

The Trademark

Issue 5 2022

GLOBAL REACH, LOCAL KNOWLEDGE

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Lawyer



A generation of counterfeit consumers: an interview with the EUIPO

The Trademark Lawyer sits down with Julio Laporta, Head of Communication and Spokesperson at the EUIPO, to discuss the findings of the latest survey that showed that one in two young Europeans have purchased counterfeits in the last year.

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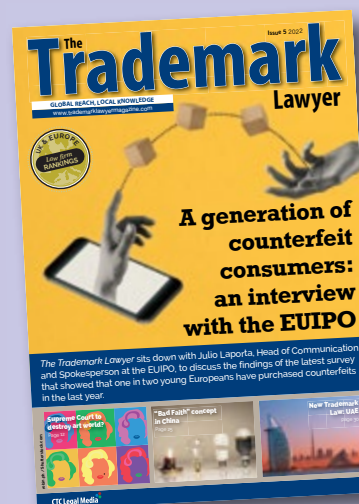
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Editor's welcome



Shocked by the finding that 52% of young Europeans surveyed admitted to buying at least one fake product online in the past year, we sat down with Julio Laporta, Head of Communications and Spokesperson for the EUIPO, to learn more. We discussed consumer trends between 2016-2022, the effects of peer and social influence on consumerism, and, among other aspects, what can be done to reduce the likelihood of consumers opting to buy counterfeit goods.

**52% of young
Europeans
surveyed admitted
to buying at least
one fake product.**

Find two timely updates on the enforcement of amendments to Article 4 of Chinese Trademark Law regarding "bad faith" applications. Understand the legislative procedure for the bad faith concept and CNIPA's special action that focuses on malicious trademark squatting, illegal interest, adverse social influence, and more.

Further, learn about forms of consent according to court evaluation; branding issues in the pharmaceutical industry due to the common practise of naming products in relation to their ingredients;

European trademarks and *force majeure*; understand the anti-counterfeiting measures available to trademarks in the Dominican Republic; who is liable when it comes to trademark infringement involving AI; and much more.

Our Women in IP Leadership segment features Patchen Haggerty, Perkins Coie, and Nidia Osorio, Nidia Osorio & Co. Contact us to feature in a future issue, or to learn more about supporting the segment.

Enjoy the issue.

Faye Waterford
Faye Waterford, Editor

Mission statement

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

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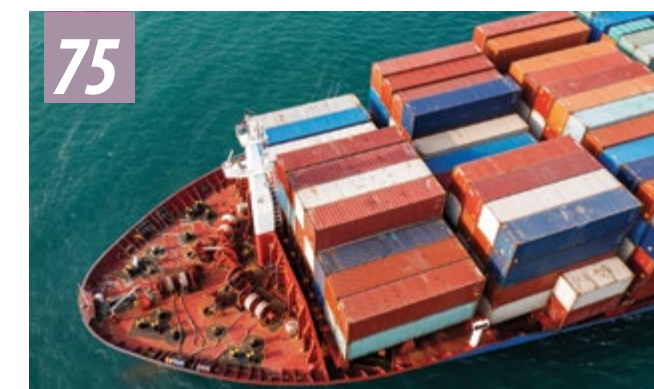
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Francesco has 20 years' experience in Italian and EU trademark and design prosecution. He has had successful cases in oppositions, appeals and cancellations both before the EUIPO and the Italian PTO. Studio Bonini, established in 1980, has its head office 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, CCPIT Patent & Trademark Office. China

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



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 as a marketing and advertising executive. Stacey is a devoted trainer of other lawyers, having educated more than 5000 lawyers on a variety of trademark and IP topics since 2018.



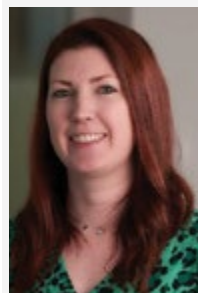
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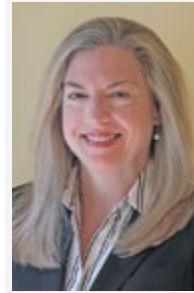
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Charlotte Wilding heads up the trademark practice at Wedlake Bell LLP. An expert in her field, she specializes in providing strategic IP advice, as well as the prosecution, maintenance, and enforcement of IP rights. Charlotte is also an active member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



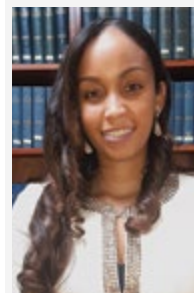
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Misum heads this full service law firm that works in diverse areas including IP. He has 18 years' trademark experience in registrations, dispute resolution and licensing. Misum, an alumnus of the University of London LLM programme, has advised clients for IP India, UKIPO, EUIPO, USPTO, IP AUS & CIPO. He is also currently Hon. VP at an academic non-profit. He has conducted guest lectures in some of India's top Law Schools. He has designed trademark courses, chaired seminars clocking 6K+ speaking hours, and trained 2.5K+ lawyers.



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Shelley is a lawyer and registered trademark agent based in Ottawa and a Fellow of the Intellectual Property Institute of Canada (IPIIC). 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 past 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.



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



Chris Mitchell - Member, Dickinson Wright. US

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



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.

The Trademark Lawyer would like to thank the Editorial Board for their time and support.



A generation of counterfeit consumers: an interview with the EUIPO

The Trademark Lawyer sits down with Julio Laporta, Head of Communication and Spokesperson at the European Union Intellectual Property Office (EUIPO), to discuss the findings of the latest survey that showed that one in two young Europeans have purchased counterfeits in the last year.

Can you start by telling us about the Intellectual Property and Youth Scoreboard and why the EUIPO decided to launch surveys in this area in 2016?

We wanted to create a study to investigate the perceptions and behaviors of young people regarding intellectual property. We launched the latest edition on the 8th of June 2022, coinciding with the world anti-counterfeiting day, through our Observatory on Infringements of Intellectual

Property Rights. One of the goals of this Observatory, which is part of the EU Intellectual Property Office, is to provide data and evidence about intellectual property and how much it contributes to society, and also to identify what damage not observing or respecting intellectual property is causing at all levels: at an individual level, company level, country or regional level. These are our primary goals.

Once we have this data, we give it to policymakers





Résumé

Julio Laporta, Head of Communication and Spokesperson, EUIPO

Julio Laporta has a law degree and an LL.M. (Master of Laws) in IP Law (Magister Lucentinus, Spain). Before joining the EUIPO, he worked in the private sector, first as an IP lawyer in a Barcelona-based firm and, then, as an in-house IP lawyer at Danone, S.A.

He joined the EUIPO in 2000 as an examiner taking decisions on trademarks and defending the EUIPO before the court in Luxembourg. In 2011, he became head of the Legal Practice Service, responsible for the update of the EUIPO's Guidelines for examination. In 2014 he was appointed deputy director of the Operations Department, the EUIPO's core business department in charge of the examination and registration of European Union trademarks and Community designs.

He was appointed Head of the Communication Service of the EUIPO in 2019.



Julio Laporta

so that they can launch new initiatives. We also share it with the stakeholders, with educational and academic organizations, with the media, and with society in general because, at the end of the day, what we want is to raise awareness as much as possible.

This Observatory is celebrating its 10th anniversary. The unit was created in 2009 and transferred to the EUIPO in 2012. Since then, we have been producing intelligence reports on a number of areas but more specifically this one on youth, which started in 2016. We carried out the study in 2016, 2019, and, the one we are now discussing, 2022.

We interviewed more than 22,000 youngsters across the 27 EU member states in order to understand what their relationship and interaction with intellectual property is. It is pertinent to have an investigation focused on this population because we identified at the very beginning that young consumers have a higher propensity and are more susceptible to buying fake goods or accessing pirated content, whether accidentally or intentionally. We are putting a spyglass on this community, observing to understand them, and then sharing the information so that everybody can take action against the consumption of fakes. Our goal is to raise awareness.

The key finding in what we've seen is that over half of the youth surveyed had bought at least one fake item during the last 12 months and 1/3

had accessed illegal content online intentionally or by accident. There is some good news, 60% of young Europeans said that they preferred to access digital content from legal sources, an increase compared to the previous study in 2019 which was only 50%. So, at least on that front, the youngsters' behavior is improving towards IP.

Between the three surveys conducted in 2016, 2019, and 2022, what trends and patterns have you identified in young consumers?

I would say there are three highlights; one which is negative, one neutral, and one positive.

The one that is positive we already mentioned, that the tendency and interest in accessing legal content online has risen from 50% in 2019 to 60% now. Youngsters prefer to access legal content, or at least when accessing products and services such as films, programs, and music.

The second highlight is negative. We have seen an increase in the intentional buying of fake products by young people, from 14% in 2019 to 37% in 2022. That's almost triple.

The last highlight is neutral: the percentage of those admitting intentionally accessing online pirated content in 2019 was 22%, in 2022 it is 21%. This very slight improvement tells us that we need to keep on focusing and investing efforts to reduce this further, but it has not increased which is important.

Why is this research important for the IP industry and what can the findings lend to the protection of IP?

It's this spyglass effect. These reports provide some objective data for intelligence and insights that, once obtained, can shed light on all these elements. Then the stakeholders can take action. This sound data can be a driving force for the protection of IP by proving its importance to businesses.

For example, from this new scoreboard, we can see that a third of youngsters find it difficult to distinguish legal content from pirated content. So, those that provide legal content need to find ways to make this more visible, to devise communication actions to make people care. They can do this by forming a narrative about what the problems with accessing pirated content are.

There is a positive narrative, saying that IP industries bring value to the economy, generating 670,000 jobs in the European Union every year. Companies can point out that consuming fake products is destroying jobs.

We have also noticed that there are connections between IP crime and organized crime. For example, organized crime groups use the funds made through pirated content and counterfeit

goods to fund other illegal activities. Working together with Europol, we have established links with drug trafficking, money laundering, and even terrorism. IP crime is not a victimless crime, other large crimes are taking advantage of this. This can have a huge impact on society.

Depending on the angle, these reports can help to bring or strengthen a narrative for a movement against counterfeits.

Also, because the youngsters are the future, it is not only the awareness of the damage that buying fakes can cause that is important but also the awareness of IP protection itself, as they are going to be the next creators. They are going to be the ones building the new startups so they need to be aware that there is a system that will protect their efforts. When they do create, there will be a legal framework and they will feel sustained by that.

52% of Europeans surveyed aged between 15 and 24 said they had bought at least one fake product online over the past year, either intentionally or by accident. Did this come as a shock to the EUIPO? Why do you think this percentage is so high?

It was certainly a shock and not good news. It is alarming that one out of two young Europeans bought a fake product. We believe that this relates to the large increase in online shopping during the pandemic. We know there was a surge in online shopping and eCommerce as of the year 2020. This is good in general terms, but when the market grows this also means that the bad side of the market grows. Whenever there is a huge market opportunity, the 'bad guys' in the IP industry will take advantage.

How can peer and social influence affect the purchase of counterfeit goods by young consumers? Are there measures that can be put in place to overcome these aspects?

One of the elements of this survey, which was not that visible in the previous surveys, was that we asked what the drivers were for choosing counterfeit goods over legal goods. The first driver is the cost, 48% said they purchased fake products because they were cheaper. But we know most fake products will be low quality or have limited functionality.

We also notice that peer and social influence has gained ground quite dramatically. Some of those surveyed referred to their interactions with social platforms. Social platforms offer many benefits but there is a niche there for people to promote fake products very easily. There are even influencers who openly promote counterfeit goods. We think this has an impact on the second factor for purchasing counterfeit goods, which we identified as a lack of concern.

“
Another
of our
initiatives
is building a
blockchain
structure.”

”

The third reason was that they can't find a difference between one or the other and that it's very easy to access these products.

This social influence, where friends, family, and influencers have purchased or accessed counterfeits, is very impactful. The fact that others are doing it so openly gives the impression that nothing bad will happen if they do it too.

What were the greatest differences highlighted by the survey when comparing a pre-pandemic and post-pandemic climate?

Eurostat figures tell us that 70% of internet users shopped online in 2020, so they now buy more online than before the pandemic.

We have conducted studies focused on online commerce and identified a surge in fake products online. We have also identified that these purchases often come in small parcels which are more difficult for customs to detect.

It is all connected. The pandemic brought more eCommerce, eCommerce encouraged more fake products that are, in turn, harder to detect through customs. Now that we know this, we can start to create strategies to counteract this problem which is what we are trying to do.

Do you anticipate that the purchase of counterfeit goods will continue to increase?

I'm afraid we don't know. We believe we know what has provoked the current scenario, so we need to take action to avoid this growth considering the current landscape. We need to monitor online commerce, be aware of these small parcels, and collect more data to stop the problem.

How can IP owners work to combat the purchase of counterfeit goods when 37% of Europeans surveyed aged between 15 and 24 said they purchased the counterfeit goods intentionally?

We need to work altogether. It's not that the IP owners are not playing their part, they are, or that the IP Offices are not doing their job, it is rather the contrary. We need to work together in the same direction.

This is precisely the goal of the Observatory of Intellectual Property Rights here at the EUIPO, to connect all the networks. For example, one of the things that we are doing is enforcing IP rights with tools and knowledge sharing. We have created a database, an online portal, which is called the IP Enforcement Portal¹, this is a site where IP owners can upload their rights and this information is available to police and customs. When officials detect something at the border, they can access this portal and identify, in an easy manner, if a product which is crossing the border is fake or not. Because we know the landscape, we can put it all together and develop tools.

¹ <https://www.ipenforcementportal.eu/>



Another thing we are doing is providing training: we are organizing webinars, workshops, and training activities on enforcement for customs officials, enforcement officials, and the police across the European Union.

We are also working with educational institutions, such as primary and secondary schools and teachers. We have a program, IP in Education, in which we produce materials in all European languages to serve to our network of stakeholders, including ministries of education, so that they can give this education and address this problem directly with the youngsters.

We are, and this is very interesting, starting a collaboration with major eCommerce platforms because it is also in their interest not to sell fake products. They do not want to be part of the problem because, of course, their clients do not want to be misled. There is a page on our website where we list all of the platforms we are working with and what actions they are taking. We provide them with intelligence information, and we are creating application programming interfaces (APIs) for us to connect our official register with their onboarding programs for new products or new traders precisely to make the landscape clearer and counterfeit-free for everybody.

Another of our initiatives is building a blockchain structure. We launched a competition to build an anti-counterfeiting infrastructure using Blockchain², the winner is now developing a proof-of-concept tool to fight against counterfeits which would also include an NFT platform to organize products. We are moving our databases and registers onto the blockchain so they can be connected to any other activity or anybody who is willing to rely on official sources of information on IP registered rights.

What do you think the IP community can do to help reduce the likelihood of young consumers buying fakes?

What we need to do is talk to them. We need to go out to raise awareness. It is not easy. We need to work together at all levels, those in the industry need to play their part, as do the general press and academic institutions too. We need to work together with the same simple message: if somebody creates something, that person deserves a reward.

I have a teenage son and I tell him, 'If you've been studying hard for your tests, do you want somebody to copy your test and benefit from doing so? No! That's exactly the same thing we are trying to avoid here!'

And we need to break the narrative that it's only affecting big players that make huge profits because 95% of companies in the industry worldwide are SMEs. They need to be cared for with the message *invest because we will be there to protect you*.

“
One of the things that we have seen is the tendency to prefer legal content. We need to nurture this so that it becomes more widespread.
”

Last year we managed to reinstate IP crime as one of the top 10 priorities in the fight against serious and organized crime and Europe (the so-called EMPACT priorities). Every four years, the Council of the European Union decides on 10 priorities, and each priority receives assistance with funding for tackling organized crime at an EU level.

How can the hopeful findings be utilized to help reduce counterfeit goods and content in the future?

One of the things that we have seen is the tendency to prefer legal content. We need to nurture this so that it becomes more widespread. The wider availability of digital content from legal sources has surely been behind this growth of preference for accessing legal content. Affordability, variety, and easy access are always driving factors.

We also asked what would make them think twice before buying or accessing something illegal, they said the risk of cyber fraud and cyber threats. If they are aware that credit card data or identity can be stolen, or that their computer can be broken or hijacked when they purchase something illegal online, they would think twice.

There is also a negative impact on the environment because not a single product that is counterfeited respects any sort of standard or rule, not to mention that there are risks of damaging their bodies and their health if they buy fake cosmetics or pharmaceutical products as there are no standards in place for counterfeits.

For stopping fakes, the main deterrent is finding affordable products or consumers having bad experiences with fakes, which often happens. One of the things that we are doing in order to remedy, or counterattack this is spreading these messages on social media. We're collaborating with influencers to pass the positive message because you must be on the same playing field as the youngsters!

² <http://blockathon.eu>

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Is the Supreme Court ready to destroy the art world?

Alain Villeneuve, Partner at Duane Morris, examines “transformative v. derivative” aspects of copyright law that may be about to riddle the works of the US’s most famous artist with license-violations.

My law school teacher once cautioned that Copyright Law was by far the most complex of the three main intellectual property areas (patent, trademark, and copyright). As a patent attorney, it took me decades to finally share his belief. In the fall, a fight is primed over some of the world’s most famous art, prints by Andy Warhol of famous celebrities. The Supreme Court could easily destroy most of the visual art world, leaving it to Congress to amend the Copyright Act.¹

The hardest Copyright cases are the rare ones facing two fantastic artists, each worthy of praise. In the battle of “transformative v. derivative,” a first artist (Artist A) creates a work and a second artist (Artist B) takes “inspiration” and creates a new work, which leverages/uses the first artist’s work. Under the complex rules, if the work is “derivative,” Artist A wins all the



Alain Villeneuve

marbles, forcing Artist B to beg for a license. If the work is found to be “transformative,” Artist B collects, forcing Artist A to weep as they cash in from the work. This is always a hard and bloody fight between two very deserving parties. The Supreme Court created a body of rules relating to “fair use defense”² rather unique to visual arts that allow judges to determine if the work is derivative or transformative.³

Marilyn Monroe (born Norma Jeane Mortenson) died on August 4, 1962. At the height of her career, she starred in the movie “Niagara” (1953), which published the portrait (above right).

On the year of her passing, the pop icon Warhol⁴ painted silkscreens inspired by the blond bombshell. Warhol used what is known as the “Niagara Advertisement” as a base only to produce five Marilyn silkscreen portraits, each with different colored backgrounds: red, orange,



The 1953 “Niagara” Advertisement

light blue, sage blue, and turquoise. He never asked anyone (even the photographer) for a license. Amusingly, artist Dorothy Podber saw four of the five paintings stacked in a studio and asked if “she could shoot them.” Warhol, believing that she intended to photograph them, agreed. Podber pulled a small revolver from her purse and fired a shot into the stack. These became



Four of the Five Marylins

Résumé

Alain Villeneuve, Partner

Villeneuve practices in the area of intellectual property law, assisting clients across a wide array of industries. He is also a British Solicitor. He routinely handles patent and trademark registration, monitoring and defense efforts, and online brand and patent enforcement, including litigation. Villeneuve has represented clients before enforcement boards, including the USPTO’s Trademark Trial and Appeal Board and the World Intellectual Property Organization. A former nuclear and aerospace engineer, Villeneuve is experienced in drafting and litigating patent applications and patents in a number of fields, including mechanical, electrical, wireless and computer software.

known as “The Shots Marylins,” a legacy of the performing art period. Only the turquoise remains undamaged.

In the spring of 2022, as the focus on new NFTs began to fade, the “Shot Sage Blue Marilyn” sold for \$195 million, the highest price achieved for any American work of visual art at auction. Warhol’s work remains core to the US art world, and must be protected, in the same way as a work by Picasso.

Like many artists, Warhol did not draw the original image of Marilyn from memory, he grabbed an image and used it without so much as an obligation for proper attribution.⁶ In 2016, a similar story surfaced. Warhol created what is called “Purple Prince.” Unlike the Marilyn portrait, this time the author of the photograph took issue.⁷



“Shot Sage Blue Marilyn” at Auction⁵



¹ *Andy Warhol Foundation for the Visual Arts, Inc. v. Lynn Goldsmith, et al.*, (Case 19-2420), Cert. granted Mar 28, 2022.

² 17 U.S.C. § 107

³ *Stewart v. Abend*, 495 U.. 207, 236 (1990).

⁴ Famous, for example, for paintings of a Campbell’s tomato soup can arguably reproducing a copyrighted image in his earlier works.

⁵ The author notes how the above image reproduces the “Short Sage Blue Marilyn” and is being reproduced under the fair use rights and other complexities afforded by the Copyright Act.

⁶ The right of attribution (e.g. the right to claim authorship) by a photographer was born from Article 6bis(1) of the Berne Convention for the Protection of Literary and Artistic Works. It was given to authors as part of The Visual Artists Rights Act (“VARA”) at 17 U.S.C. § 106A. The Copyright Office has acknowledged this problem very recently and has concluded that “any tentions between potential statutory moreal rights protections and the fair use doctrine can be overcome through proper calibration of any statutory framework.” U.S. Copyright Office, Authors, Attribution, and Integrity: Examining Moral Rights in the United States, III.A.2 (Report of the Register of Copyrights, April 2019).

⁷ *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, No. 19-2420 (2nd Cir. 2021) reversing *Andy Warhol Foundation for the Visual Arts, Inc. v. Goldsmith*, No. 1:17-cv-02532 (Judgment July 15, 2019).



The original picture from Lynn Goldsmith was shot in December 1981, for use by Newsweek magazine and is reproduced below next to the "transformative or derivative" work.



Goldsmith Picture v. Warhol Work

Relying on decades of favorable precedents, the Andy Warhol Foundation moved to dismiss the photographer's claim of ownership under derivative rules finding the work was indeed "transformative."

Ignored mostly by the litigants is the issue of the type of visual art involved, a "portrait." Historically



A Possibly Derivative Picasso

“The test, after all, is very vague. In theory, the better the portrait artist, the closer the reproduction and the least amount of rights granted.”

almost every painting, every landscape, every portrait is based on some model or visual scene. Some artists travel to foreign countries to fix to canvas their images. Picasso in 1905 dressed children to create "Acrobat and Young Harlequin." (See below left).

In 1905, artists rarely had pictures of subjects and were forced to pay subjects to sit and stand still for hours. Today, because of technology, an artist can flip a book open, find a picture of the subject and begin painting. Copyright Law, when read simply, provides that taking someone's image and simply adding color to it creates a "derivative work," which is a work based upon one or more preexisting works, and such art reproduction or any other form in which a work may be recast, transformed, or adapted requires a license from the original author.⁸

The author of the underlying piece retains a copyright in the newly created derivative work and even keeps rights of attribution.⁹ But the fair use test, a four-prong test, has left district courts and appeal courts at a disadvantage when facing creative advocates. Slowly, more and more works have slid from the "derivative" to the "transformative," away from the hands of the initial visual artist.¹⁰ The test, after all, is very vague. In theory, the better the portrait artist, the closer the reproduction and the least amount of rights granted. For example, five years later, Picasso's "Girl with a Mandolin" uses cubism and easily qualifies as transformative, giving Picasso all rights.

If the Supreme Court upholds the 2nd Circuit Appeals Court, half of Warhol's works and half of Picasso's works are simple derivative works infringing when copied. The 2nd Circuit looked at all four factors and concluded that, unlike the district court which found one of four prongs to favor the original artist, all four favored the photographer. "But here, given the degree to which Goldsmith's work remains recognizable within Warhol's, there can be no reasonable debate that the works are substantially similar [and thus not transformative]."¹¹ Said politely, certain types of art are too close and look too much like the original.

Under the current standard, a new piece is transformative if it adds something new by altering the source material with new expression, meaning, or message.¹² Truth be told, the distinction (e.g., derivative or transformative) is not part of the Copyright Act, and in fact the term "transformative" is absent from the law.

This set of rules is so strange. Keep in mind the original photographer of the Marilyn black-and-white not only saw his rights sail away but is now infringing the new work by Warhol if he dares to add pastel color to his own work (as the transformative work has infringement rights).¹³



A clearly transformative Picasso

Truth is, the biggest support for the transformative defense is one based on a longstanding recognition that rigid application of the copyright statute would "stifle the very creativity which that law was designed to foster."¹⁴ The Copyright Law as written can be an obstacle to creation, not a tool to foster and protect creation. Walking into most stores where products are sold, in today's design world, it is difficult to imagine how anyone can produce any product without some level of inspiration.

The District Court held that the Prince series "can reasonably be perceived to have transformed Prince from a vulnerable, uncomfortable person to an iconic, larger-than-life figure."¹⁵ The 2nd Circuit did not agree. It concluded: "the secondary work's transformative purpose and character must, at a bare minimum, comprise something more than the imposition of another artist's style on the primary work such that the secondary work remains both recognizably deriving from, and retaining the essential

“Ignored mostly by the litigants is the issue of the type of visual art involved, a “portrait.”

elements of, its source material."¹⁶ Multiple *amici curiae* briefs have been filed, all to reverse the 2nd Circuit and return to calmer times.¹⁷

Today, the US Supreme Court must decide nothing less than the creative license of the most famous US artist. It will decide if the art of Warhol, now valued at \$195 million a piece, is riddled with license-violating derivative works.

This author's humble opinion

Once in a while, a case reminds us certain judicial precedents slowly erode a legal principle beyond recognition to a point where a discussion is difficult to follow. A door, barely ajar to let fumes out of the kitchen, now permits the cat to walk in and eat the food as the cook demands more and more cooler, fresh air.

Fair use, as codified by 17 USC, § 107, really is only "fair use." When Warhol took the portrait of Prince, it was only as a base, a template, as the start of the process of inspiration and creation the same way every single painter has done since the Middle Ages.

Three prongs of the test clearly favor Warhol: At prong (1), the purpose and character of the use is simply inspiration and not to sell the photography itself. The nature of the copyrighted work favors using a template base as portrait as Courts, as part of the "nature of the work" (2) prong, have given greater scope of fair

⁸ 17 U.S.C. § 101.
⁹ 17 U.S.C. § 103.
¹⁰ 17 U.S.C. § 107. "(1) the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes; (2) the nature of the copyrighted work; (3) the amount and substantiality of the portion used; in relation to the copyrighted work as a whole; and (4) the effect of the use upon the potential market for or value of the copyrighted work."
¹¹ Id.
¹² *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. 569 (1994) (A work is 'transformative' when it conveys a different meaning or message from its source material).
¹³ 17 U.S.C. § 107 ("Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright.")
¹⁴ *Campbell v. Acuff-Rose Music, Inc.*, 510 U.S. at 577 (quoting *Stewart v. Abend*, 495 U.S. 207, 236 (1990)).
¹⁵ Warhol, 382 F.Supp.3d at 326.
¹⁶ *The Andy Warhol Found. for Visual Arts v. Goldsmith*, 992 F.3d 99, 114 (2d Cir. 2021)
¹⁷ Copyright Law Professors, Barbara Kruger and Robert Storr, Art Law Professors, The Robert Rauschenberg Foundation, Roy Lichtenstein Foundation and Brooklyn Museum.

use to "factual" works over "creative" works.¹⁸ While yes, the amount and substantiality of the portion used is the entire face (3), the effect of the use upon the potential market for or value of the copyrighted work only favors the photographer (4). Here, the photographer can sell the original black-and-white picture with a warning: "Image used as the base for Warhol's 'Purple Prince,' get one for \$300."

But it is possible, if not likely, that the Supreme Court is growing tired of asking judges to play art critics and will take a harder line. What a judge thinks of a fair use defense should not determine who owns a copyright in any given work. Very simple solutions can be enacted by Congress to clarify the Copyright Act. An express definition of "transformative works" can be added to 17 USC. § 101.¹⁹ Congress could simply create a mandatory licensing process for any derivative and transformative work of X% of the commercial value to be paid. Congress could simply write into the fair use clause a revision giving artists the base they always had to create.²⁰

This author believes the Court, wishing to return lawmaking power to Congress, may well decide against the Warhol Foundation and narrow the fair use defense to extreme cases where the identity of the final work greatly differs from the initial work.

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¹⁸ *New York Times Co. v. Roxbury Data Interface, Inc.*, 434 F. Supp. 217, 221, 194 U.S.P.Q. 371 (D.N.J. 1977). See also *Compaq Computer Corp. v. Ergonome, Inc.*, 387 F.3d 403, 410, 72 U.S.P.Q.2d 1705 (5th Cir. 2004); *New Era Publns. Intl. v. Carol Publ. Group*, 904 F.2d 152 (2d Cir. 1990) ("the scope of fair use is greater with respect to factual than non-factual works").

¹⁹ Proposed text: A "transformative visual work" is a work based upon one or more preexisting works, such as a translation, musical arrangement, dramatization, fictionalization, motion picture version, sound recording, art reproduction, abridgment, condensation, or any other form in which a work may be recast, transformed, or adapted in a way where the economical or artistic value of the newly created work is superior or appeals to a different consumer segment than the value of the original work(s).

²⁰ Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phonorecords or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, or for the creation of visual arts when a factual image of the same is available to the artist and is not an infringement of copyright.



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Liability for trademark infringement involving artificial intelligence

Gabriele Engels, Counsel at DLA Piper, questions infringement liability for AI processes, such as grocery delivery item replacement.

In light of the UK's policy paper on AI regulation being unveiled this summer and the EU's continuing efforts to tackle the same question, it is time to examine the status quo of AI liability, especially regarding trademark infringements. This article examines the existing liability regimes as well as the case law on trademarks and analyses their suitability for AI systems. In doing so, two sources of possible trademark infringements are illustrated; AI-assisted grocery delivery services and the EUIPO's image-based trademark search tool "eSearch plus".

What is AI?

As a uniform definition does not exist, the term "artificial intelligence" (AI) is used inconsistently to describe various applications associated with human intelligence. Generally, AI systems can be classified as such if they are "capable of learning", comparable to the problem-solving and decision-making abilities of the human mind. One of the most important capabilities of AI systems lies in the recognition and classification of patterns and rules in data sets. The characteristics of an AI application are then further defined according to (i) the functions it pursues and (ii) the environment in which it operates. Everyday examples range from facial recognition software for smartphones, over Google Maps, to the algorithms which prompt suggestions for search queries.

Legislative approaches

A decision is currently being made at the EU level as to whether the adaptation of existing liability rules is sufficient to address the newly arising challenges posed by AI or whether the



Gabriele Engels

“Instead of the universally applicable, risk-based approach which addresses all AIs, the policy paper suggests a sector-based approach.”

introduction of an AI-specific liability regime is necessary. The proposal for a Regulation on Artificial Intelligence¹ contains a broad definition of AI as a software-based technology that generates an output based on interactions with its environment. This AI Regulation then distinguishes between four risk categories: Unacceptable, high, low, and minimal risk. Low and minimal risk AIs, such as chatbots or spam filters respectively, are not subject to any special obligations and must only comply with transparency requirements. By contrast, systems with an unacceptable risk (often deployed in scenarios in which fundamental rights are significantly affected, e.g., facial recognition programs that use real-time biometric data for law enforcement purposes) are prohibited entirely. The focal point of the Regulation, however, lies on so-called high-risk AI systems, which must meet strict requirements. Examples include security components contained inside other products (e.g., drones).

This purely risk-based approach, which operates independently from fault, automatically triggers the obligation to comply with specific requirements aimed at preventing rights violations when operating AI systems or placing them on the market. However, the AI Regulation does not address particularly relevant questions surrounding intellectual property rights and liability, especially where an AI is the actual perpetrator of such infringements. These include evidentiary issues such as proving the existence of a defect in intangible products, as well as a causal link between such a defect and a harmful outcome. Similar difficulties arise around the identification of the potentially liable party and proving fault.

By comparison, the UK has made use of its new-found autonomy in a post-Brexit world and released a policy paper outlining its own approach to AI regulation on 18 July 2022². This stands in stark contrast to the approach offered by the EU. Instead of the universally applicable, risk-based approach which addresses all AIs, the policy paper suggests a sector-based approach which delegates regulation responsibilities to the individual industry sectors. The danger of multiple, highly divergent, or even unintentionally overlapping regimes shall be mitigated by the implementation of overarching core principles related *inter alia* to transparency, security, safety, and fairness.

Liability for trademark infringements

Despite innovative approaches, existing liability regimes as well as the planned legal reforms insufficiently address the issue of liability of AI systems regarding trademark infringements. In practice, one quickly encounters various concerns, especially of an evidentiary nature.

These issues are rooted in the situation-specific, unpredictable behavior of AI, its constant adaptation, and the opacity of its decision-making processes, to name but a few characteristics. The more autonomous an

“Where competitors have actively instructed the AI-based algorithm to suggest their alternative products, they are likely to be primarily liable for the possible trademark infringement.”

AI system behaves and the more comprehensive the decision process is, the more difficult it becomes for the injured right holder to determine the responsible party. It is virtually impossible for an average consumer to comprehend how these complex systems operate, let alone prove that an error in the AI caused the damage. These difficulties intensify where various AI systems are involved or a single infringement has several possible causes, e.g., faulty programming of the AI as well as incorrect data entry by the user.

1. What do the Courts say?

Due to the sheer number of new apps and AI programs appearing seemingly daily, one could assume that the courts have not yet had the opportunity to address the issue at hand. However, courts have dealt with trademark infringements committed by AI in numerous cases. Above all, these decisions were rendered in the context of so-called keyword advertising.³

These cases revolve around complex, AI-based algorithms which provide users with search results based on pre-set keywords, usually based on specific brand names. Upon entering these brand names into the search engine, the user is presented not (only) with the

¹ COM (2021) 206 final v. 21.04.2021 - "AI Regulation"

² <https://www.gov.uk/government/publications/establishing-a-pro-innovation-approach-to-regulating-ai/establishing-a-pro-innovation-approach-to-regulating-ai-policy-statement>

³ e.g. CJEU, C-236/08-C-238/08, 23 March 2010, Google France; High Court of Justice (Chancery Division), [2014] EWHC 181 (Ch), 10 February 2014, *Lush v. Amazon*.

Résumé

Gabriele Engels, Counsel

Gabriele is a German IP specialist lawyer with over 10 years' experience in advising on strategic orientation, enforcement and defense of her client's brands and rights. She has wide experience in relation to trademarks, in particular with regard to internet-related issues, including domain name disputes and use of digital content. She has also wide experience in licensing and other IP related agreements as well as advertising and marketing law.



products sold by the rights owner of the brand, but with a list of results for alternative, competitor products, offers from third-party sellers or advertisements linked to such third-party products.

In general, service providers on the internet such as Google and Amazon are only secondarily liable next to advertisers, if they do not play an "active role" in the infringement. An active involvement can be affirmed where the service provider participates in the selection of the keyword or the design of the advertisement. However, even without active participation service providers are obliged to cease and desist in cases of obvious trademark infringements or where they have knowledge of the concrete illegality of the content. Additionally, they may be held liable for damages if the content is not immediately removed or blocked.⁴

Where the algorithm is designed by the platform operator and used to push the platform's own products, the search results are generally attributable to the service provider as its own trademark infringement making it primarily liable.⁵ This does not mean that the use of third-party signs as keywords is generally prohibited, however, certain measures must be taken to avoid committing a trademark infringement. For instance, it must be ensured that the advertisement which is coupled with the search term is unequivocal regarding the economic origin of the advertised products.⁶

Generally, the party responsible for the selection of the displayed advertisement or search results, is considered the infringing party. If this selection is made by an algorithm that is operated and controlled by a platform, (perpetrator) liability for the infringement lies with the platform. If the selection is actively made by an advertiser (as in the case with classic keyword advertising), primary liability lies with the latter. The service provider is liable as a secondary infringer if it abandons its role as a "neutral intermediary", i.e., if it had knowledge of the infringement and made no reasonable efforts to end it.

2. When does this become relevant?

But do these decisions by EU and UK courts provide an answer to the essential questions surrounding AI liability for trademark infringements? With AI increasingly creeping into every aspect of our lives, have attribution, causality and evidentiary issues been sufficiently resolved?

Grocery delivery services

As everyday life grows more hectic, certain chores are increasingly outsourced to digital services. For this reason, the likes of Sainsbury's

“Due to the sheer number of new apps and AI programs appearing seemingly daily, one could assume that the courts have not yet had the opportunity to address the issue at hand.”

⁴ CJEU, Google France, loc. cit.

⁵ see High Court, Lush v. Amazon, loc. cit.

⁶ CJEU, C-323/09, 22 September 2011, Interflora.

⁷ High Court, Lush v. Amazon, loc. cit.

⁸ See also: Resolution of the EU Parliament of 20 October 2020 with recommendations to the Commission on a regulation of civil liability in the use of artificial intelligence (2020/2014(INL))

and Waitrose have been delivering the weekly shopping of households all over the UK for years. Additional competitors, such as Getir and Gorillas, have since joined the fray, making on-demand grocery delivery a fast-growing industry. A few clicks in an app allow the user to select specific products from specific brands which are then delivered straight to their front door.

Such innovation becomes relevant under trademark law if the AI-technology embedded in the software decides to offer a similar product from a different brand as an alternative to what the user initially searched for, e.g., soap from another manufacturer or brand instead of "Lush" products when prompted with the search term "Lush".⁷ This scenario could arise in the context of grocery delivery, for example, when the user's preferred ice cream brand is sold-out and the app chooses ice cream from another brand to be delivered as a replacement.

Presumably, the AI processes involved operate with the aid of databases equipped with recognition patterns and responses, similarly to other smart technologies. The question arises whether the AI embedded in the process works this way independently or whether it was programmed to do so.

To provide an answer, one can look to the ratios of the decisions mentioned above and transfer them to the issue presented by grocery delivery services. Where an AI-based search program is prompted with a specific brand, yet displays alternative products, the way in which these products are presented will be crucial in ascertaining whether a trademark infringement has been committed. Particularly decisive is whether a reference was made to the trademark proprietor's products. To avoid trademark infringement, measures should be taken to prevent a user from assuming that an economic relationship exists between the manufacturer of the (alternative) product and the trademark owner.

The attempted order of "Lush" soap which is followed by the notice that products of this brand are not available, coupled with the question whether alternative suggestions from other manufacturers or brands are desired would be an example of an instance where a trademark infringement could be negated.

Additionally, the question remains regarding whether the AI independently chose to act in this way or whether the algorithm was programmed to advertise third-party products from the outset. Where competitors have actively instructed the AI-based algorithm to suggest their alternative products, they are likely to be primarily liable for the possible trademark infringement. If the AI has independently decided to suggest an alternative product, the infringement could be attributable to its operator.



William Barton / Shutterstock.com

AI-based trademark comparison tool

Furthermore, AI programs used in trademark searches could also be considered "infringers". Consider the EUIPO's own image search engine as part of its "eSearch plus" tool. After uploading an image, the AI technology browses through its database of trademarks and produces a list of any trademark it deems similar to the uploaded image. The results of such a query are presented in order of trademark number without the tool determining how high their similarity is. The search results can then be evaluated by a lawyer with specialized knowledge.

It is no difficult feat to envision this process being transformed into a fully autonomous system, with the program replacing the lawyer's assessment by not only researching similar trademarks, but also conclusively assessing them. A party interested in registering a new trademark and wanting to ensure that the envisioned logo is not already protected by someone else, might upload a drawing or rendering of the design and search the database. The EUIPO eSearch plus tool would then present a selection of similar trademarks along with an assessment of the degree of similarity.

“Who is liable if the AI system makes an incorrect assessment?”



This scenario raises questions in particular surrounding risk distribution: Who is liable if the AI system makes an incorrect assessment, as a consequence of which a trademark is registered, used and infringements occur?

Depending on the arrangements in the contract between the service provider of the search tool software and the user, the service provider might be liable insofar as a clause determines that the evaluation provided by the AI is reliable. Insofar as liability has been expressly excluded (to the extent permitted by law), the user may well be liable for the trademark infringement. If the contract does not include a liability distribution clause, the service provider is likely to be at fault for the infringement, as the party responsible for the evaluation of the search results.

3. What are potential solutions?

Although existing jurisprudence offers some starting points as to how trademark infringements and AI can be dealt with, the approaches set out therein are unlikely to do the increasingly complex, interactive processes justice.

Establishing presumption rules which ease or even reverse the burden of proof in favor of the



injured party could solve the problem of proving causality.⁸ Regarding risk distribution, a differentiation could be made between developers, operators, users, and injured parties according to the type of AI and the degree of autonomy the system has. Increasingly automated processes mean that users have less influence over the actions and outcome of AI. This should be reflected in liability regimes.

Insofar as the user's input can only influence the output of the AI to a limited degree, liability for unforeseen damage should not be imposed on the user, but on the operator or developer (presumed fault with possibility of exculpation). To the extent that the user retains some influence over the AI system and/or does not exercise this influence with due care, he would be held liable.

Due to the implicit issues of proof, establishing joint and several liability of the involved parties (if necessary, according to causation contributions) is probably preferable from the trademark owner's perspective.

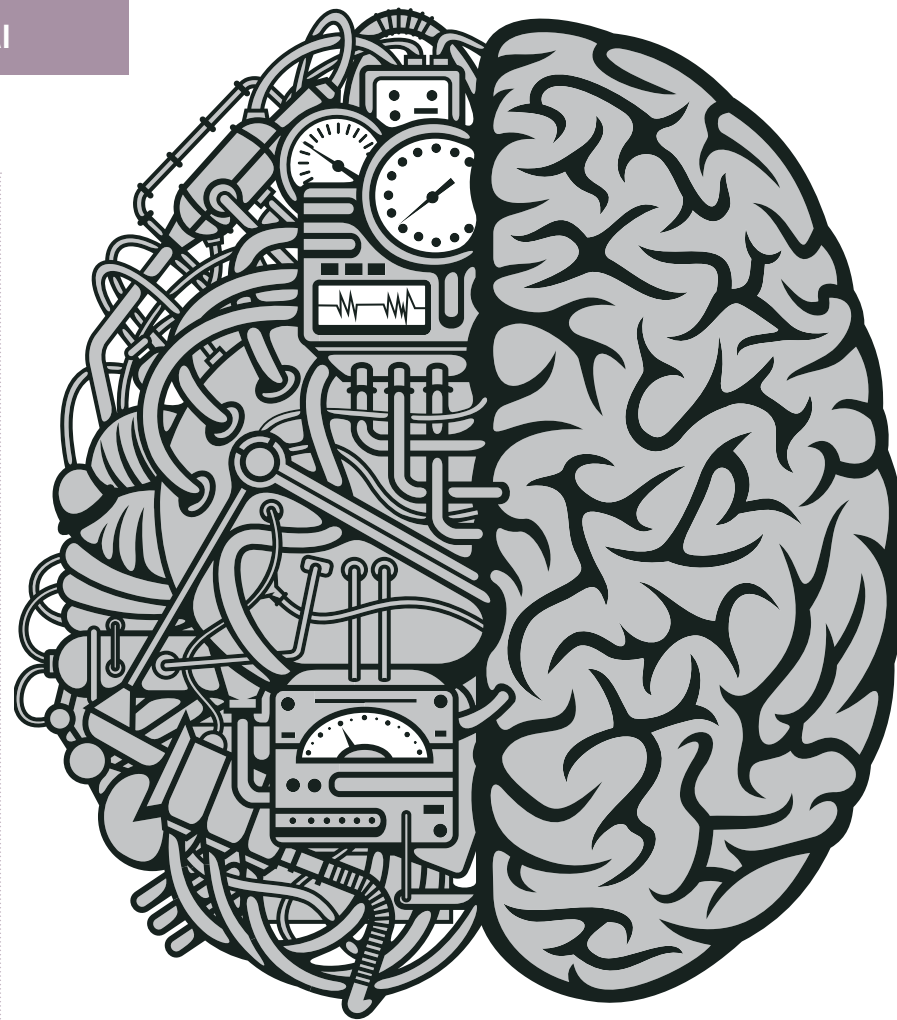
Additionally, introducing strict liability for AI systems with the significant potential of causing damage, i.e. high-risk AI, could be considered. The creation of such strict liability for operators could prevent the emergence of attribution and liability gaps. In this respect, the introduction of a compulsory insurance for AI operators is also conceivable.

Conclusion and Outlook

After an evaluation of the consultation results, the adoption of a separate AI liability regime by the EU Commission is planned for the third quarter of 2022. Until then, the general liability principles will continue to apply.

As can be deduced from the jurisprudence, EU and UK courts generally want to place liability with the party that predetermines the specific result of the AI system. This can be the individual advertiser who predetermines which search terms will trigger their specifically designed ad. It could also be the platform operator who uses an algorithm to his advantage, which is independently capable of causing an infringement. Until a more tailored liability regime has been developed, this approach offers an acceptable risk allocation.

Regarding the use of AI within a business context, the most effective protection against liability and the costs of claims is contractual arrangements addressing liability distribution. These should be negotiated with AI developers as well as with third parties who otherwise influence the AI system. In the absence of specific regulations, the nature of the AI and its exact functioning should be stipulated in an agreement, i.e. whether it is fully autonomous or semi-autonomous. For semi-autonomous systems, it



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For semi-autonomous systems, it should also be specified whether there is a significant degree of human control and the importance of this control.”

should also be specified whether there is a significant degree of human control and the importance of this control.

In view of the opacity and unpredictability of AI and the EU's risk-based approach, measures protecting the injured party should be included in a new EU-wide liability regime. This should provide, facilitations of proof up to a complete reversal of the burden of proof in favor of the injured party. Special regulations for certain types of high-risk AI and joint and several liability of the involved parties can also contribute to closing liability gaps for possible trademark infringements committed through AI systems.

"This article does not consider the EU Commission's "Proposal for a Directive of the European Parliament and of the Council on liability for defective products" (COM(2022)495) and the "Proposal for a Directive on adapting non contractual civil liability rules to artificial intelligence" of 28 September 2022, complementing the revision of the Product Liability Directive.

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The evolution of "Bad Faith" concept in China

Mr. Yimeng LU, Trademark Attorney at Beijing Sanyou Intellectual Property Agency Ltd., reviews the updates to Article 4 of the Chinese Trademark Law that enforced the regulation of "bad faith" trademark applications.

In the second decade of the 21st century, the number of trademark applications in China has increased year by year with a huge total. Among them are a considerable number of applicants applying for trademarks that are not for the purpose of actual use. These malicious registrations have seriously disturbed the order of the market economy and the order of trademark management. In addition, the existing Chinese Trademark Law only has principled provisions, and lacks direct, clear and operable provisions, which leads to insufficient strike force in actual operation. Therefore, China began to sprout the idea of clearly regulating the legal provisions of malicious trademark applications.

Legislative procedure of "bad faith" concept

At the very beginning, "bad faith" was not recorded in Trademark Law in China. In 2013, only two Articles have relevant regulation. One is the latter part of Article 32, "Filing trademarks by improper means that have been used by others and have certain influence". This Article focuses on applied for and registered trademarks, but it does not clearly explain what

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is "improper means". The other one is Article 44 of the Trademark Law. But it only stated that "Obtaining registration by deception or other improper means" can be invalidated. This provision only regulated "registered trademarks" and did not clearly state that if a trademark is filed by deception or other improper means, prior to registration, what action can be taken against it.

Then, in 2016, China National Intellectual Property Administration (hereinafter referred as CNIPA) issued "Trademark Examination Standard". Part II of Article 6 further explained Article 44 of the 2013 version of Trademark Law. In 2017, Chinese Supreme Court issued Provisions concerning the trial of administrative cases on trademark rights, which further emphasized it. However, neither of them proposed a "bad faith" concept during the whole procedure of trademark application for registration.

Finally, in 2019, China revised Trademark Law, especially for Article 4: "A maliciously filed application for registration which is not for the purpose of use shall be rejected." This is the first





Mr. Yimeng LU

“**Finally, in 2019, China revised Trademark Law, especially for Article 4: “A maliciously filed application for registration which is not for the purpose of use shall be rejected.”**”

Résumé

Mr. Yimeng LU is a trademark attorney with more than five years of experience in the IP industry at Sanyou IP. He graduated from Wake Forest University, US with a master's degree in Law. His practice specialties mainly focus on all kinds of trademark prosecution fields, including search, application, opposition, invalidation and etc.

time China clearly regulated the maliciously filed trademark from filing to registration.

In October 2019, the General Administration of Market Supervision issued “Several Provisions on Regulating the Application and Registration of Trademarks” (hereinafter referred to as Provisions). On the premise that the Trademark Law has already legislated against malicious acts, it requested the administrative authority in charge of trademarks, CNIPA, to further issue a detailed handling method for malicious trademark applications. The Provisions point out that it is necessary to specify the requirements for applying for trademark registration and engaging in trademark agency, give full play to the functions of the intellectual property management department, and achieve the goal of attacking the maliciously filed trademarks from the filing of the application till post-registration actions filed against the trademark such as invalidation application. It is necessary to comprehensively consider the applicant's business scope, useability, trademark application history, number of registered trademarks under its name, originality of the applied trademark, previous judicial decisions and other factors, and judge whether the case constitutes malicious registration. It is necessary to combine trademark review, regulate means in the management process with out-of-process measures such as credit record and agency management, and combine the active guidance of government departments with industry self-discipline to form a long-term mechanism to severely crack down on malicious trademark registration.

Specifically, Article 8 of the Provisions points out that, when judging whether a trademark registration application violates Article 4 of the Trademark Law, the trademark registration department (CNIPA) may consider the following factors comprehensively:

- 1 The number of registered trademarks applied for by the applicant or any natural person, legal person or other organization associated with the

applicant, the category of designated use, and the trademark transactions;

- 2 Industry and business conditions of the applicant;
- 3 The effective administrative decision or ruling or judicial judgment of the applicant to have engaged in malicious trademark registration or infringed upon the exclusive right to use a registered trademark of others;
- 4 Whether the trademark applied for registration is identical with or similar to the trademark of others with certain popularity;
- 5 Whether the trademark applied for registration is the same as or similar to the name of a well-known person, the name of the enterprise, the abbreviation of the enterprise name or other business marks;
- 6 Other factors that the trademark registration department thinks should be considered.

In order to better achieve the requirement of Article 4 of the Trademark Law, that trademark applications made maliciously should not be approved for registration CNIPA, in 2021, issued the new “Trademark Examination Standard”, which has a full chapter to guide use and judgement of the “Examination of malicious trademark registration applications”.

Analysis of the updated Trademark Law and “Trademark Examination Standard” relating to “bad faith”

Article 4 of the updated Trademark Law aims to resolutely curb the malicious trademark registration application behavior if “not for the purpose of use”, resolutely crack down on the registration application behavior of hoarding trademarks, and effectively regulate the order of trademark registration application.

The “malicious trademark application for registration which is not for the purpose of use” stipulated in Article 4 of the Trademark Law refers to the behavior that the applicant submits a large number of trademark applications not based on the needs of production and business activities, lacks real use intention, improperly occupies trademark resources, and disturbs the order of trademark registration.

In the updated “Trademark Examination Standard”, CNIPA clearly listed how to judge an

application that is filed maliciously. It mentioned 10 situations in total. But it does not mean that only these 10 situations can be deemed as maliciously filing a trademark. They are:

- (1) The number of trademark registration applications is huge, which obviously exceeds the demand of normal business activities and lacks real use intention.
- (2) Copying and imitating a large number of trademarks with certain popularity or strong originality of different entities.
- (3) Repeatedly applying for registration of specific trademarks with certain popularity or strong originality of the same entity.
- (4) Copying and imitating a large number of others' trade names, packaging names of products which already got certain fame, etc.
- (5) Applying for a large number of applications for registration with names that are the same and/or similar to the names of administrative divisions, mountains and rivers, scenic spots and buildings, etc.
- (6) Applying for a large number of applications for registration with names that are the same and/or similar to the names of famous people, famous characters, etc.
- (7) Applying for a large number of applications which belong to general names of the designated goods and services, or directly express the qualities or functions of the designated goods and services.
- (8) Applying for a large number of trademark registration applications and/or a large number of trademarks are transferred, and the transferees are scattered
- (9) For the purpose of seeking improper interests, the applicant sells in large quantities, forces commercial cooperation from the prior user of the trademark or others, and demands high transfer fees, license fees, or infringement compensation
- (10) Other possible actions may be deemed as malicious applications



Case Examples

Example 1: Opposition against application 26659148 for **SRAM** in class 21

In the opposition, we emphasize that all trademarks under the name of the opposed party are the same and similar to the well-known brands of others, with malicious attempts to plagiarize the trademarks which already have certain fame of others and seek illegitimate interests, which further demonstrates that the objected has a consistent plagiarism and imitation of other parties' trademarks, and always tries to attach importance to the popularity of other trademarks, causing confusion and misunderstanding among the relevant public. The acts of the opposed party are clearly in bad faith. To prove this point, we provide a full list comparing the trademarks filed by the opponent as well as the actual holders' information of these malicious filed applications.

Then, we also stated that before the application date of the opposed trademark on September 27, 2017, the opponent's “SRAM” trademark had established a certain influence in the relevant public areas in China through extensive use and publicity of sports water cups, bicycles, bicycle

“**Article 4 of the updated Trademark Law aims to resolutely curb the malicious trademark registration application behavior.**”

“**CNIPA had stated in the decision that the applicant did not provide evidence to prove the intention of filing the trademark. Hence, the mark has been invalidated.**”

parts, bicycle equipment, and other goods. The opposed trademark is identical to the opponent's trademark “SRAM”. The goods designated by the opposed trademark are closely related to the goods designated by the opponent's prior use of the trademark. The registration and use of the opposed trademark will inevitably lead to confusion among consumers, thus damaging the rights of the opponent and the interests of consumers. This is to try to prove that the opponent's trademark indeed has actual use in China, hence the holder of the opposed trademark clearly has knowledge of the opponent's brand. Then, the application of the opposed mark should not be deemed as good faith.

In the opposition decision, CNIPA supports our arguments. This example can fit No.(1) and (2) of the 10 situations of how to judge a trademark that is filed maliciously, regulated on the updated “Trademark Examination Standard”.

Example 2: Trademark “马石油酷腾” which has directly been refused by CNIPA based on Article 4 of Trademark Law

Trademark “马石油酷腾” was originally handled by applicant A, when the examiner was examining the application of such trademark the mark was transferred to applicant B.

Applicant A was a natural person, they applied for over 20 trademarks, and repeatedly filed “马石油”“途特力”“酷泰”“迈奇”“欣腾”“炫腾” in classes 1 and 4 which are similar to the same entity's prior registered trademark. Also, the applicant made some changes on the aforesaid marks like “马石油途特力”“马石油酷”“马石油迈奇” and filed applications. The applicant did not explain the reason for filing these marks.

In the invalidation case against the applicant's mark “马石油”, CNIPA had stated in the decision that the applicant did not provide evidence to prove the intention of filing the trademark. Hence, the mark has been invalidated.

Considering the aforesaid facts, CNIPA finally directly refused the applying mark “马石油酷腾”. This example can fit No.(3) of the 10 situations of how to judge a trademark which is filed maliciously, regulated on the updated “Trademark Examination Standard”.

To sum up, in the substantial examination of opposition or invalidation procedure, the examiner may fully consider the bad faith behaviors of the opposed party and provide strong protection if the prior mark is original and has been used and obtained a certain reputation. For example, if the opposed mark is not similar to the cited mark or the designated goods of both parties are not similar to each other, but the disputed mark has strong originality and the cited mark

has obtained a certain reputation through use, the examiner may fully consider the originality and reputation of the prior mark so as to consider the bad faith of the malicious trademark applications. CNIPA has done lots of work to try to reduce the number of such kinds of applications. While for the applicant, since China already has clear regulations to judge the situations on “bad faith” trademark applications, I believe that it will be easier and easier to protect the trademark right in China.

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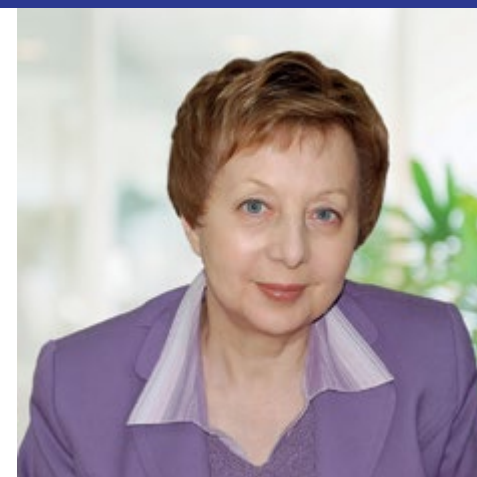
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The new Trademark Law of the United Arab Emirates

Yasir Masood of Dennemeyer reviews the most notable legislative changes and what they mean for rights holders in the UAE.

On January 2, 2022, the new Trademark Law (Federal Decree-Law No. 36/2021, "New Law") of the United Arab Emirates (UAE) came into force, followed by the Implementing Regulations (Cabinet Decision No. 57/2022, "Regulations"), issued on June 7, 2022. The New Law replaces Federal Law No. 37/1992 on Trademarks and its amendments ("Old Law").

As confidently expressed by the Ministry of Economy, the New Law "is a new legislative step towards enhancing IP [Intellectual Property] protection in the UAE" and "establishes major



Yasir Masood

*rules for trademark owners within a barrier-free environment that promotes creativity and innovation. It guarantees the growth and prosperity of their businesses, and meets the aspirations of the country to transition into a sustainable, leading global economy based on knowledge."*¹

Why changes to this small Middle Eastern country's trademark law are of interest to brand owners around the globe is evident. Despite growing competition from its larger neighbor Saudi Arabia, the UAE remains "Europe's most easterly hub and Asia's most westerly hub" for

The most significant development is that the UAE acceded to the Madrid Protocol on September 28, 2021, which entered into force on December 28, 2021.



businesses entering the Middle East and North Africa (MENA) market or who wish to establish regional headquarters.

This article looks at the most notable legislative changes and what they mean for rights holders.

International Registrations (IRs) through the Madrid System are now possible

The most significant development is that the UAE acceded to the Madrid Protocol on September 28, 2021, which entered into force on December 28, 2021, making it the third country of the Gulf Cooperation Council (GCC) after Bahrain and Oman to join the Madrid Union.

The benefits of this move are twofold: Any trademark owner that is domiciled, has an industrial or commercial establishment in, or is a citizen of one of the other 127 countries covered by the Madrid System's further 111 members can now designate their home, respectively regional, application or registration to the UAE. Also, those from the UAE can assign their UAE application or registration to any of these 111 members (127 countries).

For foreign applicants, this holds the additional advantage that, as opposed to national applications in the UAE, a designation through the Madrid System does not require a local agent appointed through a legalized and super-legalized power of attorney unless a refusal or opposition is raised.

The Regulations only refer to the Regulations under the Madrid Protocol without further guidelines from the UAE Trademark Office (TMO). How the TMO will handle some of the practical issues related to IRs thus remains to be seen.

Explicit mention of non-traditional trademarks

The New Law has added some non-traditional forms of trademarks to its definition of what can be protected as such, including 3D trademarks, colors, holograms, and smells.

The practical impact of these additions is, however, limited. As with the definition under the Old Law, the trademark types mentioned are not exhaustive but rather a list of examples, leaving room for other types not directly named by adding that the Law also covers "any other mark" used to distinguish goods or services.

At most, this change in the New Law confirms that the described non-traditional trademarks can indeed be registered in the UAE.

Allowing multi-class applications

One of the most significant additions is that the New Law introduces the possibility of multi-class applications. The implementation of this is still outstanding and is not expected before the beginning of 2023.

The New Law has added some non-traditional forms of trademarks to its definition of what can be protected as such, including 3D trademarks, colors, holograms, and smells.



Multi-class filings, and eventual registrations, carry obvious benefits for trademark owners as the administrative effort and costs thereof will be lower when applicants only have to docket the data and follow the deadlines for one application. This advantage of cost savings and ease of handling continues with renewals and recordals, which will always only have to be filed for one trademark independent of the number of classes. Official fees, as well as agent fees, are generally also lower for additional classes in multi-class applications. However, the New Law states and the TMO has confirmed that official registration fees shall still be charged per class in the future. Whether reduced official filing and publication fees will be applied for additional classes has not yet been announced.

Extended timeframe for the examination of applications

The New Law increases the term given to the TMO to examine new trademark applications from 30 to 90 days - save for Madrid designations for which up to 18 months are granted.

Possible prolongation of the timeframe to obtain a trademark registration by up to two months is certainly not welcomed by applicants, but it is hoped that the utilization of the maximum time span will be an exception and that less time pressure will lead to higher-quality examinations overall. Moreover, 90 days would still be relatively quick compared to international standards, given that the TMO carries out substantial examinations, including relative grounds.

Establishment of a new Grievance Committee

The Grievance Committee to appeal TMO decisions now consists of a judge and two IP experts, thus increasing the competency of and trust in the Committee. Additionally, decisions of the Committee can now be appealed directly to the Court of Appeals and no longer the Court of First Instance, removing one instance and thereby making the process faster and less expensive.

Cancellation actions to be filed with the TMO instead of the courts

A trademark cancellation action will now have

¹ Gulf News, UAE raises penalties on trademark violations to Dh1m in get tough move, <https://gulfnews.com/business/markets/uae-raises-penalties-on-trademark-violations-to-dh1m-in-get-tough-move-11659071814148>, (accessed September 23, 2022).

Résumé

Yasir Masood, Trademark Lawyer

Yasir is a German lawyer who has been active in the field of IP since 2016. After completing his law studies in Germany in 2013 and gaining initial experience in law firms in Germany and England, Yasir joined Dennemeyer's Dubai office in 2016. He is a frequent speaker and author on IP.



to be brought before the TMO and no longer the courts. This converts the action into an administrative procedure, as is also the case, e.g., in front of the European Union Intellectual Property Office (EUIPO) and the United States Patent and Trademark Office (USPTO), which should accelerate the process and reduce costs.

Preliminary measures

In line with the Trade-Related Aspects of Intellectual Property Rights (TRIPS) Agreement's stipulations on the availability of injunctions and expeditious remedies to prevent infringements, the New Law allows trademark owners to request provisional measures against an ongoing or imminent infringement. Such injunctions can even be obtained *ex parte*.

New filing requirement: certified Arabic translation of a trademark

New trademark filings will have to be accompanied by a certified Arabic translation of the non-Arabic parts of the trademark, as is already the practice in Saudi Arabia.

This requirement brings up several questions.

As the New Law is broad on this requirement, it must be assumed that words from any language have to be translated into Arabic. With over 7,000 languages worldwide, the practicality of this procedure is doubtful. Perhaps it could be limited to the languages of most relevance in the UAE, which would still leave a large number given that the country hosts more than 200 nationalities and holds an ex-pat population that significantly outweighs the number of UAE nationals.²

Additionally, entrusting the acquisition of the translation to the applicant might lead to misuse. A word that is descriptive in one language can be meaningless in another. The applicant could thus avoid rejection by obtaining a certified translation from a language where the word has no meaning, and the TMO would be unaware that it is descriptive in another.

An example to follow could be the EUIPO, which performs systematic language checks in all 24 official languages of the European Union *ex officio*. Beyond that, as mentioned in its examination guidelines, the EUIPO will only object when there is convincing evidence that a term has a meaning in a language other than the official languages of the European Union and is understood by a non-negligible part of the relevant public.

Accordingly, the UAE TMO could translate marks from the most relevant languages in the country as part of the examination procedure and consider the meaning in other languages that are understood by a relevant part of the population only if it receives a justified objection.

“A trademark cancellation action will now have to be brought before the TMO and no longer the courts.”

”

Temporary protection during international exhibitions

As the Paris Convention requires, the New Law confirms that trademarks may be granted temporary protection during officially recognized international exhibitions held in the UAE.

Clearer protection of well-known trademarks

The New Law explicitly includes transliterations of well-known marks in its list of marks that cannot be registered.

It further clarifies the criteria for defining a well-known mark in accordance with international standards.

Rights through prior use; bad-faith applications

The Old Law did not recognize rights to a mark based on prior use though such rights were acknowledged in court practice. This recognition is now confirmed in the New Law, providing clarity to rights holders.

Similarly, the New Law codifies that registration in bad faith can be a ground for the cancellation of a trademark.

Geographical indications (GIs) can now be registered

The New Law allows for the registration of GIs as trademarks for the first time. It uses the TRIPS Agreement's definition of GIs and makes their enforcement dependent on the protection in the country of origin. It further stipulates that GIs may not be registered where there is a likelihood of confusion with earlier bona fide trademark applications or registrations. How UAE applicants will utilize this new possibility, e.g., for the variety of date palms found in the country, will be interesting to observe.

Increased fines

Fines for violations were drastically increased from a previous maximum of AED 10,000 to AED 1,000,000.

Apart from acting as a stronger deterrent, this also sends the message that the government does not consider trademark infringements to be trivial offenses. It is hoped that this will contribute to increased awareness among the public of the seriousness of IP crime in general.

Customs measures

The New Law also includes provisions on customs seizures of infringing goods. An exception is made for small quantities of goods intended for personal rather than commercial use that are carried in the personal baggage of travelers or sent in small parcels.

Notably, goods offered for trade in the

exporting country's markets by the trademark owner or with their consent are also exempted, potentially leading to the international exhaustion of the owner's rights and the tolerance of parallel imports. Consequently, the exclusive import right of a local agent, as stipulated in the UAE's Commercial Agency Law, would also be limited under these conditions.

Easing of requirements

The New Law furthermore removes some of the red tape surrounding the UAE's trademark procedures.

For instance, natural persons applying for trademark registrations no longer need to submit a trade license. This not only eases the application process by requiring fewer documents but also affords protection to trademarks that are not used for commercial purposes. In addition, it facilitates the registration of trademarks at the earliest possible stage, when business concepts - or at least the registration of a business - might still not be finalized.

Another welcome step is that actions such as new applications, renewals and records of assignments no longer have to be published in two daily newspapers but only in the Official Gazette.

Moreover, the grace period for trademark

“Fines for violations were drastically increased from a previous maximum of AED 10,000 to AED 1,000,000.”

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renewals has been extended from three to six months, which is especially advantageous because a super-legalized power of attorney is still required at the time of filing a renewal application.

The obligation to record trademark licenses with the TMO has been abandoned as well.

Conclusion

While some details will still have to be clarified through the publication of additional regulations and the TMO's practice, it is noteworthy that a number of well-received and long-awaited steps have been taken to simplify procedures and strengthen trademark protection and enforceability in the UAE.

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² the UAE - Fact sheet, <https://u.ae/en/about-the-uae/fact-sheet>, (accessed September 23, 2022).



The branding conundrum in the pharmaceutical industry

Ranjan Narula and Mohandas Konnanath of RNA, Technology and IP Attorneys offer guidance via comparison of past cases for brand naming in pharma which is often complicated by the usual method of naming based on either the ailment or the Active Pharmaceutical Ingredient.

The pharmaceutical industry is well recognized for its innovation focus, tasked with discovering, developing, and marketing drugs that are protectable as Patents if they satisfy the criteria of being novel, inventive step, and industrial applicability. At the same time, Patent protection is limited to 20 years. Once the patent term expires, the Pharma companies rely on their brands and packaging to retain and grow their market share. The focus, therefore, shifts towards brands considering the trademarks can be maintained in perpetuity. The challenge is to retain the market share when competitors bring out competing products with the same Active Pharmaceutical Ingredient (API) with similar brand names derived from API. Also, the generic manufacturers test waters to sail as close as possible to an existing established brand. Further, adopting branding elements of an established brand on the basis that these are common to the trade is not protectable since they lack sufficient distinctiveness. The complexity in pharma branding arises from the fact that inspiration for a brand is drawn from the pharmaceutical ingredient or ailment it intends to cure. Therefore, making the task of naming companies difficult as similar sounding names help to push the product as a substitute. Branding in the pharmaceutical industry has its challenges; the restriction on advertising and promotion is an obvious impediment to building brand recognition. Further, the purchase decisions are influenced by doctors and pharmacists and now by the e-pharmacies as well.

It is settled law that no trader or pharmaceutical company can claim monopoly



Ranjan Narula



Mohandas Konnanath

or exclusivity in the International Non-proprietary Name (INN) or the Active Pharmaceutical Ingredient (API). Section 13 of the Trademarks Act explicitly bars the registration of names of chemical elements or international non-proprietary names (INN). It explicitly states that no word which is the commonly used and accepted name of any single chemical element, or any single chemical compound, shall be registered as a trademark. In fact, there is no restriction imposed on the part of the chemical element being used along with a distinctive matter to coin a trademark. However, the problem arises when enforcing such marks against third parties who have also derived their marks from the same chemical element/compound. The Indian Courts have adopted different approaches while considering distinctiveness or similarities claimed by such brand owners.

Résumés

Ranjan Narula, Managing Partner

Board Member, International Trademark Association (INTA)

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

Ranjan has been ranked as a leading IP practitioner by various publications including WTR 1000, IP Star (Managing IP), WIPR leaders, Who's Who legal, Asia IP experts, and others. Ranjan is regularly invited to speak by Universities and chamber of commerce on IP issues. He has authored several articles and papers on key IP issues that are published by IP magazines and blogs such as IAM, World Trade Mark Review, Bloomberg, Lexology, IP Kat etc.

Mohandas Konnanath, Associate Partner

Mohandas Konnanath is an Associate Partner at RNA, IP Attorneys. He joined the bar in 1995. Mohandas is a dual qualified lawyer, in India and England and Wales, and has obtained his Master's in Intellectual Property Law from Bournemouth University, UK, in 2006. He heads the Chennai operations of the firm and handles litigation, opposition, and prosecution matters. In his current role, he advises a wide range of clients on contentious and non-contentious IP matters. He also regularly writes and lectures on IP issues.



No word which is the commonly used and accepted name of any single chemical element, or any single chemical compound, shall be registered as a trademark.

The branding in the pharma industry must also be viewed from the disruption caused by Covid that has brought about wholesome changes in consumer behavior; persuaded doctors and hospitals to become tech-savvy, prompted pharma companies to invest in digital therapeutics and branding, and regulators to be flexible.

Anti-dissection rule

It is a well-settled principle of law that marks have to be compared as a whole and not split into parts to compare similarities. Indian Courts have passed varying judgments from time to time concerning pharmaceutical brand names involving prefixes and suffixes derived from the chemical name or compound. In fact, in several cases, there may not be bad faith in adoption by third parties as the mark has been coined by deriving it from the chemical name or compound. The question that arises in such cases is: can exclusive rights be granted to a particular trader when the mark in question has been derived from the main compound or the disease intended to be cured?



“
The companies are advised to choose an arbitrary or coined word, though the temptation is to go for a descriptive or suggestive word for better association with the business.”

The Supreme Court, in the landmark judgment in *Cadila Healthcare v Cadila Pharmaceuticals*¹, considering the ground realities in India, laid down broad guidelines in the principles of assessing similarities of marks in the pharmaceutical industry:

- *Even though medicines are to be sold on prescriptions, actual practices differ. Considering the linguistic variations in the country and that medicines are dispensed by pharmacists in urban and rural areas, chances of confusion are high;*
- *Stringent measures to be applied to prevent confusion in relation to medicinal products;*
- *To protect public interest, a lesser degree of proof is required to prove infringement of pharmaceutical products if the marks are similar;*
- *As confusion among drugs can be life-threatening, medicines should be treated as poison, not sweets;*
- *There exists a high risk of confusion as medicines are available over the counter and even via telephone services.*

The Cadila judgment has undoubtedly helped Indian courts to adjudicate claims in relation to pharmaceutical products with greater certainty. Though the Cadila judgement is a useful guiding tool, courts have nonetheless differed in interpreting similarities of marks in relation to pharmaceutical products. In other words, one school of thought relies on the principle of the marks being compared as a whole; the other relies on the principle of splitting the mark and ignores the portion which is a chemical compound or the organ or ailment it intends to treat for the purpose of comparison.

A few case laws are mentioned below, highlighting the courts' views on criteria to be adopted for similarity of marks.

Marks to be compared as a 'whole'

- In *United Biotech v Orchid Chemicals*², the two-judge bench, the Division Bench (DB) of the Delhi High Court discarded the concept of splitting the marks and relied on the principle of comparing the marks as a whole. The Court held that FORZID is deceptively similar to ORZID, notwithstanding the fact that the suffix 'ZID' is common to the trade and derived from the active pharmaceutical ingredient CEFTAZIDIME. The DB concurred with

the finding of the Single Judge that the mere prefixing of the letter 'F' fails to distinguish FORZID sufficiently from ORZID so as not to cause deception or confusion in the mind of an average customer with imperfect recall. In this regard, the Court also laid down the following rules of comparison:

- *Meticulous comparison is not correct,*
 - *Marks should be compared as a whole,*
 - *Prima facie view is inconclusive,*
 - *Structural resemblance and conceptual similarity should be taken into consideration.*
- In another case before the Delhi High Court, *Medicare Pvt. Ltd v Galpha Laboratories Ltd*³, the competing marks were BETADINE and BECTODINE, both products having a Povidone-Iodine combination. The defendant, Galpha Laboratories, contended that BECTODINE is an anti-Bacterial preparation and the said mark was coined by taking the prefix 'BECT' from 'BACTERIA' and suffix 'ODINE' from the generic name/molecule 'IODINE' and the suffix 'DINE' is commonly used in the pharmaceutical trade. However, the Delhi High Court relied on the anti-dissection theory and by comparing the marks as a whole, held that BETADINE and BECTODINE are deceptively similar and enjoined Galpha Laboratories from using the mark BECTODINE.
 - Similarly, in the case of *Himalaya Drug Company v SBL Limited*⁴, the Delhi High Court discarded the contention that 'LIV' is common to the trade as describing the medicines associated with the treatment of liver. The Court was considering an appeal involving the marks LIV.52 and LIV-T, both products intended to treat liver-related ailments. The Court held that LIV is an essential feature of the trademark LIV.52, and marks are to be compared as a whole. Thus, the presence of mark 'LIV' in LIV-T will be considered as trademark infringement.

Should trademarks be split for comparison?

The principle of comparing the marks as a whole is not conclusive. Courts have on various

occasions deviated from the aforesaid principle depending on the facts and circumstances of the case.


A few cases where the marks have been split for the purpose of comparison are discussed below:

- In *Panacea Biotech Ltd v Recon Ltd*⁵, the Delhi High Court adopted the theory of splitting the marks for comparing the similarities. The marks in contention in the said case were NIMULID and REMULIDE, both derived from the basic drug Nimesulide. The Plaintiff, Panacea, sought an injunction to restrain the defendant from using the mark REMULIDE. However, the Court rejected the prayer for injunction, holding that the mark NIMULID directly points to the drug from which it is manufactured. The Court observed that when the mark is derived from the name of the principal ingredient, no distinctiveness or exclusiveness can be claimed by a trader in respect of the part of the name taken by him for the trademark.
- In *Astra Zeneca v Orchid Chemical and Pharmaceuticals*⁶, the conflicting marks

were MERONEM and MEROMER. Both the marks were derived from the active ingredient Meropenem. The Court applied the splitting theory and refused to restrain the defendant from using the mark MEROMER. The Court, while declining the injunction, reasoned that the prefix 'MERO' in both the marks was derived from the generic term 'Meropenem', and the suffix in the competing marks was dissimilar.

- In *Schering Corporation & Ors v Alkem Laboratories Ltd*⁷, the Division Bench of the Delhi High Court upheld the order passed by the Single Judge in refusing injunction to the plaintiff. In the aforesaid case, the plaintiff alleged infringement of its trademarks 'TEMODAL' and 'TEMODAR' and sought to restrain the defendants use of the marks 'TEMOKEM' and 'TEMOGET'. The Court rejected the contentions and held that there was no phonetic or visual similarity between the marks. Admittedly, the marks are derived from the drug 'TEMOZOLOMIDE', and the suffix 'KEM' and 'GET' differ from the 'DAL' and 'DAR'.

“
Once the patent term expires, the Pharma companies rely on their brands and packaging to retain and grow their market share.”



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The High Court, while dismissing the appeal, held that LETROZ is not similar to LETERO as both the parties have derived the mark from the INN LETROZOLE.
 ”

While rejecting the injunction, the Court also considered that the product in question is a specialized drug used for specific treatment of brain cancer and the immense price differences between the products.

4. More recently the Division Bench of the Delhi High Court in *Sun Pharmaceutical Laboratories v Hetero Healthcare Ltd*⁸ once again affirmed that no trader can claim exclusive rights in the International Non-proprietary Name (INN). Sun Pharmaceuticals, registered proprietor of the mark LETROZ, filed the suit before the Commercial Court alleging trademark infringement and passing off and to restrain Hetero, the defendant from using the mark LETERO. The trial court refused the injunction finding that both the marks 'LETROZ' and 'LETERO' were derived from the INN, 'LETROZOLE', and Sun cannot claim monopoly over the INN and or any part thereof. The High Court, while dismissing the appeal, held that LETROZ is not similar to LETERO as both the parties have derived the mark from the INN LETROZOLE.

Comments

The Indian healthcare sector is expected to reach a market size of US\$ 500 billion by 2022. The critical key contributors to growth are rising income levels, greater health awareness, increased lifestyle diseases among the urban population, and improved access to insurance.

As with any other business, the proper selection of a brand goes a long way in building a strong brand image. The companies are advised to choose an arbitrary or coined word, though the temptation is to go for a descriptive or suggestive word for better association with the business. During the launch, many stakeholders tilt towards adopting a name that describes or identifies the drug. However, such a strategy may not produce the desired results in the long run.

To sum up, pharmaceutical companies operate in a competitive environment where branding is becoming more critical. Thus, pharma companies must invest in branding to stand out from the crowd and develop meaningful, lasting relationships with their patients.

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¹ 2001 (2) PTC 541 SC
² MANU/DE/2526/2012
³ MANU/DE/0051/2016
⁴ MANU/DE/5479/2012
⁵ 1996(16) PTC 561 (DEL)
⁶ 2006(32) PTC 733 (DEL)
⁷ MANU/DEL/3179/2009
⁸ MANU/DE/3092/2022



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Is your trademark aligned for Only One Earth?

Petter Rindforth, Managing Partner at Fenix Legal, evaluates Sweden's efforts for producing environmentally friendly brands and how these brands are received by consumers.

World Environment Day is celebrated worldwide every year on June 5. The campaign was established in 1972, at the first United Nations conference on the Human Environment in Stockholm, Sweden. The purpose of World Environment Day is to raise awareness of, and mobilize action, on pressing environmental issues. The theme day is arranged each year by the UN Environment Programme (UNEP) with a specific theme and a new host country.

June 2/3 this summer, 2022, - 50 years after the establishment - Sweden and Stockholm (the capital of Sweden) hosted World Environment Day again, with the theme: "Stockholm+50: a



Petter Rindforth

healthy planet for the prosperity of all - our responsibility, our opportunity". The event reflected on the urgent need for action, achieving a sustainable and inclusive recovery from the COVID-19 pandemic and accelerating the implementation of the environmental dimension of Sustainable Development in the context of the Decade of Action. In other words: "Only One Earth - living sustainably in harmony with nature".

So, what has this to do with intellectual property?

Sweden was the first country in the world to pass an environmental protection act in 1967.

Since then, Sweden has been making huge strides in bringing transformative societal changes for living sustainably in harmony with nature. It is a leading country in the fight against climate change, and among the frontrunners for greening its economy. More than half of the national energy supply comes from renewables. Sweden is fast transforming to low-carbon and renewable infrastructures and technologies, from subsidizing solar cells, electric vehicles and charging points to supporting the private sector and municipal investments to reduce climate impact.

This has also resulted in a number of environmentally friendly innovations. Some recent examples are: i) Ecofireprotection (EFP), a fire protection free from toxins, ii) Power paper - cellulose-polymer power paper that stores energy in all weathers (developed by researchers at Linköping University), iii) GreenIron - technology that makes it possible to sustainably, cost-effectively and fossil-free increase the steel industry's recycling of residual products and waste, iv) Swedish Algae Factory, grower of algae for use of their silica frustule as a solar cell efficiency enhancing nanomaterial, v) Ferroamp, developer of a smart grid inverter that integrates PV and storage in a local DC Microgrid, and vi) EXEGER, developer of dye-sensitized solar cells.

Swedish consumers are willing to pay a little extra for environmentally friendly products and, especially, the younger generation actively searches for information about brands that stand for sustainability and recycling.

Goodlist.se is a special site that collects consumer reviews, with the goal to help other consumers to make the right decision when looking for companies that actively work with sustainability, or, as Goodlist explains the goal: "Goodlist wants to help more people take greater

“
Another work is to reduce the climate impact from transport by increasing the proportion of renewable fuels.
”

responsibility for our planet and everyone who lives here". Goodlist gathers consumers' environmental ratings for all kinds of industries, from food, furniture, and construction companies to banks and law firms.

In 2021, Essity, a Swedish leading global hygiene and health company, conducted a consumer survey via the social research company Kantar Sifo, showing that 30% of all Swedes can imagine paying at least 20% more for their hygiene and health products if they are more environmentally friendly. When it came to the question of which environmental criteria Swedes can pay more for, locally produced was No. 1 (29%), followed by products that have recycled or renewable materials in their packaging (25%), and hygiene items that have environmental labels, natural raw materials or that they are recyclable are in demand (24%).

At the same time, the figures differ between the age groups. Almost four out of 10 (38%) in the age group 18-25 answer this - compared to one in five (19%) in the age group 61-80.

Résumé
Petter Rindforth, Managing Partner
Petter Rindforth has a Master of law from the University of Stockholm, Sweden. He is Managing Partner at Fenix Legal. Petter is a European Trademark and Design Attorney, an expert in cyberlaw, arbitrator/panellist for WIPO, Forum, IIS, Czech Arbitration Court, and at the Swedish National Courts Administration list of Mediators, focused on intellectual property. He is representing FICPI in the Intellectual Property Constituency at ICANN, member of the Alternative Dispute Resolution Committee of the International Trademark Association (INTA), and President of the Association of Swedish Patent Attorneys (SPOF).



“We have “Only One Earth”, and the young generation is actively looking for goods and services whose trademarks give a clear signal that they are climate-friendly and thereby ready for the next generation.”

Axel Thegerström Edh, sustainability manager for products and services at Essity commented on the survey result: “During the past year, many people have had time to reflect on the impact their actions have on other people and on nature. For Essity, it is important to understand how we can support and enable our customers and consumers to act more sustainably. The results are gratifying and strengthen us in our work for a more sustainable future”.

So which Swedish trademarks are considered to symbolize environmental friendliness?

The Sustainable Brand Index, a large European independent brand study provided by the Swedish company SB Insight, conducted their latest yearly study between December 2021 to February 2022, focused on sustainability. The Swedish part of the study involved 24,300 consumers, that rated 409 trademarks in 35 industries.

IKEA, the well-known furniture and home accessories company, was rated as number one. That may not be so surprising, as IKEA has a long-standing policy for sustainability, with a clear plan to become 100% circular by 2030. IKEA's sustainability strategy can be found at their web site (<https://about.ikea.com/en/sustainability>), summarized as “A sustainable everyday – with home solar panels, veggie hot dogs, and energy-saving solutions, we're paving the way for more sustainable homes for the many”.

Ånglamark (“the land of the angels”) is the No. 2 on the list. Ånglamark is owned by the co-operative supermarket Coop, and was launched in 1991 on the initiative of Coop members (that are the daily customers) based on a desire for a larger and better range of organic products.

No. 3 is ICA, a Swedish retailer with a focus on and other grocery items, however, many stores also include pharmacy, banking, and post office services. ICA has created a special sign, called Miljösmart Butik (“Eco-smart shop”) that can be used only for those local stores that follow the ecological policy for ICA stores. A Miljösmart Butik must have clear goals and ongoing follow-up of ICA's environmental work in areas such as food waste, energy, and plastics. Being an Miljösmart Butik also means that the store staff is continuously trained in environmental issues.

ICA has also a special trademark – I LOVE ECO – that ICA communicates as the trademark for “food and things for your home that we have produced in balance with nature – without skimping on taste or quality”.

Referring to Ånglamark above, the owner, The Coop, as such is rated as No. 4.

No. 5 is Apoteket, a state-owned pharma-

ceuticals retailer, that for many years has worked for, what they call, “a healthy planet”. One example is the collection of leftover medicines to reduce the environmental impact of pharmaceuticals. Apoteket has invested in Solvatten, a Swedish social enterprise with the mission to provide people living in developing countries with safe and hot water in a portable, environmentally-friendly way. The sustainable solar-powered water purification solution is especially for people living without clean water, but allows more trees to remain, which provides benefits such as shade, food, water purification, and absorption of carbon dioxide.

Another work is to reduce the climate impact from transport by increasing the proportion of renewable fuels and making Apoteket's transport solutions more efficient. When signing electricity contracts, Apoteket always chooses energy from renewable sources and when the staff travel, they prioritize train journeys over flights.

And it is not just the staff of Apoteket that prefer train over flights. No. 7 on the list is SJ – the Swedish railway company that market themselves as being climate-friendly, and has a special part of their website where travelers can see and calculate (in Swedish only) how climate-friendly their travels have been and how much carbon dioxide they have saved compared with if they had traveled by car or by airplane.

At the bottom of the index is the airline industry (No. 399 British Airways, No. 406: Air France, No. 407: Ryanair), followed by the gaming industry (No. 408 Maria Casino, No. 409 LeoVegas). Both Maria Casino and LeoVegas are online casinos, whose activities do not directly involve anything dangerous to the environment. The fact that they were ranked at the bottom rather shows the importance of – regardless of the type of business – clearly showing an active commitment to a sustainable environment.

We have “Only One Earth”, and the young generation is actively looking for goods and services whose trademarks give a clear signal that they are climate-friendly and thereby ready for the next generation.

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Women in IP Leadership

Celebrating achievements and continuing the empowerment of women





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

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

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

Patchen Haggerty: Partner, Perkins Coie

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

Patchen Haggerty is an Intellectual Property Partner at Perkins Coie and serves as a member of the Firmwide Management and Executive Committees. She manages global trademark portfolios as well as trademark and internet enforcement and take-down programs for market-leading companies worldwide. Patchen's background in trademark enforcement matters includes dispute resolution and administrative actions around the world. In her practice, she regularly manages trademark opposition and cancellation proceedings and trademark application appeals before the Trademark Trial and Appeal Board (TTAB). Patchen maintains an active profile as a presenter and author on emerging issues in trademark, copyright, and IP legal protections.

What inspired your career?

I made the choice to be a lawyer in college after I took a mass communication law class, which was the first class that really grabbed my interest. I found it particularly fascinating how our legal system governs communication, which guided my path to law school. Once in law school, I narrowed my focus from First Amendment Communication Law to the field of IP, then to trademarks in particular following a moot court competition where we argued about a museum's right to control third-party use of the shape of King Tut's Sarcophagus as trade dress and whether an Italian restaurant near the museum could have a sarcophagus shaped spaghetti dish called 'Mummy Mia'. I found it fascinating and amusing at the same time, and I instantly knew I wanted to specialize in IP! I've been in IP for 22 years now.

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

My current position on the Management and Executive Committees for Perkins Coie was a culmination of moving to Perkins Coie in 2014 and getting more involved in the leadership of the trademark group here. I became chair of the trademark group about three years ago, and I



Patchen Haggerty

chaired the group for a couple of years and made several positive changes to the group. I had expressed interest in becoming more involved in firm leadership, and I was on the task force that selected our current Managing Partner, during which time I got to know a lot of our firm leaders including our current Managing Partner. When a position opened on the firm's Management and Executive Committees, our Managing Partner called and asked if I would be interested in serving on the Committees. I, of course, said 'absolutely!'. I then went through a vetting process, and was selected to serve on the firm's Management and Executive Committees in early 2021.

I moved into those positions for a four-year term in July of 2021. Since then, I've been focused on managing the day-to-day operations of the firm as well as working toward the goals of our Strategic Plan, which has been fantastic. It's been a steep learning curve, there's a lot to learn about managing a law firm of our size that you aren't taught in law school or your legal career, but it's been great. It's very rewarding.

I think what guided my pathway was just speaking up, making it known that it was something that I was interested in, that I was keen on learning even though I didn't have as much prior management experience as prior members of the Management Committee. But that turned out to be a positive, as I bring a different perspective to those who've either been with the firm a very long time or are further along in their careers.

I think one of the most helpful things to do if you're interested in leadership, in a firm or any organization, is just to learn as much as you can about the organization and its people: the structure, the way that it's run, the financials of the organization. Then learn as much as you can about the economy, the cost of the services that you provide, and then what's important to your clients, your partners, to the people within the firm. Having that knowledge helps your understanding of what your organization needs and that will put you in the best position to take on leadership roles.

If pursuing a leadership position, I think it's helpful to start in a small leadership role and work your way up. That helps you to determine

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I think what guided my pathway was just speaking up, making it known that it was something that I was interested in, that I was keen on learning.”

how much you can and want to take on because leadership can be a full-time job, so that's a balance and a choice you need to make as you get more senior in leadership positions.

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

I think one of the challenges in moving into the Management Committee is that it is, really, a full-time role. Balancing that with the very busy practice has been a challenge. I also have two young children, twins aged 11, and I'm a single mum so balancing all of that together takes a lot of juggling and it can be challenging on a lot of days. It requires a great deal of organization which is something that, in all honesty, I've had to work on improving. I'm also learning how to say no, which I find a real challenge because if somebody asks me to do something I want to help, but I've had to learn how to put up some boundaries and prioritize. You have to figure out what's most important to you, what's most important for the organization, and in the best interest of the firm, and then what's most important for you and your family, and then prioritize those things and fit them all in - but it's definitely a challenge.

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

I achieved a lot of success as a trademark lawyer which I really enjoyed; I find it very satisfying that I've been able to successfully integrate into the IP field, which is challenging to do as a lawyer without a technology or hard science background. Then developing a client base and a bit of a reputation within the industry has been a great achievement. I'm in Seattle and the IP legal market here is small but it's very competitive because of the cache of the companies that we have here as clients. I've gotten involved in more national organizations and have received some recognition among them too. These are all very satisfying parts of my legal career.

Then getting selected and moving on to the Management Committee has been very rewarding. It's not a position someone at this stage of their career, that I am at, typically moves into and so it was a real honor for me to be asked to serve at the firm in this way.

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

I want to continue to serve the firm. We are trying to implement changes that will solidify the future of the firm long term, not just in the next three-five years. I want to continue to work on that and I see myself continuing to do that throughout the rest of my career.

I also want to continue, particularly when I'm in a lesser management role with more opportunity to focus my time, on building my practice as well. I built a bit of a niche specializing in the cosmetics industries with clients in beauty, personal care, and cosmetics - I definitely want to continue my focus on that. I also have clients in the gaming and AR/VR type space as well. I'm really interested in those two areas so, before taking on management commitments, I worked towards specializing in those two specific industries, building up a reputation and client base, so those are the areas that I will continue to focus on and build, shifting back and forth between them.

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

The IP industry still lacks diversity, so it would be wonderful to see more women and lawyers of color in the field. It's something that we really strive for here at Perkins Coie, in our promotion and our hiring we focus a lot on ensuring that we have a diverse class. With diversity comes diverse opinions which also brings a broader ability to offer the best services to our clients. That's very important, not just from an inequality and inequity perspective but from an ability to provide fair and balanced services to our clients. Perkins Coie is committed.

It would be great if we could see broader commitment across the legal industry. When I first started my career as a very junior associate, I was often the only woman in the room - it was not something that you even noticed. So not only was I the youngest by a significant amount of time but I was also the only woman. I was often mistaken for the court reporter or for someone's legal assistant, and that's just how it was. That is no longer the case and it's wonderful to see so many more women in our juniors and mid-levels. We have many diverse associates in the pipeline for promotion to partner, and the table, when we sit around in client or internal meetings, looks so much more diverse. When we do our full IP group retreats as a firm, we have more than 200 lawyers, the room looks very diverse. That's wonderful to see. It would be wonderful to have that emphasis in the broader IP community, at conferences and such, to see more women represented.

And then on the patent side, of course, that's always a challenge too because of the technology background which is not historically a field that draws women and diverse lawyers. Focusing on that, we have a Diversity Fellows program here at Perkins Coie, where students come in right after their first year of law school, and we really try to help develop them to focus

on careers in the IP industry, regardless of where they end up.

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

Flexibility is key to helping women find a career path that they can stick with. Not all women, or men, have families, but many do have obligations outside the office to care for children, parents, or their own health. Having the opportunity to flex up and down as needed, in terms of the amount that you're working in your career, allows you to find a career path with the same organization on a longer-term basis. We see a lot of women leave the firm, and leave the workforce, because of the challenges that they face in obligations outside of work, regardless of what those obligations are. Offering the opportunity to step back for a while, or ramp down for a while, but with the availability to come back when you're able will encourage more women to remain in the workforce long term. I can personally attest to the challenges of balancing a career and a family - and all of those demands that go along with it. It is not at all easy and it's difficult to make the choices as to what is best for you and your family. Flexibility has allowed me to stay in the firm, and in the legal industry, long-term.

I would also encourage women who are interested in IP to take the leap and get involved. I get a lot of reach outs from students and women early in their careers just wanting to talk about what I do, and how to get into the field. If someone feels like it's a challenge breaking into the field, I encourage you to reach out to others in the field for informal network opportunities, just to chat about it. It's a great field, it's really interesting and I can't imagine working in another area.

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I was often mistaken for the court reporter or for someone's legal assistant, and that's just how it was.”





Nidia Osorio: Founder and Managing Partner, Nidia Osorio & Co.

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

Nidia Osorio is a Colombian lawyer, with more than 25 years of experience in the fields of Industrial and Intellectual Property, and simultaneously more than 15 years practicing Labor and Social Security Law.

She is the Founder and Managing Partner of Nidia Osorio & Co. Law firm composed of five women attorneys and one paralegal. She litigates and advises Colombian and International companies in both fields.

Nidia Osorio and her law firm have both been recognized for several years in the Intellectual Property area by international publications.

What inspired your career?

My first inspiration was to become a tourist and hospitality expert! (laughs..)

I did not have the intention to be a lawyer. It was my parents' desire, since they never had the opportunity to study a career, so they wanted me to fulfill their own dreams. I wanted to study tourism and hospitality instead. My mother told me that if after the end of my first year at Law School I insisted to study Tourism, she would support me. So, I went for Law School. Once my first year was over, I personally went to file my application at the University in which I wanted to study Tourism, for my own surprise I found that the Union of the University was on a strike, immediately I did not like that University nor the idea of losing time of studying there because of continuous strikes.. so I decided to continue my studies at Law school.

Then came my second inspiration: While studying at the University I started working as an assistant at a small law firm specializing in Tax Law. There I discovered that I loved to work with lawyers, and I realized I wanted to have a law firm of my own. I was 20 years old at that moment and it took me more than 20 additional years to "remember" I had that dream. Better late than never!

After I graduated, I was gifted with my third inspiration: Mr. Germán Cavelier. I had the opportunity

to work in his Law firm for over 19 years. He was a very well-known, respected, and impressive visionary lawyer. He was a great leader and a fantastic human being. I learned a great deal at his law firm. I made my career there until I became a senior partner. I still apply many of his lessons and continue to train young lawyers with his sayings and teachings.

My current inspiration is to constantly seek how to give the best of me as a person and as a lawyer, how to guide my clients, how to strategize and solve cases, and to lead and train young lawyers to serve our society through their own work.

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

With time, I began to discover I was a good leader, a good lawyer, and a good seeker. Throughout the years I started dreaming of having my own clients, my own cases, and my law firm. I knew I had the drive and was responsible and perseverant enough to pursue this endeavor, but it took me quite a lot until I finally took the decision to go for it, not just because of leaving "the comfort zone", but also because when you've worked for so many years in a big firm, you have mixed feelings regarding your own capacity of being able to do it on your own without the big firm's umbrella.

My advice is to follow your instinct and pursue those dreams, focus on what you enjoy doing and things will happen. In the meantime, study and work very hard. It's important to have self-confidence, be very well prepared, get to know your pros and cons, and be ready to face the challenges of the unknown..

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

I have faced many challenges in my career, both from personal and professional experiences. Life and its challenges always make you grow, learn, and move on.

“My advice is to follow your instinct and pursue those dreams, focus on what you enjoy doing and things will happen.”

While I was working at a big firm, I had to face breast cancer. That was a huge challenge because at the time I was a young 33-year-old rising star lawyer. I remember I received the news of my disease after a trip to a Trademarks seminar organized by INTA in Charleston, Virginia - USA. It was a sudden strike of "touches of reality", it brought me uncertainty and affected me in all my fields. Fortunately, I was in hands of an extraordinary doctor MD José Robledo, and I also received overwhelming support from my loved ones, from the law firm I was working in and from my clients, I can't forget Mr. Jorge Eusebio Arango, at that time CEO of a huge Colombian Company that I assisted, he constantly called me to remind me that they were there for me. My dear friend MD Verónica Hoyos told me that, after overcoming breast cancer at such a young age, it would be easier for me to overcome many other events, that in comparison to that would seem to be less complicated. And it has been this way. Sometimes we tend to magnify problems in a disproportional way, I learned that as a survivor.

Many other challenges come when taking the decision to quit as a partner of a big firm and to have the will and faith in being productive enough to make it happen without receiving a monthly payroll. Challenges such as the lack of support from local banks to have access to credit because your law firm is "yet too new". Challenges such as training new lawyers, investing resources, time, and effort in doing so, and watch how big law firms take them away in a glimpse of an eye. Challenges such as finally being able to have your offices newly renovated and suddenly having to close them, because of Covid...(laughs). Challenges from the administrative perspective are worth mentioning: how to handle accounting problems, cash flow issues, invoicing and receivables, human resource difficulties. In the end, whenever you find a way to solve each problem, it is worthwhile!

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My dear friend MD Verónica Hoyos told me that, after overcoming breast cancer at such a young age, it would be easier for me to overcome many other events.

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

Founding my own law firm and being able to develop an outstanding team with five female lawyers, and also one more female paralegal. My greatest achievement has been handling IP matters as well as Labor law matters simultaneously. I have postgraduate studies in Labor Law and Social Security Law, additional to a Master's degree in Intellectual Property. I love both fields and decided to work on them at the same time in my firm. Colleagues were reluctant to understand and believe that I could succeed in developing this conjunction, and it brought me doubts, but after I decided on doing so, I am very happy and there are no regrets. My firm is very successful in both areas, and I feel delighted working with my client's challenges. You can't imagine how much I enjoy it when IP and Labor Law get connected!

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

I want to consolidate even more our IP area in our law firm, rendering selected and high-end services for complex and sophisticated cases, and continue developing the interconnection between IP and Labor Law fields, such as know-how regulation in labor contracts, or employment contracts for innovation that later become patents, or labor law in the metaverse, just to give some examples.

I wish to achieve these goals, reinforcing our IP and Labor law areas within my law firm, thoroughly investigating and actively participating in related events.

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

The inclusion of Silver Economy within the IP industry. I've handle many cases regarding pensions and conflicts between companies and senior professionals (mainly because of "budget concerns" – companies do not want to pay such high salaries and employees do not want to lose their jobs when they are getting close to pension). I perceive many conflicts here and great things to be done as well. I consider aging as an opportunity for "reinvention", being able to do things that were left in stand-by while our life was happening, it's a fantastic time for new challenges, and a tremendous opportunity for innovation! We must encourage the IP industry to include senior professionals as part of their equality and diversity programs for the next five years. Silver Economy in IP would not just solve the inclusion problem and would encourage entities, companies, and people to keep innovating, but would contribute to solving the worldwide pensions problem.

“

Silver Economy in IP would not just solve the inclusion problem and would encourage entities, companies, and people to keep innovating, but would contribute to solving the worldwide pensions problem.

”



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

I have worked with women for many years in my career, and I believe women have fantastic skills for IP, but I've seen very few CEO's, managing partners, or women in leading positions. I think it's because of a mixture of inner beliefs, education, and external pressure – such as social customs, cultural and traditional aspects, and the lack of time to attend family while intending to develop a professional career.

Society is working hard on changing these external pressures, but I believe it will take quite some time to develop the environment and harmony we need. We must work on what is in our hands, and on our inner beliefs. I encourage people to work on self-esteem, to keep looking for their own path (the one they like), and to work on balance in all possible aspects of both personal and professional fields.



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LAW FIRM RANKINGS 2022

Europe and the UK

A comprehensive list of the 10 most well-respected law firms from Europe and the UK



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

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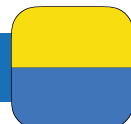
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Jurisdictional Briefing, Spain: trademarks and Designations of Origin

Sonsoles Baylina Santori, Head of the International Trademarks Department at H&A, offers a legal and economic perspective on the wine sector relating to the value of PDOs.

On the one hand, a Protected Designation of Origin (PDO) is understood as the designation of a product whose production, processing, and preparation come from a specific place or geographical area, with a recognized and proven specialization.

Each PDO is regulated by a series of Spanish Organic Laws, Decrees, Ministerial Orders, Regulations, etc., and the Regulatory Councils are responsible for ensuring compliance with the different regulations.

On the other hand, Trademarks are all those signs which have the task of distinguishing the goods or services of one enterprise on the market



Sonsoles Baylina Santori

from those of other enterprises and must therefore meet the requirement of being distinctive. All signs, in particular words, personal names, designs, etc., may constitute trademarks, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings.

Bearing this in mind, it could be stated at first glance that the inclusion of a trademark within a PDO not only protects a certain product in a qualified manner, and the entrepreneur who commercializes it, but also consumers in general. This would be a consequence of the fact that consumers, when they see that a product protected under a certain trademark is included within a PDO, will think that this product has a differentiated quality due to its origin.

It is therefore understood that these products have differentiating characteristics that are the result of the effort invested in the specific geographical area and that, therefore, are worthy of this indication. The final consequence of this would be not only a higher reputation, but also a higher economic performance for the entrepreneur.

It is for this reason that the registration and protection of PDO's must be ensured, as failure to do so would mean that anyone registering a trademark containing the name of the particular geographical area, whether or not it complies

with the PDO specification, would take advantage of its reputation.

So, if it seems that having a trademark and a product under a certain PDO is so beneficial, why are there winemakers leaving these PDOs? Are Protected Designations of Origin part of the solution, or part of the problem?

In the wine and cava sector, it is common to use trademarks that allude to the geographical origin of the product or, at least, that contain a more or less specific geographical description of the place of production.

All of this means that the interests of winemakers may come into conflict with the interests of the PDO Regulatory Councils, public bodies, producers' associations, etc. In this regard, it should be pointed out that the Spanish Trademark Law is categorical and does not allow third parties to register PDOs with respect to the product to which they are linked and legitimizes the Regulatory Council to oppose any registration of a similar trademark.

Likewise, the Regulatory Council of a PDO also has the right to oppose similar trademarks, even if they do not distinguish the product covered by the PDO and provided that it can be suspected that the reputation of the PDO is

“Without a strong trademark registration, the reputation achieved by the winery will be in vain.”

being exploited or that it could cause serious damage to its image and reputation.

Without prejudice to the above, it should be mentioned that the wine sector is one of the most active in terms of trademark applications and registrations, and the competition within this sector is constantly increasing. The very nature of this market means that entrepreneurs need to reinvent themselves at all times in order to have attractive trademarks that attract consumers to their wines and not to those of the competition.

In this sense, a problem arises from the restrictions of the PDO specifications, which, by determining the method of labeling and how it should be, the elements that can be included, the size and position of the labels, etc., limit the winemakers' creative capacity to differentiate their brands in a highly competitive market.

In view of all the above mentioned, what happens to the Industrial Property assets then?

Trademark registrations for the wine sector are absolutely crucial. This is because, whether under a PDO or not, the wine market is very demanding and competitive, where differentiation over others can mean the survival, or not, of a winery. Therefore, without a strong trademark registration, the reputation achieved by the winery will be in vain.



Résumé

Sonsoles Baylina Santori, Head of the International Trademarks Department

Sonsoles started her professional career doing her internship at a prestigious law firm in Madrid. Later on, she prepared for the State Competitions for Government Agency Officials at the Spanish Ministry of Energy, Tourism and Digital Agenda, with a specialty in Intellectual Property for the Spanish PTO.

She joined the Latin American Trademark Service Department (LTS) of H&A in 2018, focusing her practice on trademark advice for clients active or interested in the Latin American market.

Currently, Sonsoles advises our clients on International Trademarks and national Trademarks worldwide.

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Can non-tangible assets infringe tangible assets?

Dr Anna Sokółowska-Ławniczak, Partner at Traple Konarski Podrecki and Partners, reviews the *StockX v Nike* case to see if the repeated sale of a non-tangible asset that represents a tangible asset is infringing or not.

While not reiterating explanations concerning what NFTs are, there are at least two areas worth mentioning from the perspective of trademark issues. One of these is certainly the increasing popularity of trademark applications that use NFT-related terminology when listing goods and services, and how they should be correctly classified. The other issue, which has now arisen in practice, is potential trademark infringement due to use of another's mark in the form of an NFT.

With regard to the issue of trademark applications – the hype surrounding NFTs is also having an impact on authorities that grant intellectual property rights. As of January 2020, there were no trademark applications containing the term NFT in the USPTO (USA), while exactly one year later the term was mentioned in dozens of applications every day. Naturally, these include the major global brands such as Victoria Secret, McDonald's, Nike, and others, apparently reacting more to certain marketing or PR trends rather than to legal necessity. Meanwhile, the applications concerned not only NFTs, but also terms that have recently been in vogue, which are *metaverse*, *virtual goods* or *virtual services*.



Dr Anna Sokółowska-Ławniczak

Likewise, the EUIPO has observed a significant increase in NFT trademark applications over the last two years, with

- 1,277 NFT trademark applications in 2021, and
- 1,157 NFT trademark applications in 2022

Questions concerning the correct classification of the term NFT as goods or services would inevitably be raised, considering the volume of applications. In June 2022, the EUIPO published a statement on its approach to classification of trademark applications containing the term NFT. The EUIPO stated that class nine in the twelfth edition of the Nice Classification would contain the term *downloadable digital files authenticated by non-fungible tokens*. Importantly, the term non-fungible tokens by itself cannot be accepted, as the EUIPO always requires the *type of digital item* authenticated by the NFT to be specified. This is because the EUIPO makes a distinction, and incidentally rightly does so, between the NFT and the item it "authenticates" – an NFT is a kind of "front cover" for a particular digital item.

In view of the nature of an NFT, which "authenticates" a particular digital item, the situations can be considered in which the use of another's mark in the form of an NFT by a third party will constitute trademark infringement. Current laws (Polish or EU) sufficiently address a situation of this kind, because, from the point of view of trademark infringement, the crucial issue is use of a particular mark for specific goods and services in trade. Thus, there could be cases in which a third party uses another's mark as an NFT on the Internet (for obvious reasons NFTs can only be used in the virtual world). Whether infringement has occurred will naturally depend on the goods or services used, or, where applicable, whether there are grounds for considering a trademark with a reputation to have been infringed. When considered in this way, interpretation of current

laws with regard to use of a mark in NFT form does not present particular problems.

Meanwhile, in practice, one noteworthy case arose of potential infringement connected with an NFT. It will come as no surprise that the case has been in progress since February 2022 in the US, as it is mainly there, for the moment, that any court cases concerning NFT have been instigated. In the case, *StockX* – a popular online footwear store, launched the *Vault NFT* series in January 2022. The idea behind it was that an NFT was linked to a particular footwear item, in this case Nike shoes. As, in general, limited edition footwear is resold by a series of buyers until the final customer is found, linking an NFT to a specific item meant firstly that the goods could be authenticated, and secondly that the physical item of footwear could be kept in the *StockX* storage facility until the final buyer claimed it.

Thus, *StockX* customers each in turn "resold" only the NFT linked to the footwear item concerned, and not the physical goods. The item was therefore traded much more quickly than by the conventional method. This situation led Nike to file a claim against *StockX* for infringement of Nike trademarks, stating that using the Nike trademark in the form of an NFT could be misleading consumers. Interestingly, Nike included in the trademark infringement claims allegations that *StockX* was selling counterfeit products, which is odd, because before the dispute arose Nike itself recommended the authentication procedures used on that site, and its policy regarding combating counterfeit goods. Naturally, *StockX* denies Nike's allegations.

Assuming that *StockX* sells genuine Nike products and not counterfeit products, the question is whether the site was entitled to use the Nike trademark to generate an NFT and then allow the site's customers to "trade" in that NFT. *StockX* has stated that in this instance the NFT merely serves as a "virtual receipt" for a specific product, while *StockX* itself does not allow trade in "digital goods" which are in some way separate from the physical goods. However, because the physical product is kept in the *StockX* storage facility until it is claimed by the final buyer, the NFT can be sold repeatedly during this time, which, in Nike's view, is grounds for concluding that the NFT is somehow a separate product, and not a "virtual receipt". Therefore, the foremost issue to be ruled upon in court is what in fact an NFT is, and subsequently whether use of the Nike trademark in this way may constitute trademark infringement. All of this assumes, of course, that *StockX* did not have counterfeit footwear on its site; if this was the case the dispute would center on entirely different issues. In view of this factual background and the essence of an NFT, Nike's assertion that

“The NFT can be sold repeatedly during this time, which, in Nike's view, is grounds for concluding that the NFT is somehow a separate product, and not a “virtual receipt”.”

an NFT is a product separate from the physical goods seems too extreme.

When the issue described above is considered in terms of Polish or EU law, the question of exhaustion of the right conferred by the trademark has to be addressed. Assuming that *StockX* had on sale items of Nike shoes that could be demonstrated in an effective way to have been placed on the market for the first time by the trademark proprietor or with their consent, the right conferred by the trademark was exhausted with respect to those particular items of Nike footwear. This raises the question of whether, due to exhaustion of the right conferred by the trademark, *StockX* was entitled to generate an NFT using the Nike trademark, and link that NFT to each particular pair of shoes. The exception according to which the trademark proprietor is able to object to trademark-related activities is quite broad in scope – under Polish law and EU regulations, provisions on exhaustion of the right conferred by the trademark do not apply when this is supported by reasonable grounds for the trademark proprietor to object to further distribution of the product, especially when the condition of the product changes or deteriorates after being placed on the market. Proprietors of trademarks with reputation make use of this exception relatively frequently, stating that certain behavior with respect to the mark (such as the manner of distribution, advertising, etc.) breaches the reputation of the trademark concerned. In view of the above, it is of course unclear whether using an NFT with the Nike trademark falls under that exception.

While unfortunately none of the concerns expressed above are properly solved, at present we can at least consider whether use of an NFT with a registered trademark relating to a specific product is an evident infringement of a trademark, or whether it may fall under exhaustion of the right conferred by the trademark.

Résumé

Anna Sokółowska-Ławniczak, Patent and Trademark Attorney, Partner

Anna advises on every aspect of industrial property rights, from developing strategies through protecting individual items of industrial property to maintaining and enforcing industrial property rights under Polish, European and international procedures.

Anna has extensive experience in litigation before the Polish Patent Office and the EU Intellectual Property Office, as well as in court disputes concerning industrial property, combating unfair competition, and copyright law. She manages complex projects aimed at obtaining and maintaining industrial property rights.

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How bad is too bad? European trademarks and *force majeure*

Lucia Granieri and Massimo Cimoli of De Simone & Partners, part of Dennemeyer & Associates, evaluate the EUIPO's decisions relating to non-use cancellation based on unforeseen circumstances.

In the fantastic world of Intellectual Property (IP) fairy tales, the justification of non-use is the elusive and captivating Cinderella. There are very few decisions on this issue, and the existing body of law offers no practical definition of how adverse an "act of *force majeure*" must be to be considered sufficient reason for non-use of a trademark. And in the event this justification is found, the term of its validity is open to interpretation. When the clock tolls midnight, and disaster strikes, the owner of a European trademark (EUTM) can find himself holding his glass slipper, wondering whether his princess has flown.



Lucia Granieri

Every fairy tale begins with rules

Article 64(2) and (3) of the European Union Trade Mark Regulation (EUTMR) provides that where an **earlier mark has been registered for five years or more** when the application for a declaration of invalidity is filed, the proprietor of the junior mark may request proof that the earlier mark has been put to genuine use in the EU in connection with the goods or services for which it is registered **or that proper reasons for non-use exist**. In this respect, established case law acknowledges that "bureaucratic obstacles" which arise independently of the trademark proprietor's will are insufficient unless they directly affect the mark to the extent that use of the trademark rests on successful completion of the administrative action concerned. However, the criterion of a direct relationship does not necessarily imply that use of the trademark is impossible; it could suffice that use is unreasonably burdensome, with any such circumstances to be assessed on a case-by-case basis.

After many years out of sight, the matter of justifiable non-use was "brought back to

remembrance" on May 19, 2022, by an intriguing decision of the Alicante Board of Appeal, overturning the Cancellation Decision in the first instance.

Résumés

Lucia Granieri has been active in the Intellectual Property field since 2010, focusing on trademark, design and copyright law, art law, IP and sport, unfair competition and the negotiation and drafting of IP contracts. As an Italian lawyer and European-qualified IP consultant, she assists, among others, national and international sports organizations and has spoken at several conferences on the protection of IP rights.

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Massimo Cimoli

Massimo Cimoli has been active in the IP field since 1989, with a focus on trademarks and copyright, assisting clients worldwide in different industries, including major Italian and international oil and gas companies, sports and automotive corporations. A recognized attorney with vast experience, he has been a member of the working group before the Ministry of Industry and the Italian Patent and Trademark Office for the implementation of the revised industrial property code in Italy.

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... followed by tragedy

If an earthquake destroys a small-sized settlement in the EU, it is possible for trademark owners to start or resume their business activities in areas unaffected by this *force majeure* event. But is it fair to ask or expect a trademark owner who has had his activity devastated by an earthquake, flood or other natural disaster to move his operation to a different town or even country?

In actuality, the global village we live in today often makes it cheaper to relocate than rebuild. What is more, the misfortunate trademark owner could grant a trademark-use license to a third party and, by doing so, prevent their trademark from lapsing. In other words, there are choices that an ill-fated trademark owner can make instead of re-establishing their business in the same place where it was previously devastated. But should this decision be left to the trademark owner or the registering office, which could conclude that non-use was unjustified and, thus, unacceptable? And again, can such office decisions vary depending on the goods and services covered by the unused trademark? What if the trademark owner wishes to start from scratch in the same location, no matter what? Can such persistence be rejected and punished by the office?

“**The misfortunate trademark owner could grant a trademark-use license to a third party and, by doing so, prevent their trademark from lapsing.**”



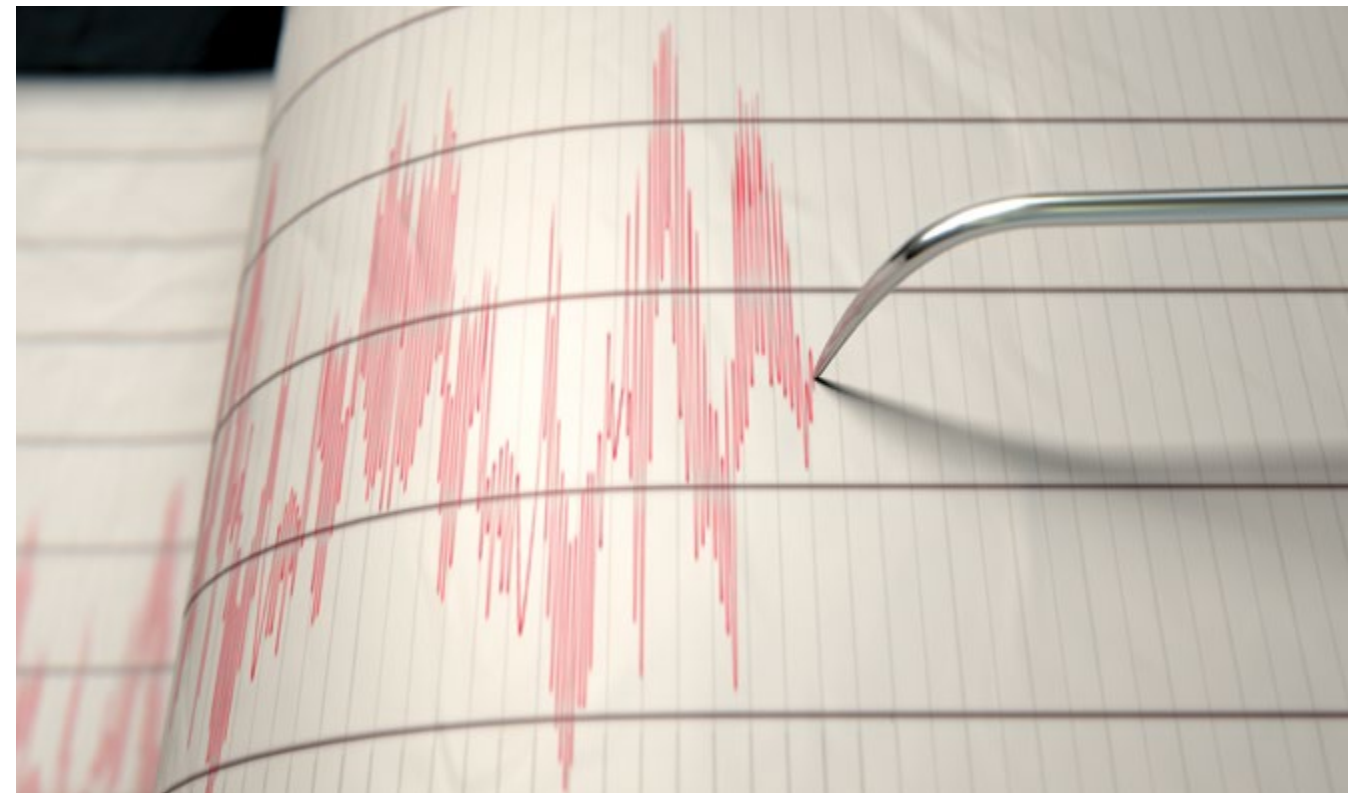
The TRE MARIE restaurant in L'Aquila during restoration works.

In the following examination, we will describe the rationales behind the decisions of the Cancellation Division and Board of Appeal in light of the facts of the case at hand. Furthermore, we will endeavor to illuminate the philosophical questions concerning the trademark registrations of “Tre Marie” and “Antico Caffè Tre Marie dal 1912” addressed differently by the Board and Division. We will analyze how these decisions were reached, particularly regarding the goods and services involved (hospitality vs. coffee production).

Tre Marie is a famous restaurant in the Italian town of L'Aquila and the subject of the EUTMs TRE MARIE and ANTICO CAFFE' TRE MARIE DAL 1912. On April 6, 2009, a powerful earthquake (measuring 6.3 on the moment magnitude scale) severely damaged the original structure, requiring many years of extensive reconstruction. The restaurant and its building are of particular historical significance in Italy. Indeed, it was the first Italian restaurant to be included in the Michelin Guide for Italy (in 1957) and one of the first Italian restaurants to receive a Michelin star (in 1959). Its venue was designated a “monumental building” by a decree of the Italian Ministry of Culture and Tourism. It is, thus, part of an illustrious elite of historic properties to which Caffè Greco of Rome, Caffè Gambinus of Naples, Caffè Florian of Venice and Caffè degli Artisti of Brera already belong.

In spite of this esteemed reputation, on July 16, 2020, the Cancellation Division of the European Union Intellectual Property Office (EUIPO) revoked Tre Marie's EUTMs in their entirety, effective August 7, 2018, on the grounds that the marks' proprietor had failed to demonstrate a proper reason for non-use. Admittedly, the Cancellation Division found that while it could not be fully excluded, the possibility of considerably speeding up reconstruction work was highly improbable. However, in the opinion of the Division, *force majeure* circumstances that hindered their normal business operations and necessitated a complex building/reconstruction project had no direct relationship with the relevant marks due to a lack of evidence proving how these factors affected the EUTMs' use.

In addition, the Cancellation Division concluded that, although the EUTM proprietor claimed that it was/is unfeasible to open the restaurant/café in any place other than its historic site and building, the argument offered did not prevent the proprietor from using the marks elsewhere, making it a personal choice or business strategy. The obstacles reported by the EUTM proprietor did not prevent them from delivering the relevant goods and services somewhere else since the scope of the EUTMs' geographical protection was vast. Therefore, the EUTM proprietor could have used the marks in other locations within the EU or Italy, even in the same region.



Finally, the conditions so described were clearly not beyond the EUTM proprietor's control and did not make the use of the marks impossible or excessively difficult.

A happy ending

Though faced with terrible commercial hardship, the proprietor successfully appealed the cancellation of their EUTMs. The Board of Appeal determined that the rationale underlying the decisions by the Cancellation Division, insofar as it refers to the contested services in Class 43, i.e., “providing of food and drink; temporary accommodation,” could not be upheld.

Firstly, it was found that the Cancellation Division had ignored the filed evidence showing that the EUTM proprietor's corporate strategy was inextricably bound with the reputation of the famous restaurant and adjoining café, both housed in the historic building. There was no doubt that the long-standing fame of the restaurant and its venue created a sufficiently intimate connection with the services in Class 43 to justify the EUTM proprietor's corporate strategy of relying entirely upon the historical site. Though it might not have been impossible for the EUTM proprietor to use the contested EUTMs to provide food and drink services in another, temporary location in Italy or elsewhere in the EU, the process would have required such a change in strategy that to use the marks would have been unreasonable.

Certainly, an EUTM provides wide geographical protection across the EU. However, this does not mean it is practicable for the proprietor of a

“**In the case at hand, this implied all the time needed for restoration, even if this was more than 10 years after the earthquake!**”

restaurant or café based out of a historic location to uproot their corporate strategy, moving away from and regardless of any core assets.

The Board agreed that, in light of the specific circumstances, the suggestion that the business plan be changed together with the location where the Class 43 services are offered was unreasonable. Any commercial action other than to reopen the business at its original setting would have exposed the EUTM proprietor to the risk of serious business damage by jeopardizing the intrinsic value of the trademark and the investment made to preserve the “one-of-a-kind” historical site. Therefore, such use of the EUTMs would have been unacceptable.

In conclusion, to paraphrase the Board of Appeal, if a devastating earthquake that causes appalling human and material loss cannot be considered *force majeure* in relation to a business strategy predicated on a time-honored building, then it is difficult to imagine what could! The question that follows is: “Until when would it be reasonable for the EUTM proprietor not to use the contested EUTMs in relation to these services in Class 43?” The answer reached by the Board was “as long as time extensions to the deadlines for completion of the reconstruction works were granted in accordance with the law and (such time extensions) were not attributable to the negligence or omission of the EUTM proprietor,” as issued in an affidavit from the Municipality of L'Aquila. In the case at hand, this implied all the time needed for restoration, even if this was more than 10 years after the earthquake!



Hard lessons learned

The proprietor's success, however, was not without qualification. In relation to all the other products and services (including, *inter alia*, coffee products in Class 30), it was found that the use of the contested EUTMs could not be said to be contingent on the restoration of the historic building which housed the restaurant and café premises.

For one, although the café or restaurant might constitute a "window" through which such goods can be viewed, it cannot be said to be objectively necessary or essentially important to their sale, given that they can be sold through any number of outlets. Additionally, the manufacture of such goods was not contingent upon the historical premises of the restaurant.

In the end, any connection therewith or reference thereto would merely "leverage" the restaurant's reputation for the sale of such goods, which was found to be too indirect to constitute proper grounds for non-use of the contested EUTMs. In addition, given the years required to restore the restaurant and café building, it would not have been unreasonable for the EUTM proprietor to have dedicated their business efforts to the production/sale of such goods elsewhere in the meantime.

This does not consider an earthquake *per se* as sufficient reason for non-use and obliges trademark owners to search for alternative possibilities of use.

The moral of the story

As we have seen, the two EUIPO decisions above represent different interpretative approaches:

- 1) A more severe one. This does not consider an earthquake *per se* as sufficient reason for non-use and obliges trademark owners to search for alternative possibilities of use. According to this reading, the time elapsed after the seismic event is of considerable importance, even if the business inactivity at the premises was due to bureaucratic interference.
- 2) A more lenient stance. This takes into account the seriousness of the event and recognizes the possibility of a strong physical connection between a service/product and the place where the activity has to be carried out. At the least, regarding restaurant services in Class 43.

In our opinion, the Board's position relating to Class 43 is the correct one. It recognizes and underlines that a specific location can be of crucial significance in restaurant services, where the serving of food and drinks becomes a unique experience not only on account of the excellence of the fare but also of the surrounding environment filled with historical, cultural and artistic artifacts. In fact, Tre Marie is still a place where valuable paintings, embroideries and memorabilia of great artists and intellectuals are jealously held. Dining there is like stepping into the past and sitting at the same tables where famous scholars, poets and directors used to eat and talk.

In sum, the Board of Appeal of the EUIPO indicated that a *force majeure* justification for trademark non-use remains applicable even many years after a natural disaster and until the reconstruction of the damaged assets whenever a strong connection exists between the trademark and the commercial location. On the contrary, this justification does not apply to goods and services lacking such clear bonds.

Thus even among ashes, something of rare and great value may still be found.

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Forms of consent for trademark use according to court evaluation

Sergey Zuykov, Managing Partner at Zuykov and partners, discusses the various approaches of the courts to the forms of consent beyond licensing agreements granted by trademark owners for use of their means of individualization.

A license agreement is a basic and indisputable form of the right holder's consent to use a trademark, while other types of such consent can still be guided mainly by law enforcement practice.

Approaches to assessing the form of consent in these cases largely depend on the circumstances in which such consent of the right holder was required.

For example, in a 2022 case NA41-13514/2020¹, the issue of the consent of the trademark owner was raised in order to agree on the placement of a sign on a pharmacy. In a case that reached

the Supreme Court of the Russian Federation, the company applied to the administration for the provision of the service "Coordination of the installation of an information placement medium", attaching to the application the consent of the trademark owner for its use by the company.

The administration refused approval due to the fact that the administration considered the consent of the copyright holder to use the trademark in the absence of registration of the right to use it as inadequate evidence.

The recognition of the refusal as illegal was denied by all courts, since the consent of the



Sergey Zuykov

Résumé

Sergey Zuykov has been working in the field of IP for more than 20 years. He is a patent attorney of the Russian Federation and a Eurasian patent attorney. Since 2004, he has been acting as Managing Partner of Zuykov and partners company which provides IP protection services all over the world. Sergey Zuykov is a member of the international associations: INTA, AIPLA, MARQUES, ECTA, and PTMG. In 2016, he was appointed Vice President of the Union of Patent Attorneys and Specialists, whose members are more than 100 patent attorneys of the Russian Federation. In 2018, Sergey Zuykov was included in the WTR-1000 rating as one of the leading specialists in law enforcement practice and legal proceedings according to the WTR magazine.

Author's profile: <https://zuykov.com/en/about/employees/sergey-zuykov/>

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The court pointed out that the absence of a prohibition of the right holder is not considered consent.”

trademark owner submitted by the company was not a proper confirmation of the right to use it - after all, the applicant did not provide evidence of registration of such a right.

In the cassation appeal filed with the Supreme Court of the Russian Federation, the company indicated that the written consent of the copyright holder received by it to use the trademark does not contradict the Civil Code of the Russian Federation². The applicant believed that the current legislation does not bind the expression of the consent of the copyright holder to use a trademark with a certain form, and the use of the result of intellectual activity is covered by the exclusive right of the copyright holder and does not require the mandatory conclusion of an agreement.

The Supreme Court of the Russian Federation noted that the list of ways to dispose of the exclusive right to a trademark is not exhaustive and is at the discretion of the right holder. Thus, by providing the applicant with his written consent to use the trademark, the right holder has lawfully disposed of his exclusive right.

In another case - on the recovery of compensation³ - the infringer referred to the exhaustion of the exclusive right to a trademark and emphasized that there were no requirements for the form of the consent of the trademark owner to introduce goods into civil circulation, and therefore believed that such consent could be expressed in any writing. He considered business correspondence to be such a form.

The court pointed out that the absence of a prohibition of the right holder is not considered consent (permission). Art. 1487 of the Civil Code of the Russian Federation does not really contain an indication of the form in which the consent of the right holder to use the trademark on the goods put into circulation on the territory of the Russian Federation or the country party to the Treaty on the Eurasian Economic Union should be formalized, but this does not mean that the right to use the trademark sign without concluding an agreement can be drawn up in any form.

The IP Court emphasized that consent must be expressed in a form that allows one to reliably identify the addressee of the consent, is capable of being perceived by the addressee, and will allow him, in the event of a dispute, to prove the issuance of such consent. With regard to the import of the original product and its further sale, the court noted that the will of the right holder to use the trademark by a specific person may follow, in particular, from documents confirming the right holder's application to the customs authority to enter the trademark in the customs register with the definition of authorized importers. There were no such documents.

In another case on the recovery of compensation⁴, it turned out that the absence of objections from the right holder was enough for the court - dismissing the claim, the court indicated that, according to the answer of the authorized representative of the company, the trademark right holder did not object to the resumption of the release of the disputed goods - that is, in fact, agreed to enter the disputed batch of goods into civil circulation, which excludes violation of the exclusive right to a trademark.

In case no. A56-70471/2020 the company was not⁵ held liable under Art. 14.10 of the Code of Administrative Offenses of the Russian Federation, since the right holder informed the customs authority of his consent to use the trademark by a corresponding letter on the day when the company filed the corresponding declaration for the goods marked with the trademark. Additionally, the specified consent was confirmed by the right holder during the consideration of the case of an administrative offense.

Trademark termination cases traditionally abound in various forms of trademark consent.

For example, in case No. SIP-380/2015⁶, the plaintiff emphasized that the only form of consent of the right holder to the use of a trademark by a third party is the conclusion of a license agreement between them. However, having considered the letter of consent and not establishing the vices of the will of the copyright holder, the court concluded that the trademark

is still used with the consent of the copyright holder.

At the same time, in case No. SIP-110/2013⁷, the court leveled even the importance of defects in the will of the right holder, indicating that when establishing the fact of using a trademark under the control of the right holder, the court should evaluate all the evidence presented in their entirety, regardless of the presence or absence of defects in the expression of this will.

Practice⁸ allows us to establish that, according to the IP Court, as a general rule, the will of the right holder to use a trademark by a third party can be expressed in an agreement with this third party; such agreements, in addition to the license agreement, may be a commercial concession agreement, a simple partnership agreement, a work contract, an agreement for the provision of services for a fee.

At the same time, the will of the copyright holder can be established without any of the above agreements or letters of consent - for example, if there are corporate relations between the copyright holder and the user of the trademark. In case No. SIP-247/2013⁹, the use of a trademark under the control of the right holder was confirmed through the performance by the person using the trademark of the functions of the sole executive body of the right holder. At the same time, no other document formalizing the consent of the trademark owner, except for the agreement on the transfer of powers of the sole executive body, was submitted.

Thus, law enforcement practice also offers other forms of consent of the right holder to use a trademark, in addition to the traditional license agreement, and it can be stated that these forms depend on various types of circumstances in which such consent is required.



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However, having considered the letter of consent and not establishing the vices of the will of the copyright holder, the court concluded that the trademark is still used with the consent of the copyright holder.”

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¹ Determination of the Judicial Collegium for Economic Disputes of the Supreme Court of the Russian Federation dated 04/05/2022 N 305-ES21-23755 in case N A41-13514 / 2020, decision of the Arbitration Court of the Moscow Region dated 10/06/2020, decision of the Tenth Arbitration Court of Appeal dated 03/03/2021 and the decision of the Arbitration Court of the Moscow District dated August 17, 2021 in case No. A41-13514/2020

² Civil Code of the Russian Federation (Part Four) dated December 18, 2006 N 230-FZ

³ Ruling of the Court for Intellectual Property Rights dated July 4, 2017 N C01-521/2017 in case N A56-48300/2015

⁴ Ruling of the Court for Intellectual Property Rights dated May 31, 2016 N C01-305/2016 in case N A59-2809/2015

⁵ Resolution of the Court for Intellectual Property Rights dated July 30, 2021 N C01-836/2021 in case N A56-70471/2020

⁶ Resolution of the Presidium of the Court for Intellectual Property Rights dated February 1, 2016 N C01-1157/2015 in case N SIP-380/2015

⁷ Resolution of the Presidium of the SIP dated 01.04.2014 N C01-148/2014 in case N SIP-110/2013

⁸ For example, the rulings of the Presidium of the Intellectual Property Rights Court dated September 24, 2018 in case No. SIP-107/2018, dated May 20, 2020 in case No. SIP-762/2019, dated December 14, 2020 in case No. SIP-1059/2019

⁹ Resolution of the Presidium of the Court for Intellectual Property Rights dated April 2, 2014 N C01-184/2014 in case N SIP-247/2013



CNIPA tightly regulates malicious trademark applications

Mr. Zhenkun Fu, Senior Partner at Corner Stone & Partners, details the new regulations surrounding malicious trademark applications in Chinese Trademark Law that will aid in the protection of genuine trademarks.

China has been continuously strengthening the protection of intellectual property rights (IPR) in every aspect in recent years. As the administrative authorities for trademark matters, China National Intellectual Property Administration (CNIPA) tightens regulation of "malicious trademark registration" in the stage of application filing. This is of great significance to stopping malicious trademark registration at the beginning. According to the CNIPA, from 2018 to 2020, more than 150,000 malicious applications for trademark squatting and hoarding were refused.



Mr. Zhenkun Fu

I. The concept of "malicious trademark registration"

i. The concept of "malicious trademark registration"

The concept of "malicious trademark registration" is not exactly defined by the legislature or the administrative authorities for trademark matters. As a subjective concept, "malice" is usually identified in specific cases by combining facts and legal provisions. The "malice" in trademark

registration alters over time. Now it is generally understood as "the act of filing an application for trademark registration against the principle of good faith or against established social norms".

ii. The circumstances where "malicious trademark registration" occurs

The act of "malicious trademark registration" alters over time. At present, the common circumstances where malicious trademark registration occurs are as follows:

- (i) Applying for registration of a trademark not for the purpose of using the trademark;
- (ii) Applying for registration of a trademark which is a reproduction and imitation of a well-known trademark of others;
- (iii) The agent, representative, associate or other stakeholder is trying to pre-empt the trademark;
- (iv) Infringing upon others' prior right and pre-empting a mark that has already been in use by others and has considerable influence;
- (v) Acquiring the registration or applying for registration of a trademark by fraud or any other improper means; and
- (vi) Violating the principle of good faith, harming socialist morals or customs, or having other unhealthy influences.

iii. Relevant Legal Grounds

The 2019 Trademark Law of the People's Republic



of China ("the Trademark Law") and the Several Provisions for Regulating the Applications for Trademark Registration ("the Provisions") both made general provisions for malicious trademark registration.

II. CNIPA's Special Action

In order to further crack down on malicious trademark squatting, the CNIPA decided to carry out a special action against the acts of malicious trademark squatting from March 2021 in accordance with the Trademark Law of the PRC, the Implementing Regulations of the Trademark Law of the PRC, and the Several Provisions for Regulating the Applications for Trademark Registration.

i. The special action focuses on cracking down on the acts of malicious trademark squatting, plotting for illegal interests, disrupting the order of trademark registration administration, and causing great adverse social influence, specifically:

- (i) maliciously pre-empting the names of national or regional strategies, major activities, major policies, major projects, and major technological projects;

- (ii) maliciously pre-empting the words and signs related to major natural disasters, major accidents, major public health events, social security incidents and other public emergencies to harm public interests;
- (iii) maliciously pre-empting the names and signs of major events and exhibitions with extensive publicity;
- (iv) maliciously pre-empting the names of administrative divisions, mountains and rivers, scenic spots, buildings and other public resources;
- (v) maliciously pre-empting the generic names and industry terms of goods or services and other public business resources;
- (vi) maliciously pre-empting the names of public figures, well-known works or role names with high popularity;
- (vii) maliciously pre-empting others' trademark or other trade name with extensive publicity or strong distinctiveness to harm the prior rights and interests of others;

“The special action focuses on cracking down on the acts of malicious trademark squatting.”

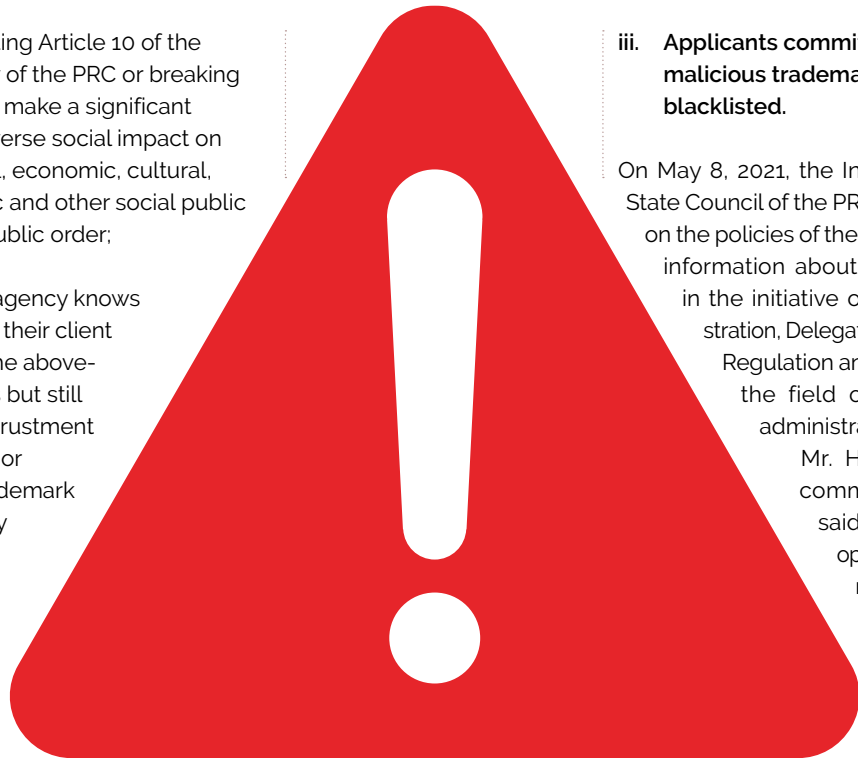
Résumé

Mr. Zhenkun Fu, Senior Partner; Trademark & Litigation Attorney

Zhenkun is a leading intellectual property law practitioner with more than 20 years' experience in prosecuting trademark and patent infringement, unfair competition, and anti-counterfeiting cases. His work with Fortune 500 companies has resulted in the recovery of millions of dollars in damages. As a leading IP litigator, having managed thousands of lawsuits, Zhenkun's groundwork and strategic insight, coupled with his exceptional relationships with AIC, BQS and PSB at national and local levels, makes him a key leader in intellectual property enforcement in China.



- (viii) obviously violating Article 10 of the Trademark Law of the PRC or breaking social norms to make a significant negative or adverse social impact on China's political, economic, cultural, religious, ethnic and other social public interests and public order;
- (ix) the trademark agency knows or should know their client is engaged in the above-mentioned acts but still accepts the entrustment from the client, or disturbs the trademark agency order by other improper means; and
- (x) other obvious violations of the principle of good faith.



iii. Applicants committing more acts of malicious trademark registration will be blacklisted.

On May 8, 2021, the Information Office of the State Council of the PRC held a regular briefing on the policies of the State Council, imparting information about deepening the reform in the initiative of "Streamlining Administration, Delegating Power, Strengthening Regulation and Improving Services" in the field of intellectual property administration

Mr. He Zhimin, one deputy commissioner of the CNIPA said: "The CNIPA resolutely opposes and promptly fights malicious trademark registration, and actively guides the whole society into building correct awareness of trademark registration."

For malicious applications for trademark hoarding which are not filed for the purpose of using those marks, a document will be issued separately for rectification.

ii. Carry out precision strikes throughout trademark registration

Strengthen the monitoring of the acts of malicious trademark squatting, realize the coordination among trademark registration, opposition, review and follow-ups, and promote consistent enforcement of standards.

For those case clues in the trademark registration process, the Trademark Office shall guide the local trademark examination and coordination centers into handling them according to law. Where an act of malicious trademark squatting is committed, the mechanism of quick refusal shall be initiated.

For those case clues in the process of trademark opposition or invalidation, where an act of malicious trademark squatting is committed, measures such as early examination and review, combined examination and review, and oral examination of major cases shall be taken to reject or invalidate the registration according to law.

Intensify the crackdown on trademark squatting which is not filed for the purpose of using the mark.

Those applications which are filed to pre-empt trademarks maliciously and then assign them at a profit shall be rejected according to law. Make full use of information technology to promote information sharing among all examination links.

“Where an act of malicious trademark squatting is committed, the mechanism of quick refusal shall be initiated.”

According to him, a blacklist system has been established, and some applicants committing more acts of malicious trademark registration will be blacklisted. New applications will be more tightly regulated. Nearly 1,000 applicants suspected of malicious trademark registration have been noticed.

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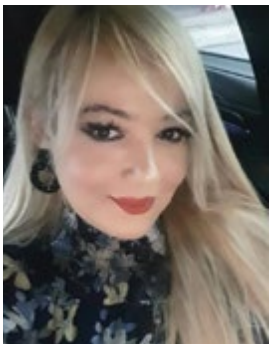
Dominican Republic: anti-counterfeiting measures available to trademark owners

Wendy Diaz of WDA International Law Firm provides insights about the current legislation ruling the anti-counterfeiting actions available to trademark owners in this jurisdiction.

The Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPS) came into force in 1995, as part of the Agreement Establishing the World Trade Organization (WTO). TRIPS incorporates and builds upon the latest versions of the primary intellectual property agreements administered by the World Intellectual Property Organization (WIPO), the Paris Convention for the Protection of Industrial Property, and the Berne Convention for the Protection of Literary and Artistic Works, agreements that go back to the 1880s.

TRIPS is unique among these IPR accords because membership in the WTO is a "package deal," meaning that WTO members are not free to pick and choose among agreements. They are subject to all the WTO's multilateral agreements, including TRIPS.

TRIPS applies basic international trade principles to member states regarding intellectual property, including national treatment and most-favored-nation treatment. TRIPS establishes minimum standards for the availability, scope, and use of seven forms of intellectual property: copyrights, trademarks, geographical indications, industrial designs, patents, layout designs for integrated circuits, and undisclosed information (trade secrets). It spells out permissible limitations and exceptions in order to balance the interests of intellectual property with interests in other areas, such as public health and economic development. (For the complete text of the TRIPS Agreement, as well as an explanation of its provisions, see



Wendy Diaz

the WTO website at www.wto.org)

The improvements made to the trademarks anti-counterfeiting legislation in Dominican Republic, in response to the WTO's TRIPS agreement, include The Dominican Republic becoming a member of the Paris Convention. Modifications include the TRIPS and confirms the local trademark law 20-00 of the year 2000 was made on the basis of TRIPS agreement and WTO and WIPO guidelines and provides imprisonment penalties to the counterfeiters, importers, and retailers, owners of warehouses, and everyone involved in the commercialization

Résumé
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Wendy is a Senior Trademark lawyer and litigator of WDA INTERNATIONAL LAW FIRM with more than 25 years of experience, representative of Fortune 500 companies including major U.S. and European; extensive experience in anti-counterfeiting with outstanding expertise in conflict resolution; has lodged border injunctions for the world's best-selling brands and won more than 500 trademark litigation cases; completed over 10,000 registrations. Award winner of the most important recognitions on the field and ranked in the top 10 Best Trademark Lawyers.

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or use in the Dominican Republic of a fake product and also provides the reimbursements of damages to the plaintiff.

In counterfeiting cases, the criminal case might be started upon a private party's request directly to the Intellectual Property Section of the Prosecutors Office in the jurisdiction where the counterfeits were found. This means basically that the trademark owner has the right to take the initiative to start a process that before was to be handled only by the prosecutor's office upon receipt of a formal complaint in accordance only to the criminal code and its procedure.

In order to have the public forces of the State assist the trademark owner on the case, the plaintiff must provide sufficient evidence justifying the veracity of the trademark ownership as well as providing reasonable proof of the counterfeit. The District Attorney would request a judge to issue a restraining order addressed to Customs in order to seize any counterfeit product bearing the trademark in question held at the Dominican ports of entry; the judicial process should be started immediately against the parties involved and the plaintiff should deposit a bond sufficient to guarantee the merchandise in the event the suit is dismissed by a judge.

In the event the products are already in the country these might be seized by the Prosecutors Office using the local police force; however, forfeiture and destruction or donation thereof might only be accomplished upon obtaining a final decision from a court of law.

In addition, damages and other forms of compensation, due to the profits lost for the counterfeiting actions, might be claimed before a civil court in Dominican Republic; on this concern, clients should be aware that the defendant is not held liable for damages until a final ruling is granted by the judge at the criminal court thus the civil court claim will only depend on the outcome at the criminal jurisdiction.

It is necessary in most cases to use an investigator service in order to gather sufficient information and evidence to be used in a court of law; this investigator should have previous experience on market research for counterfeiting cases. Thus, the investigator will have the task to complete all reference information about: importers, distributors, retailers.

In our experience, we advise our clients against prosecuting retailers provided in many cases they are unaware of the illegitimacy of their suppliers actions as they are bona fide users and are sometimes the only source of information as to the suppliers/importers/wholesalers and might be capable of identifying individuals responsible. Once the lawyers at WDA International Law Firm have all pertaining information in hand, the process will be followed as provided by the criminal process law on the basis of the Trademark Act, which provides felony penalties for infringement of trademarks.

As regards to retailers, in order to start the process in an amicable way, it is suggested to send to small retailers (supermarkets, convenience stores,

department stores) bailiff-served cease and desist letters including all legal provisions for such an infringement with a deadline for stopping the sale of the products. In the event the trademark owner wants such merchandise seized, it would be necessary to obtain an order from a judge and the process would need to be taken to the prosecutor's office for obtaining the order. This merchandise is not destroyed of course, until a final judge's ruling on the case is granted.

Border measures in Dominican Republic Customs

It is strongly advised for all clients to have the trademark registered at the Intellectual Property Section of the Dominican Customs, which process is similar to that established by the U.S. Customs and Border Protection (CBP). This way, Dominican Customs may send a notice to the trademark owner or the trademark lawyer on file every time a suspicious cargo is received and send pictures to representatives to verify or confirm counterfeit.

In addition, it is always a good idea to provide the IP section of Customs with a comparative guide showing the authorities the best way to identify a legitimate item and differentiate it from a counterfeit. This document, which is drafted by an experienced lawyer in the field with the assistance of the trademark owner, should showcase any previous labels of counterfeit found or of any that the trademark owner suspects will arrive at the border eventually as well as all the distinctive signals of the rightful trademark registration including label colors and indications.

As for the border's measures before customs authorities in Dominican Republic, i.e., to seize the merchandise, it is necessary to lodge the legal actions within 10 working days from the notice of Customs of suspicious imports to the trademark owner. As for the forfeiture and subsequent destruction of merchandise, this can only be done upon a Judge's decision and a bond will be necessary to be paid by the trademark owner in order to indemnify the importer in the event of a false accusation.

Thus, unlike the border measures available in other countries such as the United States where the Customs and Border Protection (CBP) might seize and forfeit and even destroy counterfeits without a court decision, we must submit strong and sufficient evidence of infringement as to prove that there is imminent harm to be caused to the trademark's lawful owner/licensee. In such cases, a monetary deposit is to be provided by the plaintiff with the court (calculated three times the value of the goods to be seized) as a bond for guaranteeing the defendant's rights or damages claim.

This order for customs to refrain from allowing the entrance of counterfeit products can be

started before, at the same time, or after the legal claim is filed with the court, but if started before the action should take place within the next 10 days.

Penalties provided by the law to counterfeiters/importers/retailers/warehouse owners/sales persons include:

Article 166 of our Trademark act 20-00 provides imprisonment from three months to two years and a fine of 10 to 50 minimum monthly wages (currently around US\$160.00);

Article 168 of our Trademark act 20-00 provides a damage claim to the plaintiff/owner of a trademark counterfeited.

Furthermore, article 175 of our Trademark Act 20-00 gives the formula to be used to calculate the damages as follows:

- As for the benefits that the rightful owner could have received if there was not unfair competition by the counterfeiter/infractor;
- As for number of benefits obtained by the counterfeiter as a result of the infraction;
- As for the amounts of money the infractor/counterfeiter would have had to pay to the rightful owner for a license of use, taking into account the commercial value of the goods and any license the rightful owner might already have agreed.

These types of cases involve intense legal expertise, personal actions of our attorneys going to the places of counterfeit, visiting ports, retailers, and most importantly, taking full responsibility for the cease of counterfeit actions by parties involved and sometimes even risking personal safety. For more information, the author can be contacted directly at w.diaz@wdalaw.com or www.wdalaw.com.

“It is always a good idea to provide the IP section of Customs with a comparative guide showing the authorities the best way to identify a legitimate item.”

“The defendant is not held liable for damages until a final ruling is granted by the judge at the criminal court thus the civil court claim will only depend on the outcome at the criminal jurisdiction.”



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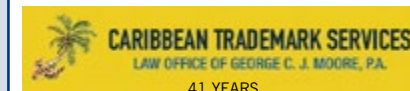


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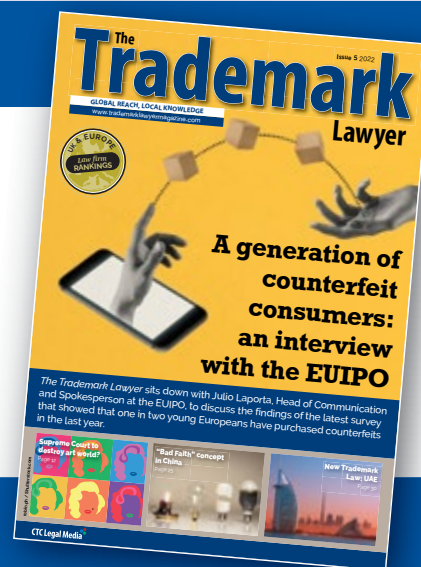
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