical beauty apps, takeaway apps, etc.

For an app only of computer software attributes, the owner usually registers the app icon in classes 9 (computer software and hardware), 38 (communication media), and 42 (computer programming and related services). If the app mainly profits from advertisement push, it is also necessary

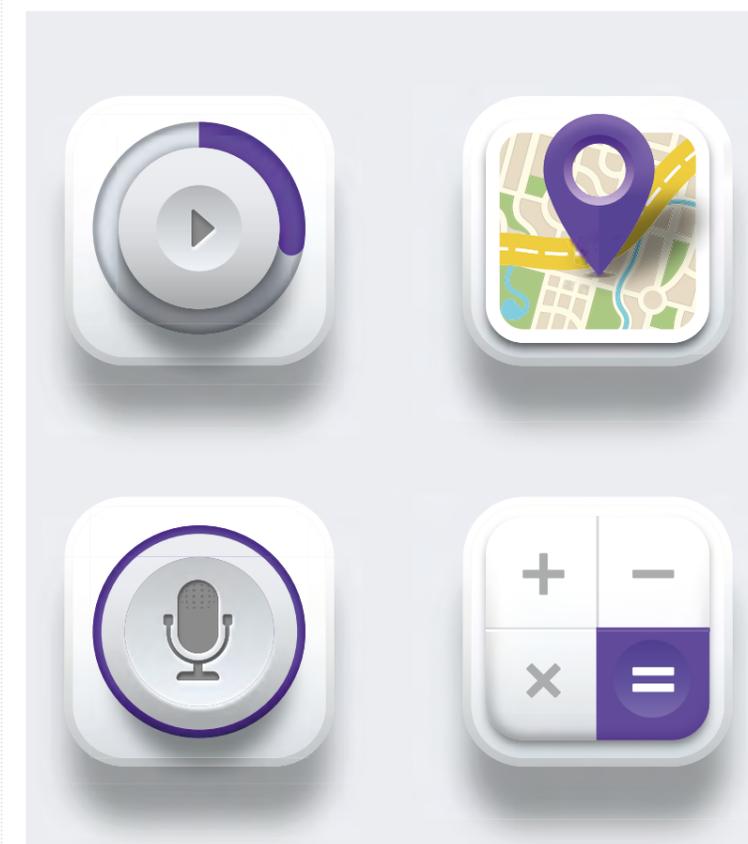
to register the app icon in class 35 (advertising service). Data shown by the World Intellectual Property Indicators 2023 roughly reflects this trend. According to the distribution of non-resident trademark applications by top nice classes 2022, applications in class 9 designating goods such as scientific, photographic, measuring instruments, computers, and software, etc. accounted for 12% to rank the first, applications in class 35 accounted for 7.9% to rank the second and applications in class 42 ranked third with 6.9%. While for an app combining software and other service attributes, classes in which the owner chooses to register its app icon will be determined by its specific function, use, and the terminal goods or services provided. For instance, the famous Chinese food delivery app "美团外卖" (in English: Meituan Takeout) and famous American food delivery app "DoorDash" will not only need to register its app icon in classes 9, 38, 42, and 35, but also in class 39 (transport service), class 42 (catering service), etc.

In trademark infringement cases, the classification of app products is quite controversial and there exist two dominant views: one view is an app is used on the terminal goods or services provided to the customers, rather than on goods in class 9. For example, in 2017, Jiren (Shanghai) Intelligent Technology Co., Ltd. (hereinafter referred to as Jiren) accused Beijing Baikeluoke Technology Co., Ltd. (hereinafter referred to as ofo, the owner of a bicycle-rental app named "ofo 小黄车") of infringing its exclusive right for trademark "小黄车" (in English: little yellow bike) in classes 9 and 38 through using the app "ofo 小黄车". The court held that Jiren's marks are used on goods "downloadable computer application software, etc." which are independently used as products to process, store, and manage data and with people having demands for information processing as targeted customers. While the purpose of ofo's use of the "ofo 小黄车" app is to indicate the source of its services. The app alone cannot function or be sold, which is only a technical means or medium to provide bicycle rental services. Therefore, ofo's use of the app "ofo 小黄车" should not be categorized as use on goods in class 9 therefore ofo did not infringe Jiren's trademark rights.

The other view is an app is simultaneously used on goods in class 9 and the terminal goods or services provided to the customers. For example, in 2020, Shanghai Lianshang Network Technology Co., Ltd. (hereinafter referred to as Lianshang) accused Xiamen Zhonglian Century Co., Ltd. (hereinafter referred to as Zhonglian) of infringing its exclusive right for trademark "万能钥匙" (in English: master key) in classes 9, 35, 38, and 41 through using an app named "WiFi钥匙" (in English: WiFi key). Upon investigation, the court found

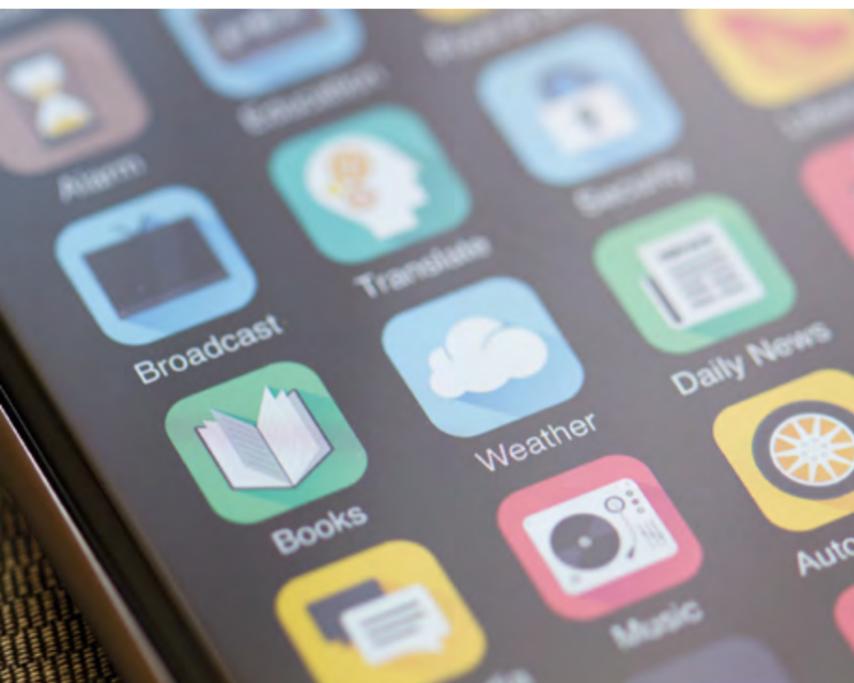


**Currently, the apps we have access to can be broadly divided into two categories, namely, apps only of computer software attributes and apps combining software and other service attributes.**



## Résumé

**Tianyuan (Tanya) ZHANG** is a trademark attorney at Beijing Sanyou Intellectual Property Agency Ltd. She obtained her Master's Degree from Tianjin University of Technology in the Department of English Translation, which showcases her constant scholarly pursuits and perseverance. She has handled hundreds of trademark cases in various procedures including registrations, oppositions, invalidations, cancellations, etc., and participated in multiple tricky cases. She has rich insights to not only represent Chinese clients to manage trademark cases in other countries/regions but also take care of foreign clients' cases in China.



Zhonglian's app "WiFi钥匙" not only provides users with secure and free internet access services, and secure WiFi hotspot passwords, but also provides entertainment information and advertising services. The court ruled that the aforesaid use should be categorized into use on goods or services in classes 9, 41, and 35. Therefore, Zhonglian infringed Jiren's trademark rights. It can be seen that, if the disputed app products provide services on which the plaintiff has trademark rights, the court tends to categorize its use also under these services.

While determining whether a disputed app product is an infringement of rights, the court will also take the fame of the app within the industry and the owner's subjective malice into consideration. If the disputed app has obtained great fame and influence through extensive use and developed a corresponding relationship with its owner, while the plaintiff's prior marks in class 9 were not well-known within the industry before the launch of the disputed app, it is hard to prove the defendant's malice and further to consider it an infringement of the plaintiff's trademark rights. Given that the classification of app products is still controversial, the app owner, if it could provide massive use evidence and the evidence can form complete evidence chains to prove the fame enjoyed by its marks, will have a higher chance to defend its rights.

Although app products are not certainly classified into classes 9, 35, 39, 42, etc., it remains advisable to register app icons in the aforesaid classes for defensive purposes. For an entity engaging in the Internet industry wishing to prevent others

“**Besides core goods and services, it remains advisable to register app icons as software-related goods and services in classes 9, 35, 38, 42, etc. for the defensive purpose of preventing rush registrations.**”

from registering, even if it does not have its own app products for the time being, it is recommended to apply for trademark registrations on software-related products and services. After obtaining registrations, the owner needs to actively use the marks and preserve relevant use evidence. The classification of app products in administrative cases is different from infringement cases. In administrative cases, the CNIPA will pay more attention to the evidence to determine whether the mark is used on the app or the terminal goods or services. For instance, the famous Chinese financial service app "蚂蚁金服" (in English: Ant Financial, affiliated with Alibaba Group) once received a cancellation application from third parties for registration of goods in class 9 (computer software) based on non-use for three consecutive years. The terminal services of Ant Financial actually belong to class 36 (financial services), if the app owner had not provided massive use evidence to prove its mark is widely used as the name of its app, its mark registered in class 9 is very likely to be canceled.

In conclusion, besides core goods and services, it remains advisable to register app icons as software-related goods and services in classes 9, 35, 38, 42, etc. for the defensive purpose of preventing rush registrations. After obtaining registrations, the owner needs to actively use the marks and preserve relevant use evidence in case a third party files cancellation actions against the owner's use. To remedy the limitations of trademark protection, the app owner can also apply for a copyright registration for its app icon to protect it under Copyright Law. Facing the boom of multi-scenario applications and smart economy platforms, and to solve the classification problem of app products, the China National Intellectual Property Administration is now making great efforts to refine the existing China Trademark Classification of Goods and Services and to update descriptions of acceptable goods and services beyond it. It can be expected the classification and protection problem of app products will be addressed in the earlier stage of China's trademark system.

### Contact

**Beijing Sanyou Intellectual Property Agency Ltd.**

16th Fl. Block A, Corporate Square,  
No.35 Jinrong Street, Beijing, 100033,  
P.R.China

**Tel:** +86 10 8809 1921 | + 86 10 8809 1922

**Fax:** +86 10 8809 1920

sanyou@sanyouip.com

www.sanyouip.com



# SANYOU IP GROUP

BUILD IP PROTECTION WORLDWIDE

WWW.SANYOUIP.COM

ESTABLISHED IN 1986

Established in 1986, Sanyou IP Group started as Beijing Sanyou Patent Agency founded by the former President Ms. Qiang Li. Sanyou is one of the first private patent agency approved by CNIPA.

As a pioneer dedicating to intellectual property for more than 37 years, Sanyou is committed to pursue excellence and continues safeguarding IP rights for domestic and overseas clients with professionalism and craftsmanship.

Sanyou is one of the first batch of firms awarded by the Chinese Patent Office the title of Outstanding Patent Agency, a vice president member of ACPAA, a standing committee member of CTA, and a vice president member of CIPS, etc.

After more than 37 years' development, Sanyou has become a comprehensive IP group providing all-round IP services for domestic and international clients from rights procurement to enforcement.

Sanyou IP is always striving to improve services in the hope to share a win-win future with our clients.

# SANYOU

## Professional Staff Structure

More than  
**400**  
employees

Over  
**300**  
professionals

Over  
**180**  
patent attorneys  
and lawyers

A trademark  
team of  
**30**  
members

### OUR HEADQUARTER

16th Fl., Block A, Corporate Square, No.35 Jinrong Street,  
Beijing, 100033, P. R. China  
TEL: +86-10-88091921  
FAX: +86-10-88091920  
Email: sanyou@sanyouip.com  
Website: www.sanyouip.com



# The latest updates to geographical indications in the UK

**Cherry Shin, Senior Trademark Attorney at HGF, provides an overview of GIs and their variations under UK law to provide helpful comparative advice for the protection of jurisdictionally relevant IP.**

At the date of this article, the UK is home to over 100 Geographical Indications (GIs), of which almost one quarter (25 GIs) have been applied for since the Brexit transition date of 1 January 2021. Well-known examples of UK-originating GIs include: Scotch whisky, Cornish clotted cream, Cornish pasty, Stilton Blue Cheese, and Whitstable Oysters.

GIs are an important component of the UK's food and drink industry, which as a whole is the country's biggest manufacturing sector by turnover. The industry in total has been valued at over £100 billion for some years now, and this year is valued at £104.4 billion. In 2022, the agriculture industry alone contributed £13.9 billion (0.6% of GDP) to the UK economy. These figures show that



Cherry Shin

the food and drink industry is larger than the automotive and aerospace industries combined.<sup>1</sup>

However, the UK lags behind its EU neighbors when it comes to the number of domestically-originating GIs. For example, France has over 700 while Italy has over 800 protected GIs.

Aside from these figures, the UK and EU GI schemes have rapidly diverged, and this article explores this by looking at how the current UK and EU GI systems operate, and considers what new developments and measures have been put in place to promote the significance of GIs in the UK since its departure from the EU.

## What are GIs?

GIs are signs that can function as a guarantee of authenticity for particular qualities, reputation, or the method by which the associated products are made. They are often associated with a local region or tradition.

Products bearing the same GI can be offered by different businesses, provided the products comply with the requirements. This is in contrast to trademarks, which focus on protecting the brand and reputation of the products or services of one commercial undertaking and distinguishing those products or services from others.

## Background to GIs

Prior to 2021, when the UK was a member of the EU, the protection of GIs was officially governed by EU regulations, provisions, and trade agreements which were implemented from as early as 1992.

Following its departure, the UK introduced an independent GI scheme on 1 January 2021, which allowed for the protection of the same and other qualifying names in the UK. The Department for

Environment, Food and Rural Affairs (DEFRA) is the competent authority for managing the GI schemes in the UK (including Northern Ireland).

Protection of GIs in the UK is divided into four different product categories:

1. Food, agricultural products, beer, cider, and perry;
2. Wine;
3. Aromatised wine;
4. Spirit drinks.

As with the EU scheme, UK GI logos can represent the three designations of GI products:

- i. Protected designation of origin (PDO): protects ingredients and foods sourced from a specific region or origin.

An example is Gower Salt Marsh Lamb, a type of salt marsh lamb born, reared, and slaughtered on the Gower Peninsula;

- ii. Protected geographical indication (PGI): protects the name of an area or region that describes where agricultural products, foods, and wines may come from. Some elements or sourcing can take place outside of the defined geographical area.

For example, a Cornish Pasty must be made within the county of Cornwall, and must only contain minced or roughly diced beef, sliced or diced potato, swede, onion, and seasoning. It can, however, be baked outside of Cornwall;

- iii. Traditional speciality guaranteed (TSG): certifies that an agricultural product possesses certain characteristics and was produced according to a traditional method or recipe to distinguish them from other similar products. The method of production must have been consistent for several years.

For example, Traditional Bramley Apple Pie Filling is a recipe with specific ingredients to be used under a specific preparation method.

Each GI scheme has a set of rules for producers to follow before products can be marketed to the public. As part of these rules, specific logos must be added to the product (see Figure 1). The use of a UK GI logo is optional for wines and spirit drinks.

Proprietors of GIs protected in the EU on 31 December 2020 were automatically granted an equivalent independent UK right. However, holders of applications for GIs in the EU that were still pending on 31 December 2020 had to apply for a separate UK right before 30 September 2021 to benefit from the original EU application date.

GIs are signs that can function as a guarantee of authenticity for particular qualities, reputation, or the method by which the associated products are made.



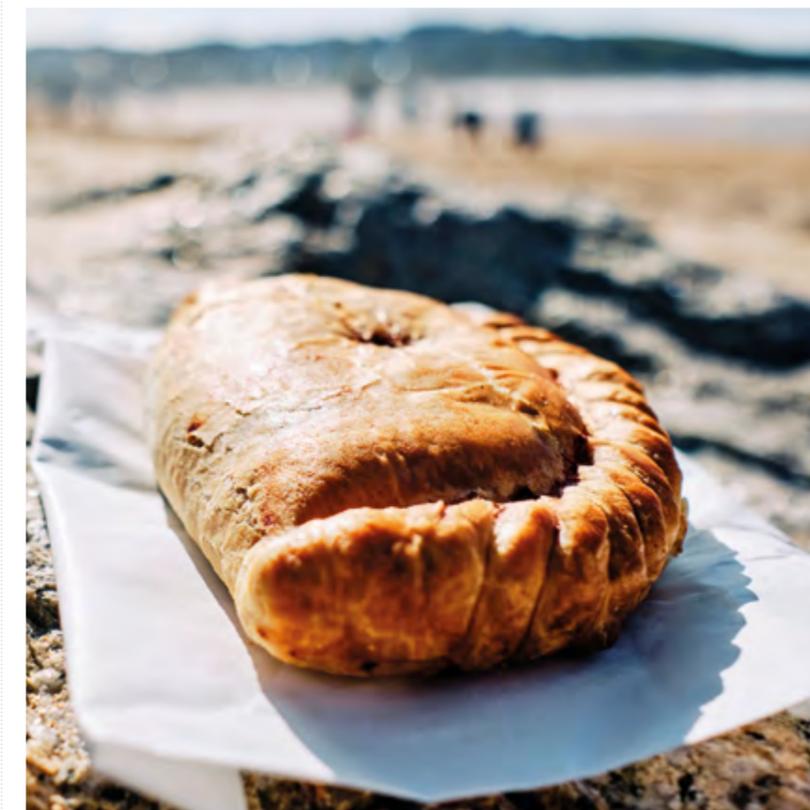
Figure 1

## Recent EU updates to its GI scheme

Whilst the UK GI scheme largely reflected that of the EU in the beginning, both the UK and EU have taken different paths in the past two years, meaning that both systems now feature stark differences.

Before identifying the differences, notable updates to the EU schemes include:

1. On 27 October 2023, the European Commission published the regulation on Geographical Indication Protection for Craft and Industrial Products (CIGIR). This extends the protection of GIs to craft and industrial products, also known as non-agricultural geographical indications (NAGIs). Examples of NAGIs include handcraft and artisanal products, similar to Murano glass or Donegal Tweed;





- On 31 March 2022 (to be implemented from 2025) it was proposed there should be a single set of rules to protect GIs for food, wines, and spirits, as opposed to each being governed by separate legislation;
- The EUIPO's increased administrative role within the scheme, namely for maintaining and updating the GI register, whilst also managing a domain name information and alert system;
- The addition of wines to the list of products that can become subject to cancellation (alongside existing agricultural products and spirits).

**The current similarities and differences between the UK and the EU GI systems**

**UK position in relation to EU updates**

The UK has not introduced any legal changes to its scheme since 2021, however, its current position in relation to the above updates is as follows:

- Concerning NAGIs, the Department for Business, Energy and Industrial Strategy on 27 June 2022 released an explanatory memorandum clarifying its view that NAGIs are better protected by the trademark system in the UK, specifically via collective and certification marks – see paragraph below. This is a common way to provide protection, with similar systems operating in the US, Australia, and Canada.

A certification mark serves as a guarantee that the goods or services bearing the mark meet a certain defined standard or possess a particular characteristic, and a collective mark indicates that the goods or services bearing the mark originate from members of a single collective body, e.g., a trade association, rather than just one trader.

The Government has stated:

“The UK’s long-standing position is that a trade mark-oriented approach provides effective protection for NAGIs and there have been no widespread calls amongst stakeholders for change. Analysis of UK responses to an early EU consultation on NAGI proposals demonstrated very limited understanding among stakeholders on the benefits and disadvantages to business of GI protection. Additionally, there is no convincing evidence to suggest that there are deficiencies in the current system.

Introducing a UK sui generis NAGI system would require legislative change, though

“**The UK and EU have taken different paths in the past two years, meaning that both systems now feature stark differences.**”

<sup>2</sup> [https://assets.publishing.service.gov.uk/media/62c2c0ed3bf7f3003443098/EM\\_on\\_geographical\\_indication\\_protection\\_for\\_craft\\_and\\_industrial\\_products.pdf](https://assets.publishing.service.gov.uk/media/62c2c0ed3bf7f3003443098/EM_on_geographical_indication_protection_for_craft_and_industrial_products.pdf)  
<sup>3</sup> <https://committees.parliament.uk/publications/41359/documents/203350/default/>  
<sup>4</sup> IBID

current evidence shows very limited potential benefits. A 2019 European study identified only five British products which could potentially benefit from NAGI protection.\* Compared to many other countries assessed in the report, the UK has far fewer NAGIs.”

...  
 “The proposal foresees low numbers of potential candidates for NAGI registration through the new scheme, with an assumption of 30 NAGIs registered annually at an annual cost of EUR 860,000 for the EU as a whole. The cost to protect (and enforce) third country NAGIs in the EU is noted but not specified, as the numbers here are uncertain. Though it estimates that the number of national NAGIs registered in China and India alone is between 400-800.

Whilst HM Government will continue to track the EU proposals to understand possible impacts on the UK, there are no current plans to undertake an Impact Assessment for this instrument.”

\*The five to six products that could benefit from NAGI protection would be: Harris tweed, Savile Row apparel, Irish linen, North Staffordshire pottery, Sheffield steel, and Nottingham lace.<sup>3</sup>

Whilst the UK government appears to be dedicated to protecting the interests of UK businesses so they are not disadvantaged from their EU counterparts, it seems GIs will not protect NAGIs in the UK for now.

The biggest concern for the UK government therefore seems to be whether EU NAGI protection should apply to goods placed on the Northern Ireland market, and what impact this will have on the UK. The EU will need to seek permission from the UK for NAGIs to have effect in Northern Ireland. If the UK agrees:

“It would mean that NAGIs approved by the EU Intellectual Property Office would have legal protection in Northern Ireland under EU law applying via the Windsor Framework, and the Government would be under an obligation to ensure official market surveillance activity to ensure non-compliant products were removed from that market. Conversely, Northern Ireland producers of craft and industrial products linked to a specific region, for example those making Irish linen, would be able to apply for GI status for their goods under the scheme as if they were based within the EU (meaning that, unlike for relevant products made in Great Britain, they would not have to demonstrate prior protection under UK domestic law)”<sup>4</sup>;

- The UK GI system offers differing guidance for seeking protection in the four different categories (1) food, agricultural products, beer, cider, and perry, (2) wine, (3) aromatised wine, and (4) spirit drinks;
- DEFRA is responsible for GI registration and maintenance in the UK; and
- In the UK, it is possible to apply to object to or cancel wines, food products as well as spirits.

The similarities and differences are summarised on right.

**Trade agreements and negotiations**

The UK government has been actively engaged in negotiations with various countries and trading blocs to establish agreements that include provisions for the recognition and protection of UK GIs.

Examples include:

- UK-US**  
 The UK and US entered into an agreement with a separate scheme to GIs, protecting over 700 wine names in the UK as an American Viticultural Area (AVA), and two spirit names, Bourbon Whiskey and Tennessee Whiskey.
- UK-Canada**  
 The UK has negotiated an agreement that allows for the protection of UK GIs in Canada, including ‘transborder GIs’ that relate to the territory of both Northern Ireland and the Republic of Ireland. These include Irish whiskey, Irish cream, and Scotch whisky.
- UK-Japan**  
 Under the Comprehensive Economic Partnership Agreement (CEPA), the UK and Japan have agreed to finalize protection for almost 40 British food and drink products in Japan. This is viewed to increase to potentially over 70. There are also around 39 Japanese GIs pending registration in the UK.
- UK-EU**  
 A Trade and Cooperation Agreement was reached at the end of the Brexit transition period. It includes provisions for the mutual recognition and protection of GIs in both territories.
- UK-Switzerland**  
 The trade agreement between both countries was agreed in December 2020, and ensures protection of GIs for products like Scotch whisky, Stilton cheese, and Welsh lamb. There are

	UK	EU
<b>Applicant</b>	Any entity can apply to register a GI. Non-UK applicants are required to have a registered GI under the scheme which governs their home nation, prior to making an application to DEFRA for a UK right.	EU producers or producer groups can apply to register the name of a product. The application must be sent to national authorities and then forwarded to the European Commission, which will examine the request. Registration is open to third (non-EU) countries. For non-EU products to be registered, producers must send their applications directly, or via their national authorities, to the European Commission. GI applications for craft and industrial products originating from third countries must be made directly at the EUIPO. They must have registered protection in their country of origin.
<b>What does it protect?</b>	<ul style="list-style-type: none"> <li>- Food, agricultural products, beer, cider, and perry;</li> <li>- Wine;</li> <li>- Aromatised wine;</li> <li>- Spirit drinks.</li> </ul>	<ul style="list-style-type: none"> <li>- Craft and industrial products, (PGI only).</li> <li>- Agricultural products and foodstuffs, wine (either as a ‘PDO’ or a ‘PGI’), and spirit drinks (‘GI’ only).</li> </ul>
<b>Who manages it?</b>	DEFRA	The European Commission is in charge whilst the EUIPO has an administrative role for register maintenance. The EUIPO will, however, manage NAGIs.
<b>Cancellation?</b>	Registered food, wine, and spirit products can be canceled if: <ul style="list-style-type: none"> <li>- No producer is complying with its specification;</li> <li>- It has not been produced for seven years or more.</li> </ul>	Registered agricultural products, spirits, and wines can be canceled if: <ul style="list-style-type: none"> <li>- No producer is complying with its specification;</li> <li>- It has not been produced for seven years or more.</li> </ul>
<b>NAGIs protected?</b>	Under trademark system via collective and certification marks.	Under GI system.
<b>GI logos</b>		



45 UK GIs protected in Switzerland under this agreement.

#### 6. UK-South Korea

The trade agreement was signed in August 2019 and includes provisions for the protection of GIs in the UK and South Korea. The agreement allows for the protection of Scotch Whisky and Irish Whisky, and 64 Korean agricultural products, including Boseong Green Tea, Sunchang Traditional Gochujang, Icheon Rice, and Korean Red Ginseng.

#### 7. UK-Mexico

The Continuity Agreement was agreed upon in December 2020 and came into force on 1 June 2021. GIs were particularly referenced to in the UK-Mexico Spirits Agreement, which includes protection in Mexico of four UK spirit drink GIs, such as Irish Whiskey/Whisky, Scotch Whisky, Irish Poteen, and Irish Cream. Tequila is protected as a GI in the UK.

#### Conclusion

While the EU has focussed on refining its regulations to better protect GIs, the UK has promoted the importance of GIs by establishing new trade relationships outside the EU. Securing



**The UK has promoted the importance of GIs by establishing new trade relationships outside the EU.**



GI protection for British products abroad is vital in facilitating trade, whilst safeguarding the integrity of products associated with GIs. The protection not only benefits British businesses with better trading opportunities, a wider consumer market, and opportunities to sell at premium prices, but also protects non-British consumers by preventing the circulation of counterfeit goods in these markets, and vice versa.

GIs therefore are not only important for domestic purposes, but also can be an important tool to promote international relations.

#### Contact

##### HGF (London)

Central Court, 25 Southampton Buildings,  
London, WC2A 1AL, UK  
Tel: +44 207 776 5100  
Hgf-longon@hgf.com  
www.hgf.com

Global expertise from a European base / HGF



Austria France Germany Ireland Netherlands Switzerland United Kingdom

HGF offers a fully integrated IP solution, bringing together trade mark attorneys, patent attorneys and IP solicitors across 25 offices throughout Europe.



EUROPE'S LEADING PATENT LAW FIRMS | 2019 - 2023

hgf.com

in HGF Limited  
@HGF\_IP

IP TrendMonitor  
ANNUAL  
STUDY  
2023

# IP FRONTIERS

Navigating innovation in eight key industries



The latest IP Trend Monitor study gathers the opinions of IP specialists to identify far-reaching research and legal trends in eight critical industries.



Download the study at:  
iptrendmonitor.com

# ABOUT THIS EDITION

The 2023 edition of IP Trend Monitor, the annual survey established by the Dennemeyer Group in cooperation with CTC Legal Media to investigate current and emerging topics in Intellectual Property (IP), focuses on projections for eight industries that are pivotal for the global economy. All of these commercial endeavors are undergoing significant change thanks to disruptive technologies, new business models, and external commitments such as meeting the United Nations Sustainable Development Goals.

The report is based on 1,803 answers and opinions from the most active members of the IP Trend Monitor panel, which represents the full range of IP practitioners – lawyers, consultants, inventors, businesspeople, and scientists, working in all areas of the industry – large corporations, small and medium-sized enterprises (SMEs), law firms, IP service providers, and IP offices.

The main findings for each industry are described below, along with key data, reflecting on differences between respondent groups where appropriate.

By analyzing the expected trajectory of future industry, the IP Trend Monitor report serves as a companion piece to Dennemeyer's recent retrospective study **Technology in the 21st century: Innovation trends since 2000**.



## The future role of IP

The IP Trend Monitor report touches on patterns in just eight industries, but the findings support some broader conclusions. In particular, it is likely that AI tools based on machine- and deep learning will have a significant impact across the entire economy.

Additionally, the transition to net-zero carbon emissions will lead to fundamental changes in the automotive and energy industries, among others. Meanwhile, the pressures of aging populations in advanced economies, combined with new technologies and techniques, will transform healthcare.

Innovative products, services, and business models, as well as disruption from new entrants, will reshape previously stable markets. In all these aspects, IP rights will have a critical role to play in determining the direction of research and how deliverables reach consumers. The next few years promise to be very exciting for all involved in developing, commercializing, and protecting IP rights.

# AUTOMOTIVE INDUSTRY

## Batteries at full charge

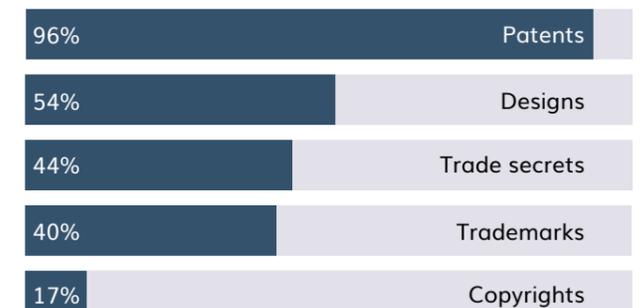
The automotive industry is being revolutionized with electric power, wireless communications, autonomous or semi-autonomous driving, and a wide variety of sensors and analytics. The IP Trend Monitor panel was asked to rank four emerging technologies according to their effect on the sector in the next five years on a scale of 1 (most impact) to 4 (least impact).

Advanced/solid-state batteries came out on top, with 85% of respondents ranking the energy storage solutions either 1 or 2. This reflects the significance of electric vehicles (EVs) and the need for further research into making batteries that last longer, are lighter, and can charge quickly.

It is perhaps surprising that 71% of all respondents ranked autonomous driving as either 1 or 2 (although this proportion fell to 56% among law firm respondents). There has been huge investment in this area by companies such as Waymo, Tesla, and Uber, with autonomous cars already on roads in the U.S. cities Phoenix and San Francisco. With patent applications in this field growing massively in recent years, as shown in Dennemeyer's *Technology in the 21st century*, it is likely that we will see the results of this extensive R&D within the next five years.

The rapid changeover from internal combustion engines to electric motors will inevitably have a knock-on effect on IP strategies in the industry, from the direction of inventive activity to patent portfolio development and licensing. More than half of respondents predicted increased patenting of battery technologies and more collaboration between automakers and technology companies, with slightly fewer (46%) expecting more focus on software and IP related to artificial intelligence (AI). However, 61% of trademark specialists said it will result in more software and AI-related IP, in what was the most popular answer among this specialism.

## Which IP protections will be essential for the automotive industry's future growth?



MULTIPLE CHOICE QUESTION



# BIOTECH INDUSTRY

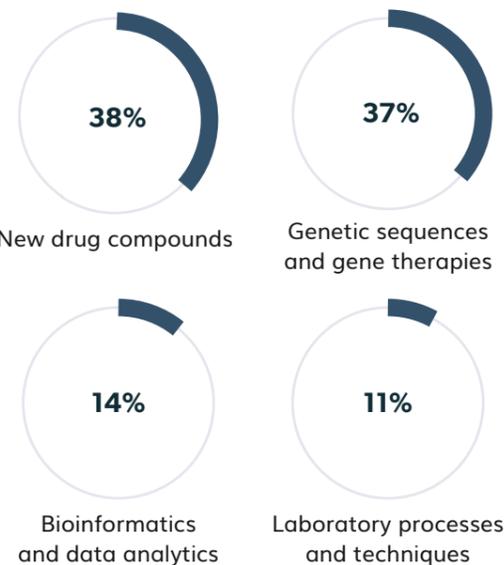
Growing innovation strategies

The biotechnology industry has burgeoned over the past three decades, and all evidence suggests that its reach will extend immensely thanks to research into areas such as genetic sequencing, gene editing, and precision (or personalized) medicine. Recent breakthroughs in the field have been awarded Nobel Prizes – for example, the 2023 Nobel Prize in Physiology or Medicine for the development of mRNA vaccines against COVID-19 and the 2020 Nobel Prize in Chemistry for the discovery of CRISPR/Cas9 genetic scissors.

When asked what the primary focus of IP protection in this sector should be, the most popular response from the IP Trend Monitor panel was "new drug compounds," followed by "genetic sequences and gene therapies." By contrast, just 14% said "bioinformatics and data analytics" (though this proportion dropped to 13% among trademark specialists and rose to 25% among corporate respondents), and around 1 in 10 said "laboratory processes and techniques."

At the same time, the panel recognized the potential for "open innovation and sharing of research findings" to redefine IP in the biotech industry. An overwhelming 80% either agreed or strongly agreed with the contention that a cooperative approach is essential for accelerating innovation, while just 16% agreed or strongly agreed that it is not a priority for biotech IP strategies.

**In the biotech industry,** what should be the primary focus of IP protection?



SINGLE CHOICE QUESTION

# ENERGY SECTOR

Electrifying change

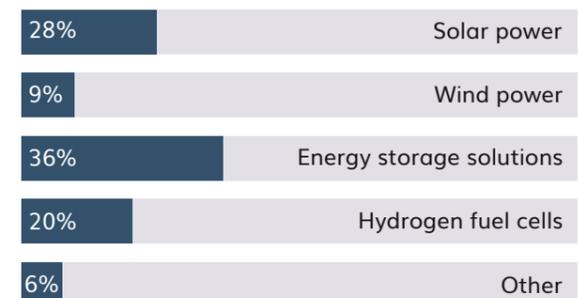
If there is one industry that will look very different in the future, it is energy production. Over the coming decades, the way we power most aspects of our lives will change substantially, from everyday appliances to transportation to domestic and industrial heating.

Asked which renewable energy technology will dominate over the next five years, contributors were split, with "energy storage solutions" the most popular response, ahead of "solar power," "hydrogen fuel cells," and "wind power." Other energy technologies mentioned by respondents included hydroelectric, smart grids, and next-generation nuclear methods.

Curiously, a higher proportion of trademark specialists (39%) selected solar power compared to the average (28%), suggesting a potential for further improvement upon a familiar concept. Despite this tendency, no trademark respondents selected "wind power."

The fundamental shift the industry is undergoing poses a number of IP hurdles, particularly around how to incentivize original research and encourage broad take-up. Selected by a third of respondents, the biggest single hindrance identified was "balancing the need for collaboration and exclusive IP rights" – in other words, ensuring that different entities work together to advance technology without giving up rights to the fruits of that research. Next came "navigating complex patent landscapes," with 5% of respondents selecting "IP infringement risks in emerging markets," increasing to 10% among trademark specialists.

**Which renewable energy technology** will dominate over the next five years?



SINGLE CHOICE QUESTION



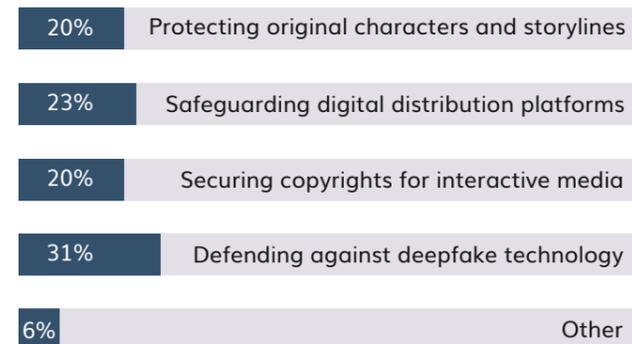
# DIGITAL MEDIA

Defending against deepfakes

The digital media industry faces unusual dilemmas compared to most sectors covered in this report. It has already been shaken up by digitization and streaming, along with the emergence of platforms and technologies that make it as easy to upload user-generated content as to share IP-infringing material.

## What is the most critical aspect of IP protection

for the digital media industry's future success?



Of the priorities facing the entertainment sector, "defending against deepfake technology" was the issue selected by most respondents at 31%. In addition to threatening individuals' privacy and personality rights, computer-generated likenesses can negatively affect IP in various ways, such as by facilitating highly convincing trademark and copyright infringement, producing fake endorsements, and spreading misinformation.

The other three concerns presented to the panel – "protecting original characters and storylines," "safeguarding digital distribution platforms," and "securing copyrights for interactive media" – were each selected by between a fifth and a quarter of overall contributors.

AI was the clear frontrunner when the panel was asked to rank various technologies according to their effect on digital media. Nearly three quarters of participants ranked AI as either 1 or 2 on a scale of 1-4, putting it some way ahead of "metaverse and digital commodities" and "VR/AR" [virtual reality/augmented reality]. At the other end of the spectrum, 79% of respondents (including 86% of trademark specialists and 93% of corporate respondents) ranked "video on demand" as 3 or 4 out of 4.



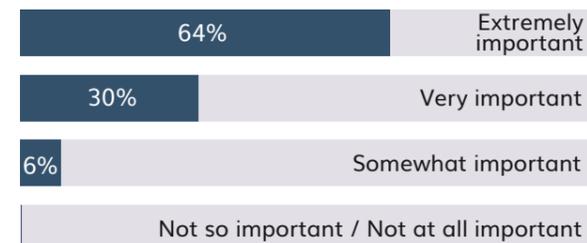
# MEDICAL DEVICES

Data protection is paramount

The medical device industry is expansive and well-established, but wearable medical devices such as smartwatches and remote health monitoring tools are still relatively new and raise several interesting business and IP complications.

One of the most pressing is data security, which almost all respondents said was either "extremely important" or "very important" (94%). Given the quantity of information wearables are able to collect, its sensitive nature, and the need to process it for research purposes, airtight privacy standards and ethical usage are essential. These hazards are compounded by the fact that many companies – including healthcare specialists and IT hardware and software providers – are divergently innovating in this field.

## How important is data security in the context of wearable medical devices?



One determinant of commercial success is likely to be whether users trust companies with their data – and that trust can easily be lost. The sensitivities around wearable health devices and remote monitoring are clear from the survey. Nearly half of all respondents (and 55% of trademark specialists) ranked this field as the top priority for robust IP protection. That put it ahead of "surgical and diagnostic tools" and "nanotechnology," and well in front of "3D printing." The majority of respondents gave this last technology a ranking of 4, though it was more popular among large corporate and SME respondents, 28% of whom ranked it as 1 or 2.

The dynamic and complex nature of the medical device industry is on display in responses to the question about the main reason for IP protection. Only a fifth of respondents said it is to protect against infringement (possibly because high technical and regulatory barriers make such breaches difficult), while twice that proportion (and an impressive 42% of trademark specialists and 50% of C-suite/management) said that it allows for commercialization. This highlights the role that IP rights can play in helping organizations obtain finance, monetize technology, and negotiate deals.





# ICT INDUSTRY

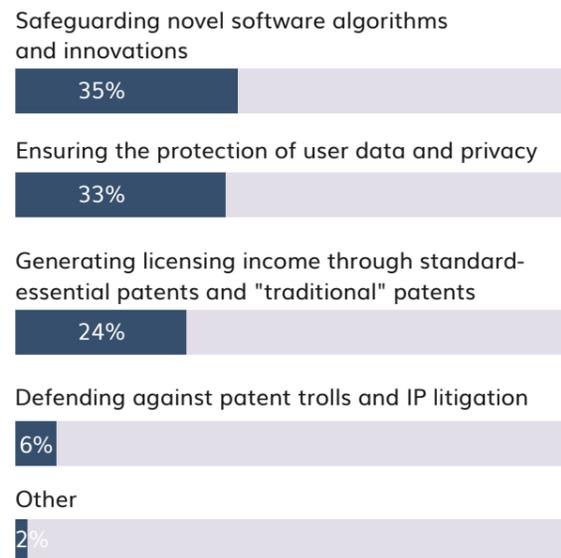
Keeping software safe

ICT operators have been among those most affected by the aggressive assertion of patents in court disputes over the past two decades, yet only a relative handful of the IP Trend Monitor panel members identified "defending against patent trolls and IP litigation" as the primary goal of IP protection here.

Instead, most respondents identified challenges arising from ambiguous, unharmonized, or complex areas of law, such as protecting software and upholding data security. Among responses from law firms, "ensuring the protection of user data and privacy" was the most popular, with 47%, while just 12% (half of the average) selected generating income through standard-essential patents (SEPs) and "traditional" patents.

When ranking innovations impacting the sector, 33% of trademark specialists put "blockchain and distributed ledger technology" as their first or second preference. However, there were generally lower expectations for "quantum computing" – with 75% of trademark respondents ranking it either 3 or 4.

## What is the primary goal of IP protection in the future of this industry?



SINGLE CHOICE QUESTION



# PHARMA INDUSTRY

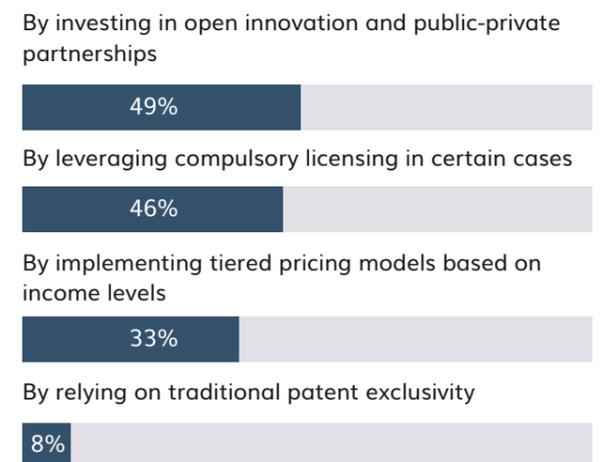
Synthesis and distribution

The pharmaceutical industry has matured to a point where the role of IP – particularly patents and trademarks – is massively valued. However, as in other fields, it is being disrupted by new technologies and business models. For instance, recent research has demonstrated the power of AI to improve the understanding, diagnosis, and treatment of complex diseases. In one example, a study found that AI was almost twice as accurate as a biopsy in assessing how aggressive sarcomas are.

A clear majority of IP Trend Monitor panelists agree or strongly agree that the use of AI in drug discovery will "increase patenting of AI-generated drug candidates" (66%), "result in IP challenges related to data ownership" (69%), and "create challenges in identifying true inventors" (60%). This emphasizes the extent to which the use of machine learning will cloud issues that were previously considered transparent (such as who is an inventor) and increase uncertainty for researchers (if many more drug candidates are patented).

However, only 35% of panelists agreed or strongly agreed that the use of AI will encourage more open collaboration, with more than half either disagreeing with the statement or being neutral.

## How should pharmaceutical companies balance the need for IP protection with ensuring affordable access to life-saving medications?



MULTIPLE CHOICE QUESTION





# SPACE TECH

Still on the launchpad

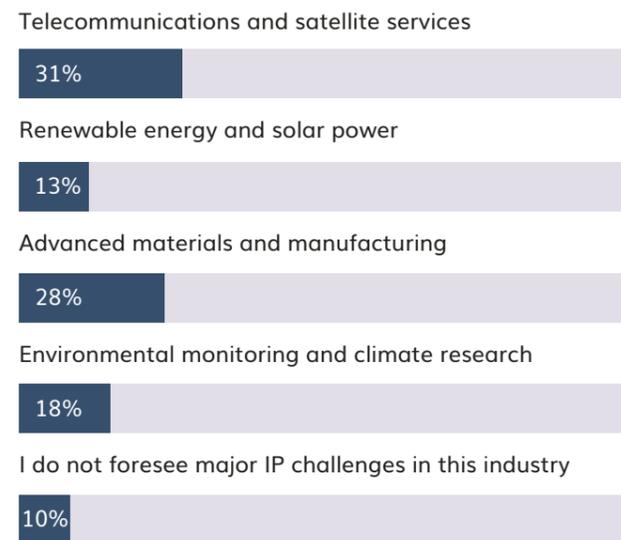
Space is one area where the impact of IP protection is yet to become evident; nevertheless, respondents identified certain areas as likely to pose IP challenges. Top among these was "telecommunications and satellite services," followed by "advanced materials and manufacturing." However, issues relating to renewable energy and the environment generally received less attention.

Surprisingly, 1 in 10 respondents did not foresee any major IP problems in the space industry – perhaps because such matters have not yet developed or are of a lower priority. At this time, questions around jurisdiction are still uncertain, and the size of the sector remains hard to predict.

When it comes to which projects will have the greatest implications for IP, more than two thirds of all respondents ranked "satellites" as either 1 or 2 out of 4. However, 36% of trademark specialists ranked "space tourism" as 1 out of 4, and a further 25% ranked it as 2, possibly hinting at lucrative branding opportunities in this field.

## Where will the most significant IP challenges arise due to space-derived technologies?

arise due to space-derived technologies?



SINGLE CHOICE  
 QUESTION

Innovation transforms  
**SO DO WE**



Redefine your IP management with our cutting-edge solutions.  
Reduce costs, boost efficiency and mitigate risk!

# HSM IP

Worldwide Services  
Caribbean Specialists



## Enforcing rights in composite marks

Ranjan Narula and Shivangi Kohli of RNA, Technology and IP Attorneys evaluate the procedure for enforcing rights against a deceptively similar mark that uses components of other well-known marks in an attempt to capitalize on existing reputations.

Protect your brand names, logos, inventions, trade secrets, creative works and designs with help from the intellectual property (IP) experts.

We advise major Fortune Global 500 brand owners, international law firms and other specialist IP practices.

- Portfolio management
- Strategic advice
- Renewals and annuities management
- Clearance and availability searches
- Dispute resolution/enforcement
- Prosecution services
- Anti-counterfeiting

### Key Contacts:



**Huw Moses**  
Managing Partner  
+1 345 815 7400  
hmoses@hsmoffice.com



**Mrinali Menon**  
Senior IP Manager  
+1 345 815 7436  
mmenon@hsmoffice.com

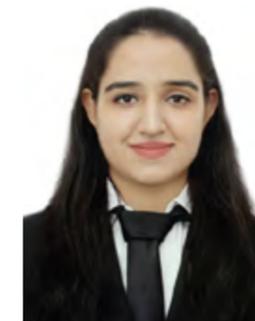
68 Fort Street, George Town  
PO Box 31726, KY1-1207  
Grand Cayman, Cayman Islands  
[www.hsmoffice.com](http://www.hsmoffice.com)

It is a well-accepted principle that the courts, while dealing with cases of trademark infringement, must compare the marks "as a whole". The marks should not be dissected into components for comparing only parts of the rival trademarks to determine the likelihood of confusion amongst consumers. The said rule is widely known as the Rule of anti-dissection and finds its origins in Section 17 of the Trade Marks Act, 1999 that provides, "when a trade mark consists of several matters, its registration shall confer on the proprietor exclusive right to the use of the trade mark taken as a whole." Section 17 also specifies that where a mark consists of several elements, it disentitles a registered proprietor to claim exclusive rights over the different elements of the composite mark unless the same has been registered separately by the proprietor.

A composite mark may be made up of a combination of two or more words or a combination of a logo and a word mark. While the registered proprietor can enforce his rights when the mark 'as a whole' has been copied by a third party, the real controversy arises when the Defendant copies only a part/element of the composite mark. It is in these circumstances the Courts are called upon to determine whether the copied element is the dominant feature of the mark to hold that the Defendant's use constitutes infringement. To elaborate, in cases where the Defendant copies not the entire mark but a particular element of a composite mark which enjoys greater prominence in a composite mark or is the dominant part of the composite mark, the Courts have held such use to be infringement. The rule of 'dominant feature' finds its premise in the settled principle that an average consumer with imperfect recollection is bound to remember and identify a brand/trademark by the dominant/prominent part of the mark and therefore, the dominant feature of the mark deserves more attention.



Ranjan Narula



Shivangi Kohli

The rule of Anti-Dissection and the rule of dominant feature are not antithetical to each other but rather complement one another. There exists a vast jurisprudence on the infringement of a composite mark where the infringer has copied only some elements of the mark and not the composite mark "as a whole".

The cases outlined below reiterated the principle of dominant feature and comparing the composite marks and holding marks to be similar marks

1. *Amar Singh Chawal Wala v. Shree Vardhman Rice and Genl. Mills 159(2009)DLT267*

The court while, comparing the marks GOLDEN QILLA/ LAL QILLA/LAL QILLA CHAPP/ NEELA QILLA/ and HARA QILLA, protected the rights of a registered proprietor of the composite mark in the essential element of the mark and held:

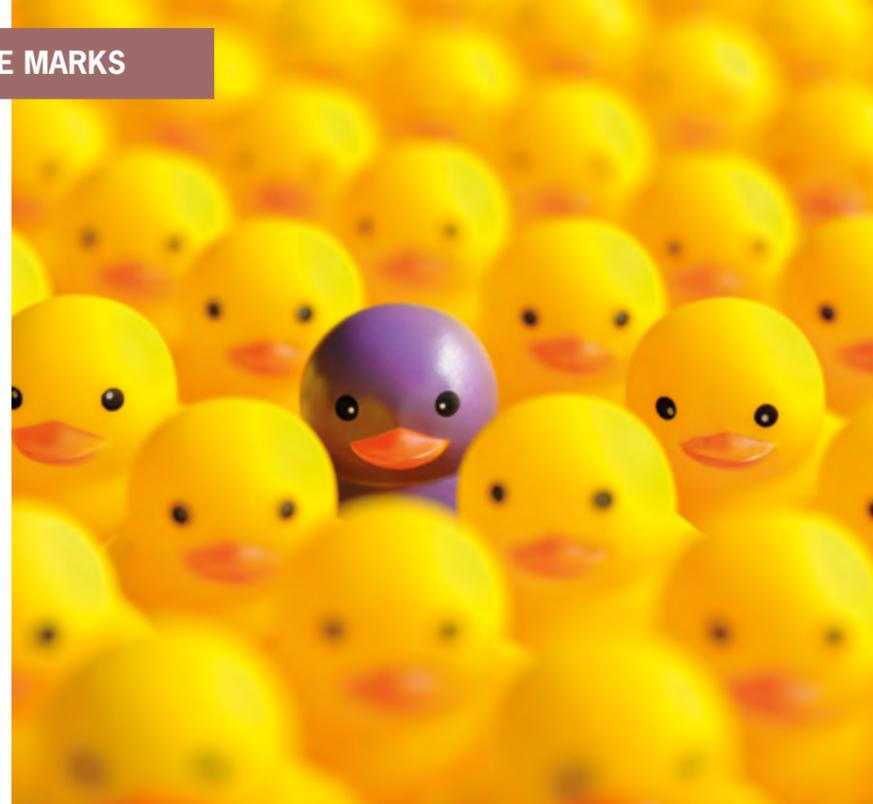
"In the instant case as far as the registered marks in favour of the plaintiff are concerned, applying the test laid down in Kaviraj Pandit it is seen that the essential feature of the mark is the word 'QILLA'. Whether the word is spelt as QILLA or KILLA, or even written in a different style or colour combination. To the customer who seeks to purchase the QILLA brand rice both names would sound phonetically similar. The customer is likely to ask the retailer: "Can I have the QILLA brand rice?" In the considered view of this Court, it is this essential feature of the plaintiff's mark, i.e. the word QILLA, which has been adopted by the Defendant No. 1. That the defendants have also used a pictorial representation of the device in the form of a fort also indicates that the Defendants too intended the same meaning to be assigned to the



word, which is an Urdu one meaning "fort". Therefore, though the device QILLA is depicted in a slightly different way by the defendant, it is deceptively similar to the device used by the plaintiff. Further the use is in respect of the same commodity, rice. Therefore there is every possibility of there being a confusion created in the mind of the purchaser of rice that the product being sold by the Defendant is in fact a product that has emanated from or has been manufactured by the plaintiff."

2. The need for protection to be granted to essential / dominant features of a composite mark was further reiterated by the Division Bench of the Delhi High Court in *Kirorimal Kashiram Marketing and Agencies Pvt. Ltd. v. Shree Sita Chawal Udyog Mill 2010/DHC/4248-DB*. While dealing with the rival marks 'Double Deer' and 'Golden Deer' with respect to rice, the Hon'ble Court overturned the order passed by the Single Judge and observed that "Deer" forms an essential part of the Appellant's mark Double Deer and the same having no connection with rice, is therefore arbitrarily adopted. The Court held:

"Copying of a prominent part of a trademark leads to deceptive similarity especially when the product of both the parties is the same. The expression "Deer" was arbitrarily



adopted by the appellant with respect to its product being rice. A deer has no connection or co-relation with the product namely rice. Such arbitrary adoption of a word mark with respect to a product with which it has no co-relation is entitled to a very high degree of protection, more so, as the appellant's trademark is a registered trademark. The use by the respondent of its trademark is admittedly subsequent to that of the appellant."

The Court further relied on a foreign judgement to uphold that the benefit of "...no one can copy an essential part or predominant part of a trade mark and the benefit of prior use doctrine will also be available to an essential/prominent/predominant part of trade mark i.e. an important part of a trade mark of another person...". The Court ultimately allowed the appeal and observed:

"we are of the firm opinion that only one view is possible in the facts of the present case because not only the appellant/plaintiff was the prior and the registered user of the trademark, the adoption of the respondent/defendant was not honest and it is not permissible to copy a prominent part of the registered trademark of another person, more so, when the said word mark is arbitrarily adopted with respect to the product in question. The balance of convenience is clearly not in favour of the defendant/respondent but is in favour of the appellant/plaintiff who will be caused serious, grave and irreparable injury with respect to its ownership and goodwill in the trademark "Double Deer"."

3. One of the most notable judgments dealing with the infringement of elements of a composite mark is *South India Beverages Pvt. Ltd. v. General Mills Marketing Inc., (2015) 61 PTC 231* wherein the Delhi High Court analyzed the Rule of Anti-Dissection and Dominant Feature of a composite mark. The marks in question were HAAGEN DAZS and D'DAAZS. The Court, in the present case, rejected the Defendant's contention that the Rule of Anti-Dissection allows a party to copy an element of the trademark and the same would not result in complete appropriation of the registered trademark and held:

"...while a trademark is supposed to be looked at in entirety, yet the consideration of a trademark as a whole does not condone infringement where less than the entire trademark is appropriated. It is therefore not improper to identify elements or features of the marks that are more or less important for the purpose of analysis in cases of composite marks."

4. The Court in *Apaar Homez Mart Pvt. Ltd. v. Century World, 2022/DHC/3495-DB*, correlated/ harmonized the rules of

anti-dissection and dominant feature while dealing with the rival marks CP CENTURY, CWPL CENTURY, and SEPAL CENTURY and upheld the established principle of comparing the rival marks as a whole and observed:

"The question whether the trademark adopted by the appellant infringes the respondent's registered trademark is required to be determined by examining the trademarks adopted by the parties as a whole. There is merit in the contention that the grant of a registration in respect of a device mark cannot be construed as registration of a part or a feature of the trademark. In that view, the respondent does not have an absolute right to use the word 'Century' to the exclusion of all others. The learned Commercial Court has also accepted the said proposition. However, on examination of the trademark adopted by the appellant, the learned Commercial Court had found the same to be deceptively similar to the trademarks adopted by the respondent. 20. This Court finds no infirmity with the view that the appellant's use of the trademark 'Sepal Century' has a propensity of confusing consumers to believe that the respondent is the source of the said goods."

## Résumés

**Ranjan Narula** founded the specialist IP law firm, RNA, Technology and IP Attorneys in 2004, and is now its Managing Partner. He has 27 years' post qualification experience working on contentious and non-contentious IP and Technology issues. Ranjan has been practicing as an advocate and patent attorney since 1991 handling a wide range of IP, IT, and Technology matters including IP management issues, and strategic advice on IP clearance, acquisition, and enforcement. Ranjan has worked in-house and in private practice including a stint with international IP practice heading its India operations. In 2019, Ranjan was invited to join the INTA, Board of Directors.

**Shivangi Kohli** is an Associate at RNA Technology and IP Attorneys and has been working with the Litigation Team since 2022. She is enrolled as an Advocate with the Bar Council of Delhi and has been regularly appearing and arguing cases before Delhi High Court and District Courts. Shivangi has handled an array of complex legal matters for companies in a diverse range of industries. Her specialization is in trademarks and copyright litigation, infringement actions, counterfeiting, defamation, domain-name disputes, etc. She also actively participates in mediation proceedings and negotiating settlements for dispute resolution. Shivangi is an avid reader and has keen interest in crime thrillers.

# [FRESH PERSPECTIVE]

★ PROTECTION      ★ ENFORCEMENT      ★ TRANSACTIONS

★ CONSULTING      ★ COMMERCIALISATION      ★ DIGITAL

WWW.RNAIP.COM  
GURUGRAM | CHENNAI



However, the Court went on to observe that while the marks are to be compared in entirety, the word "CENTURY" is a prominent part of the Appellant's mark with the word SEPAL in comparatively smaller font. Thus, the Court upheld the trial court's order and found the words 'CPWL' phonetically similar to 'Sepal' and likely to cause confusion of its source, thereby amounting to passing off of the Respondent's marks.

5. The Delhi High Court, in the recent case of *Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd. 2023/DHC/2711*, analyzed the various judgements on the Rule of Dominant Feature, clarified the Rules of Dominant Feature and observed, "where a composite mark consists of various parts, of which one or the other is dominant, the Court can while assessing whether the mark is infringed by another mark, take into account the dominant part thereof." The marks in question in this case were UNDER ARMOUR/UA/UNDR ARMOR and STREET ARMOR/SA/STRT ARMR.

The views of the Courts have differed where the mark in question was either a commonly

“**Ultimately, it is consumer confusion that must be avoided.**”

used word, had laudatory meaning, or the name of the deity. Some of the examples are listed in Table 1.

**To sum up**

As businesses vie for consumer attention, the trend of copying elements of a senior mark or part of the mark that enjoys larger market share is likely to be resorted to by the new entrant to attract attention. Therefore, the facts of each case will play a role in the determination of confusion and consequent infringement finding in the case of composite marks. Ultimately, it is consumer confusion that must be avoided.

**Contact**

**RNA, Technology and IP Attorneys**  
 401-402, 4th Floor, Suncity Success Tower, Sector - 65, Golf Course Extension Road, Gurgaon - 122 005, National Capital Region (Haryana), India  
**Offices:** Delhi | Chennai  
**Tel:** +91 124 429 6999  
 info@rnaip.com  
 www.rnaip.com

Table 1

Citation	Case Name	Rival Marks
2024/DHC/427	<i>Premier SPG and WVG Mills Pvt. Ltd. v. Football Association Premier League Ltd. and Ors.</i>	
2022/DHC / 4255-DB	<i>Vasundhra Jewellers Pvt. Ltd. v. Kirat Vinodbhai Jadvani and Ors.</i>	Vasundhra/ Vasundhra Jewellers/ 
2021(86)PTC 437(Del)	<i>Phonepe Private Limited v. Ezy Services and Ors.</i>	PhonePe and BharatPe
2010 (42) PTC 806 (DEL)	<i>Rhizome Distilleries v. Pernod Ricard SA</i>	Imperial Gold and Imperial Blue
2016/DHC / 577-DB	<i>S.K. Sachdeva and Ors. v. Shri Educare Limited and Ors.</i>	Shri Ram / Shriram/ The Shri Ram School and ShreeRam World School
2011/DHC / 5334-DB	<i>Bhole Baba Milk Food Industries Ltd. v. Parul Food Specialities Pvt. Ltd.</i>	Krishna and Parul's Lord Krishna

# VAKHNINA & Partners, Russia

Trademarks  
 Patents  
 Utility models  
 Designs



ip@vakhnina.com  
 www.vakhnina.com  
 +7-495-946-7075  
 Russia, Armenia, Kyrgyzstan

RUSSIA | ARMENIA | KYRGYZSTAN | AZERBAIJAN | BELARUS | GEORGIA | KAZAKHSTAN  
 MOLDOVA | TAJIKISTAN | TURKMENISTAN | UKRAINE | UZBEKISTAN



# VAKHNINA & Partners, Russia

Our Leading Trademark Attorneys



**Tatiana Vakhnina**

Russian Trademark and Patent Attorney, Eurasian Patent Attorney

Specializes in trademarks (prosecution, litigation), copyright law, and patents (mechanical and electrical engineering).



**Alexey Vakhnin**

Russian Trademark and Patent Attorney, Eurasian Patent Attorney

Specializes in area of Medicine, Biotechnology, Biochemistry, Pharmacology, Pharmaceuticals.



**Elena Ivanushkina**

Russian Trademark Attorney

Specializes in trademarks: prosecution, opposition, trademark disputes, dealing with international registrations and refusals.

**Contacts:**

Russia:  
 ip@vakhnina.com

Armenia:  
 am@vakhnina.com

Kyrgyzstan:  
 kg@vakhnina.com

Our attorneys are members of INTA, FICPI, AIPPI, LES Russia/LESI, PTMG, ECTA, Chamber of Russian Patent Attorneys

# If you think you are insured against trademark and copyright infringement claims, look again

**Susan J. Lutzker, Senior Partner at Lutzker & Lutzker LLP, explains the intricacies of business liability policies and insurances concerning claims for IP infringement to provide key advice for protecting your portfolio.**

If you are in the media business (such as publishing, broadcasting, film, or advertising), whether print or online, you are undoubtedly insured against claims of trademark or copyright infringement under a special media errors and omissions insurance policy, which will also cover claims such as defamation and invasion of privacy. The specialized policy is essential since general business liability policies for media companies specifically exclude *any* coverage for such liability.

To the extent non-media businesses worry about the risk of being sued for trademark or copyright infringement relating to their marketing materials, they may assume that they are protected by their business liability insurance. This insurance, which covers liability for slips and falls and damage to property, also typically includes what is known as "personal and advertising injury" coverage. However, restrictive definitions and broad exclusions often so dilute this coverage as to render it illusory.

## Advertising injury coverage in business liability policies

The Insurance Services Office (ISO), an insurance advisory organization, provides standard policy forms that are used by many insurers. These forms have evolved over time, and whether there is coverage in a particular case may depend on the version of the ISO form that is being used in the relevant policy or policies. In addition, courts have interpreted the ISO forms inconsistently, with the result that there is little clear guidance as to when a particular claim is covered. Moreover, as courts have become more liberal in interpreting



Susan J. Lutzker

“Even with this narrow construction, however, courts have found intellectual property exclusions to bar coverage in certain situations.”

the coverage, ISO has responded by drafting more restrictive forms. To complicate matters further, many insurers use their own forms rather than the ISO forms.

Whether written on an ISO or specific insurer's form, typical coverage clauses define personal and advertising injury to include, among other things, injury that arises from the insured's:

- Copying, in your "advertisement," a person's or organization's advertising idea or style of "advertisement;"
- Infringement of copyright, slogan, or title of any literary or artistic work, in your "advertisement".

Thus, the infringement must occur in the context of an "advertisement," as defined in the policy, which in general involves the widespread public dissemination of information or images with the goal of inducing the sale of goods, products, or services. Additionally, there must be a causal connection between the advertising and the alleged injury. Newer policies specifically include coverage for dissemination of information about the insured's product via the Internet, but only in the context of "offering" goods or services for sale. Typically, information and images on the packaging or labeling of goods or services will not be covered in the definition of "advertisement." Notably, the term "in your advertisement" is a narrower formulation than the language of some older policies, which used the term "in the course of advertising." If you are looking for protection for activities that go beyond the

scope of advertising, you will not find coverage under your business liability policy.

## Intellectual property exclusion

Most policies will contain an "intellectual property exclusion" to the coverage for personal and advertising injury, similar to the following:

"[Personal and advertising injury does not include injury] arising out of any actual or alleged infringement or violation of any intellectual property rights, such as copyright, patent, trademark, trade name, trade secret, service mark, or other designation of origin or authenticity."

And then, in a twist worthy of the Internal Revenue Code, many policies *restore* some of the excluded coverage by including language such as:

"However, this exclusion does not apply if the only allegation in the claim or suit involving any intellectual property right is limited to:

Infringement in your advertisement, of:

1. Copyright;
2. Slogan;
3. Title of any literary or artistic work; or
4. Copying in your advertisement, a person's or organization's advertising idea or style of advertisement."

Reading an insurance policy is not for the faint of heart. It is important to read all the way through the policy because often the language of a definition or an exclusion has been updated

“Courts are divided as to whether a trademarked phrase can fit within the exception to the exclusion carved out for slogans.”

## Résumé

**Susan Lutzker, Senior Partner**

Combining an academic and personal background in the arts with a strong foundation in the nuts and bolts of complex legal transactions, Susan enjoys helping entrepreneurs and creative professionals develop and grow their businesses. She guides content creators in the process of identifying, prioritizing, and protecting their intellectual property assets and, when necessary, enforcing them. She has a special interest in the preservation of cultural heritage, particularly that of indigenous populations.

Author email: [susan@lutzker.com](mailto:susan@lutzker.com)

(read "materially changed") via an endorsement that appears as an amendment to the policy, and takes precedence over the policy terms.

## General principles of interpretation

To understand how courts have approached these coverage disputes, a few broad principles should be noted.

First, an insurer's duty to defend (to pay attorneys' fees and other litigation expenses, which can greatly exceed actual financial liability for an infringement) is broader than its duty to indemnify (to pay the costs of a settlement or a judgment). To determine whether there is a duty to defend, courts must "compare the allegations of the [underlying] complaint – and facts extrinsic to the complaint – with the policy terms to see if they reveal a possibility that the claim may be covered by the policy." *First One Lending Corp. v. Hartford Cas. Ins. Co.*, 755 Fed. Appx. 710, 710 (9th Cir. 2019) (quoting *Pension Tr. Fund for*



*Operating Eng'rs v. Fed. Ins. Co.*, 307 F.3d 944, 949 (9th Cir. 2002)).

If such a possibility exists, courts find a duty to defend. Courts are not limited to the words used in the complaint but rather look to the substance of the claim and may consider extrinsic facts. See *Holland v. Travelers Commer. Ins. Co.*, 2:19-cv-02604-SVW-RAO, 2020 U.S. Dist. LEXIS 89799, at \*12 (C.D. Cal. 2020), *aff'd*, 843 Fed. Appx. 928 (9th Cir. 2021).

Fortunately, because insureds should be able to rely on a common sense reading of a policy, exclusions are to be construed narrowly against the insurer. See *My Choice Software, LLC v. Travelers Cas. Ins. Co. of Am.*, 823 Fed. Appx. 510, 512 (9th Cir. 2020); *Great Am. E&S Ins. Co. v. Theos Med. Sys.*, 357 F. Supp. 3d 953, 965 (N.D. Cal. 2019) ("California courts do not apply coverage limitations if the insured has an objectively reasonable expectation of coverage under the policy, and the limitation on that reasonably expected coverage is either (1) not conspicuous, or (2) not plain and clear.") (internal citations omitted). Policies are to be interpreted based on the ordinary understanding of a layperson. *Align Tech., Inc. v. Fed. Ins. Co.*, 673 F. Supp. 2d 957, 967 (N.D. Cal. 2009) (quoting *Stanford Ranch, Inc. v. Maryland Cas. Co.*, 89 F.3d 168, 626 (9th Cir. 1996)).

Even with this narrow construction, however, courts have found intellectual property exclusions to bar coverage in certain situations.

"The scope of coverage for intellectual property claims, however, has been the subject of significant and increased litigation because CGL [Commercial General Liability] insurers are employing these "intellectual property" exclusions with greater frequency as a defensive tool at the pleading

“**Don't assume that a business liability policy that includes coverage for personal injury and advertising claims will protect your business.**”

stage in an attempt to provide an effective means of ending litigation without incurring significant litigation costs.”

4 J. Thomas, *New Appleman on Insurance Law Library Edition* §30.07 [6] [a]; see *Tzumi Elecs. LLC v. Burlington Ins. Co.*, 2023 U.S. Dist. LEXIS 134576, at \*8 (S.D.N.Y. 2023) (no duty to defend where the intellectual property exclusion was "prominently marked in all capital letters as an 'EXCLUSION' applicable to 'INTELLECTUAL PROPERTY' and an 'ENDORSEMENT' that 'CHANGES THE POLICY'").

### Trademark issues and the intellectual property exclusion

In the trademark area, much of the confusion has revolved around the word "slogan." Courts are divided as to whether a trademarked phrase can fit within the exception to the exclusion carved out for slogans. The federal district court in Massachusetts, interpreting such an exclusion, held that a complaint alleging infringement of a company's registered trademark OSSEAN by the insured's OSSEO marks could not be construed as a claim for slogan infringement, and that, therefore, the insurer had no duty to defend the claim. That court distinguished between a phrase used to promote or advertise a house mark or product and a trademark functioning as a source identifier of products or services. *Sterngold Dental, LLC v. HDI Global Ins. Co.*, No. 17-11735-GAO, 2018 U.S. Dist. LEXIS 169196, at \*9 (D. Mass. Sept. 29, 2018) (citing *Hugo Boss Fashions, Inc. v. Fed. Ins. Co.*, 252 F.3d 608 (2d Cir. 2001)), *aff'd*, 929 F.3d 1 (1st Cir. 2019). Notably, nothing in the Sterngold complaint or the record even suggested that the mark was used as a slogan, so arguably

the court went further than it needed to. *Hugo Boss Fashions, Inc.*, 252 F.3d at \*10; but see *CGS Indus. v. Charter Oak Fire Ins. Co.*, 10-CV-3186, 2010 U.S. Dist. LEXIS 120671, at \*14 (E.D.N.Y. 2010).

Another area of ambiguity concerns claims of disparagement and/or unfair competition. These claims arguably arise out of a violation of "designation of origin or authenticity," generally included within the definition of personal and advertising injury and not specifically identified in the intellectual property exclusion. While some courts have held that such claims are really disguised trademark infringement claims – and thus barred under the exclusion – the sounder view appears to be that such claims can be distinct from claims of trademark infringement and therefore covered by this or similar policy language. See *W. Int'l Syndication Corp. v. Gulf Ins. Co.*, 222 Fed. Appx. 589, 592-93 (9th Cir. 2007) (although the majority of the claims involved trademark issues, factual allegations of disparagement about the company's ownership were distinct).

An additional hurdle for some insureds relates to a more recent iteration of the intellectual policy exclusion (sometimes called the "regardless clause"); namely, **that coverage is denied for all claims in a suit where any claim falls within the intellectual property exclusion:**

“**Whether a regardless clause will be enforced will depend upon the clarity of the language.**”

"[Personal or advertising injury does not include] any injury or damage alleged in any claim or "suit" that also alleges an infringement or violation of any intellectual property right, whether such allegation of infringement or violation is made by you or by any other party involved in the claim or "suit," regardless of whether this insurance would otherwise apply."

Whether a regardless clause will be enforced will depend upon the clarity of the language. Compare *Align Tech., Inc. v. Fed. Ins. Co.*, 673 F. Supp. 2d 957, 969 (N.D. Cal. 2009) (court declined to apply the exclusion because the language was ambiguous and would not have put a lay person on notice that coverage would be denied), with *Tela Bio, Inc. v. Fed. Ins. Co.*, 313 F. Supp. 3d 646 (E.D. Penn. 2018) (exclusion was upheld where its language was clear).

The "made by you or by any other party" language is significant because it will defeat coverage if there is a counterclaim by the insured involving an infringement of an intellectual property right. This is important where defending against a claim of infringement requires challenging the plaintiff's IP rights. See *My Choice Software, LLC v. Travelers Cas. Ins. Co. of Am.*, 823 Fed. Appx. 510 (9th Cir. 2020) (coverage upheld for counterclaim where language of exclusion was not clear);

ALIPA has been Recognised as 'Pakistan's Trademark Firm of The Year' in AsiaIP 2021



# 5K+

Trademark Filings

Our Senior Partners have been continuously recognised as AsiaIP Experts for the Jurisdiction of Pakistan



# 25+

Countries Served

**Client Recognition**

- Fortune 500 companies
- Top 10 to Top 100 Chinese Brands
- Top 10 to Top 100 European Brands
- Leading telecommunication, technology & Pharmaceutical Companies

# 30+

Years experience amongst the Partners of the firm in various cases.

## A Regional IP Hub!

ALIPA is an agent of innovation, providing clients in Pakistan, the SAARC region and worldwide with forward-focused and wide range of professional intellectual property, technology law and corporate law services and representation. We are one of the largest and fastest-growing IP law firms in the region, with experienced attorneys and technical staff representing the complete spectrum of technologies and IP practice areas. Our trademark and patent attorneys represent region and world leaders in business and technology, and our collective experience spans practically every practice area in the legal field and niche specialty within intellectual property laws.

### Our Practice Areas

**Intellectual Property**  
We are involved in all aspects of Intellectual Property Laws.

**Trademarks**  
We have one of the largest full service trademark practices in Pakistan.

**Copyright**  
We deliver comprehensive copyright counseling to all kinds of clients.

**Patent**  
We are actively engaged in developing and securing vital patents for our clients.

**Design**  
We acknowledge that designs are a powerful and all-prevalent legal rights.

info@alipaip.com | alipa.ipservices@gmail.com  
www.alipaip.com | 042 36306548  
Office No. 2, 2nd Floor, Mumtaz Centre, 15/A, Queens Road, Lahore, Pakistan

**PROTECT • ADVANCE • RESOLVE**

David A. Gauntlett, *Travelers Expansive Intellectual Property Exclusion Construction Rejected by Ninth Circuit for Affirmative Pursuit of IP Claims by Policyholders*, LinkedIn (Aug. 20, 2020) [linkedin.com/pulse/travelers-expansive-intellectual-property-exclusion-ninth-gauntlett/](https://www.linkedin.com/pulse/travelers-expansive-intellectual-property-exclusion-ninth-gauntlett/).

In addition to the intellectual property exclusion, other exclusions may lead an insurer to deny coverage, such as an exclusion for acts of the insured that are intended to, or could reasonably be expected to, cause injury or an exclusion for material first published before the beginning of the policy period.

Even if your current policy does not cover an alleged infringement, it is worth checking your prior policies, since they may be implicated depending on the period to which the claim relates.

#### The bottom line

Don't assume that a business liability policy that includes coverage for personal injury and advertising claims will protect your business. Narrow definitions, myriad exclusions, ambiguous policy language, and inconsistent legal interpretations suggest that you should consider a specialized IP policy. At a minimum do seek expert advice as to what the policy actually covers, and if possible attempt to negotiate a "buy-back" of exclusionary endorse-

“  
**You should consider a specialized IP policy.**  
”

ments or do consider a more specialized policy that is designed to cover IP risks.

#### Enforcement coverage

This discussion has been limited to insurance for defending IP claims. There is also an insurance product called enforcement (or abatement) insurance that pays your costs of pursuing infringers. These plaintiffs' policies generally require you to reimburse the insurer for funds it has advanced if you have a successful outcome. Unlike other litigation funding arrangements, you pay zero interest and no other share of the recovery. Enforcement policies are typically less costly than defensive insurance. The insurer will do a rigorous view of your IP before agreeing to provide coverage for specified trademarks, copyrights, or, especially, patents.

#### Contact

**Lutzker & Lutzker LLP**  
1233 20th Street,  
NW Suite 703 Washington, DC 20036,  
USA  
[www.lutzker.com](http://www.lutzker.com)



## IP SERVICES IN RUSSIA, EURASIA, UAE AND CIS COUNTRIES

### IP LITIGATION



### PATENTS



### TRADEMARKS



### AGREEMENTS



CHAMBERS  
EUROPE  
IP STARS

ПРАВО  
300<sup>RU</sup>

WIPR  
LEADERS >>>  
SELECTED  
AS A WIPR  
LEADER 2018

iam  
1000

WTR  
1000  
Recommended  
Firm 2018-2019

#### Russian Federation

Moscow, 129090, Grokholskiy per., d. 28,  
2nd floor, Tel: + 7 (495) 775-16-37  
email: [info@zuykov.com](mailto:info@zuykov.com)

#### Belarus

Minsk, 220004, 23/1 Pobediteley Avenue  
Tel: +375 17 204-16-37  
email: [bel@zuykov.com](mailto:bel@zuykov.com)

#### Kazakhstan

Almaty, 050042, 28/8 Ryskulbekov Str., Office 59  
Tel: +7 727 312 16 37  
email: [kz@zuykov.com](mailto:kz@zuykov.com)

#### UAE

Dubai, Barsha Heights, Madison Residency, Office 611,  
Tel: +971-50-425-1637  
email: [info@zuykov.ae](mailto:info@zuykov.ae)

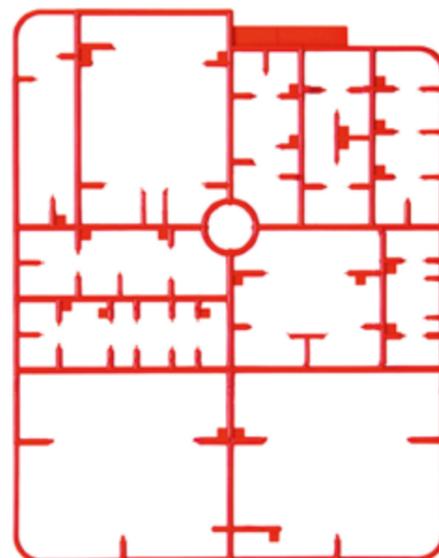
**CMS**  
law · tax · future

If you can build it,  
we'll work to protect it.

From trade marks to trade secrets, CMS is ready to advise on and actively defend your ideas, insight and expertise. Supported by over 450 intellectual property specialists across more than 40 countries, see how your best thinking can remain your most valuable asset.

CMS is an international law firm that helps clients to thrive through technical rigour, strategic expertise and a deep focus on partnerships.

[cms.law](http://cms.law)





# The ultimate brand protection play

**Stuart Fuller, Chief Commercial Officer at Com Laude, builds a case for the importance of dotBrand domains, expressing the undeniable value of trust between participating brands and their consumers.**

*"Trust is the glue of life. It is the most essential ingredient in effective communication. It is the foundational principle that holds all relationships true." Stephen Covey.*

**W**ithout trust, what do we have? That is effectively what bestselling author Stephen Covey is saying with those words. Trust defines us all and our relationships with everyone around us. In the commercial world trust and consequently, brand value can make or break a business. In the last few decades, we have seen catastrophic breakdowns in trust in the financial services sector that have led to old-fashioned "runs on the bank", and previously respected multi-billion-dollar financial organizations having to be bailed out by governments.

It can take years for companies to build their revenues and reputations only for it to all come crashing down in a matter of days, if not in some instances hours, when trust is broken. That is one of the key tenets in brand and intellectual property protection - deploying a strategy that can prevent malicious activities that can damage that trust and ultimately harm reputations and impact revenues.

Organizations spend hundreds of thousands of dollars each year trying to stay one step ahead of the bad actors and their nefarious activities. Whether it is counterfeiting, digital piracy, or online fraud, the damage to brand value and consumer trust that these activities can inflict far outweighs the budgets set aside to try to protect an organization's intellectual property. It is rare though, that an organization will invest anywhere near the same amounts in protecting its brand as it will in promoting it.

The ultimate digital goal for most brand holders is to provide a trusted online, zero-abuse namespace for their clients and prospects, whilst taking advantage of the opportunity technology continues to present. Multiple stakeholders in every organization will have their own objectives



Stuart Fuller

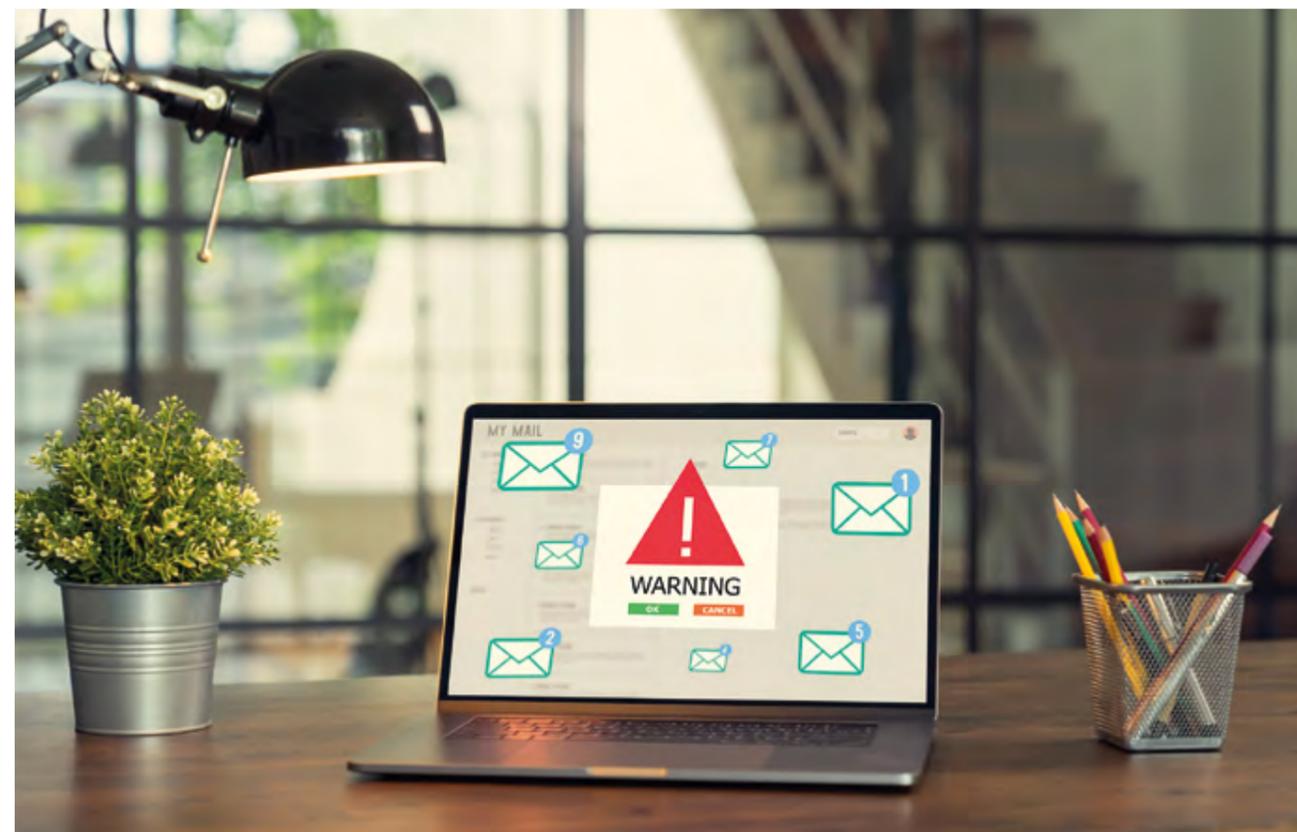
“  
Without  
trust, what  
do we have?  
”

related to customer reach and engagement, revenues, reputation, security, and compliance. Fortunately, there is an opportunity coming around the corner that could meet all of those objectives and goals, especially those related to providing the zero-abuse namespace.

Rarely a day goes by without stories in the press about the growing threat and the consequences of online fraud and intellectual property abuse. The numbers are eye-watering. Google estimates that it stops around one hundred million suspicious emails *per day* reaching its customers' inboxes. Unfortunately, it only takes one email to get through the most sophisticated defenses and significant financial damage can result. Last year, 83% of UK businesses that suffered a cyber-attack reported the attack vector as phishing emails, with end users being tricked into sharing personal and financial details.

At the heart of most phishing and online fraud attacks is a domain name. And herein lies the fundamental issue of trust. By using cyber and typo-squatted domain names, fraudsters can abuse the trust and goodwill that organizations have spent years building with their customers. The growth in popularity and availability of internationalized domain names (IDNs) has also led to homoglyph attacks, where similar-looking letters in different language scripts are used to trick users. For example, someone could register *tésco.com* (note the "e" is an accented character) to resemble the legitimate *tesco.com* and set up a fake site at the former. To the untrained eye, the two domains look identical so users could be targeted with phishing emails directing them to the fake site, which then steals any personal financial information they enter.

So, if trust in a domain name is at the very core of protecting revenue and reputation, is traditional brand protection monitoring and enforcement enough? It is certainly a valuable investment and should always form part of an intellectual property protection strategy, but in



many cases, it is a game of whack-a-mole, enforcing against bad actors in one corner of the Internet just to have them appear immediately somewhere else.

There is no panacea, but there is an opportunity coming over the horizon that could significantly reduce the risk of the erosion of trust in a brand through phishing and online fraud. Over a decade ago, the Internet Corporation for Assigned Names and Numbers (ICANN) created a process for brand holders to apply to run their own Top-Level Domain (TLD), effectively owning their own slice of the Internet, commonly called dotBrand TLDs.

The application window was limited and the process not without its challenges, but even with a relatively high price tag, over five hundred organizations successfully applied and were given ownership of their own dotBrand suffix. 12 years later, many have put innovative and practical strategies in place for their dotBrand, differentiating themselves in a competitive online space, but for many the key objective of owning a dotBrand TLD is to use it as the ultimate brand protection tool, giving their customers and prospects the reassurance that any website address and any email which ends with the dotBrand TLD is genuine, thus ensuring that trust is, as Covey described, the glue of life.

With great power comes great responsibility, a famous line from Stan Lee's Spider-Man films,

is also a very relevant value statement for brand holders in the digital world. Organizations spend significant amounts of money on protecting their digital and intangible assets, waging an ongoing war with serial infringers across multiple online and offline channels. Technology provides the poison and the antidote to brand abuse.

## Résumé

**Stuart Fuller** is Com Laude's Chief Commercial Officer. 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.

“  
Is traditional  
brand  
protection  
monitoring  
and  
enforcement  
enough?  
”



For any brand holder, the ultimate goal of any digital strategy has to be finding the perfect balance between risk and reward. It is simply not practical, or affordable, to register every combination of keyword and top-level domain. Using brand protection solutions can provide defensive intelligence combined with proactive enforcement actions but, again, that approach comes at a cost. By being proactive in communicating their new naming strategy, utilizing the dotBrand, the brand holder may also see a reduction in the number and cost of domain name disputes and subsequent legal action against third-party IP infringers.

Because the dotBrand owner controls each and every domain ending in their dotBrand suffix, they have complete authority over how the domains are used, meaning that anyone engaging with the organization through web inventory using a dotBrand domain name can have confidence they are interacting with the genuine brand holder. Thus, users can trust that the dotBrand is a safe space.

Some commentators suggest the success of the dotBrand program is based on the number of domains registered, but the quantity of names and quality of usage are two very different measures. The success, and often return on investment in a dotBrand TLD should not be solely measured on the volume of domain names registered by an organization, but on how those domains are being used. For instance, deploying a single dotBrand domain for secure email communication with customers, or to host a key piece of business architecture in a secure environment could offer value to an organization if it helps to reduce fraud or the risk of system compromise by just a fraction of a percent.

“  
At the heart  
of most  
phishing  
and online  
fraud  
attacks is  
a domain  
name.”

In the Financial Services and Technology space, many brands have built their business models purely around a digital application. Today, well-known brands such as Stripe, Klarna, Revolut, and Monzo have produced innovative solutions for both consumers and businesses, bringing financial simplicity to billions of people. These brands, and hundreds of others that make up the FinTech industry rely on trust, security, and stability to provide their solutions. Whilst many have built their value propositions on mobile applications and software platforms, at these solutions heart is often a single domain name. If trust, security, and stability are the three critical characteristics then using a dotBrand TLD ticks all the boxes for them.

There are other notable associated benefits for an organization in utilizing a dotBrand as a cornerstone for an integrated intellectual property and brand protection strategy. By migrating existing domain name registrations from gTLD and ccTLDs to the dotBrand, the organization will soon start to see a reduction in the costs associated with the renewal (and future registration) of domain names as they will no longer be beholden to registrars and other registries in paying their fees. Whilst it would not be prudent to delete the whole existing portfolio of domains, there will normally be a number of names that can be quickly set up under the new dotBrand naming convention. The brand holder will also be able to create their own security and encryption protocols, reducing the reliance on third-party SSL and DNS providers and their costs.

In conclusion, a dotBrand TLD application for an organization domain will bring many benefits but it could be one of the most effective tools for entities that are focused on building and maintaining brand trust and loyalty. A dotBrand offers a unique combination of branding, marketing, control, but most importantly security and brand protection that can significantly contribute to a stronger and more secure brand presence online. DotBrand domains can enhance consumer trust because they signal to users that they are interacting with an official and secure online presence directly associated with the brand. This is particularly important in an era where phishing and fraudulent websites are common. Customers know that if they are visiting a dotBrand website or communication channel, they are in the right place.

### Contact

**Com Laude**  
28-30 Little Russell Street,  
London WC1A 2HN, UK  
**Tel:** +44 20 7421 8250  
comlaude.com

# The Canadian trademark ecosystem: what to consider for 2024

**Micheline Dessureault, Caroline Guy, and Simone Ndiaye of Therrien Couture Joli-Cœur LLP provide their annual update with advice for navigating the Canadian trademark system for our INTA special edition.**

### Official bilingualism in Canada: recent developments regarding new legislation affecting non-French trademarks in the province of Quebec

Last January, the Government of Quebec published the draft regulation to amend mainly the Regulation respecting the language of commerce and business related to Bill 96.

For context, Bill 96 (now Law 14) was adopted in 2022 to safeguard the French language and culture, in this province of Canada where the majority of the Canadian French-speaking population is located.

It brings important amendments to the Charter of the French Language.

These modifications affect businesses, non-profit organizations, government agencies, workers, and consumers. This new legislation stipulates that in the province of Quebec, non-registered trademarks in a language other than French will need to be translated into French when they are used on products, commercial signage, and advertising. Also, if a French version of a trademark has been filed, this French version is the one that must be used in Quebec. Although Bill 96 applies only to Quebec, its impacts on intellec-





## Résumés

**Micheline Dessureault** is a partner at Therrien Couture Joli-Coeur LLP and Director of the IP and International Business Law practice groups. As an attorney and trademark agent, she has worked for over 35 years with Canadian and foreign companies expanding internationally. She publishes and acts as a guest speaker on IP and international commerce, in Canada and abroad. She is a member of LES, IPIC, and INTA, and an accredited consultant on international trade, business law, and intellectual property for ADRIQ-RCTI (Association for Research and Development of Innovation) in Quebec, Canada, providing strategic counseling on IP and international expansion for innovative businesses, and is the Honorary Vice-Consul for Mexico in Quebec City since 1997.  
*Email:* micheline.dessureault@groupepcj.ca

**Caroline Guy** is a Canadian attorney and a trademark agent at Therrien Couture Joli-Coeur LLP. She has been working in the Intellectual property field for over 20 years. Her practice is focused on trademark prosecution. She also represents her clients in trademark opposition and expungement proceedings. She is a member of the Intellectual Property Institute of Canada (IPIC), and of the International Trademark Association (INTA), where she currently sits on the Professional Development committee.  
*Email:* caroline.guy@groupepcj.ca

**Simone Ndiaye** is a Trademark Agent at Therrien Couture Joli-Coeur LLP, with over 15 years of experience. She graduated from France and immigrated to Canada in 2006. She has a DESS degree in Engineering and Valorization of Intangible Heritage of Companies (University of Marne-La-Vallée, France), a Master's degree in Documentation and Information Sciences (University of Paris X Nanterre, France), and a postgraduate Microprogram in Fundamentals of Technology Transfer (University of Sherbrooke, Canada). She is a member of INTA and the Intellectual Property Institute of Canada (IPIC), which has spotlighted her during the 2022 Black History Month as a BIPOC leader within the IP profession.  
*Email:* simone.ndiaye@groupepcj.ca



Micheline Dessureault



Caroline Guy



Simone Ndiaye

tual property are Canada-wide, as the distribution chain renders products and services available across the country.

Many national and international industry organizations and associations, including the International Trademark Association (INTA) and the Intellectual Property Institute of Canada (IPIC), have presented their comments to the Quebec government. These organizations and associations have judged that the implementation of Bill 96 and its draft regulation create important impacts on commerce and trade, some of which may not have been fully assessed. Amendments could be announced in the upcoming months, as a result of this lobbying and consultation.

Some of the comments submitted to the Quebec government are to the effect that the regulation, as drafted, lacks clarity and flexibility, and imposes a significant financial and operational burden on businesses needing to implement these measures in the context of a global economy and supply chain. Some manufacturers and service providers may decide that the challenge of implementing these measures may not be worth the trouble or investment, for such a small population in the overall North American market.

### Trademarks on goods

The draft regulation stipulates that the generic or descriptive words of a registered trademark must be translated into French. The aim of this new legislation is mainly to prevent companies from registering the entire product label to avoid translating certain descriptive terms. However, the regulation does not provide a clear definition for 'descriptive' or 'generic' and does not assess the situation of acquired distinctiveness. Possible amendments to this from the Quebec authorities would be welcomed.

For example, if the label in Table 1 was a registered trademark, the mark BESTSOAP would not have to be translated, according to the governmental entity responsible for applying French protection legislation, namely the *Office québécois de la langue française* (OQLF). But all

Table 1

BESTSOAP	BESTSOAP
Pear and Lavender	Pear and Lavender Poire et lavande
Moisturizing hand soap	Moisturizing hand soap Savon hydratant pour les mains
Kills 99.9% of bacteria and deeply moisturizes	Kills 99.9% of bacteria and deeply moisturizes Élimine 99,9% des bactéries et hydrate en profondeur

the descriptive information included in the registered trademark would have to be translated. However, the draft regulation could also be interpreted differently, as it does not make a distinction between the mark itself, and the informative wording. Again, this shows that clarification and better guidelines for what is expected and permissible must be provided. See Table 1.

Lots of other questions are still pending: Do manufacturers have to change all the markings on products or product packaging? How can they ensure that the layout of the text on their products complies with this new legislation? Do the marks have to be translated into French?

The draft regulation provides a two-year grace period. Non-complying products manufactured before June 1, 2025 may still be sold, distributed, or leased in Quebec until June 1, 2027. Implementing the changes required to comply with the new legislation is a time-consuming and cost-intensive process that product manufacturers need to address in the short term. However, it would be risky to take these costly steps before the final regulation is adopted.

Faced with this state of uncertainty, some manufacturers have already announced that they will be suspending distribution of their products in Quebec, regrettably to the detriment of Quebec consumers. Others may follow, which is a situation that the Quebec authorities will need to address and try to find a fair balance between protection of language and culture, and the adverse effects for consumers.

### Trademarks on exterior signage

The draft regulation stipulates that French must be markedly predominant in the public display of trademarks, when visible from outside the premises, French being markedly predominant if the French text is at least twice as large as the text in another language.

### New requirement

The draft regulation also brings an important change, which was not in Bill 96, affecting manufacturers, namely the requirement to add French for any usage instructions that are engraved, baked, or inlaid into a product. This could include terms engraved on many products, such as "on" or "off". This new requirement would come into effect 15 days after the regulation is adopted, with no grace period.

The impacts of this addition to the regulation could have huge consequences. Most manufacturers, domestic or foreign, already comply with Quebec legislation by translating user manuals and packaging, but many, including American manufacturers of electrical appliances for example, believe that the draft regulation goes too far according to recent media coverage on this topic.

“**Non-registered trademarks in a language other than French will need to be translated into French when they are used on products, commercial signage, and advertising.**”

”





### Implementing changes now for compliance?

In February, the INTA Bill g6 coalition had discussions with the OQLF. It is expected that the OQLF will use its reasonable judgment with businesses that cannot comply by June 1, 2025, so long as they have taken steps to comply and are facing logistical or administrative obstacles outside their control.

However, businesses are still facing a significant risk. The Quebec *Charter of Human Rights and Freedoms* recognizes in Quebec the fundamental right for every person to live in French to the extent provided for in the Charter of the French language (section 3.1). As a possible consequence, any individual feeling that their rights have been violated may decide to launch an individual or class action lawsuit pertaining to such a violation.

To conclude on Bill g6 and the draft regulation: Canada has trading partners worldwide and the manufacturing supply chain is also very integrated, particularly with the free-trade agreements in place for North America and Europe. Numerous products and components, including those from Asia, are intended to be commercialized by manufacturers on a more regional or global basis, rendering products customized for smaller markets often not very attractive, and costly.

This new legislation may cause some concerns for companies doing business in Quebec, including those from other provinces of Canada and foreign companies, considering they also have to comply concurrently with several other laws and regulations of the Quebec and federal governments, including the federal Labeling Act. How the Quebec government navigates these important issues and consequences is yet to be seen.

### Backlog at the Canadian Intellectual Property Office (CIPO) remains but.....

In our last article, we talked about the Backlog at the CIPO; have there been any improvements? Yes, but...

To assist with tackling the backlog of domestic applications awaiting examination, CIPO hired and trained approximately 100 new examiners in 2023. Things should be improving, over time.

To try to expedite the registration and examination process, the best strategy, whenever possible, is to use CIPO's pre-approved list of goods and services terms at the time of filing. Currently, these applications are examined within 18 to 20 months.

If the goods and services are not pre-approved terms, the alternative is to determine with clients the terms that would be the most appropriate to best describe their goods or services, and then file a request with CIPO recommending adding these terms to *The Goods and Services Manual*.

“  
To assist with tackling the backlog of domestic applications awaiting examination, CIPO hired and trained approx. 100 new examiners in 2023.  
”

CIPO should respond within approximately four weeks. If the response is positive, agents can then file amended applications, using the pre-approved terms. CIPO implemented an artificial intelligence tool that reviews the goods and services statements in pending Canadian trademark applications. When the AI tool recognizes that the goods and services used in the amended applications are pre-approved terms, these applications will then be placed in one of CIPO's lists of applications to be examined quicker. Hopefully, this will substantially reduce the overall processing time up to registration.

Unfortunately, if the goods and services are not pre-approved terms and it is not possible to add them to *The Goods and Services Manual*, these applications will be examined less rapidly. As of April 2024, CIPO is examining applications not using the Pre-approved List of Goods and Services that were filed in August of 2019.

Applicants who wish to get their trademarks registered within a reasonable timeframe are encouraged to use CIPO's pre-approved list of goods and services at the time of filing.

### What about distinctiveness in Canada?

Canada has examined the distinctiveness of trademarks at the examination stage since the major reform of the Trademark Law on June 17, 2019.

The Registrar of Trademarks now has the discretion to raise an objection if a trademark does not have inherent distinctiveness<sup>1</sup> according to their preliminary opinion. We have noted a profusion of objections under this criterion.

A trademark is inherently distinctive if it does not refer the consumer to a multitude of sources when considered in association with the related products and services. "There is a spectrum of inherent distinctiveness, ranging from no inherent distinctiveness to high inherent distinctiveness." Under the provisions of the Trademarks Act, a trademark must have some degree of inherent distinctiveness to be accepted by the Registrar.

The following trademarks are generally considered to lack inherent distinctiveness:

- Geographic locations;
- Generic designs;
- Names of colors;
- One- and two-letter or -number trademarks;
- Trademarks that consist of words/phrases that are clearly descriptive in both English and French;

- Laudatory words and phrases;
- Combinations of unregistrable elements.

Moreover, if an objection is raised because the trademark is primarily a name or surname under paragraph 12(1)(a) of the Act, or because it is clearly descriptive or deceptively misdescriptive under paragraph 12(1)(b), the examiner will automatically raise an objection of lack of inherent distinctiveness.

Arguments showing that the trademarks have inherent distinctiveness can be submitted. Alternatively, an applicant may overcome an objection by filing evidence that the trademark was distinctive at the filing date of the application for its registration. The burden of proof is very high.

### Conclusion

Canada is certainly a complex jurisdiction, like many others. Trademarks are the core of all successful business opportunities. In the context of global trade and supply chains, it is paramount to better understand the particulars of trademarks and other legislations affecting the ability of manufacturers and service providers to carry on business successfully in

“  
Applicants who wish to get their trademarks registered within a reasonable timeframe are encouraged to use CIPO's pre-approved list of goods and services at the time of filing.  
”

Canada. Be sure to look out for our article in next year's INTA special edition of *The Trademark Lawyer* magazine, for an update about our unique Canadian landscape.

### Contact

**Therrien Couture Joli-Cœur LLP**  
Montreal (Quebec) Canada  
**Tel:** +1 514 871 2880  
[www.groupecj.ca](http://www.groupecj.ca)

# A friendly approach to navigating the Canadian trademark and IP environment

Lawyers • Notaries • Trademark Agents

[groupecj.ca](http://groupecj.ca)  
[tm-intl@groupecj.ca](mailto:tm-intl@groupecj.ca)

**TCJ<sup>1</sup>** Therrien  
Couture  
Jolicœur

<sup>1</sup> Canada's Trademarks Examination Manual



博学 审问 慎思 明辨 笃行  
ERUDITE CURIOUS SCRUPULOUS CLARIFYING DETERMINED

北京市正见永申律师事务所成立于 1998 年，作为一家根植于中国的精品律所，正见永申始终坚持以专业立身，在知识产权领域精耕细作，凭借对本土的深入了解，卓越的执业能力和丰富经验，正见永申代理的众多知识产权案件被列入最高人民法院指导性案例或其他法院典型案例。

ZY PARTNERS was founded in 1998. As a boutique law firm rooted in China, ZY has always adhered to the principle of professionalism and intensive cultivation in the field of intellectual property. With in-depth understanding of the local area, excellent practice ability and rich experience, many intellectual property cases represented by ZY have been listed as guiding cases of the PRC Supreme People's Court or typical cases of other courts.

我们常年为国内外客户提供全方位知识产权法律服务，包括但不限于：  
A full range of intellectual property legal services to domestic/international clients, including but not limited to:

疑难复杂商标、版权、不正当竞争等知识产权诉讼案件；  
Intellectual Property Enforcement/litigation: Trademark, Copyright, Unfair Competition Etc.;

商标/版权日常法律服务；  
Trademark/copyright Prosecution And Counsel

知识产权保护策略和咨询；  
Strategy Advice On Ip Protection And Development

域名；海关保护；工商投诉；调查等。  
Domain Name, Customs Protection, Amr Complaints, Investigation And Research, Etc..

业务涵盖商标、专利、著作权、反不正当竞争等领域，服务的行业从食品、服装、图书音像、制造业等传统行业到电子、网络、通讯、生物、医药等科技企业。

ZY is engaged in trademarks, patents, copyrights, anti-unfair competition etc., serving industries ranging from traditional industries such as food, clothing, books and audio-visual industries, manufacturing to technology enterprises such as electronics, network, communications, biology, and medicine.

正见永申的律师极具国际化视野，正见永申及其律师连续多年被各大行业榜单评为中国顶尖知识产权律所及顶尖知识产权律师。

ZY's lawyers have an international vision. ZY and its lawyers have been rated at the top of many different rankings for legal industry for many consecutive years.



# Protecting unregistered overseas brands in China

Li Xiaohong and Tian Yu of ZY Partners examine the application of overseas prior use for the protection of high fame trademarks unregistered in China in the face of first-to-file bad faith registrations.

With the rapid expansion of the internet, brands may skyrocket to fame across the globe overnight. Sophisticated bad faith filers take advantage of China's first-to-file system and register marks in China even before their true owners do. Some big brands can seek protection for their unregistered marks as an unregistered well-known trademark. But for most brands, due to the extremely high burden of proof and cost to prove well-known status, a more viable option seems to be leveraging prior use under Article 32 of the PRC Trademark Law. Traditionally, Article 32 is presumed to target situations where a brand had no prior filing but used the mark in China. But in fact, under certain situations, even for brands that have not yet entered China, Article 32 could also be utilized to protect their rights.

Article 32 of the PRC Trademark Law rules that if any trademark has been used for a long time and gained a certain influence, any other person cannot file a trademark application similar to that prior used mark. It comes with two pre-conditions: (1) the mark was used by the brand owner prior to the application date of the disputed mark; (2) the prior mark has gained a certain influence. Although the law remains silent on whether both pre-conditions must occur in China, we can see from the guidelines issued by the China National Intellectual Property Administration (CNIPA) and precedents that, as long as the mark gained a certain influence in China, prior use could take place outside China.

### Factors considered for overseas brands to apply prior use

In practice, the following factors shall be considered when an overseas brand raises a prior use claim:

#### The brand's prior use and fame evidence outside China

For those brands that have not yet entered China, overseas prior use evidence is crucial. On one hand, such evidence can demonstrate whether

As long as the mark gained a certain influence in China, prior use could take place outside China.

a trademark serves as a source identifier for consumers and whether the brand owner has rights to the trademark prior to the third-party filers. On the other hand, it indicates the level of fame of the trademark in overseas markets and the likelihood of it being known to the Chinese public before the filing date of the disputed trademark. For example, in *HAVE&BE Co., Ltd. v. CNIPA*, the plaintiff's mark "V7ToingLight" was being pirated by a bad faith filer, but the plaintiff did not use or register the mark in China. Most of the fame evidence is about the mark's use in South Korea. However, the plaintiff still prevailed by providing evidence including trademark filing records, publicity plans, advertising expenses, and rewards received concerning the "V7ToningLight" mark to show its use and fame in South Korea. In *SKYVENTURE, LLC v. CNIPA*, a similar scenario, the plaintiff also successfully established its prior use status and fame outside China by presenting evidence including trademark



CHINA · BEIJING  
SUITE 2606, KUNTAI INTERNATIONAL PLAZA, NO.12 CHAOWAI STREET,  
CHAOWANG DISTRICT, 100020  
TEL: +8610 5879-0066 EMAIL: ZY@ZYPARTNERS.COM

ZY PARTNERS



## Résumés

### Li Xiaohong, Senior Partner

Li is an experienced litigator in the field of IP law. She represents multinational clients in IP enforcement and litigation actions relating to trademarks, copyright, unfair competition, domain names, and designs. She has expertise in advising on IP enforcement strategy and has in-depth knowledge of court procedures. She also leads a team providing trademark portfolio services to multinational clients in China, including trademark prosecution, opposition, cancellation, enforcement, opinion work, licensing, and other work.

Li has helped numerous clients obtain well-known mark recognition for their brands before the Trademark Office/ Trademark Review and Adjudication Board and the courts.

Li joined ZY Partners in 2006 after practicing commercial law at Beijing B & D Law Firm for two years. She obtained her LLB from Peking University Law School in 2004.

Author email: [xiaohong.li@zypartners.com](mailto:xiaohong.li@zypartners.com)

### Tian Yu, Senior Associate

Tian's practice has been covering a full range of contentious and non-contentious matters, particularly specialized in IP prosecution and enforcement. Over more than eight years of specialized practice, Tian has acquired extensive hands-on experience, penetrating insights, and very practical skills in advising on the strategic protection of IP portfolios, IP enforcement, and litigation.

Tian represented clients from the world's top luxury brands, Fortune 500, Hong Kong-listed companies, and multinational corporations for various IP litigation and IP-driven commercial deals. She has considerable experience in managing IP portfolios and providing strategic advice in complex IP litigations.

Tian graduated from the College of William & Mary in the United States. She obtained her New York State Bar qualification in 2016 and joined ZY Partners in 2019.

Author email: [yu.tian@zypartners.com](mailto:yu.tian@zypartners.com)



Li Xiaohong



Tian Yu

“The plaintiff also successfully established its prior use status and fame outside China by presenting evidence including trademark filing records.”

filing records for the “SKYVENTURE” trademark in the United States and Canada, news reports on the operation of the “SKYVENTURE” project in the United States, Singapore, Malaysia, and other jurisdictions.

#### The brand's popularity status in China

Despite prior use evidence in China no longer being a must-have, to claim prior use under Article 32 the brand still needs to prove its fame gained in China. Substantial evidence from Chinese-language media is required, such as broadcasts, television, newspapers, magazines, online media reports, etc. Otherwise, it's still hard to receive protection. For instance, the court did not support BGF Retail Co., Ltd.'s prior use claim against the “HEYROO” mark being pirated by a bad faith filer, provided that BGF Retail Co., Ltd. submitted insufficient evidence showing its local recognition in China. In contrast, in the above two cases where the brands' prior use is supported, although neither brand directly sells or promotes its products in China, they both proved their products had been known to the relevant Chinese public and gained a certain level of fame in China. Another positive example is *COLOURPOP v. CNIPA*, in addition to local media coverage, the plaintiff provided evidence to show Chinese consumers purchased products through channels such as purchasing agents, overseas shopping, and duty-free shops. Though such evidence cannot be viewed as direct sales by the brand owner in China, they are helpful to enhance the overall probative value of the evidence, especially when coupled with local fame evidence such as relevant consumer reviews, influencers' postings, and local media reports.

#### The type of industry to which the goods or services belong

Another factor the courts often consider is the industry to which the goods/services belong. This impacts the spreading speed and scope of the brand's popularity. In fact, according to the *Cross Border eCommerce 2023 Finding Report* released by Meta, apparel, food and beverage, and health/beauty products are the top three popular products in cross-border e-commerce. Entertainment, finance, and education-related services are also more favored by cross-border consumers compared with other types of services. Therefore, when trademarks are used on these more popular goods or services, they have a higher possibility of spreading quickly and at scale. This is also in line with how the courts ruled in practice. For example, in the three favorable cases we mentioned, the brands “V7ToningLight” and “COLOURPOP” belong to the beauty industry, and the brand “SKYVENTURE” belongs to the entertainment industry.

#### Consumers' cognition in the internet age

Consumers' increased exposure to the internet is also a significant factor, as it changes the consumers' cognition. On August 28, 2023, the China Internet Network Information Center (CNNIC) released the *52nd Statistical Report on the Development of China's Internet Network*, showing that as of June 2023, China's internet users reached 1.079 billion, an increase of 11.09 million from December 2022, with an internet penetration rate of 76.4%. At the same time, the report also showed that cross-border e-commerce continues to grow rapidly. In the first half of 2023, China's cross-border e-commerce import and export volume reached 1.1 trillion, a year-on-year increase of 16%; the proportion of cross-border e-commerce goods import and export volume in foreign trade has increased from less than 1% five years ago to about 5%, making cross-border e-commerce an important new force in foreign trade.

With the widespread use of the internet, consumers have increasingly diverse ways of obtaining information about goods or services, and the demand for cross-border consumption is also growing. For overseas brands that have not yet entered China, the likelihood of being known to Chinese consumers is higher than before. With more opportunities for the public to purchase goods/services overseas, it comes along with the increased risk of a rising brand's trademark being pirated by some bad faith filers in another country. For example, we note the “ChatGPT” (a globally popular chatbot program) was being pirated by some bad faith filer in China on services in Class 35, just within less than one week since its release on November 30, 2022. As such, we should allow these overseas brands to submit certain evidence outside China to mitigate the risk brought by the internet age.

The courts also made their comments in some rulings. In *HAVE&BE Co., Ltd. v. CNIPA*, the court opined “[...] in the era of the internet, it's common for consumers to get to know new overseas brands through foreign websites and purchase them from channels such as purchasing agents, overseas shopping, and duty-free shops”, and in *SKYVENTURE, LLC v. CNIPA*, the court concluded “[...] with the continuous deepening of international exchanges and the increasing frequency of personnel exchanges, it's easy for the public to travel to various parts of the world to learn about the SKYVENTURE project and share it with more audiences through online media.”

#### Legislative trends

There are traces from the legislation that China is gradually accepting certain evidence formed overseas in terms of proving the mark's fame. On January 13, 2023, the CNIPA issued the *Draft Amendment to the Trademark Law of the People's*

“Despite prior use evidence in China no longer being a must-have, to claim prior use under Article 32 the brand still needs to prove its fame gained in China.”

*Republic of China (Draft for Public Comments)*, below referred to as the “Draft Amendment.” Although it did not substantially change the language of the current Article 32, it did, and for the first time, list the “trademark application and registration record in other jurisdictions” (Article 10.4) as one of the factors to assess if the mark is well-known in China.

At the same time, Article 10.2, which is another newly added article, says “evidence concerning the duration, manner, and geographical scope of the use of the mark” is another factor to assess the well-known status of a trademark. Compared with Article 10.4, Article 10.2 used a rather implied wording to leave room for passive use and overseas prior use evidence. It can be speculated from these draft revisions that China is now more open to accepting overseas prior use/fame evidence in practice.

#### Conclusion

This article showcased the factors that shall be considered and the current legislative trends for the protection of prior use under Article 32 of PRC Trademark Law. With the *Outline for Building an Intellectual Property Power* coming out, China is committed to improving the protection of intellectual property rights. We saw some efforts and achievements have been made so far, and we trust more measures will be followed to protect overseas brands in the near future.



## Contact

### ZY Partners

Suite 2606, Kuntai International Plaza,  
No.12, Chaowai Street, Chaoyang District,  
Beijing 100020, P.R.China

Tel: +86 10 5879 0066

Fax: +86 10 5879 0088

[www.zypartners.com](http://www.zypartners.com)

 Clarivate™

# Ignite

IP conference  
2024

June 23-26, 2024  
San Diego, CA

## Empowering IP professionals to achieve their full potential



Clarivate Ignite is the annual event for the intellectual property community to come together and learn from their peers and IP experts.

Join the IP community for three days of interactive patent and trademark workshops, educational sessions, panel discussions and networking opportunities.

- Develop your skills and career as an IP professional
- Gain insights from industry experts
- Attend dedicated tracks for your Clarivate software and services
- Deliver more value to your team and your organization

To register, visit: [ignite.clarivate.com](https://ignite.clarivate.com)



# Women in IP Leadership

Celebrating achievements and continuing  
the empowerment of women



Sponsored by



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 Clarivate, who, like *The Trademark Lawyer*, are passionate to continue the empowerment of women. Clarivate's sponsorship enables us to remove the boundaries and offer this opportunity to all women in the sector. We give special thanks to Clarivate 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.

Sponsored by  Clarivate™



“  
**At Clarivate, we connect you to intelligence you can trust to ensure an IP-empowered tomorrow. We know that bringing people together from different cultures and backgrounds, with different life experiences and perspectives, is a key driver of innovation. This is an opportunity to celebrate all talented women around the world of IP and acknowledge their work which has changed the industry to date and look forward to what they and many more women in IP will do for tomorrow.**

”

**Gordon Samson, President, IP, Clarivate**

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.



# Janice Bereskin: Partner, Bereskin & Parr LLP

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

**J**anice Bereskin is a partner and registered trademark agent with Bereskin & Parr LLP. She is the leader of the firm's Trademarks practice group, and a member of the firm's Executive Committee.

Janice's practice focuses on Canadian and international trademarks. She has in-depth experience in search analysis, filing applications, oppositions and cancellation proceedings. Janice manages large trademark portfolios of Canadian and international companies and portfolio management. She offers clients strategic advice for protecting and managing their trademarks in Canada and abroad.

“  
**I also suggest that in addition to a hard work ethic, be sure to carve out time for family, friends, hobbies, and exercise.**

”

Janice was a recipient of the Intellectual Property Institute of Canada (IPIC) Education Foundation Prize for achieving the highest mark overall in the Canadian Trade-mark Agent Examination and has also completed the Intellectual Property Summer Institute (IPSI) program at the Franklin Pierce Law Centre. In 2023, she was named one of the Top 250 leading female IP practitioners by Managing IP.

Janice previously served on INTA's Board of Directors and co-chaired an INTA Presidential Task Force and she is currently a member of INTA's Professional Development Committee. In 2015, INTA honored Janice with the Volunteer Service Award in the Advancement of the Association.

**What inspired your career?**

My father, Dan Bereskin, inspired me to pursue a career in trademarks. I grew up exposed to intellectual property law and I found his work incredibly interesting. I worked at the firm as a university student one summer and that's when I really learned how great the trademark field is to work in – even though I was doing data entry!

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

My pathway was a little different. After graduating university, I attended Franklin Pierce Law School summer intellectual property program and enjoyed meeting people from all over with a shared interest in intellectual property. I found the trademark sessions the most appealing and learned a lot about US law and practice, which I found very helpful back in Canada.

The advice is - not all pathways have to be the same. While there are standard routes from law school, there are less common ways of entering the profession as well. It also helps to have a mentor or friend in the field.

I also suggest that in addition to a hard work ethic, be sure to carve out time for family, friends, hobbies, and exercise. Having a balanced life has been tremendously helpful to me while navigating the ups and downs associated with my career. I had two young children early in my



“  
I have been very fortunate to be at a firm where I am surrounded by other working mothers and supportive colleagues. I also have great clients!”

career and they kept me really busy. I was also a hockey Mom for many years. My outlet was running and playing tennis. In the last few years, it's been walking our dog Charly. I have also been able to share my hobbies and interests with colleagues and clients, which feels like a win-win.

Lastly, I suggest getting involved in IP organizations. Volunteering and giving back to the IP community can be rewarding and beneficial. I was very fortunate to serve on the INTA Board of Directors after being on committees for several years.

**What challenges have you faced, and how have you overcome them?**

I've faced challenges personally and professionally. At a law firm, it can be hard to shine and work in a competitive environment where billings are closely tracked.

It's also a very competitive industry - over the years there have been increased demands to provide faster turn-arounds and increase our capacity. Keeping clients happy, and satisfying the requirements of being an associate or partner at a law firm, can be challenging.

I have been very fortunate to be at a firm where I am surrounded by other working mothers and supportive colleagues. I also have great clients!

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

The first was achieving the highest mark in the Canadian trademark agent exams - although it was several years ago, it really opened a lot of doors for me.

I've also been listed twice amongst the top 250 women in intellectual property, I was greatly honored to be included in that group.

I also served on the INTA Board of Directors and was awarded a Volunteer Service Award.

**What future career aspirations do you have and how will you work to achieve them?**

I've reached a few aspirations already and I've achieved interesting milestones. I'm now the Head of our firm's Trademark Group and I've served on the executive committee, those each came with great challenges that I've overcome. Now, it's about improving our client service and improving the way we do things at work.

Also, I'd actually like to try to balance my work-home life a little bit better. I think I've maybe lost a little bit of the balance.

I'd also like to find ways to help the firm use artificial intelligence. I don't want to replace anyone, but I want to find ways to serve our clients better, to do things faster while retaining the quality of our services. I'm sure AI will provide some help.

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

I've seen a lot of progress with respect to DEI in our field, in Canada but there is still much work to be done.

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

We need to mentor and champion others. As leaders in the field, we have to set an example and make an effort.



Sponsored by



# Donna Short: IP Partner and Head of the Trademark Practice, Addisons

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

Donna Short is an intellectual property (IP) partner and head of the trademark practice at the law firm Addisons in Sydney, Australia. Donna's work with clients involves the entire IP life cycle, from the initial innovation stage, IP protection, commercialization, and enforcement of IP rights. Donna advises clients on a range of areas including trademarks, copyright, domain name disputes, licensing issues, and commercialization agreements. Donna's expertise includes trademark opposition proceedings, and IP litigation. Donna's clients cover a range of industries including food and beverage, technology, financial services, health, and entertainment.

Donna is frequently recognized as a leader in her field, having been consistently ranked in Chambers, The Legal 500, IP Stars, and WTR 1000. Donna has served on a number of INTA committees and is currently serving on INTA's Recession IP Project Team.

**What inspired your career?**

A love of learning has inspired my career. I commenced my career at a small boutique firm that undertook work for clients in the creative industries including film and publishing and this is where my love of intellectual property law was ignited. After three years I moved to a larger national law firm and was seconded to a multi-national IT company. From there my expertise expanded into the area of information technology law but my passionate interest in IP brought me back to working in a law firm in the area of IP.

Prior to joining Addisons, I was Head of the Intellectual Property Practice at the national law firm Henry Davis York, which merged with an international law firm. In 2018, I moved my practice to the independent Australian law firm, Addisons, which has a thriving, top-tier IP practice with four partners that practice in the IP area. Since joining Addisons my practice has gone from strength to strength.

“  
My advice to younger lawyers is that the long road to partnership is sometimes the better road to take if you wish to have a family and take time out with your children.”



“  
**My career aspiration is to continue to grow the IP practice at Addisons and to assist my senior lawyers in building their practices so that one day they may also be partners at the firm.**  
 ”

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

My path to my current position has had a few twists and turns along the way and I have had to face a few crossroads. During the early years of my career, I had a few offers to work in-house as a lawyer and whilst being an in-house lawyer is a dynamic and rewarding role, I made the decision to continue my career in a law firm and to become a specialist in the area of IP. I very much enjoy the collegiality of a law firm and my goal has always been to be a partner.

I have three sons aged 25, 22, and 17, and having children means that your career needs to go on temporary hold whilst you are on maternity leave. After having my second son, I worked extremely hard to build my practice and was on the path to partnership, but I also wanted a third child as I am from a family of five, and five is my lucky number! I was thrilled when I fell pregnant at age 39 with my third son, however my partnership plans were once again put on hold. At the time, I thought that I should be able to do both but the maxim that 'you cannot have everything at once' holds true and in many ways, it was a blessing in disguise. My last maternity leave was a joy, and I didn't have to worry about meeting budgets and keeping my junior lawyers fully utilized. Following my third maternity leave, I worked hard to re-build my practice and I was fully supported by my supervising partner and my group leader (both male partners) to put forward my application for partnership which was unanimously approved by all the partners of the firm.

My advice to younger lawyers is that the long road to partnership is sometimes the better road to take if you wish to have a family and take time out with your children. If you work hard and are passionate about achieving a goal, then you will achieve it.

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

Building a practice and a network of referrers was a challenge I set myself early in my career with the goal of becoming a partner. I recognized early on how important it is to look after my clients, communicate well, and be responsive and commercial in my approach. This strategy has served me well throughout my career, and although these days keeping up with emails in my inbox is a challenge, often calling the client or having a Teams meeting can resolve issues much faster than numerous emails going backwards and forwards.

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

My greatest achievement in my career so far

has been becoming a partner in a law firm and leading an excellent team of IP lawyers. I am also very proud to be acknowledged for my expertise in IP by peers, and well-regarded legal directories, including Chambers, The Legal 500 Asia Pacific, Who's Who Legal, and World Trademark Review. In 2021, I was ranked by Managing Intellectual Property in IP Stars in the Top 250 Women in IP in its global rankings. In 2023, I was ranked in Who's Who Legal as a Global Leader in IP: Trademarks.

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

My career aspiration is to continue to grow the IP practice at Addisons and to assist my senior lawyers in building their practices so that one day they may also be partners at the firm. I also want to continue to be a trusted adviser to my clients and maintain long-term client relationships.

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

At Addisons, 50% of the IP partners are female and there are more female lawyers in the team than male. Addisons is a leader in gender equality, and we have signed the NSW Law Society Charter for the Advancement of Women. The firm strives to be an employer of choice in the legal profession in Australia and is proud to have a diverse and inclusive workplace. I hope for a continued commitment to equality and diversity in the IP industry.

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

Female partners and leaders in the IP sector can empower other women whether it is supporting female lawyers within their own firm or supporting female clients who are in-house lawyers. Both formal and informal mentoring arrangements as well as sharing insights from your own professional experience and knowledge will assist women to rise up to leadership positions.

Sponsored by



Now Exhibiting at Booth 300



- Intellectual Property
- Corporate Law
- Regulatory Affairs
- Tax Law

YOUR EXPERT AI IN:

MARIA

YOUR  
 KEY TO  
 THE FUTURE



# Jurisdictional briefing, Russia: 2024: 30th anniversary of the Eurasian Patent Office

**Dr. Tatiana Vakhnina and Dr. Alexey Vakhnin of Vakhnina and Partners celebrate the upcoming 30th anniversary of the EAPO by detailing the much-anticipated developments of the Eurasian Trademark.**

In September 2024, the Eurasian Patent Office celebrates the 30th anniversary of the signing of the Eurasian Patent Convention.

Over 30 years of active work, the Eurasian Patent Office has been working to increase the number of participating countries and negotiating the entry of new members. The types of industrial property that can be registered in the EAPO is also expanding. At first, designs were added to inventions, and a new registration system for the Eurasian Trademark is currently being actively developed and prepared.

The Eurasian Patent Convention was signed on September 9, 1994, and came into force on August 12, 1995. EAPC allows applicants to obtain regional legal protection along with the national patent registration procedures.

September 09, 2024, marks the 30th anniversary of The Eurasian Patent Organization.

*Eurasian Patent Office (EAPO) is an executive body of the Eurasian Patent Organization, administering the regional patent registration system, covering eight countries of the Eurasian region that ratified the Convention.*

*Dr. Grigory Ivliev has served as the EAPO President since February 11, 2022. Dr. Ivliev is a Former Head of the Federal Service for Intellectual Property (Rospatent).*

To date, the following countries are members of the Eurasian Association: **Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, Tajikistan, Turkmenistan.**

The Eurasian patent system is one of the most successful integration projects throughout the region that has been gradually developed in line with global trends, including cross-border economic links.

## Eurasian Designs are available in seven countries

The recent introduction of Eurasian Designs at the



Dr. Tatiana Vakhnina



Dr. Alexey Vakhnin

EAPO allows applicants to facilitate and improve the protection of their IP rights in the countries of the Eurasian region. At the moment, the Eurasian Designs Protocol has been ratified by seven countries: Armenia, Azerbaijan, Belarus, Kazakhstan, Kyrgyzstan, Russia, and Tajikistan.

Briefly:

- One Eurasian Design application may comprise up to 100 industrial designs that refer to the same Locarno class;
- The procedure of granting a Eurasian patent is quite fast, in the absence of objections from third persons the term for registration may take around four-six months.

An additional advantage of the Eurasian Design System is the fact that an applicant may file a single application comprising several designs referring to the same class, thus reducing the prosecution costs.

## EAPO digitalization

The EAPO is a highly digitalized IP Office, including the paperless patent workflow implemented in 2015. Furthermore, in 2022, the EAPO initiated granting electronic titles of protection that are available in users' personal accounts, as well as on the web portal.

The EAPO has adapted the processing and examination of applications, as well as administrative procedures, taking into account digital technological capabilities. Further, the EAPO has developed and enhanced its information systems to make e-services as convenient as possible to meet the needs of applicants.

Thanks to digitalization and modern technologies, paperwork is greatly accelerated, and applicants and patent holders from many countries of the world note the speed of work and professionalism of the Patent Office.

## Eurasian Trademarks

The project of Eurasian Trademarks is one of the most popular and frequently discussed topics in IP in the Eurasian space. It is also the most anticipated change that will help trademark owners from all around the world register a single trademark that will be valid in several Eurasian countries at once.

The Eurasian Trademark and Appellations of Origin Registration System will provide new opportunities for trademark owners. The System is a regional system to help trademark/brand owners to file trademarks to be registered in all of the countries of the Eurasian Economic Union (EAEU). The convenience of this system is to file only one single trademark application to the national patent office of one of the Eurasian member states.

The Eurasian Trademark Registration system will provide applicants with several significant advantages, including:

- Filing a single trademark application for all EAEU countries;
- Significant reduction in registration costs, compared to filing separate applications to all countries of the Eurasian Economic Union;
- Fast registration, currently estimated at eight months.

The estimated duration of registration is expected to be within eight-12 months, however, it can be longer if a National Patent and Trademark Office requests additional documents or information for verification. It is worth mentioning that the estimated registration period is shorter than the trademark registration in the national Patent Offices or via the Madrid System.

If the registration is granted, the Eurasian Trademark will be automatically registered in all the EAEU states.

The Eurasian Trademark will be valid for 10 years starting from the date of filing the application, and it will be possible to renew the Eurasian Trademark an unlimited number of times.

Any interested third party may attempt to cancel the Eurasian trademark due to non-use within three years from the date of its registration on the territory of each EAEU country.

The license agreement for the Eurasian trademark should be registered with the national office of the EAEU member state in which the right to use the trademark is granted, and the transfer of the exclusive right to the Eurasian trademark must take place on the territories of all EAEU member states simultaneously.

## Résumés

**Dr. Tatiana Vakhnina** is a Senior Partner and Founder of Vakhnina and Partners, Eurasian Patent Attorney, Patent and Trademark Attorney of the Russian Federation with extensive experience in IP since 1970s.

Tatiana is one of the first registered Eurasian Patent Attorneys with reg. No. 38.

*Tatiana is an Honorary Advocate of the Russian Federation, an active member of a number of Russian and International IP Organizations and the professional community of Patent Attorneys in Russia.*

**Dr. Alexey Vakhnin** is a Co-Founder, Partner, and Managing Director of Vakhnina and Partners. He is a Eurasian Patent Attorney, Patent and Trademark Attorney of the Russian Federation, with extensive experience in IP since the 1990s.

Alexey is a member of the Eurasian Patent Attorneys Assembly (EPAA), FICPI, AIPPI, LESI, INTA, ECTA, PTMG etc.

Having a PhD in Medicine (Biochemistry and Immunology), while working on patent matters, Alexey specializes in Medicine, Biotechnology, Biochemistry, Pharmacology, and Pharmaceuticals.

At the moment there are five member-states of the Eurasian Economic Union where the Eurasian Trademark will be available for filing and registration: Armenia, Belarus, Kazakhstan, Kyrgyzstan and Russia.

## Users of the Eurasian Patent System

The Eurasian regional system, with its huge geographical coverage, is being used by applicants from 133 countries around the globe.

The top-filing applicants are the USA, Russia, and European states. As of today, the EAPO has received more than 72,000 patent applications for inventions. Annually, more than 3,600 applications are filed and more than 2,700 patents have been granted for inventions.





Among the EAPO Member States, the most active applicants represent Russia, Belarus, and Kazakhstan. China ranked fifth in Eurasian patent applications for inventions in 2022, reflecting a recent increase in patent activity.

The vast majority of applications, around 80%, entered the regional phase under the PCT procedure. Since July 1, 2022, the EAPO has been functioning as an International Searching Authority and a Preliminary Examining Authority under the PCT, which allows international applications to go through the entire lifecycle of the examination process within the regional office.

From June 1, 2021, the filing of applications for industrial designs is available, though the system is still under development.

**High quality is confirmed by 30 years of EAPO service**

The Eurasian patent is a strong one since it is granted following the patent search and substantive examination procedures with a relevant decision. To guarantee the impartiality and quality of the examination results, the decision to grant a patent or refuse the application is taken by three different experts, each representing a different EAPO Member State. The Eurasian Patent Office implements additional activities to ensure

**Contact**

**Vakhnina and Partners**

**Moscow office**  
Preobrazhenskaya pl., 6, Moscow, Russia, 107061.  
ip@vakhnina.ru  
www.vakhnina.ru

**Yerevan office**  
Republic of Armenia, Yerevan 0028, str. Kievyan, 4.  
office@vakhnina.am  
www.vakhnina.am

**Bishkek office**  
Kyrgyz Republic, 720044, Bishkek, Sevastopolskaya 20.  
kg@vakhnina.com

diversity and the widest possible geographical representation at the EAPO. EAPO has an opportunity to involve the best experts and examiners from all EAPO Member States.

The quantity of opposition remains extremely low due to the management of examination quality and the opposition and appeal system at the EAPO system. Overall, the EAPO revokes around 0.04% of patents a year under the invalidation procedure.

*Patent and Trademark Attorneys at Vakhnina and Partners will be pleased to assist you and your clients, if you have any questions or inquiries on IP matters in EAPO, Russia, Armenia, and other Eurasian countries. Our specialists in Moscow (Russia, ip@vakhnina.ru), Yerevan (Armenia, office@vakhnina.am) and Bishkek (Kyrgyzstan, kg@vakhnina.com) offices are ready to provide more information on your request.*

**VAKHNINA & Partners**

Trademarks Patents Designs Utility models

ip@vakhnina.com  
www.vakhnina.com  
+7-495-946-7075



**Dr. Tatiana Vakhnina**

Specializes in trademarks, and patents in mechanical and electrical engineering.



**Dr. Alexey Vakhnin**

Specializes in Medicine, Biotechnology, Biochemistry, Pharmacology, Pharmaceuticals.



**Dr. Elena Utkina**

Specializes in Chemistry, Biochemistry, Pharmacology, Pharmaceuticals.

**EAPO | Russia | Armenia | Azerbaijan | Belarus | Georgia | Kazakhstan  
Kyrgyzstan | Moldova | Tajikistan | Turkmenistan | Uzbekistan**

**Contacts:** Russia: ip@vakhnina.com Armenia: am@vakhnina.com Kyrgyzstan: kg@vakhnina.com

Our attorneys are members of INTA, FICPI, AIPPI, LES Russia/LESI, PTMG, ECTA, Chamber of Russian Patent Attorneys

**GOODRICH  
RIQUELME  
ASOCIADOS**

MULTIDISCIPLINARY LAW FIRM OFFERING TAILORED SOLUTIONS TO YOUR BUSINESS SINCE 1934.

**COMMITTED TO  
EXCELLENCE**

**CONNECTED TO  
PEOPLE**

**ENRIQUE DÍAZ**

TEL: +52 55 5525 1422

E-MAIL:

EDIAZ@GOODRICHRIQUELME.COM

**GUILLERMO SOSA**

TEL: +52 55 5207 7561

E-MAIL:

GSOSA@GOODRICHRIQUELME.COM

**JUAN SUÁREZ**

TEL: +52 55 5207 9261

E-MAIL:

JCSUAREZ@GOODRICHRIQUELME.COM

**JULIO PRIETO**

TEL: +52 55 5207 8183

E-MAIL:

JPRIETO@GOODRICHRIQUELME.COM

**GOODRICHRIQUELME.COM**

# Jurisdictional Briefing, US: specimen requirements of the United States Patent and Trademark Office

**Nancy Kennedy and Farzad Panjshiri of Cantor Colburn detail the requirements for goods and services alongside the rules for submitting specimens at the USPTO to protect trademarks and service marks.**

The United States Patent and Trademark Office (USPTO) requires evidence that a mark is "used in commerce" to obtain and maintain a trademark registration in the United States. Applications based on foreign registration or Madrid Filings are an exception and must provide such proof of use only five years after registration. All post-registration maintenance filings (after five years and every 10 years) must contain proper specimens with the Declaration of Continuing Use.

A "specimen" is evidence proving that a mark is used in US commerce. This article provides general requirements for specimens, but numerous exceptions exist - including industry standards, the type of the mark, and the particular goods and services - that can impact these general specimen rules.

## Specimen requirements for goods

The Lanham Act indicates that a mark is used in connection with goods in International Classes 1 to 34 if "it is placed in any manner on the goods or their containers or the displays associated therewith or on the tags or labels affixed thereto." See 15 U.S.C. § 1127.

This means the specimen must show the mark affixed to the goods, namely on the product itself, on a label/tag attached to the product, on the packaging or container of the product, on a website where the goods can be purchased, or on a display in a store presented with the



Nancy Kennedy



Farzad Panjshiri

physical products.

## Specimen requirements for services

According to the Lanham Act, a mark is used in connection with services in International Classes 35 to 45 if "it is used or displayed in the sale or advertising of services and the services are rendered in commerce, or the services are rendered in commerce." See 15 U.S.C. § 1127.

This means the specimen must show the service mark on any advertisement, brochures, websites, business signs, invoices, vehicles, or any other promotional material where the services are advertised, sold, or rendered. The specimen must present the service mark in "direct association" with the services.

## USPTO's rules for submitting specimens

Specimens submitted to the USPTO should follow these guidelines:

- At least one specimen per International Class must be provided.
- Do not submit physical evidence to the USPTO, a copy or picture of the evidence is sufficient.
- The mark on the specimen must be a "substantially exact" representation of the application/registration.

- The specimen must demonstrate a real marketplace example and use of the mark in commerce (not digitally created or altered, and no mock-up).
- The mark must be prominently visible on the specimen to function as a mark and have source-indicating properties.
- The specimen must show the applicant's or a licensee's use of the mark.
- The mark on the specimen should be in close proximity to the goods/services.
- Specimens consisting of website screenshots must show the URL and the date accessed on the specimen.
- Lastly, the appropriate type of specimen must be chosen for goods or services, as discussed above.

The comprehension of the above rules and guidelines is essential to navigate US trademark law and this unique creature of "specimens." Knowledge of specimen requirements will help attorneys guide trademark owners in obtaining, maintaining, and enforcing a US trademark or service mark.

## Résumés

### Nancy Kennedy, Partner

Nancy manages domestic and international trademark, copyright, trade dress, domain name, and other cyberlaw matters. She concentrates her practice on conducting trademark clearance searches and rendering opinions on availability and registrability; prosecuting applications for registration at the US Patent and Trademark Office and the US Copyright Office; recording registrations with the US Department of Homeland Security Office of Customs and Border Protection; and representing clients in disputes before the Trademark Trial and Appeal Board.

Author email: [nkennedy@cantorcolburn.com](mailto:nkennedy@cantorcolburn.com)

### Farzad Panjshiri, Associate

Farzad is an experienced trademark and copyright attorney who fights passionately for the intellectual property rights of his clients. He has extensive experience in trademarks, copyrights, and other intellectual property rights, emphasized by his Master of Laws (LLM) degree in US Intellectual Property Law, his German Law degree, as well as his international and domestic legal experience. Farzad concentrates his practice on all areas of trademark prosecution, enforcement, and litigation before the US Patent and Trademark Office. He has been counseling individuals, small and midsize businesses, as well as large multinational companies, on trademark and copyright matters.

Author email: [fpanjshiri@cantorcolburn.com](mailto:fpanjshiri@cantorcolburn.com)

## Contact

### Cantor Colburn LLP

20 Church Street, 22nd Floor, Hartford, CT 06103-3207 USA

Tel: +1 860 286 2929

[contact@cantorcolburn.com](mailto:contact@cantorcolburn.com)

[www.cantorcolburn.com](http://www.cantorcolburn.com)





# Your ideas are worth protecting

Have you secured your IP rights when entering new markets? We have helped companies protect their business-critical intellectual property for over 45 years.

Want to hear more?

[www.papula-nevinpat.com](http://www.papula-nevinpat.com)

PAPULA  NEVINPAT  
YOUR EXCLUSIVE RIGHT

## The landscape of IP rights in Russia amidst geopolitical tensions

**Riikka Palmos, European Trademark Attorney at Papula-Nevinpat, provides an update on the IP landscape for foreign filers in Russia, drawing on recent case decisions to answer important questions.**

The invasion of Russia into Ukraine in 2022 and subsequent events have raised numerous questions and uncertainties among intellectual property rights (IP) holders. Instances of bad faith applications, unauthorized use of foreign trademarks, and restrictions on exclusive rights due to sanctions and counteractions have undermined confidence in the entire IP system. Many question the availability, legality, and necessity of IP protection in Russia. Moreover, trust in the Russian judicial system is also in question. The current situation begs the question: where do we stand today?



Riikka Palmos

### IP rights can be protected and maintained

Despite the ongoing sanctions and geopolitical tensions, the protection, maintenance, and enforcement of IP rights continue normally. The legal framework governing IP rights remains intact and no new restrictions on exclusive IP rights have been imposed just recently. The Russian patent office continues to operate normally and there are no significant changes in the patent office's practices or decisions. Also, no discrimination based on the nationality of the applicants has been reported.

Although the protection of IPs itself continues smoothly, there are still challenges to beat. Russia hasn't declared a state of war and thus no force majeure rules are applicable. Original documents are still required although no international courier services are operating in Russia. Additionally, financial restrictions complicate payments to Russia even if the IP protection is free from sanctions.

### International trade with Russia continues

Surprisingly, international trade with Russia continues despite the imposition of many sanctions

in different fields. Foreign products remain accessible in the market, even from companies leaving the country. Some companies even appear to have re-entered the market, while others have implemented various strategies to maintain their presence, including business arrangements, cooperation agreements, and licensing agreements.

Due to sanctions on transportation, there has been a significant increase in new entry routes for the import of goods to Russia, such as imports from Kyrgyzstan, which have surged by over 800%. Additionally, a considerable volume of goods is now reaching the Russian market through transportation routes via Kazakhstan and Georgia. Additionally, the Eurasian Economic and Customs Union, comprising Armenia, Kazakhstan, Kyrgyzstan, Belarus, and Russia, facilitates the free movement of goods into Russia through member states.

### Résumé

**Riikka Palmos** is a Master of Laws and European Trademark Attorney in the Head Office of patent and trademark agency Papula-Nevinpat in Helsinki. She joined Papula-Nevinpat in 1995, and she is a senior partner in the company.

Riikka has 28 years of experience in IP protection especially in trademark laws and practices. Riikka has specialized in trademark legislation and practices in Eurasia, including Russia and Ukraine. She has wide experience in trademark prosecution and litigation issues as well as license and assignment agreement drafting in the region. Riikka has very closely monitored the IP situation in Russia and Ukraine since the invasion.

“The ongoing conflict and evolving geopolitical dynamics pose challenges for IP rights holders.”





Accordingly, foreign products reach Russian consumers through various channels, including parallel imports, online store orders, and purchases made by private individuals abroad. However, there has also been a noticeable shift in consumer preferences, with many foreign brands being replaced by local alternatives.

Additionally, the void left by departing foreign companies from the Russian market has been filled by new players, particularly from Asia and Turkey. Local businesses are also capitalizing on the opportunity, leading to increased competition and new challenges for retailers and distributors.

### What should IP rights holders be aware of?

While the current IP situation in Russia appears relatively stable, uncertainties persist. The ongoing conflict and evolving geopolitical dynamics pose challenges for IP rights holders, necessitating vigilance and proactive measures to protect and defend their rights or at least to be aware of the existing circumstances.

Local parties are increasingly frustrated with the current situation where many former partners have ended their cooperation – local parties are eager to take over foreign businesses. This trend is particularly evident among local retailers and distributors, who are actively seeking to assume control of businesses previously held by foreign companies. Additionally, there has been a notable surge in non-use cancellation actions targeting foreign trademark registrations, as well as a rise in consent requests from Russian applicants seeking to register trademarks similar to those of foreign rights holders.

Furthermore, unauthorized use of foreign trademarks is on the rise, presenting a challenging scenario. While the patent office and courts operate within legal frameworks and issue valid decisions, many local companies and individuals attempt to exploit the situation for their own gain. Although many foreign companies no longer operate in Russia, their interest in defending the existing rights is increasing while the conflict is ongoing.

To safeguard trademark rights in this complex landscape, foreign companies must be vigilant. This involves monitoring the market, obtaining evidence of the infringement (video purchases of infringing products, notarizing web pages), sending cease and desist letters, and, if necessary, pursuing legal action through filing infringement actions. As the conflict situation develops, the IP rights holders must be prepared quickly to adapt to new and changing circumstances.

### Case Bosch



“ Many local companies and individuals attempt to exploit the situation for their own gain. ”

The case of Robert Bosch GmbH (Bosch) exemplifies the complexities faced by foreign companies operating in Russia. Despite withdrawing from the Russian market, Bosch remains committed to safeguarding its IP rights. Bosch's proactive approach includes filing numerous infringement claims against individuals and companies involved in trademark infringement and unauthorized sales of counterfeit products.

Bosch serves as a notable example of a company that has withdrawn from the Russian market while steadfastly dedicated to safeguarding and defending its intellectual property rights. Despite the closure of its Russian factories and cessation of deliveries to the country, Bosch's products continue to circulate within the Russian market. Among these products, some are original parallel imports, which Bosch is unable to contest under current legislation, while others are blatant counterfeits.

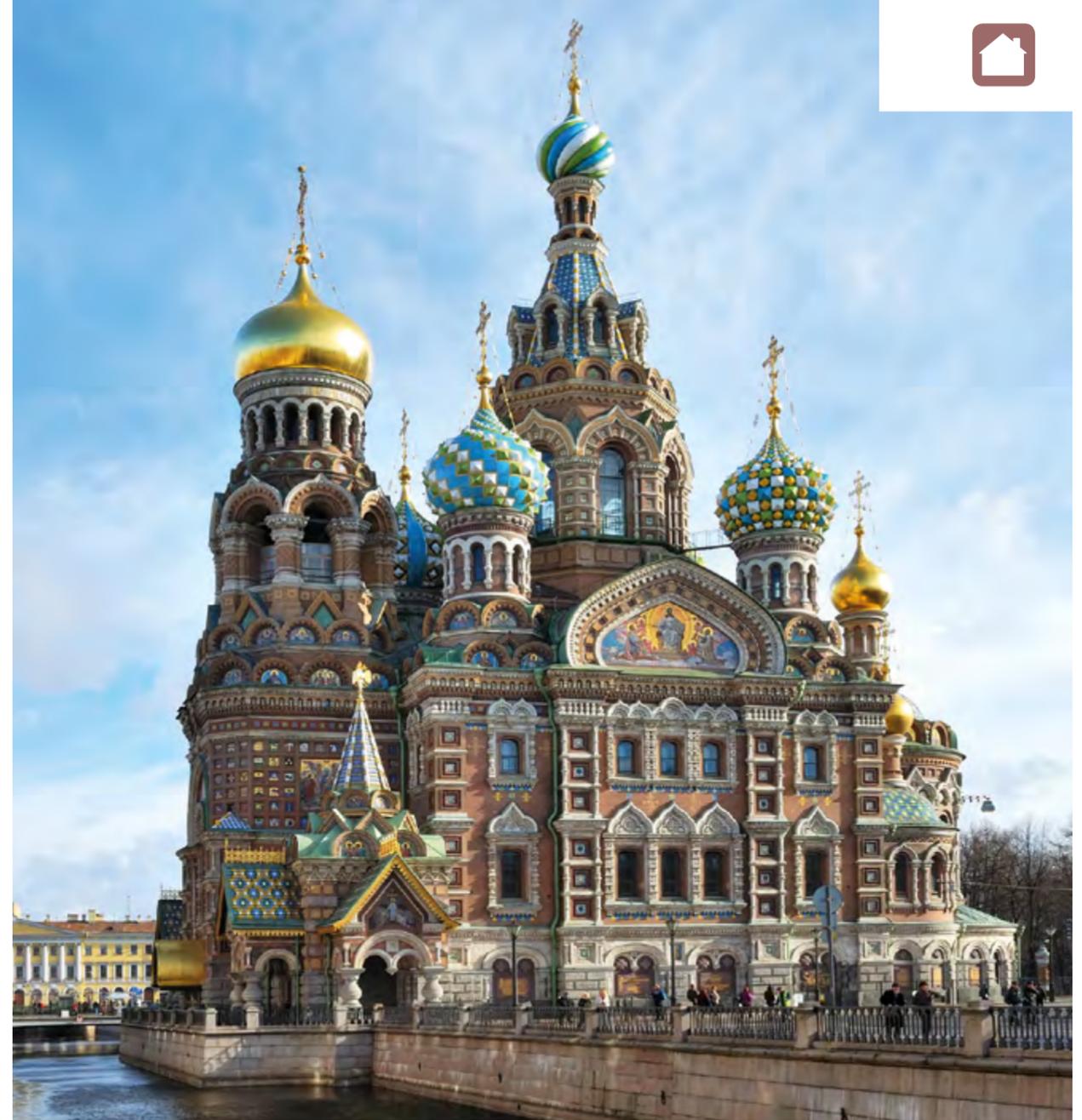
The departure of Bosch from the Russian market has led to an increase in the importation of both authentic and counterfeit Bosch products. Notably, Bosch is among the companies whose products can currently be imported into Russia without the right holder's permission, as listed on the parallel import list. However, this reality hasn't deterred Bosch from actively combatting counterfeit goods.

In response to the situation, Bosch initiated over 100 infringement claims last year in Russia against various defendants, ranging from individuals to companies such as car dealerships and spare parts sellers. These claims primarily focused on trademark infringement, addressing the unauthorized use of Bosch's trademarks. The objective extends beyond mere financial compensation; Bosch seeks to eradicate counterfeit goods from the market altogether.

Many of Bosch's legal actions involving obvious counterfeit goods are resolved through summary judgment, resulting in settlements favoring Bosch without the need for a full trial. Bosch's legal endeavors are aimed at maintaining control over its brands and preventing the unauthorized sale of counterfeit products bearing its esteemed name, even after the company departs from the country.

### Recent IP Court decisions affirm legal system integrity

Despite uncertainties and exceptional circumstances, recent court decisions confirm that the legal system is functioning properly. Courts issue legal decisions and respect international IP treaties. Many recent decisions highlight that providing legal protection to trademarks from unfriendly countries does not contravene the national interests of the Russian Federation, as often claimed by the local parties. Additionally,



the Courts affirm that the inclusion of countries in the list of unfriendly countries by the government does not preclude such companies from defending and enforcing their intellectual property rights in Russia.

The following three recent reassuring Court case examples involving conflicts between local and foreign entities affirm the current court practice of respecting legal norms, consumer protection, and the importance of upholding ethical standards in business practices.

### Case SORMEC

The IP Court issued a significant ruling on October 10, 2023, in the SORMEC case (N SIP-684/2023), highlighting the complexities of IP rights protection in the country. The case involved a legal dispute between Italian company SORMEC s.r.l. and Russian company SALITACO over the registration of the "SORMEC" designation. Despite SALITACO's appeal, the court upheld the rejection

of their application, emphasizing consumer protection and the association of the designation with SORMEC s.r.l., even in the absence of direct business operations in Russia.

### Case LATISSE

# Latisse

The recent ruling by the Supreme Court of Russia (case CIP-457/2023) affirmed the validity of foreign trademark rights, even when the respective company has withdrawn from the Russian market. This landmark decision arose from the case of Beautymarket LLC's trademark application for "Latisse," which was rejected by the Patent office due to potential confusion with the well-known product of the US company Allergan, Inc. Despite Allergan, Inc.'s trademark expiration in 2019, the widespread recognition of their product in Russia raised concerns about consumer confusion.



The IP Court questioned the notoriety of the products and overturned the rejection decision of the patent office, but the Presidium of the IP Court ultimately ruled against Beautymarket LLC, citing the recognition of Latisse cosmetics by Russian consumers and the availability of online information. The Supreme Court upheld this decision on February 16, 2024, affirming the refusal to register Beautymarket LLC's trademark.

The decision is extremely interesting, especially as it was the patent office that appealed the first-instance court decision. The US company was never a part of the proceedings, and the patent office was not forced to appeal – but it still did it at its initiative.

#### Case SHAIRIN

In a ruling dated August 22, 2023, the IP Court addressed a case involving a Russian company's claim for compensation against a competitor for the unauthorized use of a similar trademark, "SHAIRIN," in the importation of products from Korea. The court dismissed the plaintiff's claim, recognizing their actions as being in bad faith. It was evident that the plaintiff knowingly adopted a trademark similar to that of a foreign manufacturer without obtaining permission and used it to hinder the sale of the competitor's goods in Russia.

Crucially, the original trademark holder did not engage in commercial activities using their trademark, further underscoring the plaintiff's bad faith intentions. This decision reaffirms the importance of conducting business in good faith, respecting IP rights, and resolving trademark disputes with fairness and integrity. It serves as a reminder that deceptive practices will be held accountable under the law, emphasizing the need for businesses to uphold ethical standards and legal requirements to safeguard the integrity of the marketplace.

#### Case Carlsberg



Unfortunately, not everyone is as lucky, and the countermeasures of the sanctions have also targeted foreign companies. One such case, case Carlsberg (A56-99747/2023) deserves closer attention. The case is not purely a trademark case but also includes other business aspects, such as Carlsberg's right to sell their local business as a result of their departure from Russia.

After the assets of the Russian Federation and Russian legal entities and individuals began to be seized abroad based on sanctions against Russia, Russia issued Presidential Decree No. 302 "On Temporary Management of Certain Property" on 25 April 2023.

“**The Courts affirm that the inclusion of countries in the list of unfriendly countries by the government does not preclude such companies from defending and enforcing their intellectual property rights in Russia.**”

The essence of the decree is that if Russian property is arrested or seized in country A, then in Russia, the property of companies from country A may be placed under the temporary management of the Federal Agency for State Property Management. In practice, this means that foreign ownership interests in company management are temporarily transferred to authorities to safeguard the local interests. The temporary manager's authority does not extend to the sale or transfer of the company's property; rather, it aims to inventory and ensure the safety of the assets under temporary management. This includes the company's equipment, real estate, and intellectual property, which cannot be sold through separate transactions.

On July 16, 2023, President Putin issued a decree ordering that Carlsberg's stakes in company management of Baltika Brewery be temporarily transferred to authorities without altering ownership. This measure suspended Carlsberg's right to make management decisions on the sale of the business. Carlsberg lost control over their shares, but the property has not been sold or transferred, at least for now. This also applies to their trademarks.

The case also involves trademark licenses, namely Baltika Breweries had registered licenses to use Carlsberg trademarks. After the issuance of the decree on temporary transfer of the management to Authorities, Carlsberg terminated these licenses, including those for Carlsberg, Seth Riley's Garage, Holsten, Kroonenberg, and Tuborg. Baltika Brewery in turn challenged the termination in court. In December 2023 the court ruled the termination of licenses unlawful, resulting in the freezing of Carlsberg's stake in Baltika Brewery. Consequently, Baltika Brewery retained the right to use the trademarks for the time being.

Carlsberg is obviously irritated and this case clearly undermines confidence in Russia's actions towards foreigners. The question arises as to what the next step in the treatment of foreign assets is. However, it is still reassuring that the general attitude towards IP rights has remained relatively respectful. What the future will bring is, however, difficult to predict.

#### Contact

##### Papula-Nevinpat

Mechelininkatu 1 a  
00180 Helsinki (Ruoholahti), Finland

**Tel:** +358 9348 0060

**Fax:** +358 9348 00630

##### Author email:

riikka.palmos@papula-nevinpat.com

www.papula-nevinpat.com

LATIN AMERICAN LEADING LAW FIRM

WWW.VERAABOGADOS.COM



INTELLECTUAL PROPERTY - CORPORATE LAW - FOREIGN INVESTMENT



COLOMBIA

PRAGMA | INTERNATIONAL NETWORK OF LAW FIRMS PARTNERS

INFO@VERAABOGADOS.COM





# The Olympic Games and the protection of intellectual property

**Vanessa Rondeau, Associate at Uthoff, explains the principles of ambush marketing in advance of the 2024 Olympic Games to provide guidance on what to look for to protect and profit from relevant IP.**

The Olympic Games are the largest sporting event in the world, as it gathers more than 200 countries to celebrate sports, fair play, and global unity. Organized every four years, the Games are indeed a time to recognize the elite of the sports world, but they also stand as the event that promotes friendship and diversity.

While sports fans fervently await the launch of this year's Olympic Games in Paris, the protection of intellectual property plays a crucial role behind the scenes.

As for any major sports event, companies around the world try to obtain brand exposure during the Games, using in some cases, without authorization, the Olympic symbol, but also creating marketing strategies to gain publicity and other benefits.

The intellectual property system therefore plays a significant role in safeguarding the use of the Olympic identifications, as the Olympic symbol, emblems, flag, torch, and anthem.

The Olympic symbol is protected under the Nairobi Treaty. This treaty was adopted on



Vanessa Rondeau

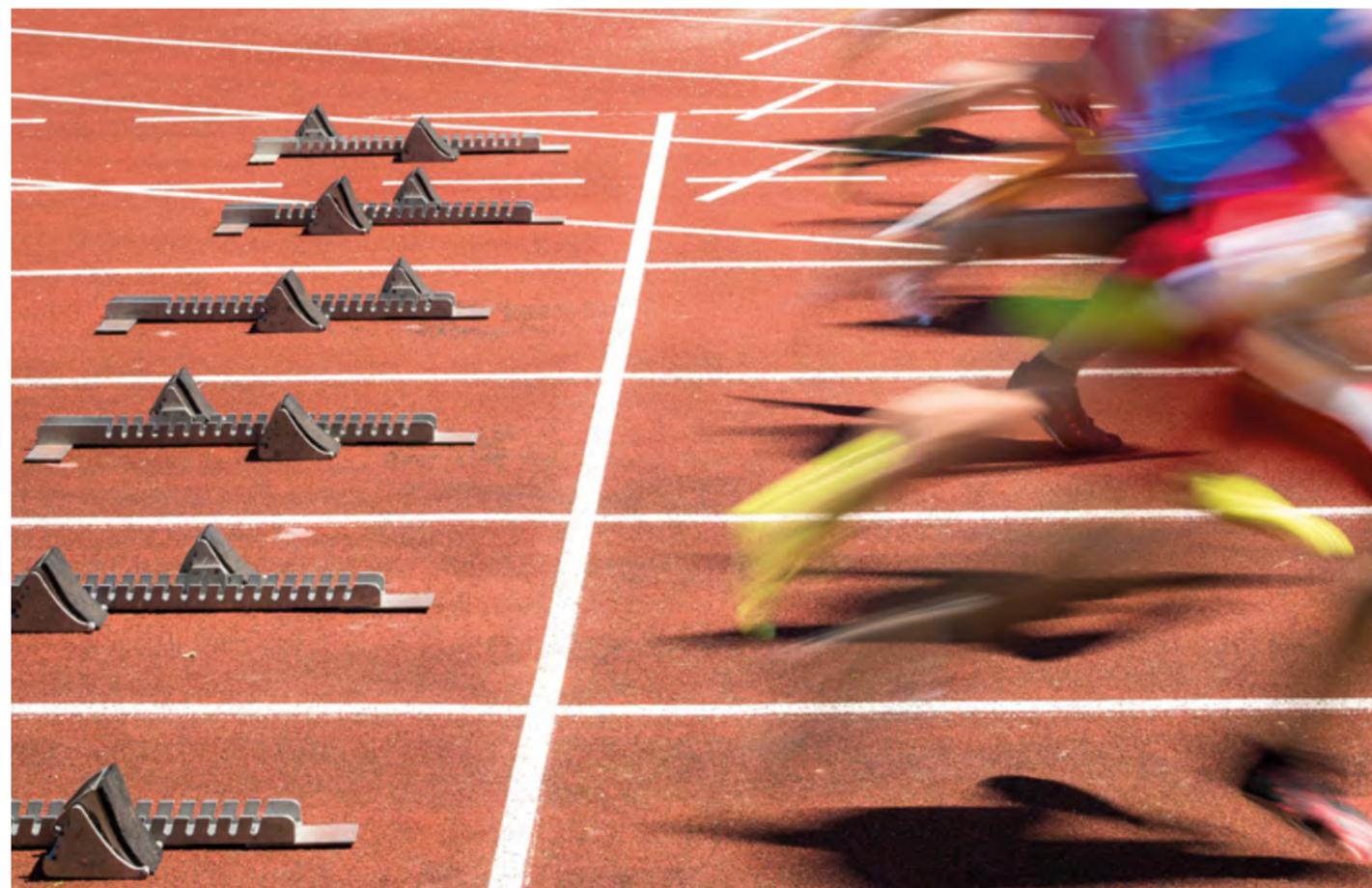
September 26, 1981, and is administered by the World Intellectual Property Organization. It establishes that any State party is under the obligation to protect the Olympic symbol - five interlaced rings - and shall therefore refuse or invalidate the registration as a mark that contains the Olympic symbol. In addition, the treaty sets the prohibition of using the Olympic symbol for commercial purposes, without authorization.

Still, there are two exceptions to the obligation. First, if a mark that contains the Olympic symbol was registered prior to the date on which the treaty entered into force, the obligation is considered suspended. The second exception is related to the continued use of the Olympic symbol, and it states that any person or enterprise that lawfully started using a mark prior to the date on which the Treaty entered into force is still authorized to use the Olympic symbol.

The International Olympic Committee holds all the rights to the Olympic Properties, as well as the rights to the use thereof, including the use of profit-making, and has developed strategies to uphold its rights. The International Olympic Committee may however grant license of its rights under some conditions.

Given the financial success of the Games, non-sponsor companies have tried to obtain benefits that have led to intellectual property infringement, including trademark and copyright infringement, but also counterfeiting, which is probably the most common type of infringement surrounding the Games.

The protection of IP rights of each edition of the Olympics usually starts a decade prior to the set date of the event, and several trademarks are registered. For this 2024 Games, marks including "PARIS 2024", the medal and torch designs, and



mascot images and names were registered, which sums up to the protection of the Olympic symbol, the Olympic motto "Citius, Altius, Fortius" (Faster, Higher, Stronger) and the Paralympic motto "Spirit in Motion", among others.

Any identical or similar commercial use of the Olympic names, symbols, or signs will most likely be objected to by the International Olympic Committee on the basis that it is confusingly similar to some of its prior trademark registrations. Thus, if a company affixes an Olympic sign on its products or promotes goods and services using Olympic signs, such use could be sanctioned. This also applies to advertisements on social media, which are now commonly used for promoting goods and services.

The Official partners are the only companies that are entitled to use the Olympic symbols and other identifications for commercial purposes, and they have paid substantial sums of money to obtain this privilege. Still, some companies tend to create, without authorization, advertisements related to the Olympic Games and use Olympic identifications in an attempt to gain exposure and profits.

This practice is called "ambush marketing", and is also known as "guerilla", "parasitic" or

“During the Atlanta Olympic Games in 1996, Reebok won the sponsorship, however, it was not recognized as such by the public due to the creativity of Nike in advertising its products.”

## Résumé

**Vanessa Rondeau**

Vanessa has been an Associate at Uthoff in Mexico since 2019, where she is part of the Trademarks Department. Her practice is based on the registration, maintenance, and enforcement of Trademarks, Slogans, and Trade Names, both on domestic and international levels.

She holds a Bachelor's Degree in Law and Foreign Languages from the University of Nantes, France. She also holds a Master's Degree in International and European Business & Competition Law from the Catholic University of Lille.

Author email: [vrondeaug@uthoff.com.mx](mailto:vrondeaug@uthoff.com.mx)



"coattail" marketing. Ambush marketing can be defined as the practice of attempting, through marketing activity, to take advantage of a major event, by associating itself with the event, without permission of sponsorship rights. The purpose is to gain exposure and profit, but also, create public confusion on who is the real sponsor of an event. Any event can be targeted by ambush marketers, as music festivals, but it affects mainly sporting events.

Ambush marketing has been considered an effective marketing tool for several companies around the world as they can gain profit without incurring all the expenses of an official sponsorship or endorsement.

Although there are different types of ambush marketing, the main practices are known as predatory ambushing, ambush by association, and ambush by intrusion. A practice is considered predatory ambushing when an advertisement directly attacks its competitor and tries to sabotage it, while the ambush by association is less aggressive, as a company attempts to associate itself directly with the event without attacking the competitor. By using this practice, companies seek to mislead the consumer into thinking that they are connected with the event by making direct reference to the same.

Marketing by intrusion consists of gaining brand exposure during an event by distributing, outside of a controlled area, products or flyers to fans as they arrive at an event, or surrounding the event, for example.

“**In some cases, putting their business at risk of an infringement action results in more profitable outcomes.**”

Several cases involved ambush marketing over the last Olympic Games. The first case was exposed at the Los Angeles Games in 1984, when Converse had the official sponsorship but during the Games, Nike ran several advertisements with athletes, associating itself directly with the Games. Research found that the consumer thought that Nike was the official sponsor, and not Converse.

The same year, Kodak, which had lost the sponsorship to its direct competitor Fuji, sponsored the television broadcasts of the Games and the US track team. By doing so, Kodak's advertisements were seen by more people than the live events, including Fuji's campaign, and it caused confusion as to which company was the official sponsor. Although Fuji considered this practice unfair, there was no ban preventing Kodak from running its ads during the event.

Then, during the Atlanta Olympic Games in 1996, Reebok won the sponsorship, however, it was not recognized as such by the public due to the creativity of Nike in advertising its products. Besides distributing flyers and running TV commercials featuring athletes, Nike was the official sponsor of sprinter Michael Johnson who took the gold medal with a pair of gold-colored Nike shoes. Not only did millions of viewers see the Nike shoes on the screen during the competition, but they also saw them on the cover of Time a few days later. This led the consumer to think that Nike was the official sponsor.

This marketing practice by Nike also resulted in the International Olympic Committee taking more severe guidelines against this type of marketing, although it may not have been as effective as expected.

During the London Olympic Games in 2012, Adidas was the official sponsor and spent millions of dollars on advertisement. Moreover, the International Olympic Committee created strict rules, such as prohibiting any third party from using "LONDON 2012" or "LONDON OLYMPICS", for example. Still, once again Nike launched several TV campaigns featuring athletes and the slogan "Find your greatness" during the Olympic Games. Nike used this campaign to connect with consumers by celebrating the human body and the great things people can accomplish, as acts of kindness and bravery. They also associated their campaign for new Volt running shoes with worldwide athletes.

When the Games ended, Nike's Campaign resulted in more profits than Adidas' Campaign, and the public also associated Nike as the sponsor, instead of Adidas.

The International Olympic Committee tried to limit these practices by adopting Rule 40 of the Olympic Charter. The Olympic Charter is defined as "the codification of the fundamental principles

of Olympism" and Rule 40 prevents athletes who are competing in the Games from appearing in advertising during the Games period without the permission of the International Olympic Committee. In case of infringement of this rule, athletes risk disqualification.

Some guidelines have also been published for social and digital media posts. While the guidelines allow athletes and other individuals to take content at the Olympic Games, such as photographs and videos using their mobile phones and publish them on social media, this practice is not authorized for commercial purposes. It is also prohibited to share live footage or any videos that are longer than two minutes in duration.

Moreover, hosting cities are required to take measures to protect the Intellectual Property of the Games, and it also includes protection for official sponsors. Ambush marketing is not punishable as such under French law – hosting country of the "Paris 2024 Olympic Games" – however, several laws may apply to protect sponsors against ambush marketing, as the Intellectual Property Law, for trademark infringements, and the consumer law, for misleading commercial practices, among others.

Although several guidelines and Laws have been adopted around the world to protect the

“**Hosting cities are required to take measures to protect the Intellectual Property of the Games.**”

IP rights of the Olympic Games and prevent ambush marketing, non-sponsor companies still find alternatives to promote their goods and services and create campaigns that allow them to gain exposure during international sporting events, and in some cases, putting their business at risk of an infringement action results in more profitable outcomes. The Paris 2024 Olympic Games promises to be the field of another major sporting event surrounded by creative marketing techniques.

## Contact

### Uhthoff

Av. Paseo de la Reforma #509,  
22 floor 06500, Cuauhtemoc,  
Mexico City, Mexico  
[www.uhthoff.com.mx/en/](http://www.uhthoff.com.mx/en/)

UHTHOFF:  
**YOUR GLOBAL PARTNER**  
IN THE PROTECTION OF  
**INTELLECTUAL PROPERTY RIGHTS**

[uhthoff.com.mx](http://uhthoff.com.mx) | [f](#) [@](#) [in](#) [X](#)



# Current trends and practices for anti-counterfeiting in e-commerce in Russia

**Anton Bankovsky, Counsel at Gorodissky & Partners, evaluates the current approaches to tackling IPR infringement through online sales across the Internet and marketplace platforms.**

According to the Association of Internet Trade Companies (AKIT), in 2023 the volume of online trade in Russia increased by 27.5% and amounted to 6.4 trillion rubles. Between 2019 and 2023, the Russian e-commerce market more than tripled.

According to Data Insight's forecast, the share of online trading in the domestic retail market will continue to grow this year – with expectations for up to 19% of the total retail trade volume. At the same time, sales volume will amount to 7.9 trillion rubles, which should make an increase of 38%.

This growth has been taking place in the context of the departure of a number of foreign brands from the Russian market, brands that had accounted for a fairly large market share. However, the rapid replacement of the departed brands, as well as partially legalized parallel importation, made it possible to stabilize the situation and maintain the trade turnover.

This has triggered a series of amendments to Russian legislation in the e-commerce area, and the process is still ongoing. The main ongoing legislative trends in e-commerce in Russia include increasing state control over the internet; increasing the responsibility burden for marketplaces and other information or sales intermediaries; and spreading the use of e-signatures both by legal entities and individuals.

This situation also led to an increase of fakes in Internet sales, especially on marketplaces, which *inter alia* raises legal responsibility issues for both sellers and marketplaces themselves.



Anton Bankovsky

The concept of "owner of a product information aggregator" was introduced into the Law on the Protection of Consumer Rights in 2018. Marketplaces are defined by the Law as aggregators of information about goods or services that have a corresponding resource – e.g., software or websites through which consumers can learn about goods or services and purchase them. We still do not have a single comprehensive regulation for online trading through marketplaces in Russia. The parties independently develop contractual provisions, taking into account the requirements of the Civil Code, the Law on the Protection of Consumer Rights, Government resolutions, and other by-laws.

Different marketplaces enter into various types of legal relationships with their clients, the sellers of goods. Some sites, under a contract, provide only services for publishing the seller's information, organizing delivery, and all document flow (checks, returns, etc.).

Other marketplaces enter into other types of legal relationships with sellers, acting on behalf of the sellers and retaining a percentage of sales. In this case, we do not talk only about merely information intermediation. Thus, if a counterfeit product is sold on this marketplace, it is logical that the marketplace will also be held liable for IP rights infringement. This position was supported by the Supreme Court of the Russian Federation; similar recommendations are reflected in the Ruling of the Plenum of the Supreme Court No. 10 of 23 April 2019.

In this regard, internet service providers (ISPs), internet hosting providers, marketplaces, social

media, and peer-to-peer networks, among others, are considered information intermediaries in Russia and they can also be held liable for IP infringements. According to Article 1253.1 of the Civil Code, ISPs, internet hosting providers, and other information intermediaries can be held liable for IP infringements except in cases where they can prove that:

- They do not initiate the transmission of data;
- They do not modify data in the process of their transmission;
- They were not and should not have been aware of the fact that the content is infringing;
- On receipt of a written notice of the rights holder containing links to the infringing content, they made all necessary actions to cease the infringement;
- Compensation for infringement may be claimed only from guilty information intermediaries; and
- Claims for removal of infringing content or restriction of access to this content may be applied against innocent information intermediaries.



**The rapid replacement of the departed brands, as well as partially legalized parallel importation, made it possible to stabilize the situation and maintain the trade turnover.**



## Résumé

**Anton Bankovsky, PhD, Counsel**

Anton graduated from MGIMO University and received a PhD at the Institute of State and Law of the Russian Academy of Sciences.

Anton started his career in the United Mining and Metallurgical Company LLC., later he worked in various Russian and international legal firms such as Baker & McKenzie CIS, Hogan Lovells CIS, Simless Legal LLC, and others.

Since 2024 he has been working at Gorodissky & Partners, where he represents and advises clients on trademark and intellectual property rights protection, Internet and domain disputes, enforcement of intellectual property rights, fight against counterfeit goods and parallel imports, suppression of distribution of counterfeit goods on the Internet, customs registration of IP, registration of license agreements and franchising contracts.

Anton speaks Russian and English.

Author email: [bankovsky@gorodissky.com](mailto:bankovsky@gorodissky.com)





Thus, the above provides the possibility to send takedown notices not only to the direct infringers but to information intermediaries as well, since they have technical options for blocking or removing infringing offers or other content (i.e., cease the infringement).

Practically, at this stage, anti-counterfeiting regulations remain, in general, varied among major market players in e-commerce, and various marketplaces use different approaches in this regard. Some of them ensure that they track counterfeit products, including using a neural network. They do not support negative assessments, emphasizing that all transactions are tracked in real time, and before purchasing, the buyers can familiarize themselves with the ratings of products and sellers. They also use different approaches in their cooperation with the IP owners.

While total refusals to cooperate are infrequent, some marketplaces can be slow in responding to inquiries – they might be trying to buy some time until the goods are sold out. Some of the marketplaces prefer to merely refer to the sellers directly.

Noteworthy, while civil, administrative or criminal liability is envisaged by Russian law for selling fakes; warning letters and further negotiations with the marketplaces remain the most preferable option chosen by most brand or copyright owners.

Marketplaces normally try to respond to requests made by the IP owners, and this is a

“  
If a  
counterfeit  
product is  
sold on this  
marketplace,  
it is logical  
that the  
marketplace  
will also be  
held liable  
for IP rights  
infringement.”

good way to quickly stop the sale of counterfeits. Thus, there are chances that it will be possible to resolve the issue without going to court and save time and money. When a marketplace receives a complaint, it usually first requests information from the seller and only then, after studying all the materials, decides how to respond. Lawyers who work closely with the infringements on marketplaces note that very often the reason for refusal to block a seller is an insufficiently well-drafted claim. Typically, a claim contains not one, but several claims – both monetary and non-monetary. If compensation is sought, the amount is supposed to be calculated at this stage. IP owner will need to prove the cost of one product and the number of units sold. Sometimes this information is collected from the product card during a notary inspection. The card may indicate the price and the number of purchases. Proving the value of a relevant IP object (trademark, photo, or video) is more difficult. If an IP owner sells similar goods under a license agreement, calculations can be made on its basis. Otherwise, an independent assessment may be required.

The complaint should be issued in written form and contain key information, i.e., a detailed description of the infringement, proof of the title, identification of the infringing content, preferably in the form of a link to the particular site, counterfeit features, contact details of the IP owner or its representative, and power of attorney if the complaint is filed by the right owner's representative.

Practice shows that it is difficult to manage online IP infringement cases manually in a traditional way due to the huge number of cases and the difficulty of identifying the infringers' personalities. Therefore, brand owners should look for efficient tools that leverage modern IT technologies to detect infringements automatically, and send any number of takedown notices to the infringers within a short period.

The perspectives of the court action against marketplaces vary depending on the role that the marketplace has in the sale of goods. In some cases, a marketplace may act as a direct seller of the product. Alternatively, it may just provide infrastructure for third parties to sell their own products. While the liability of the marketplace in the first situation should not be difficult to substantiate, the second case can be more challenging for IP owners. The courts have not yet developed a unified approach to assessing the status or actions of marketplaces in these cases. Thus, the perspective of the court action should be analyzed in each case depending on the role of the marketplace in a particular transaction.

In some cases, courts refused to hold a marketplace liable if the site did not request confirmation

of the rights to use the disputed mark from the seller or could not even confirm this right. This happened e.g., in a dispute over the image of rolls in one of the popular food delivery services – the court found that the marketplace simply could not check the owner of the images used by the seller. The company demanded more than a million rubles from the online platform as compensation for 15 photographs that had been published on the product card without the consent of the copyright owner. The company sent a claim to the marketplace before proceeding to court, indicating that the site did not take proper measures to eliminate the infringement. The case went through several rounds of consideration. The Intellectual Property Rights Court of the Russian Federation ultimately rejected the claim saying that:

“the online platform, as a person relying on the assurances about the circumstances that were given by the seller when accepting the offer, did not know and should not have known that the use of the results of intellectual activity or means of individualization contained in this is unlawful”.

Consequently, an online platform, relying on assurances about the circumstances from its counterparty and guided by the presumption of good faith of participants of the civil turnover, can be considered to have exercised due diligence when choosing a counterparty and concluding an agreement with it.

In a number of cases, the information intermediary cannot independently determine, based on the name of the work, whether the fact of its downloading is illegal or not, in particular, taking into account the peculiarities of the emergence of copyright due to the fact of the creation of the work, which does not require any registration, the lack of connection between the name content assigned by the user and the content, as well as the lack of a detailed and complete register of rights of the copyright objects. Due to these circumstances, without requests from copyright owners to provide evidence of their exclusive rights, the online platform is deprived of the opportunity to determine whether the posted material could potentially infringe upon someone else's rights. Thus, for the purpose of detecting a specific infringement, the information intermediary must have sufficient information (including information that allows one to establish the status of the copyright owner and the disputed object, as well as information that allows one to detect a specific fact of infringement, according to the Ruling of the Intellectual Property Rights Court of the Russian Federation of 31 August 2022 in case No. A41-47401/2021

“  
After the first  
infringement,  
the seller's  
activities  
should be  
suspended for  
three months,  
and after a  
second  
infringement,  
the seller  
should be  
denied the  
opportunity to  
place product  
offers on all  
trading  
platforms in  
the country.”

In 2022, the biggest Russian marketplaces created a system for exchanging information about sellers of counterfeit products. This system should collect information about cases of placement of counterfeit goods, as well as information about the seller and data from documents confirming the infringement. Having detected a counterfeit, the marketplace is supposed to block it. If the same seller is noticed on another trading platform, one can request documents from the seller and, if they are missing or unreliable, also block that seller. The marketplaces also confirm their readiness to work together with the Federal Antimonopoly Service to develop a mechanism for suspending the activities of counterfeit suppliers. It is assumed that after the first infringement, the seller's activities should be suspended for three months, and after a second infringement, the seller should be denied the opportunity to place product offers on all trading platforms in the country.

In March 2024, a bill “On state regulation of trade activities of aggregators of information about goods in the Russian Federation” and amendments to the Federal Law “On the fundamentals of state regulation of trade activities in the Russian Federation” was submitted to the lower house of parliament. The new regulation will apply not only to platforms but also to sellers and operators of delivery points. To some extent, indirectly, the provisions of the bill are intended to regulate and facilitate the fight against the circulation of counterfeit products. However, we believe that the IP owners are looking forward to seeing not only more active work of the enforcement bodies in the future, but also a more profound and uniform regulation of the cooperation process between IP owners and various e-commerce platforms.

## Contact

### Gorodissky & Partners Russia, Moscow

Russia 129090, Moscow, B. Spasskaya Str.,  
25, bldg 3, Moscow  
**Tel:** +7 495 937 6116  
pat@gorodissky.com

### Ukraine

Ukraine 01135, Kyiv, V. Chornovola str.,  
25 lit. A, Office 219, Kyiv  
**Tel:** +380 44 501 1871

### Kazakhstan

Kazakhstan 010000, Astana,  
Tauelsyzdyk Avenue, 41, office 507,  
Almaty district, Astana city  
**Tel:** +7 717 227 0901

www.gorodissky.com

# Country branding - COLOMBIA THE COUNTRY OF BEAUTY

**Carolina Vera Martiz of VERA ABOGADOS ASOCIADOS details the reasons behind and the benefits of PROCOLOMBIA's recent development and promotion of their country's brand.**

Recently, PROCOLOMBIA the entity in charge of the development and promotion of Colombia's country image, launched its new brand: **COLOMBIA THE COUNTRY OF BEAUTY**.

The country brand, which has been quite stimulating and commercially successful for member countries of the Andean Community of Nations, is regulated by Decision 876 2021, whose consideration states that: "country brands are essential signs for effective communication when executing national promotion policies characterized by globalized trade and communication, amongst others, tourism, exports, and investment just like the positive image of the country".

The launching of the new brand COLOMBIA THE COUNTRY OF BEAUTY has as its fundamental aim to promote Colombian culture, foment exports and foreign investment as well as tourism nationwide.

As regards business opportunities, PROCOLOMBIA highlights the following:

"Every year, national investment and exports figures break the country's historic records. News of multinational companies interested in entering Colombia is now routine and new business opportunities become available month after month. This has been boosted by Colombia's trade agreements with more than 60 countries, which allow it to reach



Carolina Vera Martiz

approximately 1.5 billion consumers around the world. In addition, incentive policies and agreements put in place by the governing authorities render investment and business development profitable and easy.

The opportunities the country poses are wide and diverse. Colombia's intention is to allow anyone to find its beauty in its growth and its business ecosystem for investments<sup>1</sup> and exports. The business fabric has been developed so that various sectors of the national and global economy have a clear path to success within the country."

Concerning tourism, Colombia has traditionally been recognized for the wonderful cities of the Caribbean coast, especially Cartagena, a city declared a UNESCO World Heritage Site and coffee tourism where coffee-culture landscapes extending around Quindio, Caldas, Risaralda and the Cauca Valley are highlighted, and which have also been declared UNESCO World Heritage Sites.

On this occasion, the aim is to promote those regions lesser known internationally, but which are equally traditional tourist attractions; amongst those destinations, we can find the regions of Choco and the Amazon. PROCOLOMBIA said:

"Places like the Colombian Amazon<sup>2</sup> and the Chocó department<sup>3</sup> in the Colombian Pacific bear witness to the extraordinary richness of flora and fauna housed within the country's jungles and forests. This vital ecosystem, deemed an essential lung for human life, accounts for at least 15% of Colombia's forest areas. Tropical rainforests are filled with wildlife while

also acting as water and air purifiers. The ancestral heritage of these spaces endures today, thanks to indigenous communities and Afro-Colombian populations who safeguard and harness the resources provided by nature. It's crucial not to leave permanent traces in these ecosystems and to grasp that our visit should have minimal impact as we revel in the beauty of the jungle and rainforests."

## Ancestral medicine and natural plant treatments

Besides the extraordinary beauty of these two regions, they are also characterized by their knowledge of ancestral medicine and the use of natural plants in the treatment of a variety of illnesses.

In the Cocho region, we find amongst many other plants:

**Llanten:** Used in the treatment of kidney and blood pressure ailments; some even believe that it may possess properties to cure cancer.

**Botoncillo:** Herbaceous plant with a carmelite-colored stem and yellow flower; used as a liver cure.

**Hierbabuena:** used as a beverage against common colds.

**Sauco:** bitter-tasting, thin bush; used in raw juice form against fever and malaria-induced shivering.

**Higueron:** used for liver treatment, gall-bladder bile, and blood pressure; it is more bitter than quinine.

**Dormidera or sensitiva:** beautiful red and white flower; used to combat sleeplessness.

In the Amazon:

**Guarana:** invigorating, rejuvenating, refreshing and aphrodisiac properties; can be taken as tea, juice or as a milk-shake to help strengthen the heart and other muscles; it is perfect for brain function and improves circulation.

**Uña de Gato:** it is considered that its properties are wholly infinite, mainly as an anti-inflammatory and it helps to heal illnesses such as those of the prostate and ovaries, rheumatism, bad breath, ulcers, diabetes, hemorrhoids, amongst other ailments.

**Sangre de drago:** it helps to heal skin wounds and gastric ulcers; it has anti-inflammatory, anti-viral, anti-bacterial, anti-septic, and anti-hemorrhaging properties which also help to alleviate insect bites and cold-sores.

**Huacapurana:** this plant is an excellent option to cure any blood issues, ovarian cysts and also helps to detoxify the body. In addition, it calms pain in the bones, it prevents diarrhea, malaria, arthritis, and cancer; it also helps to



“  
In Colombia, the geographical conditions co-exist with the legal tools to both make use of and conserve these plants.”

alleviate osteoporosis, blood pressure, whilst also protecting the liver and it reduces high cholesterol amongst other benefits.

In times of artificial intelligence development, it is more than worthwhile taking a look at ancestral medicine and holistic plant remedies in order to combine traditional knowledge with new medicinal advancements. In Colombia, the geographical conditions co-exist with the legal tools to both make use of and conserve these plants which together with new medical innovations may well be an alternative cure for modern illnesses or diseases.

VERA ABOGADOS is a law firm duly authorized by PROCOLOMBIA to use its country brand.

## Contact

VERA ABOGADOS ASOCIADOS  
Calle 70a 11-43, Bogotá, Colombia  
Tel: +57 601 317 6650  
<https://veraabogados.com/en/>

## Résumé

**Carolina Vera Matiz, General Director & Partner**

Carolina is a Lawyer with a degree from the Andes University in Bogotá, Colombia. She has a Master's degree in Trademarks, Patents and Copyrights from the University of Alicante, Spain.



# Registration features of collective trademarks

**Maria Dvornikova, Russian Trademark Attorney at Zuykov and partners, details the intricacies of the infrequently used collective trademark to express their valuable benefits.**

A collective trademark is a rather rare type of trademark. A main characteristic is its ownership by an association of persons, as well as its use in relation to goods that have common characteristics. This type of trademark is registered and used in civil circulation the least and has a number of features that will be discussed below.

In accordance with Article 1510 of the Civil Code of the Russian Federation, an association of persons, the creation and activities of which do not contradict the legislation of the state, has the right to register a collective mark in the Russian Federation. **A collective mark is a trademark intended to designate goods produced or sold by persons belonging to a given association and having uniform characteristics of their quality or other common characteristics.**

It should be noted that the purpose of using such a means of individualization as a collective trademark does not differ from a regular trademark. Its main purpose is the individualization of goods and their identification from other manufacturers. The main difference is who the copyright holder is (association of persons).

Since the copyright holder of a collective mark is an association of persons that is a legal entity, it has a number of documents that regulate its activities. That's why it is necessary to establish the procedure for using the collective mark, requirements for the characteristics of goods



Maria Dvornikova

marked with such a mark, the procedure for its use, the procedure for monitoring its use, as well as liability for violations of established rules. Such requirements are established by the association in the Charter of a collective mark. The preparation and submission of the Charter to Rospatent is necessary at the stage of filing an application for registration of a designation as a collective mark. In addition to the requirements for the use of a collective mark, the Charter of a collective mark also lists those persons who are members of the association and have the right to use it, as well as a description of the mark itself and the purposes of its registration.

Thus, in accordance with Article 1511 of the Civil Code, the Charter of a collective trademark must contain:

- 1) Name of the association authorized to register the mark in its name (copyright holder);
- 2) List of persons entitled to use this mark;
- 3) Purpose of registering a mark;
- 4) List and uniform quality characteristics or other general characteristics of goods that will be designated by the sign;
- 5) Terms of use of the mark;
- 6) Provisions on the procedure for monitoring the use of a mark;
- 7) Provisions on liability for violation of the Charter.

It should be noted that if changes are made to the Charter, Rospatent must be notified accordingly. Additionally, information about the participants of the association is entered into the State Register of Trademarks and the certificate for a collective mark. Data are entered into the general State Register of Trademarks and Service Marks of the Russian Federation, and this information is published on the official website of the Federal Institute of Industrial Property (FIPS).

Summarizing the above, we can highlight the

“Such a trademark helps consumers to easily identify goods produced only by members of the association.”

following mandatory conditions for registration of a collective mark:

- The copyright holder may be an association of persons;
- The designation must be intended to identify goods produced or sold by members of the association;
- Goods must have uniform characteristics;
- In addition to the standard documents for registration of a trademark, the Charter of the collective mark must be attached to the application for registration. For its part, it contains the rules for the use of the collective mark, control over its placement, a list of persons who have the right to use the collective mark, and the procedure for bringing responsibility.

**Another feature of a collective mark is the possibility of its transformation into a (ordinary) trademark, which is possible both at the application stage and after registration.** Conversion can be carried out either from a collective trademark/collective mark application to a trademark/trademark application, or vice versa.

When converting an application for registration of a collective mark into an application for registration of a trademark, several conditions must be met:

- Submission of consent to the transformation of the application by persons of the association;
- Submitting an application before a decision is made on the converted application;
- The application is signed by an authorized person of the association of persons;
- An application for state registration of a trademark (service mark) is attached to the application for transformation of the application;
- The state fee for registering a trademark (service mark) has been paid.

It should be noted that the applicant must be a person who was part of the association (the applicant for the converted application). Based on the results of consideration of the application, Rospatent makes a decision in the form of a notification of approval or refusal of the application. The priority and filing date of the application are retained when the application is converted.

**Another feature of the legal regime of a collective mark in Russia is the presence of restrictions on the disposal of rights to it.** Thus, Article 1510 of the Civil Code establishes a direct ban on the alienation of rights to a collective trademark and the conclusion of licensing agreements.

It is also important to note that a person belong-

“The small number of registered collective marks and their low popularity can be explained by the fact that registering a collective mark is a rather labor-intensive procedure.”

ing to an association that has registered a collective mark has the right to use its trademark along with the collective one.

Taking into account the specifics of this means of individualization, a collective mark is not the most popular type of trademark, as evidenced by the small number of registered objects. The following are examples of collective signs:

- Trademark "Borjomi" No. 899664, registered for goods of class 32 ICGS, copyright holder Non-entrepreneurial (non-commercial) legal entity Georgian Glass and Mineral Waters Association, Georgia (GE);
- Trademark "Solingen" No. 312608, registered for goods of class 08 ICTU, copyright holder Industry-und Handelskammer Vuppertal-. Solingen-Remscheid, Germany (DE);
- Trademark "Derevenkino" No. 712363, registered for goods of class 29 of the ICTU, copyright holder Association of Peasant (Farm) Farms and Agricultural Cooperatives of the Tambov Region, Russia (RU);
- Trademark "Aleksandrovsкая products" No. 324484, registered for goods of class 30 of the ICTU, copyright holder Association Aleksandrovsкая, Russia (RU);
- Trademark "Silver of Russia" No. 484309, registered for goods and services of classes 14, 35 of the ICTU, copyright holder Jewelry and production company "Silver of Russia", Russia (RU).

The list is not exhaustive.

Among these marks, such marks as: "Aleksandrovsкая products" No. 324484, "Silver of Russia" No. 484309 were transformed, which can be traced in the chronology of publications of information in open registers.

The small number of registered collective marks and their low popularity can be explained by the fact that registering a collective mark is a rather labor-intensive procedure that requires certain preparation of documents and information. At the same time, such a trademark helps consumers to easily identify goods produced only by members of the association and be confident in their quality, which in turn increases the reputation of the manufacturer.

## Contact

**Zuykov and partners**

Grokholsky lane, 28 Moscow, Russia, 129090

**Tel:** +7 495 775-1637

info@zuykov.com

www.zuykov.com/en

# Shine bright in Antwerp at the ECTA 42nd Annual Conference

**Carina Gommers, ECTA First Vice-President responsible for the ECTA academic program, provides a glimpse behind the curtain for the upcoming conference that is set to inform and inspire attendees.**

The countdown has begun! Antwerp is set to sparkle from **19-22 June 2024**, as the **ECTA 42nd Annual Conference** takes centre stage with the theme **'Many Facets of IP'**.

Known as the city of diamonds, Antwerp offers a radiant setting for exploring the diverse realm of intellectual property. **Registration is open**, so don't miss the chance to secure your spot for another rewarding ECTA experience surrounded by hundreds of IP colleagues and friends from around the world.

The agenda is rich, covering a wide range of interests. Beyond exploring the latest IP trends and case law, this year's Conference aligns with



Carina Gommers

the **2024 WIPO theme, IP & the sustainable development goals (SDGs)**, placing a special focus on sustainability, a pivotal factor for a brighter future. Significant emphasis is also reserved for **diversity and inclusion**, fundamental for a forward-looking IP landscape.

Let me give you a glimpse behind the curtain!

**Wednesday, 19 June – committee meetings kickstart and Welcome Reception**

Committees will meet again to delve into impactful IP projects and case law updates, and the Supervisory Board will debate more strategic aspects of the association. Delegates will learn more about IP mediation and ADR in a dedicated workshop, before a Welcome Reception at the enchanting Horta Grand Café.

**Thursday, 20 June – educational immersion and Belgian tasting**

Attendees will dive into the latest IP news, discussing sustainability in trademarks, the role of AI in shaping the future, and the impact of IP in the food industry. Committee Leaders will be available to meet with interested colleagues at the Committee Corner and, at 'ECTA at a Glance', we will toast with first-timers and share insights on how to get the best out of our association. The day concludes with a gourmet taste of Belgian delicacies in the Convention Centre gardens, connected to the Antwerp Zoo – an award winning science and research centre – exceptionally open for an evening walk. Worth noting is that all profits from the Convention Centre will be donated to the ZOO Foundation, thus the Conference will directly contribute to nature conservation, zoological research, and animal welfare.

**Friday, 21 June – learning boost and Gala Dinner**

Delegates will continue their IP exploration, delving into topics such as copycats, diversity and inclusion, animal trademarks, traditional knowledge, and the most recent EU case law updates. ECTA Award winners will be celebrated, and the Conference will conclude with a dazzling Gala Dinner at Handelsbeurs, the world's first purpose-built commodity exchange building.

**Saturday, 22 June – excursions (upon reservation)**

ECTA friends can sign up for a half-day tour exploring the city of Antwerp or a full-day adventure uncovering the secrets of diamonds and Belgian chocolate.

Last but not least, Antwerp's central location ensures easy access for many European colleagues as it is seamlessly connected by **high-speed train to major cities such as Paris, Amsterdam, London, and Cologne** – and is just a swift **30-minute train trip to/from Brussels International Airport**. Moreover, the Flanders Meeting and Convention Centre Antwerp (FMCCA), where the event takes place, is conveniently located in front of the famous Antwerp Central Station.

It promises to be a not-to-be-missed Annual Conference, where you will forge new connections in a friendly atmosphere while staying abreast of the latest IP developments.

If you are not yet an ECTA member, join the association and come to the Conference at the discounted member rate. I very much look forward to seeing you all in Antwerp!

## Contact

**ECTA**

Rue des Colonies 18/24, Box 8, 8th Floor, BE-1000, Brussels, Belgium

**Tel:** +32 2 513 52 85

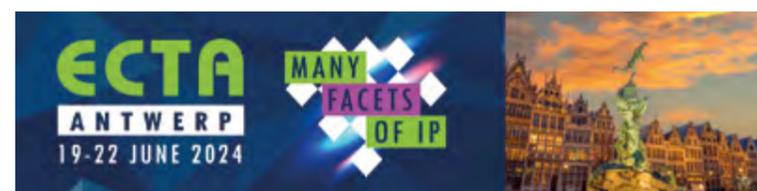
**Fax:** + 32 2 513 09 14

ecta@ecta.org

www.ecta.org

**LinkedIn:** ECTA (Official)

**Twitter:** @ECTABrussel



## Résumé

**Carina Gommers, ECTA First Vice-President, ECTA Programme Committee Chair, BE**

Carina Gommers is ECTA First Vice-President and partner at Wiggin LLP's Brussels office. Her practice covers trademark portfolio management and litigation regarding intellectual property rights, including trademarks and designs. Carina has extensive experience regarding customs counterfeit seizures and also regularly advises on matters of advertising and unfair market practices.

Since qualifying, she has worked on a number of high-profile cases, representing clients including Solvay, Philips, Supergroup, Pfizer, Procter & Gamble and Wolters Kluwer.



# Crucial strategies for trademarks in Russia: navigating use-related issues

**Anna Bobkina, Trademark Attorney at PATENTICA, discusses the adapted approach to trademark protection in Russia given the recent changes in the market with foreign brands suspending activity, rebranding, or facing challenges from Russian competitors.**

Since early 2022, a significant number of companies have either stopped or paused their operations in Russia. This tendency now raises concerns as the three-year threshold stipulated in the legislation for initiating the cancellation of a trademark due to non-use is nearing. Given the present circumstances, the lack of trademark use is an aspect worth reviewing.

There is a reverse problem as well: when a foreign company, despite having a significant market presence and recognition elsewhere, fails to register its trademark in Russia, a Russian company can seize an opportunity to fill this void by registering the same trademark in its own name.

Both these issues, however, can be resolved through proper legal measures.

While numerous Western brands have announced their departure from the Russian market, some continue to operate under alternative names.



Anna Bobkina

Often, the name change aligns with a shift in the brand's local management, indicating its sale to a Russian franchisee or a third-country owner. For instance, ZARA's stores reopened as MAAG under the supervision of Fashion And More Management and DECATHLON was replaced by DESPORT chain, managed by the local distributor ARM.

Partly as a result of a wave of M&A deals, the Russian Patent and Trademark Office (RUPTO) reported a notable uptick in new trademark application filings in its 2023 annual report. Overall, there was an approximate increase of 30% for new trademark applications submitted to the RUPTO in 2023 compared to the previous year, with international registrations designating Russia seeing a rise of around 10%. These figures evoke both optimism and a call for cautiousness.

In the context of rebranding for the Russian market, it is essential for companies to protect their new rights by adhering to the "first to file" principle. However, for businesses that have exited the market but aim to preserve their established reputation, navigating this landscape presents distinct challenges. After all, trademark protection can be infinite, whereas circumstances and economic scenery are subject to change.

Generally, trademarks registered in Russia, even if not sufficiently used, do not lose their protection automatically and there is no need to submit any evidence with the RUPTO; instead,

such termination requires a non-use cancellation court procedure. Specifically, according to the legislation, a trademark registration can be cancelled in the IP court by an interested party, if it remains unused by the owner for three consecutive years. During consideration of the legal action, the plaintiff has to prove honest interest, whilst the trademark owner must present confirmation of use to prevent its cancellation. Prior to initiating the proceedings, a pre-trial notice must be sent to the owner to provide parties with an opportunity for amicable settlement and ensure that the defendant is not caught unaware of the proceedings.

Unless a trademark is cancelled by the IP Court, its owner can still initiate and succeed in lawsuits against infringers, even if the trademark is not currently used, without being deemed to act in bad faith. A 2023 Judicial Review of the court practice prepared by the Russian Supreme Court supports this approach.

In order to stay afloat and ensure a fresh three-year protection against non-use threats, companies can file new trademark applications for the same brand. New application shall not however be entirely identical to the prior mark, which implies applying various strategies such as tweaking the list of goods and services, introducing a new design, or combining it with a slogan. Adopting this approach not only safeguards the right but also strengthens it. For instance, legal guidelines acknowledge trademark series comprising at least three trademarks in the name of one entity based on the same element as a factor increasing the risk of confusion.

According to the same Judicial Review of November 2023, filing a new trademark application for a mark previously cancelled by the IP court due to non-use could potentially be viewed as an act of bad faith in specific situations. However, any claim of bad faith must be considered in a separate court proceeding, with each case evaluated on its own merits. Currently, these provisions primarily target "patent trolls" who also practice continuous submission of trademark applications without genuine use. Importantly, the legislation does not impose restrictions on trademark owners registering multiple similar trademarks, and there is no established practice of deeming new applications, aimed at avoiding non-use claims, as filed in bad faith.

Another scenario where the use of a trademark becomes important is during trademark opposition proceedings at the RUPTO. The final

“  
The three-year threshold stipulated in the legislation for initiating the cancellation of a trademark due to non-use is nearing.”

ruling on the revocation of trademarks may be based not solely on the actual priority and similarity of the marks but also depending on the risk of consumer confusion in the current market. In case of relatively low similarity between the marks, the RUPTO can take into account accessibility of the goods labelled with the prior trademark to consumers. In these circumstances, the recently authorized parallel import for particular brands is helpful to show that these products are still available to Russian consumers. Though not directly from the original source, such presence highlights the genuine risk of confusion. At the same time, goods entering the market through parallel import would not help in non-use cancellation proceedings, since the trademark use in such case cannot be regarded as controlled by the trademark owner.

Now, let's consider the reverse situation, when a company owns a brand used and protected in other jurisdictions, but lacking a registered trademark in Russia; and in its further attempt to secure protection, it encounters a refusal from the RUPTO since a local party has already applied for and registered this trademark for identical or similar goods.

In such situations, the legislation provides a valuable invalidation mechanism, an additional ground to challenge trademark applications and registrations, beyond just relying on previously registered trademarks – namely, a possibility of misleading consumers.

Although the Russian system stipulates "first to file" basis for determining priority of trademarks, there are ways to prevent registration or invalidate a trademark on the basis of prior use. Merely using the mark might not suffice, though: this is more about reputation of the prior unregistered brand. The owner of such brand must prove that, at the date of filing of the contested application, the target audience was already associating the same mark with this owner.

## Résumé

Anna Bobkina is a trademark attorney at PATENTICA with 10 years of experience in trademark prosecution, including accelerated and well-known trademarks. Anna's other area of expertise is related to the registration of appellations of origin and geographical indications. Excellent research skills and a tendency to keep an open mind allow Anna to explore all available courses of action in order to present the client with the best solution to an issue at hand.  
Author email: [anna.bobkina@patentica.com](mailto:anna.bobkina@patentica.com)



While current use of the mark is also taken into account, ultimately, the outcome depends on the ability to prove longstanding and active use before the filing date - the current state of affairs can only be mentioned in passing.

A recent example demonstrates such situation in detail. In a case considered by the Chamber for Patent Disputes throughout 2022, culminating in a final decision on 23 January 2023, the South Korean company BigHit Music Co. Ltd succeeded in partial invalidation of a trademark "BTS" filed and registered in 2020 by a Russian entity. This trademark not only included the name but also featured the logo of the popular K-Pop group BTS. The Korean company had to prove that Russian consumers were familiar with this mark in 2020 and associated it with the musical group.

A primary method for substantiating consumer awareness in such cases involves conducting opinion polls through certified agencies among consumers across major Russian cities. Unsurprisingly, the registered mark was identified as the logo of the music group BTS by almost 30% of general music lovers and more than a half of K-Pop fans. The final decision of the Chamber for Patent Disputes deemed these results "robust".

The majority of the materials presented to the Chamber for Patent Disputes did not specifically target Russian consumers but were accessible to them online. A notable example is YouTube, a

“  
**There was an approximate increase of 30% for new trademark applications submitted to the RUPTO in 2023 compared to the previous year.**  
 ”

widely-used global video streaming platform. Channel owners can access internal statistics in their profiles to determine viewer demographics by country. Consequently, even if the content is not in Russian language, the significant interest from Russian viewers can nevertheless be shown. For a popular group like BTS, this interest is counted in millions of local views.

In light of the current unavailability of certain major social platforms, alternative options can be explored. In the present case, the focus has shifted towards the services that remain accessible in Russia, particularly highlighting domestic social networks like "Vkontakte" and "Odnoklassniki."

In today's digital age, there is a natural inclination to depend heavily on online services. Nonetheless, the RUPTO frequently requests evidence demonstrating that consumers can also access information about the mark through offline channels.

The last concert of BTS music group held in Russia was in 2014, but their presence was maintained through the distribution of concert films, coverage in popular magazines, and even biographical books. Some of these promotional materials were not directly commissioned by their record label, BigHit Music, yet they effectively heightened awareness of BTS among the Russian audience. This demonstrates that even when the usage does not specifically target the Russian

market or is not directly endorsed by the trademark owner, rather by the audience itself such as reviews and opinions, it can still be a valuable asset.

Ultimately, based on the gathered proof, despite current usage in Russia being obstructed, the brand remained familiar to Russian consumers. As a result, the registered trademark was invalidated for all goods and services linked to the music group's activities.

The same approach, leveraging the fame or prior use of a mark can be employed not only in post-grant opposition proceedings but also when acting against any mark during its examination by the RUPTO. It is essential to highlight that the trademark registration process in Russia does not involve publishing the application specifically for opposition purposes. However, the law provides an opportunity to file third-party observations with regard to a pending trademark application. Such observations can be grounded both on relative and absolute grounds, be filed by any party, and the legislation mandates examiners to consider these submissions when making their decisions.

Challenging a trademark is even easier at examination stage, since it requires much less evidence on the prior use to incite a provisional

“  
**There are ways to prevent registration or invalidate a trademark on the basis of prior use.**  
 ”

refusal based on misleading. For example, it is possible to provide the examiner with some evidence of sales and customer reviews, without an opinion poll – a costly remedy that may be put off until later, in case the applicant succeeds in the first defense. This brings mindful companies to watching pending applications in Russia as well.

All in all, if a trademark is registered but currently not in use, there are solutions to secure its protection, whereas a stolen brand can be successfully contested even in a "first to file" system. Human ingenuity always finds a way to thrive, despite the complicated circumstances, and perhaps especially in them.

**Contact**  
**PATENTICA**  
 info@patentica.com  
 www.patentica.com

## EXPANDING THE VALUE OF YOUR IDEAS



Patentica is an intellectual property law firm operating since 1997 and providing full range of high standard IP services

- ◆ Patents
- ◆ Utility Models
- ◆ Patent translations
- ◆ Trademarks
- ◆ Industrial Designs
- ◆ Litigation
- ◆ FTO searches and opinions
- ◆ Licensing & IP transactions
- ◆ Patent & Trademark Searches
- ◆ Computer programs



www.patentica.com info@patentica.com

SINCE 1997 SINCE 1997 SINCE 1997 SINCE 1997 SINCE 1997



# Promoting business through trademark security in Brazil

**Renata Rocha of Vaz e Dias Advogados & Associados provides advice on the novelties of trademark security in Brazil to guide best practices for business success.**

Trademarks are essential elements when it comes to the identification of products and services in the market, so much so that due to their significant impact in the Brazilian economy, marks are also used as an indicator of commercial flow and expectation of future business. In the last 10 years, the extensive use of marks has been furthered by companies and the local courts to secure the execution of financial obligations assumed but not complied with, especially those of labor and taxation nature. Further to that, trademarks have been used to promote investments in the sense that they have been in use as collateral to secure financing obligations by means of security interest agreements.

This article addresses exactly the peculiarities of trademark as a collateral and security role to investments in the Brazilian market, which has been greatly highlighted by the recent Federal



Renata Rocha

“ Trademarks are adequate company assets to work as lien, since they are integrative to debtor’s business. ”

## Résumé

Renata Cundines da Rocha is an attorney at law of the Brazilian law firm VAZ E DIAS ADVOGADOS & ASSOCIADOS with a focus on trademark and copyright matters. Her activities focus especially on administrative procedures presented towards the BTO for both national and international clients in order to ensure the protection and enforcement of patents and trademarks. She holds further knowledge on legal issues related to artificial intelligence, including those related to the interface or collision between AI and trademarks.

Law 14,711 of October 30, 2023 – so-called the Legal Framework of Guarantees. Promulgated in 2023, Federal Law 14,711/2023 brings new rules to the table to improve guarantee rules, provide legal certainty, and streamlines procedures for creditors and debtors, thus, reducing financial transaction costs and making it easier for businesses to obtain financing. With simpler procedures, facilitating the use of movable assets (such as inventory, machinery, and accounts receivable), as collateral for loans, small and medium-sized enterprises can access credits more easily and increase their productions and trade.

The additional proposal of this article is to deal with required formalities to effect security interest agreement before the Brazilian Trademark Office (BTO), which is an agency in charge of registering this kind of agreement so that they produce effects before third parties.

## Treatment of security interest

Security interest plays a key role when it comes to commercial financing, since it secures loans to third parties and businessmen by demanding the disposal of an asset as a collateral thereby reducing the financial risks in commercial transactions.

Aware of the economic importance, the Brazilian Civil Code provides a legal framework for diverse types of pledges, such as ordinary, rural, of vehicles, of rights and credit titles, second-degree, legal, and most importantly commercial pledges. According to Article 1,447, the following assets in industry and commerce may be regarded as a pledge for securing finance obligations and debts: appliances, materials, instruments, accessories, animals used in industry; salt and goods

intended for the exploitation of saltworks; products of pig farming, animals intended for the industrialization of meat and its derivatives; raw materials and manufactured products. The provided list of assets is not exhaustive, since businesspeople may use diverse materials, goods and rights as instruments to promote their trade and reputation thereby using one of them to secure loans and finance for investments.

Although intangible matters were not expressly provided in the list of commercial matters under Article 1,447, it is unanimous by scholars and court decisions that the assets under the commercial pledge must be moveable (not immovables) and therefore subject matters to be divested and, most importantly, be integrative to the business. Trademarks are adequate company assets to work as lien, since they are integrative to debtor’s business. Further to that, they are classified as chattels or movables by Article 5 of the Industrial Property Law (Federal Law no. 9,279/96). Also, the Civil Code has eliminated the requirement of effective conveyance of the asset to the hands of creditor for a security interest to effect. Nowadays, the possession of the collateral may be in the hands of debtor, which has made the conveyance of chattels as a “fictitious” transfer and essentially ruled by an agreement that secures the lien.

It is a customary practice adopted by Brazilian commercial banks and financing institution to accept products/goods as security for a debt and empower the debtor as a trustee of the product thereby maintaining with the debtor the pledge products/goods. Since the security interest subject matter is not in the hands of the creditor, the Civil Code, through Art. 1.450, has granted legal rights to said creditor to verify the condition of the pledged item, inspecting it wherever it may be, either personally or by a person authorized by them.

Under this perspective, to perfect the lien when the asset is a trademark and further secure creditor’s control of the pledged trademark, the Industrial Property Law requires the registration of any limitation or pledge of trademark applications or registration at the Brazilian Trademark Office (BTO). This means that recordal of the pledge by the BTO will make the agency refuse to record assignments, mortgages, or any additional collateral specified as a security for the satisfaction of a debt.

The Industrial Property Law provides further novelty in relation to the prior law as it recognizes that recordal will be applicable to any kind of limitation, not only to those derived from the judge’s authorities and decisions of government’s authorities. With the new wording of Article 136 of the Industrial Property Law, any limitation on a trademark application or registration for example will be taken into account for recordation, including

“ What is most interesting to us is the inauguration of the possibility to use the same good to secure two or more obligations of an investor or debtor. ”





those privately agreed by the titleholder from commercial agreements, such as "Trademark Mortgage Agreement", "Security Interest Agreement," among others.

Amongst the many changes brought by the Legal Framework of Guarantee, what is most interesting to us is the inauguration of the possibility to use the same good to secure two or more obligations of an investor or debtor. Although the law only mentions explicitly realty, there are already scholars' understanding to support that this development could reach out movables, including intellectual property rights. Their use to support different obligations may be fully accepted when explicitly dealing with the security interest agreement that the same asset secures obligations from the same or different business. It is expected further that this asset is adequately valued by expert so that so that the attributable monetary value of the trademark may be adequate to support the different obligations assumed by the trademark owner/debtor.

#### Formal requirements under the law of the land

After showcasing how the Brazilian law perceives security interests, it is most fitting to point out how to effect said interest when it involves the BTO. Security interest in trademarks is usually affected in the form of a separate contract or within the contents of a loan agreement, which should contain the following matters, among others freely stipulated by the parties:

1. The nature of the loan or the main obligation that created the amount of the credit or the existing debt;
2. The precise amount of the credit, or its estimated value or total amount, or the debt amount;
3. The time frame for payment of the credit;
4. The effective filing or registration of the trademark at the BTO, since marks not yet filed in Brazil are not regarded as adequate matter to perfect a collateral. Therefore, it is needed to specify the peculiarities of the secured trademarks, including registration or application numbers, classification, and titleholder's details;
5. Estimated value of the secured or trademark so that it is an adequate asset to cover the total amount of the security.

It is important to state the indication of trademark applications or registrations, as security for a debt does not exempt the applicant or registrant

“ Security interest in trademarks is usually affected in the form of a separate contract or within the contents of a loan agreement. ”

from complying with its obligation to maintain valid and effective trademarks. In fact, the applicant or registrant of the lien is placed as a trustee and therefore should hold the obligation to maintain the security in good order.

As to the formalities, the agreement needs to be signed by the parties and two witnesses. The signature of the foreign party's representative should be notarized by a notary public and obtain the Apostille under the Hague Convention (abolishes the requirement of legalization of foreign public documents). There is no need for the financed party to have its signature notarized locally. It is recommendable, but not compulsory, for the initials of the parties and witnesses to be on each page of the agreement, as this procedure grants further assurances to the contents of the agreement.

The BTO defines limitations or encumbrances as restrictions of rights imposed on registered trademarks or applications. For those to be considered valid and, therefore, enforceable towards third parties, the restrictions must be recorded/registered along the BTO, as provided for in article 137, of the Industrial Property Law (LPI), and published on the Industrial Property Gazette (RPI). The following peculiarities should be observed by the contracting parties after execution of the security interest agreement:

1. **Who can request a recordal?** The recordal of the pledge at the BTO may be requested by individuals or legal entities that have legitimate interest in seeking the recordal. These are the trademark owners, the investors and the contracting parties of the security interest agreement. The BTO also points out the applicant's need to have an account registered in the BTO's official website to properly send the documentation and request to the office's corresponding sector, even if deciding to present the documentation in person.
2. **Step 1: login in the e-INPI system.** If, by any means, the system is found to be unavailable/offline, the BTO gives the applicant the options to either conduct an in-person protocol at the headquarters or regional units, or request a deadline extension if needed, after monitoring the restoration of digital services.
3. **Step 2: pay the federal tax liability payment form (GRU).** The official taxes for the recordal are R\$ 70.00 (approximately USD 15,00) if requested through electronic means and R\$ 105.00 (approximately USD 20.00) if in physical form (paper). Again, if, by any means, the system is found to be unavailable/offline, the BTO

gives the applicant the option to request a deadline extension if needed, after monitoring the restoration of digital services.

4. **Step 3: petitioning.** The applicant should access the e-Marcas System and fill in the electronic form or its printed version and post the paper form. As for the data, the applicant has to identify itself as well as point out the numbered code of the paid GRU. The petition and documentation related to the recordal of the agreement or request for registering the limitation or encumbrance stemmed from a court order should comprise, as an attachment, the corresponding agreement or the order, since the BTO should evidence the parties' interest in the lien or the court decision. Just as seen above, if, by any means, the system is found to be unavailable/offline, the BTO gives the applicant the option to conduct an in-person protocol at the headquarters or regional units or request a deadline extension if needed, after monitoring the restoration of digital services.

5. **Step 4: monitoring the registration prosecution of the collateral.** The BTO emphasizes this step so the applicant is aware of what is happening to their request, inviting the applicant to always stay tuned with new published content in the Industrial Property Gazette and, thus, never miss deadlines if a new document or information is requested by the office in order to fulfill requirements.

6. **Step 5: becoming aware of the BTO's decision.** The decision is published in the weekly edition of the RPI, the BTO's official publishing platform. It is from this moment on that the trademark limitations, such as identifying it as an asset of security interest, are finally officially registered in the BTO's database and, therefore, able to enforce said limitations towards third parties.

In summary, obtaining a recordal along the BTO registering that a trademark is an object of security interest, serving as collateral for a debt, is a way to directly fulfill what is demanded in the Civil Code regarding the formalization of security interest. Thus, if there are any third parties interested in obtaining the trademark, they will be aware of its status as a collateral, once such information is widely available through the Industrial Property Gazette, building a more secure scenario for legal transactions and obligations.

“ It is possible to observe a scenario in Brazil where legislation seeks to increasingly simplify the processes required for an asset to be pledged. ”

#### Concluding comments

After exploring the topics above, it is possible to observe a scenario in Brazil where legislation seeks to increasingly simplify the processes required for an asset to be pledged, allowing intangible assets such as trademarks to be accepted as collateral. This was made possible through the developments of the Civil Code of 2002 that removed the requirement of conveyance for the realization of security interest.

More recently, a new discussion surfaces around the possibility of a trademark to be a lien of two or more obligations assumed by the trademark owner following up the recent Legal Framework of Guarantees.

In this regard, it is noteworthy that ceasing to require conveyance of assets and making pledge procedures simpler and more dynamic does not mean sacrificing the legal security of the obligation. On the contrary, it allows for greater expediency in this legal mechanism (security interest), reducing unnecessary expenses for both creditors and debtors and increasing the chances of financing for both businesses involved.

Thus, Brazil becomes fertile ground for both domestic and international investments, recognizing the importance and prominence of intangible assets, especially trademarks, for companies and consequently for the entire economic activity.

#### Contact

##### VAZ E DIAS ADVOGADOS & ASSOCIADOS

Rua Da Assembleia nº 10 Office 2422,  
Centro, Rio de Janeiro - RJ, Brazil  
Phone: +55 21 3176 6530  
www.vdav.com.br



# IP and the metaverse: a new world in focus

**Rania Vrontou and Socratis Socratous of Hadjianastassiou, Ioannides LLC (member of the Deloitte Legal network in Cyprus) evaluate the possible implications the metaverse may have on the protection of intellectual property.**

The "metaverse" is considered by some as the gatekeeper to a new world with many unexplored opportunities, and by others as an abstract concept.

The EU Commission has estimated that the virtual worlds will reach a global growth of €800 billion by 2030 and provide the potential for the creation of 860,000 new jobs by 2025.<sup>1</sup> At the same time, private stakeholders such as Nvidia, Meta and others are heavily invested in exploring and securing a head start at the many potentials of the metaverse.

In this meta-world, geographical boundaries are blurred. The International Trademark Association (INTA) in their 2023 Metaverse Report provide a description of this characteristic and its effect on brand owners by stating that "The metaverse, much like the Internet, is not restrained by geographical boundaries. Therefore, by placing a brand into the metaverse, a brand owner arguably enters international commerce."<sup>2</sup>

The questions surrounding the metaverse are many, interesting, and extend to a variety of areas including banking, regulatory, tax, compliance, data protection, and intellectual property.

This article will attempt to consider whether the protection of intellectual property rights, specifically copyrights and trademarks, can remain relevant in this new 'metaverse' world, by reference to non-fungible tokens (NFTs) and trademark registration.



Rania Vrontou



Socratis Socratous

The authors will conclude that copyright protection must remain relevant in the metaverse (i) where there is a nexus with tangible goods or services in the physical world and (ii) for providing the legal basis for redress and/or enforcement actions in whatever form, including techno-regulation. In contrast to copyright protection, the authors will argue that trademark protection on the territoriality principles on which the system is currently founded is unlikely to remain relevant in the metaverse.

## The metaverse: what is it exactly?

There is a lot of discussion around the metaverse. But what is it exactly? The European Commission in Shaping Europe's digital future describes the metaverse as "virtual worlds"<sup>3</sup> while Meta described it as "providing new ways to connect and share experiences".<sup>4</sup>

INTA adopts, among others, Neal Stephenson's description who considered the metaverse to be "a digital space in which users interact and create social relationships, using avatars to escape a dystopian reality".<sup>5</sup>

The descriptions provided above consider that the metaverse "does not identify as a single shared virtual space [...], it is decentralized across various platforms and therefore can only come into full existence once there is a true interoperability between these different platforms."<sup>6</sup>

Another view is that the metaverse will eventually

## Résumés

**Rania Vrontou** is Senior Managing Associate at the Commercial Department of Hadjianastassiou, Ioannides LLC (member of the Deloitte Legal network in Cyprus), focusing on private client, real estate, intellectual property law, and regulatory aspects of innovation. She advises on trademark protection, brand strategies, copyrights, trade secrets, and know-how, including transactional matters such as IP due diligence, drafting of agreements, and ad-hoc advice on intellectual property matters.

Rania holds an LL.B from the University of Leeds, an LL.M in Commercial Law from the University of Bristol, and a Postgraduate Diploma in Professional Legal Practice (LPC) from the University of Law. She is a member (TEP) of the Society of Trust and Estate Practitioners (STEP) and a member of the board of STEP (Cyprus). She is also a certified person for the provision of investment advice, a seminar trainer, and a registered mediator.

Author email: [rvrontou@deloitte.com](mailto:rvrontou@deloitte.com)

**Socratis Socratous** has been an Associate at the Commercial Department of Hadjianastassiou, Ioannides LLC (member of the Deloitte Legal network in Cyprus) since 2022. His main areas of focus include intellectual property law and general commercial law. Socratis holds an LL.B from the University of East Anglia and a Postgraduate Diploma in Professional Legal Practice (LPC) with an MSc in Law, Business and Management from the University of Law.

Author email: [ssocratous@deloitte.com](mailto:ssocratous@deloitte.com)

acquire the form of a multiverse: "a loose partially interoperable confederation of distinct virtual worlds and metaverse environments, each subject to a different mix of state authority, corporate oversight, and participatory governance".<sup>7</sup>

Regardless of the metaverse's final form, the content of the terms and conditions of the different metaverse providers (platforms) and smart contracts are expected to be the primary means through which existence on the metaverse and transactions on the metaverse will be regulated. While terms and conditions will allow for its existence, meta-tools are expected to be responsible for the users' overall experience. Meta-tools are expected to build upon a variety of new technologies including the Internet of Things (IoT),

“The notion of creativity and the understanding of “works” are expected to acquire a meaning different from the one in the physical world.”



<sup>1</sup> <https://digital-strategy.ec.europa.eu/en/policies/virtual-worlds>

<sup>2</sup> INTA, 'TM Metaverse, a report from INTA' <[https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/METAVERSE\\_REPORT-070323.pdf](https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/METAVERSE_REPORT-070323.pdf)>

<sup>3</sup> <https://digital-strategy.ec.europa.eu/en/policies/virtual-worlds>

<sup>4</sup> <https://about.meta.com/metaverse/>

<sup>5</sup> INTA, 'TM Metaverse, a report from INTA' <[https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/METAVERSE\\_REPORT-070323.pdf](https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/METAVERSE_REPORT-070323.pdf)>

<sup>6</sup> INTA, 'TM Metaverse, a report from INTA' <[https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/METAVERSE\\_REPORT-070323.pdf](https://www.inta.org/wp-content/uploads/public-files/perspectives/industry-research/METAVERSE_REPORT-070323.pdf)>

<sup>7</sup> UKIPO, IP and Metaverse(s) report <<https://www.gov.uk/government/publications/ip-and-metaverses-an-externally-commissioned-research-report/ip-and-metaverses-an-externally-commissioned-research-report>>



blockchain, smart contracts, virtual reality tools/products, augmented reality tools/products, and artificial intelligence (AI).

### Drawing parallels from NFTs

NFTs can be understood as a "cryptographic tool that uses a blockchain to create a unique non-fungible digital asset which can be owned and traded"<sup>8</sup> or "a metadata file, a digital receipt, which is transferable".<sup>9</sup>

In certain cases, the holders of NFTs have been compared to owners of a copy of a book.<sup>10</sup> The authors find this parallel appealing, although they consider that different NFTs have the potential to be treated differently depending on their individual characteristics.

Indicatively, the NFT's smart contract (that is the digital agreement written in computer code and programmed to execute automatically once certain conditions have been met<sup>11</sup>) may expressly provide otherwise, although, erring on the side of caution, smart contracts (as a series of automated actions) would complement or manifest the provisions of traditional contracts<sup>12</sup>. Further, other important considerations include (i) the capacity of the issuer of the NFTs, namely that the issuer is the copyright owner of the tangible tokenized work<sup>13</sup> and (ii) the rights attaching to the NFT (*vis-à-vis* the tokenized work).

In the EU, the recent Spanish decision<sup>14</sup> of the Visual Entidad de Gestión de Artistas Plásticos (Vegap) the Spanish collective society against Punto FA trading as Mango sheds light on some interesting considerations. In this case, Vegap brought a claim for copyright infringement against

“  
The  
metaverse  
has the  
potential to  
disturb the  
foundations  
of the  
trademark  
registration  
system.”

”

Mango in connection to the tokenization of artworks including Miro, Tapes, and Barcelo to celebrate and promote the opening of a new shop in New York. Mango also owned the physical originals of the commissioned work.

The court of Barcelona ruled in favor of Mango on the ground that the use by Mango constituted "harmless use".<sup>15</sup>

Interestingly, the NFTs were created off-chain, that is the NFTs' smart contract was not deployed on the blockchain and the NFTs were not issued for commercial use.

The case suggests the Spanish court's inclination to find copyright law of relevance in the metaverse, especially when the tokenized works are protected by copyright. It would seem, however, that, in this case at least, the Spanish court was not as inclined to find copyright infringement.

Undeniably, copyrights provide important protections to copyright holders in the physical world, and for so long as there is a nexus between digital and tangible works, it would seem unlikely that copyrights will become obsolete.

Nonetheless, as the nature of works shifts, with works being produced entirely in digital or virtual form, this could in turn trigger a shift towards a more practical approach to the protection of rights (not only copyrights but also contractual rights) through technoregulation.

Technoregulation in the embodiment of smart contracts, blockchain, and other technologies has the potential of complementing and, to a certain extent, replacing the traditional recourse to enforcement of rights such as judicial/ extra-judicial proceedings and enforcement of judgments.

The added advantage of technoregulation is that of "efficient enforcement". This comes with a few caveats: the actions executed under the smart contract are correctly executed and such actions, to the extent they have a nexus with tangible goods, are also implemented in the physical world.

On another note, the risk with technoregulation lies in its data dependence. In this context data validation centers, validating the accuracy of the data used, have the potential to become a necessity, perhaps the second "big" thing after big data.

### Trademark protection in the metaverse

With the value of virtual platforms being expected to reach 800 billion euros by 2050, it is no wonder that many brands have or intend to expand in the metaverse.

According to the World Intellectual Property Office (WIPO) companies interested in the metaverse tend to file new applications in classes such as class 9 (downloadable virtual goods, namely computer programs), class 35 (retail store services

featuring virtual goods), class 41 (entertainment services) class 42 (online non downloadable virtual goods and NFTs), and class 36 (financial services, including digital tokens).

Such registrations are expected to take place not only as a result of the intention to expand in the metaverse but pre-emptively as well, in an effort to prevent bad faith registrations (despite associated risks pertaining to non-use claims).

Despite increasing interest in trademark applications for the metaverse and virtual reality, the territorial nature and scope of the trademark registration system give rise to a number of challenges.<sup>16</sup>

Similar trademarks registered in different jurisdictions carry the risk of interacting in the metaverse. This is likely to create an increased risk of likelihood of confusion amongst users of the metaverse.

It could be argued that the "well-known" mark status under the Paris Convention could in the end be the determining factor. However, most trademarks are unlikely to meet the "well-known" threshold. In this latter case, a trademark whose registration includes the most relevant class of goods/services would seem to secure an advantage, noting that the registration of a mark for physical goods/services would not necessarily guarantee protection in the metaverse.

Even if the jurisdiction issues are surpassed, enforcement is not expected to be less challenging, considering that enforcement of judgments is challenging in the physical world.

The above suggests that the metaverse has the potential to disturb the foundations of the trademark registration system. Thus, in order for trademark protection to remain relevant in the metaverse, one would expect that territoriality must become less relevant.

The authors consider that this is likely to require legislative intervention and cooperation on an international level.

### Conclusion

Metaverse or multiverse, no matter its form, will rely on the content of the terms and conditions of the different metaverse providers (platforms) and new technologies such as smart contracts, blockchain, and other meta-experience tools such as the internet of things, virtual reality tools, augmented reality tools and AI.

In this meta-world, the notion of creativity and the understanding of "works" are expected to acquire a meaning different from the one in the physical world. To date, NFTs constitute, in their majority, tokens of tangible work creating a nexus between the physical world and the metaverse. For so long as the nexus between physical and digital exists, it would seem that copyright law (despite its territorial constraints) will remain relevant. The question arises whether it would be as

“  
The  
borderless  
nature of the  
metaverse  
is expected  
to create  
practical  
issues  
including  
likelihood  
of confusion  
where  
similar  
trademarks  
registered  
in different  
jurisdictions  
are forced to  
co-exist.”

”

easy for copyright law to remain relevant in the absence of such nexus.

The authors are of the view that copyright law must remain relevant in the sense that it forms the basis of legal protection, noting that as the metaverse develops, territorial constraints will be challenged. Technoregulation could provide a good starting point in enforcing these rights provided such enforcement is founded on valid data verified through data validation centers.

By contrast, the relevance of trademark protection is expected to be more challenging noting the territorial foundations of the trademark registration system. The borderless nature of the metaverse is expected to create practical issues including likelihood of confusion where similar trademarks registered in different jurisdictions are forced to co-exist, jurisdictional and enforcement issues. Legislative intervention would in this context seem necessary.

Case law in the different jurisdictions remains scarce. The only certainty at the moment is that the metaverse has the potential to create a world very different to the one we currently live in and even to the one we imagine! How different, and what the role of intellectual property will be remains to be seen.

### Contact

**Hadjianastassiou, Ioannides LLC**

(Member of the Deloitte Legal network in Cyprus)

11 Michail Paridi Street, Lefkosia, 1095, Cyprus

**Tel:** +357 22 818280

cylegal@deloitte.com

www2.deloitte.com/cy/en.html

<sup>8</sup> Dr. Katharina Garbers-von Boehm, Helena Haag Katharina Gruber, 'Intellectual Property Rights and Distributed Ledger Technology with a focus on art NFTs and tokenized art' <[https://www.europarl.europa.eu/RegData/etudes/STUD/2022/737709/IPOL\\_STU\(2022\)737709\\_EN.pdf](https://www.europarl.europa.eu/RegData/etudes/STUD/2022/737709/IPOL_STU(2022)737709_EN.pdf)>

<sup>9</sup> UKIPO, IP and Metaverse(s) report <<https://www.gov.uk/government/publications/ip-and-metaverses-an-externally-commissioned-research-report/ip-and-metaverses-an-externally-commissioned-research-report>>

<sup>10</sup> See Gabriella Angeletti, Crypto group shamed for spending USD 3 million on "Dune" book, mistakenly believing it had acquired copyright to produce NFTs, THE ART NEWSPAPER, cited in Jessica Rizzo, Non-Fungible Token Litigation: The Early Years.

<sup>11</sup> Dr Paul Gilmour, 'Smart contracts and the metaverse' (2023) 44(7) Company Lawyer, 244

<sup>12</sup> Vladimir Troitskiy, 'Neither Tinder nor Karaoke: Approaching the Legal Status of Non-Fungible Tokens (NFTs)' <<https://ssrn.com/abstract=4581840>>

<sup>13</sup> Andres Guadamuz, 'Non-fungible tokens and copyright', 2021 (4) WIPO Magazine

<sup>14</sup> Decision in the Spanish language may be accessed here: <[https://www.technollama.co.uk/wp-content/uploads/2024/02/SJM\\_B\\_1\\_2024.pdf](https://www.technollama.co.uk/wp-content/uploads/2024/02/SJM_B_1_2024.pdf)>

<sup>15</sup> Alessandro Cerri, 'Spanish court finds that virtual exhibition of NFTs based on paintings is "harmless use' <<https://ipkitten.blogspot.com/2024/02/spanish-court-finds-that-virtual.html>>

<sup>16</sup> UKIPO, IP and Metaverse(s) report <<https://www.gov.uk/government/publications/ip-and-metaverses-an-externally-commissioned-research-report/ip-and-metaverses-an-externally-commissioned-research-report>>





# Back to the Future revisited – NBCUniversal and DeLorean Motor Company settle case involving DeLorean trademark claims

Maya L. Tarr, Principal and Founder of Carob Law, P.C., summarizes the recent dispute over the rights of the DeLorean-related trademarks and the infamous Time Machine Car after the transfer of rights for the DeLorean Motor Company raised questions over granted rights.

# GORODISSKY IP&TMT LAW

An earlier draft of the *Back to the Future* script had a refrigerator as the time machine.<sup>1</sup> The creator's decision to replace a bulky refrigerator with a modified DeLorean car luckily did not "creat[e] a chain reaction that [unraveled] the very fabric of the space-time continuum."<sup>2</sup> However, it likely changed not only the movie's appeal but perhaps the DeLorean's future. NBCUniversal Media, LLC (NBCU) and

<sup>1</sup> See [http://www.scifiscripts.com/scripts/back\\_to\\_the\\_future\\_original\\_draft.html](http://www.scifiscripts.com/scripts/back_to_the_future_original_draft.html)

<sup>2</sup> *Back to the Future Part II* (Universal Pictures 1989).

the DeLorean Motor Company (DMCT) recently settled a trademark case that raised complex issues relating to the transfer of rights over time, who held senior rights in the DeLorean trademarks, and whether NBCU's uses on its merchandise were infringing.

In February 2024, a Central District of California judge partially denied a summary judgment motion by NBCU with respect to certain



istock.com/AOhoho

gorodissky.com



trademark and trade dress infringement claims by DMCT regarding use of DeLorean trademarks and trade dress in connection with merchandising related to the *Back to the Future* film series.<sup>3</sup> The dispute raised intricate issues related to trademark rights with one of the most legendary cars in entertainment history.

The *Back to the Future* film series, the first of which was released in 1985, featured a modified DeLorean DMC-12 as the famous Time Machine Car, which was the only car model produced by John Z. DeLorean's original DeLorean Motor Company. In 1989, predecessors in interest to Universal City Studios, LLC (Universal), which is a subsidiary of NBCU, entered into an agreement with Mr. DeLorean where Mr. DeLorean granted Universal certain rights to DeLorean-related marks and the appearance of the DeLorean car for use in "merchandising and commercial tie-ups" in connection with the film series *Back to the Future*. The agreement represented Mr. DeLorean as the sole owner of the rights granted in the agreement.

The 1989 agreement was entered into with Mr. DeLorean after the original DeLorean Motor Company went bankrupt in 1982, a few years before the release of the *Back to the Future* film series. When the original DeLorean Motor Company

**The dispute raised intricate issues related to trademark rights with one of the most legendary cars in entertainment history.**

<sup>3</sup> *DeLorean Motor Co. v. NBCUniversal Media, LLC*, No. 8:22-cv-02189 (C.D. Cal. Feb. 2024)

went bankrupt in 1982, certain assets were purchased by a liquidation company named Consolidated International. The sales agreement to Consolidated International did not explicitly reference the transfer of trademark rights. In 1997, after a couple of subsequent transfers of these assets, DMCT, a Texas company, acquired them. Starting in 2009, DMCT filed several trademarks with the USPTO for variations of the DeLorean-related marks, with an earliest claimed first use date of 1995.

Mr. DeLorean died in 2005, and in 2014, his estate sued DMCT for infringing certain of DeLorean's trademark rights. Thereafter, in 2015, the parties executed a settlement agreement where the DeLorean estate acknowledged DMCT's trademark rights. However, in the recent lawsuit, the parties disputed whether the 2015 agreement was limited to an acknowledgment of DMCT's trademark registrations only or also common law rights in the car brand and related goods and services. The settlement agreement did not acknowledge the 1989 agreement between Mr. DeLorean and Universal or make any assertions that rights under that agreement were transferred to DMCT.

After DMCT contacted NBCU in 2017 indicating that they were due royalties under the 1989 agree-

ment, NBCU began paying DMCT for outstanding royalties. In 2018, Mr. DeLorean's estate contacted NBCU asserting that it was entitled to the royalties, leading NBCU to pause payment to DMCT so that DMCT and the DeLorean estate could resolve to whom the royalties were owed. In 2018, the DeLorean estate brought a declaratory judgment action against DMCT asserting that the 1989 settlement agreement did not transfer rights to DMCT and that the DeLorean Estate was entitled to royalties by NBCU. However, the court found that according to the 2015 settlement agreement, the DeLorean estate was precluded from bringing the action, so the court did not resolve which rights were transferred to DMCT under the 1989 agreement. Thereafter, NBCU continued to make royalty payments to DMCT.

The Central District of California dismissed DMCT's breach of contract and accounting claims because DMCT did not have standing to enforce the 1989 agreement, but the court denied NBCU's summary judgment motion as to the trademark infringement claim as it found a genuine issue of disputed fact as to whether NBCU was a senior user of the DeLorean marks and whether there was a likelihood of confusion. NBCU asserted that its activities reflected the strength of the



Maya L. Tarr

**Résumé**

**Maya L. Tarr** is the Principal and Founder of Carob Law, P.C., a boutique trademark practice based in New York, New York.

**Contact**

**Carob Law, P.C.**  
11 Broadway,  
Suite 615, New York,  
NY 10004, USA  
info@caroblaw.com  
www.caroblaw.com

Time Machine Car trademark separate and apart from the strength of any of DMCT's trademarks and that there was no overlap between the parties' respective goods. However, DMCT claimed that the goods/services were related because both parties license services related to the use of DeLorean and there was actual confusion by consumers inquiring with DMCT about purchasing cars in the style of the Time Machine Car. NBCU argued, on the other hand, that this demonstrated that consumers were not confused because they understood the differences between rights in the *Back to the Future* film series and the rights in the DeLorean-related marks.

While the case recently settled, the court's denial of NBCU's summary judgment motion on the trademark infringement claim underscores the complexities of transfer of rights and determining trademark infringement in the context of merchandising and entertainment.

**Using Madrid Refusals to effectively expand your IP practice**

Expand the reach of your practice beyond your home country by taking advantage of the global network of IP firms using Madrid.

Gain insight into Madrid refusals issued by your country's trademark office. Find out which representative firms have marks being refused. Discover the filers within your home country who have been refused abroad.

Be proactive and scout potential firms and clients from abroad, and prep for international meetings.

**WEEKLY REPORTS MAY INCLUDE THE FOLLOWING:**

- foreign refusals into your home country
- refusal from your home country into other Madrid jurisdictions
- which third-party marks have been cited (only certain jurisdictions)
- email address of foreign representatives
- WIPO record link

From the company that created the US-market 2(d) Citation Watch... now bringing you global data from foreign IP offices.

**towergateinformatics**

**Contact us:**  
info@towergatesoftware.com • Telephone: +1.866.523.8948

**PALACIO & Asociados ARGENTINA**

INTELLECTUAL PROPERTY

**90 YEARS**

palacio@palacio.com.ar  
www.palacio.com.ar

Your reliable partners for intellectual property matters in Pakistan, South East Asia, Arabian Gulf, Middle East & Africa

**UNited TRADEMARK & PATENT SERVICES**  
International Intellectual Property Attorneys

Trademark, Patent, Design, Copyright, Domain name registration, litigation & enforcement services

**Head Office: (New Postal & Visiting Address)**  
85 -The Mall Road, Lahore 54000 Pakistan (Opposite Ferozsons books store / adjacent rado time center)  
**TEL:** +92-42-36285588-90, +92-42-36285581-84 **FAX:** +92-42-36285585, 36285586, 36285587  
**Email:** UnitedTrademark@UnitedTm.com **Websites:** www.utmps.com and www.unitedip.com

 <b>QATAR</b> Villa # 40, Al Amir Street Al Mirgap Area, Doha, Qatar Tel : +974-444 3083, 444 3093 Fax : +974-444 7311 Email: Qatar@UnitedTm.com	 <b>SAUDI ARABIA</b> Behind Maktaba Al Shawwaf 30th Street-Olaya, Riyadh 11444 Tel : +966 -11- 4616157, 4655477 Fax: +966 -11- 4616156, 4622134 Email: SaudiArabia@UnitedTm.com	 <b>SHARJAH (UAE)</b> Suite 203, Al Buhairah Building Buhairah Corniche, Sharjah Tel : +971-6-5722742 Fax : +971-6-5722741 Email: UAE@UnitedTm.com	 <b>SUDAN (Khartoum)</b> Flat No.1, 3rd Floor, Al Hurriya St. Shaik Al Deen Brothers Bldg. Tel : +249-183-740634 Fax : +249-183-796031 Email: sudan@UnitedTm.com	 <b>TANZANIA</b> Shauri Moyo Area, Pugu Road Dar-Es-Salaam Tel : +255-222862900 Email: Tanzania@UnitedTm.com	 <b>YEMEN</b> 6th Floor Ideal Clinic Building Hadda Street, Sana'a, Yemen. Tel: +967 181 9642 Email: yemen@UnitedTm.com
 <b>DUBAI (UAE)</b> Suites 401-402, Al-Hawai Tower Sheikh Zayed Road, Dubai Tel : +971-4-3437 544 Fax : +971-4-3437 546 Email: Dubai@UnitedTm.com	 <b>JORDAN (Amman)</b> Suite 7, 2nd Floor Chicago Building, Al Abdali Tel : +962-6-5683088 Fax : +962-6-5683089 Email: Jordan@UnitedTm.com	 <b>LEBANON</b> 6th Floor, Burj Al-Ghazal Bldg., Tabaris, Beirut, Lebanon Tel : +961-1-21 5373 Fax: +961-1-21 5374 Email: Lebanon@UnitedTm.com	 <b>MOROCCO</b> 58, Rue Ibn Batouta, PPT. No. 4, 1 er Estage, Casablanca, Morocco Tel : +212-522206096 Email: Morocco@UnitedTm.com	 <b>OMAN</b> Suite No. 702, 7th Floor Oman Commercial Centre, Ruwi Tel : +968-24-787555, 704788 Fax: +968-24-794447 Email: Oman@UnitedTm.com	

REGISTER TODAY!

May 18-22, 2024 | Atlanta, Georgia, USA



# 2024 ANNUAL MEETING

JOIN US FOR THE IP EVENT OF THE YEAR!



SCAN TO REGISTER



# Directory of Services

DIRECTORY OF SERVICES

## ARGENTINA



### O'Conor & Power

O'Conor & Power's trademark and patent practice group has wide experience in handling portfolios for international and domestic companies in Argentina and Latin America. Our services in the region include searches, filing and registration strategies, prosecution, opposition, renewals, settlement negotiations, litigation, enforcement and anti-counterfeiting procedures, recordal of assignments, licences, registration with the National Custom Administration, audit and IP due-diligences, general counselling in IP matters, and counselling in IP matters in Argentina and the region.

**Address:** San Martín 663, 9th Floor, (C1004AAM) Buenos Aires, Argentina  
005411 4311-2740  
005411 5368-7192/3

**Website:** [www.oconorpower.com.ar](http://www.oconorpower.com.ar)  
**E-mail:** [soc@oconorpower.com.ar](mailto:soc@oconorpower.com.ar)  
[ocp@oconorpower.com.ar](mailto:ocp@oconorpower.com.ar)  
[oconor@oconorpower.com.ar](mailto:oconor@oconorpower.com.ar)

## ARMENIA



### Vakhnina & Partners

The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers. Major areas of expertise of our patent team: Chemistry, Pharmaceuticals, Biotechnology, Biochemistry, Life Science etc.

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.

**Address:** Yerevan, Republic of Armenia  
**Tel:** +374 91 066393  
**Email:** [Armenia@vakhnina.com](mailto:Armenia@vakhnina.com)  
**Website:** <http://about.vakhnina.com>  
**Contact:** Dr. Alexey Vakhnin, Partner

## BAHRAIN



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** United Trademark & Patent Services  
Office 21, Sabha Building No. 338  
Road 1705, Block 317 Diplomatic Area,  
Manama, Bahrain

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [Bahrain@unitedtm.com](mailto:Bahrain@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Talal F.Khan & Mr Imad

## BANGLADESH



### Old Bailey Chambers

OLD BAILEY Chambers is a full-service intellectual property law firm in Bangladesh. OLD BAILEY also has expertise in technology, data protection and competition law practice.

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.

**Website:** <https://www.oldbaileybd.com/>  
**Email:** [mishbah@oldbaileybd.com](mailto:mishbah@oldbaileybd.com)  
**Tel:** +8801727444888

## BOLIVIA



### Landivar & Landivar

Established by Gaston Landivar Iturricha in 1961, Landivar & Landivar is a pioneer firm in the field of Intellectual Property in Bolivia. Our international reputation was gained through a competent and complete legal service in our area of specialization. Our firm has grown into a Chain of Corporate Legal Services and Integral Counseling, with the objective of guiding national and international entrepreneurs and business-people towards the success of their activities.

**Address:** Arce Ave, Isabel La Católica Square,  
N° 2519, Bldg. Torres del Poeta, B  
Tower, 9th floor, off. 902. La Paz,  
Bolivia, South America  
**Tel/Fax:** +591-2-2430671 / +591 79503777  
**Website:** [www.landivar.com](http://www.landivar.com)  
**Email:** [ip@landivar.com](mailto:ip@landivar.com) - [info@landivar.com](mailto:info@landivar.com)  
**Contact:** Martha Landivar, Marcial Navia

## CARIBBEAN



### CARIBBEAN TRADEMARK SERVICES

#### Law Office of George C.J. Moore, P.A.

Caribbean Trademark Services, founded by George C.J. Moore in 1981, provides a single contact source of protecting trademarks and patents in the Caribbean. Covering 29 countries, including Belize, Bermuda, Costa Rica and Cuba; a bilingual staff provides IP services tailored to the diverse jurisdictions. Experienced staff members and volume transactions, services are efficient making our single contact, long established source for the Caribbean most cost effective.

**Address:** 2855 PGA Boulevard, Palm Beach  
Gardens, Florida 33410, USA  
**Tel:** +1 561 833-9000  
**Fax:** +1 561 833-9990  
**Contact:** Michael Slavin  
**Website:** [www.CaribbeanTrademarks.com](http://www.CaribbeanTrademarks.com)  
**Email:** [IP@CaribbeanTrademarks.com](mailto:IP@CaribbeanTrademarks.com)

## COLOMBIA



### VERA ABOGADOS ASOCIADOS S.A.

VERA ABOGADOS was founded 50 years ago to attend to legal needs of the business sector in the area of IP. Today they provide their services to all fields of law. The law firm is a reference in the Andean community and they are part of international associations such as INTA, ASIPI, ABPI and ASPI.

They were ranked in 2022 by Leaders League as a highly recommended Colombian law firm and in addition, they are a member of PRAGMA, the International Network of Law Firms.

**Tel:** +57 60-1 3176650  
+57 60-1 3127928  
**Website:** [www.veraabogados.com](http://www.veraabogados.com)  
**Email:** [info@veraabogados.com](mailto:info@veraabogados.com)  
**Contact:** Carolina Vera Matiz, Natalia Vera Matiz

## CZECH REPUBLIC



### Cermak a spol.

Čermák a spol. is a leading IP law firm in the Czech Republic and Slovakia, providing services in all areas of IP law, including patents, trademarks, utility models, industrial designs, unfair competition and others. We have a qualified team of lawyers for both IP prosecution and litigation including litigation in court. Our strengths is a unique combination of experienced and qualified patent attorneys and lawyers.

**Address:** Čermák a spol, Elišky Peškové 15  
150 00 Praha 5, Czech Republic  
**Website:** [www.cermakaspol.com](http://www.cermakaspol.com)  
**Email:** [intelprop@apk.cz](mailto:intelprop@apk.cz)  
**Contact:** Dr. Karel Cermak - Managing Partner  
Dr. Andrea Kus Povazanova - Partner

## DJIBOUTI



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** United Trademark & Patent Services  
Djibouti Branch Djibouti,  
Rue Pierre Pascal, Q. commercial Imm,  
Ali Warki, Djibouti  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [Djibouti@unitedtm.com](mailto:Djibouti@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Imad & Faima Al Heyari



# Directory of Services

**DOMINICAN REPUBLIC**



**WDA International Law Firm**  
Intellectual Property

For over 25 years we have provided excellence in Intellectual Property protection to worldwide renowned companies including the most iconic pharmaceutical, beauty and clothing, beverages and motion pictures companies.

Our main practice is devoted to Intellectual Property which specializes in docketing maintenance of trademarks and patents and litigation attorneys of high profile IPR infringements, border protection and counterfeiting cases in Dominican Republic.

Tel: 809-540-8001  
Website: [www.wdalaw.com](http://www.wdalaw.com)  
Email: [trademarks@wdalaw.com](mailto:trademarks@wdalaw.com)  
Contacts: LIC. Wendy Diaz  
LIC. Frank Lazala  
Whatsapp: 829-743-8001

**DOMINICAN REPUBLIC**



**Guzmán Ariza, Attorneys at Law**

Guzman Ariza is the largest law and consulting firm in the Dominican Republic. Founded in 1927, we have extensive experience in protecting local and international clients' intellectual property rights, including trademarks, trade names, copyrights, and patents. We are your one-stop shop for all of your IP needs in the Dominican Republic.

Our services include: • Trademarks and trade names • Patents • Industrial design • Sanitary • Copyrights • IP management and IP audit • Litigation

Tel: +1 809 255 0980  
Fax: +1 809 255 0940  
Website: [www.drlawyer.com](http://www.drlawyer.com)  
Email: [info@drlawyer.com](mailto:info@drlawyer.com)  
Contact: Fabio Guzmán Saladín, Partner  
fabio@drlawyer.com  
Leandro Corral, Senior Counsel  
lcorral@drlawyer.com

**GHANA · NIGERIA · GAMBIA**



**SN ANKU IP FIRM**

SN ANKU IP FIRM is a trusted, experienced all purpose IP firm. Headquartered in Accra, Ghana, with a strategic presence in Nigeria, and The Gambia, we offer tailored services to safeguard our clients' innovations and ideas. We are accredited ARIPO Agents covering 22 African countries.

Our Services: IP Litigation & Enforcement  
• IP Registration & Recordals  
• Patents, Trademarks, Industrial Designs and Copyright  
• Due Diligence Consulting • Portfolio Management

Tel: +233 597 237 710 (Ghana)  
+234 905 950 8874 (Nigeria)  
+220 721 5283 (The Gambia)  
+1(332) 257-6448 (USA)

Website: [www.snankuipfirm.com](http://www.snankuipfirm.com)  
Email: [www.snankuipfirm.com](mailto:www.snankuipfirm.com)  
Contact: Name: Sarah Norkor Anku  
sarah@snankuipfirm.com

**KYRGYZSTAN**



**Vakhnina & Partners**

The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers.

We handle our clients' cases in Kyrgyzstan, Russia, Armenia, 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, AIPPI, LESI, ECTA, PTMG.

Address: Bishkek, Kyrgyz Republic  
Tel: +996-551-655-694  
Email: [ip@vakhnina.com](mailto:ip@vakhnina.com)  
Website: <https://www.vakhnina.com>  
Contact: Dr. Alexey VAKHNIN and Mr. Vlad PEROV

**LEBANON**



**United Trademark & Patent Services**  
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services  
6th Floor, Burj Al Ghazal Building, Tabaris,  
P. O. Box 11-7078, Beirut, Lebanon

Website: [www.utmps.com](http://www.utmps.com)  
Email: [lebanon@unitedtm.com](mailto:lebanon@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Hanadi

**LUXEMBOURG**



**Patent42**  
Patents and Trademarks

Patent42 is a leading law firm offering a full range of services in the field of Intellectual Property rights. Our team of high-qualified patent and trademark attorneys are entitled to represent client's interests in Europe, Luxembourg, France and Belgium. Patent 42 provides concrete and careful solutions in the area of patents, trademarks and designs. We support clients in all stages of elaboration and implementation of an intellectual property strategy adapted to your needs at both national and international level.

**Whatever your question is, we will find an answer for you.**

Address: BP 297, L-4003 Esch-sur-Alzette,  
Luxembourg  
Tel: (+352) 28 79 33 36  
Website: [www.patent42.com](http://www.patent42.com)  
Email: [info@patent42.com](mailto:info@patent42.com)

**GUATEMALA**



**Ideas Trademarks Guatemala, S.A.**

Ideas is a firm specialized in the defense of intellectual property rights, offering advice on all kinds of issues related to them and in the management of portfolios of distinctive signs and patents, at competitive prices, in the Central American and Caribbean region.

Ideas is focused on meeting the needs and solving the problems of its clients, setting clear expectations and obtaining creative solutions with minimal exposure and cost-effective. Proactivity has determined our constant growth and modernization, maintaining a high standard of quality and satisfaction in our professional services.

Tel: +502 2460 3030  
Website: <https://www.ideasips.com/?lang=en>  
Email: [guatemala@ideasips.com](mailto:guatemala@ideasips.com)  
Contact: Gonzalo Menéndez, partner,  
gmenendez@ideasips.com  
Gustavo Noyola, partner,  
noyola@ideasips.com

**GUATEMALA**



**Merida & Asociados**

The firm provides services throughout the range of different legal matters, specializing in the banking industry both nationally and internationally, business law, banking law, trademarks and patents, litigation, notary law, litigation and arbitration. We are a very well-known law firm for Intellectual Property in Guatemala. Our office serves clients from abroad, including clients from Europe and the United States, as well as Japan and other countries.

Address: 20 calle 12-51 "A" zona 10,  
Guatemala City, 01010, Guatemala  
Armando Mérida, Section 019170,  
P.O. Box 02-5339, Miami, Florida,  
33102-5339, USA  
(502) 2366 7427  
Tel: <http://www.meridayasociados.com.gt/en>  
Website: <http://www.meridayasociados.com.gt/en>  
Email: [corporativo@meridayasociados.com.gt](mailto:corporativo@meridayasociados.com.gt)  
Contact: Armando Merida

**INDIA**



**Chandrakant M Joshi**

Our law firm has been exclusively practicing Intellectual Property Rights matters since 1968. Today, Mr. Hiral Chandrakant Joshi heads the law firm as the senior most Attorney. It represents clientele spread over 35 countries. The law firm conducts search, undertakes registration, post-registration IP management strategies, IP valuation, infringement matters, domain name disputes and cyber law disputes of patents (including PCT applications), trademarks, industrial designs and copyrights.

Address: 6th Floor, Solitaire-II, Link Road,  
Opp. Infinity Mall, Malad (West),  
Mumbai 400 064, India.  
Tel: +91 22 28886856 / 57 / 58 / 64  
Fax: +91 22 28886859 / 65  
Website: [www.cmjoshi.com](http://www.cmjoshi.com)  
Email: [mail@cmjoshi.com](mailto:mail@cmjoshi.com)  
[patents@cmjoshi.com](mailto:patents@cmjoshi.com)  
[trademarks@cmjoshi.com](mailto:trademarks@cmjoshi.com)

**MACAU**



**IPSOL**

IPSOL is a key service line focused on the planning, registration and management of trademark, patent and other IP rights portfolios, offering solutions that enable to maximize the protection of your IP assets in Macau and worldwide.

Address: Avenida da Praia Grande, 759,  
5º andar, Macau  
(853) 2837 2623  
Tel: (853) 2837 2613  
Fax: (853) 2837 2613  
Website: [www.ipsol.com.mo](http://www.ipsol.com.mo)  
Email: [ip@ipsol.com.mo](mailto:ip@ipsol.com.mo)  
Contact: Emalita Rocha

**MALAYSIA**



**Adastra IP**

Adastra IP is a full service IP firm with offices across the South East Asia, India and Australia with a full team of legal and technical specialists to handle drafting, responses and filings for Trademarks, Patents and Designs with emphasis on value and service for our clients. In addition, we have IP analytics and IP valuation capabilities aside from prosecution work to support our clients' IP needs.

Tel: +60322842281  
Website: [www.adastraip.com](http://www.adastraip.com)  
Email: [info@adastraip.com](mailto:info@adastraip.com)  
Contact: Mohan K.  
Managing Director

**MALAYSIA**



**MarQonsult IP**

MarQonsult® was established in February 2002 and is located in Petaling Jaya, nearby the MyIPO. MarQonsult® was founded by Clara C F Yip, who holds a double degree in law and economics from Auckland University, NZ. MarQonsult® is synonymous with effective delivery of services marked by its: quick response time; in-depth client counselling; affordability and adaptability; commercially viable IP strategies; result-oriented approach; and a high rate of success.

Tel: +603 78820456  
Fax: +603 78820457  
Website: [www.marqonsult.com](http://www.marqonsult.com)  
Email: [clara@marqonsult.com](mailto:clara@marqonsult.com)  
Contact: Clara C F Yip (Ms)

**INDIA**



**L. S. DAVAR & CO.**  
PATENT AND TRADEMARK ATTORNEYS

We are India's oldest Intellectual Property and Litigation Firm. Since 1932, we have been as a trusted IP partner of Global Large and Mid-size companies and foreign IP law firms. We have been widely acknowledged by Govt. of India. In the last 90 years, we have retained number one position in India in not only filing the Patents, Designs, Trademarks, Copyright, and Geographical Indications but also in getting the grants.

Tel: 033- 2357 1015 | 1020  
Fax: 033 - 2357 1018  
Website: [www.lsdavar.com](http://www.lsdavar.com)  
Email: [mailinfo@lsdavar.in](mailto:mailinfo@lsdavar.in)  
Contact: Dr Joshita Davar Khemani  
Mrs. Dahlia Chaudhuri

**ISRAEL**



**Gold Patents and Financial Services (1992) Ltd.**

Gold Patents and Financial Services (1992) Ltd. is an intellectual property solution provider firm that operates in Israel as well as worldwide. We specialize in providing evaluation and analyses of IP portfolios; prosecuting and drafting complex patent, design, and trademark applications; freedom-to-operate, due diligence, patentability, validity and infringement opinions. We provide high quality services and solutions that support our clients' business goals and deliver superior IP services in a timely and cost-effective manner.

Address: 15 Yohanan Hasandlar St., Haifa 31251  
Tel/Fax: +972-48110007/ +972-46892283  
Website: [www.gold-patent.co.il](http://www.gold-patent.co.il)  
Email: [office@gold-patent.co.il](mailto:office@gold-patent.co.il)  
Contact: Marganit Goldraich

**JORDAN**



**United Trademark & Patent Services**  
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services  
Suite 7, 2nd Floor, Chicago Building,  
Al Abdali, P.O. Box 925852, Amman,  
Jordan  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [jordan@unitedtm.com](mailto:jordan@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Mrs Fatima Al-Heyari

**MAURITIUS**



**Yusuf S Nazroo**  
IP Agent/Consultant  
Member of CITMA-INTA-APAA-AIPPI

Address: 12 Frère Félix De Valois Street,  
Port Louis, Mauritius  
Tel: +230 57 14 09 00  
Fax: +230 212 27 93  
Website: <http://yn-trademark.com>



*Greetings from Mauritius the Rainbow Island*

**MEXICO**



**Goodrich Riquelme Asociados**

Our staff of attorneys, engineers and computer specialists help adapt foreign patent specifications and claims to Mexican law, secure patent inventions and trademark registrations and maintain them by handling the necessary renewals. Our computer system, which is linked to the Mexican Patent and Trademark Department, permits us to provide our clients with a timely notice of their intellectual property matters. We also prepare and register license agreements.

Address: Paseo de la Reforma 265, M2, Col. Y  
Del. Cuauhtemoc, 06500 Mexico, D.F.  
Tel: (5255) 5533 0040  
Fax: (5255) 5207 3150  
Website: [www.goodrichriquelme.com](http://www.goodrichriquelme.com)  
Email: [mailcentral@goodrichriquelme.com](mailto:mailcentral@goodrichriquelme.com)  
Contact: Enrique Diaz  
Email: [ediaz@goodrichriquelme.com](mailto:ediaz@goodrichriquelme.com)

**MEXICO**



**TOVAR & CRUZ IP-LAWYERS, S.C.**

We are a specialized legal firm providing intellectual property and business law services. Founded in 2009. The purpose is that our clients not only feel safe, besides satisfied since their business needs have been resolved, so, our professional success is also based on providing prompt response and high quality, personalized service. "Whatever you need in Mexico, we can legally find the most affordable way"

Tel: +52 5528621761 & +52 5534516553  
Address: Rio Mixcoac No. 25, Floor Mezzanine A,  
Crédito Constructor, 03940 Mexico City.  
Website: [www.tciplaw.mx](http://www.tciplaw.mx)  
Email: [ecruz@tciplaw.mx](mailto:ecruz@tciplaw.mx); [mtovar@tciplaw.mx](mailto:mtovar@tciplaw.mx);  
[contactus@tciplaw.mx](mailto:contactus@tciplaw.mx)  
Contact: Elsa Cruz, Martin Tovar



# Directory of Services

**MOROCCO**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** United Trademark & Patent Services  
 58, rue Ibn Battouta 1er étage,  
 no 4. Casa Blanca, Morocco

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [morocco@unitedtm.com](mailto:morocco@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Yawar Irfan Khan

**NEPAL**



**Kraya And Partners**  
 We are an independent, full-service IP law firm focused on providing cost-efficient services to protect, manage, enforce and evaluate IP Rights in the changing legal landscape. Our endeavor is to set new benchmarks and raise existing standards to reflect our passion. Our practice areas include IP counselling, prosecution, and litigation. This includes Trademark, Patent, Design, Copyrights, IP Litigation, Trademark Watch/ TM Monitoring, Business Management, Domain Registration and more.

**Tel:** +977-9851181729 +977-9808370262  
**Website:** [www.kraya.com.np](http://www.kraya.com.np)  
**Email:** [info@kraya.com.np](mailto:info@kraya.com.np); [kraya@kraya.com.np](mailto:kraya@kraya.com.np)  
**Contacts:** Nabin Khadka, Managing Partner  
[info@kraya.com.np](mailto:info@kraya.com.np)  
 Susmita Bhattarai, Associate  
[kraya@kraya.com.np](mailto:kraya@kraya.com.np)

**NIGERIA**



**ALN Nigeria | Aluko & Oyebo**  
 The IP practice at ALN Nigeria | Aluko & Oyebo is recognised as a leader in handling patents, trademarks, copyrights, designs, and related IP litigation in Nigeria. The Firm's IP team has an extensive trial experience and provides an incomparable expertise in a variety of IP matters, including clearance searches, protection, portfolio management, use and enforcement of trademarks, copyright, patents, design and trade secrets, licensing, technology transfer (interface with the National Office for Technology Acquisition and Promotion), franchising, media law, packaging, advertising, labelling, manufacturing and distribution agreements, and product registration with the National Agency for Food and Drug Administration and Control (NAFDAC).

**Website:** [www.aluko-oyebode.com](http://www.aluko-oyebode.com)  
**Email:** [AOIP@aluko-oyebode.com](mailto:AOIP@aluko-oyebode.com)  
**Contacts:** Uche Nwokocha (Partner):  
[Uche.Nwokocha@aluko-oyebode.com](mailto:Uche.Nwokocha@aluko-oyebode.com)  
 Tel: +234 703 400 1093  
 Regina Onwumere (Senior Associate)

**RUSSIA**



**Vakhnina and Partners**  
 The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers. Major areas of expertise of our patent team: Chemistry, Pharmaceuticals, Biotechnology, Biochemistry, etc. We handle our clients' cases in Russia, Armenia, 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, AIPPI, LESI, ECTA, PTMG.

**Address:** Moscow, Russia  
**Tel:** +7-495-946-7075  
**Website:** <https://www.vakhnina.com>  
**Email:** [ip@vakhnina.com](mailto:ip@vakhnina.com)  
**Contact:** Dr. Tatiana VAKHNINA  
 Dr. Alexey VAKHNIN

**SAUDI ARABIA**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** 30th Street, Olaya Opposite to Madaris  
 Al Mustaqbil, P.O. Box 15185,  
 Riyadh 11444, Kingdom of Saudi Arabia

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [saudia@unitedtm.com](mailto:saudia@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Dr.Hasan Al Mulla &  
 Justice R Farrukh Irfan Khan

**SLOVAKIA**



**Boldiz Law Firm s.r.o.**  
 Boldiz Law Firm is a boutique law firm which provides high quality services and solutions that support client's needs in national (Slovak) and European trademark & design law in a cost-efficient way. We are a full-service brand protection law firm, qualified to assist with all types of legal services related to trademarks and designs, such as registrations, oppositions, litigation, IP enforcement services and many others.

**Tel:** +421 915 976 275  
**Website:** [www.boldiz.com/en](http://www.boldiz.com/en)  
**Email:** [info@boldiz.com](mailto:info@boldiz.com)  
**Contact:** Dr. Ján Boldizsár

**OMAN**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** Suite No. 702, 7th Floor, Commercial Centre, Ruwi Muscat, Sultanate of Oman, P. O. Box 3441, Postal Code 112 Ruwi, Sultanate of Oman

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [oman@unitedtm.com](mailto:oman@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** S.Maqqool & T.F. Khan

**PAKISTAN**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 International Intellectual Property Attorneys specialising in Trademarks, Patents, Designs, Copyrights, Domain Name Registration, Litigation & Enforcement services.

**Address:** 85 The Mall Road, Lahore 54000, Pakistan

**Tel:** +92 42 36285588, +92 42 36285590,  
 +92 42 36285581, +92 42 36285584

**Fax:** +92 42 36285585, +92 42 36285586,  
 +92 42 36285587

**Website:** [www.utmps.com](http://www.utmps.com) & [www.unitedip.com](http://www.unitedip.com)  
**Email:** [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Yawar Irfan Khan, Hasan Irfan Khan

**POLAND**



**LION & LION Kancelaria Patentowa Dariusz Mielcarski**  
 We offer:

- a full range of services related to patents, utility models, designs and trademarks in Poland as well as Community Designs and European Trademarks in the EU
- cooperation with patent agencies in all PCT countries
- preparation of patent applications from scratch for filing in the USA
- validations of EU patents in Poland,
- annuity payments

**Tel:** +48 663 802 804  
**Website:** [www.LIONandLION.eu](http://www.LIONandLION.eu)  
**Email:** [patent@lionandlion.eu](mailto:patent@lionandlion.eu)  
**Contact:** Dariusz Mielcarski,  
 Patent and Trademark Attorney

**SRI LANKA**



**Julius & Creasy**  
 Julius and Creasy is one of the oldest civil law firms in Sri Lanka. Founded in 1879, the firm has established itself on rich tradition and the highest professional principles. Julius and Creasy's wealth of expertise and experience in a wide range of specialised fields of Law enables it to offer innovative legal and business solutions to a diverse, sophisticated and high-profile clientele. The Intellectual Property practice of the firm includes enforcement, management and transactional matters. The firm has acted for several Fortune 500 companies and is Sri Lanka correspondent of several firms in Europe, USA and Asia.

**Address:** No. 371, R A De Mel Mawatha, Colombo 3, Sri Lanka  
 94 11-2336277

**Tel:** +94 11-2336277  
**Website:** [www.juliusandcreasy.com](http://www.juliusandcreasy.com)  
**Email:** [anomi@juliusandcreasy.lk](mailto:anomi@juliusandcreasy.lk)  
**Contact:** Mrs Anomi Wanigasekera

**SRI LANKA**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** U.T.P.S Lanka (Pvt) Ltd  
 105, Hunupitiya Lake Road,  
 Colombo - 2, Sri Lanka

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [srilanka@unitedtm.com](mailto:srilanka@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Krishni & M.F. Khan

**SWEDEN**



**Fenix Legal**  
**INTERNATIONAL PATENT AND LAW FIRM**  
 Fenix Legal, a cost-efficient, fast and professional Patent and Law firm, specialized in intellectual property in Europe, Sweden and Scandinavia. Our consultants are well known, experienced lawyers, European patent, trademark and design attorneys, business consultants, authorized mediators and branding experts. We offer all services in the IP field including trademarks, patents, designs, dispute resolution, mediation, copyright, domain names, IP Due Diligence and business agreements.

**Tel:** +46 8 463 50 16  
**Fax:** +46 8 463 10 10  
**Website:** [www.fenixlegal.eu](http://www.fenixlegal.eu)  
**Email:** [info@fenixlegal.eu](mailto:info@fenixlegal.eu)  
**Contacts:** Ms Maria Zamkova  
 Mr Petter Rindforth

**POLAND**



**Sigeon IP, Grzelak & Partners**  
 Sigeon IP, Grzelak & Partners are professionals specializing in the protection of intellectual property rights, as well as in broadly defined patent, trademark, design, legal, IP- related business, management and strategic consulting. Thanks to the close cooperation within one team of the Polish and European Patent & Trademark Attorneys, Attorneys-at-Law and business advisors, we offer the highest quality "one-stop-shop" service in Poland and Europe.

**Tel:** +48 22 40 50 401/301  
**Fax:** +48 22 40 50 221  
**Website:** [www.sigeon.pl/en](http://www.sigeon.pl/en)  
**Email:** [ip@sigeon.pl](mailto:ip@sigeon.pl)  
**Contacts:** [anna.grzelak@sigeon.pl](mailto:anna.grzelak@sigeon.pl) (patents, management & international cooperation)  
[tomasz.gawrylczyk@sigeon.pl](mailto:tomasz.gawrylczyk@sigeon.pl) (trademarks, designs & legal)

**QATAR**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

**Address:** Ahmed Al-Misnad Building, Building No. 241, 2nd Floor, Office 9, Street No. 361, Zone No. 37, Mohammad Bin Thani Street, Bin Omran P.O.Box : 23896 Doha

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [qatar@unitedtm.com](mailto:qatar@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Ahmed Tawfik & M.Y.I. Khan

**RUSSIA**



**KHUSAINOV KHOMYAKOV**  
**Intellectual property attorneys**  
 KHUSAINOV KHOMYAKOV is a full-service IP law firm with offices in Kazan (Russia) and Istanbul (Turkey), providing services to clients in Russia and Eurasia. We specialize in a range of services, including filing and prosecuting trademark and patent applications, handling registration and protection of rights to designs, software, and copyrights, conducting patent and trademark searches, handling IP legal disputes, and supporting transactions with IP rights.

**Tel:** +7 843 215 00 55  
**Web:** <https://en.khp.legal/>  
**Email:** [info@khp.legal](mailto:info@khp.legal)  
**Contact:** Ramzan Khusainov, LL.M., Managing Partner  
 Anton Khomyakov, Ph.D., Senior Partner

**TAIWAN, ROC**



**Deep & Far Attorneys-at-law**  
 Deep & Far attorneys-at-law deal with all phases of laws with a focus on IPRs, and represent some international giants, e.g. InterDigital, MPS, Schott Glas, Toyo Ink, Motorola, Cypress. The patent attorneys and patent engineers in Deep & Far normally are generally graduated from the top five universities in this country. More information regarding this firm could be found from the website above-identified.

**Address:** 13 Fl., 27 Sec. 3, Chung San N. Rd., Taipei 104, Taiwan  
**Tel/Fax:** 886-2-25856688/886-2-25989900  
**Website:** [www.deepnfar.com.tw](http://www.deepnfar.com.tw)  
**Email:** [email@deepnfar.com.tw](mailto:email@deepnfar.com.tw)  
**Contact:** C.F. Tsai, Yu-Li Tsai

**TAIWAN**



**TOP TEAM INTERNATIONAL PATENT AND TRADEMARK OFFICE**  
 TOPTEAM's trademark practice supports all areas of brand protection for a trademark's full lifespan. We counsel clients on trademark selection, adoption and filing strategies – and the correct enforcement options – from the earliest stages. Our experience handling complex foreign and domestic trademark issues allows us to preemptively address potential risks and avoid unwanted problems during prosecution or post-registration proceedings.

**Tel:** +886.2.2655.1616  
**Fax:** +886.2.2655.2929  
**Website:** <https://www.top-team.com.tw>  
**Email:** [trademark@top-team.com.tw](mailto:trademark@top-team.com.tw)  
**Contact:** Lydia Wong, Principal Attorney at Law

**TANZANIA**



**Bowmans Tanzania Limited**  
 Bowmans Tanzania Limited offers full IPR services in Tanzania and the rest of countries in the East Africa and ARIPO region member states. We have an experienced team of lawyers headed by Audax Kameja, a Senior Partner of 35+ years of experience, and Francis Kamuzora, with an experience of 15+ years. We have been a firm of choice, and have a track record in advising and representing some of the biggest and prestigious brand owners in IPR litigation and in other non-contentious transactions.

**Website:** [www.bowmanslaw.com](http://www.bowmanslaw.com)  
**Email:** [francis.kamuzora@bowmanslaw.com](mailto:francis.kamuzora@bowmanslaw.com)  
**Contacts:** Francis Kamuzora  
 Audax Kameja

# Directory of Services

## TANZANIA



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services  
Shauri Mayo Area, Pugu Road,  
Dar-Es-Salaam, Tanzania  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [tanzania@unitedtm.com](mailto:tanzania@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: Mr Imad & Fatima Al Heyari

## UNITED ARAB EMIRATES



### Marks n Brands Intellectual Property

MnB IP is a specialized IP firm providing high quality services including the registration and maintenance of trademarks, industrial designs, patents and copyrights in the United Arab Emirates, Saudi Arabia, Oman, Bahrain, Kuwait and across the MENA (Middle East & North Africa) region for both the individual and corporate clients. We are committed to provide high quality professional services through personal attention to the clients' needs.

Tel: +971 56 936 7973  
Website: [www.marksnbrandsip.com](http://www.marksnbrandsip.com)  
Email: [info@marksnbrandsip.com](mailto:info@marksnbrandsip.com)  
Contact: Mahin Muhammed

## U.A.E.



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services  
Suite 401-402, Al Hawaii Tower,  
Sheikh Zayed Road, P.O. Box 72430,  
Dubai, United Arab Emirates  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [uae@unitedtm.com](mailto:uae@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: M.F.I. Khan, SM. Ali & Maria Khan

## UKRAINE



### EIMar-IP Agency

EIMar-IP Agency was founded in 2010 and specializes in the intellectual property rights protection in Ukraine. Providing of services by specialists with more than 15 years' experience, professional competence and education, competitive prices with client budget orientation allow us to provide our clients with the range of IP services including representation before the Trademark and Patent Office, the Board of Appeal and in court procedures.

Tel: +38 093 587 91 25  
Website: <https://elmar-ip.com/>  
Email: [elmarip33@gmail.com](mailto:elmarip33@gmail.com)  
[clients@elmar-ip.com](mailto:clients@elmar-ip.com)  
Contact: Mrs. Elvira Volkova  
Mrs. Julia Postelnik

## UKRAINE



### Pakharenko & Partners

Pakharenko & Partners provides full IP service coverage in Ukraine, CIS countries and Baltic states and has offices in Kyiv and London. We pride ourselves on an exclusive expertise and experience in the fields of IP law, anti-counterfeiting and anti-piracy, pharmaceutical law, competition law, advertising and media law, corporate law, litigation and dispute resolution.

Address: P.O.Box 78, 03150 Kyiv, Ukraine  
Visiting: Business Centre 'Olimpiyskiy',  
72 Chervonoarmijska Str.,  
Kyiv 03150, Ukraine  
Tel: +380(44) 593 96 93  
Fax: +380(44) 451 40 48  
Website: [www.pakharenko.com](http://www.pakharenko.com)  
Email: [pakharenko@pakharenko.com.ua](mailto:pakharenko@pakharenko.com.ua)  
Contact: Antonina Pakharenko-Anderson  
Alexander Pakharenko

## VIETNAM



### ELITE LAW FIRM

ELITE LAW FIRM is very pleased to assist our esteemed clients in Registration of their Intellectual property rights Safely, Effectively and Handle IP Rights disputes Quickly So that Clients can Do Business Strongly and Successfully Develop.

Tel: (+84) 243 7373051  
Hotline: (+84) 988 746527  
Website: <https://lawfirmelite.com/>  
Email: [info@lawfirmelite.com](mailto:info@lawfirmelite.com)  
Contact: Nguyen Tran Tuyen (Mr.)  
Patent & Trademark  
Attorney  
[tuyen@lawfirmelite.com](mailto:tuyen@lawfirmelite.com)  
Hoang Thanh Hong (Ms.)  
Manager of IP Division  
[honght@lawfirmelite.com](mailto:honght@lawfirmelite.com)



## VIETNAM



### Pham & Associates

Established in 1991, staffed by 110 professionals including 14 lawyers and 34 IP attorneys, Pham & Associates is a leading IP law firm in Vietnam. The firm has been being the biggest filers of patents, trademarks, industrial designs and GIs each year and renowned for appeals, oppositions, court actions, out-of-court agreements and handling IP infringements. The firm also advises clients in all aspects of copyright and other matters related to IP.

Tel: +84 24 3824 4852  
Fax: +84 24 3824 4853  
Website: [www.pham.com.vn](http://www.pham.com.vn)  
Email: [hanoi@pham.com.vn](mailto:hanoi@pham.com.vn)  
Contact: Pham Vu Khanh Toan, Managing  
Partner,  
General Director  
Tran Dzung Tien, Senior IP Consultant

## VIETNAM



### Tri Viet & Associates

Tri Viet & Associates is a registered and fully licensed IP & LAW FIRM based in Hanoi, Vietnam. The firm provides a full range of IP services, strongly focuses on PATENT and PCT services, in a wide range of industries and modern technologies, in Vietnam, Laos, Cambodia, Myanmar, and other jurisdictions upon client's inquiries.

Tri Viet & Associates is a member of AIPPI, INTA, APAA, VBF, HBA, VIPA.  
Tel: +84-24-37913084  
Fax: +84-24-37913085  
Website: [www.trivietlaw.com.vn](http://www.trivietlaw.com.vn)  
Email: [info@trivietlaw.com.vn](mailto:info@trivietlaw.com.vn)  
Contact: Nguyen Duc Long (Mr.),  
Managing Partner,  
Reg. Patent & Trademark Attorney  
<https://www.linkedin.com/in/longnguyen-tva>

LinkedIn: <https://www.linkedin.com/in/longnguyen-tva>

To list  
your firm in  
this section,  
please email  
[katie@ctclegalmedia.com](mailto:katie@ctclegalmedia.com)

*A Foundation to Your Success!*



IMITATORS FOLLOW INNOVATION



100 YEARS

GRÜNECKER

INTELLECTUAL PROPERTY LAW SINCE 1924

Patent Law · Patent Infringement · Trademark Prosecution · Design · Copyrights · Competition Law  
Trademark Litigation & Anti-Counterfeiting · Digitalization & Data Protection · Due Diligence  
Contracts & Antitrust · Licensing & Technology Transfer · Know-How & Trade Secrets Protection

[WWW.GRUNECKER.DE](http://WWW.GRUNECKER.DE)