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The Madrid Protocol to make it to Hong Kong

Issue 4 2024

Lawyer



Jiezhen (Amy) Min, Trademark Attorney at Beijing Sanyou Intellectual Property Agency Ltd., details examination considerations for identifying malicious intention based on past CINPA decisions to provide advice on good practices.







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Mission statement

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

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Editor's welcome

n this issue's cover story, we explore the long-awaited implementation of the Madrid Protocol in Hong Kong, providing an in-depth look at the preparations underway as the region moves closer to integrating this international system after a decade of anticipation.

Our guest interview features David Christopherson, EVP, Chief Administrative Officer & Chief Legal Officer of Floor & Decor. In this exclusive discussion, David shares key takeaways from a recent trademark infringement trial concerning the 'Floor & Decor' mark, offering invaluable insights for navigating such challenges successfully.

Further, we examine the complex issue of malicious intention in trademark administrative cases with expert advice based on recent CINPA decision; navigate the intricate landscape of intellectual property rights in Russia post-2022, addressing the legislative challenges brought on by sanctions; and undertake a comparative analysis of trademark consent provisions in Japan, India, and the USA, delving into the varying levels of flexibility and rigidity across these jurisdictions.

challenges successfully.

From here, we discuss the emerging threats to trademarks in Russia with insights into how geopolitical tensions are affecting brand protection; assess the evolving landscape of brand protection and the shifting role of trademark lawyers, providing essential advice for staying ahead; explain the intricacies of trademark popularity and protection

in Russia, offering guidance on securing well-known trademark status; and explore the complex relationship between AI and IP.

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Chris Mitchell, a member of Dickinson Wright, has practiced exclusively in the area of intellectual property law for over 25 years.

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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,

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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.

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The Madrid Protocol to make it to Hong Kong

Ellen Wan, Head of the Hong Kong Trademark Team at China Patent Agent (H.K.) Ltd., introduces the Madrid Protocol System as preparations progress for it to be implemented into practice in Hong Kong after a decade of anticipation.

n Hong Kong, the implementation of the Madrid Protocol for trademarks has been a topic of discussion for nearly a decade. Although the implementation timeline has yet to be officially announced, the wait is nearly over, and the Madrid Protocol will hopefully become effective soon.

The Hong Kong Special Administrative Region ("HKSAR") Government has been taking steps to move forward with the process over the last 10 years, including in the related subsidiary legislation and adjusting the required information technology system for implementation of the international trademark registration system in Hong Kong.

The Madrid Protocol provides a convenient and cost-effective solution for international registration of trademarks in over 100 member

Résumé

Ellen Wan is a trademark specialist and Head of the Hong Kong Trademark Team of China Patent Agent (H.K.) Limited. Ellen has been working in the Intellectual Property area since 1995, with extensive experience in contentious and non-contentious trademark matters at all levels in Hong Kong and China, including trademark clearance searches, trademark application filings and prosecution, licensing, opposition, revocation, and invalidation. Ellen is especially experienced in legal consultancy of strategic analysis for complex trademark issues, negotiation agreements, and challenging portfolio management for national and international clients.



Ellen Wan

countries. With the implementation of the Madrid Protocol in Hong Kong, the Hong Kong Intellectual Property Department ("HKIPD") shall be an Office of Origin to enable Hong Kong trademark owners to extend their trademark protection in multiple jurisdictions in one single application. HKIPD shall also be the Designated Office to give overseas trademark applicants the option to include Hong Kong as one of the jurisdictions in their application for international trademark registration.

International registration with Hong Kong characteristics

Special arrangements have evolved between the Central Government of China and the World Intellectual Property Organization to bring the Madrid Protocol into effect in Hong Kong. With these arrangements, Hong Kong is joining the Madrid Protocol as the same contracting party as China

Contracting parties to the Madrid Protocol have to be either sovereign states or qualified intergovernmental organizations, meaning that, as a special administrative Region of China, Hong Kong cannot be a contracting party to the Madrid Protocol. China became a contracting party to the Madrid Protocol in 1995 and clarified to WIPO in 1997 that the territorial extension of the International registration in Mainland China "will be deferred to be applied to the Hong Kong Special Administrative Region". Further, article 153 of the Basic Law of the Hong Kong Special Administrative Region of the People's Republic of China provides that "the application to the HKSAR of international agreements to which the People's Republic of China is or becomes a party shall be decided by the Central People's Government, in accordance with the circumstances and needs of the Region, and after seeking the views of the government of the

Region". In other words, the implementation of the Madrid Protocol in Hong Kong is subject to the decision of the Central People's Government. According to the HKSAR government, the Central People's Government has indicated its in-principle support for the proposed application of the Madrid Protocol to Hong Kong.

Given the special arrangements, here are the noteworthy points in the implementation of the Madrid Protocol to Hong Kong:

- 1. Although China has been a contracting party to the Madrid Protocol since 1995 and Hong Kong is treated as the same contracting party as China, an international registration with a territory extension to China does not automatically give the same protection in Hong Kong or vice versa before and after Hong Kong's accession to the Madrid Protocol system.
- 2. The Madrid Protocol gives trademark applicants the convenience to apply for registration of trademarks internationally among contracting parties. In light that



Hong Kong is joining the Madrid **Protocol** as the same contracting party as China.

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the Madrid Protocol is an international agreement and Hong Kong is part of China, an international registration with China as the "Office of Original" cannot have Hong Kong as a "Designated Office", meaning that applicants from Mainland China shall not be able to extend their international trademark protection to Hong Kong or vice versa through the Madrid Protocol route. According to the HKSAR government, discussions with the relevant authorities of Mainland China have been ongoing regarding the possibility of putting a separate administrative arrangement in place to facilitate reciprocal applications between Hong Kong and Mainland China.

Advantages of international registration

As we all know, the Madrid Protocol streamlines registration applications, registration maintenance, and the payment process for applicants seeking trademark protection in multiple jurisdictions.

The first advantage of international registration

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through the centralized system under the Madrid Protocol is that an applicant only needs to file one application in one language to designate various countries and pay one-time initial registration fees. This will save applicants time and costs incurred from dealing with different foreign associates. Applicants from Hong Kong and overseas countries only need one local associate to file through to registration in straightforward cases. Foreign associates are only required if objections or oppositions are raised and the applicant will pursue the application in that jurisdiction.

Another advantage of centralized registration is simplified portfolio management and maintenance to save trademark owners time and costs, especially for companies with large trademark portfolios. Trademark owners no longer need to manage different renewal deadlines in various jurisdictions. They do not have to deal with foreign associates, go through different formalities, and meet different documentation requirements in case of changes in ownership such as assignments, mergers and acquisitions, or changes in name or address.

Chinese applicants who have real and effective industrial, commercial establishments, or are domiciled in Hong Kong are entitled to apply for registration under the Madrid Protocol. In China, the increasingly crowded register and bad-faith trademark squatting have made it more and more difficult to get a registration. For export businesses of Mainland China, basing their international application on a Hong Kong trademark application/registration would be more advantageous for several reasons, among which (1) Applicants can register their marks for a broad scope of goods/services as Hong Kong Trade Marks Registry is quite open in terms of designation of goods and services and does not have a subclass practice. Whatever description is accepted under the current NICE classification will generally be accepted in Hong Kong. As long as the description of goods and services is clear for classification, applicants can identify their goods and services in a relatively flexible way in Hong Kong, whereas in China, applicants have to follow "standard" terms of goods and services to be accepted by CNIPA; (2) although applications for registration of trademarks are subject to examination to determine their availability, chances of being viewed as similar to any earlier rights would be lower in a less crowded register in Hong Kong. Likewise, the chances of running into conflict or dispute with earlier rights of third parties would be lower as the register is less crowded and applicants will have better changes of having straightforward cases in Hong Kong. With a "central attack" policy in international registration, the stability of trademark

Applicants can register their marks for a wide scope of qoods/ services as Hong Kong Trade Marks **Registry** is quite open in terms of designation of goods and services and does not have

a subclass

practice.

ownership derived from the basic applications/ registrations would be particularly important.

Limitation of international registration

"Central Attack" is generally acknowledged as the major risk of an international registration. Within five years from the date of an international registration, if the home registration ceases to have effect as a result of action taken by a third party, voluntary abandonment, or any other course of action, the international registration which has cost the applicant a good amount of money and efforts shall be automatically canceled in all designated countries. This leads to uncertainty and vulnerability of a trademark right acquired through international registration in its first five years, which is also called the "dependency period".

Applicants may need to know the risks and plan ahead before they file an application for international trademark registration. Preparation work, such as comprehensive searches in home countries to determine the registrability and availability of the trademarks, as well as the likelihood of running into conflict with trademarks of third parties, and preliminary searches in countries to be designated in the international applications to estimate the chances of registering, may be necessary.

Due to the dependency of international registrations in their first five years, trademark owners shall have to maintain their home registrations regardless of whether they still need them. As a special administrative region with a population of only 7.5 million, the local market in Hong Kong is relatively small. With the advantage of access to mainland China's manufacturing centers, most Hong Kong manufacturers have production facilities in China, and their goods are going overseas. For local Hong Kong applicants seeking protection through the Madrid Protocol route, consideration must be taken for the potential risk of revocation for not using the trademarks in the local market and also the costs to be incurred from defending the home registrations.

An international trademark application has to mirror its home application or registration. They cannot go beyond the home application or registration. In some member countries (e.g., the US), goods and services in general terms are unacceptable, and applicants have to specify their goods and services to tally with what has been/is to be in actual use. Some countries have the so-called "subclass" practice (e.g., China, Japan) to further classify the goods and services in each class. These practices could lead to a relatively narrow scope of protection derived from home applications or registrations. Applicants of international trademark applications may review their home applications/registrations to make sure the home applications/registrations are adequate to cope with their needs of overseas trademark protection and/or have left enough room for business expansion in overseas markets.

Madrid Protocol is known as a one-stop solution for trademark protection across the countries if everything goes straightforward from filing through registration. However, trademark rights are territorial in nature. Protection under the Madrid Protocol shall still be subject to separate examination according to local law and practice in each Designated Office. In case of refusal, objections, or opposition in any jurisdiction, applicants shall have to appoint local trademark agents to handle the cases at extra costs. The scope of protection in terms of goods and services cannot go beyond the home application or registration.



In Hong Kong, a trademark application can be processed for publication in a few weeks to around three months in straightforward cases. Within six months, a straightforward application for registration could be preliminarily approved and published, and some could even be issued certificates of registration. Trademark applicants with priority dates to claim may not sit tight until the six-month deadlines loom. Even if the priority dates predate those straightforward applications, priority trademark applicants have to go through opposition or revocation proceedings if they wish to remove a published/registered trademark. Considering the additional time for a formality check in the office of origin before an international application is sent to IB and then to various designated offices for further examination, an international application designating Hong Kong shall take a longer period of time before it is substantively examined. In light of the current work efficiency of HKIPD, it would be doubtful whether international trademark applicants could still enjoy the benefit of their priority dates if they file international applications too close to the filing deadlines.

With the amendment of the Trade Marks Ordinance in 2020, the Trade Marks Registrar has been endowed with the power to make rules for the implementation of the Madrid Protocol. Until further announcements from the government on an operational level, harmonization with the local practice shall continue to be a hot topic in town.

Everything has its pros and cons. Whether to go with the international or national/regional route is always a decision made on a case-bycase basis, taking into consideration the stability of the home applications and registrations, the applicant's business plan in domestic and overseas markets, etc.

Based in Hong Kong, we have a group of experienced specialists representing our local and overseas clients before HKIPD and CNIPA for their trademark registrations and protections. We are known for our pragmatic approach and expertise to provide our clients with professional strategies in their trademark searches, filings, appeals, oppositions, and revocation proceedings in Hong Kong. We are committed to our client's success.

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An interview with EVP, Chief Administrative Officer & Chief Legal Officer of Floor & Decor, David Christopherson

David sits down with The Trademark Lawyer to share key takeaways from the recent trademark infringement trial that challenged their 'Floor & Decor' mark, providing insights for success.

Can you start by introducing yourself and your pathway to your current position at Floor & Decor?

I started my career as a corporate transactional lawyer at Sullivan & Cromwell in New York and then worked as a corporate attorney focusing on mergers & acquisitions at King & Spalding in Atlanta. After moving in-house, I became the General Counsel of Teavana, a high-growth speciality retailer, which was sold to Starbucks in 2012. For the last 11 years, I've been at Floor & Decor, also a high-growth specialty retailer based in Atlanta but of hard surface flooring. During that time, we've been fortunate to experience tremendous growth and had an initial public offering in 2017. We currently operate more than 220 warehouse-format stores in 36 states. Our growth has been driven by offering the industry's broadest selection of trend-right hard surface flooring at everyday low prices. During my tenure, in addition to running our Legal Department, I've taken on additional business responsibilities, leading to the Chief Administrative Officer title being added earlier this year.

What does your day-to-day role look like as EVP, Chief Administrative Officer & Chief Legal Officer at Floor & Decor?

I currently have responsibility for our Human Resources, Information Technology, Legal, Safety & Asset Protection, Sustainability and Risk Management functions. In a typical day, I'll spend time with my direct reports and other members of those teams, often acting as a resource to help them overcome any challenges they may face in executing their objectives. I'll also have



David Christopherson

The decision does an excellent job of explaining what it takes to establish secondary meaning.

meetings with our other senior leaders about any number of issues facing our business. Finally, whenever I can, I like to spend time in our stores or walking the halls in our office, talking to associates, hearing what's on their mind and learning from them ways we can continuously improve our business.

Floor & Decor were recently victorious in an interesting case concerning the accused infringement of the mark "Floor Decor", can you briefly outline the background to the case?

We received the federal registration to the mark "Floor & Decor" in 2006 and have used it consistently as we've expanded nationwide. In 2018, we opened our first store on Long Island (and used the mark in the same way we have done so nationwide) and were subsequently sued for trademark infringement by a small business in the area that claimed to have a common law right to the name "Floor Decor" for all of Long Island.

How did you prepare to face the trial?

The team at Kilpatrick Townsend did a thorough job preparing us for trial and made sure we knew what to expect. They commissioned an expert witness to survey residents on Long Island to demonstrate scientifically what we already knew anecdotally - i.e., the plaintiff's mark had not established secondary meaning. They also interviewed potential witnesses to establish a strong record of our use of the mark, which clearly had nothing to do with this small, independent business. These interviews also ensured we weren't surprised at trial.



What advice would you give to a company facing similar circumstances? If the facts and the law are on your side, don't be afraid to go to trial.

The judge found that the plaintiff failed to establish that its asserted name had achieved secondary meaning - what significance do you think this result will have on the IP community? The decision does an excellent job of explaining

what it takes to establish secondary meaning.

Kilpatrick Townsend & Stockton LLP team, led by Charlie Henn, were your counsel. On reflection, what attributes do you think the team leveraged to secure the success for Floor & Decor?

First, they took the time to understand our business, which was important in distinguishing how fundamentally different we are from the plaintiff and helped our argument that there was no actual customer confusion. Second, their deep subject matter expertise in trademark infringement law was especially apparent at trial and helped us achieve some important procedural wins. Finally, Charlie and his team were excellent at distilling everything into persuasive themes, which effectively told our story at trial.

Where there any key take aways in the trial that you think are pivotal to remember in the pursuit of protecting IP?

Consistency of use. I believe we were helped at trial by being able to demonstrate that we had a consistent use of the mark nationwide and

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I believe we were helped at trial by being able to demonstrate that we had a consistent use of the mark nationwide and consistently did the right thing to protect it.



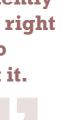
consistently did the right thing to protect it. We also benefitted from investing upfront in our federal registrations.

Has facing the trial resulted in an adaption of IP strategy at Floor & Decor?

No, fortunately, the trial largely validated our IP strategy. We have approximately 70 registered marks, and we regard our intellectual property, including our over 50 proprietary brands, as an important part of our business strategy.

Do you think this trial lends and lessons to the IP community?

I think there are three main lessons - (1) Hire outstanding IP counsel with subject matter expertise to be sure you're conducting appropriate knockout searches and protecting your marks in advance of any conflict. (2) Use your marks consistently and invest upfront in protecting them. (3) If you face a claim that lacks merit, don't be bullied and don't be afraid to go to trial. If you've acted in good faith and have done the right thing, take every action to protect your rights.





Malicious intention in trademark administrative cases

Jiezhen (Amy) Min, Trademark Attorney at Beijing Sanyou Intellectual Property Agency Ltd., details examination considerations for identifying malicious intention based on past CINPA decisions to provide advice on good practices.

alicious intention plays an important role in many different types of trademark cases. Whether examining a new trademark application, reviewing refusal, opposition, or invalidation cases, examiners will consider malicious intention as a disadvantage that will affect the final official decision.

In substantial examination of a new trademark application, if examiners detect evidence proving that the application was filed by the applicant without true intention of using the applied mark, such application will be actively refused by the examiners based on Article 4 of the Chinese Trademark Law. The following points can affect the examiners' decision regarding the applicant's true intention for using the applied mark or not:

- 1) The condition of the applicant, such as abnormal business operations including revocation or closure, etc.;
- 2) An applicant filing large numbers of trademarks in a short period in multiple classes considered beyond common commercial practice;
- 3) Specific composition of the trademark (such as marks composed of other parties' marks bearing high popularity and strong distinctiveness or composed of industry terminology, scenic spot names, mountain or river names, administrative divisions names, public resources, or well-known trade names, enterprise names, famous person names, advertising slogans, artworks,



Jiezhen (Amy) Min

designs actually owned by other parties, commercial identifications, etc.);

- 4) Actions during the application or after the registration such as selling or intending to sell the mark to third parties for high assignment fees to obtain improper gains, coercing other parties to cooperate with the applicant, claiming a high price as a license fee, infringement compensation fee, or settlement fee, or large numbers of assignment to different entities;
- 5) Prior official decisions or verdicts already deeming the same applicant as having no true intention of using the mark;
- 6) Repeated applications for trademarks with high popularity and strong distinctiveness actually owned by the same party;
- 7) Affiliated entities' conditions on the above items.

In an examination of the review of refusal, opposition, or invalidation cases based on prior similar marks, if the applicant has malicious intention of confusing the market, such intention will affect the examiners' decision on judging whether the applied mark and prior cited marks constitute similar marks.

Generally, if there is no unique corresponding relationship between a Chinese mark and an English mark formed in an inherent dictionary

meaning or through use, it is difficult to judge the marks as similar to each other. In the invalidation case against the disputed mark "荷荷巴斯德莫尔" handled by the author, the prior mark cited by the applicant is " SIDMOOL , combined by an invented English word "SIDMOOL" and an invented Korean word " 세 드 물 " as a Korean transliteration of "SIDMOOL". As background information, Korean words will be deemed as devices by examiners as it is difficult for the Chinese public to recognize such a mark. The applicant or consumers never used a Chinese mark corresponding to the English word. In theory, the disputed Chinese character mark and the cited combined mark, including the invented English word, do not constitute similar marks according to Chinese local examination criteria since there is no unique relationship between the Chinese characters and the English part, no matter the inherent dictionary meaning or through use.

However, the applicant made the below breakthrough points to obtain a higher chance of invalidation:

- 1) The Chinese characters "斯德莫尔" in the disputed mark are one of the Chinese transliterations of the cited mark "SIDMOOL" which bears high originality. Besides the disputed mark, the disputed party also filed applications for "JOJOBA SIDMOOL" in different Classes. Obviously, the disputed party has malicious intentions for filing the applications.
- 2) The applicant submitted extensive evidence of prior use of the trademark SIDMOOL to prove the high reputation of its mark "SIDMOOL" on designated goods in China.
- 3) The disputed party has malicious intentions proved by the following points:
 - 3.1 The distinctive part of the disputed party's other mark, "JOJOBA SIDMOOL", is identical to that of the cited mark, e.g., SIDMOOL, which bears strong creativity and distinctiveness.
 - 3.2 Evidence of use and reputation of the cited mark "SIDMOOL" in China.
 - 3.3 The disputed party's packaging of lipsticks branded "JOJOBA SIDMOOL" is almost identical to that of the applicant's branded

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If examiners detect evidence proving that the application was filed by the applicant without true intention of using the applied mark, such application will be activelv refused by the examiners.

Résumé

China and abroad. of China Trademark.



"SIDMOOL". Moreover, the disputed party fraudulently advertised in its online store that its lipsticks were from Korea.

3.4 The disputed party also preemptively copied and imitated several other parties' well-known marks, including marks of another cosmetics company in Korea.

Besides, the applicant used absolute grounds based on a misleading article since the disputed mark contains the Chinese character's "荷荷巴" (meaning "JOJOBA"), a common material mainly used for extracting oils and fats for cosmetics, medicine. etc.

Finally, the examiners decided to invalidate the disputed registration on the grounds that the disputed mark is similar to the cited mark on similar goods and that "荷荷巴" in the disputed mark would mislead consumers about raw materials of the designated goods.

From the above case, we can see that CNIPA fully considered the disputed party's bad faith in addition to the strong originality and high reputation of the cited trademark. Said differently, the disputed party's malicious intention can be one of the most important factors affecting the examiners' judgment on the similarity between marks in practice.

While in opposition and invalidation, malicious intention is also an important point that affects the examiners' decisions and the final winning chance based on:

• Principle of good faith and trustworthiness stipulated in Article 7 of Chinese Trademark Law:

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She has rich experience in strategic planning for trademark management and protection and trademark prosecution in China. She is active in sharing trademark practice issues and has spoken at IP conferences, such as the 2023 AIPPI China Youth IP Seminar

She engaged in research for the Trademark Law and Trademark practice in China and has published several articles in periodicals and magazines in China, e.g. "TM case shows how to choose best right defense measures " published in the magazine of China Business Law Journal, "Trademark co-existence in China" published in the magazine

- Bad faith application based on a specific relationship such as business contact or nearby regions or employment relationship, etc. stipulated in Article 15;
- Bad faith application for trademarks actually prior created and used by other parties and enjoying high reputation through prior use by the same party stipulated in Article 32; and
- Obtaining registration through other improper means stipulated in Article 44 of Chinese Trademark Law.

Normally, to prove the malicious intention of the attacked party, the attacking party can collect evidence in aspects of creativity and distinctiveness of its own cited marks, prior reputation through its use, the lists of the marks unauthorizedly possessed by the attacked party and its affiliated entity, prior official decisions or verdicts recording the malicious intention of the attacked party and its affiliated entity. However, sometimes, it may be difficult to prove the malicious intention, especially when the attacked party and its affiliated entity, if any, have very few trademarks and when the approved goods are not similar to those covered by the prior cited mark(s).

In the opposition case against the trademark application for "BARMAG", handled by the author's firm, the opposed party did not have obvious hints of malicious intention as they only own three marks, including another two marks, which they may have created by themselves. Moreover, although the opposed mark is identical to the cited marks, the approved goods of the opposed mark are not similar to the goods covered by the cited prior registered marks.

The opposing party made a great effort to prove that the opposed party had malicious intentions besides arguments with supporting evidence on strong creativity, distinctiveness, and high reputation of the cited prior marks through prior use in China. To prove the malicious intention of the opposed party, the opponent stressed and proved that:

There is some relationship between . both parties' goods in actuality, and the opposed mark will make consumers misunderstand that the opposed mark has specific relations with the opponent. To prove the approved goods of the opposed mark are closely related to the opponent's products in business activities, the opponent collected and provided patent search results, industry research reports, introduction of functions, and use

disputed party's malicious intention can be one of the most

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of two parties' approved goods, etc.

The opposed party, as a same-field competitor, also produces goods that overlap the opponent's products. To prove the competitor relationship between the opponent party and the opposed party, the opponent conducted an onsite investigation, proving the opposed party has been selling goods identical to the opponent's products reflected by the opposed party's products brochure and notarized WeChat communication on identical products provided by both parties. The adversary should have known the opponent's mark BARMAG bears a high reputation.

The opposed party did not file a response to give a reasonable explanation for filing the opposed mark. Finally, the CNIPA fully considered the inferred malicious intention of the opposed party, strong originality, the high reputation of the opponent's cited trademark, and the relationship between both parties' goods (although they are not similar according to our local classification lists), so it was determined that the filing of the opposed mark violated the principle of honesty and it was decided to disapprove the registration of the opposed mark.

From the above case, we can see that deeper investigation to prove covert malicious intention can be very important. Sometimes, we need to try any potential actions, even on-site investigations, to reveal the veil of malicious intention.

In short, malicious intention can be widely used in trademark cases in China. We should gather all possible evidence and utilize it to remove prior obstacles and obtain a better chance of success

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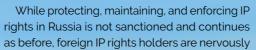
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Navigating the sanctions jungle: Intellectual property rights in Russia post-2022

Riikka Palmos, Senior Partner at Papula-Nevinpat, explores legislative issues that have arisen from sanctions in Russia, and against Russian filers elsewhere, to erase IP enforcement challenges.

Nature and the second s





watching Russia's potential response to the recent EU's 14th sanction package, which restricts IP flings for Russian applicants in the EU. Many fear this development could affect the treatment of

As geopolitical tensions rise and legal frameworks shift, IP rights holders face uncertainty.

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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. Author email

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foreign IP rights in Russia and is increasing uncertainty among IP holders. This article explores the legislative issues and offers insights into burning practical challenges in IP enforcement.

Government powers and IP exemptions

Following the imposing sanctions on Russia in 2022 and the massive departure of trademark holders from the Russian market, the following notable countermeasures involving the IP field have been taken.

The Russian government now has the power to decide which goods are exempt from specific intellectual property protections outlined in the Civil Code. This means the government can temporarily halt the enforcement of legal norms that protect exclusive rights to various forms of intellectual property, such as creative works, sound recordings, live performances, and trademarks. Consequently, legal consequences for infringing on these rights, like being held liable for violations, may not apply to the goods on this specified list.

While the government has been given the power to determine which goods are exempt from certain intellectual property protections under the Civil Code, this authority is limited. The government cannot eliminate the legal norms established by the Civil Code. Furthermore, it does not have the power to suspend any provisions in the Criminal Code or the Code of Administrative Offenses. This means that criminal and admini-strative penalties for violations of intellectual property rights remain in force, ensuring that there are still legal consequences for such infringements (Federal Law of 8 March 2022 No. 46-FZ).



Riikka Palmos

The mechanism for compulsory licensing is also introduced in the law, where the government can permit the use of patents without the patent holder's

consent under specific conditions.

Introduction of partial parallel imports

Additionally, Russian authorities have permitted partial parallel import without the trademark holder's consent (Resolution No. 506 dated 29 March 2022). This measure applies only to companies and their brands that have officially left the market and are included in the list compiled by the Ministry of Industry and Trade.

The Russian government's decision to permit partial parallel imports in response to sanctions has created difficulties for foreign trademark holders. Parallel imports refer to the importation of genuine products without the trademark holder's permission, often through unofficial channels. By allowing this practice, the government effectively limits the trademark holders' ability to control the import of their products to Russia and rely on customs to prevent counterfeit goods from entering the market.

While trademark holders can still take legal action against counterfeiters, the sheer increase in counterfeit products makes it harder to manage and protect their brands. This scenario illustrates the complexities and risks involved in safeguarding intellectual property rights under such regulatory changes.

Compulsory licensing mechanism

The mechanism for compulsory licensing is also introduced in the law, where the government can permit the use of patents without the patent holder's consent under specific conditions. Normally, patent holders would receive 0.5% of the revenue from the use of their patents. However, for patent holders from countries considered unfriendly to Russia, this compensation can be reduced to 0%. This measure is intended to address situations of extreme necessity, such as safeguarding public health or national security, where the government deems it essential to utilize certain patented technologies or designs without the patent holder's approval. This ensures that the state can act swiftly in critical situations while still providing a legal framework for compensating patent holders, albeit at a reduced rate. (Clause 1 of Article 1360 of the Civil Code, Decree No. 299 of 6 March 2022).

Currently, only two compulsory licenses have been issued for the antiviral drug remdesivir (patent holder: Gilead Sciences). The first was issued on 31 December 2020, due to the need for this drug during the COVID-19 pandemic, and the second was issued on 5 March 2022.

Financial restrictions and IP payments

Subsequently, President Putin has prohibited the transfer of money to the accounts of representatives of unfriendly IP rights holders. Payments can only

be made in rubles to a special "O" type account opened in a bank of the Russian Federation in the name of the IP rights holder (Decree No. 322 of 27 May 2022).

To better implement previous acts, the Presidential Decree instructed the Government to form a commission on the use of inventions, utility models, and industrial designs to ensure the economic security of Russia. The decree also amended Decree No. 322 to ensure that funds for compensation for the use of intellectual property without the consent of IP Rights holders are credited to the "O" type account, based on the Government's decision (Decree No. 122 of 15 February 2024 "On improving the procedure for making decisions on the use of inventions, utility models, and industrial designs to ensure the economic security of the Russian Federation").

The Government has created a subcommittee on the use of IP rights to ensure the economic security of the state:

- · Which operates on a "one-stop-shop" principle for Russian companies that have been unreasonably denied the right to use inventions, utility models, and industrial designs by foreign IP holders
- · Which is authorized to issue permits for the use of foreign intellectual property products without the consent of IP rights holders (Resolution of the Government of Russia dated 27 March 2024 No. 380).

Regulating significant IP transactions

On 20 May 2024, the Decree of President No. 430, "On the temporary procedure for acquiring exclusive rights of certain IP Right holders and fulfilling monetary obligations to certain foreign creditors and entities controlled by them" came into force. In practice, this means that any significant IP sale involving foreign entities from unfriendly countries, or Russian entities controlled by or related to such countries, must receive special approval if the transaction exceeds 15 million rubles. This measure aims to regulate and monitor significant IP transactions that could impact national interests.

The Russian Patent Office has implemented practical steps to enforce this regulation. When a company submits a contract for the transfer of IP rights, the Patent Office requires detailed contract documentation if the transaction amount is above the specified threshold. For foreign sellers, the Patent Office verifies if they are linked to unfriendly countries. For domestic companies, it examines ownership structures to identify any indirect foreign influence and monetary transactions.

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Courts prioritize registered trademarks over prior use or older domain names.



This process ensures that significant IP transfers are thoroughly vetted, safeguarding against potential risks associated with transactions involving parties from countries considered unfriendly by the Russian government. This rule does not apply to transactions involving exclusive rights to works, performances, phonograms, and broadcast or cable broadcasts.

Burning practical challenges in IP protection Trademark registration

- In Russia, trademark protection is based on registration rather than first use. Companies that operate without registering their trademarks risk losing exclusive rights if another party registers a similar trademark first. Courts prioritize registered trademarks over prior use or older domain names.
- To avoid legal disputes, companies must register their trademarks early to secure their rights. The departure of many foreign companies has created opportunities for bad-faith applicants to exploit this situation, expanding their questionable operations at the expense of legitimate IP rights holders in the form of bad-faith applications and non-use cancellation actions.

Non-use trademark cancellation

- Non-use cancellation actions have become a pressing issue for foreign trademark holders in Russia. If a trademark is not used for an uninterrupted period of three years, it becomes vulnerable to cancellation. In the current geopolitical climate, demonstrating trademark use is challenging or even impossible, making it difficult for rights holders to avoid termination of their trademark rights.
- Although there are ways to safeguard the existing rights, any actions must be properly strategized to avoid accusations of abusing the rights. Trademark holders must find effective solutions to navigate these challenging circumstances.
 - Many foreign companies now wonder whether parallel imported goods would constitute the trademark's use. There is a simple answer - the trademark holder must consent to such use and the consent must be expressed in written form, for example in an agreement with

the third party. Otherwise, the trademark is not considered used by the proprietor or with their consent.

Patent trolls

Patent trolls exploit legal gaps by registering patents and trademarks not for use but to find opportunities to sue other companies for alleged infringement. Their primary goal is financial compensation or to force companies to cease selling products that allegedly infringe on their rights. This practice is opportunistic, focusing on litigation and profit rather than innovation.

Administrative weaknesses

- Customs authorities: Customs face challenges in accurately verifying trademarks, especially when importers provide false information. This can lead to inadequate enforcement of IP rights at the border. Although including a trademark in the Customs Register of Intellectual Property offers better protection, Customs often refrain due to insufficient details to differentiate genuine products from counterfeits.
- Police Officers: IP cases are rare for police, leading to a lack of familiarity and a preference for quickly closing these cases without proper investigation.

Enforcement challenges

- Judges in regional courts often lack the specialized understanding needed for effective IP infringement rulings, leading to inconsistent or incorrect decisions. Courts in major cities, particularly the capital, are overwhelmed with cases, straining resources and potentially compromising the thoroughness and accuracy of their decisions. Both factors contribute to challenges in achieving fair and effective resolutions of IP disputes.
- Due to insufficient staff, courts frequently struggle to meet procedural deadlines, causing delays. Smaller claims, those below specific monetary thresholds (600,000 rubles for individual entrepreneurs and 1,200,000 rubles for organizations), are resolved using a simplified procedure that bypasses traditional court hearings. While this expedites the process, it can disadvantage parties by restricting

In the current geopolitical climate, demonstrating trademark use is challenging or even impossible, making it difficult for rights holders to avoid termination of their trademark rights.



the presentation of additional evidence or explanations, particularly if the judge does not fully grasp the case complexities, impacting the fairness and accuracy of the final judgment.

The legal environment in Russia is constantly evolving due to instability and the imposition of various sanctions and countersanctions, complicating the ability of judges to stay current with new laws and regulations. Despite these challenges, the Court for Intellectual Property Rights (IP Court) continues to perform well, specializing in IP cases and ensuring fair and equal treatment for both parties. The court maintains a high standard of work and delivers consistent, unbiased judgments amidst political upheavals. Additionally, the Patent Office of Russia operates with high efficiency and issues legal decisions, with trademark examinations currently taking as little as four months.

In summary, while the current political and legal landscape presents significant challenges for IP rights holders, there are mechanisms in place to uphold IP rights in Russia. Staying informed and proactive is essential for navigating this complex environment.

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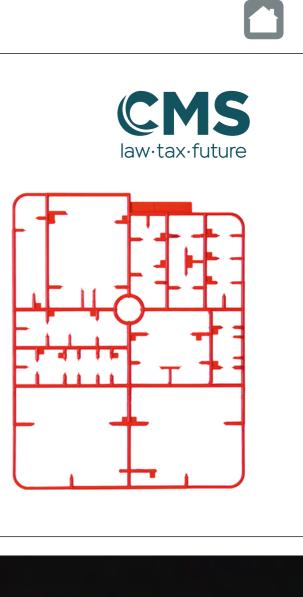
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A comparative analysis of trademark consent provisions in Japan, India, and the USA

Rachna Bakhru and Swati Dalal of RNA, Technology and IP Attorneys, explores the varying degrees of flexibility and rigidity that define the consent provisions in these countries.

he intricate world of trademark law is replete with mechanisms designed to navigate the complex interplay of rights, interests, and legal frameworks that span across different jurisdictions. Among these mechanisms, Trademark Consent Provisions stand out as a pivotal element that allows for the coexistence of similar trademarks under certain conditions.

The importance of Trademark Consent Provisions cannot be overstated. They are instrumental in preventing the likelihood of consumer confusion, which is a central concern in trademark law. By ensuring that the prior rights holder does not object to the new registration, provided that there is a clear delineation between the goods or services offered, these provisions help maintain the integrity of the trademark system and protect consumer interests. Moreover, they offer a pragmatic solution for businesses to avoid protracted legal battles, which can be both time-consuming and costly. In essence, Trademark Consent Provisions embody the principle of balance - between protecting the rights of trademark owners and fostering a competitive market landscape.

As we embark on this comparative journey, we will explore the varying degrees of flexibility and rigidity that define the consent provisions in these countries. From Japan's structured approach to India's discretionary practices, and the USA's formalized consent agreements, this analysis aims to provide a comprehensive understanding of how consent provisions are employed to foster a balance between trademark protection and market competition.



Rachna Bakhru



Swati Dalal

It's important to note that while Letters of Consent can facilitate the registration process and help avoid trademark disputes, they are not universally accepted and must be carefully drafted to meet the specific requirements of each jurisdiction.

Japan's recent revisions

Overview of the new Consent System The recent amendment to Japan's Trademark Law, effective from April 1, 2024, introduces a trademark consent system. This system allows for the registration of trademarks that are identical or similar to a prior registered trademark, provided two conditions are met:

- 1. The owner of the prior registered trademark consents to the registration.
- 2. There is no likelihood of confusion between the goods/services of the new and existing trademarks.

Legal framework

Under the current Trademark Act in Japan, specifically Article 4(1)(xi), registering a trademark that is identical or similar to another person's registered trademark is not allowed. As an alternative, an "assign-back agreement" was implemented. In this arrangement, the applicant transferred their trade-mark application to the holder of the relevant trademark rights, and after registration, the trademark rights were transferred back to the original applicant.



With the revised Article 4 of the Trademark Act, a new Paragraph 4 has been introduced. This allows for the registration of trademarks falling under Article 4(1)(xi) if the consent of the prior registered trademark holder has been obtained and there is no risk of confusion.

During the examination process, applicants must submit

- 1. A written consent from the prior trademark holder.
- 2. A document demonstrating that there is no risk of confusion between the two marks.

The Consent System does not apply to applications filed before April 1, 2024, even if they are pending examination after this date. It does not apply to divisional applications based on an original application filed before this date.

For international applications designating Japan, the Consent System will apply if the date of international registration or the date of subsequent designation falls on or after the effective date. Generally, documents showing consent from prior registered trademark holders are required in response to a Notification of Provisional Refusal under Article 4(1)(xi) but can also be submitted beforehand.

After registration, to prevent confusion with the coexisting trademarks under the Consent System, the following provisions have been added:

Résumés

publications.

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Rachna currently heads the Dispute Resolution team of the firm, dealing with IP enforcement and advisory. She has over 25 years of extensive experience in managing non-contentious and contentious IP matters, IT and Technology issues. Her expertise includes risk assessment, IP clearance, regulatory issues, litigation and alternate dispute resolution. She has worked on portfolios of large international companies and her industry expertise includes Pharmaceuticals and Information technology. She advises her clients on issues related to IP infringement, Information Technology, trade secrets, data protection, and geographical indications.

Swati Dalal is a Managing Associate with RNA, Technology and IP Attorneys. Having been in practice for more than 15 years, she joined the RNA family in 2016. Prior to joining RNA, Swati was associated with leading law firms in Gurgaon, where she acquired valuable experience advising clients on a wide range of IP matters.

Swati is a member of the trademarks group at RNA, and her scope of work encompasses a broad range of services in trademark rights, including advising domestic and international clients on issues related to clearance search, trademark prosecution, post-registration matters, including assignments and renewals, and managing overseas trademark portfolios for clients in other countries. Swati regularly appears before various forums, including the Trademarks Registry. She has authored a number of articles in various leading legal and IP

- 1. When there is a risk that the interests of one rights holder may be harmed by the use of another rights holder's trademark, a request for an appropriate indication to prevent confusion between both trademarks can be made (Article 24-4 (1) (ij)).
- 2. If one rights holder uses a trademark in a manner that causes confusion with the goods or services related to the business of another rights holder for the purpose of unfair competition, anyone can request a trial to cancel the trademark registration ("Trial for Cancellation of Registered trademark with Unfair Use") (Article 52-2 (1)).

Criteria for no likelihood of confusion

The Japan Patent Office (JPO) comprehensive evidence to ensure no confusion (present or future), including details on business content, usage regions, future business plans, and market surveys. Despite the submission of a Letter of Consent, the JPO retains the final decision authority. The practical implications of this system include the need for thorough documentation and evidence to support the application, the possibility for businesses to secure trademark registrations with appropriate consent, and the inclusion of provisions to prevent confusion and unfair competition. This ensures a balanced approach between facilitating trademark registrations and protecting the interests of existing trademark holders. Additionally, trademarks registered under the Consent System will be searchable on the J-PlatPat platform and listed in the Trademark Gazette, enhancing transparency and accessibility.

Trademark consent in India

In India, the Trademarks Act, 1999, governs the trademark registration process. Unlike Japan's stringent requirements, India's system is more flexible:

- 1. A Letter of Consent from the prior trademark owner is generally sufficient to overcome objections related to the similarity of trademarks.
- 2. The Registrar may still refuse the application if there is a likelihood of confusion among the public, but the process does not require extensive evidence as mandated by the JPO.

Legal framework in India

India's Trademarks Act, 1999, governs the trademark registration process. While the Act does not explicitly mention Letters of Consent, they are accepted in practice to overcome objections based on similarity to existing trademarks. Section

The United advantage. States follows the Lanham

Act, which permits the use of consent agreements to overcome refusals based on the likelihood of confusion.

11 (4) of the Trademarks Act 1999 highlights the importance of obtaining consent to overcome potential refusal based on similarity or unfair

Practical implications

In India, the Trademarks Act, 1999, does not formally recognize the Letter of Consent as a means to overcome objections based on prior similar trademarks. The Registrar of Trademarks has discretion and may consider such letters, but typically, the primary concern is to prevent public confusion. This means businesses may face challenges in securing trademark registrations even with consent from the existing trademark owner, necessitating more rigorous evidence to prove no likelihood of confusion and potentially seeking alternative solutions like coexistence agreements or assignments.

Trademark consent in the USA

The United States follows the Lanham Act, which also allows for the use of consent agreements to overcome refusals based on the likelihood of confusion. The key features of the US system include:

- 1. The United States Patent and Trademark Office (USPTO) gives significant weight to consent agreements between parties, especially if they include detailed provisions to prevent confusion.
- 2. Unlike Japan, the USPTO does not mandate comprehensive future business plans or market surveys, although a well-drafted consent agreement outlining measures to prevent confusion is essential.

Legal framework in the USA

The United States follows the Lanham Act, which permits the use of consent agreements to overcome refusals based on the likelihood of confusion. Key provisions include:

- 1. Section 2(d) of the Lanham Act allows the USPTO to refuse registration of a trademark that is likely to cause confusion with an existing mark. However, if the applicant submits a well-drafted consent agreement, the USPTO often considers this sufficient to overcome the refusal
- 2. The consent agreement must outline the measures both parties will take to avoid confusion. This can include limitations on the scope of goods or services, geographical restrictions, or specific branding requirements.

Practical Implications

In the USA, the use of consent agreements is a well-established practice. These agreements must be detailed and clearly demonstrate how the parties will avoid consumer confusion. The USPTO gives substantial weight to these agreements, especially if they include detailed provisions for mitigating confusion. Unlike Japan's comprehensive evidence requirements, the focus in the USA is more on the legal and practical measures outlined in the agreement itself.

Conclusion

The Letter of Consent emerges as a beacon of cooperation and mutual understanding in the often-contentious arena of trademark law. In Japan, the structured consent system introduced in 2024 has provided a clear pathway for the coexistence of similar trademarks, emphasizing the prevention of consumer confusion through meticulous legal provisions. India's approach, characterized by the discretionary power of the Registrar of Trademarks, reflects a more flexible legal culture that accommodates the nuances of each case. Meanwhile, the USA's formalized consent agreements underscore the importance of detailed legal documentation in safeguarding the interests of trademark owners.

In conclusion, the importance of Letters of **Consent** in trademark disputes cannot be overstated.

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As businesses continue to expand their reach across borders, the significance of Letters of Consent is likely to grow. They represent a key tool in the arsenal of international trademark law, providing a means to bridge the gaps between different legal systems and cultural approaches to intellectual property.

In conclusion, the importance of Letters of Consent in trademark disputes cannot be overstated. They are a testament to the adaptability and collaborative spirit of trademark law, ensuring that it remains responsive to the needs of a dynamic and interconnected global marketplace.

Contact

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

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

Noemi Parrotta: Partner, **Spheriens**

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

oemi is a partner at the Italian-based IP law firm Spheriens. She regularly manages IP disputes at both the Italian and EU levels and has experience advising clients on IP-related transactions. She regularly holds lessons at the Master in Luxury Goods Management – EMLUX at Università Cattolica of Milan and has contributed to the Italian IP law review Giurisprudenza Annotata di Diritto Industriale since 2003. Noemi also serves as a chair of the Europe Amicus Subcommittee of INTA and is a member of the Famous & Well-Known Marks Team of MARQUES. She holds an LL.M. from UC Berkeley and a law degree from Università Cattolica of Milan. She is a qualified attorney in

So, my advice is: get out of your comfort zone, especially if you are at the early stage of your career!

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.

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Italy, where she has also been admitted to practice before the Supreme Court and the other Superior Courts, as well as in New York.

What inspired your career?

I have always been a very curious, open-minded, and sociable person. Since I was a child, I have always loved to talk a lot with other people and to learn about different points of view, constantly looking for dialogue and sometimes also provoking debate, to the point where my family and teachers used to joke about my talkativeness saying that I should make a profession out of it by becoming a lawyer.

The first time I personally experienced a keen desire to study law was in connection with the bloody murder by the Italian Mafia - known as "La Strage di Capaci" (i.e., "Capaci bombing") - of Giovanni Falcone, an Italian Judge who dedicated his entire life to prosecute "Cosa Nostra", which killed him with a dynamite explosion attack on May 23, 1992. Since I grew up in Calabria, a southern Italian region where organized crime is a serious everyday problem, this tragedy touched me particularly deeply, and, although I was just 12 years old, I remember feeling a sense of absolute injustice that then inspired me to undertake legal studies.

When, in 1998, I moved to Milan to study law at the Università Cattolica del Sacro Cuore, I was pretty sure that I'd become either a Judge or a lawyer specialized in criminal law. But then in 2001, I attended the course on Intellectual Property Law, held by Professor Adriano Vanzetti - renowned as the "father" of Italian IP law - and everything changed: the attendance of this course represented the decisive experience for my career, as Professor Vanzetti became my mentor and since then my interest in IP law has shaped the rest of my life. Indeed, in 2003 I graduated with a thesis in IP law on the different tools for the protection of products' shapes which is still a rather hot topic in our field! - and one week after my graduation, I was already working as a trainee at Professor Vanzetti's IP boutique firm.

I do value challenges as I consider them a kev part of any professional path.

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

As already mentioned, meeting Professor Vanzetti was my life-changing experience, and working at his boutique IP law firm laid the groundwork for my entire career, as it gave me: a method to deal with complex issues by going straight to the point; the right attitude to our job, which encompasses professionalism, understatement, tenacity and grit; and, well... also a partner in life, since this is where I met my husband to be (who is one of my business partners at Spheriens). In October 2006, I passed the Italian bar exam,

and shortly thereafter I quit my job and moved to New York City to improve my English (some behind the scenes of this choice to come in my reply to the next question). This experience inspired in me a passion for the melting pot of different cultures that only an international environment can offer.

Therefore, when I came back to Italy in the fall of 2007 - while continuing my cooperation with my mentor by remaining on the editorial board of Giurisprudenza Annotata di Diritto Industriale - one of the major Italian IP Law Journals that Professor Vanzetti founded and directed until he passed away - I decided to orient my professional career towards a more international environment and I joined the Milan office of the international New York-based law firm Cleary Gottlieb Steen & Hamilton LLP, where I had the chance to approach IP law from a multi-jurisdictional perspective as well as to broaden my knowledge of new fields of law. And it was while at Cleary that I thought, for the very first time in my life, about attending an LL.M. program in the USA (also because an LL.M. degree was basically mandatory to work there).

So, between 2009 and 2010 I attended an LL.M. in Law & Technology at the University of California, Berkeley School of Law. Needless to say, it has been one of the best experiences of my life: being a student again when you know what real work looks like is priceless, you approach things differently, by focusing on the topics catching your actual interest, without the desire to always be at the top of the class. And I really enjoyed the lively discussions with the JD students and the professors fostered by the Socratic method; I have great memories of a big discussion we had over parody cases during my trademark class: with my EU-perspective I could not be in agreement with the Chewy Vuiton decision and, on the other hand, most of my US classmates did not agree with my EU-protectionist views.

After graduation, I prolonged my stay in the USA for a few more months to take the NY bar exam, which is something that I did just because I was eligible thanks to my LL.M. degree. But I

have never really thought of continuing my professional career overseas. So, I took the exam, passed it, and then came back to Italy!

During my LL.M., the idea of working with an IP boutique with the capabilities of an international firm, possibly with a focus on fashion and luxury. began to mature...and there was a place matching these characteristics in Italy: my current firm! So, when back I had a chat with Pier Luigi Roncaglia - the managing partner of Spheriens, whom I knew quite well as he was part of the editorial of Giurisprudenza Annotata di Diritto Industriale - who told me that I would have great fun working with him and his team.

So, in October 2010, I joined Spheriens - which at that time had a different name and structure, but the same core of people and values - and. in 2017, I became a partner of the firm. As part of my job, I regularly manage IP disputes at both the Italian and EU level, and also advise clients on domestic and cross-border contractual and strategic operations related to intellectual property.

Over the last 10 years, in addition to working for the firm's clients, I've been performing pro bono activities within some IP international organizations. In particular, I've been highly involved in INTA, where I currently serve as a chair of the Europe Amicus Subcommittee: and in MARQUES, where I'm part of the Famous and Well-Known Marks Team, and currently working on organizing the next edition of the Luxury Brands Symposium. Furthermore, I regularly hold lessons at the Master in Luxury Goods Management - EMLUX at Università Cattolica del Sacro Cuore.

How have I found the pathway to my current position? By working hard with enthusiasm and curiosity. And also, by being flexible, going with the flow without getting hung up on my original plans: it's incredible how things that at first glance looked like a detour to your predetermined path make perfect sense when you connect the dots looking backwards.

Just to give you an example, when I joined my current law firm in 2010, I was supposed to spend just a few months in Florence - where our main office is - and then move to our Milan office. Milan has always been the place where I wanted to live: I moved from my hometown in Calabria to Milan to go to law school and came back to Milan twice after living in New York and then in the Bay Area for a while. Well, after 14 years (!) I still live in Florence, because this has turned out to be the right thing to do for my professional growth. In the meantime, I made it to partner at Spheriens and started enjoying my life in this city, while traveling across the world pretty often thanks to my amazing job...and yes, Milan remains "my place" even if I don't live there on a regular basis anymore.

So, my advice is: get out of your comfort

zone, especially if you are at the early stage of your career! If you feel like the most intelligent/ interesting person in the room and are surrounded by people who often please you and/or you are very comfortable with your routine (working during the day and then hanging out with familiar faces at night), then you should better try something different and challenge yourself!

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

I do value challenges as I consider them a key part of any professional path.

Of course, over the years, I've faced many challenges. I guess that most of them are common to those people who, like me, leave their hometown relatively young to make their way in a different place...with that Southern attitude driven by an ancestral sense of redemption!

And my hate-love relationship with English is one of my favorite stories when talking about professional challenges.

When I graduated from law school, I barely knew English. Of course this is a big flaw, especially if you are in the IP industry and one of the first cases you are working on is the cross-border trademark dispute between the American company "Anheuser-Bush" and the Czech beer maker "Budejovicky Budvar" over the trademark "Budweiser". I still remember when we had lunch with the American clients: it was a living nightmare! And this is when I decided that I should do something to make up for this shortcoming.

So, after passing the Italian bar exam, in 2007, I quit my job and moved to New York City just to learn English, living in a flat in Alphabet City with a professor of sociology from Santo Domingo and a Texan musician. And I made it: after spending six months in NYC my level of English was good enough to work at the international law firm Cleary Gottlieb Steen & Hamilton LLP first; then to attend an LL.M. at the University of California, Berkeley School of Law; and even to take and pass the New York Bar in 2010!

Needless to say, I could not be where I am without knowing English. Almost 90% of my daily job is in English: most of our clients are foreign companies, and I regularly write briefs and even plead before Courts in English. Plus I am actively involved in international IP organizations such as INTA and MARQUES.

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

I'm extremely happy with what I've achieved so far.

I very much enjoy what I do. I've always been fascinated by the multifaceted nature of law that is able to address so many different needs

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of society, and being an IP lawyer allows me to work on high-level cases, which are very interesting from a juridical perspective but at the same time are strictly linked to every-daylife. Actually, the link is so strong that there are no barriers between my job and the rest of my life, and the interaction between the two can be hilarious: like the time when my husband (who is an IP lawyer as well) and I were staring at a bag (belonging to a fashion house, being a defendant, in a huge piece of litigation that we were handling) of a lady in the subway and her companion turned to her saying "hold on to the bag they want to steal it from you"; or when I entertained some old friends during Christmas' break, telling them about the case of a porno actress who picked a famous luxury mark as her stage name. And yes, your friends might hate you when you use them to "test" the distinctive character of a pattern, a stitching, or a shoe sole! I am particularly glad to work in such an international environment. I travel a lot abroad to visit clients, attend conferences, and even hearings (it is always thrilling to go to Luxembourg to plead before the Court of Justice).

Turning to the specific question, contributing to establishing Spheriens has probably been one of my greatest achievements so far. After months of sleepless nights and working weekends - also doing "funny" things that our clients usually do, like going through the naming process and establishing the brand image coordinate in April 2018, my partners and I gave the start to this new IP boutique firm, which reflects our values and vision. It was a bit of a challenge, but it has definitely paid off: Spheriens quickly became the "talk of the town" and, in a few months, reached the top positions in the most important rankings in our field, establishing itself as a leading firm, especially in the fashion and luxury industry. After six years it feels like Spheriens has always existed, and I'm looking forward to the next achievements with this great team!

We should do the best that we can to actively engage in removing any discrimination, creating more inclusive environments where diverse voices are actively heard and valued.

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

I want to bring out the best in the people I work with, making them great IP professionals who love this job at least as much as I do. I think that this is one of the most challenging tasks that people in leadership positions – also in the IP industry - have been facing lately.

I don't know whether there is any magic trick to do that. My approach is very basic: I'm always very direct and expect people who I work with to be the same; I try to involve juniors as much as I can in very complicated matters, showing them the beauty of our job, which is often blurred by tight deadlines and high-pressure situations.

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

I hope that in a short while, full equality will be taken for granted, and the gender or race of a person holding a leadership position will not be a relevant piece of information. However, I know that we'll hardly reach that point in five years: we've centuries of discriminations and whiteman-centered culture to overcome.

Until then, we should do the best that we can to actively engage in removing any discrimination, creating more inclusive environments where diverse voices are actively heard and valued, and address and eradicate unconscious bias. And I think that the IP industry is moving in the right direction.

Luckily, the IP industry can count on a great community worldwide, which can be extremely powerful and effectively serve this cause, which calls for a multi-faceted approach.

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

Luckily, the IP industry can count on a great community worldwide, which can be extremely powerful and effectively serve this cause, which calls for a multi-faceted approach.

It would be key, on the one hand, to keep creating networks and communities for women in IP that can foster collaboration, knowledgesharing, and support; and, on the other hand, the entire IP community - law firms, brand owners, IP organizations, suppliers and so on shall work to challenge and dismantle the systemic barriers that women face in the workplace, advocating for equal pay, equitable career progression opportunities, and adequate welfare policies, by working with policymakers to develop and implement regulations that promote gender equality.



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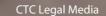


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A comprehensive list of the 10 most well-respected law firms from North and Central America, the Middle East and Africa.



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



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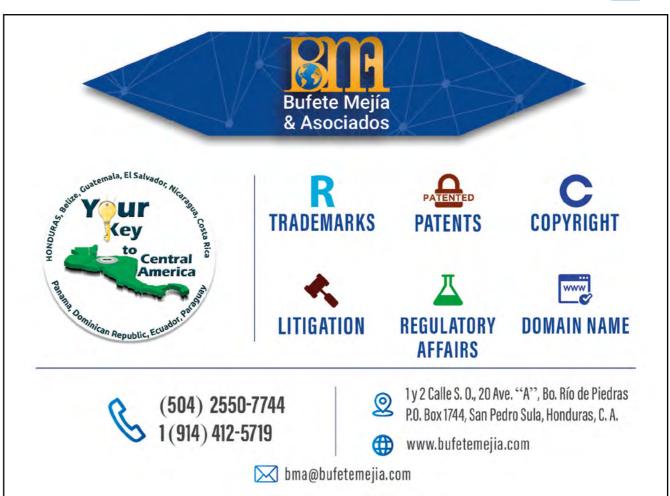
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Back up your brand: dealing with new threats for trademarks in Russia

Evgeny Alexandrov and Alexey Kratiuk of Gorodissky & Partners evaluate the impact of current geopolitical tensions on brand protection and provide valuable insights into maintaining IP ownership.

llowing the current political situation and the sanctions imposed on Russia, some Western companies decided to re-consider their trading and other business activities in Russia, and in some cases, announced total termination, winding down, or suspension of business in Russia starting from 2022. Taking advantage of the moment, some market players, acting in bad faith, are attempting to register famous brands or their imitations in their own name without the consent of the real owners of those brands. In some cases, bad faith applications are filed for mirror imitation, such as Figure 1 (Appl. Nº 2022746075, now refused), Figure 2 (Appl. Nº 2022723177, now withdrawn), and Figure 3 (Appl. Nº 2022724293, now withdrawn).

In others, applications are filed for the creative imitation of famous brands featuring high levels of stylization such as Figure 4 (Appl. N° 2022720003, now refused), Figure 5, (Appl.Nº 2022719552, now refused), and Figure 6 (Appl.Nº 2022720127, now refused).

In Russia, a trademark becomes vulnerable to cancellation for non-use three years after the registration date.

Figure 1 Figure 2 Figure 3 Figure 4 **Dell** Adidas Swarovski Figure 5 Fiaure 6 Figure 7 Fiaure 8 ADIDAS SWAROVSKI

Bad faith applications are normally filed without the consent of the true owner and are usually rejected because they are associated with famous brands.

Over the last two years hundreds of applications have been filed by local persons to register different imitations of famous brands. The mere fact of filing an application does not guarantee that the mark will get registered. The point is that the Russian PTO conducts examinations on both absolute and relative grounds and, in particular, is supposed to refuse applications if these are filed for marks that are confusingly similar to the prior third parties' marks existing on the Register in respect of similar goods. Therefore, in most cases, obvious copycats of famous marks are rejected during examination based on similarity grounds as well as for being misleading as to the commercial origin of goods. In some cases, bad faith applicants make up their minds to voluntarily withdraw their applications, such as in the case with McDonald's, where the Russian company specializing in the production of canned vegetables initially filed an application to register "Uncle Vanya" copycat Figure 7 and then decided to give up the application. In some cases, the local business comes up with a better idea of re-branding: it launches replacement brands that are fairly distinct from the original brands to eliminate confusion. For example, instead of McDonald's, a new local brand, Figure 8, which could be translated as "Tasty and that's it" was born to replace the original one.

The existence of prior rights in confusingly similar signs should pose an obstacle to the acceptance and registration of third parties' bad faith applications featuring imitations of true owners' brands.

However, the prior right should be valid to be cited against a bad faith application, and trademark squatters, in some cases, initiate non-use cancellation actions against cited trademarks in order to remove obstacles and get their own registration.

To retain validity, a trademark must be used in Russia in accordance with the adopted use requirements. In particular, in Russia, a trademark becomes vulnerable to cancellation for nonuse three years after the registration date. This means that after the expiration of this grace period, any interested third party is entitled to file a cancellation action against trademark registration on the grounds of non-use. It may be assumed that for those brands who left the Russian market in 2022, the three-year period of continuous nonuse expires very soon - in 2025.

The non-use cancellation action starts with a pre-trial letter in which the interested person suggests that the brand owner should either voluntarily assign its brand to the plaintiff or renounce its trademark. If no reply is received within two months, the interested person may initiate a non-use cancellation action before the IP Court which shall institute legal proceedings if all formal requirements are met. At that, the legal interest in pursuing the cancellation action has to be documentarily proved.

The burden of proof lies with the defendant (brand owner) in the cancellation proceedings. That means that the cancellation action can be based on mere presumption that the mark has not been used in Russia for the last three years and it is up to the trademark owner to prove otherwise in order to retain the registration in force and defeat the cancellation action.

According to the Russian use requirements, a trademark is considered as having been used if it has been used by the brand owner themself, their recorded licensee, or any other person under the brand owner's control. In case the branded goods enter the Russian market using parallel (grey) import channels, the brand owner may not be able to control how its brand is used in Russia, and such use may be deemed improper and not being in compliance with use requirements.

In this regard, it should be noted that the Russian Ministry of Industry and Trade issued Order No. 2701 in March 2022, legalizing the import of certain goods into Russia without the owner's consent (also known as the "List of goods allowed for parallel import," or "the List") in an effort to prevent a shortage of goods made by foreign manufacturers in response to the termination of business by some foreign brands on the Russian



Evgenv Alexandrov



Alexey Kratiuk

Alexey Kratiuk, Partner, Trademark & Design Attorney, **Head of Trademark Department**

Attorneys.







market. The Ministry of Industry and Trade makes it clear that this process entails the import of authentic products via alternative supply routes rather than the authorization of counterfeit goods.

The list of brands that are eligible for parallel import includes dozens of different products, including cars and spare parts, electronics and household appliances, clothing and shoes, cosmetics, furniture, paper and cardboard, industrial equipment and materials, and may be changed depending on the decision of the brand owners to remain or resume trading in Russia. If the brand owner wishes for its trademark or product to be excluded from the List, it is necessary to confirm that the brand owner has decided to remain on the Russian market, and suppliers of imported products will maintain their logistics and supply products to the Russian market.

Although the use of a trademark is obligatory, Russian law provides for some circumstances which may be treated as excusable reasons for non-use. These are circumstances that are beyond the control of a trademark owner, such as forcemajeure circumstances, personal health of a trademark owner, and unpredicted political decisions. These circumstances may be used as a defense to defeat the cancellation action.

Résumés

Evgeny Alexandrov, Ph.D., Partner, Trademark & Design Attorney, Head of Legal, Trademark & Design Practice

Evgeny joined Gorodissky & Partners in 2005 and, in 2015, was promoted to partner at the firm.

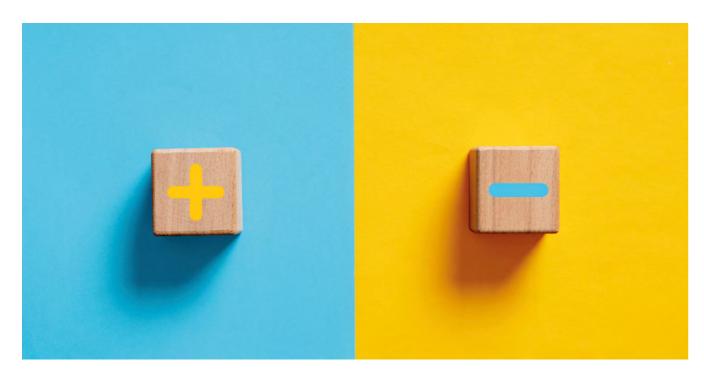
Evgeny advises clients on the legal (non-contentious) and illegal (contentious) use of IP/IT, unfair competition and false advertising, parallel imports and anti-counterfeiting, licensing and franchising, media, and technology. He is one of the most experienced and strongest IP/IT litigators in Russia.

Projects handled by Evgeny include successful representation of major companies in patent and trademark infringement cases, and legal support of Russian companies in different IP issues including multi-jurisdiction disputes.

Member of AIPPI, INTA, LES International, AIPLA, PTMG, and Russian Chamber of Patent Attorneys.

Alexey joined Gorodissky & Partners in 1999 and was promoted to partner at the firm in 2010.

Alexey has more than 20 years of experience in IP and counsels clients on issues relating to trademark strategies in different jurisdictions. Alexey deals with obtaining rights for trademarks and appellations of origin of goods, trademark prosecution proceedings in Russia and other countries. He is intensively involved in invalidation/ cancellation proceedings and enforcement of trademark rights using legal actions in both Administrative bodies and Courts in Russia. Member of AIPPI, INTA, ECTA, and the Russian Chamber of Patent



However, the Russian authorities are unlikely to accept an excuse for non-use if the trademark use was suspended because the owner voluntarily withdrew from the Russian market. The same applies to the sanctions imposed on Russia by some of the foreign states - the mere reference to such sanctions should not be deemed a good reason for non-use and may not be used as a defense in the non-use cancellation proceedings because there is no local law prohibiting the foreign trademark owner from using its trademark in Russia

Therefore it would be strongly recommendable to ensure that the documents attesting to the use of the brand(s) in Russia by the brand owner themselves, or any other person under its control for registered goods and services for the previous three years are accessible and prepared for examination by the relevant authority and any interested party in the event that the cancellation action is brought.

Non-usage of a trademark could put this trademark at serious risk of being attacked by squatters, who are now very active. They are attempting to revoke the protection of globally recognized brands whose owners do not utilize them in Russia by filing cancellation actions for non-use so as to pave the way for their bad faith applications for identical or confusingly similar marks to proceed to acceptance without being provisionally refused based on similarity grounds.

To be on the safe side, in the event that the current registration is not properly used in Russia and could be removed from the Register for non-use, and to stop a potential third party's application for a similar mark from being accepted on the grounds of similarity, it makes sense to consider filing new back-up application(s)

It makes sense to consider filing new back-up application(s) if the business has, in fact, ceased trading activities on the Russian market.

if the business has, in fact, ceased trading activities on the Russian market. However, it should be kept in mind that the so-called "double" registration is prohibited in Russia; therefore, it will be prudent and worthwhile in the circumstances to consider re-filing for a trademark that would be slightly different from the registered trademark or for the same mark covering an amended list of goods/services to avoid the duplication issue.

It should be noted that there are no obstacles for foreign companies to continue filing applications for any registrable IP subject-matter, including patents, trademarks, designs, and other since Russia is a member-state to many International Treaties in the IP sphere and equally protects the IP rights of domestic and foreign companies.

The present article gives just a general idea of how IP-related issues related to the current political situation in the world could be resolved to better safeguard brand owners' interests in Russia. However, each particular case requires a specific legal approach, and brand protection strategy development should take into consideration best practices and IP solutions.

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Our Practice Areas Intellectual Property Patent We are involved in all aspects of We are actively engaged in Intellectual Property Laws. devloping and securing vital patents for our clients. Design Trademarks We have one of the largest full We acknowledge that designs are a service trademark practices in powerful and all-prevasive legal Pakistan rights Copyright We deliver comprehensive copyright counseling to all kinds of clients 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

Keeping pace with the changing face of brand protection

Emmy Hunt, Head of Trademarks at Potter Clarkson, evaluates the evolution of brand protection and its impact on the expected role of trademark lawyers, offering invaluable advice for keeping up with the times.

Rands often account for a huge part of a business' value. In sectors such as software, tech, retail, and FMCG, a brand can easily account for 85% of a company's total value. The most commercially astute businesses drive their brand into the public consciousness to expand their share in increasingly competitive marketplaces.



Client Recoginition

• Fortune 500 companies

Brands

Brands

Companies

• Top 10 to Top 100 Chinese

• Top 10 to Top 100 European

Leading telecommunication,

technology & Pharmaceutica



Consequently, brand strategy is moving to the top of the list of commercial priorities for many businesses that recognize that the stronger a brand is, the more it can help differentiate the business from its competition, drive sales, increase market position, support premium pricing, attract investment, and entice the best talent.

Naturally, the best in the trademark profession have sought to better serve these changing commercial priorities of their clients.

The traditional role of a trademark lawyer – searching and clearance, filing and prosecution, portfolio management, and enforcement – is now a minimum requirement. Clients need much

Résumé

Emmy Hunt is the Head of Potter Clarkson's Trademark Team. She is a highly experienced attorney with an international reputation for advising clients on trademark matters, managing and enforcing a wide range of UK and worldwide portfolios, and providing strategic advice for major brand owners across the world. Having specialized in media, technology, engineering, and fashion, Emmy is recognized as an expert in the particular brand protection issues these sectors face: certification marks, protecting non-traditional marks, company and domain name watching and enforcement, challenging existing rights in order to safeguard freedom to operate, and licence and co-existence negotiations.

more – they need the support of well-rounded advisers who genuinely understand a brand from all its directions, legal and commercial, and can advise on the most effective ways to maximize its value.

The pivot to a wider brand strategy presents challenges for those in the trademark profession, not least because we are also working much more closely with commercial teams centered on brand management, licensing, marketing, and so on. As lawyers, our terminology can be different, as can our appetite for risk, timescales, and cost-efficiency. However, if this is the way our clients think and, more importantly, where clients enjoy the greatest return from our involvement, these challenges must be overcome.

At Potter Clarkson, our transition to better supporting our clients' brand strategy has centered on our teams of trademark attorneys and IP solicitors actively working together to deliver the four stages of a brand's life cycle: identification, protection, exploitation, and enforcement.

Ultimately, a business develops intellectual property as part of a wider strategy to achieve financial and commercial success. Successful delivery of the brand strategy must be delivered by both the business and its lawyers with the financial and commercial objectives in mind.

In supporting our clients to achieve this, our lawyers might provide clearance advice, adapt and extend the trademark portfolio, and keep watch for potential brand infringers, counterfeiting, and any other behavior that could impact the market performance of a business. They might also assist with licensing, franchising, collaborations, the



Emmy Hunt

Ultimately,

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expansion of a brand owner's wider business model, and any strategic acquisitions the business wants to make.

In enforcing a brand, success will again depend on IP lawyers working together closely with the business.

Our trademark lawyers will work closely with a business to help them to set out their customs enforcement strategy and file customs notifications to enable the relevant authorities to seize infringing goods, initiate online marketplace takedowns and manage registry disputes in addition to managing infringement actions, litigation, settlements, mediation or arbitration, co-existence and any contractual or ancillary rights disputes.

The risks presented to brand owners in the online marketplace have brought the need for closer collaboration between a business and its lawyers into much sharper focus.

As internet usage all over the world continues to grow, online marketplaces are now integral to the way products are sold. However, with increased opportunity comes increased risk. In 2023, there was a 38% increase in counterfeiting, and reports of products being sold online under entirely false pretenses are frequently in the headlines. Trademark lawyers have increasingly been under pressure to develop even more complex tools to protect their clients' brands and make it as quick and easy as possible to identify and deal with illegal activity.

We have addressed this on behalf of our clients with iProvidence, a state-of-the-art online brand protection solution that brings together the latest search technology with the strategic, tactical, and international brand protection expertise of our IP attorneys, our solicitors, and the brand protection analysts to add yet another dimension to our brand protection offering.

Regardless of which platform a brand owner uses to monitor the online marketplace (and more options keep coming onto the market, particularly with the development of increasingly smart AI tools), the ability to instantly identify and deal with online infringement is now a vital component of a brand strategy. As trademark lawyers, we have taken steps to ensure we are well placed to protect our clients online depending on the level of threat, staying on top of the latest tactics of counterfeiters.

Understanding how and where fake products are sold is key to enforcement. IP infringement takes place on many different channels and there are now more and more infringing items sold via social media and marketplaces rather than on the more traditional ecommerce sites. We regularly keep clients up to date on these trends.

One approach to online enforcement is through an initial infringement audit to analyze where infringing products are sold and in what volume. The results can be used to show where a business should focus its brand strategy and where its enforcement budget would be best spent.

An additional approach is to help clients develop **have** their own anti-infringement model tailored to their products, most likely looking at consumer behavior (i.e., where people search for these types of products: through apps, social media, or e-commerce sites) and their key geographic markets. This can be particularly well suited to specialist products and/or unusual markets.

A further approach for a business to cement its position against infringers is for our lawyers to provide a framework, in consultation with the relevant teams within the client's business, creating a blacklist of repeat infringers next to a white list of official resellers, providing updates on new counterfeit trends and patterns with adjustments made to monitoring and enforcement policies, instigating a centralized repository for information and procedures and even helping them hire a dedicated member of staff to gather and manage these requests within the business.

Regardless of the support clients need, we must all be prepared to provide much more in terms of strategic support when we do find new infringements. In our experience, where infringements occur, strategic support can be summarized as:

- 1. Connecting the dots to find the source of the problem;
- 2. Improving internal intelligence gathering and using existing commercial networks of the client's business; and
- 3. Better integrating online and offline brand protection efforts.

Connecting the dots requires us to adopt a proactive approach to gathering information on the particular risks a brand is facing so that the business can make informed decisions as to how they need to develop their brand protection strategy to stay one step ahead of the counterfeiters and reduce the risk of future infringements.

Regarding business intelligence, a brand protection strategy must be about more than 'just' taking down fakes. It should also look for wider information and collect data from different sources that can be made available throughout the business so that new fakes and changes in infringer behavior can be identified and acted upon quickly.

Trademark lawyers increasingly been under pressure to develop even more complex tools to protect their clients' brands and make it as quick and easy as possible to identify and deal with illegal activity.



Many brand protection strategies still focus on bulk seizures, customs training, and border protection. These offline practices are important, but they're also slow. They are much more effective if they are supported by digital activity. For example, by tracking search engine traffic, most specifically the keywords that imposter sites and counterfeiters' campaigns are using, a business's marketing team can make smarter decisions on its future digital marketing spend.

Businesses can also thwart online counterfeit sellers by overlaying text on their product images to give contact details or product descriptions to potential buyers. At the same time, it blocks bots from searching for keywords in text and deters infringers from lifting product images and using them unlawfully.

Similarly, adopting Optical Character Recognition (OCR) technology on behalf of our clients, to scan images for words (when text-based searches won't work) can save hours of time that can be reinvested in taking offensive action against counterfeiters and infringers.

As trademark lawyers, the integration of online and offline brand protection strategies is an area where we offer particular value, and again, reflects both the change in the traditional role of a trademark lawyer and the way that brands are now communicated and commercialized. Trademark lawyers that support modern business must keep step or face the very real possibility that they will be found lacking in terms of what clients really need from us in today's marketplace.

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Understanding trademark popularity and protection in Russia

Olga Plyasunova, Head of the Trademark Department at Zuykov and partners, explains the concept and available protection for well-known trademarks in Russia with advice on how to obtain such a privilege.

ccording to Articles 1477 & 1484 of the Russian Civil Code, a trademark (service mark) is understood as a designation that serves to individualize goods, works, or services in respect of which the trademark is registered. The exclusive right to a trademark, including the right to place it on goods (labels, product packaging), as well as on signs, in advertising, etc., belongs to the copyright holder. Thus, a trademark allows you to distinguish the goods of a certain manufacturer from the total mass and from the goods of other manufacturers of homogeneous goods.

Without the permission of the copyright holder, the law prohibits the use of designations similar to registered trademarks in relation to goods for the individualization of which it is registered, or homogeneous goods, if as a result of such use, there is a likelihood of confusion (Clause 3 of Article 1484 of the Civil Code of the Russian Federation). As experts note¹, the condition of homogeneity of goods is natural, since the appearance on the market of goods of the same

Résumé

Olga Plyasunova is the Head of the Trademark Department at Zuykov and partners, a trademark attorney in Russia and a Eurasian patent attorney. She has extensive experience in the fields of appellations of origin for goods, trademarks, service marks, and industrial designs. Olga also specializes in the registration of geographical indications and well-known trademarks.



Olga Plyasunova

Both a registered trademark and a designation used as a trademark can be recognized as wellknown.

name from a competing manufacturer deprives the copyright holder of some consumers and reduces its profits. At the same time, the appearance on the market of goods of the same name, but fundamentally different in essence, does not affect the business of copyright holders.

To protect exclusive rights to a trademark, the copyright holder needs to prove that a third party, without consent, uses a trademark (a confusingly similar designation) specifically in relation to the goods (works, services) for which it is registered or similar to.

At the same time, when regulating wellknown trademarks, the legislator takes a different approach, which provides the copyright holder of such a mark with certain advantages. However, registering a trademark as well-known is quite a difficult task. In the register² of well-known trademarks in the Russian Federation, only 260 designations are registered. Let's consider what criteria are used when assessing the wide popularity of a trademark in Russia in order to provide it with legal protection.

Which trademarks are considered well-known in the Russian Federation?

A well-known mark is a special type of mark that gives its owner special status and protection regulated by the Civil Code of the Russian Federation. The conditions for registration and protection of well-known trademarks are specified in Articles 1508-1509 of the Civil Code. Thus, both a registered trademark and a designation used as a trademark can be recognized as wellknown. A trademark or designation may be recognized as well-known if, as a result of intensive use, it has become widely known in



Russia among relevant consumers in relation to the goods (works, services) of the applicant.

For example, the trademarks marking the applicant's products, which are sold in all federal districts of Russia, including administrative centers of the constituent entities of the Russian Federation, large cities, and urban districts (Figure 1).

Befree Sela ZARINA

Figure 1: Well-known trademarks N N 237, 253, 210 (25th class of the ICGS "Clothing"). Copyright holder JSC Melon Fashion Group

However, the geographical criterion in itself is not a decisive factor. In order for a designation to be recognized as a well-known trademark, it is not necessary that it be used in all or most regions of Russia. Moreover, it may be considered generally known, even if it is used only in the territory of one region or other administrative unit. An example is the verbal designation "VDNKh" (Moscow), which was recognized as a well-known trademark in relation to the services of the 35th class of the ICGS "organization of exhibitions" and the services of the 41st class of

Kozlova N.V., Vorozhevich A.S. Well-known trademarks: concept and features of legal protection // Law. 2015. N 12. P. 179 -190

- https://w/w/w1fips.ru/ registers-web/ action?acName= docList2tree
- the Intellectual Property Rights Court on issues of legal protection of wellknown trademarks", approved by resolution of the Presidium of the SIP dated August 26, 2022, N SP-21/18 Decision of the Intellectual Riahts Court dated

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66 **Proving the fact** that a trademark is well known is a rather difficult task

the ICGS "organization of exhibitions for cultural and educational purposes; organization of leisure" (No. 153, Copyright holder OJSC "VDNKh").

Thus, the main criteria are the familiarity (recognizability) of the designation in the Russian Federation by a wide circle of consumers and its association with the source of origin of goods (works, services) on the date specified in the application for registration of the mark as wellknown.

According to the explanations³ of the Intellectual Property Rights Court, the wide popularity of a trademark can result not only from its intensive use in any particular period of time, but also from other circumstances, for example, from a long, widely known history of the designation. However, continuous use of the trademark is not a prerequisite.

Also, to recognize a mark as generally known, it is not necessary to establish whether the applicant is known to consumers; it is sufficient to establish whether the consumer believes that the goods come from the same source⁴.

What are the advantages of owning a well-known trademark?

Like the owner of a regular trademark, the copyright holder of a well-known trademark receives the exclusive right to it and all related powers: use of the trademark by any legal

"Review of the practice of

December 6, 2023, in case No. SIP-647/2023

means, disposal of the right to it, as well as the right to protect the trademark from illegal use by third parties, including the requirement to pay compensation.

However, unlike the copyright holders of an ordinary mark, a well-known trademark gives the copyright holder the following advantages:

- Perpetual legal protection the validity period of legal protection for wellknown trademarks is unlimited in time and does not require extension (clause 2 of Article 1508 of the Civil Code of the Russian Federation);
- Expanded protection of rights legal protection extends to goods that are not similar to those for which the trademark is recognized as well-known, and also increases the possibility of suppressing violations of a well-known trademark;
- Confirmation of the owner's status is a public confirmation of the widest popularity of the brand in the Russian Federation and its unambiguous association with the copyright holder company.

In addition to these advantages, a well-known trademark is one of the tools to combat the socalled "blurring" of trademarks.

This possibility of extended protection is due to the fact that a well-known trademark is perceived by consumers as something more than just a means of individualizing specific goods. It is associated with the business reputation of the owner of the mark, and often with prestige.

Therefore, the peculiarities of regulating legal relations related to a well-known trademark are aimed at protecting consumers from misconceptions regarding the source of the origin of goods, their belonging to a specific manufacturer, as well as preventing image and reputational losses of the copyright holder in the event of poor quality of other people's goods marked with the corresponding trademark.

How to recognize a trademark as well-known

To recognize a trademark as well-known in Russia, you need to submit a corresponding application to the Rospatent. The application must indicate the trademark or designation used as a trademark that the applicant wants to recognize as wellknown, as well as a list of goods (works, services) and the date from which the applicant considers his mark to be well-known.

The application must be accompanied by materials confirming that the trademark has become widely known in the Russian Federation

during the time period preceding the date from which the applicant considers the mark to be well-known

An approximate list of materials on the basis of which the well-known nature of a trademark is established is indicated in the Administrative Regulations of Rospatent. This, in particular, may be materials that contain information:

- On the intensive use of a trademark or designation, including information on the date of commencement of use of the trademark, places, and volumes of sales of goods, the average annual number of consumers of the product, the position of the manufacturer on the market in the relevant sector of the economy, and similar information;
- On the costs of advertising a trademark or designation and on its cost (value) according to the annual financial reports;
- On the results of a survey of consumers of goods on the issue of well-known trademark or designation, conducted by a specialized independent organization. At the same time, Rospatent has developed appropriate recommendations for processing data from sociological surveys.

As practice shows, proving the fact that a trademark is well known is a rather difficult task. For example, when developing a strategy to prove the widespread popularity of marks, the number of materials that our experts used to confirm this fact amounted to several dozen for each mark.

At the same time, competently building a strategy helps to immediately achieve the desired result at the stage of interaction with Rospatent without resorting to lengthy legal disputes. In addition, all difficulties are outweighed by the economic and other advantages that the owner of a well-known trademark ultimately receives. Zuykov and partners have extensive experience in registering well-known trademarks having already recognized 14 trademarks as well-known, including those mentioned in this article (VDNKh, Befree, Zarina, Sela), as well as such marks as Belaz, Vitek, and many others.

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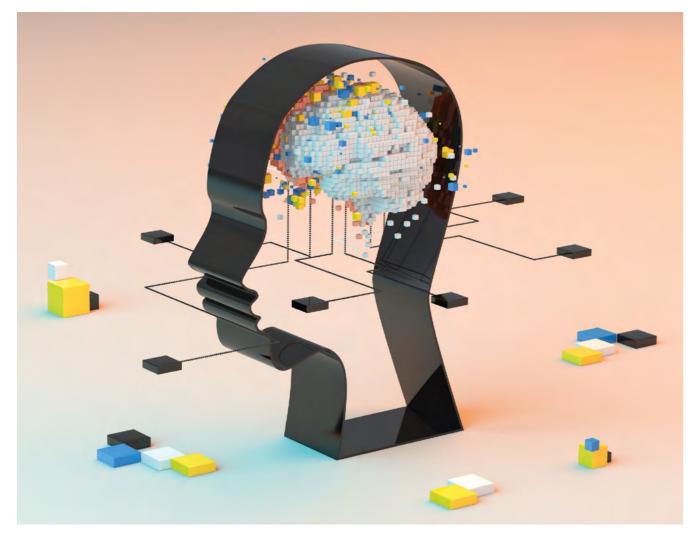
Are AI and intellectual property ¿"frenemies"?

Natalia Vera Matiz, partner at Vera Abogados Asociados, explores the two main concerns surrounding the coexistence of AI and IP.

hen we discuss AI and its interaction with intellectual property, it seems that the first constitutes a threat to the second. To assess this preconception, it is important to consider different points of view.

The issue at hand is not minor, especially considering that many authors nowadays use AI in their creative process. This raises two concerns: first, determining the extent of human intervention required to consider a work created with the assistance of AI as eligible for copyright protection.

The most straightforward conclusion for this issue is that works created solely by AI are not entitled to copyright protection. However, this approach could hinder the advancements of the technology industry and investment in this field of the economy. Just as the cinema industry has benefited from changes in copyright legislation that allowed for increased flexibility in the use of copyrighted materials, encouraging innovation in filmmaking, the attitudes towards AI authorship could turn the other way.



Résumé

Natalia Vera Matiz, Lawyer (Universidad Externado de Colombia 2006). Master in Law (Universidad de Chile, Santiago de Chile, Chile). Natalia has a graduate degree from Harvard Extension School, Boston, US (2011) and is currently a Partner of Vera Abogados Asociados.

The second issue concerns the use of materials for training AI. Some advocate for the free use of materials to train AI, arguing that free speech and scientific research are at stake because AI

can constitute an important advancement in both fields. The counterargument concerns the lack of remuneration for and authorization from the owners of materials used in training AI models.

Lawmakers and judges need to consider implementing policies that provide remunerations alongside setting exceptions for obtaining a license or authorization from the owner to use protected materials in the process of training AI models. These subjects have been taken into account in recent cases, including The Times v. ChatGPT. We should also look to other countries; Japan, for



Natalia Vera Matiz

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instance, has proposed a very flexible draft policy to allow for the broadest possible training of AI with copyrighted material.

In order to foster the development of generative AI and the technology in general, it's time to ask the right questions and avoid arriving at premature conclusions, such as ruling out the protection of works produced by AI altogether! We will not be able to train AI to its fullest potential without copyrighted material; it's time to think globally once again, achieve a general consensus before it overwhelms us all, and think with the mindset of the original purposes of IP.



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