“THUMS UP” – and down – to US trademark registration challenges based on “foreign” marks

Chris Mitchell, a member of Dickinson Wright, reviews the dispute between Coco-Cola and Meenaxi over the request for the cancellation of registration of identical marks with key takeaways in light of a surprising outcome.
It is no secret that the root cause for many cases of infringement is the opportunity to benefit from the reputation of an already well-known brand. Most try and fail due to either a poor-quality knock-off rejected by consumers or an infringement action brought by the original brand for deceptive similarity. But where do foreign marks sit with deceptive similarity, if the consumers are not aware of well-known goods in a different jurisdiction? Our cover story explores Coca-Cola’s failure despite the territoriality principle.

Our guest interview this issue features Chris Bolinger, Senior Director, IP Legal, Trademarks at Astellas Pharma, and discusses his experiences with the process for trademarking drug names and the company’s decision to engage outside counsel in a globalization effort and to allow his team to focus on strategic initiatives.

This issue also includes timely updates on trademark protection in Russia, the benefits of keeping track of the Chinese version of your trademark, an exploration of domain name registration liability, and more! Special thanks to this issue’s Women in IP Leadership sponsor, HGF. HGF’s sponsorship enables us to continue the segment and offer a platform for women to share their experiences and ideas for equity.

Don’t forget to make your law firm rankings nominations for 2023 by the end of November. Find out more at www.trademarklawyermagazine.com/law-firm-rankings/

Enjoy the issue.

Faye Waterford, Editor
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Francesco Bonini - Studio Bonini, Italy
Francesco has 20 years experience in Italian and EU trademark and design prosecution. He has had successful cases in opposition, appeals and cancellations both before the EUIPO and the Italian PTO. Studio Bonini was established in 1992 and its head office is located in Vicenza in the North-East of Italy. It has helped several companies of the Venetian area to protect their IP rights, dealing with IP prosecution.

Gang HU - General Director of Litigation Division, CCIPT Patent & Trademark Office, China
Gang is a senior Chinese IP specialist and practitioner. He is good at solving all kinds of complicated trademark litigation and non-litigation cases. Some of the influential cases he handled were widely reported by a variety of media. He has a successful track record in defending the IP rights of many famous brands.

Stacey C. Kalamaras - Senior Counsel, Marketing Properties, Mars Wrigley, US
Stacey is one of three senior counsel at Mars, Wrigley handling the brand protection responsibilities for the candy brands on a global basis. Stacey spent most of her career in Big Law representing many well-known brands in 150+ countries. Prior to law school, she worked at an academic non-profit. She has conducted guest lectures in some of India’s top Law Schools. She has designed trademark courses, chaired seminars clocking 60+ speaking hours, and trained 2.5K+ lawyers.

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

Charlotte Wilding - Partner, Wedlake Bell LLP, UK
Charlotte Wilding heads up the trademark practice at Wedlake Bell LLP. An expert in her field, she specializes in providing strategic IP advice, as well as the prosecution, maintenance, and enforcement of IP rights. Charlotte is also an active member of the International Trademark Association’s Young Practitioners Committee.

Misum Hossain - Founder & Head, Lincoln Legal Chambers, India
Misum heads the full service law firm that works in diverse areas including IP. He has 30 years' trademark experience in registrations, dispute resolution and licensing. Misum, an alumnus of the University of London LL.M programme, has advised clients for IP, UKIPO, EUPTO, USPTO, IP AUS & CIPO. He is also currently their VP at an academic non-profit. He has conducted guest lectures in some of India’s top Law Schools. He has designed trademark courses, chaired seminars clocking 60+ speaking hours, and trained 2.5K+ lawyers.

Shelley Jones - Lawyer and Registered Trademark Agent, Canada
Shelley is a lawyer and registered trademark agent based in Ottawa and a Fellow of the Intellectual Property Institute of Canada (IPIC). As experienced IP counsel, Shelley has worked with famous brands on matters related to trademark and copyright infringement, litigation, domain name disputes, and anti-counterfeiting issues. A significant portion of her paid practice has also involved managing global trademark portfolios. More recently, Shelley has been working in the not-for-profit sector on projects focused on increasing IP awareness and education.

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

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

Stacey is a devoted trainer of other lawyers, as a marketing and advertising executive. She is a lawyer and registered trademark agent with a passion for Intellectual Property law. Focused on brand portfolio management, trademark prosecution, non-routine trademark matters and advertising law. She is an active member of the Jamaican Bar Association, INTA’s Young Practitioners Committee and a member of the Women’s IP Today Steering Committee.
Recent decision from the United States Court of Appeals for the Federal Circuit ("Fed. Cir.")1, Meenaxi Enterprise, Inc. v. Coca-Cola Company, No. 2021-2209 (Fed. Cir. June 29, 2022), provides valuable instruction on the circumstances in which foreign trademark owners can challenge a US trademark registration despite the territoriality principle.

In trademark law, "territoriality" recognizes that "trademark rights exist in each country solely according to that country’s statutory scheme."2 On this principle alone, the holder of a non-US mark might well be constrained to suffer another’s registration and use in the US of the same mark. However, Meenaxi articulates a more expansive reading of US law in the wake of the US Supreme Court’s decision in Lexmark International, Inc. v. Static Control Components, Inc.3 finding that the US Trademark Act provides causes of action for reputational or economic injury (even in the absence of trademark rights).

The facts of the case reach back decades and concern two soft drinks sold primarily outside of the US: THUMS UP and LIMCA. Both were introduced in India in the 1970s by a third party whom Coca-Cola, already present in India since the 1950s, acquired in 1993. Both beverages are widely distributed and well-known in India, and each has sales in Southeast Asia, Africa, and the Middle East as well. Coca-Cola itself doesn’t sell either beverage in the US except in apparently de minimis amounts at "Coca-Cola stores" in the cities of Atlanta, Georgia, and Orlando, Florida. However, both THUMS UP and LIMCA are resold in significant numbers in Indian grocery stores worldwide, including the US.

In 2008, Meenaxi began selling its own LIMCA and THUMS UP-branded soft drinks to Indian grocery stores in the US. In 2012 it registered these marks in the US Patent and Trademark Office ("USPTO"). Meenaxi didn’t stop at adopting two identical marks for very similar soft drinks (a cola in the case of THUMS UP and a lemon-lime soda in the case of LIMCA, just like the Coca-Cola product). For a time Meenaxi used logo forms of these marks that were highly similar to those used by Coca-Cola. It also leveraged its US trade-marks to block third-party imports of genuine LIMCA and THUMS UP beverages into the US.

Coca-Cola sought to cancel both registrations in 2016 through administrative proceedings in the USPTO (before the Trademark Trial and Appeal Board, the "TTAB"), asserting multiple grounds but ultimately only pursuing a claim under Section 14(3) of the US Trademark Act. That statutory section provides a cause for cancellation of a registration "at any time...if the registered mark is being used by, or with the permission of, the registrant so as to misrepresent the source of the goods or services on or in connection with which the mark is used."4

Résumé

Chris Mitchell, a member of Dickinson Wright, reviews the dispute between Coca-Cola and Meenaxi over the request for the cancellation of registration of identical marks with key takeaways in light of a surprising outcome.

1 The Fed. Cir. is the exclusive court for appeals from the US Patent and Trademark Office. So, absent further successful appeal to the US Supreme Court, the decisions of the Fed. Cir. are the final statement of the law as concerns US Patent and Trademark Office proceedings.


4 15 USC §14(3).

Chris Mitchell, a member of Dickinson Wright, has practiced exclusively in the area of intellectual property law for over 25 years, handling trademark matters - from procurement to licensing and litigation - for clients throughout the world.
At the administrative level, the TTAB sided with Coca-Cola, seemingly persuaded largely by the idea that the US Indian-American population is familiar with Coca-Cola’s THUMS UP and LIMCA beverages’ reputations in India, as well as Meenaxi’s apparent intent to trade on those reputations in the US. As the TTAB summed up: “the record as a whole demonstrates [Meenaxi’s] intent to cause consumers exposed to [its] use of the THUMS UP and LIMCA marks to draw the logical conclusion that [Meenaxi’s] products in the United States are licensed or produced by the source of the same types of cola and lemon-lime soda sold under these marks for decades in India.”

On appeal by Meenaxi, however, the Fed. Cir. wasn’t equally persuaded. Though confirming that the “territoriality” principle didn’t stop Coca-Cola from seeking cancelation under Section 14(3) where its claim was premised on injury allegedly occurring in the US, the court found Coca-Cola’s position untenable when it came to the evidence of either economic or reputational injury.

As to economic injury, the court faulted Coca-Cola’s proofs for identifying damage only to third party resellers of genuine LIMCA and THUMS UP sodas. Damage to those third parties didn’t equate to lost sales for Coca-Cola. The court further considered Coca-Cola’s own US sales at its stores in Atlanta and Orlando. It found these to be unquantifiable and likely de minimis. It also found Coca-Cola failed to show that it lost any sales to Meenaxi’s beverages. Relatedly, Coca-Cola’s claims of future plans for the US market were deemed too speculative to justify a cause of action.

On the matter of alleged reputational injury, Coca-Cola’s failure to demonstrate economic harm would again undermine its claim: Coca-Cola failed to explain how its’ supposed reputational injury adversely affected its commercial interests other than to speculate that a consumer dissatisfied with Meenaxi’s products might blame Coca-Cola. The Supreme Court in Lexmark explained that a cognizable “economic and reputational injury” generally “occurs when deception of consumers causes them to withhold trade from the plaintiff.” As we have discussed earlier, Coca-Cola alleges no lost U.S. sales as a result of the claimed reputational injury in the Indian-American community.

As to the foundational issue of whether the Coca-Cola marks had any US reputation to be impinged, the court faulted the TTAB for presuming too much from the evidence of name recognition in the Indian-American community:

“The Board’s findings are primarily related to Coca-Cola’s activity and reputation in India, but that does not establish reputation within the Indian-American community in the United States...”

Substantial evidence does not support that finding. The Board’s conclusion that reputation of the THUMS UP and LIMCA marks would extend to the millions of Indian Americans appears to rest in part on an assumption that Indian Americans would necessarily be aware of the marks’ reputations in India. There is no basis to assume that an American of Indian descent is aware of brands in India. And so, finding that Coca-Cola failed to demonstrate injury giving rise to a cause of action under Section 14(3), the Fed. Cir. reversed the decision of the TTAB, preserving Meenaxi’s US registrations.

Some key takeaways

The most obvious takeaway, of course, is that foreign trademark owners able to demonstrate injury in the US due to a challenged mark have grounds to seek cancelation even in the absence of US trademark rights. However, Meenaxi makes plain that: (i) evidence of a US reputation must be more than speculative; and (ii) evidence of financial harm in the US must be to the complainant rather than a third party, as well as more than de minimis. Apropos of this cause, a consumer survey of Indian-Americans would have been the clear frontrunner in dealing with the first hurdle, though the facts don’t suggest Coca-Cola had a strong position on the issue of financial injury to itself.

The court’s comments on reputational injury also suggest the need to tie in economic harm, such as lost sales. In other words, reputational injury must have an economic component. However, it did leave room for future complainants to argue that other kinds of commercial injury in the US might suffice.

The line between the territoriality principle and Section 14(3) remains murky. Heretofore, some courts have recognized an exception to “territoriality” where “famous marks” – marks whose use outside the US had nonetheless resulted in renown in this country – are concerned. Coca-Cola didn’t rely on this exception however, despite the fact that its reputational injury argument asserts notoriety of the THUMS UP and LIMCA brands in the US. Meenaxi therefore appears to expand the theoretical grounds for challenges based on foreign marks, so long as injury in the US is demonstrable, in further erosion of “territoriality.” The dissenting opinion in Meenaxi (Judge Reyna) takes the majority to task for this, arguing that – “excepting perhaps ‘famous marks’ – the territoriality principle should have precluded Coca-Cola’s claims altogether.”

Meenaxi does not go so far in expanding the reach of the US Trademark Act as the Fourth Circuit’s decision in Belmora LLC v. Bayer Consumer Care AG, a case which held, in the wake of Lexmark, that the Trademark Act gives standing to foreign trademark owners to challenge US marks on the basis of commercial injury outside the US. Some key takeaways extend to the millions of Indian Americans appears to rest in part on an assumption that Indian Americans would necessarily be aware of the marks’ reputations in India. There is no basis to assume that an American of Indian descent is aware of brands in India. And so, finding that Coca-Cola failed to demonstrate injury giving rise to a cause of action under Section 14(3), the Fed. Cir. reversed the decision of the TTAB, preserving Meenaxi’s US registrations.

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Can you start by telling us about Astellas Pharma and your role at the company?

Astellas is a Japan-based global company with a core business in innovative prescription pharmaceuticals. The company also has active initiatives in cell and gene therapies and medical technologies.

As the Trademark Lead at Astellas, I am responsible for heading a five-person team that provides practical, strategic, and risk-balanced advice to our corporate clients on trademark, copyright, design, and domain-name matters, and manages the company’s global trademark, copyright, design, and domain-name portfolios, including clearance, acquisition, maintenance, enforcement, and licensing.

What attracted you to the role?

Astellas provided me with an excellent opportunity to use my extensive experience in the pharmaceutical industry and to provide leadership to a superb team of IP professionals in the healthcare industry and to help create a more strategic and cost-efficient operation.

Is there a product that Astellas Pharma has developed that you find of particular interest? Why?

Not a product per se, but the first thing that comes to mind is Astellas’ Rx+ business. The Rx+ business seeks to capitalize on the company’s experience and knowledge in the pharmaceuticals arena and integrate innovative medical technologies to improve patients’ lives in areas such as chronic disease progression prevention and motor and sensory function support. I’m excited to see what products and services come out of it. I like the Rx+ model in that it operates with a business accelerator approach with quick timelines and the need for branding and intensive trademark support. It’s a prime opportunity to guide our clients and provide value to them.

Many pharmaceuticals will have multiple names, e.g., a long, generic, scientific name and a generic, known-to-market brand name. Can you explain the decision process behind deciding upon and trademarking new drug names?

Pharmaceutical trademark development is quite a process, but as a trademark attorney it is fun to experience. First, of course, you need a generic name – known as an INN (International Nonproprietary Name) – for the drug. INN creation usually involves a collaboration between representatives from Regulatory, Clinical Research, Marketing, and Legal to find an INN that is safe, that communicates accurate information about the drug, and that is – hopefully! – not impossible to pronounce. The process typically starts several years prior to anticipated regulatory submission.

A proposed INN needs to pass muster with regulatory bodies such as WHO (World Health Organization) and USAN (United States Adopted Names). To be viable, the INN will need to avoid similarity to existing INNs and trademarks. It will also need to identify accurately the pharmacological substance through use of “stems” – syllables at the beginning, middle, or often, the end of the INN – through which anyone dealing with pharmaceutical products can appreciate the chemical structure or pharmacological activity involved with the drug. For example, many antiviral drugs end with -vir (oseltamivir, bictegravir, etc.).

In addition to relevant stems, the INN will incorporate a prefix designed to differentiate the new drug from others in the same pharmacological class. The primary importance of such differentiation is patient safety, though many teams develop prefixes that also may carry some meaning to the development team.

The pharmaceutical trademark development process can be even more complicated than developing the INN. In addition to navigating successfully the various global trademark offices, your trademark (or “proprietary name” in pharma parlance) must satisfy the relevant regulatory authorities such as the US FDA (Food & Drug Administration), EMA (European Medicines Agency), Health Canada, and others.

The trademark process usually starts after the INN process but still several years prior to regulatory submission and is a collaboration between Marketing, Regulatory, and Legal, typically working in conjunction with an experienced branding agency to develop names that are not only legally available but also viable from a patient safety perspective.

The branding agency will meet with the in-house team to determine creative direction and then develop hundreds of candidate marks that are reviewed for availability for use and registration on a global basis and reviewed against the FDA’s POCAs (Phonetic and Orthographic Computer Analysis) tool to avoid “look-alike, sound-alike” issues with prior trademarks or INNs that might create a patient safety issue. In addition to spelling and pronunciation similarities, companies generally need to avoid names that incorporate stems, product-specific attributes, medical abbreviations, or false or misleading representations as to safety or efficacy.

Short-listed candidates often go through further screening, including name simulation studies, handwriting analysis, linguistics analysis (such as to ensure that the candidate name is not offensive in another language), and marketing studies. If a trademark gets through this gauntlet unscathed, it’s like gold! However, given the proliferation of drugs and trademarks, it is increasingly difficult to find a trademark that works globally. Therefore, companies often...
First, education of the client is the key. We work to build strong relationships with our internal business clients and have developed education and guidance materials concerning trademarks, copyright, design, and domain names so that our clients know when to come to us and guidance materials concerning trademarks, copyright, design, and domain names so that our clients know when to come to us and generally our clients know when to come to us and when they want to go, explaining the risks and benefits of the different options in front of them. They want answers and pragmatic guidance. Work with them to find a way to get to where they want to go, explaining the risks and benefits of the different options in front of them, and leverage your experience to provide a recommendation that fits their needs.

What advice would you give to a lawyer moving to an in-house position? First, build a network within the company – when your colleagues get to know you and trust that you are there to help them reach their goals, they will come to you for guidance. This will only help flush out IP issues and help you to serve their needs and the company’s needs. Also, keep your audience in mind. Your internal clients usually don’t want a legal treatise, so keep your advice simple and boil it down for them.

**In addition to navigating successfully the various global trademark offices, your trademark (or “proprietary name” in pharma parlance) must satisfy the relevant regulatory authorities such as the US FDA, EMA, Health Canada, and others.**

As trademark attorneys, we are always vigilant about finding any packaging or product elements that might function as trademarks or qualify for design protection. However, I would say that my main experience in this area has generally been to identify and avoid obvious conflicts with pre-existing competitor products that have or might have reasonable claim to protection in color or shape.

Do you have a process for capturing IP at Astellas Pharma? First, education of the client is the key. We work to build strong relationships with our internal business clients and have developed education and guidance materials concerning trademarks, copyright, design, and domain names so that our clients know when to come to us and when they want to go, explaining the risks and benefits of the different options in front of them. They want answers and pragmatic guidance. Work with them to find a way to get to where they want to go, explaining the risks and benefits of the different options in front of them, and leverage your experience to provide a recommendation that fits their needs.

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Successfully pursuing a TRO – what to do so the horse doesn’t leave the barn

Richard Moore, Member of Frost Brown Todd, analyses the *Mesa Industrial Inc. v. Charter Industrial Supply, et al.* case, offering key takeaways for tackling a temporary restraining order.

In Mesa Industrial Inc. v. Charter Industrial Supply, et al., Case No. 1:22-cv-160, the plaintiff, Mesa Industries, Inc. (“Mesa”) sued its former employee, Alexandra Espinoza and Kyle King, and their new employer, Charter Industrial Supply (“Charter”), for, among other things, misappropriation of trade secrets and the court granted its request for a temporary restraining order (“TRO”). Nothing groundbreaking there, but the case provides a good framework for a general discussion on what companies can do to set themselves up for success if they have to pursue a TRO.

**Background**

Espinoza began working for Mesa in California as a Quality Control/Design Drafter. Espinoza eventually transferred to Mesa’s Cincinnati, Ohio location where his co-defendant, King, also worked. When he started at Mesa, Espinoza signed two separate agreements that prohibited him from disclosing Mesa’s confidential information. Both Espinoza and King also received the employee handbook, which also contained prohibitions against disclosure of the company’s confidential information.

The confidential information that Mesa sought to protect fell into two categories – its above-ground storage tank database (the “Database”), which contained 30 years of data about its customer’s tanks, their components, technical specifications, and other information. The other category of trade secret information was “Application Drawings” regarding the tanks contained in the Database.

When he left, Espinoza told Mesa he was accepting another position in Cincinnati but instead took off to California to go to work for Defendant Charter, a direct competitor of Mesa. When Mesa found out, it sent both Espinoza and Charter a letter informing Charter and Espinoza of its obligation not to share Mesa’s secret stuff. Espinoza responded that he had not done so and would not do so – but he apparently did do so.

Espinoza was ratted out by a former Mesa employee who also worked at Charter and recognized the Database and Application Drawings on a thumb drive he shared with Espinoza. That employee sent Mesa screenshots of the information and that was all the proof Mesa needed and it filed suit. Before turning to the details of the decision, it is important to point out some key distinctions between a “regular” lawsuit and one seeking injunctive relief. First, in a typical civil suit, one party is seeking money from the other party to repair the harm caused by the defendant. For example, when a defendant failed to pay the plaintiff for the variety box of bagels the plaintiff delivered, the defendant owes the plaintiff the cost of the bagels. If the plaintiff recovers the money it is owed, it is made whole, and justice is done.

In cases involving injunctive relief, however, money might help but it won’t fix everything. A key component of establishing a right to injunctive relief is that the party seeking the injunction must be able to show that they will suffer “irreparable” harm if the injunction is not granted – think horses leaving barns.

Because the plaintiff runs the risk of suffering irreparable harm that leads to the other distinction between “regular” cases and injunctions – the court is asked to grant the requested relief quickly to avoid potential irreparable harm. A typical lawsuit creeps along at a petty pace from day to day and takes much longer to resolve than anyone involved thinks it should. In cases involving requests for injunctive relief, however, the LP is turned up to 78 and things move much faster.

This is a critical point for companies to keep in mind. A company claiming irreparable harm can’t sit on its claim. Delay in bringing a claim undermines a company’s argument that exigent circumstances exist. A company seeking injunctive relief – certainly a TRO – must move immediately to support its claim for relief.

The next unique characteristic of a TRO is typically decided without the benefit of all, or even much, of the evidence being presented to the court. In fact, in some cases, the court is asked to decide without even hearing from the other side. Typically, a court will insist on opposing counsel being notified, but in some cases that may not be possible – e.g., the bulldozer has already begun moving directly toward the dilapidated, but historically significant house.

The burden of proof for securing a TRO is also higher than what is needed in a normal case. In an ordinary suit, the plaintiff must prove its case by a preponderance of the evidence – a mere majority. If the TRO is granted, it will then be turned over to the new judge for a preliminary hearing and then the regular trial. If the judge has ordered the plaintiff to prove its case by a preponderance of the evidence, the plaintiff will need to show its case is more likely than not. If the judge asked the plaintiff to prove its case by a preponderance of the evidence, the plaintiff will need to show its case is more likely than not.
The burden of proof for securing a TRO is also higher than what is needed in a normal case.

Mesa Industrial Inc. v. Charter Industrial Supply, et al.

Now, back to the story...

Mesa supported its claim that the Database and the Application Drawings were trade secrets by arguing that the Database was not otherwise available and would be very difficult to reproduce. Mesa alleged that the Database was a 30-year working compilation of “detailed information about its customers’ tanks, their components, technical specifications, service history, pricing, and other information.” Also, according to Mesa, the Application Drawings “provide additional critical information regarding the use of specific products in specific tanks and allow for efficient servicing of tanks without the need to re-engineer products,” which gave Mesa a competitive advantage because having advance knowledge of a tank’s specifications and past service allowed Mesa to anticipate customers’ needs, prepare parts and components in advance, and eliminate or minimize engineering issues. That explanation satisfied the court that the Database and Application Drawings were indeed trade secrets.

The court also concluded that Mesa was substantially likely to succeed in showing that Espinoza gained access to Mesa’s information by virtue of his confidential relationship with the company. As mentioned, in this case Espinoza signed multiple agreements that referenced “trade secrets,” “proprietary information,” and “confidential information.” The court found that these agreements made it clear that Espinoza was obligated not to disclose Mesa’s confidential information. In addition, both Espinoza and King acknowledged the Non-Disclosure Policy in the Mesa’s Employee Handbook, which the court also relied on to find that the defendants had gained access to the trade secrets through a confidential relationship.

Finally, the court concluded that Mesa was likely to prove the unauthorized use of a trade secret. To establish the “unauthorized” part, the court relied on Mesa’s allegation that Espinoza and King, knew that they had acquired the information until the dispute could be resolved. Mesa supported its claim that the Database and the Application Drawings were trade secrets by arguing that the Database was not otherwise available and would be very difficult to reproduce. Mesa alleged that the Database was a 30-year working compilation of “detailed information about its customers’ tanks, their components, technical specifications, service history, pricing, and other information.” Also, according to Mesa, the Application Drawings “provide additional critical information regarding the use of specific products in specific tanks and allow for efficient servicing of tanks without the need to re-engineer products,” which gave Mesa a competitive advantage because having advance knowledge of a tank’s specifications and past service allowed Mesa to anticipate customers’ needs, prepare parts and components in advance, and eliminate or minimize engineering issues. That explanation satisfied the court that the Database and Application Drawings were indeed trade secrets.

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So, Mesa got its TRO and was able to keep its secret stuff from being disseminated any further.

Keys to Mesa’s success

First, before the fight even started, Mesa had taken steps to protect its trade secrets. It had employees sign confidentiality agreements to make clear they were not to share the company information to which they were given access. In addition, the company treated the information as confidential by limiting access to only those who had a business need for the information. Next, when the company found out that the confidential information had been taken, it acted quickly to protect its interest. It not only warned the employee and his new employer not to use its information, but also moved forward with the lawsuit once it received information that made clear that the former employee had its information and was apparently using it in his new role with a competitor. These steps helped to secure the TRO for Mesa and put a stop to any use of its information until the dispute could be resolved.
Will real-world registrations be enough to protect trademarks in the metaverse?

Vanessa Rondeau Galindo, Attorney at Uhthoff, Gómez Vega & Uhthoff, evaluates Trademark protection in the metaverse and raises questions yet to be answered in this new reality.

The past few years, we have been hearing of a new kind of virtual reality: the metaverse.

In the 1992 novel by Neal Stephenson, Snow Crash, we can find the first reference of the term “Metaverse”, which was the result of mixing the words “meta” and “universe”. In his book, the “Metaverse” referred to a virtual universe, where we can escape the reality of life.

Although there is more than one definition of the metaverse, this term is usually used to refer to a non-virtual world, similar to video games, where users can interact, socialize and purchase products. It can also be described as a digital parallel world similar to real life, as users can almost do everything they will do in the real world, but it can also be seen as a confluence between the existing and future virtual and real worlds.

During early 2000, the ROBLOX platform was created and allowed multiple players to play and interact online. Then MINECRAFT was developed and is considered a sandbox video game, where users can construct shelter, explore the landscape and also interact. Most recently, the DECENTRALAND platform was created and is known as a 3D virtual world, and users may buy or sell virtual lands and estates, using cryptocurrencies and NFTs.

These are just some examples of virtual worlds using avatars for interaction in a digital space, which are controlled by a user.

With the metaverse, some companies have seen the opportunity to reinforce their position in the market, and have therefore developed virtual goods which can be purchased in the virtual platforms. For example, GUCCI, through its collaboration with ROBLOX, gave players the opportunity to win a digital version of its GUCCI DIONYSUS bag. On the other hand, GIORGIO ARMANI and AMERICAN APPAREL offered virtual clothing, while TOYOTA offered virtual cars, and ZARA collaborated with ZEPETO and launched a virtual clothing collection.

In addition to the metaverse offering its users the possibility of buying virtual goods, it can also facilitate the purchase of physical goods. Indeed, virtual stores can allow the users to virtually test the products, through artificial intelligence, and the real goods can then be purchased and delivered to a real address.

It is commonly known that the function of a trademark is to allow consumers to distinguish the goods and services of a company from the ones of its competitors in the market. Therefore, a trademark serves as an indicator of origin.

In Mexico, the Mexican Industrial Property Law grants an exclusive right to the owner of a trademark, to use a name or a sign in relation to the goods and services designated in the application. However, some concerns have arisen regarding the classification of trademarks in the metaverse.

For example, if a company generally commercializes clothing, which is classified in international class 25, and owns a registration, once they intend to expand their commerce to the metaverse, the concern is whether the mark is already protected in the metaverse or if it will be necessary to obtain another registration for those goods in another class in order to prevent the infringement of their rights in the metaverse.

Recently, several companies have filed new applications around the world in an attempt to adapt their rights to the digital environment and in order to protect their goods in the metaverse, but also, to enforce their rights against any similar or identical representation of their products or marks in the metaverse. Indeed, it is not guaranteed that their existing registered marks will suffice to protect their rights in the metaverse.

For this reason, the applications were filed in class 09, which covers computer software, for digital goods.

For example, a few months ago the mark NIKE was granted into registration in Mexico in class 09 for “downloadable virtual products, namely, software including, footwear, apparel, headwear, eyewear, bags, sports bags, backpacks, sports equipment, or toys and accessories for use online and in the virtual world online”. In the meantime, the mark TOYOTA was granted into registration in class 09 for “retail services of virtual products, namely, footwear, clothing, headwear, eyewear, bags, sports bags, backpacks, sports equipment, art, toys and accessories for use online; online retail services of virtual merchandise, namely, footwear, clothing, headwear, eyewear, bags, sports bags, backpacks, sports equipment, art, toys and accessories.”

By doing this, the companies intend to extend the protection of their marks to the Metaverse, in order to obtain a full protection against any potential infringer.

Résumé
Vanessa Rondeau Galindo, Attorney
Vanessa practices Intellectual Property Law and is specialized in the area of trademark prosecution, enforcement, and maintenance, both on a domestic and international level.
Vanessa advises individuals, corporations, and law firms in connection with Intellectual Property matters, including trademark clearance opinions, trademark prosecution, oppositions, drafting provisional refusal opinions and responses, cancellation actions, drafting and negotiating letters of consent, drafting assignments, change of names and license agreements, trademark maintenance.
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However, these actions taken by NIKE derived from a recent case, where the company sued StockX, a marketplace located in the Metaverse, for commercializing NIKE’s footwear as NFTs, which reproduced their orderly existing NIKE shoes, and allowed the consumer to obtain real shoes. Therefore, when consumers purchased the NFT, they had the possibility to obtain the real version of the shoe by requesting the same in exchange for its NFT. Here the problem was that StockX was not commercializing real NIKE NFT products, although they were related to the real shoe.

Moreover, StockX granted exclusive advantages to consumers in order to prevent them exchanging the NFTs for the real shoe, and keeping these NFTs. Indeed, in case the consumers decided to exchange their NFT for the physical shoe, they would not benefit from their exclusive advantage. Nike argued that this practice could lead the consumers into error, since they believed they were purchasing authentic NIKE NFT products, which was not the case. In addition, NIKE considered that this practice could be harmful for its reputation, and it could potentially affect its entry into the metaverse, since consumers could associate StockX as the authorized NFT retailer.

Another recent suit was filed by the luxury and famous mark HERMÈS against ROTHSCILD, creator of NFTs named METAHERMÈS. These NFTs represented blurry images of the iconic HERMÈS BIRKIN bag. For this reason, HERMÈS argued that ROTHSCILD was infringing its rights, and accused them of using the likeness of confusion of its bag to sell NFTs. In addition, HERMÈS considered that by calling the NFTs METAHERMÈS, it was clear that the NFTs were making reference to its bag, and adding the prefix “meta” was not sufficient to distinguish the same to its famous bag. In addition, it was argued that the NFTs were representing the trade dress of the bag.

Therefore, HERMÈS considered that the NFTs could be misleading for the consumer, who could assume that the METAHERMÈS NFTs were created by HERMÈS, or at least, were authorized by HERMÈS. The lawsuit was filed and based upon direct trademark infringement, false designation of origin, trademark dilution, cyber-squatting, common law trademark infringement, and violations of other local business and unfair competition laws, among others.

This suit is still in its early stages, but the final decision will certainly have an impact on future similar cases.

These cases are just examples of the emerging issue that trademark holders are facing, which is the unauthorized use of registered trademarks in the metaverse, particularly as NFTs. Indeed, infringers have seen the added value of using without authorization, a trademark, as it increases the price of the NFTs. The trademark owners should see this as a real concern, as it constitutes an act of unfair advantage, and it can also affect their reputation.

Beside the fact that the metaverse raises some questions regarding the classification of marks, it also raises another concern regarding the determination of jurisdiction in case of conflict. In that regard, it is fair to assume it will be handled by the court as it was for the internet, that is, the competent jurisdiction will be the one where the harm was caused.

In our country, the unauthorized use of an identical or confusingly similar mark in association with digital goods should allow the affected Mexican trademark owner to initiate an infringement action in order to enforce its rights. Indeed, owning a trademark registration in Mexico would allow the registrant to initiate any action against a potential infringer, as long as the registration cover similar or identical goods as the mark used in the metaverse.

For example, if a trademark owner has a Mexican registration for digital clothing, footwear or headwear, that the Mexican users can buy in the metaverse, and a third-party uses this trademark for the same goods without authorization, then we can assume that this owner could enforce its rights against the infringer.

However, the concern is whether a trademark owner only having a registration in class 25, would be able to prove use of the mark. Indeed, if the NFT sold as an NFT is then billed as an NFT, it would demonstrate use of the mark in class 09 but would not serve to prove use of the mark in class 25, and the trademark owner could lose its registration in the latter class. Nonetheless, it would be fair to assume that if the t-shirt NFT is billed as clothing, it would be sufficient to demonstrate use of the mark.

If the t-shirt sold as an NFT is then billed as an NFT, it would demonstrate use of the mark in class 09 but would not serve to prove use of the mark in class 25.

The metaverse will certainly raise future additional concerns for trademark holders, who will have to adapt their practice to the digital world, in order to be fully protected against any potential infringement.

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IP RIGHTS IN RUSSIA

Russia remains a party to all international treaties on intellectual property protection. This means, regardless of whether an Applicant company is from a friendly, or an "unfriendly" state, this does not influence the trademark registration and enforcement procedure at all.

Truth unveiled: IP has not been abolished in Russia; trademark rights remain unscathed

Ekaterina Kovaleva, Trademark Attorney at Patentica, provides a detailed analysis of the latest news and decrees in Russian IP Law following the events of this year, focusing on trademarks and recent court practice.

February events and wide-range sanctions significantly changed the Russian business landscape and intellectual property practice and, inevitably, raised endless speculations about governmental protectionism, bias towards foreign IP holders and the end of IP era in Russia, no less.

The essential truth is that the IP legislation remains intact, meaning that all and every provision of the 4th Part of The Russian Civil Code remains in force. Here is a detailed analysis of the latest news and decrees with a fair insight into how and if those novelties affect the intellectual property rights with a focus on trademarks and the recent court practice.

There are several issues worth discussing.

1. Russia remains a party to all international treaties on intellectual property protection

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IP RIGHTS IN RUSSIA

Résumé
Ekaterina Kovalova, Trademark Attorney

Having worked in the Intellectual Property sphere for over eight years, Ekaterina is experienced in trademark protection and enforcement, and is certified as a Russian Trademark Attorney. She has extensive experience in consulting foreign and domestic clients and handling trademark cases before the Russian Patent and Trademark Office (Rospatent) and WIPO as well as in international and regional trademark agencies in Europe, Americas, Asia and CIS through colleagues and associates. She also participates in cases considered by the Russian Intellectual Property Court, the Chamber for Patent Disputes (Rospatent) and Federal Antimonopoly Service on infringement cases, unfair competition, and enforcement. Ekaterina takes part in Russian and international conferences and events in the IP sphere including INTA and IP Summit.

Russia remains a party to numerous intellectual property treaties, including the Paris Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), the Hague Convention, and the Agreement on the Hague Agreement. The very same Peppa Pig and other characters from the famous cartoon have been protected by Entertainment One (US) and Harman International Industries, Korea - over 80 positive first instance decisions for trademark owners. Although Rospatent is a party to numerous intellectual property treaties, including the Paris Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS), the Hague Convention, and the Agreement on the Hague Agreement, it has never meant that all applications will mature into trademarks. According to the Russian Civil Code, marks identical or confusingly similar to prior trademarks cannot be registered without consent of prior rights holders. Therefore, no matter how many imitations are filed, their registration will be refused. On April 1, Rospatent even published an official statement pointing out that “positive decisions on copycats” is a more media speculation than reality, that applications have been accepted for examination and published in the database. In fact, some of these applications were withdrawn soon after filing; for others official fees were not paid, so there will be no examination.

Although there is no straightforward opposition system in Russian for pending trademark applications, and examination on both absolute and relative grounds is the responsibility of Rospatent, it is possible to affect the examination results by submitting third-party observations with the arguments against registering a trademark on “unfriendly” states7. This decision, if approved, can affect the examination of a trademark on “unfriendly” states8, and, quite predictably, it was successfully appealed against and reversed by the Second Court of Appeal on 21 June 2022. Defendants in trademark infringement cases started referring to the “unfriendly” statuses of foreign plaintiffs and asking to dismiss lawsuits. In such cases, the courts have been admissibly rejecting this argument stating that a company’s origin cannot serve as a base for recognizing an abuse of rights, while the Decree cannot be used to declare an application as non-use9.

Thus, all statements regarding the inability of non-Russian companies to enforce their rights are highly misleading. Contrary to the mass media image, foreign companies have been successfully protecting their rights since February 2022. The very same Peppa Pig and other characters from the famous cartoon have been protected by Entertainment One (US) in about 50 successful lawsuits (first instance) since February. Another active plaintiff seeking compensations for trademark infringement is Entertainment One Inc (US), which is featured in over 500 successful first instance decisions regarding protection of trademarks and copyright to FANCY, MISS BABY, LOL, SURPRISE characters. Some other statistics below show that companies from “unfriendly” states have been able to have recent decisions that are described as “positive first instance decisions for trademark owners”.

According to the Russian Civil Code, marks identical or confusingly similar to prior trademarks cannot be registered without consent of prior rights holders. Therefore, no matter how many imitations are filed, their registration will be refused.

IP RIGHTS IN RUSSIA

8. The list was determined by the Decree of the Ministry of Industry and Trade No 1532 of 19 April 2022.
complaints with marketplaces and enter trademarks into Customs Registries of the countries forming the Eurasian Economic Union.

4. How to pay fees and royalties

Many newly introduced enactments and statements revolve around the concept of so-called “unfriendly” or “hostile” states and entities. This term first appeared in the Decree of the Government of the Russian Federation dated 5 March 2022 No. 430-pf, which did not directly refer to the IP field, but is crucial to understand the context of the IP law amendments and court practice.

Said Decree referred to financial counter-measures mirroring sanctions against Russia10 and its list contains the following countries: Australia, Albania, Andorra, Great Britain, all Member States of the European Union, Iceland, Canada, Liechtenstein, Micronesia, Monaco, New Zealand, Norway, Republic of Korea, San Marino, Northern Macedonia, Singapore, United States of America, Taiwan (ROC), Ukraine, Montenegro, Switzerland, and Japan.

Sanctions and counter-measures have complicated the payment of official fees for IP related actions and fulfillment of mutual obligations arising from license and franchise agreements. According to the Presidential Decree No. 322 of 22 May 2022, a temporary mechanism has been introduced for the payments for use of intellectual property owned by companies (both Russian and foreign) falling into one of the categories:

1. entities associated with “unfriendly” states;
2. entities publicly supporting sanctions;
3. entities, which terminated or restricted activities in Russia;
4. entities, which prohibited use of their IP in Russia after 23 February 2022.

The licensees and franchisees of such companies need to open an “O”-type account in a bank determined by the Russian government and make payments in rubles. The IP owner (or an authorized representative) needs an authorization from the Government Commission on Monitoring Foreign Investment to transfer funds from an “O”-type account.

This new mechanism does not apply to the IP related to telecommunications, pharmaceuticals, food, agricultural goods, solutions intended for creating or using software, databases, data processing and informational systems. Another exemption applies to payments below 100,000 rubles (around 1,600 USD), whenever a party to the agreement is an individual (rather than a company, not commercial purposes). If the licensor from one of the “unfriendly” states complies with the terms of the agreement and has not ceased operations in Russia, there is also no need to open an “O”-type account.

Actual application of this decree is still vague, and it is needless to say that sanctions can prevent foreign licensors from extracting royalty in rubles from “O”-type accounts in Russian banks, but continuation of mutual obligations seems to make the parties exempt from the new requirements. In principal, the decree seems to have been introduced to protect the rights of Russian entities from situations when the IP owners abruptly withdrew licenses or stopped all communication.

Instead of a conclusion, I want to offer a sort of a universal recipe for owners of Russian trademarks that might help:

- seek legal assessment and advice from the local lawyers and not the yellow press and mass media;
- monitor similar marks and infringement cases as well as secure trademark rights by filing fresh applications in key Nice classes;
- be sure that Russia remains a party to all international IP treaties even if official engagements of patent offices are canceled, which means no bias or discrimination towards foreign trademark owners.

While we see numerous changes and remain uncertain about consequences and implications of some of them, we keep analyzing all legal acts, monitoring the court practice and informing our colleagues and clients of all noteworthy updates, with the hope for a better future.

Expanding the value of your idea...

Patentica is an intellectual property law firm operating in Russia, Ukraine, the CIS countries and providing the highest standard of service in the IP industry.

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NOT REGISTERED

It followed the Presidential Executive Order On a Temporary Procedure for Meeting Obligations to Certain Foreign Creditors of 5 March 2022.
Keep an eye on your mark’s Chinese version. It is worth it!

**Smile (Shujie) Hao, Trademark Attorney at Beijing Sanyou Intellectual Property Agency Ltd., explains the importance of trademarking a Chinese version of your mark for use in mainland China, with tips on best practice for registration.**

There are many advantages to having your mark’s Chinese version registered and used in mainland China. It is worthwhile to try to file such a mark because there are risks that may be involved in actual business if an applicant does not have its mark’s Chinese version registered. However, in practice, it is not an easy task to pick up a proper Chinese version mark to be registered because various factors need to be considered.

**Advantages to having your mark’s Chinese version registered and used**

1. A registered mark of the Chinese version can help an applicant’s foreign mark have a better chance to be registered if the foreign mark is rejected because it constitutes a similar mark over similar goods or services with other prior marks. By adding an additional Chinese part to the foreign mark, it will make the foreign mark distinguishable from the cited marks among relevant public in mainland China. It is a common strategy adopted by the applicant to overcome rejection of its marks. Even if the mark is composed of a foreign name and the Chinese version is rejected again for the filing, there are chances to overcome the rejection by arguing dissimilarity of the marks after filling a review for the mark.

2. Having a foreign mark’s Chinese version registered and using the mark (alone or combined with its foreign name) in the actual business can make the applicant’s mark(s) easier to be memorized and accepted by the Chinese customers. In fact, some Chinese versions are as popular as in their local markets, such as “雀巢” (Chinese version of English mark “Coca-Cola”) and “肯德基” (Chinese version of English mark “KFC”). For some foreign marks’ Chinese versions, they attract Chinese customers to buy their products bearing these marks and make the customers think that these products used daily belong to domestic companies, such as “肯德基” (Chinese version of English mark “KFC”) which actually belongs to chemical giant Unilever, a British company.

3. Having a Chinese version mark registered and using the mark (alone or combined with its foreign name) in the actual business can avoid customers making nicknames for its original foreign mark. If it happens, media reports and the public will tend to use these nicknames to replace the original foreign mark, which will damage the reputation and influence obtained by the original foreign mark. For example, if the foreign mark “Viagra” (or its Chinese translation “伟艾力”) is used on the male drug produced by Pfizer Inc., the public may think that the mark belongs to a Chinese company.

4. Having a Chinese version mark registered and using the mark (alone or combined with its foreign name) in the actual business can reduce the risk of third parties filing marks through translating the foreign mark with bad faith. It is normal for a foreign mark to have several Chinese transliterations. According to the current practice, there is a high chance that Chinese marks which are identical to the pronunciation, but different in the composition of characters, will not be considered as similar. Thus, it is suggested to file a foreign mark’s Chinese version to reduce possible confusion or misunderstanding which may be caused by coexistence of the marks.

Potential risks which may be involved in actual business

1. Cooperated companies may file the foreign mark’s Chinese version and take advantage of the reputation and influence obtained by it after the cooperation ended. Recently, when collecting use evidence for a German company’s English mark “Coca-Cola” on our side, we found the following facts which damage the company’s interest in mainland China:

   i. During the cooperation, the distributor filed a Chinese version of the German company’s English mark over its key goods. The distributor used the German company’s English mark with its own registered Chinese mark when promoting the products to the Chinese customers.

   ii. After the cooperation ended, the distributor filed a similar English mark with one letter difference from the German company’s mark and several composed marks containing the newly filed English mark and the registered Chinese mark over goods and services to seek much broader protection for these marks than the German company’s mark. When promoting the products bearing its newly filed English mark to the Chinese customers, the distributor also used its own registered Chinese mark.

According to the evidence obtained and referenced decisions made by the CNIPA, we think that the chance to attack the distributor’s English mark and the composed marks designating over goods and services which are closely related to those of the German company’s mark based on Article 15 and Article 30 of the China Trademark Law is optimistic. However, for the marks published over goods and services which are not closely related to those of the German company’s key goods, the chance to attack them may not be optimistic. In addition, it will be hard to invalidate the Chinese version mark filed by the distributor because it has been registered for more than five years and the invalidation should be based on the well-known German company’s mark before the Chinese mark’s application date, the bad faith of the distributor when filing the mark will be hard to prove. What makes the situation worse is that since the Chinese mark is used by the distributor, it may be hard to cancel the mark through cancellation action based on non-use for three consecutive years.

As you may find from the above, the distributor had consistent malicious to take advantage of the reputation and influence obtained by the German company’s English mark and the mark’s Chinese version. However, there are risks that the German company may not attack all of these marks filed with bad faith successfully.

2. The applicant may have to accept a Chinese nickname made for the original foreign mark by the public, although it does not like it. If a foreign mark’s Chinese nickname was filed by other third parties in bad faith, the foreign mark’s applicant may need to take actions filing an invalidation or opposition against the mark.

Résumé

*Smile (Shujie) Hao* has worked in the IP field for more than 10 years. She joined Sanyou in 2018 as a trademark attorney. She has rich experience in providing consultancy service regarding all-round trademark protection strategies in mainland China. She is good at handling trademark opposition and invalidation cases.

It is a common strategy adopted by the applicant to overcome rejection of its mark(s).
otherwise, the third party will take advantage of the reputation and influence obtained by the Chinese nickname and the foreign mark among the relevant public. In this situation, if the foreign mark’s applicant accepts (at least it does not deny the use of it publicly) the nickname’s use, it may have a certain chance to attack the nickname. If the foreign mark’s holder has made it clear that it does not accept the Chinese nickname of its foreign mark from the media and the public (such as what Pfizer Inc. did for the nickname “百靈”), which means that the holder does not take the use of the Chinese nickname as the true use of its corresponding foreign mark, and their corresponding relationship will be considered as broken. In turn, the chance to crack down on the foreign mark’s Chinese nickname will not be optimistic.

3. It is hard to attack other Chinese versions filed by other third parties with bad faith.

As discussed, it is normal for a foreign mark to have several Chinese transliterations. Since there is a high chance that Chinese versions composed of different characters will not be considered as similar, it is suggested to file a foreign mark’s Chinese mark by its holder and use the marks in the actual business to establish a sole relationship between them. Otherwise, other Chinese versions filed by other third parties with bad faith may lead to confusion or misunderstanding among the relevant public as to origin of the goods and services.

Tips to pick up a proper Chinese version mark

Various translation strategies can be applied to translate a foreign mark into its Chinese versions. The most commonly used are the followings:

1. Transliteration:

   such as “宜家” (yi jia) of “IKEA” – a furniture and home retail brand from Sweden.
   “寶馬” (bao ma) of “Benz” – a car brand from Germany.
   “古驰” (gu chi) of “Gucci” – a class A clothing and home retail brand from Sweden.

2. Literal translation:

   such as “平果” (ping guo) of “Apple” – an electronic products brand from the USA.
   “加拿大人” (can nada ren) of “Canada Goose” – a clothing brand from Canada.

3. Combination of literal translation and transliteration:

   such as “耐克” (lang xie) of “JackKnealx” – an outdoor goods brand from Germany.
   “宜家” (yi jia) of “ing Temple” – a coffee brand from the USA.
   “陆虎” (lu hu) of “Land Rover” – a car brand from the UK.

4. Free translation:

   such as “小米” (xiao mi) of “Spritie” – a soda drink brand from the USA.
   “雀巢” (que chao) of “Nestle” – a food brand from Switzerland.
   “HSBC” – a banking & financial services brand from the UK.

In addition to these translation strategies which may be used in the translation of a foreign mark, the following factors should also be considered to enhance the Chinese version’s chance to be registered as a mark:

5. It should not violate absolute grounds as prescribed in China Trademark Law. For a specific Chinese version, especially when it is translated literally, we should pay special attention so that it does not belong to signs which shall not be used as trademarks as prescribed in Article 10 and it should bear distinctiveness to be registered as a mark as prescribed in Article 11. If there is a certain risk that the version may violate these Articles, we should take other translation strategies (such as transliteration or free translation) to translate the foreign mark in a different way to reduce the risk of possible rejection which may be based on absolute grounds.

6. For those marks which are not translated literally, we should consider the Chinese version’s registrability and conduct searches to evaluate the version’s chance to be registered. If there are prior marks that may bar registration of it, we should change some characters (such as initial Chinese character with the same pinyin pronunciation, but in different characters) to make it distinguishable from those prior marks and conduct searches for this new version again to evaluate the situation further.

7. The Chinese version should not be an imitation or copy of other Chinese brands which have obtained a certain reputation or influence among the relevant public in mainland China. In addition, it is suggested to keep the version’s composition within four characters because more than four characters in a composition will be easily considered as a slogan which lacks distinctiveness to be registered as a mark and it will also be difficult for the customers to pronounce and remember the version.

8. At last, if there are several Chinese versions for the applicant to choose (we usually provide four options) as a mark, consider the one which bears certain characteristics or spirit of the product or the brand’s history to have a try.

To sum up, it is not a cliché to have your mark’s Chinese version registered in mainland China. It is the most cost-effective and efficient way to protect your foreign mark’s reputation and influence obtained through long-term use in mainland China. It can also save cost and effort to attack other parties’ marks filed with bad faith. Even if the holder needs to attack marks filed with bad faith, the chance will be enhanced if it has its own Chinese version mark registered and used in mainland China.

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Novelties in trademarks and industrial designs: amendments to the Polish Law on Industrial Property

Joanna Rafalska, Polish and European Trademark and Design Attorney at Patpol, reviews the long-awaited update to the amendments to Polish IP Law and offers her opinion on what this means for the industry.

In the circles of Polish intellectual property experts and practitioners, for some years there has already been going a discussion about the growing need for a coherent amendment to the Industrial Property Law. The Act itself has been amended a number of times, amendment to the Industrial Property Law. The Law and offers her opinion on what this means for the industry.

Patpol, reviews the long-awaited update to the amendments to Polish IP Law. Joanna Rafalska, Polish and European Trademark and Design Attorney at Patpol, reviews the long-awaited update to the amendments to Polish IP Law and offers her opinion on what this means for the industry.

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Now both professional practitioners and legislators stand at the long-awaited moment, in which not merely “a modification”, but a profound and systemic amendment of the Polish IP Law is to be performed. Simultaneously, one is wondering whether the proposed changes will properly solve the problematic issues, and to what extent they will simplify the practical application of law and conducting the proceedings, or on the contrary - what complications may potentially arise after implementing the amendments.

Below I will focus on the most essential changes that have been proposed in the draft amendment of the Polish Law on Industrial Property in the field of trademarks and industrial designs.

First of all, according to the draft, the double-step payment of fees in the application-registration proceedings before the Polish Patent Office will not be applicable any longer. Currently, payment of the official fees is divided into two steps: the first fee is paid at the application stage (the application fee), while the second one is paid upon registration of the mark (the fee for publication and the first 10-year protection period). After the amendments come into effect, the two fees will be replaced by a single one, which shall be paid at the time of filing a trademark or design application, as is done for example in the European Union Intellectual Property Office.

In my opinion, this is a very good and practical change, because in Polish practice, a conditional decision issued on condition of payment of the second fee often expired due to lack of payment. As a result, a trademark that had not faced any registration obstacles did not obtain registration. The introduction of one fee in place of two seems to be an effective remedy for such frequent cases.

The draft amendment of the IP Law also provides for the abandonment of the joint right of protection for a trademark. The draft will refer in this regard to civil law provisions on joint ownership. Joint trademarks and guarantee marks are to remain without major changes.

Changes are also to be made in the nature and place of publications. Until now, the publications used by the Polish Patent Office (PPO) were the Patent Office Bulletin and the Patent Office Journal. The former published, among others, information on the applied trademarks, while the latter published information on registrations. The draft to amend the IP Law provides for the introduction of the institution of “public disclosure” in place of publication in the Bulletin. The public disclosure of a new trademark application will be of particular importance here, as the deadlines in the opposition proceedings (after the amendment – the objection proceedings) will be calculated from this date. Similarly, the disclosure of a trademark and the subsequent publication after examination of the absolute grounds for granting protection will take place on the Patent Office’s website instead of the Bulletin.

Let me discuss in more detail the change, which in my opinion is the most essential, namely the distinction of the opposition procedure depending on whether it is filed against a pending application or a registration. The mechanism functioning until now – simply an opposition against both applications and registrations – will be replaced by introducing the so-called “objection” against pending applications and opposition against already registered rights of protection. In practice, this change will only refer to legal terminology. It consists in introducing a new term and is not followed by any significant changes in the procedure itself. This amendment aims to distinguish “the objection” filed against a pending application from “the opposition” which can only be filed against already granted exclusive rights.

The mechanism of opposition, which shall provide for the possibility of filing either objection or opposition depending on the status of a mark, will differ from the previous single opposition proceedings in terms of shortening the filing deadline from three months (as it was previously) to only two months. The new two-month term will be counted from the date of public disclosure of information about filing a trademark application. The shortening of the deadline does not seem to be in favor of the potential opponents, given that the deadline may prove to be relatively short, particularly for foreign entities who may want to oppose Polish national trademark applications.

The party filing the objection will be required to indicate one’s legal basis and briefly present the state of facts. Then, at a later date, the party will be obliged to submit a full statement of reasons. This makes the Polish procedure more uniform with the solutions applied in the EU procedure. Namely, the newly introduced objection to be filed against a pending application in the Polish Patent Office is very much analogous to the submission of the so-called “notice of opposition” to the EUIPO, which is simply intended to secure the deadline. The full reasons are submitted at a later stage. However, it should be stressed that the first letter of objection filed in the PPO is not intended to be freed from the obligation to even briefly present the facts, which can be done later in the statement of reasons presenting the state of facts extensively. An indication of one’s legal and factual basis (e.g. the opponent’s prior trademark) should in my opinion be sufficient in the first “objection” letter which is filed in the
An important change will also be the abandonment of the official two-month term for amicable settlement of a dispute (the so-called “cooling-off period”). The said term was a mandatory two-month period in an alternative proceeding for the so-called amicable settlement between the parties. It could be extended by another four months, up to a maximum of six months, upon joint request of the parties. After the amendment, enter into force, the appointment of the term for amicable settlement of the dispute will take place only upon the request of the parties, thus gaining a reply to the applicant's standpoint, on the other hand, however, shortening the procedure on the other hand.

In my opinion, this change, which is intended to IP Law, procedure, is not advantageous, because, as practice shows, the parties often fail to obtain a satisfactory agreement within the stipulated time limit. Negotiations are often prolonged, and the settlements themselves are signed by both parties long after the deadline for settling the dispute amicably (even after it has been extended). The planned changes not only shorten the deadline for the parties to talk, they also multiply the number of requests that need to be filed in order to start and continue negotiations. The need for more time to undertake and conduct talks arises particularly in relation to foreign entities. The preparation of translations and the circulation of documents instrument, the period from reaching the agreement up to the actual signing of the settlement by both parties. In addition, the activities resulting from the settlement agreement, such as the filing of a request to limit the list of goods and services in the application, also take time, and the Office's decisions that follow must become final. Consequently, the time limit, which has been reduced to a maximum of two months, appears to be a period that is evidently insufficient to conclude the settlement effectively and implement its provisions.

One more significant change, which also relates to deadlines in the objection proceedings, is the shortening to one month of the term that the Office will appoint for a party to take certain actions, such as responding to an objection or filing an additional standpoint. Currently, the Office appoints two-month deadlines for foreign entities. As it can be seen, the length of terms appointed both for Polish and foreign entities will become equal. As I mentioned above with reference to the deadlines for amicable settlement of disputes, also in this case the fact of shortening the terms for foreign parties to present their standpoints may be particularly disadvantageous. Although a party will be able to have the deadline extended by another month, upon informing the Office of one's inability to keep it, this change will unnecessarily increase the number of letters to be filed in the course of the proceedings. Undoubtedly, the change in this regard is not in favor of the parties who are foreign entities. For example, in response to the objection, the applicant may raise an allegation of non-use of the prior marks of the opponent. Thus, within such a short period the opponent, who is a foreign entity, may not be able to gather the evidence of genuine use of the earlier trademark over the statutory five-year period and may thus be deprived of the possibility of amicably settling the dispute, especially as the translations of documents into Polish will be required.

In addition, according to the draft amendment of the IP Law, there will no longer be an obligation to deliver to the Patent Office a paper copy following the opposition which has already been filed electronically. This change, although relatively small, may be assessed positively, as it removes the troublesome need to send on copies, which also caused an unnecessary prolongation of the proceedings.

The draft amendment of the IP Law also provides a new definition of an industrial design by, among others, replacing the term “work” with the term “product.” The amendment provides a new definition of an industrial design by, among others, replacing the term “work” with the term “product.” This change, although relatively small, may be assessed positively, as it removes the troublesome need to send on copies, which also caused an unnecessary prolongation of the proceedings.

The draft amendment of the IP Law also provides a new definition of an industrial design by, among others, replacing the term “work” with the term “product.” What is more, the amendment to the IP Law will introduce a new type of proceedings – the so-called “conciliation proceedings.” This new procedure is intended to allow the parties to resolve a dispute in an alternative manner by a conciliator appointed by the Patent office. A list of conciliators will be available at the Patent Office. Conciliation will be initiated at the request of the parties and is expected to be a shortened form of the proceedings aiming at ending a dispute as soon as possible by reviewing the case and preparing a draft written standpoint by the conciliator. The parties may accept the conciliator’s standpoint, or they may reject it.

The introduction of the above-mentioned alternative conciliation procedure may not necessarily be sufficiently attractive for the parties to rely on it, in view of shortening the time limits for reaching an amicable settlement by means of undertaking negotiations through professional representatives. Conciliation is a new instrument, and it is difficult to assess its effectiveness at this point. It seems that through the negotiations during the objection (or opposition) proceedings, so far the involved parties have been able to reach mutually satisfactory settlements on many occasions. Reducing the time of the negotiation process and putting the settlement in the hands of a conciliator appointed by the Patent Office in separate proceedings is a completely new instrument, so its potential pros and cons need to be proved in practice.

The proposed changes are certainly aimed at expediting and shortening the procedure of obtaining exclusive rights or conducting the objection/opposition proceedings. In many cases, the fees will be reduced. However, not all of the proposed solutions seem to be perfect, so when the IP Law amendments enter into force, it will be a matter of time to see whether or not the better is the enemy of the good.

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We give special thanks to HGF for their dedication and support in continuing the empowerment of women in IP by facilitating this opportunity.
This segment is dedicated to women working in the IP industry, providing a platform to share real accounts from rising women around the globe. In these interviews, we will be discussing experiences, celebrating milestones and achievements, and putting forward ideas for advancing equality and diversity.

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

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

Stephanie Moe: Associate, Fitzwilliam, Stone, Furness-Smith & Morgan

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

Stephanie is an Associate at Fitzwilliam, Stone, Furness-Smith & Morgan. She began her legal career in 2013 and is a member of the Firm’s Intellectual Property and Litigation Departments. She has considerable trademark and commercial litigation experience representing many clients before the Intellectual Property Office of Trinidad and Tobago, the High Court, and Court of Appeal.

At the Law Firm, Stephanie handles all aspects of trademark work including prosecution and enforcement. She also regularly advises clients on unfair competition, copyright, food and drug advertising law and generally all aspects of intellectual property practice.

What inspired your career?

My parents have definitely been very influential in developing and inspiring my legal career, especially my father. As a child, I remember he had a very strong work ethic, he travelled a lot for work, and he always instilled in me the value of education and more so being independent and critically thinking as a woman. My parents have offered a lot of guidance in my educational and, eventually, professional choices and I am very grateful for their support.

Also, I have always had a passion for literature. It was a natural fit for me to study law as reading is a fundamental aspect of legal training and practice.

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

My Firm, Fitzwilliam Stone, Furness-Smith & Morgan is a full-service firm with several departments ranging from Corporate, Commercial, Litigation, Oil and Gas and of course, Intellectual Property. When I first started working at the Firm, I gained exposure in these various practice areas.

I settled into the Litigation department for a number of years, however, an opportunity arose when Olive Ramchand, a Partner in the Intellectual Property department, needed assistance in a trademark litigation dispute. She called on me to prepare the legal arguments and I remember being very captivated by her passion for intellectual property. That was really my first exposure to litigious intellectual property practice, and I loved it. Shortly thereafter, an opportunity arose for an Associate to join the IP department - I thought about whether I wanted to make a career change after about five years in the Litigation department to go in a completely different direction. I spoke with several Partners in the Firm and they were very supportive. I eventually decided to take the leap and do it. I have never looked back!

If I was to offer any advice to someone based on my experience, I would say don’t be afraid to change direction as taking a different path could lead to a more fulfilling career.

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

I think for all lawyers, there’s a need to develop a certain amount of grit to have confidence when practising the law.

Being a young woman, there are some challenges in developing that fortitude. I’ve learned to rely on my past experiences to help me through. For example, as a teenager, I entered different singing and music competitions both in the Caribbean and the UK. I was heavily involved in music for several years and being on a stage is not an easy thing.

It takes a lot of courage to be able to perform in front of an audience and on camera. When I graduated from law school, I entered the Miss World Trinidad and Tobago pageant on a whim, and I had a fantastic experience. Mary would think that those experiences don’t inherently have anything to do with the law, but they definitely developed an ability to work under pressure, to be able to develop poise in nerve-wracking situations and confidence which is critical in practising law.

If I was to offer any advice to someone based on my experience, I would say don’t be afraid to change direction as taking a different path could lead to a more fulfilling career.

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

Rachel is Partner in the Trademark Unit within the Intellectual Property department of the London office of Baker McKenzie. Rachel advises on all aspects of trademark and design protection and enforcement, including global filing strategies, clearance searching and transactions involving intellectual property for the UK, EU, Madrid Protocol and overseas. Rachel specializes in trademark disputes such as infringements, oppositions, cancellation actions, company and domain name disputes and dispute resolution. Rachel has worked with clients in a broad range of different fields, including pharmaceuticals, finance, and fashion, as well as assisting NGOs in a number of sectors on a pro bono basis.

What inspired your career?

When I first started out at a small trademark attorney firm, I lacked any legal experience. I worked for a number of really inspiring women. They were all very different, but each in their unique way made me want to follow the same career path. What impressed me most was how much they all loved what they did and had a passion for IP. They were really different and you work around lots of incredibly strong women who have been very willing to sit down with me and guide me through my legal career. I think it’s very important to not just speak about inclusion but to have mentorship programs in place to really make that tangible experience and to develop opportunities for younger practitioners. For women, for people who are ethnic minorities, and I think that globally, we are headed in the right direction.

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

Rachel actually got into Fitzwilliam Stone, a top-tier firm in Trinidad and Tobago and very well respected in the Caribbean, and I’m still working towards partnership. That has been a great achievement, to be able, all these years later, to come full circle to say that the statement I made to my friends is being realized. I’d also say one of my greatest achievements is actually sticking with law because law is not easy and it takes a lot of nerve to overcome certain challenges and to push through when you’re deep in deadlines with demanding clients. So, I think more than anything else the professional development and character development which I’ve seen in myself over the past several years is something that I hold very dearly. It’s that self-growth and those qualities that propel me and are very necessary for my career path moving forward.

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

I would say that in Trinidad and Tobago, and in the Caribbean as a whole, there’s so much to offer in terms of culture and heritage but there’s not a lot of awareness of IP in the Caribbean which is essential in protecting these cultural expressions. I’ve been able to meet with small and medium-sized enterprises to assist in leveraging IP opportunities and developing trademark strategies, both locally and internationally. I really enjoy helping these businesses to protect their trademarks and also create enforcement strategies, which is where my litigation background is leveraged. I take a lot of pride in sitting down and explaining the trademark process in a comprehensive manner to clients who may not have any knowledge of intellectual property at all. In recent years, the pleasure of working with a team of Chinese agents to protect a local client’s trademarks from infringement in China was particularly rewarding and very rewarding experience.

So, as far as my future career aspirations go, I want to continue in that vein of really educating the Trinidad and Tobago and Caribbean population because there’s a lot of valuable intellectual property in this region. It is very rewarding when you see product launches, successful enforcement strategies and your client comes back and thanks you for your hard work, appreciating the time, patience and dedication to assist in developing and protecting their IP portfolios.

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

Coming from a different background to most I didn’t follow the usual university-to-trainee route into the profession; a personal challenge for me was not to give into the feeling that I don’t belong. That sense of imposter feeling that we all get from time to time can be particularly strong when there is a clear reason why you are different and you work around lots of incredibly gifted people who are perhaps better or worse than anyone else. Anyone other than you that are parts of those thoughts entirely, but I do think that when you are particularly struggling with it’s important to let yourself see some personal pride in your achievements. Recognize that you are parts of that you are really incredible too, maybe even strengths that others around you might not see, so you bring something important and valuable to the table also. For me personally, looking at it more as everyone being an important piece of the puzzle, rather than being better or worse than anyone else, has really helped me to overcome my insecurities around being different from others.

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

As it is pretty recent, being promoted to partner at Baker McKenzie and elected as CITMA President within the space of a year has felt like a particular achievement. However, I hope that...
when I look back at the end of my career, what I will be most proud of are the people who I was able to develop and help in some way to go on to their own greatest achievements. It is always a motivating thought that you can only ever achieve so much personally, but that if you enable others the scope of what they can go on to achieve is almost limitless.

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

Well, my fellow trademark partner at Baker McKenzie and I often say that we will not stop until we have achieved world domination. More seriously though, I really don’t like to be too prescriptive about how I want the rest of my career to develop, as who knows where the career path might wind off to. Building an ever stronger litigation practice and hopefully acting as a role model for other trademark attorney litigators is a shorter term aspiration for me though. That ambition is largely driven by my personal passion for litigation and the job satisfaction it gives, so I am keen to help build out a stronger base in the trademark attorney profession to enable others coming through to ranks to take up a litigation practice where there is an interest. Currently I am working with the CITMA team, as well as others in the wider legal profession who are very kindly offering up their time to provide suggestions and support, to see what can be done to leave a lasting legacy on this during my two-year term as President. Watch this space!

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

I fear it may be a little too ambitious to hope we would actually achieve it in the next five years, but I would love to see us to get to the point where we work in an industry where everyone truly understands the value of inclusion and diversity of thought and how this can super charge business success, without the need for quotas. We are all unique in so many different ways and that should be celebrated and leveraged.

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

Well, firstly I have to say that I think we really have come a very long way, both in the IP sector and more broadly in society, when it comes to female empowerment. The significant gains we have made in the past two decades since I started working really are incredible and I believe it is important to recognize those for the achievements they really are. Even 10 years ago, concepts like shared maternity/paternity leave and flexible working were virtually unheard of and are now the norm. Moving forward, my view is that continuing to build on engagement by both men and women in diversity and inclusion initiatives will be key, not necessarily in a ‘big initiatives’ way, but firmly embedding the culture that we are all equally striving for true equality of opportunity. I would like to think that being a true champion of female empowerment is an entirely gender neutral role and continuing to develop that general mindset in lots of little everyday ways is what is going to ensure that the gains we have made stick and continue to expand.
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.

Caribbean

Caribbean IP
- DunnCox
- Ferraiuoli
- Foga Daley
- Guzmán Ariza
- HSM IP
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- Miniño Abogados
- Thornton Smith
- WDA International Law Firm

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ANTIGUA & BARBUDA
### Costa Rica
- Arias
- BLP
- Central Law
- COBIS Estudio Legal
- Consortium Legal
- Dentons Muñoz
- EPoint
- EY Law
- Facio & Carías
- Lexincorp

### El Salvador
- Arias
- Central Law
- Consortium Legal
- Dentons Muñoz
- De La Gasca & Cía
- Espino Nieto & Asociados
- Garcia & Bodán
- LatinAlliance
- Lexincorp
- Romero Pineda & Asociados

### Honduras
- Aguilar Castillo Love
- Arias
- BLP
- Bufete Mejía & Asociados
- Casco & Casco
- Consortium Legal
- Dentons Muñoz Zacapa
- Garcia & Bodán
- Mayora IP
- Melara & Asociados

### Mexico
- Arrochi & Lindner
- Basham, Ringe y Correa
- BC&B – Law & Business
- Calderón & De La Sierra
- Dumont
- Goodrich, Riquelme y Asociados
- IBERBRAND®
- OLIVARES
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Jurisdictional Briefing, Poland: Key amendments to Polish Industrial Property Law

Justyna Sitnikow, Attorney at law at Trapple Konarski Podrecki and Partners, details the most important amendments to Polish Industrial Property Law regarding trademarks.

Opposition to replace objection
Under the proposal, the existing objection to registration of a trademark would be replaced with opposition. Apart from the new terminology used, there is a major change due to a reduction in the time limit for filing it - from three months to two months from the day on which the application to register the trademark is announced publicly. There will also be a new name for the party filing the opposition. The term used accordingly in the bill is the opposing, and not objecting party.

Cooling-off period optional
With regard to opposition (at the moment termed objection) there will be a major change due to abolition of the current compulsory two-month limit for amicably resolving a dispute concerning opposition. Under the bill, there will be an option, and not an obligation, to stipulate a time limit for resolving a dispute amicably.

To exercise this option, the parties have one month from the day on which the Polish Patent Office advises of that option, to apply, by joint consensus, for a time limit to be set for an amicable resolution to be reached. If that application is filed by consensus, the Polish Patent Office will stipulate a two-month deadline for the parties.

Copy of electronically filed opposition
The bill regulates the issue of submitting copies if the opposition is filed electronically. Under the new rules, a copy of opposition filed electronically is not attached, except when a trademark applicant does not use electronic devices to receive correspondence. In such a case, the Polish Patent Office will issue a notice calling upon the person submitting opposition to file a copy on paper within the stipulated time limit.

Fees
With respect to fees, there are two developments concerning the procedure and time for payment. Firstly, the fee for registration of a mark will no longer be split. At the moment, a trademark applicant firstly pays the filing fee, and later the fee for protection and announcement of the granted right, once the Polish Patent Office has issued a conditional decision. Under the proposal, these fees will be replaced by a single fee payable at the time of application in the same way as registration of EU trademarks.

The other development concerns the validity period and deadline for renewing trademarks following conversion. At the moment, trademarks created due to conversion of EU trademarks are valid for, and thus renewed, ten years from the day of submission of an application for conversion into a national trademark. Under the proposed amendment, if an application is filed for conversion of an EU trademark during the protection period, the fee for the next ten-year protection period must be paid when that protection period ends.

Collective protection right
The legislature has abolished registration of the collective protection right.

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Résumé
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Justyna specializes in intellectual property law, particularly in trademark, industrial design, unfair competition, and copyright law. Her experience in trademark and industrial design cases brought before the European Union Intellectual Property Office (EUIPO) and the Polish Patent Office was gained in Warsaw law firms.

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Can religious trademarks be protected in Angola?

Vera Albino & António Sequeira of Inventa focus on the influences of religions in Angola, raising questions as to whether religious phrases and symbols can and should be protectable.

Although the religious texts do not refer to Intellectual Property (IP), religions are connected to IP. In a more evident way, religions influence on IP ranges from discussing and approving IP laws to registering and using trademarks. In less obvious ways, we observe a displacement of religion in trademarks, through consumerism. Like religions, well-known brands, such as Coca-Cola and McDonald’s, became ideological structures that shape our ways of being and doing, filling the void left by the withdrawal of the main religions of a partially desacralized world.

This article will focus on the more evident influences of religions on IP, particularly on trademarks, in Angola.

The imprint of religions in the IP legislation of secular countries such as Angola is not evident. However, it is a question that arises when considering the increase in the number of applications for religious trademarks in the country. It is a question that is, in some measure, addressed by the Angolan Patent and Trademark Office (IIP).

I. The influence of religions on the legislation applicable in Angola

As Article 6ter of the Paris Convention, applicable in Angola, which provides absolute grounds against trademark registration but makes no specific reference to the religious signs, the Angolan IP law (Law No. 3/92 of February 28, 1992, on Industrial Property) prohibits, in its Article 39º, c. the registration, without due authorization, of trademarks that contain “symbols such as insignia, flags, arms or official signs adopted by the State, commissariats, international organizations or any other public entities”, without explicitly mentioning the religious signs. Angola is a secular state (Article 10º, 1º, of the Constitution), ruled by governments inspired by Marxism and Communism since 1975, which can partially explain the omission of the law and the small interest IP legislators have shown in the question. Indeed, in countries where religion occupies a more prominent place, the issue of religious signs is expressly addressed in the IP law like in the United Arab Emirates and in India.

Nevertheless, besides the political and social factors, the Angolan legislation’s omission may seem logical if we consider the following viewpoints.

First, trademarks are quite connected to commerce, but religions could not always, in its essence, fit into the trade.

Second, the religious signs do not comply with the requirements of distinctiveness.

Third, the religious signs could not respect the requirements of “Morality” or “Public Order”.

And fourth, religious signs are symbols that are, generally, adopted by international organizations or by public entities, and thus are necessarily excluded from registration.

Despite these considerations, the question of religious trademarks’ protection arises when we observe an increase in the number of registrations of trademarks containing religious signs, such as “Cristo Redentor” or “Santo Cristo”. Can religious trademarks be protected in Angola?

Résumés

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We must conclude that the Angolan PTO tends to accept religious trademarks unless there is a serious violation of the IP legislation or an imitation of a previous trademark.

Although these questions would be without purpose if it would be accepted, unreservedly, that religious signs are symbols that are adopted by international organizations and by public entities, and thus, should be excluded from registration according to Article 35º, c) we understand that to respond to them, we must consider the inner reasons for these trademark applications and decide on them, at the risk of being abusive or inappropriate regarding the intimate sphere of each applicant.

II. National context

There are currently dozens of religious trademarks in Angola, granted and pending, related to various classes and goods and services.

The most frequent class related to these trademarks is class 41 for cultural and educational services, followed by classes 35 and 25. This brings the following questions:

1. Can representatives of religions provide education services without jeopardizing the principle of secularism provided for under the Constitution?
2. Shall it be considered that the registration of religious trademarks for goods included in classes 35 and 25 violate religious precepts and, consequently, the Articles 10º of the Constitution, which dictates the state to protect churches and faiths and their places and objects of worship?, what is, or shall be, the action of the state, particularly of the Patent and Trademark National Office (PTO) in this regard?

III. The Patent and Trademark Office’s approach

When analyzing Angola’s public data, we notice that the PTO grants religious trademarks, independently of the class and the goods and services, and, therefore, without any regard for the motive of the applications.

For instance, the trademark “IGREJA EVANGÉLICA BAPTISTA EM ANGOLA - I.E.B.A.” (word and device) was granted for classes 24 and 25. The trademark “IGREJA UNIVERSAL DO REINO DE DEUS” (word and device) is registered in class 41. The trademark “IGREJA DO NOSSO SENHOR JESUS CRISTO NO MUNDO” (word) is registered in classes 25, 29, 35, 41 and 45.

Thus, we must conclude that the Angolan PTO tends to accept religious trademarks unless there is a serious violation of the IP legislation or an imitation of a previous trademark.

It seems that the PTO is of the opinion that because it is not expressly prohibited by the law, religious trademarks can be granted. Trade is religiously neutral and, we can assume that, even though the commercialization of religion is rampant, the PTO considers that it is not under its responsibility to judge its rightness.

Because religious trademarks can, effectively, hurt the religious sensibilities of communities, the PTO seems to believe that these communities shall oppose the registration of these trademarks when they are published. In other words, the Angolan PTO appears to believe that religion must stand in a private sphere.
threats and risks for trademarks in Russia

Evgeny Alexandrov, Alexey Kratiuk, and Alexander Nesterov of Gorodissky & Partners provide an overview of the protection of trademarks and the risk of identical or similar marks in the Russian market, explaining why registration and renewal are paramount.

Intellectual property has its value if it is duly protected in a country where a company has its business interests. Despite the current sanctions policy against Russia and the counter-sanctions adopted by Russia in response to the actions of some foreign countries, from the so-called “unfriendly” list of countries, Russia remains a key participant in the global intellectual property system that includes a number of international treaties and the institute of IP in our country continues to work effectively to protect the legitimate interests and rights of IP owners, regardless of where they come from. The Russian intellectual property system operates in full conformity with the rules of substantive and procedural law as laid down by part IV of the Russian Civil Code that relates to IP rights.

It means that those companies, under the influence of the political decisions of their governments or for other commercial reasons, are forced to consider suspending their businesses in Russia or even leaving the Russian market, should not be concerned about unfair, politically motivated, or biased treatment of their IP rights by the official Russian IP bodies such as the Russian Patent and Trademark Office (hereinafter referred to as “Rospatent”) or IP Court.

This, however, should not be interpreted as though no proactive measures are required to safeguard IP rights owners’ interests in Russia. On the contrary, IP owners should take care of high-level protection of their IP, especially trademarks, using all available legal remedies as provided by the Russian law including possible legal actions against third parties infringing trademark filings or registrations as a case may be. Such actions may also be required to hinder the dilution of famous trademarks in a situation when it comes to a third party’s trademark filing in respect of a similar mark covering a wide range of goods incorporating those being dissimilar to the goods of the genuine trademark owner.

Insofar as trademarks are concerned all legal mechanisms for protection and enforcement of rights established by the Russian law remain fully in force as it follows from the current practice in both administrative and judicial cases. This, in turn, reflects steady commitments of competent bodies to the legal approaches and procedures for the enforcement and protection of rights and a stable state of affairs in this regard.

Accordingly, all recent bad faith filings by Russian legal entities or individual entrepreneurs of trademarks that are identical or similar to famous third parties’ trademarks covering similar or dissimilar goods and services (e.g. ASOS, BUD, EPIC GAMES, GUINNESS, METAVERSE, LOUIS VUITTON, NESQUIK, NETFLIX, ORBIT, PEDIIGREE, SMIRNOFF, TIFFANY & CO, TUBORG, WHISKAS and 200+ more) should undergo the usual examination procedure. This means that, as a first step after the filing, Rospatent is obliged by law to publish any application, regardless of whether it may or may not contain the signs of bad faith acting. The filed application is accepted for consideration if it meets formal requirements and the formal stage is followed by further verification of the compliance of the filed application with the registrability requirements, which is carried out at the stage of substantive examination of the application.

As it follows from the recent declaration made by the Head of Rospatent, Mr. Yuri Zubov during his visit at the St.Petersburg’s International Economic Forum in June 2022, such trademarks that are identical or confusingly similar to the previously registered famous trademarks cannot be registered in Russia.

Trademark examination is conducted by Rospatent based on both absolute grounds for refusal of registration analyzing the essence of the mark and verifying whether the proposed mark is capable of distinguishing goods and services and based on relative grounds (checking whether the claimed designation is in conflict with third party’s rights for similar signs and other IP objects enjoying earlier priority and whether or not registration of a sign is capable of misleading consumers in respect of the applicant or goods/services).

Therefore, during examination procedures, it has to be established if the applied designation can be registered as a trademark or if there are any obstacles such as identical/similar trademarks with earlier priority or other grounds such as possible misleading, which prevent the mark from being accepted. Accordingly, if there are prior rights for identical/similar trademarks in respect of identical/similar goods/services, such trademarks should be identified by the examiner and cited as obstacles during examination procedures.

A similar approach regarding preventing misleading and commercial use of the marks similar to the registered trademarks of the other company is also applied in unfair competition cases. For instance, in the case initiated by the licensee of The Coca-Cola Company, it was discovered that a local Russian manufacturer launched sales of soft drinks under the name “FANT”. On June 2, 2022, the IP Court considered the case as the cassation instance and upheld the antimonopoly body’s conclusions to the effect that the designation “FANT” and its label were confusingly similar to the trademark and original label “FANTA” and the designation was used concerning the same type of product - a carbonated orange soft drink. The Court reasoned that “confusion with respect to two products may not only lead to a decrease in sales of FANTA drink and redistribution of customer demand, but may also cause harm to

Résumés

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Alexander joined Gorodissky & Partners in 2001 and was promoted to partner at the firm in 2012. His experience includes counselling clients on the protection and enforcement of trademarks and service marks and appellations of origin and other trademark issues. He represents clients both before the Russian PTO and commercial courts. Russian IP Court also. Alexander is keen on registration proceeding strategy and in international cases as well, he advises clients on transactional, opposition and cancellation work.

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the business reputation of a third party, since the consumer is misled by the mixing and receives another product with different quality, taste and other characteristics.” (case No.А38- 470/2021)

The bad faith filings or the use of similar marks obviously have a purpose of gaining easy and fast profits based on the reputation, goodwill, and popularity established in the famous brand by its genuine owner. However, such kind of threat may continue or even grow in view of recent amendments to part IV of the Russian Civil Code, which will allow not only legal entities and individual entrepreneurs to apply for registration of trademarks but also allow natural persons, including those self-employed, to be applicants.

Currently, the Russian Civil Code provides a limited list of those who are entitled to file a trademark application. The applicants for trademark applications are limited to legal entities and individual entrepreneurs. However, recent amendments to the Russian Civil Code, taking legal effect from June 29, 2023, will allow natural persons and self-employed persons to file trademark applications since they can engage in certain types of entrepreneurial activity without registering themselves as individual entrepreneurs. It can be assumed that such provision may boost the creation of personal brands, which allow for promoting goods and services for such persons more actively. On the other hand, this brand new tool may be easily used by natural persons acting in bad faith to apply for registration of third parties’ famous brands in their own name.

Under such circumstances, regular monitoring of filed applications becomes crucial to identifying bad faith filings in a timely manner since, even though there is no opposition system in Russia in respect of pending applications, the Russian Civil Code provides for the possibility for any person to file an observation letter in respect of a pending application with Rospatent in order to bring the examiner’s attention to the existence of the conflicting prior rights or other grounds for possible refusal of registration by setting out arguments on the non-compliance of the applied designation with the statutory requirements.

Once the bad faith mark is detected, one should consider filing an observation letter as it may be used alongside with other arguments against registration of such mark to make the legal position stronger.

The brand new tool to deal with possible bad faith filings of identical/similar marks is monitoring newly filed applications in a timely manner and filing observation letters to prevent registration of the conflicting trademark at the stage of examination. It is much easier to prevent registration of a bad faith trademark at the examination stage rather than bringing for more costly and time-consuming invalidation action at the post-registration stage.

Whilst monitoring and observations are, no doubt, very effective pro-active measures that ensure high-level standards of brand protection, one should also keep in mind that Russia is a first-to-file country which suggests that trademark rights basically arise as a result of registration. Therefore obtaining trademark protection through registration and maintaining trademark rights through timely renewal, updating use in accordance with the use requirements are a must in Russia to be able to effectively enforce trademark rights against a bad faith applicant or potential infringer.

Potential trademarks may effectively use procedures for early termination of the trademark protection which is an obstacle to the registration of an identical or similar trademark in Russia. At that, it should be noted that suspending the business activity or leaving the market shall not be recognized as an excusable reason and in cases where the trademark is not used within the years in Russia, it can be canceled due to its non-use. The burden of proof of the trademark use lies on the trademark owner and the standard of requirements for the evidence is quite high which means a formal license, or a small document, may not be accepted by the IP Court as persuasive. For instance, in case No. CHT-18/2021 the trademark owner of “TJ Footwear UKO Limited has lost his trademarks “TJ” and “TJ COLLECTION” (both in Cyrillic) because he failed to prove their proper use in Russia. A plaintiff Tee Jays A/S (Denmark) insisted that the trademarks were not used in Russia and asked for their termination because he was interested in granting the legal protection for similar trademarks with a word element “JAYS” extended to Russia based on the current international trademark registered under the Madrid Agreement. The trademark’s owner produced a license agreement, photos of branded stores, the list of goods, cash receipts, contracts, specifications, customs declarations, and screen-shots of advertising in Yandex and Google to prove the use of the trademark. However, the evidence was not accepted by the IP Court since they demonstrated the use of brands in Latin characters while the trademarks were registered in Cyrillic and the IP Court concluded that no evidence of use of the registered trademarks was presented by the trademark’s owner.

In the current political and economic environment, the long-term brand protection strategies require considering the risks of losing the brands or the appearance of counterfeit copypaste products on the market. It is worth noting that there are no limitations or restrictions for the IP owners to deal with IP matters in Russia, in particular, pay the respective official fees where necessary as IP transactions including those connected with filing and registering trademarks are explicitly exempted and are not affected by the sanctions by virtue of General License 31 (GL31) issued by the Office of Foreign Assets Control (“OFAC”) of the U.S. Department of the Treasury on May 5, 2022. Recently, by the way, there was a prohibition for US clients to pay official fees to Rospatent, but OFAC later lifted that prohibition by its GL31 which authorizes any IP transactions in Russia, including the filing and prosecution of any application to obtain a copyright, patent, or trademark, as well as the payment of renewal and maintenance fees.

The stable state of affairs in the legal fields in general, and in respect of intellectual property in particular, shows that despite present sanction pressure, Russia remains to be committed to all existing laws including International Agreements to which Russia is a party and follows spirit and language of law, which makes it possible and recommendable for right holders to continue with protection and enforcement of their IP rights in Russia.
The principal purpose of this new requirement is to avoid trademark registrations that are not actually and effectively in use in Mexico. It is to give more importance to the use of trademarks in Mexico and have not achieved registration yet. The scope of protection for national and international trademark registrations which declare use will only cover those products or services which are precisely declared. Consequently, the protection will be lost for the remaining products or services which were originally covered by the registration but for which use was not declared with the Declaration of Actual and Effective Use. It is recommended to holders of international registrations which have designated Mexico as a contracting party to appoint local legal representatives in order to timely file this mandatory Declaration of Actual and Effective Use and avoid the expiration of the relevant registration simply for the lack of the filing of this requirement.

Résumé

María del Carmen Sada, Attorney-at-Law at OLIVARES

María del Carmen Sada focuses her practice on Intellectual Property matters. Her tasks at OLIVARES are primarily registration, prosecution, and maintenance of trademarks, client counseling, preparation and prosecution of trademark applications, trademark protection, licensing, of trademark rights. Her practice includes a diverse range of industries and technologies such as pharmaceuticals, building products, video games, consumer goods, clothing, among others.
The use of a trademark usually means the actual sale of a product or service to the consumers in Mexico.

We suggest always reviewing your trademark registrations in Mexico in order to be aware of the maintenance deadlines such as the so called “Declaration of Actual and Effective Use” and review the real and effective use of the trademarks and it is advisable to have in hand evidence that attests the use of the trademark, such as contracts, advertisements, invoices, publications, brochures, catalogues or any other marketing document, in case that trademark is challenged by a third party for not being in use in Mexico.

In conclusion, the main purpose of incorporating the Declaration of Actual and Effective Use into Mexican Law is to encourage the active use of registered trademarks and in order to avoid control over registrations that are not being used by their owners. This new requirement has caused a fundamental modification in the Mexican Industrial Property System, complementing the importance of the use of trademarks with the prevailing regulations in the world.

Much has been written and discussed about the Declarations of Actual and Effective Use of a Trademark in Mexico; however, it is worth bearing this topic in mind in order to be alert of the maintenance requirements for all of your client’s trademarks.

The Trademark Registrations granted before August 10, 2018, are not obligated to file this Declaration of Actual and Effective Use, those trademarks are still in force until the term of 10 years, which is the period for which the authority protects a trademark, a period that can be extended for an equal period if renewal petitions are filed.

The Declaration of Actual and Effective Use in Mexico is filed based on the principle of good faith. No proof of use should be filed with the Mexican Institute of Industrial Property (IMPI), it is not mandatory to submit evidence of the use of the trademark when declaring it. For both cases, IMPI has published official forms for filing and the same has to be executed by filing the specific goods or services on which the trademark owner confirms actual and effective use in Mexico for the registered trademark. In other words, The Mexican IP Law requires a declaration with the official format, indicating, and declaring under oath the list of specific goods or services for which the trademark is in use and on which the trademark owner confirms actual and effective use in Mexico, but it cannot include new products or services. The trademark is in use in Mexico in connection with new products or services, a new application should be filed before the IMPI.

Accordingly, it is very important to try to determine what is actually meant by real and effective use of a trademark in our country.

In terms of Article 235 of the IP Law, “the use of a mark must be made by its owner or by its authorized user. If a trademark is not used for three consecutive years in the products or services for which it was registered, its registration will lapse or, it can take place the partial lapse in connection with the products or services that are not in use, unless its owner or authorized user who has been granted a license has used it during the three consecutive years immediately prior of the filing of an eventual administrative cancellation action, or that there are circumstances arising independently of the will of the trademark owner that constitute an obstacle to the use of the mark, such as import restrictions or any other governmental requirements applicable to the goods or services to which the mark is protected”.

The use should necessarily mean an actual and effective presence of the products or services in the market within Mexico. In other words, the products or services distinguished by the trademark registration have to be at least offered and available in the market for Mexican consumers in the amount and ways that relates to the customs and habits in the commerce. The use of a trademark usually means the actual sale of a product or service to the consumers in Mexico.
According to Art. 6.septies of the Paris Convention for the Protection of Industrial Property, if an agent or representative of a trademark owned in one of the Union countries files, without the owner’s permission, an application for this trademark registration on their own behalf in another Union country, the owner has the right to demand the cancellation of such registration, if the agent or representative fails to provide evidence, justifying their action. It should be noted that in some cases such registrations are the result of simple ignorance - it is not immediately obvious whether the consent of a person to use their trademark under a distribution agreement is consent to filing an application for registration of this trademark in the name of an agent (distributor). However, often the acquisition of the exclusive right to such a trademark pursues parasitic goals - the means of individualization is already recognizable, has a certain reputation, there is no need to invest in its “promotion”. In practice, the qualification of legal relations as agency relations often causes difficulties due to the ambiguity of the corresponding concept, but difficulties also arise with other issues. For example, in case No. SIP-244/2020, the Rospatent refused to satisfy an objection to the legal protection of a trademark on the grounds that the agency relationship between the foreign right holder and the original applicant, noting that the filing of a trademark application by an agent or representative of such a person has no legal significance if the rights subsequently transferred to another person.

Résumé
Olga Plyasunova is Head of the Trademark Department at Zuykov and partners and a Trademark Attorney. Olga also has the status of Patent attorney of the Russian Federation (No 1258), and specializes in appellations of origin of goods, trademarks and service marks, and industrial designs. Olga is a member of ECTA (2019). Olga has worked with Zuykov and partners LLC since 2007 and has extensive experience in consideration of disputes, objections, and statements in the Chamber on patent disputes of trademarks.

Olga Plyasunova, Head of the Trademark Department at Zuykov and partners, reviews the right to the cancelation of a registered trademark of a foreign right holder if registered, without justification, by an agent or representative.
Since these conditions were not established by the court in full, the case was sent for a new trial.

Bajaki Ferenc was a founder of the applicant company Horizon Food Kft and entered into a trademark license agreement with his company. All this made it possible to recognize persons as affiliated, having the same business goals and acting in the common interest.

As for the confirmation of agency relations, between Horizon Food Kft. and the owner of the disputed trademark entered into a distribution agreement and a contract for the supply of goods, on the basis of which the court concluded that the company acted as a distributor for the 'Madjarica brand' before the priority date of the disputed trademark. However, the company denied the existence of agency relations and referred to the fact that relations with the company were not based on an agency agreement. In response to this argument, the IP Court considered it possible to give a broad interpretation of the agency and representative relations between the right holder of the disputed trademark and the trademark in the state party to the Paris Convention and noted that in such a case such relations include any contractual relations for the sale of goods on the territory of the Russian Federation, labeled with a controversial designation.

The company also challenged the application of the considered grounds for recognizing the grant of legal protection as invalid on the basis of the following:

- Bajaki Ferenc ceased its status as a member of the company from a certain date and at the time of filing an application for registration of a trademark in Hungary was no longer such;
- the license agreement for the right to use the Hungarian trademark was concluded on the day of filing an application for its registration and was not registered in the prescribed manner.

Rejecting the arguments of the society, the court proceeded from the fact that on the priority date of the disputed trademark Bajaki Ferenc and the company were in any case affiliated persons: until 05/09/2017, this person was the sole participant of the company, and after that date, his wife became the owner of the company.

The IP Court also came to the conclusion that the norms of the Hungarian Law XI of 1997 “On the Protection of Trademarks and Geographical Indications” do not contain a prohibition on concluding a license agreement for the use of a designation after the filing of an application, but before its registration as a trademark, as well as not providing for a mandatory procedure for registering a license agreement.

Thus, IP Court acknowledged the presence of the entire set of circumstances that are the basis for the application of the provisions of Article 6septies of the Paris Convention and paras.5 p.2 art. 1512 of the Civil Code of the Russian Federation.

A similar case with the same participants recently passed the first instance of the IP Court. Rospatent also satisfied the objection on the same grounds in relation to the trademark N 690394 “МАДЬЯРИЦА” (‘Madjarica’), and the IP Court sided with Rospatent.

As can be concluded, disputes over contesting the legal protection of trademarks due to the inconsistency of Art. 6septies of the Paris Convention seem to be quite complex - one may encounter ambiguity in the legal qualification of relations between applicants and copyright holders of Russian trademarks, and the need to analyze foreign legislation, and with a multi-link chain of copyright holders as a result of the transfer of the exclusive right to a disputed mark. Also, in practice, there are cases in which the ultimate trademark owner is liquidated (according to the IP Court position, this should not prevent the consideration of objections).
To be or not to be - domain name registrar liability under IP law

Karan Kumar Kamra, Senior Associate at Anand & Anand, evaluates the possibility of confusingly similar domain names and who is liable for providing protection against infringement.

Domain names in the contemporary setting:
With the exponential expansion of internet communication, domain names were recognized by Indian Courts as a valuable corporate asset, having as much legal sanctity and being entitled to equal protection as a trade name/trademark. Domain names were noted to be key identifiers of online businesses and were treated as internet addresses, which were to be preserved, to protect the provider of services against third parties trying to unauthorizedly traffic or usurp domain names. Courts have unanimously held that rendering of internet services via domain names is entitled to protection in the same way as goods and services are protected under the trademark law.

Abusive domain name registrations:
The Delhi High Court, in a recent order dated 3rd August, 2022, duly observed that there has been a proliferation of abusive domain name registrations on account of the large number of domain name registrations, comprising of registered trademarks and brand names of right holders by unauthorized persons, instances of such abusive domain name registrations as identified by the Court include:
- Registration of domain names by registrants bearing the right holder’s trademark/brand with the intention to monetarily gain from the right holder’s goodwill by selling their products using such domain names.
- Registration of domain names by registrants bearing the right holder’s trademark/brand which are used in distrubutionships, franchisees and dealerships are fraudulently offered and large sums of money are collected from unsuspecting customers.

Prior to passing the aforesaid order, the Court in Fashnear Technologies Private Limited vs. Meesho Online Shopping Pvt. Ltd & Anr. took cognizance of numerous pending matters which relate to similar issues involving fraudulent domain names infringing well-known marks and brand names. Recognizing that comprehensive directions would be required to be issued to the various governmental agencies, the Court decided to consolidate all such matters.

Blanket or dynamic injunctions vis-à-vis infringing domain names:
In the Dabur order, it was further observed that on account of fraudulent registration of domain names, containing well-known trademarks and brands, innocent individuals had been duped of crores of rupees. While right holders sought blanket injunctions restraining Domain Name Registrars (DNRs) from registering any infringing domain names comprising of their registered trademarks and brand names, DNRs strongly resisted the said prayer, submitting that alphabets contained in these marks and names are such that there could be registration of genuine domain names as well, containing the said trademarks or parts thereof.

The predecesor bench of the Delhi High Court, while adjudicating upon the interim injunction application in the Snapdeal matter, had duly considered the tenability of granting blanket injunctions against prospective fraudulent domain name registrations. In this regard, the Court held that granting such injunctions, in the nature of quo amet actions, cannot be predicated on imaginary or hypothetical infringements as it would be attributing a clairvoyance that the Court does not possess.

Consequently, it was held that the right holder must necessarily petition the Court against each domain name it finds to be infringing in order to establish: 1) The website hosted on the domain name is in fact a rogue website; and 2) The website has infringed the Plaintiff’s intellectual property rights. The Court held that the said aspects could be decided only by a judicial authority and despite the process being cumbersome, there is no shortcut to justice.

The Bombay High Court had earlier alluded to the practical limitations in granting blanket injunctions. It was observed that seeking “blocking” or “continued suspensions” of potentially infringing domain names is impossible given the current technology as the whole process of registering domain names is automated. The Court further observed that a working protocol needs to be established within the permissible limits of existing technology and applicable provisions of law. In contrast, the Delhi High Court in Gujarat Cooperative Milk Marketing Federation Ltd & Anr v. Amul Franchisee did not buy into arguments concerning technological limitations of DNS as it was observed that they are operating similar filters to ensure that obscene websites and/or words denoting illegality are not accessible for sale.

Although courts have generally been reluctant to grant blanket injunctions, there have been instances where such relief has been granted to restrain registration of potentially infringing domain names. For instance, in CTC Limited v. Ashok Kumar & Ors, the Court restrained various DNRs from registering any domain name which comprised of the well-known mark of the right holder in conjunction with a particular brand name and words. However, the Bombay and Delhi High Courts vide their other orders have clarified that blanket injunctions/orders akin to blanket injunctions may be granted only in extenuating circumstances determined on a case-by-case basis.

Intermediaries or infringers - the DNR conundrum:
The Court has taken a stand on this matter by considering the question of whether DNRs would qualify as an “intermediary” under the meaning of Section 2(1)(w) of the Information Technology Act, 2000 (‘IT Act’). It was recognized that DNRs are persons who provide services with respect to domain names (which qualify as “electronic records” within the meaning of Section 2 (g) of the IT Act) and thereby qualify as “intermediaries” under Section 2(1)(w) of the Act.

However, the Court went one step further and held that despite being an intermediary, DNRs can be made liable for infringement under Section 29 of the Trade Marks Act, 1999 (“TM Act”).

Résumé
Mr. Karan Kumar Kamra is a senior associate in the litigation team at Anand and Anand. Mr. Kamra graduated from the Campus Law Centre, University of Delhi in 2003. He had been associated with the firm for the period 2013-2018 and after brief hiatus during which he was associated with a leading IP Boutique firm, he rejoined the Litigation Team at the firm in 2020.

Mr. Kamra has a rich experience of over nine years in litigation on core and in complex aspects of Intellectual Property. He has extensively worked in a plethora of matters, covering various IP practice areas, including trademark and copyright law, domain name disputes and resolution, IP advisory, risk management and mitigation consultancy, litigation advisory and strategy consultation.

Karan Kumar Kamra
To overcome challenges posed by the large quantum of fraudulent domain name registrations and to protect the interests of the right holders’ interests, the Court directed convening a meeting between all relevant stakeholders namely NPCI, DoT, MeITY, and CERT-IN and Delhi Police to facilitate investigation and resolution of all such disputes. Vide an order dated 13 July, 202218, the Court had previously directed DNRs to file affidavits proposing mechanisms and solutions to prevent the abuse of domain name registrations and to limit the use of the privacy protection features. However, no affidavit had been filed. 

While hearing the Dabur19 case and other tagged matters, the Court took note of relevant provisions of various ICANN Agreements namely the ICANN Registrar Accreditation Agreement, the Registry-Registrar Agreement (“RAA”), and the ICANN Registry Agreement. On a perusal of the agreements, it was observed that domain name registrations ought to be done through an identifiable natural person20. It was further noted that DNRs have to respond adequately to governmental or semi-governmental authorities operating in any country and have to abide by applicable laws and regulations. Notice was also taken of the Registry Agreement (“RAA”) which stipulates that DNRs are under an obligation to curb illegal activity and not act in a manner which could result in damage to third parties including brand names and trademark owners. Further, it was observed that legal rights of third parties are to be protected and the Registry Operator is to take reasonable steps to investigate and respond to any reports from law enforcement and governmental agencies on illegal conduct.21 The Court observed that the DNRs do not seem to be under an obligation to extend privacy protection features, even in cases of blatant infringement and fraudulent activities. Moreover, the Court was of the opinion that as per the Agreements, all Registrars and DNRs have to abide by and give effect to orders passed by competent courts, governmental authorities etc. Given the quantum of fraudulent domain names capable of being registered, it was observed that the existing grievance redressal mechanism of seeking remedies under UDRP or approaching the Court was unsatisfactory since the existing framework makes it almost impossible for the domain name registrar to place their recommendations through affidavits on multiple aspects. Broadly, the recommendations sought include:

• Setting a mechanism to verify the identities of registrants (possibly at the time of registration itself).
• The manner in which privacy or proxy services are provided.
• The manner in which the data related to the registrant can be provided to an owner of a well-known trademark or brand in case he contacts any DNR, without the intervention of a Court, or any governmental agency;
• Whether any specific links or domain names are provided by the CGPDTM, covering a list of well-known marks, maintained by the Registrar of the Trademarks, or declared by any Court of law, which can then be used for expeditious blocking of domain names consisting of such marks;
• Whether there can be an agency identified in India, such as NIXI, which can be made a repository of the data concerning the registrant, an agency through which the data could be transmitted to the DNR, upon verification by NIXI, in case a trademark owner has a grievance against a specific domain name;
• Whether any directions issued to the DNRs are not implemented, the manner in which in the implementation of the said orders can be ensured;
• Whether upon request by any identified agency, details of payment either through credit card or online methods or apps can be provided to trademark owners.

While it is yet to be seen which of the tides would turn, the Court has to strive for a balancing act between the rights of a trademark holder as well as the DNRs, which claim to be an intermediary under law.

As early as in the Arun Jaitley case22, it was observed that the domain policy under ICANN is aimed at curbing bad faith adoption as well as to prevent the use of the domain names for trafficking and that sufficient powers can be assumed by DNRs under the said policies to prevent the same. The Court, noting that it is necessary to implement the domain name policy at all stages from registration up until seeking cancellation of the domain name it was observed that DNRs are to act circumspectly at the first instance itself so that the domain name litigation can be curbed to the maximum by merely calling upon registrants to disclose their identity or establish a sufficient connection or nexus with the domain name in question. It is unfortunate that despite this order being passed nearly 12 years ago, no actions were taken to address the issue of fraudulent domain name registrations and the obligations of DNRs thereto. Nevertheless, the Dabur order could be the first step towards establishing a regulatory framework to address menaces posed by fraudulent domain name registrations.

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18 Dabur India Limited vs. Ashok Kumar - CS (COMM) 135/2022
19 National Internet Exchange of India
20 General Data Protection Regulation. Regulation (EU) 2016/679
21 Member of the ICANN’s Government and Public Affairs Committee
22 ICANN-Registry Agreement
23 ICANN Registry Agreement
24 CS (COMM) 135/2022
25 ICANN Registry Agreement

The masking dilemma of DNRs

The Court in Darbur observed that in various instances DNRs either voluntarily mask the identities of the registrants or provide bundled services, including privacy protection and proxy domain. At higher prices. It was noted that even if the information collected by the DNRs at the time of registration of the domain name is unmasked, on most occasions, details provided are fictitious and not traceable. The Court was informed that Clause 4.4.3 of NIXI’s14 Registrar Accreditation Agreement15 bars anonymous proxy registrations and that no privacy or proxy service can also be given. However, it was clarified that as GDPR16 had been implemented by NIXI, the details of the domain name registrants are ordinarily masked, but in the event of receipt of a court order or a direction by any authority or any law enforcement agency, such details are duly disclosed. As regards MeITY too, the Court noted that though at present there were no regulations as to the manner in which it could be ensured that DNSLs (especially those not in India), follow the orders of the Court or any executive instructions.

As they ‘use’ the infringing mark ‘in the course of trade’ when they provide alternate domain names to potential registrants. The rationale of the order is premised on the fact that by providing alternate domain names for registration at higher price rates, depending on the demand for the domain name, DNSLs are essentially ‘acting commercially for profit’ thereby performing functions beyond that of a mere intermediary.

Taking note of the scope and ambit of Section 79 of the IT Act, it was observed that to avail protection of the safe harbor provisions under Section 79, intermediaries will have to observe due diligence obligations. The Court held that as the functions of DNRs are not limited to merely providing access to communication systems but also include providing alternate domain names and charging different price rates for the same, they do prima facie qualify for protection. Therefore, by providing alternate domain names which infringe the intellectual property rights of a right-holder, DNSLs can be made liable for infringement within the meaning of Section 29 of the TMA Act.

Conclusion

Considering the perils encountered on account of fraudulent registration of domain names and large-scale misappropriation of public funds, the Court has directed DoT and NIXI to come up with necessary remedies qua each and every domain name.

It was observed under Section 79, intermediaries will have to observe due diligence obligations, and to prevent the use of the domain names for illegal conduct.

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A relevant issue for the applicants of an EU trademark is the possibility of receiving an opposition, how to face this situation, considering risks and opportunities, costs, and savings. One could see a received opposition just as a risk (of failing registration) and a cost (the attorney fees and the procedural costs); but is it really so? The EUIPO TM Focus (2010 to 2019 evolution) Report shows us several figures, trends, and a changing scenario in these nine years. Let us consider, first, that an EU TM application is a single, excellent shot for 27 targets (27 Member States), instead of 25 shots for 27 targets (the Benelux covers three Member States). The Report shows the key information that the opposition numbers before the EUIPO are stable in the last years, while the number of applications/publications is growing. Hence, the opposition rate on publications has steadily declined from 14.3% (one publication opposed in seven) to 10.7% (one in ten). This is the first relevant news. Another 4% of opposition notices are declared inadmissible; then, on the admitted ones, 63% are resolved during the cooling-off period and another 12.4% are totally rejected after a decision. This means that 75.4% of admitted oppositions go to a favorable solution (i.e., the registration) either by a coexistence agreement or by EUIPO’s decision. Just 12.5% of applications are partially refused and 8.2% are totally refused: an overall rate of 20.7% of opposed applications is rejected in full or in part. Considering that oppositions are 10.7% of all publications and multiplying them by 20.7%, we have just 2.21% of total/partial rejections on EUTM published applications after an opposition decision.

Francesco Bonini evaluates the opposition-related findings of The EUIPO TM Focus Report that spanned 2010-2019 to discover trends and changes.
When your EUTM application is published, you have 97.79% possibility of getting it registered.

Consequently, the above-cited figures show a very little percentage of publications failing registration in full or in part and this information should be disseminated among non-EU applicants and applicants.

The wide and successful use of the cooling-off period should also be underlined as a successful tool for solving conflicts.

Then, all non-EU applicants could be advised to contact the counterpart, by their EU TM attorney, and see if it wishes to negotiate an agreement within the cooling-off.

Each applicant can collect other useful information for taking a reasoned decision whether to go on or not: for example, asking its EU attorney for a quotation on a possible negotiation or for entering the proceeding.

In this way, the applicant could get the 27-targets strike with the initial costs, plus additional but definite ones; surely, the total amount will be much less than 25 costs (of the 25 ‘shots’, as mentioned above).

If the other party agrees to negotiate and is proactive, the opposition can be withdrawn in a few months and the applicant can get its registration in a reasonable time.

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Otherwise, should they enter the opposition procedure, it lasts on average 19.3 months or even less, if submissions of arguments are limited and extensions are not requested.

An appropriate balance between costs and benefits should lead non-EU applicants to carefully consider their decision of surrendering when receiving an opposition.

Indeed, if they compare the EUIPO costs to the national registration ones and if they also consider the large percentage of solved oppositions, they could consider relying on negotiation or facing the opposition, instead of surrendering.

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Dilemma of jurisdiction over online infringements, solved?

Dheeraj Kapoor and Vibhuti Sharma of LexOrbis review the Bvlgari SPA v. Notandas Gems Pvt. Ltd. case that may lay the foundations for future jurisdictional disputes surrounding online infringement.

Deciding jurisdiction in matters of online marketplaces has always been a tricky aspect in cases involving intellectual property. However, recently the judgment in Bvlgari SPA v. Notandas Gems Pvt. Ltd. acted as an important anchor, with the Honble Delhi High Court taking a comprehensive stand regarding territorial jurisdiction over online infringement.

In this case, the Plaintiff approached the Delhi High Court alleging infringement by the Defendant of its registered trademarks containing the distinctive word “SERPENTI” and its registered device mark comprising a “snakehead”. These marks were claimed to have been in use for niche luxury products since the 1940s. If you know your fashion well, then you would be well aware of Bvlgari’s iconic high-end jewellery and watches having a bejewelled snake head.

The Plaintiff contended that the mark “SERPENTI” was indelibly associated with the range of luxury bracelets/jewellery. The fact that the Defendant had adopted the same idea, style and trade dress to sell its jewellery naming “SERPENTINE” was a blatant act of infringement of the Plaintiff’s trademark “BVLAGI SERPENTI”, “SERPENTI HYPNOTIC”, “SERPENTI INCANTAT” and “SERPENTI SEDUTTORI”. To this, the Defendant relied on Section 27 of the Trade Marks Act, 1999 contending that the Plaintiff cannot claim monopoly over the use of the term “SERPENTI” as it was only a part of the whole mark. It was further contended by the Defendant that the two marks “SERPENTI” and “SERPENTINE” were not phonetically similar as the concluding syllables were different. It was also argued that the mark “SERPENTI” was common to the trade and the word “SERPENTINE” was merely an adjectival form of the word ‘serpent’ signifying the shape of the Defendant’s jewellery.

The Defendant further contended that there were several jewellery manufacturers using the form of a serpent/snake.

The Court noted that there was a clear phonetic similarity between the expressions “SERPENTI” and “SERPENTINE”. Also, the slight phonetic distinction in terms of the concluding syllables was not enough to make the marks different in their overall impression. As the Defendant was using the mark “SERPENTINE” in respect of goods which were identical to the Plaintiff’s products, namely jewellery/bracelets, the target customers were also the same. The Court further observed that going by the reputation of the “SERPENTI” line of products of the Plaintiff, a prima facie case for treating “SERPENTI” as the dominant part of the Plaintiff’s marks was made out. Referring to the case of South India Beverages Pvt. Ltd. v. General Mills Marketing Inc. 2014 SCC On Line Del 329 the Court noted that where the dominant part of the mark was infringed, a case for injunction was made out. Accordingly, the Court held that the Plaintiff had a prima facie case for infringement.

However, the all pervasive issue which attracted the eye was about the determination of territorial jurisdiction over infringement of IP rights on the internet. In this connection, the Defendant contended that the Delhi High Court had no jurisdiction to adjudicate on the matter as the Defendant’s exclusive store located in Delhi had been shut and it had only one outlet in Mumbai. However, it was the Plaintiff’s contention that the Defendant’s infringing products were also available online through its website www.notandas.com which was not only interactive in nature but also accessible from Delhi i.e., within the jurisdiction of the Delhi High Court. The Defendant contended that mere interactivity of its website could not justify invocation of the jurisdiction of the Delhi High Court. It relied on the judgment of the Division Bench of the Delhi High Court in Banyan Tree Holding (IP) Limited v. A. Murali Krishna Reddy, and of a learned Single Judge in Karans Guruwal Classes v. Guruwal Classes IP Division, wherein it was observed that mere interactivity could not justify invocation of the Court’s jurisdiction and that it would additionally have to be shown that the defendant was targeting customers within the jurisdiction of the Court through its website, for purposefully invoking the Court’s jurisdiction. However, the Plaintiff contended that, on the aspect of territorial jurisdiction, the principle of actual transactions taking place across an interactive website would not apply where commercial transactions are possible from any geographical location through the website. Therefore, goods being sold across different territories and consumers purchasing those goods through online marketplaces, even if they are physically located in different territories, would conclude as commercial transactions. As a result, courts having territorial jurisdiction over the location of purchasers where transactions are concluded would necessarily be empowered to adjudicate on the aspect of infringement as well.

While adjudicating on this issue, the Court relied on V. Guard Industries Ltd. v. Sukran Raj Jain and noted that “once the Defendant has made its goods, or services, available for consideration online, it has, prima facie, purposefully availed the jurisdiction of the Delhi High Court taking a comprehensive stand regarding territorial jurisdiction over online infringement.

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Résumés

Dheeraj Kapoor, working as a Managing Associate with LexOrbis, has extensive knowledge and expertise in intellectual property laws, and specializes in handling diverse matters before the High Courts, Trade Marks Office and the Copyright Office, as well as advising on related laws. He also specialises in contentious issues pertaining to border protection and control measures, as well as enforcement. He is intricately associated with the legal research and publication team of LexOrbis and has authored many articles and papers in leading IP publications. Dheeraj advises many Fortune 500 companies, multi-national corporations, pharmaceutical companies, small- and medium-sized enterprises, and technology start-ups.

Vibhuti Sharma, working as an Associate with LexOrbis is well versed in handling Trademark prosecution and opposition matters. She has handled matters at all stages of prosecution before the Trademark Office and has also experience working on Custom matters, IPR record matters and drafting of agreements.
ONLINE INFRINGEMENT: JURISDICTION

Accordingly, the Court held that the Plaintiff had a prima facie case for infringement.

The defendant’s website was interactive and accessible to persons located within the Court’s jurisdiction, although relevant, was by itself insufficient. The Court emphasised that the predominant considerations in deciding the issue were whether the defendant’s website was interactive and whether it disclosed an overt intention to target the Indian market. Without an intention to target, the Court could not exercise jurisdiction.

The current case of Bvlgari SPA v. Notandas Gems Pvt. Ltd. throws positive light on territorial jurisdiction vis-a-vis online marketplaces and infringement of IP assets. In this case, the Court decisively pointed out the following factual position:

i. The Defendant’s website is interactive in nature if it permits commercial transactions to be concluded across the website. The courts having jurisdiction over their respective territories from where such commercial transactions can potentially be concluded and consummated, would also have territorial jurisdiction to adjudicate on a case of infringement.

ii. Once the Defendant has made its goods or services available online, it has, prima facie, purposefully availed the jurisdiction of Courts in all territories where such transactions can be carried out and consummated.

iii. There is a distinction between an interactive website which merely provides information and an interactive website across which goods or services can be purchased or availed for consideration. In the case of the former, it also needs to be shown that such information has been accessed by a person located within the court’s jurisdiction for the court to exercise its jurisdiction over the case. Whereas in the case of the latter where the website permits purchase of goods or services, the court of every place from where such goods or services can be purchased would, prima facie, have the territorial jurisdiction to deal with a case of trademark infringement.

In Tata Sons Private Limited v. Hatknamotata Tata Founders & Ors where the Court did not find the defendants’ intention to consciously target India as a potential market to have been prima facie established, the mere accessibility of the website in India was observed to be insufficient for the purpose of invoking the Court’s jurisdiction. The Court thus refused to grant an interim injunction to the plaintiff in that case. Interestingly, the only relevant differentiating factor in that case, also adjudicated by the same Judge of the Delhi High Court, was that the defendants weren’t located within India and were conducting infringing activities online from outside India. Whereas in the present case, the defendant was based in India and also carried out its activities within India. With the observations in the present case brand owners will now be better equipped to take action against online infringers and counterfeiters, if they can establish interactive presence of the infringing websites potentially leading to a commercial transaction in a jurisdiction of expediency.

We live in a world where, now, with a simple click of a button goods/services can be purchased at our doorsteps, and that too, from any part of the world. In those times, when a consumer sitting in Delhi can mistakenly order a counterfeit from some other part of the country without even having to step out of his or her house, establishing strong precedents in matters of territorial jurisdiction over cases of infringement is the need of the hour. Therefore, with help of this judgment, the Delhi High Court has made enforcement of IP laws against counterfeiters and infringers more accessible and practical for brand owners. This is a welcome move for the future of IP rights in an ecosystem of online businesses, which is expanding at a rapid rate.

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