Welcome to Singapore!

Celebrating INTA’s 2023 Annual Meeting Live+ with our special bumper edition!

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Welcome to our INTA Annual Meeting 2023 Special Edition! And for those attending, welcome to Singapore! If you’re picking up The Trademark Lawyer for the first time then know that our magazines are also available in digital format via our website, with the latest issue always free-to-read.

Our guest interview this issue features Kristin Lamb, Associate General Counsel, VP of IP and Regulatory Compliance at ŌURA – an innovative technology company reshaping health monitoring with a passion for bettering users’ lives. This issue is packed full of updates on trademark and IP law, starting with the unusual rulings so far in the Jack Daniel’s Properties, Inc. v. VIP Products LLC case, questioning whether the humorous use of another’s mark really is a laughing matter. Further, we have a discussion on fraud claims: we take a look at name, image and likeness marks: an update on the Canadian trademark ecosystem; where the German Federal Court stands on third-party information from Google; and, amongst many other topics, a review of bad faith filings.

Our Women in IP Leadership segment features Simona Lavagnini, Founding Partner of LGV Avvocati, and Olga Plyasunova, Head of the Trademark Department at Zuykov and partners. Contact us to find out how you can support the segment and the continued empowerment of women working in IP.

We strive to keep the IP community up-to-date with the latest, sign up to our newsletter to received the latest news via our website. Enjoy the issue!

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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Editor’s welcome

Questioning whether the humorous use of another’s mark really is a laughing matter.

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Over 300 professionals
Over 180 patent attorneys and lawyers
A trademark team of 30 members

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

As a pioneer dedicated to intellectual property for more than 30 years, Sanyou is committed to pursue excellence and continues safeguarding IP rights for domestic and overseas clients with professionalism and craftsmanship.

Sanyou is the first firm being awarded as Outstanding Patent Agency by China Patent Office, a vice president member of ACPAA, a standing committee member of CTA, and a president member of CIPSA, etc.

After more than 30 years‘ development, Sanyou has become a comprehensive IP group providing all-round IP services for domestic and international clients from rights procurement to enforcement.

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

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Another extraordinary ECTA Conference is coming up on 28 June-1 July 2023 in Prague, the City of Magic. You will have the opportunity to network with hundreds of IP colleagues worldwide, meet remarkable speakers, and catch up with ECTA friends. The programme includes instructive sessions on the latest case law and IP trends, tailored workshops for young practitioners, exciting gatherings in the hottest spots, and Saturday excursions as the cherry on top. Are you new to the ECTA Conference? Long-standing members will welcome you at the first-time attendee reception ECTA at a Glance.

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

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

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

Enrique A. Diaz – Senior Partner, Goodrich Riquelme, Mexico
Enrique joined the firm in 1998, finished law school in 2002, and by 2010 he became the youngest lawyer to have ever been made senior partner in the firm’s history. He is currently a foreign expert on Latin-American intellectual property, managing the prosecution of over 1500 trademarks and more than 3000 patents per year.

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.

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Shelley Jones – Lawyer and Registered Trademark Agent, Canada
Shelley has a BCL/A and has worked with famous brands on trademark and copyright infringement, domain name disputes, and anti-counterfeiting issues. Her past practice involved managing global trademark portfolios. Shelley has been working on an IP strategic project focused on increasing IP awareness.

Stacey C. Kalamaras – Founder
Trademarkabilities, US
Stacey is founder and lead instructor of Trademarkabilities, a training academy for lawyers. Stacey is a seasoned trademark lawyer, having spent most of her career in Big Law representing many well-known brands in 50+ countries. She has prior business experience working in marketing and advertising. Since 2018 Stacey has educated more than 5000 lawyers on a variety of IP topics.

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MEXICO

MEXICO
US Supreme Court to rule on Jack Daniel’s proposal to throw ‘Bad Spaniels’ to the dogs

Max Vern and David P. Goldberg of Amster, Rothstein & Ebenstein LLP deconstruct the arguments brought against dog toy manufacturer VIP Products LLC, whose product humorously evokes similarities with the famous No.7 whiskey, to assess the suitability of the application of Rogers v. Grimaldi.

This Term, the US Supreme Court heard an appeal in a trademark case that is not just consequential, but also fun. The case involves claims of trademark infringement and dilution by famed US whiskey manufacturer Jack Daniel’s Properties, Inc. (‘Jack Daniel’s’) against VIP Products LLC (‘VIP’), a manufacturer of humorous dog toys. Jack Daniel’s Prods. v. VIP Prods. No. 22-148 (US argued Mar. 22, 2023).

Despite the whimsical nature of the claimed infringement, the case is of the foremost importance to trademark practitioners since Jack Daniel’s, inter alia, challenges the merits and validity of the decision in Rogers v. Grimaldi. 875 F.2d 994 (2d Cir. 1989), which sets forth the standard test that disparage others or are immoral or scandalous trademarks to be unconstitutional.

VIP is a manufacturer of dog toys. Among their products is a line of ‘Silly Squeakers’ toys, which humorously mimic familiar beer, wine, liquor, and soda bottles. One of these dog toys, dubbed BAD SPANIELS, is clearly meant to call to mind the appearance of a bottle of JACK DANIEL’S whiskey, but with a scatological twist. See Figures 1 and 2.

The dogfight between the companies goes back almost 10 years. Not finding the poop-themed toy at all humorous, and notwithstanding the fact that the BAD SPANIELS hang tag includes a clear disclaimer that the product is not sold or authorized by Jack Daniel’s (see Figure 3), the whiskey company sent VIP a Cease-and-Desist Letter. In response, VIP filed a lawsuit in the US District Court for the District of Arizona seeking, inter alia, declaratory judgment that its use of the BAD SPANIELS mark was neither infringing nor dilatory of Jack Daniel’s rights. Jack Daniel’s filed a counterclaim for both causes of action. In a bench trial, the District Court found in favor of Jack Daniel’s. However, the District Court’s decision was overturned by the Ninth Circuit Court of Appeals, which held that the District Court erred in finding that the BAD SPANIELS toy was not an expressive work subject to analysis under the laws forbidding registration of trademarks that disparage others or are immoral or scandalous trademarks to be unconstitutional.

In Rogers v. Grimaldi, the US Court of Appeals for the Second Circuit protected the rights of producers and distributors of Federico Fellini’s motion picture “Ginger and Fred” in a lawsuit by Ginger Rogers, who enjoyed legendary fame as Fred Astaire’s dance partner. The plaintiff asserted that the film violated the provisions of Lanham Act (the US Trademark Act) by creating the false impression that she sponsored, endorsed, or was otherwise involved in the film. The Second Circuit upheld the findings by the District Court that use of Rogers’ first name in the film title and in the screenplay was an exercise of artistic expression rather than commercial speech and that “because the speech at issue here is not primarily intended to serve a commercial purpose, the prohibitions of the Lanham Act do not apply and the film is entitled to the full scope of protection under the First Amendment.”

If, in the present instance, the Supreme Court holds in favor of Jack Daniel’s on this point, the case could mark a far more consequential rebalancing of the boundaries of free-speech and trademark protection than the Court’s recent decisions expanding the boundaries of the federal registrability of trademarks embodied in Metst v. Tam 137 S. Ct. 1764 (US 2017) and Iancu v. Brunetti 139 S. Ct. 2294 (US 2019), finding

Résumés

Max Vern is a Partner and David P. Goldberg is an Associate at Amster, Rothstein & Ebenstein LLP. Their practices focus on trademark law, and they are pleased to be able to help clients obtain, defend, and enforce their trademark rights while maintaining a sense of humor.
This Decision was affirmed the following two questions:

1. Whether humorous use of another’s trademark as one’s own on a commercial product is subject to the Lanham Act’s traditional likelihood-of-confusion analysis, or instead receives the heightened First Amendment protection?

2. Whether humorous use of another’s mark as one’s own on a commercial product is ‘noncommercial’ under 15 U.S.C. §1125(c)(3)(C), thus barring as a parody the use of the trademark as one’s own on a commercial product?

Ninth Circuit’s reasoning that a dog toy is an infringing product is ‘noncommercial’ for First Amendment purposes. The Supreme Court’s decision is expected by June 2023.

Against this background, where should we draw the line between commercial products and noncommercial product use in dilution cases? The Ninth Circuit’s analysis to stand, Jack Daniel’s argues, and Circuit Courts litigations. Against this background, where should we draw the line between commercial products and noncommercial product use in dilution cases? The Ninth Circuit’s analysis to stand, Jack Daniel’s argues, and Circuit Courts litigations.

In short, rather than abandoning the Rogers v. Grimaldi test, the Ninth Circuit reversed the lower court’s ruling on dilution and remanded the case for further proceedings on infringement. Because there is no standard test, courts make such determinations on a case-by-case basis. In this case, the Ninth Circuit reasoned that the toy communicates a “humorous message,” using word play to alter the serious phrase that appears on a Jack Daniel's bottle - “Old No. 7 Brand” - with a silly message - “The Old No. 2.” The effect is “a simple reference to the fact that the toy message “that business and product images need not always be taken too seriously”. Rogers v. Grimaldi was not authorized by the trademark owner, whether the trademark owner sells competing products, whether parody is common in the relevant industry, and how the parody targets the mark, evidence as to public perception of the parody, etc. But, first and foremost, what could distinguish many of the present cases, from Bad Spaniels to MetaBirkins, from the Rogers v. Grimaldi scenario is the motive for the humorous adaptation of the brand by the entrepreneurial (or so-called artistic) party.

Affording First Amendment protection to a message “that business and product images need not always be taken too seriously”.

The Ninth Circuit reversed the lower court’s ruling on dilution and remanded the case for further proceedings on infringement.
An interview with Kristin Lamb, Associate General Counsel, VP of IP and Regulatory Compliance at ŌURA

Kristin sits down with The Trademark Lawyer magazine to discuss her experiences, delving into the importance of the team mentality of outside counsel, a proactive approach to capturing IP often required for new technology, and the passion behind ŌURA’s innovations.

Can you start by explaining your pathway into IP and to your current role?

I studied Biochemistry in undergrad, initially thinking I would go into medicine. When I realized halfway through college that I wasn’t as committed to becoming a doctor as I would need to be to go down that long and difficult path, I wasn’t sure how to re-apply my major without losing time. I tried working in a laboratory as a research and development biochemist, and though that experience showed me that laboratory work was not my future career path either (the materials we worked with in the lab were photosensitive, so there were no windows, and I was a bit starved for human interaction after toiling over machines and materials all day), I did have the opportunity to co-invent a novel monomer that was intended to replace toxic BPA in dental composite materials (the material used for fillings and crowns). When I worked with a law firm to draft and file the patent application for my invention, I was introduced to patent law, and realized that I could apply my science background to another category of work outside the hospital or lab.

While in law school, I worked as a summer intern at the same firm that had drafted my patent application. During my summer there I had the opportunity to work on a wide variety of technologies – everything from implantable ocular lenses, to car engines, to kids’ toys – and I discovered how varied my work could be as a patent attorney, where I could maintain a diverse docket assisting clients with a wide range of technologies, features, and products. I loved the intersection of law, technology, and business, and decided to pursue IP law based on that experience. I later expanded my practice beyond patent prosecution, to include trademark, copyright, licensing, and litigation.

After pursuing private practice for many years, I transitioned to an in-house role at ŌURA. I was drawn in by the opportunity to build an IP program from the ground up, at a company that was growing rapidly and had a mission – to empower everyone to understand and take control of their individual health – that I could support and about which I am passionate. I was also energized by the opportunity to work closely with various parts of the business – from engineering and science, to marketing, communications, customer service, finance, and leadership – to support the many different aspects of intellectual property in a growing and innovative company.

In my current role as Head of IP at ŌURA, I see myself as a steward of innovation. I educate, advise, evangelize and advocate, celebrate and reward, seek out and identify, protect, enforce, and defend innovation throughout the company. I am fortunate to work at a company that has such a personally relatable mission and product. Everyone at ŌURA wears an Oura Ring, so everyone at the company, regardless of their background or role, has valuable insights on what would make our products and services more useful for themselves and their friends and families. Harnessing, encouraging, and celebrating those ideas is one of the great joys of my role at ŌURA.

I also work to protect and defend our brand, and am involved in all aspects of our trademark and copyright efforts, and I lead our regulatory compliance function as well.
Can you introduce ŌURA and the technology that it offers?

ŌURA is a technology company that specializes in developing wearable devices and software for tracking and improving overall wellbeing, with an emphasis on sleep, activity, and recovery. The company was founded in 2013 in Finland and has since become one of the leading companies in the field of sleep tracking and health monitoring.

ŌURA’s flagship product is the Oura Ring, a smart ring that measures a user’s heart rate, body temperature trends, respiratory rate, and movement to provide a comprehensive picture of sleep quality and overall health. The Oura Ring also tracks daily activity and provides insights into recovery and readiness for physical activity.

The Oura App, which is compatible with iOS and Android devices, provides users with personalized insights and recommendations based on their data, as well as the ability to connect with other health and wellness apps and devices. ŌURA has also partnered with several research institutions to further understand the relationship between sleep and health.

ŌURA has received several awards and accolades for its technology, including being named one of Time Magazine’s Best Inventions of 2020. The company has a growing user base and has received funding from several venture capital firms to support its continued growth and innovation. In 2022, we sold our 1,000,000th Oura Ring, and have continued to steadily gain popularity worldwide.

How is ŌURA innovative in comparison to other health-tracking technologies available on the market?

Focus on Sleep: ŌURA is one of the few companies that specializes in sleep tracking and health monitoring, whereas many other wearables companies primarily focus on fitness and activity tracking. ŌURA’s technology is designed to provide users with a comprehensive understanding of their sleep quality and the factors that affect their sleep, which is increasingly being more broadly recognized as a critical component of overall health and wellness.

Ring form factor: The Oura Ring is a unique form factor compared to other wearables like watches and fitness bands. The Oura Ring is comfortable to wear and is unobtrusive, making it easy to wear at all times, including during sleep. Additionally, the ring provides a unique and superior location for monitoring, as it provides a stronger and clearer signal than can be obtained from the back of the wrist.

Advanced sensor technology: ŌURA’s sensor technology is among the most advanced in the wearables market, with the ability to track a range of biometric data, including heart rate variability, body temperature trends, and respiratory rate. In developing our product, we have put an emphasis on providing research-level data. This allows for more accurate and detailed insights into sleep quality and overall health.

Personalized insights and recommendations: The Oura App provides personalized insights and recommendations based on a user’s individual data, allowing them to take actionable steps to improve their sleep and overall health. The ability to wear the Oura Ring for extended periods of time, facilitated both by the more comfortable and less intrusive form factor, as well as by a longer battery life than most wearables, also allows for more continuous data collection. This allows the Oura App to provide more tailored health and sleep insights based on long-term trends observed by the user.

Scientific research partnerships: ŌURA has partnered with several research institutions to further understand the relationship between sleep and health, including the University of California, San Francisco, and the Finnish Institute of Occupational Health, among many others. On the whole, our company is committed to evidence-based approaches to health monitoring and innovation.

What process do you use to capture IP?

There is so much innovation happening among the different technical teams at ŌURA, and it is important to me that my team proactively identifies, harvests, and protects it. Rather than waiting for inventors to submit invention disclosures on their ideas (we certainly don’t turn them down if offered), my team sits in on technical teams’ weekly meetings to hear what they’re working on so that we can identify potentially protectable ideas. If the ideas are in the early stages, we follow along in their development until they’ve reached a protectable stage. Then we fill out disclosure forms on behalf of the inventors, and seek their input for additional information or supporting documents or figures as needed. The idea is to remove any barriers to participation in the patent process for inventors so that they are more inclined to participate, despite their otherwise demanding workloads. We have found a lot of success in this method, and have grown our portfolio exponentially over the past couple of years.

We also regularly host brainstorming sessions on one or more topics of strategic interest, which we open up to anyone at ŌURA who might be interested in the topic. These sessions provide a unique opportunity for blue-sky inventing, without being confined by current commercial plans or resources, and often lead to very rich patentable ideas.

Last year, we hosted the company-wide Hack-Week, which attracted participation from nearly half of the company globally from almost every practice group, including non-engineering functions. As a result of that hack, we were able to identify and secure dozens of unique inventions, while also building enthusiasm around innovation and promoting collegiality and top-down normalization.

We are uniquely positioned at ŌURA, in that every employee wears and interacts with our products daily, and therefore has valuable input on what would improve our products, and offerings for themselves and their loved ones. So I make sure to harness those ideas through a company-wide slack channel that rewards anyone at the company who submits an idea that makes its way into a filed patent application, even if the person who submitted the idea does not rise to the level of inventor for patent purposes. This promotes a company-wide culture of innovation, and allows everyone to feel like a stakeholder and contributor to innovation at ŌURA. Through this channel, I have been able to file applications attributable to members of a number of non-engineering teams, like legal, marketing, customer service, management, etc.

Has ŌURA encountered any difficulties while building its patent portfolio?

Our initial struggle was in identifying the innovation that was already happening at ŌURA. The more typical practice of putting the impetus on the engineers to identify their innovations, fill out invention disclosure forms, and submit them to legal was not working for our org, and was resulting in a lot of overlooked innovation. Instead, we decided to go straight to the teams to learn for ourselves what they were working on so we could identify potentially protectable ideas. If the ideas are in the early stages, we follow along in their development until they’ve reached a protectable stage. Then we fill out disclosure forms on behalf of the inventors, and seek their input for additional information or supporting documents or figures as needed. The idea is to remove any barriers to participation in the patent process for inventors so that they are more inclined to participate, despite their otherwise demanding workloads. We have found a lot of success in this method, and have grown our portfolio exponentially over the past couple of years. We also regularly host brainstorming sessions on one or more topics of strategic interest, which we open up to anyone at ŌURA who might be interested in the topic. These sessions provide a

This quality of working as a team and providing proactive support is very important to me.

Under what circumstances do you use outside counsel at ŌURA?

Because my IP team at ŌURA is small (just my Finnish IP Manager and myself, at the moment), we rely heavily on outside counsel for all patent drafting after first working closely with them to develop the drafting strategy and scope. I also have a team of outside counsel who assist with

AN INTERVIEW WITH KRISTIN LAMB

THE TRADEMARK LAWYER

CTC Legal Media
I am always developing our portfolio with an eye for both defensive and offensive value.

Do you believe it is important to prepare for potential litigation when preparing and maintaining an IP portfolio? If yes, how would you work to prepare?

Certainly. Especially as a young but quickly growing company, litigation will increasingly become a part of our experience and strategy going forward. I am always developing our portfolio with an eye for both defensive and offensive value. One of the ways I do that is by pushing both our inventors and our counsel to think broadly about the scope of any given invention, beyond any current iteration or roadmap, so that we can clear a path for ourselves for future development. This gives us both defensive and offensive protection as we expand beyond our current offerings.

How has ŌURA leveraged IP to stand out in a saturated market?

I would challenge the premise of this question, actually. While the wrist-based wearables market may be well-established, ŌURA is at the forefront of smart ring innovation. And even more broadly, wearables have typically addressed activity monitoring with generic feedback, whereas ŌURA is focused on giving tailored insights into individual members’ health and wellbeing, based on highly accurate data that can be relied upon by our members’ doctors and caregivers. So it is not our experience that we are competing in a saturated market at all, but rather that we are leading the way in an industry that is just starting to shift its focus from novelty tracking to providing research level insights to help individuals understand their health and wellness on a personal and actionable level.

Where do you hope ŌURA will be in five years’ time?

Our form factor and focus on accuracy allow us to gather continuous temperature trend, heart rate, and movement data, which together serve as the basis of innumerous health insights. We have only just started to scratch the surface of what can be tracked, measured, and translated into actionable insights based on those three data sets. While we focus primarily on sleep and activity now, I am excited to see all of the ways in which ŌURA can help our members to better understand their overall health and wellbeing in the future. In five years’ time, I think we will look back and feel a bit incredulous at how little we used to know about our bodies, and how much we had to rely on yearly medical spotchecks, rather than having control over and visibility into our physical state on a daily basis, and I believe ŌURA will be a primary contributor to that shift.
Avoiding fraud attacks on US trademarks

Britt Anderson, Partner at Perkins Coie, details strategies against fraud claims to US trademarks in defense and enforcement.

Chutter may increase bases of attack

In oral argument on March 6, 2023, in Great Concepts LLC v. Chutter Inc., Case No. 22-1212, the United States Court of Appeals for the Federal Circuit (‘Federal Circuit’) considered for the first time whether the US Trademark Trial and Appeal Board (TTAB) wrongly granted cancellation of a trademark registration because a lawyer signed an affidavit of use without reading it. The facts at play in Chutter are only another variation in the circumstances that may permit a claim of fraud to be asserted against a US registration in a contest over trademark rights. Even with a high bar to proof and pleading, allegations of fraud are frequently used by defendants to attack brand owners’ registered trademark rights in the United States, despite the Federal Circuit’s finding in In re Bose, 580 F.3d 1240, 1245 (Fed. Cir. 2009), that a specific intent to deceive the U.S. Patent and Trademark Office (USPTO) is required to cancel a registration on the ground of fraud.

Bose sets narrow guardrails for fraud claims

Since 2009, Bose has been the dominant legal framework for determining both sufficiency of pleading and proof of trademark registration fraud claims before the TTAB. As articulated in Bose, fraud in a trademark registration occurs when an applicant for registration, or a registrant in a post-registration setting, knowingly makes a false, material representation of fact in connection with an application to register, or a post-registration document, with the intent of obtaining or maintaining a registration to which it is otherwise not entitled. See id. at 1245. Bose imposes the heavy burden of proving fraud with clear and convincing evidence. Id. at 1243. Further, the Bose court held that intent to deceive is an indispensable element of the analysis in a fraud case, making it stricter than the standard for negligence or gross negligence. Id. at 1242. In Bose, the declarant in a post-registration affidavit falsely stated that the mark was in use. However, the Federal Circuit found no intent to deceive because the declarant did not have guidance from any prior USPTO or court ruling as to whether the circumstances the declarant relied on as indicating use in commerce were sufficient.

How can fraud claims affect trademark rights?

US trademark fraud claims generally center around when applicants furnish use information and specimens to support registration of their trademarks, but claims may also involve post-registration submission of affidavits and materials supporting continued registration of the mark. A successful fraud claim may result in cancellation of a registration critical to a subsequent infringement claim in a US federal court or to success in an opposition proceeding at the TTAB. Most importantly, cancellation may leave a trademark owner with only a common law infringement claim, which may preclude a preliminary injunction or summary judgment. Moreover, while a federal registration is not mandatory to assert prior trademark rights under US trademark law, trademark registration provides critical statutory benefits both for enforcement and defense. For example, cancellation of a registration means that a trademark owner lacks a statutory presumption of exclusive right to use. See 15 U.S.C. §1057(b). With only a single, narrow exception, counterfeiting provisions under US trademark law apply only to registered trademarks, 15 U.S.C. §1116(d), so assessment of treble damages

Résumé

Britt Anderson is a Partner in Perkins Coie’s Intellectual Property Law practice where he represents clients before US federal courts and the US Trademark Trial and Appeal Board, helping them develop strategies for trademark enforcement, defense, and protection.

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for counterfeiting violations does not apply unless there is a registered trademark covering the goods. 15 U.S.C. § 1127(b). In defense against certain trademark dilution claims, ownership of a valid registration is a complete bar to claims. 15 U.S.C. § 1117(c)(1).

Even fraud allegations without a decision can add a dimension to a case that substantially increases the burden of litigation by deepening the targets of written and testimonial discovery. A trademark owner may find settlement drawn out or elusive resulting from the uncertainty created by an unexpected fraud allegation. Fraud claims can also be brought over five years after registration, unlike a cancellation claim for like-lihood of confusion, causing raising questions of fraud. Registration, unlike a cancellation claim for like-lihood of confusion, causing raising questions of fraud.

Fraud claimants can cast a broad net
Despite the indispensable element of intent – not just direct statements by a trademark owner but also indirect and circumstantial evidence. This increases a claimant’s pathways to attempting to show or prove fraud if false statements have been made.

Even with a high bar to proof and pleading, allegations of fraud are frequently used by defendants to attack brand owners’ registered trademark rights in the United States.

For example, the TTAB found clear and convincing evidence of fraud in Nationstar Mortgage, LLC v. Mujahid Ahmad, 112 USPQ2d 1361 (TTAB 2014), despite the lack of direct evidence of deceptive intent by the applicant. In Nationstar, the applicant, Mujahid Ahmad, filed a use-based application for NATIONSTAR on April 20, 2006 alleging use of the mark in commerce since April 4, 2005, in connection with broad real estate, insurance, and business finance services. The opponent, Nationstar Mortgage LLC, filed applications for NATIONSTAR MORTGAGE that were blocked by the applicant’s earlier application. Nationstar Mortgage followed with an opposition to the applicant’s application alleging fraud because the applicant had not used its mark in connection with the identified services on or prior to the filing date of his application. Information revealed in discovery showed that Ahmad had not become a real estate broker and had not incorporated under the name until after the date of the in-use application; it also revealed that Ahmad was not able to provide evidence of use at the time of the application other than its own oral testimony. Based on these facts, the TTAB found that Ahmad knew and understood at the time of filing that it was not using the mark for the applied-for services and made false statements with the intent to deceive the USPTO into granting registration. In subsequent infringement litigation, the TTAB’s decision against Ahmad was found to be preclusive in Nationstar Mortgage’s motion for summary judgment. Nationstar Mortgage, LLC v. Ahmad, 115 F. Supp. 3d 984, 993 (E.D. Va. 2015).

In defense against certain trademark dilution claims, ownership of a valid registration is a complete bar to claims.
It is imperative for trademark owners to take affirmative steps to minimize risk of fraud claims.

Best practices to avoid fraud claims

Chutter may well lead to an expansion of circumstances in which fraud can be proven, but even without the TTAB’s expansion of intent to deceive to include reckless disregard, it is imperative for trademark owners to take affirmative steps to minimize risk of fraud claims. Specifically, to make sure that they’re in the best possible position to defend fraud claims, trademark owners should:

1. Investigate the facts carefully and read documents thoroughly before filing them with the USPTO;
2. Assess goods and services for actual use when filing affidavits asserting use and avoid reliance on overly broad claims or descriptions developed for non-US jurisdictions;
3. Conduct diligence and delete goods or services on which the mark has not been used;
4. Keep records documenting use of a mark on all goods and services in an application or registration;
5. Be candid in USPTO communications; and,
6. Particularly where business conditions have changed or trademark assets are acquired, audit all registrations and pending applications to ensure the information in them is absolutely correct. If any discrepancies are discovered, the trademark owner should consider petitioning to amend the application or registration before it faces a challenge.

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

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

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THE TRADEMARK LAWYER
The Canadian trademark ecosystem: what to consider for 2023

Micheline Dessureault, Caroline Guy and Simone Ndiaye of Therrien Couture Joli-Coeur LLP provide vital information to stay up-to-date with protecting IP in Canada.

In the 2022 INTA edition of the Trademark Lawyer magazine, we presented you with an overview of the Canadian trademark ecosystem and the 10 things you absolutely need to know! This year’s article provides updates and new items to look out for when dealing with trademark issues in Canada.

Official bilingualism in Canada: new legislation that impacts non-French trademarks

One of the specificities of Canada is the fact that it has two official languages, English and French. The last national census performed by Statistics Canada in 2011 showed that only about 18% of the population is bilingual, and around 20% speaks French as an official first language. More recent sources indicate that those numbers may have decreased, and some are even sounding the alarm about French culture and language being disappearing. This unique context has led Quebec to reinforce its legal protection of French in the province, bringing important modifications to the Charter of the French Language. These modifications affect businesses, non-profit organizations, government agencies, workers and consumers. Bill 96 (“An Act respecting the official and common language of Quebec, French”) received royal assent on June 1, 2022. Although most of the provisions regarding trademarks will only be coming into force on June 1, 2025, trademark professionals should be aware that this delay was given for organizations to make necessary adaptations and for regulations to be drafted and enacted, with some urgent steps which need to be taken as soon as possible.

Although Bill 96 applies only to Quebec, its impacts on intellectual property are Canada-wide. For example, brand owners who sell their products in Canada generally use the same brand and packaging in all provinces and they are not always aware of where their products end up through Canadian distribution and retail channels.

As of June 1, 2025, in the province of Quebec, non-registered trademarks in a language other than French will need to be translated when they are used on products and commercial signage and advertising. Also, if a French version of the registered trademark has been filed, this French version will be the one which must be used in Quebec.

Moreover, generic or descriptive terms in any language other than French such as “moistening soap” or “sugar free”, will need to be translated into French on products or any attached medium, even if they are included in the registered trademark.

Bill 96 further mandates the predominant presence of French on public signage and commercial advertisement with a French text outside premises. A non-French trademark, visible from outside a building, must be accompanied by French text that is “markedly predominantly”, meaning that the text in French must have a greater visual impact. Generally, the text in French will be considered to have a greater visual impact if it is double the size or the quantity of the text in another language.

Considering that the current delay to obtain a trademark registration in Canada is approximately two to three years from the filing of the application, it is therefore high time for trademark practitioners and owners to file their applications for non-French trademarks. The pending regulations will contain more specific guidelines. Both the International Trademark Association (INTA) and the Intellectual Property Institute of Canada (IPIC) have been meeting with CIPO with a view to both the billing and the regulations being implemented consider brand owners’ interests.

It is also important to mention that in the case of noncompliance with the new requirements, injunction is one of the legal means that the Quebec Government will have at its disposal to force compliance with the law and regulation, in addition to substantial fines.

Backlog at the Canadian Intellectual Property Office (“CIP0”)

CIP0 still has a huge backlog of trademark applications awaiting examination. If the application was filed without using CIP0’s preapproved list of goods and services terms, it currently takes more than three years for the application to be examined, excluding Madrid protocol trademark applications. It can also take many months for re-examination after a response to an examiner’s report, for both national and Madrid applications.

CIP0’s preapproved list of goods and services is not exhaustive, although it regularly adds new goods and services to its list. Trademark agents are also encouraged to propose new terms to be added to this list, which may be useful for complex innovative products and services. We have yet to see if CIP0 will issue a non-French trademark.

Micheline Dessureault, a partner at Therrien Couture Joli-Coeur LLP, and Caroline Guy and Simone Ndiaye of Therrien Couture Joli-Coeur LLP provide vital information to stay up-to-date with protecting IP in Canada.

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Caroline Guy is a Canadian attorney and a trademark agent at Therrien Couture Joli-Coeur LLP. She has been working in the Intellectual property field for 20 years. Her practice is focused on trademark prosecution. She also represents her clients in trademark opposition and espousal proceedings. She is a member of the Intellectual Property Institute of Canada (IPIC), RICO (Regulatory Information Committee of Canada) and the International Trademark Association (INTA), where she currently sits on the Harmonization of Trademark Law and Practice committee.

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Résumés

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Generic or descriptive terms in any language other than French, such as “moistening soap” or “sugar free”, will need to be translated into French on products or any attached medium, even if they are included in the registered trademark.”
IP service fees increase starting from January 1, 2024

In Canada, CIPO is the authority responsible for the examination, granting, and registration of IP rights, namely, patents, trademarks, industrial designs, copyrights, official marks, geographical indications, integrated circuit topography, and plant breeders’ rights.

Previously, slight adjustments to the official fees were made at the beginning of each year. CIPO not having substantially updated its IP service fees since 2004 and therefore, not accounting for inflation over the last 18 years. According to CIPO, “revenues from fees no longer cover the costs required to deliver services” and this situation has resulted in a structural deficit.

To improve its financial situation and allow CIPO to deploy its IP strategy, “CIPO has proposed increasing its fees by 25% in an effort to catch up with the near 30% increase in inflation since 2004.”

The draft regulations have been approved and published in the Canada Gazette of December 31, 2022 and were submitted for comments to the industry. Once the final regulations are published in the Canada Gazette, they will come into force normally on January 1, 2024. Therefore, be prepared to pay additional official fees as of January 1, 2024, and trademark practitioners and owners should plan on filing their new trademarks in 2023, if and when possible.

Written licenses and control over the use of trademarks by licensors

A recent trademark invalidity decision rendered by the Federal Court of Canada demonstrates the importance of written license agreements and control over licensees. Without going into the complex details of the case, one of the many restaurants using the MILANO Design trademark without any written license was sold by the licensee. The purchaser continued the use of the trademark, also without any written license by the owner of the mark.

The trademark registration was invalidated, amongst other reasons, for lack of sufficient control by the licensor over the use of the trademark. The Court also concluded that the mark was not distinctive because the licensor tolerated its use by the purchaser of the restaurant, without any written license being in force. The control over the pizza’s ingredients was not considered sufficient because there was a lack of control over the finished products. In addition, a third party had been using a confusingly similar trademark for many years which also undermined the distinctiveness of the mark.

It is therefore highly recommended that written licenses be signed in Canada (including between related entities), and that control is in fact exercised over users of the trademarks, such as by implementing product quality testing.

Conclusion

Canada has its own specificities that are important to understand and are often quite complex and unfamiliar to foreign trademark practitioners and owners. Canada is party to many bilateral and multilateral trade treaties, including with the US, the EU and others, as well as a member of the Madrid Protocol. As a result, filing for trademark protection in Canada should certainly be considered.

With all the new legal implications regarding languages in Canada, advice should be sought to ensure a smoother transition for organizations already selling products and services in Canada or those that are considering it, while keeping in mind that products sold in the US may well end up making their way north to Canada, without the trademark owner even being aware of it. Finally be sure to look out for our 2024 update in next year’s INTA issue of The Trademark Lawyer magazine, to stay informed about our unique Canadian trademark landscape.

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Detlef von Ahsen, Partner at KUHNEN & WACKER, discusses claims concerning the provision of information against infringers of property rights and platform operators.

Time and time again, providers of goods and services that infringe on property rights make use of internet marketplaces and paid adverts on internet search engines to distribute the same. While the operators of the marketplaces and search engines have meanwhile introduced well-attuned processes to remove such offers from the marketplace or the search engine, at the latest upon the proprietor’s request (so-called take-down procedures), oftentimes the question arises in how far the operator of the marketplace and/or the search engine is liable to the proprietor. Among other things, this concerns the information to be provided by the operator to the proprietor, so that the proprietor may calculate and claim damages from the provider of the goods or services infringing their rights, i.e., from the buyer of the advert (in the following shortened to buyer). The German Federal Court of Justice (BGH) had to rule in such a case this July (BGH I ZR 121/21 – Google-Drittauskunft; Third-Party Information from Google).

Underlying facts of the ruling
The complainant is the proprietor of a German word mark registered, among other things, for the services of disposing of waste and utilizing it by means of recycling. The word sign is further used by the complainant as a company sign for their sphere of business.

Using this sign, a buyer ran an AdWords advertisement campaign on Google to offer disposal services. Thus, when entering the sign in question into the search engine by Google, the attention of the person searching for this search term was immediately called to the offer of the buyer, and they
THIRD-PARTY INFORMATION FROM GOOGLE

Kuhner & Wacker
THIRD-PARTY INFORMATION FROM GOOGLE

Remé Détele von Ahsen

The Court of Justice of the European Union overturned the ruling of the Court of Appeal, which had been in favor of the complainant and dismissed the case overall. The court held that the complainant was not entitled to the contested information.

Section 19 para. 1 sentence 1 of the German Act on the Protection of Trade Marks and other Signs (Trade Mark Act) allows for the proprietor of a trademark or a commercial designation to sue an infringer for provision of information regarding the origin of a product or a service. However, there was no special legal relationship between the parties in the present case, which would have been required for the application of section 242 of the German Civil Code.

Conclusion

The claims concerning the provision of information from infringers and platform operators the preparation of claims for damages against the infringer and therefore constitute an important part of the process that enables the proprietor to calculate and consequently enforce the claim for damages. Even though this is not significant for the decision in the current dispute, the author deducts from the ruling that the German Federal Court of Justice principally confirms the claims concerning the provision of information against the platform operator in the ruling “Third-Party Information from Google” set out hereinafter. However, the German Federal Court of Justice clarifies that a proprietor of a trademark or a commercial designation is only entitled to the claims concerning the provision of information explicitly set out in section 19 para. 3 of the Trade Mark Act. Even though the decision was made with respect to trademark law, it should also cover other property rights, seeing as substantially the same regulations for the claim concerning the provision of information are applicable.

No further claims based on good faith (section 242 of the German Civil Code) either

Even in view of good faith (section 242 of the German Civil Code), this information cannot be required from Google. In accordance with this regulation, the proprietor has in addition to the claim according to section 19 of the Trade Mark Act, a non-independent claim concerning the provision of information in order to prepare and enforce a claim for damages against the infringer. However, there was no special legal relationship between the parties in the present case, which would have been required for the application of section 242 of the German Civil Code.

Information requested regarding the number of clicks

The wording of section 19 para. 3 No. 1 of section 19 para. 3 No. 1 of the Trade Mark Act – such as the German-language version of Art. 82(b) of the Trade Mark Directive – directly justifies only an obligation to provide information concerning “the quantity of the goods manufactured, delivered, received or ordered” as well as “the prices paid for the goods or services concerned”. Hence, there is no explicit reference to information as regards the information on the quantity. With reference to other language versions of the Trade Mark Directive, such as the English, French or Spanish version, however, the German Federal Court of Justice arrived at the conclusion that the provision of information concerning the quantity of the services provided, received or ordered may also be required. But even under this assumption in favor of the complainant, they would not be entitled to the requested information regarding the number of clicks, seeing as the trademark is not registered to the inquired services, but was merely the subject of an AdWords advert. Again, an analogous application of section 19 para. 3 of the Trade Mark Act did not come into consideration.

Information requested regarding the price of the AdWords advert

In this regard, the German Federal Court of Justice agrees with the opinion of the Court of Appeal that the “services” in the sense of section 19 para. 3 No. 2 of the Trade Mark Act are not the services used for the infringing activity by the infringer, but the unlawfully identified services in the sense of section 19 para. 1 of the Trade Mark Act. The court held that an analogous application of section 19 para. 3 No. 2 of the Trade Mark Act was out of the question. Further, the price paid by the buyer to the respondent for the AdWords advert was not a price “paid for the goods or services concerned” in the sense of section 19 para. 3 No. 2 of the Trade Mark Act.
Coexistence of Trademarks in China

Wei He of Beijing Sanyou Intellectual Property Agency Ltd. explains coexistence agreements for similar trademarks in the Chinese market, including those in the same class, and provides advice for application.

The so-called coexistence of trademarks refers to the coexistence of identical or similar trademarks owned by different parties, which are used or registered in association with the same or similar goods/services, based on the provisions of law or the agreements reached between those parties. The trademark coexistence is different from the trademark coexistence agreement, from the perspective of judicial practice, trademark coexistence in China can be divided into two forms in terms of content:

Coexistence under agreement: It refers to the coexistence of similar trademarks based on a consent letter or agreement. The coexistence agreement is a typical type. A trademark coexistence agreement refers to it reached by two or more companies on their own commercial judgement and consideration, allowing similar trademarks to coexist on the same or similar goods. As to whether the coexistence agreement can be accepted, the trademark examination department or the judicial authority will still regard the coexistence as not to cause market confusion as the principle of judgement.

Coexistence based on legal provisions: It is also known as statutory coexistence or the coexistence of unregistered trademarks and registered trademarks. I will introduce the case for your reference. Beijing Duck King applied for registration of the trademark “Duck King” for the service of Restaurants in Class 43. Beijing Duck King filed the opposition against the trademark owned by Shanghai Duck King. The Beijing high court confirmed that Shanghai Duck King had no intention of taking advantage of the goodwill of Beijing Duck King and it didn’t try to associate the business with Beijing Duck King so as to confuse the relevant public. Therefore, it was finally determined that Shanghai Duck King’s filing of the trademark application was not improper. The Beijing High Court confirmed that Beijing Duck King had gained certain popularity and influence in the Beijing area before Shanghai Duck King applied for the trademark of Duck King. However, Shanghai Duck King has developed its own reputation and brand influence by carrying out relevant business activities in Shanghai with its owned trademark.

Considerations for acceptance of trademark coexistence agreement
In practice, the court generally judged whether the coexistence agreement can be accepted by considering whether the trademarks are too similar to each other or whether there is a likelihood of confusion among the public.

Form and content of trademark coexistence agreement:
• The specific information of the trademark must be identified: conditions or time limit cannot be attached, and whether there exists an agreement in the content to avoid confusion and misunderstanding.
• Content to avoid confusion: Due to different nature, function, use, relevant consumers and distribution channels of the products under these two brands, and the difference between the two trademark specimens, the co-existence of the trademarks in the market will not cause confusion.

“"The trademark agreement submitted by the owner of the applied-for trademark should not be taken as the sufficient reason for the approval of registration of the applied-for trademark."

Résumé
Wei He joined Beijing Sanyou Intellectual Property Agency Ltd. in 2015. She has practiced as a trademark attorney for more than 10 years. She has handled and supervised many trademark opposition cases for many well-known companies in China and abroad. She has rich experience in strategy planning on trademark management and protection, trademark opposition in China and abroad, and Madrid international trademark application. She is actively involved in the Chinese and international IP forums, sharing her knowledge and experience of IP practice in China with clients at home or abroad. She is engaged in research for Trademark Law. and Trademark practice in China and foreign countries and has published several articles in periodicals and magazines in China and abroad, including “Analysis of Trademark Use Systems in China and EU” published in the magazine The Trademark Lawyer, and “Trademark examination and analysis of Trademark Use Evidence in U.S.” published in China Trademark magazine.
COEXISTENCE OF TRADEMARKS IN CHINA

• If the previous trademark owner is a foreign company or person, the original notarized and legalized consent letter signed by the authorized person shall be provided.
• Documents proving that the person signing the letter of consent is authorized to do so must also be provided.

Degree of likelihood of confusion: The greater the similarity of the two trademarks, and the more similar the goods designated or approved to be used are, the greater the possibility of likelihood of confusion is, therefore, the more careful the verification of the effectiveness of coexistence agreement should be. The greater the degree of similarity of the goods will largely take reference from the Nice classifications, which is an international classification of goods and services applied for the registration of marks. But the areas, such as the products, services, and location of both parties will be considered at the court stage.

Review of refusal to trademark No. 1210634 No. 1210634 (2017 Jing Administrative No. 1124]
Disputed trademark: Cited trademark: "OCULUS" and devices, Designated goods: computer; monitor (computer hardware); "OCULUS" and devices. Designated goods: virtual reality game software

The coexistence agreement was accepted finally. The determination of the trademark case of "Wubigao" which is owned by a pharmaceutical company: Beijing High People’s Court held the designated goods of the applied-for trademark are closely related to agricultural products and other chemical agents, soil disinfection agents, and agricultural fungicides. Since those goods are closely related to agricultural products and the ecological environment, the trademarks will likely do harm to the public interests. Accordingly, the trademark agreement submitted by the owner of the apply-for trademark should not be taken as the sufficient reason for the approval of registration of the applied-for trademark.

Change on examination standard for coexistence agreement in trademark review and adjudication
The majority of coexistence agreements in the stage of trademark review and adjudication are limited to the coexistence agreement should be. The greater the degree of similarity between trademarks, the classifications of the designated goods and whether the coexistence will impact the social and public interests should be taken into consideration.
Trademark case of “Aligefu” which is owned by a pharmaceutical company: The Supreme People’s Court held the designated goods of the applied-for trademark are chemicals such as pesticides and some others in Class 3, which contain the goods of pharmaceuticals, Medical nutritional products, and are closely related to the social public interests. Although the signing of a coexistence agreement or a letter of consent by the trademark applicant and the cited trademark owner is a kind of disposal of private rights and therefore should be given respect, it should be established on the premise of not damaging the national interests, the social public interests and the other parties’ legitimate interests. In this case, both trademarks are used in association with such goods in Class 3, as pesticides and other chemical agents, soil disinfection agents, and agricultural fungicides. Since those goods are closely related to agricultural products and the ecological environment, the trademarks will likely do harm to the public interests. Accordingly, the trademark agreement submitted by the owner of the apply-for trademark should not be taken as the sufficient reason for the approval of registration of the applied-for trademark.

China National Intellectual Property Administration (CNIPA) and the court generally strictly examine the cases in which the designated goods fall in class 5 because such goods affect the health of people. Therefore, there is a high chance of refusal for the coexistence agreement in the case of which the designated goods fall in class 5.

Change on examination standard for coexistence agreement in trademark review and adjudication

For those prior cited trademarks which are very similar to the client’s apply-for trademark, we will not suggest the client obtain a coexistent agreement.

Therefore, we have changed our strategy: for those prior cited trademarks which are very similar to the client’s apply-for trademark, we will not suggest the client obtain a coexistent agreement.

Or order to overcome the obstacle of the cited mark. But since 2021, the acceptance of the coexistence agreement has dramatically decreased. The reason is that CNIPA consider that trademark Law should protect the trademark right owner’s interests and also protect the consumer’s interests. CNIPA is taking the protection of consumer’s interests as the fundamental purpose in the judgement of the likelihood of confusion. The coexistence agreement can’t replace the examination for the possibility of confusion. Therefore, we have changed our strategy: for those prior cited trademarks which are very similar to the client’s apply-for trademark, we will not suggest the client obtain a coexistent agreement.

Different from the CNIPA, which always adopts the policy of uniformity, in the examination of coexistence agreements, the court will take into consideration various factors such as the similarity between trademarks, the definitiveness of the agreement, etc. and then decide whether or not to accept the agreement. But indeed, the rate of acceptance of coexistence agreements has decreased.

In 2019, Beijing High People’s Court issued the Guidelines for the Trial of Trademark Right Granting and Verification Cases. The provisions of Sections 10 to 12 of Article 15 make it clear that coexistence agreements can be viewed as preliminary evidence for eliminating the likelihood of confusion. Before the issuance of the guidelines, the court tools were to determine the agreement can be taken as important evidence for eliminating the likelihood of confusion. It can be seen from this perspective that the court’s examination has become increasingly strict.

Considering the recent trend for recognition of the coexistence of agreement by CNIPA and the court, I would like to provide you with some suggestions:
• Considering the acceptability of coexistence agreement in the lawsuit is higher than in the review procedure, it is suggested to file the lawsuits with the submission of a coexistence agreement, in the case that the agreement is assumed to be flawless.
• Be cautious to initiate negotiation for coexistence with cited trademarks, where the applied-for trademark is rejected. It can be replaced by other measures such as negotiation for assignment or only a deletion of conflicted goods. If the trademarks belong to the affiliate or parent subsidary companies and are not supposed to be held only by one party, joint ownership can be considered.

• Adding other distinctive elements to the trademarks and filing new registration applications for the changed trademarks.

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The many faces of IP in name, image, and likeness

LaKeisha C. Marsh and Kourtney A. Mulcahy of Akerman LLP look at a few controversies and some possible approaches to safeguard and maximize the benefit of NIL.

As the era of NIL — Name, Image, and Likeness — dawned on collegiate sports, athletes have begun to receive compensation for these valuable, intangible assets. Most who support and represent these athletes feel that “it’s about time,” and we are of like mind. The student-athletes’ various institutions of higher learning have long benefited from the athletic prowess and public image of young people who are, not infrequently, at least as well-known as the Nobel Prize winners on their campuses, let alone the two-time national-championship winning coaches.

Sure as the fresh smell of wet gridiron soil after a thunderstorm, however, legal matters have arisen in the wake of the NIL tidal wave. And a lot of the new legal and business considerations have to do with intellectual property, which, at root, is what an athlete’s name, image, and likeness are — their intellectual property. We mean here to look at a few of these controversies and at some possible approaches to safeguard and maximize the benefit of NIL, drawn from our years of collaborating with athletes, colleges and universities, and the realm of IP.

One of the most notorious cases of an IP problem in sports involves not a college player but a professional. Consider the matter of Luka Doncic, the Dallas Mavericks star who stunned the NBA world when he signed with a sports technology company’s estimate that his $300,000 worths of revenue lurking in that nickname — and that was early yet, during her sophomore year.

Likewise, other college athletes have capitalized on NIL trademark opportunities to develop their own brands. Jordan Bohannon, a former star basketball player for the University of Iowa now playing professionally, has his own trademark and clothing line “J30 Apparel.” In 2021, Bohannon also launched a website to sell t-shirts, socks, and other apparel. University of Michigan football star running back Blake Corum also established his own trademark. “The Duce Is Loose,” for his merchandise brand, which sells shirts, hats, pants, and other apparel on his website.

And let’s not forget Tim Tebow, former University of Florida and Denver Broncos great, whose displays of Christian faith, both off and particularly on the field, were so widely seen that he earned himself a verbiage — “Tebowing” — meaning publicly kneeling in public prayer, with clenched fist pressed to forehead. Tebow trademarked the term in 2012 for apparel items and has been battling any proceeds to his own mononymous foundation — focused on children’s needs and fighting human trafficking — ever since.

There’s more coming down the line in terms of protecting identity-adjacent names and images. Giannis Sina Ugo Antetokounmpo, the 6’11” power forward for the Milwaukee Bucks, might have solved the marketing challenge of having a 13-syllable name by trademarking his nickname, “The Greek Freak,” in 2014. He has guarded it zealously ever since. Bloomberg News reported last March that Antetokounmpo had filed at least four dozen suits over other businesses using or challenging the nickname. There’s no reason such a pattern couldn’t extend to a college athlete, now that Bueckers and others have “made their mark” literally.

What do college athletes need to know about protecting their NIL?

NIL is all about intellectual property, so ensuring that there are proper legal protections surrounding an athlete’s brand is a critical first step. An athlete’s brand is usually their individual name or nickname, but their brand can also be a logo, catchphrase, or caricature of them that highlights a recognizable feature. For example, “Fear the Brow” is associated with the University of Kentucky and Los Angeles Lakers star Anthony Davis, well-known for his unibrow. Both this catchphrase and the caricature of Davis that highlights his unibrow are intellectual property assets. Once the athlete and their representative have clearly identified the IP at issue, they should file trademark applications with the USPTO.

Even in the infant stages of building an athlete’s brand, a member of their team should always be looking for “trademarkable” IP associated with the athlete, and they should file for the mark at the earliest possible moment. Once the brand grows in popularity and becomes more profitable, knock-offs, trolls, and copycats inevitably will emerge, seeking to capitalize on a brand they didn’t create. Oftentimes, such copycats will detect that the athlete has failed to file trademark applications to protect the brand and will file their own in an effort to extort money from the athlete. In those situations, the athlete is forced into one of three unappealing options: 1) pay the fraudster to transfer the ownership of the trademark should be. As in Luka Doncic’s situation, even parent or guardian trademark owners can limit an athlete’s ability to control decisions related to their NIL. And it probably goes without saying that suing your mom makes for an awkward holiday dinner!

Résumés

LaKeisha C. Marsh serves as the chair of Akerman’s Higher Education and Collegiate Athletics Practice. She represents colleges, universities, and related institutions on federal and state regulatory compliance, accreditation, state licensure, institutional governance, collegiate sports and NCAA compliance-related matters. She has structured and executed a broad range of transactional, restructuring, finance, and corporate governance matters for educational institutions. She is based in Chicago.

Kourtney A. Mulcahy is a partner in the Intellectual Property and Trademark practices at Akerman, and focuses her practice on managing domestic and international trademark portfolios for athletes, sports concerns, and other businesses and individuals. She implements cost-effective trademark clearance, procurement, and protection strategies for her clients. Kourtney has experience in all areas of trademark law, including domain name issues, right of publicity, social media, digital and print advertising, and marketing. She has represented clients before the U.S. Trademark Trial and Appeal Board and around the country in trademark/trade dress infringement, dilution, cybersquatting, counterfeiting, and unfair competition claims. She is based in Chicago.
Depending on the situation, it may be in the best interest of the athlete to form and incorporate a new company through which to run their NIL opportunities and to own their IP assets. Let’s say, for example, that an athlete creates their own apparel brand using a creative logo, and the logo is considered confusingly similar to another party’s logo. Having a property formed company tied to the apparel brand and the IP assets offers the athlete a layer of protection against personal liability in infringement lawsuits.

Athletes’ representatives should also consider copyright protections for caricatures or creative artwork connected to the athlete. For example, a unique and creative logo used in connection with the athlete’s clothing line may benefit from copyright protection. Moreover, the caricature that highlights the athlete’s signature pose, move, or feature is subject to copyright protections. Copyright applications for those works should be filed within three months of first publication to take advantage of all of the statutory benefits that come with seeking federal protections for that artwork. Moreover, the athlete should obtain an assignment from the artist who created the work so that the athlete – and not the artist – owns the copyright in that creative image.

An athlete who establishes such IP protections almost surely will enhance the value of the NIL opportunities that lead to compensation for the athlete through sports camps, brand partnerships, media appearances, and social media advertisements. Often, these opportunities involve the player wearing their team’s jersey or endorsements of products or services that conflict with existing sponsorship deals their university has with third parties. So before the college athlete enters into that lucrative NIL deal, they should be advised as to what state law allows and what is compliant with the NCAA and their school’s rules and regulations.

Some institutions have prohibited college athletes from using school intellectual property, including school logos, slogans, and other copyrightable material, for NIL purposes. For example, Texas NIL legislation prohibits an athlete from using a school’s intellectual property in NIL activity. There is an exception to this rule, where the university and student athlete enter into a co-licensing or joint deal that permits the use of university trademarks with a college athlete’s NIL. In August 2021, the University of Texas contracted with The Brand Group to allow athletes to use the school’s trademarks and logos in NIL deals.

On the other hand, some schools entirely support their athletes’ use of school trademarks in NIL activity. In November 2021, the University of Dayton announced its student-athletes could use the school’s official trademarks and logos in NIL opportunities. College athletes, potential sponsors, and endorsers must navigate various NIL rules and regulations, which frequently vary by jurisdiction.

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It is critical that college athletes and their representatives protect themselves against infringement liability. As a starting point, college athletes should inquire as to whether their school has IP protections in place and obtain the institution’s written consent before engaging in NIL activity that incorporates the institution’s intellectual property. NIL opportunities can be exciting and lucrative prospects for college athletes, but it is important that athletes and their representatives recognize that these opportunities are not without limitation and even risk. Athletes need to protect their own brands, and just as importantly, seek to protect themselves from IP infringement liability. Timing in conjunction with effective legal strategy are the keys to both.

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Sudath Perera Associates is one of Sri Lanka’s leading full-service law firms with a team of highly skilled and experienced professionals specializing in varied aspects of the law. The firm has a well-established reputation of being innovative and providing excellent service to its clientele—who are both local and international.

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Sponsored links: the Brazilian Courts as proficient venues under the perspective of trademark infringement

It is very likely that the reader of this paper already knows about the existence of sponsored links and their importance to the modern way of commerce. However, what the reader might not know is that this is a hot topic in Brazil and that has become a frequent subject matter by the court laws of the country.

In a Final Committee Report of the INTA Unfair Competition Committee – UCIC Committee – Policy Development Subcommittee, Brazil was indicated as one of the countries where contemporary unfair practices could be found, including “unauthorized use of other registered trademark(s) as search keywords” (sponsored links; fake news on commerce. Zombie Trademarks and geo-blocking and geo-pricing. Contemporary unfair competition is that of disloyal nature found in new commercial platforms, such as social media, the internet, and other recent commercial events that impair the legitimate rights of trademarks. Sponsored links are an important aspect of modern digital marketing and e-commerce. They are an unarguably cost-effective tool that considerably increases a company’s visibility in search results and on social media platforms, directly impacting revenue and providing a great competitive advantage, notably because it allows a targeted advertisement and the possibility to measure its effectiveness. Further to that, this new way of advertising is a manifestation of free market, allowing businesses to compete with one another for customers in a relatively unregulated environment. However, they can be used in ways that violate rights, hence the raise of concerns on the abuse of sponsored links and fairness, as there may be instances of misleading advertisement causing confusion or deception among consumers and trademark infringement.

A quick overview of sponsored links and their set of norms and regulations:
Sponsored links - also known as sponsored results or sponsored ads - are advertisements triggered by keywords typed in search engines of websites and marketplaces by their users, e.g. Google.com, Facebook.com, Amazon.com, and LinkedIn.com. The advertisers bid on specific keywords (or phrases) and their advertisements are shown to the users as results of what they are looking for, typically marked as “sponsored” keywords (or phrases). The raise of concerns on the (ab)use of sponsored ads. This judgment may be seen as a positive development toward securing IP rights of trademark owners and formal regulation. We will explore in this article this recent decision by the superior court and the existing legal framework that governs it.

We will explore in this article this recent decision by the superior court and the existing legal framework that governs it.

Résumé
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Thiago specializes in litigation and has expertise in representing clients through court suits, probates, and ex-parte proceedings. Advancing for major and important companies in various business areas. Due to his experience and knowledge, he leads the State and Federal court legal cases regarding all aspects of unfair competition and copyright, trademark, and patent infringement.
or "ad" to differentiate them from their organic search results. Each time someone clicks on their sponsored link, the advertisers pay the advertising platforms, which is known as pay-per-click (PPC) advertising.

Being a new way of advertising on an online platform, sponsored links are relatively unregulated in Brazil, but this does not mean necessarily that they are illegal. On the contrary, sponsored links can be considered licit commercial practice as long as they comply with the laws of the land, including applicable regulations, guidelines, IP laws, and antitrust and court decisions. Simultaneously, the advertising platforms self-regulate through their own policies and guidelines for sponsored links, which advertisers must adhere to in order to participate in their programs.

The matter of the sponsored links according to the Brazilian’s Superior Court of Justice: Advertising is regulated by the National Council for Self-Regulation of Advertising (ICONAR) and the Brazilian Advertising Standards Council (ICONARH), which set guidelines for truthful and transparent advertising that respects consumer rights. However, there is no set of laws or regulations specifically addressing sponsored links, meaning that any illegality committed through sponsored links against trademark infringement, consumer protection violation or unfair competition, must be, as a rule of thumb, resolved in the State Courts in light of general rules, which brings us to the recent ruling of Brazil’s STJ.

One of the main legal issues related to sponsored links in Brazil is trademark infringement and unfair competition. There are only two cases duly examined by Brazil’s STJ that planary that refer to sponsored links, both of which, not coincidentally, were motivated by trademark infringement claims. In the first one, dating 2016, the Justices of the Third Appellate Chamber ruled on the ‘urgent need for regulation of the sponsored links market due to the abuses committed in this field, as a result of the unauthorized use of keywords associated with brands that enjoy greater prestige.’ The Justices further authorized, despite the fact that there is no legislation on the matter, the law enforcers to determine whether certain practices constitute unfair competition as provided in article 195 of Brazilian Law No. 9.279/1996. As for the second one, records number REsp 1937989/SP ruled in August 2022 and published in the official gazette of November 7, 2022, the STJ’s Fourth Appellate Chamber extensively examined the matter to establish, in a 16-page decision, that despite the constitutional right of free competition and the liberty of paid advertising services offered by search engines, those who use, as a keyword in sponsored links, trademarks registered by a competitor, infringe the industrial property legislation, constituting the diversion of clients, which characterizes an act of unfair competition as provided in article 195, II and V. of the IP Law and Article 10 bis of the Paris Convention. The Justices determined that using a competitor’s trademarked term as a keyword in sponsored links can cause confusion regarding the provenance of the products and activities, leading to the dilution of the brand and reduced visibility in the market. On those grounds, the Justices upheld and endorsed the second instance decision issued by the São Paulo’s State Court that awarded full restitution for the losses and damages and noted that in such cases the moral damages occur in re ipsa, meaning the plaintiff does not need to provide specific evidence to this end.

This decision – now a leading case - has provided legal certainty to trademark owners in the sense that sponsored ads triggered by trademarked terms unequivocally constitute trademark infringement. It is important to state that up until 2022, the legal scenario involving infringements committed through sponsored links was fairly uncertain, meaning that they often rendered dissuasive decisions, lacking uniformity and therefore jeopardizing trademark rights granted by the Brazilian Trademark Office (BOTRO). Until the STJ’s decision, the judges did not have effective guidelines to decide on such matters, which contributed to the growth of cases of trademark infringements and unfair competition in the digital market.

A clear example of that situation is a particular case in which two major Brazilian retailers, in a typical “eye for an eye” situation, accuse each other of buying another’s trademarked terms as keywords for sponsored links. Claims made in two different lawsuits respectively handled by the 1st and 2nd Specialized Courts in Business Law of São Paulo State Court. In the first lawsuit, sentenced in September 2022 – that is, before the STJ’s leading case publication – the judge of the 1st Specialized Court dismissed the case on the ground that there was neither trademark infringement nor unfair competition. To that judge, the use of the competitor brand in sponsored links is limited to an environment that does reach the consumer. Also, it was decided that the competitor that bid on trademarked terms did not have the intent to deceive their common consumers, but to attract them as a manifestation of free competition and free initiative. The Judge sustained that since the word “AD” is clearly highlighted in every sponsored link, there is no effective risk of confusion. In February 2023, the Judge of the 2nd Court ruled the competitor’s lawsuit in a completely different turn and found in favor of the plaintiff, considering the existence of unfair competition behavior, awarding losses and damages.

Even though this recent STJ judgment is not technically viewed as a precedent under the Brazilian Civil Procedural Code, it is a clear turning point for the Brazilian IP Law as it is already reverberating in the lower instances’ Court of Law, despite the fact that it has not reached res judicata yet. From November 2022 to nowadays, there are records of at least 12 State Judges’ decisions issued with a specific reference to STJ’s case number REsp 1937989/SP, seven of which are final decisions of merit. In all the final decisions rendered so far, mainly from the São Paulo State Court, the Judges awarded moral damages in re ipsa directly influenced by the STJ’s ruling.

The STJ’s recent decision signals to the lower instance judges the main criteria of analysis to be considered in their specific cases and, more importantly, sends out a clear (political) message about the importance of the matter being fully regulated, reinforcing the importance of intellectual property protection to Brazil’s economic order.

Brazil: a great venue for litigating against the abuses committed through sponsored links: Due to the lack of specific regulation, the use of sponsored links is currently subjected to legal restrictions originally designed to protect the rights of trademark owners and prevent unfair competition. These restrictions are enforced by the Brazilian State Courts of Law of Brazil’s 26 states and the Federal District, all of which are hierarchically submissive to the Superior Court of Justice (STJ). Despite the existence of procedural rules providing specific venues within one of the existing
state courts, basically according to the cause of action, claim, and domicile of the parties. For claims motivated by illicit actions perpetrated on the internet – which is the case for sponsored links – the plaintiff will have the flexibility to choose the venue that better suits their needs. All of them have jurisdiction to enforce intellectual property rights, but there are four (4) states that stand out: Rio de Janeiro, São Paulo, Minas Gerais, and Rio Grande do Sul. These four states have established specialized courts for business law, intellectual property, and related intangible rights. More importantly, they maintain an overall consistent quality in their decisions and render final decisions swiftly.

Brazil has consequently turned into an unequivocally favorable and reliable venue for the companies that are victims of unfair competition, notably if the violation is inflicted through sponsored links. Until recently, it was not unusual for parties who were experiencing trademark infringement or unfair competition, to mitigate their risks by choosing not to seek losses and damages, but only the cessation of the infringement. This was because the uncertainty of bearing the costs and expenses resulting from the defeat of restitution claims was considerably high. Fortunately, the recent STJ’s judgment minimized said risk, if not removing it completely.

To Brazil’s Superior Court of Justice’s recent leading case, the mere demonstration by the plaintiffs that the defendant’s advertisements are shown as a result of searches of their trademarked terms is considered unfair competition and enough to secure to the companies which they are legally obliged to answer.

As for the material damages, the leading counsel has the important task to assess the number of times the advertisements were shown and how many clicks the links achieved in order to allow accurate calculation of the award. This information can be obtained, for example, by requesting the judge the issuance of an official letter to the advertisement platform requesting such data, which they are legally obliged to answer.

Prior to the recent ruling of the STJ, the litigation surrounding this matter was quite uncertain, particularly for the parties involved. This was largely due to the lack of clear guidelines available to judges, resulting in inconsistent and unequal decisions. This latest decision by the STJ, therefore, is a development of great significance as it provides much-needed legal certainty to this issue.

The recent STJ’s judgment minimized said risk, if not removing it completely.

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Brazil
Protecting the shape, get-up, and designs of products – a comparative view

Leigh Smith, Partner, London, H. Straat Tenney, Partner, New York, and Bart Lieben, Senior Counsel, Brussels, of international law firm Locke Lord discuss the similarities and differences for design protection in the US, UK and Europe.

At tempting to protect the shape or appearance of a product is by no means novel, and neither are disputes arising from attempts to protect these characteristics. In the United Kingdom, there have of late been a number of interesting cases where one party has sought to assert rights in the shape or get-up of its product against another. In this article, we look at the various ways in which a brand owner might try to secure rights over product design in the United Kingdom, and compare and contrast the position in the United Kingdom with that in the United States of America, and Europe.

The United Kingdom
In the United Kingdom, a brand owner can rely upon a number of IP rights to protect the appearance of a product, but each has its limitations. Registered trademarks, design rights, goodwill which is protectable through the law of passing off, and copyright can each offer a measure of protection, depending on the specific features for which exclusivity is sought.

It is now common for brand owners to seek to protect the whole or part of the appearance of its product through a registered trademark. Protection of an image of the front label of a product – which may automatically attract copyright protection in any event – or an image of the entire appearance of a product, usually does not meet with any objection on absolute grounds. However, seeking to protect more abstract features – the shape of a bottle alone for example – may be more problematic. Even where such trademark registrations can be secured, the utility of such registrations can be questionable. Although they act as a sign-post to third parties considering producing a product with a similar appearance, where the shape alone is protected an English court will find it hard to ignore the other features of the alleged infringing sign, in particular if a markedly different brand name forms part of it. Although the English courts recognize the possibility of initial interest confusion in respect of registered trademark infringement, as Mr. Justice Mellor said in Au Vodka Limited v NE10 Vodka Limited & another1 which is discussed in more detail below, “consumers are not in the habit of making assumptions about the origin of products on the basis of the shape of goods.” 2

In Marks and Spencer Plc v Aldi Stores Limited,3 the claimant was successful in asserting a number of registered designs covering the shape and appearance of a decorative gin bottle against the defendant. In registered design cases, an English court is essentially required to assess whether the alleged infringing design creates a different overall impression to the registrations in suit, taking into account the relevant design corpus. Arguably looking at the designs in suit as a whole favors the brand owner as compared to the equivalent test of assessing the likelihood of confusion between a trademark and sign, where the addition of a distinctive brand name may have more of an impact.

In Au Vodka Limited v NE10 Vodka Limited & another, the claimant was unsuccessful in seeking a preliminary injunction against the defendants preventing the continued sale of a vodka in a bottle which had a similar shape to and shared a metallic finish (albeit in a different color) with the claimant’s product. The claimant relied solely upon passing off, claiming goodwill in the shape and appearance of its product. Whilst this was a preliminary injunction application and therefore not a “mini trial” of the merits, the decision highlighted the difficulties in asserting goodwill in the shape or appearance of products alone.

1 [2022] EWHC 2371 (Ch)
2 Supra, at [50]
3 [2023] EWHC 178
4 [2022] EWHC 2371 (Ch)
**DESIGN PROTECTION: US, UK AND EUROPE**

A claimant faces two main challenges when relying on passing off to protect the shape or appearance of a product. First, there are the practical difficulties in showing goodwill in the shape and appearance of the product alone, as opposed to that goodwill being intertwined with the goodwill attached to the brand name used for a product or the product as a whole. Assuming the claimant can overcome this hurdle, the claimant then needs to demonstrate an operative misrepresentation. Even if a consumer is drawn in by the familiarity of the shape and appearance of a product, it will be difficult for the consumer to ignore a markedly different brand name on the front of the product. By the time the purchasing decision is made, the consumer is aware that it is not purchasing the product of the claimant as it has seen and understood the different branding. Unlike in respect of registered trademarks, English law does not recognize an equivalent of initial interest confusion for passing off.

The **United States of America**

United States trademark and unfair competition law has long provided strong legal protection over nonfunctional product shapes and package designs. Similar to the United Kingdom, to obtain the most robust protections, companies should work to combine product design trade dress rights with design patent rights, and to a lesser extent copyrights. The Lanham Act broadly defines a "trademark as "any word, name, symbol, or device or any combination thereof" used by anyone to identify and distinguish their goods from those offered by others and to indicate the source of the goods, even if that source is unknown. In Wal-Mart Stores, Inc. v. Samara Brothers, Inc., 529 U.S. 205, 207 (2000) (citing 15 U.S.C. § 1127), the US Supreme Court has confirmed that this definition extends broadly, encompassing word marks, logos, colors, and product designs, like a restaurant with a festive and vivid color scheme, children’s outfits decorated with hearts, flowers, and fruits, and tablet computers." To be protectable, product design trade dress must be distinctive and nonfunctional. Product designs can never be inherently distinctive. The US Supreme Court requires, somewhat peculiarly, a showing of over-extending trade dress protection, noting in Wal-Mart that "product design almost invariably serves purposes other than source identification." Therefore, in order to assert rights in a product shape, a party must demonstrate that the trade dress has acquired distinctiveness through the development of secondary meaning which occurs when "in the minds of the public, the primary significance of a mark is to identify the source of the product rather than the product itself." Other types of trade dress, such as product packaging and color, may be classified as inherently distinctive, and thus protectable without demonstrating acquired distinctiveness. Proving acquired distinctiveness is of course often easier said than done.

Ordinary - or "generic" - shapes receive no protection. Finally, to be protectable, the party asserting the product design trade dress must define each element of the purported trade dress so that the public (and competitors) know the exact parameters of the claimed exclusive right covered by the trade dress. Notwithstanding the hurdles to the protection of product design trade dress, US trademark law arguably provides broader protections, compared with the United Kingdom. For example, the Lanham Act largely protects against confusion at any point in the buying process. Therefore, US courts are more receptive to finding infringement based on confusion that creates initial customer interest, even though no actual sale is finally completed as a result of the confusion. Such "initial interest confusion" is important where the respective product designs are confusingly similar, but the product features other non-trade dress elements.

**European Union**

Not unsurprisingly, the European perspective is rather similar to the UK’s. As IP owners are granted different options in view of protecting the shape of goods or of the packaging of goods. But also here, caution must be taken when deciding upon enforcement actions, in light of evolutions in the way courts tend to look at brand owners invoking a multitude of rights in order to counter infringements.

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The CJEU confirmed that any original subject matter constituting the expression of its author’s own intellectual creation can be classified as a “work” in the sense of the European Copyright Directive, even if such subject matter is protected as a design.14 Notwithstanding, the CJEU was of the opinion that “the grant of protection, under copyright, to subject matter that is already protected as a design must not undermine the respective objectives and effectiveness of those two sets of rules, which is why the cumulative grant of such protection can be envisaged only in certain situations.”15

In summary, the above highlights the need to rely on the relative strengths of a range of IP rights on a jurisdiction-by-jurisdiction basis to protect the shape and appearance of a product. Brand owners seeking to benefit from multiple protection mechanisms should therefore – more than ever – closely follow up evolutions and clarifications in all fields of IP law, including unfair competition, in view of making a holistic assessment of the protectability and enforceability of exclusive claims on product designs.
The Initiative of the CNIPA to regulate bad faith filings showing from the Draft Amendment to the PRC Trademark Law

Since its first adoption in 1983, the PRC Trademark Law has experienced four amendments in 1993, 2001, 2013 and 2019 respectively. On January 13, 2023, the China National Intellectual Property Administration (“CNIPA”) issued the Draft Amendment to the PRC Trademark Law (Draft for Comments) (the “Draft”) to seek public comments. The Draft is a comprehensive amendment in terms of both procedural and substantive content, reflecting the legislator’s attitude to make significant changes to the current Trademark Law. A number of new provisions were added, aiming at addressing issues such as bad faith filings and trademark infringement, so as to guide the trademark filings back to the original intention of “registration for use.” If the Draft becomes effective, it will increase the “cost” to file malicious trademarks and correct the current unhealthy trend of increasing bad faith filings in China.

1. Emphasize use requirement, and increase the “cost” of bad faith filing

The Draft adds rules of “commitment to use” and “submission of statement of use every five years” in Article 5 and Article 61. That said, when filing a new trademark application, the applicant needs to commit that the applied-for mark is in use or will be used. An obligation to file a statement of use every five years is also added for marks that have been granted for registration. If no statement for use is filed or sound reason is given, the registered mark shall be deemed abandoned, and canceled by the CNIPA. Also, the CNIPA may conduct a random review for authenticity of the statement of use, and the registered mark will be canceled if such statement is found to be unauthentic.

China’s “first-to-file” registration system and the extremely low filing and renewal fees are one of the reasons that triggers bad faith filings. Emphasizing the use requirement will certainly increase the bad faith filer’s “cost” to commit bad faith filing and thus help to clean out some non-use trademarks.
Résumés

Li Xiaohong, Senior Partner, ZY Partners

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

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

Ms. Li has helped numerous clients to obtain well-known trademark recognition for their brands before the Trademark Office/Trademark Review and Adjudication Board and the courts. Some of the litigation cases that Ms. Li has handled have been selected as the Supreme Court’s guiding cases and/or typical cases for the lower courts.

She was recognized as one of IP House’s Top 50 China Excellent IP Lawyers in 2019 and 2023.

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Ms. Han specializes in the prosecution and enforcement of multiple intellectual property rights, including trademarks, copyrights, and domain names. She has over six years of experience as an IP lawyer at ZY Partners.

Ms. Han has handled numerous trademark litigations before different industries, mainly including clothing, cosmetics, food, hotel, medicine, and computer. She is outstanding in trademark protection and domain name disputes. She advises clients on brand strategies and the protection and enforcement of trademark rights, including but not limited to trademark clearance, registration, refusal appeal, opposition, invalidation, and non-use cancellation actions.

She also handles numerous trademark litigations before the Beijing IP Court, Beijing Higher Court and the Supreme Court. She has helped many clients successfully obtain well-known mark recognitions for their brands.

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 requirement will certainly increase the bad faith filer’s “cost” to commit bad faith filing and thus help to clean out some non-use trademarks.

2. Add “Preclusion of Repeated Registration” to cease the recurrence of bad faith filings

In practice, it is often seen that bad faith filers file repetitive bad-faith marks imitating a famous brand, and some even make several refiling attempts after their marks are identified as a bad faith application and rejected/canceled by the CNIPA. These filings directly perturb the trademark examination system and drained the right holders’ resources to enforce their rights.

A rule called “Preclusion of Repeated Registration” is hence adopted as one of the Draft to address the issue, which says, “a trademark applicant shall, in respect of the same goods or services, own only one registration when it comes to the same mark” (Article 14.1), and some exceptions are also provided for repeated registration (Article 2z), such as “At the needs of production and operation, minor changes are made to the prior mark in use and the differences can be explained.”

The Draft also lists “Preclusion of Repeated Registration” as one of absolute grounds for filing invalidation or opposition actions under Article 45.

This rule will, to a large extent, put an end to the bad faith filings. However, it is possible that the bad faith filers will turn to more concealed ways such as setting up dummy entities to engage in bad faith filing to get around the laws. If so, that would be another challenge for both the trademark examination authorities and right holders to tackle.

3. Separate an article to discuss the circumstances of bad faith filings, showing China’s determination to combat trademark squatting

The 2019 Amendment to the PRC Trademark Law has made great efforts to combat trademark hoarding. In this Draft, the CNIPA takes a step further, and tries to absorb some articles originally in the "Provisions Regulating the Application and Registration of Trademarks" into the Trademark Law. The Draft sets forth a separate article to specifically cover situations that shall be considered as bad faith filings.

Article 2z of the Draft enumerates the circumstances constituting bad faith filing, including massive filings without intent to use, the trademark registration application obtained through any other illicit means, applying for a trademark that is detrimental to the state interest, public interests or has other negative effects, applying for a trademark that infringes upon other’s well-known trademarks (Article 8 of the Draft), pre-emptive registration by agents or representatives (Article 29 of the Draft), applying for a trademark that infringes upon other’s prior rights or interests (Article 23 of the Draft), etc.

4. Introduce “mandatory transfer” of bad faith filing in invalidation action

The Draft further introduces a new trademark assign- ment system in invalidation action. It is stipulated under Article 45.9 that the prior right holder may request the transfer of the squatted trademark under the supervision of the CNIPA. These filings directly perturb the trademark examination system and drained the right holders’ resources to enforce their rights.

While the prior right holder has to go through multiple legal actions to invalidate the disputed trademark, the prior right holder can now choose to request mandatory transfer of the trademark to be transferred back to their own name, which reduces the cost of obtaining the trademark right and improves the efficiency of dispute resolution.

5. Impose administrative penalties and civil liability for malicious trademark squatting

Under the existing legal framework, the cost of bad faith filing is extremely low, usually only a nominal trademark application fee. Whilst the right holder has to go through multiple legal procedures such as opposition, invalidation and non-use cancellation to cancel the mark, which is costly and time-consuming.

Article 67 of the Draft imposes administrative penalties on bad faith filers, i.e., the bad faith filer may be subject to a fine up to a maximum amount of CN¥250,000, confiscation of illegal income and other punitive measures, and placed on the blacklist of the National Enterprise Credit Information Publicity System. Civil compensation is also added in Article 83 (i.e., if the bad faith filer suffers damages to another party, the party who suffers losses can file a lawsuit claiming compensation, and the amount of compensation shall at least cover the reasonable expenses paid by the party to stop the bad faith filings, such as the official fees to file the opposition/ invalidation, notarization fees, and attorney fees).

These provisions will again increase the cost for filing malicious marks and deter infringement.

Currently, to regulate bad faith filings in civil cases, some courts invoked the catch-all provisions of the PRC Anti-Unfair Competition Law to support the plaintiff’s claim for civil compensation. For example, in 2021, in Emerson Electric vs. Wang and others, the Xiamen Intermediate People’s Court (the trial court) and the Fujian High People’s Court (the appellate court) found that the defendant’s acts violated Article 3 of PRC Anti-Unfair Competition Law solely on the basis that the defendant’s bad faith filings infringed upon the plaintiff’s prior registrations with high fame. The court finally awarded economic damages of CN¥1.6 million, including reasonable expenses to stop the infringement. If such provision relating civil compensation is written into the Trademark Law, it will provide a clear legal basis for the right owner to recover its losses against the bad-faith filers based on Trademark Law.

The Chinese government has been making efforts to crack down on bad faith filings and improve the protection of trademark rights, with remarkable results. This Draft further shows the Chinese government’s determination to resolve issues that are long-existing in the current system. Next, the CNIPA will finalize the Draft based on the consultations and comments received, and submit it to the Standing Committee of the National People’s Congress for review. There will be Implementing Regulations coming out with more details on procedure and specific requirements, we look forward to the following Implementing Regulations in the foreseeable future.
India focuses on growth and innovation

Ranjan Narula and Abhishek Nangia of RNA, Technology and IP Attorneys detail the increased innovation and subsequent interest in IP protection in India following on from the meteoric rise in the Global Innovation Index rankings.

India’s image as an attractive destination for doing business has been strengthened with the country’s ranking in the Global Innovation Index (GII) going up from the 81st spot in 2015 to the 40th spot in 2022 out of 132 economies. The GII report released by World Intellectual Property Organization is a leading reference for measuring the economy’s innovation performance. The meteoric rise in the global ranking, despite being the second most populous country in the world, has encouraged multinational companies to tap India’s talent for manufacturing goods for domestic consumption and export. Further, strict restrictions and lockdowns imposed during the Covid phase in China have also made the businesses realize the need to diversify their manufacturing base to India considering its political and economic stability.

The increased IP awareness and meteoric rise in the country’s GII rankings are reflected in the consistent growth in the filing of trademark, patent, design and copyright applications in India. For the first time in the past five years, India achieved a milestone with the domestic patent filing surpassing the international patent filings during January-March 2022 quarter. As per Annual Report 2021-22 issued by the office of Controller General of Patents, Designs, Trademarks and Geographical Indications, the following trends are noteworthy:

1. In the past five years, trademark filings rose by over 60%, copyright filings rose by over 70%, design filings rose by over 90%, Patent filings rose by over 35%.

2. In 2021-22 (post covid) the IP office witnessed a healthy growth in filing of Patent, Design and Trademark applications over previous years. The Patent filings grew by 13.67%. Design by 59.39% and Trademark by 3.85%.

3. The top five foreign trademark applicants in India are USA, China, Singapore, the United Kingdom and the United Arab Emirates. Interestingly, the number of applications from the United Arab Emirates were only 21.5% of applications filed by US companies.

The consistent rise in the number of IP filings reflects the increasing importance given to IP by businesses to safeguard their rights and prevent misuse by third parties. However, 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.

Abhishek Nangia, Partner, at RNA, Technology and IP Attorneys Abhishek is a seasoned professional in advising clients of diverse sectors on a wide range of Intellectual Property (IP), Information Technology (IT) issues and evolving e-commerce regulations. Abhishek is an expert on advertising/ media clearance, legal framework and practical issues surrounding misleading advertising practices in India. He regularly writes articles which have been published in print and electronic media including ENISH magazine published by Japan Patent Office and have also been invited to address law enforcement officials, law institutes and various other organizations on IT Law, IP enforcement and IP issues in cyber space.

Ranjan Narula, Managing Partner at RNA, Technology and IP Attorneys 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 1995 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 2009, 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 has been invited to speak by Universities and IP experts and others. Ranjan is regularly invited to address law enforcement officials, law institutes and various other organizations on IT Law, IP enforcement and IP issues in cyber space.
Creation of IPD

The abolition of IPAB in April 2021 caught most of the IP practitioners by surprise and it paved the way for creation of Intellectual Property Division (IPD) as part of the Commercial Courts on July 6, 2021 by the Delhi High Court. With the increasing workload and for speedier execution of the matters relating to Intellectual Property Rights, a separate IP division was most needed. Recently, Gujarat High Court has created IP Division and started listing cases for hearing cases transferred from the Ahmedabad bench of IPAB. Chennai High Court has also principally notified creation of a special IP Division.

Delhi High Court Intellectual Property Rights Division Rules, 2022

The Delhi High Court Intellectual Property Rights Division Rules, 2022 (IPD Rules) were notified on February 24, 2022 along with the High Court of Delhi Rules Governing Patent Suits, 2022. IPD is an exclusive division created within the Commercial Courts Division of the High Court of Delhi for adjudication of disputes relating to trademark, Copyright, Design Patent, Geographical Indications, Information Technology, Plant Varieties and Farmers Rights, Semiconductor Integrated Circuits Layout.

The IPD at the Delhi High Court comprises three Courts/judges exercising original (new cases), appellate, writ jurisdiction over matters relating to Intellectual Property Rights with powers to adjudicate:

1. revocation, cancellation applications;
2. pending and fresh suits involving intellectual property rights as defined under the IPD Rules;
3. appeals arising out of subject matter involving Intellectual Property Rights and disputes dealt by Commercial Court in Delhi except matters dealt by Division Bench;
4. appeals against the decisions passed by the Patent office/Trademark office/ Copyright office/ Geographical Indication office/ Plant Varieties office/ Semiconductor Integrated Circuits Layout-Design office;
5. matters transferred from the erstwhile IPAB.

The IPD Rules provide for

- strict timelines – The Rules provide strict timelines for filing replies and rejoinders in original petition cases and appeal cases. The reply is required to be filed within 60 days and the rejoinder within 30 days. The proceedings can be consolidated if there are multiple proceedings relating to the same subject matter irrespective of whether the proceedings are between the same parties or not.
- Appointment of experts - The IPD Rules empower the court to seek the assistance of expert(s) including individuals and institutions in adjudicating the disputes. The opinion of the expert is persuasive and not binding on the Court. The remuneration of the expert(s) shall be decided by IPD.
- Mediation - The Rules provide for mediation and Early Neutral Evaluation (ENE). It is interesting to note that consent of litigating parties is not required for appointing a Mediator or ENE. Mediation/ENE may occur simultaneously with the legal proceedings to avoid any delays if the mediation/ENE is unsuccessful.
- Video recording of the evidence - The IPD Rules permit video recording of the evidence or recording at any venue outside the court premises or by court-appointed commissioner.
- Hot-tubbing - Rule 16 of IPD provides that in case of evidence by experts, the same may be recorded by Hot-tubbing technique under Delhi High Court (Original Side) Rules, 2018 which provide a detailed protocol for Hot tубbing. The technique involves recording experts’ evidence in each other’s presence and before the judge who asks the same questions. The objective is to provide more clarity and facilitate a better understanding of the facts. However, the experts must be fully prepared to explain their evidence better and counter the evidence produced by the opposite party.
- Confidentiality club - Considering parties are not willing to divulge confidential information in the IP disputes to the general public, the Court can constitute a confidentiality club to preserve the confidential information. The confidentiality club consists of lawyers, nominated representatives of the parties. To maintain such confidentiality, the involved persons shall not share confidential information to third parties.

The Court, upon request, can direct redaction of confidential information and if any redacted pleading/document is filed as confidential, a non-redacted version of the pleading/document is required to be filed in a sealed cover along with an application supporting the claim for redaction.

Orders passed by IPD

The IPD at Delhi High Court, in its short tenure, has heard numerous cases and energized the IP scenario by its ruling on important legal and procedural aspects of the IP legal system. In the process, it has streamlined the processes for expeditious disposal of cases. As an example, the court has consolidated cases where the legal issues to be decided are similar. Transferred cases between the IP Courts to consolidate the cases where the same parties have more than one action pending and the outcome of one will have bearing on the other.

Also, the Courts have pronounced a number of noteworthy orders within one year of the enactment of IPD Rules. A few of them are outlined below:

a) In the case of Dr. Reddys Laboratories Limited v Combitic Global Caplet Pvt. Ltd (CISC/COM/21/2022), the Plaintiff, being the prior user and registered proprietor of the mark OMEZ, brought an action against the registered proprietor of the mark OMEZ in class 5 claiming to have used the mark since the year 2000 for treatment of gastrointestinal disorder containing ‘Omeprazole’.

The Court took into account the closeness between the marks and identical goods granted an ex-parte injunction and restrained the registered proprietor from dealing in pharmaceutical preparations under OMEZ mark both for domestic sales and export. The defendant came forward to settle the case which was disposed of.

b) In the case of Allergan Inc. v Controller General of Patents, Designs and Trade Marks W.R.I.C/IPD 55/2021 & CM 37157/2019, Allergan Inc. (Appellant) challenged the decision of the Controller of Patents and Designs dismissing the opposition as it failed to inform about the Provisional Refusal to WIPO within the statutory period of 18 months.

The Trademarks office took the stand that, due to a technical glitch in the functioning of software module, provisional refusal could not be communicated to WIPO. The court stayed the operation of the order passed by the Trademarks Office and observed that such acts not only cause inconvenience and prejudice to the parties but also present India in a bad light to the world.

c) In Art Screw Co. Ltd v Assistant Controller of Patents and Designs C.A./COMM/IPD-PATI/4/2022, the Appellant filed an appeal against the order passed by Assistant Controller of Patents & Designs, rejecting the patent application stating that the invention lacks inventive step. The Court, after hearing the parties, held that the basis for holding that the invention lacks inventive step is impossible to comprehend in the absence of sound reasoning. The matter was remanded back to the Controller of Patents to reconsider the matter and pass a fresh reasoned order.

d) Another case, which has been making headlines, is Phonographic Performance
Limited (PPL) v Lookpart Exhibitions and Events Private Limited (LEPL) (CS (COMM) 188/2022). This case involves an interesting issue of whether a license is required to be obtained for playing music at a wedding and is likely to have large-scale implications.

PPL brought a suit against LEPL engaged in providing various services, including DJs for weddings alleging that LEPL should obtain a license from them to play sound recordings at commercial venues which are strictly not religious ceremonies. LEPL contended that use of music for marriages & social events connected to marriages falls under fair use and a license is not required to be obtained.

Given the complexity of the case and its far-reaching impact in the future, the court has appointed an expert in the interpretation of section 52(1)(za) of the Copyright Act, 1957 to determine fair use of sound recordings in marriage ceremonies and weddings. The matter is currently pending adjudication.

To sum up, Delhi High Court has emerged as a preferred forum for IP litigation and it was the first court in the country to establish an exclusive IP division. The IPD at Delhi High Court has stepped up to cut down on the delays, pronounced reasoned orders on critical issues, and persuaded parties to amicably resolve the dispute to avoid litigation route wherever possible to expeditiously conclude the conflict. In terms of numbers since July 2021, IPD at Delhi High Court has decided nearly 450 cases transferred from erstwhile IPAB and appeals filed against the decisions of IP offices and approx. 550 IP commercial suits, appeals filed against the order passed by the District courts.

“The technique involves recording experts’ evidence in each other’s presence and before the judge who asks the same questions.”
E nforcement of intellectual property rights always takes a long time. With the objective of speeding up the proceedings, there have been several amendments to the respective Hungarian laws let me give a brief overview of some recent changes.

First to mention, one of the objectives of the last codification of the law of civil proceedings – completed in 2016, taking effect on 1 January, 2018 was to facilitate civil lawsuits to be concluded in a reasonable time. The concept of the revision defined the improving of litigation efficiency as the main regulatory goal of the new Code of Civil Procedure. With this objective, the new Code of Civil Proceeding has introduced a more stringent order of procedure. In addition to shorter deadlines the parties may not submit petitions or statements at any time, not even to reflect on a statement of the opposite party or their own initiative, but according to strict rules, or at an express invitation by the court, respectively. Late filings or out-of-order submissions are disregarded.

The introduction of a divided litigation structure (admission and case initiation stage prior to the substantive hearing on the merits and the creation of procedural rules ensuring the concentration of litigation shall also act in the direction of faster processing of cases. At the stage of the hearing on merits, the court shall take evidence within the framework defined for the dispute in the case initiation stage. At the stage of the proceeding on the merits, the party is no longer allowed to issue a case initiation statement or to change their initial statement previously presented accept in cases provided for by the Code. The court shall also disregard any evidence submitted not in conformity with the provisions. In course of the hearing on the merits, additional facts or facts derogating from the factual claims presented in the case initiation stage may not be presented unless the party relies on a fact that has occurred or came to their knowledge, through no fault of their own, after the conclusion of the case initiation stage, or if said additional fact has gained significance in adjusting the case with respect to a circumstance that has occurred or came to their knowledge after the conclusion of the case initiation stage, through no fault of their own. The requirement of mandatory legal representation has been introduced as a guarantee of professionalism in every proceeding starting at the tribunals normally functioning as appeal courts in court cases heard by the local courts at first instance, but functioning as courts of first instance in complex cases, including patent, trademark, design and copyright infringement cases and in general, most of the intellectual property related laws and also apply in the courts in concluding cases within a reasonable time frame.

As a technical issue in supporting faster communication between the court and the parties, electronic communication has become a mandatory requirement for professional representatives and for companies, the only allowed way of communication between the court and the parties. The provision of procedural provisions serving faster proceedings specifically in IP enforcement matters, it is not new but due to its importance it is worth mentioning here the provision that in IP matters a right-holder’s request for provisional measures is handled by the Metropolitan Tribunal in priority proceedings, and the court makes a decision at the latest within 15 days following presentation of the request. The time shall be counted from the date when the claimant’s request was received by the court in full, with no deficiency. Eventual late submissions to overcome deficiencies may delay the decision. This rule is identical provided for each kind of intellectual property, i.e., in the patent, trademark, design, utility model and copyright laws. In this connection, it is another important provision supporting procedure efficiency that in patent, trademark and any other IP infringement actions the court shall, subject to certain time conditions, consider provisional measures necessary, solely on the basis that the claimant proves by documentary evidence that the IP right is protected and that he is the proprietor or an authorized user of the IP right. In a trademark infringement case, for example, it is sufficient to prove that the trademark is registered and the registration is valid and that the claimant is the trademark proprietor or an authorized user licensee of the trademark.

Further, the efficiency of the enforcement of rights is also supported by the provision of the right to file a counterclaim for violation of their IP right. The party relies on a fact that has occurred or came to their knowledge after the conclusion of the case initiation stage, or if said additional fact has gained significance in adjusting the case with respect to a circumstance that has occurred or came to their knowledge after the conclusion of the case initiation stage, through no fault of their own.

Finally, it is worth mentioning here the provision that in IP matters a right-holder’s request for provisional measures is handled by the Metropolitan Tribunal in priority proceedings, and the court makes a decision at the latest within 15 days following presentation of the request. The time shall be counted from the date when the claimant’s request was received by the court in full, with no deficiency. Eventual late submissions to overcome deficiencies may delay the decision. This rule is identical provided for each kind of intellectual property, i.e., in the patent, trademark, design, utility model and copyright laws. In this connection, it is another important provision supporting procedure efficiency that in patent, trademark and any other IP infringement actions the court shall, subject to certain time conditions, consider provisional measures necessary, solely on the basis that the claimant proves by documentary evidence that the IP right is protected and that he is the proprietor or an authorized user of the IP right. In a trademark infringement case, for example, it is sufficient to prove that the trademark is registered and the registration is valid and that the claimant is the trademark proprietor or an authorized user licensee of the trademark.

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The party is no longer allowed to issue a case initiation statement or to change their initial statement previously presented.

Late filings or out-of-order submissions are disregarded.

HUNGARIAN IP ENFORCEMENT PROCEEDINGS

Miklós Sóvári, Partner and Head of the Trademark Department at Danubia Patent & Law Office, details the measures that have been put into place to accelerate enforcement proceedings in Hungary with important guidance to avoid filing or opposition refusal.

HUNGARIAN IP ENFORCEMENT PROCEEDINGS

Résumé

Dr. Miklós Sóvári, Partner and Head of Trademark Department Miklós is a European and Hungarian Patent Attorney and has been at Danubia Patent & Law Office since 1994, where he is also a member of the managing board. He is experienced in national, European Union and international IP matters, focusing on trademark prosecution, litigation and customs enforcement, licensing and matters related to the prohibition of unfair competition. He is Vice President of Hungarian Chamber of Patent Attorneys and a Body of Experts on Industrial Property of the Hungarian Intellectual Property Office, a member of many organizations including: MIE, LESI, Hungarian Competition Law Association, HUNGARIUM Trademark Committee, Union ip., INTA and PTMG.

Hungarian Intellectual Property Office: the defendant in a patent infringement action is entitled to file with the court a counterclaim for the declaration of invalidity, provided that there is no proceeding relating to a declaration of invalidity against the same patent and based on the same factual grounds, pending before the Hungarian Intellectual Property Office.

Bifurcation is also the basic concept in theTrademark Law: Cancellation actions shall be started with the Hungarian Intellectual Property Office, regardless of any infringement proceeding in respect of the affected trademark. The decision of the Office can be appealed to the Metropolitan Tribunal.

The only exception: in case of European Union trademark infringement actions where the Metropolitan Tribunal functions as a European Union Trademark Court the plaintiff’s EU trademark shall be declared invalid on the basis of a counterclaim submitted by the defendant in infringement proceeding:

- Act CXXX of 2016 - on the Code of Civil Procedure
- The Metropolitan Tribunal (Budapest) has exclusive jurisdiction to hear industrial property infringement actions (also functioning as a European Union trademark court of first instance)
- Appeals against the decisions of the Metropolitan Tribunal shall be adjudged by the Budapest High Court of Appeal (also functioning as a European Union trademark court of second instance)
- Act XXXVII of 1995 on the Protection of Inventions
- See Article 60 of European Union trade mark regulation

The party is no longer allowed to issue a case initiation statement or to change their initial statement previously presented.

The party is no longer allowed to issue a case initiation statement or to change their initial statement previously presented.
Very last-minute actions may result in incomplete oppositions or insufficient evidence, ultimately leading to the refusal of the opposition.

It can be established that, in comparison to the situation some years ago, IP enforcement cases in Hungary proceed faster, and we hope this tendency will continue.

Specifically in the Trademark Law, there are numerous provisions serving the efficiency and faster conclusion of procedures. It is an important restriction, and some reasonable support for a trademark applicant or a registrant against abusive practices at the same time. In opposition cases, following the non-extendible deadline of opposition (three months from the publication of the trademark application), no additional ground for refusal shall be admissible. Any argument presented by the opponent after the deadline shall be disregarded by the Office. Similarly, in trademark cancellation actions, following a deadline set by the Office for the petitioner, any ground for invalidation which had not been claimed until the deadline shall be deemed inadmissible.

And according to the most recent severity that came into effect on 1 January 2023, the opposition must indicate the ground or grounds of opposition (the cause of objection), and it must be duly substantiated by way of documentary evidence. That is the opposition must be complete in terms of content and evidence. Until this year it was a common practice of opponents to file, by the deadline, a notice of opposition with no reasoning in detail, and the detailed justification of the ground/s for refusal with its supporting evidence was subsequently submitted, which might be after several extensions of terms that could be detrimental to the applicant. Such a situation is no longer possible but potential opponents have to take care to consult with their attorneys in time so that a full opposition, including detailed reasoning and sufficient evidence to support the cause of the opposition, e.g. including certificates of an earlier trademark or other relative grounds and the evidence supporting the reputation of the earlier trademark etc., be completed before the deadline. Very last-minute actions may result in incomplete oppositions or insufficient evidence, ultimately leading to the refusal of the opposition.

After all, it can be established that, in comparison to the situation some years ago, IP enforcement cases in Hungary proceed faster, and we hope this tendency will continue.
**Women in IP Leadership**

Celebrating achievements and continuing the empowerment of women

Weird or wonderful. We’re here to protect it.

From bold technology to inspired creativity, CMS is ready to advise on and actively defend your ideas, innovation and insight. With over 450 intellectual property specialists across more than 40 countries, see how your best thinking can remain your most valuable asset.

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

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

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

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.
I think another useful tip is to train yourself to see problems from different perspectives and always try to come up with multiple solutions with a strategic approach.

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

The path so far has been exciting, thanks to the current position? And can you offer advice from your experience? How have you found the pathway to your current position? And can you offer advice from your experience?

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Olga Plyasunova: Head of the Trademark Department, Zuykov and partners

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

Olga Plyasunova is a Trademark Attorney and the Head of The Trademark Department at Zuykov and partners. Olga has the status of Patent Attorney of the Russian Federation (No 01618) and Eurasian Patent Attorney (No 016). Olga has been working with Zuykov and partners LLC since 2007. She specializes in Appellations of origin of goods, trademarks and service marks, and the legal protection of employees. Olga is fluent in English and is a member of ECTA (2019). She has extensive experience in the consideration of disputes, object and statements in the Chamber on patent disputes of trademarks. Olga regularly participates in conferences and writings on the protection of trademarks in Russia and abroad.

What inspired your career? When I studied at the institute, I had the subject “Patent Law,” but I did not assume that my whole life would be connected with IP. It’s fate that after graduating from the institute, I started working at Rospatent. At Rospatent, I was surrounded by interesting people devoted to their specialty. In their field, they inspired me to devote my life

How have you found the pathway to your current position? And can you offer advice from your experience? My IP career began in 1996 when I worked at the Russia’s Patent Office as an expert trainee in the trademark department. While working at Rospatent, I simultaneously studied advanced training courses, including those organized by WIPO, which allowed me to grow professionally. A few years later, I took a management position and became Deputy Head of Trademarks at the Patent Office. After working for some time in this position, I realized that I wanted to plunge into the work from the “other side” and set myself the goal of becoming a patent attorney. In 2007, I joined Zuykov and partners and have been working there for 15 years. I continued to develop my career and in 2008 became a patent attorney and then the head of the Trademark Department. The department employs 70 people, 40 of them are patent attorneys, the rest are assistants. The Trademark Department provides services with trademark registration and design services.

Intellectual property is an integral part of our life, and protecting the rights of customers is our priority. If you came up with a company logo, or invented a device or method, you must definitely register them, you can’t let the situation take its course. Otherwise, your competitor will appropriate the results of your intellectual activity and will reap commercial benefits.

What challenges have you faced? And how have you overcome them? During my professional development, I realized that achieving professional goals and success depends only on me, and I need to work on myself and constantly improve myself to achieve them. In the Patent Office, I became a high-level manager at a young age, some of my subordinates were older than me and had more experience in the office than I had. I took a lot of strength, tact, and professional skills from me to gain authority among employees. But I coped with this task because I am a professional in my field. In addition, it was difficult for me, like any working woman, to combine my work, career growth, family, and children, since legal work in the field of IP requires complete immersion in the process. But I managed with this because I believe that a woman should be a diplomat and be able to negotiate not only in the legal field but also in everyday life.

What would you consider to be your greatest achievement in your career so far? In my opinion, the most significant achievement in my work is that I have made climbing the steps of the career ladder from an intern in the field of IP to the head of a department in a large company, becoming a Russian and Eurasian patent attorney. I was able to realize myself in the profession and became a professional in my field. I also consider my department, which I created and developed, as my achievement. A team of colleagues who surround me and for whom I try to be an example in my professional activities, including working as a mentor, teaching the profession, and development. So, many employees of the department came to the company in the position of attorney’s assistant, and in the process of working in the company they themselves became attorneys. This is a real team of professionals, ready to work in the difficult conditions that have now developed in the world.

Life does not stand still. Our company is constantly expanding – both in terms of the number of employees and the geography of the provision of services. Recent events have forced us to look to the East - the countries of Asia, China, the United Arab Emirates. On January 1, 2023, we opened an office of Zuykov and partners in Dubai, UAE. This country and the region as a whole is a very promising area for business development. We are pleased that now we can provide our clients with a full range of services for the registration of intellectual property, including the services of trademark registration in the UAE.

What is your future career aspirations? And how will you work to achieve them? Today, I am the Head of the Trademark Department at Zuykov and partners, which is the Russian market leader in the field of IP. In order to meet this level and not stop there, I plan to continue my professional growth, participate in IP conferences to exchange experience with colleagues and partners, and improve my knowledge. I also plan to continue to develop the trademark department and its employees professionally. Particularly interesting for our clients in the current market conditions is the topic of regional registration - the registration of Eurasian industrial designs, trademarks. Therefore, as soon as we have a Eurasian trademark, I will definitely become a Eurasian trademark attorney.

I would like to see the introduction of a procedure for pre-registration public opposition to the Russian system of verification examination of intellectual property objects, in particular, for applications for industrial designs. The issues of public opposition have been tested by a number of patent offices around the world when registering various industrial property objects. I believe that the introduction of public opposition will ensure convergence of the registration procedures for Eurasian, international and Russian industrial designs.

In addition, we have been waiting for a year for a Eurasian trademark to appear. The Treaty on Trademarks, Service Marks and Appellations of Origin of Goods of the Eurasian Economic Union entered into force on International Intellectual Property Day on April 26, 2021. The Treaty creates a regional system for registration and legal protection of means of individualization of the EAEU, within which the applicant will be able to obtain legal protection of a trademark or an appellation of origin based on a single application filed with any of the five national patent offices.

How do you think the empowerment of women can be continued and expanded in the IP sector? In my opinion, in Russia, unlike foreign countries, especially European ones, there are a lot of women working in the IP field compared to men. But at the same time, for the most part, they occupy ordinary positions, doing routine work. Women should invest more in their education, and develop professionally in order to show their value in the labor market, i.e. so that quantity turns into quality and more women can succeed in the IP industry in the future.

"It was difficult for me, like any working woman, to combine my work, career growth, family, and children, since legal work in the field of IP requires complete immersion in the process."
Jurisdictional Briefing, Spain: Inditex VS Buongiorno Myalert

Marta Gimeno and Alfonso Sabán of H&A, reports: three strikes and out after the Spanish Supreme Court confirms that the complainant has not fulfilled acts of trademark infringement using the term ZARA on its promotions.

Résumés

Marta Gimeno, graduate in Law, specializing in economics (Deusto University in 2007) and partner at H&A, began her professional career in 2007 in one of the top firms in Spain, providing advisory services in trade law and digital law. In this first phase, she specialized in advisory services for large national clients. In 2010, she had the opportunity to join the growing Digital Law and Technological Innovation Department of H&A, and she thus started her career at H&A, focusing on issues such as data protection, domain name disputes and the LSSI.

In the year 2013, Marta became the head of the Litigation Department, incorporating other functions such as managing the secretariat of the council of companies in the group or compliance. Marta also actively participates in congresses and presentations, and has been the speaker at internal chats and in other forums, such as APD and the Sport Business Congress. Since 2021, she has been a member of the INTA (International Trademark Association) Enforcement Committee.

Alfonso Sabán is a partner at H&A (Herrero & Asociados), a Spanish IP leading firm with branches in Portugal and several Latin American countries. Mr. Sabán is a Spanish trademark attorney based at H&A’s HQ in Madrid. He has over 10 years of experience counseling foreign clients and helping them develop and exploit their trademark portfolios in Spain and the EU, including clearance prosecution, preparing demand letters, negotiating settlement agreements, as well as handling opposition, cancellation, and infringement actions before both Spanish and European Union administrative and judicial bodies.

On July 13, 2013, the Spanish company Industrias de Diseño Textil (Inditex), owner of the worldwide known fashion brand ZARA, initiated a lengthy and unfruitful judicial path filing a judicial action against Buongiorno Myalert, S.A. (Myalert).

But the story began even earlier: back in 2010, Myalert launched a draw amongst those consumers that hired their services (i.e., remittance of multimedia content via SMS), with a prize of a ZARA gift card valued at €1,000. That was the hook.

The judge analyzed the content of the promotion in which Myalert offered the €1,000 ZARA gift card to the winner of a draw to be held among all those who signed up for a subscription service to “CLUB BLINKO” and concluded that:

a. the defendant was simply offering information about the draw prize;

b. in the process of subscribing to “CLUB BLINKO”, users received additional information about the type of service they were subscribing to, and about the service provider, highlighting that, within the information received by the user, there was no reference to either ZARA or INDITEX.

The judge, however, stated that even if the defendant had not distinguished its services with ZARA, this does not necessarily mean that such use was covered by article 37 of the LM, highlighting that such use informed about the prize features offered in the context of the promotion and not the service provided by Myalerts, namely a subscription service of alerts to phone users.

At this point, the Court focused on EU case law to analyze if the use carried out by the counterparty was to be considered an infringement, and this is where Inditex was finally defeated by the judge’s conclusions.

Against these claims, Myalert argued that the action had been prescribed, as the promotion had taken place in November 2010 and the actions had not been filed until 2013. According to the Art. 35 of the Spanish Trademark Law on Unfair Competition, this kind of action needs to be exercised within one year of the behavior. The judge upheld this argument. As Art. 45 of the Spanish Trademark Law (hereinafter, LMI) holders have five years to file actions against trademark infringement, the case focused on trademark infringement.

The defendant alleged that use of the “ZARA” sign had a descriptive nature allowed by the trademark limits provided by article 37(b) of the LM, according to which, trademark owners cannot prohibit third parties from using their signs during trade, in accordance with honest practices in industrial or commercial matters of indications relating to the kind, quality, quantity, destination, value or geographical origin.

The judge confirmed that the promotion in which Myalert offered the €1,000 ZARA gift card to the winner of a draw to be held among all those who signed up for a subscription service to “CLUB BLINKO” infringed their exclusive right to use the well-known trademark “ZARA” linked to its advertising efforts as a consequence of Inditex’s recognition and damaging its reputation.

Based on these actions, Inditex requested the judge to order the defendant:

i. not to resume infringing activities and to refrain from using any distinctive signs which might be associated with any of Inditex’s trademarks;

ii. to pay damages;

iii. to publish the judgment.

The Spanish Supreme Court confirms that the complainant has not fulfilled acts of trademark infringement using the term ZARA on its promotions.
Jurisdictional Briefing, US: bad faith and morality – an EU update and where the US stands

Benjamin Cantor, Associate at Cantor Colburn, compares the EUIPN’s CP13 and CP14 to the recently updated measures for handling bad faith and morality in US trademark law in the pursuit of solutions for tackling similar issues.

In October 2022, the European Union Intellectual Property Network (EUINPN) released its first drafts for public comment of Common Practice 13 ‘Trademark Applications Made in Bad Faith’ (‘CP13’) and Common Practice 14 ‘Trademark Applications Contrary to Public Policy or to Accepted Principles of Morality’ (‘CP14’). CP13 and CP14 intend to provide a common understanding of newly established principles on bad faith and morality for the European Union Intellectual Property Office (EUIPO), Member States’ Intellectual Property Offices (‘MS IPOs’), and other stake holders. CP13 and CP14 come shortly after the United States updated its own measures handling bad faith and morality in trademark law.

As the EU embarks on establishing updated principles on bad faith and morality for intellectual property owners and stakeholders, this article analyses how CP13 and CP14 compare to the updated standards in the United States.

Without the guardrail of requiring proof of use prior to registration in the EU, as opposed to the use requirement in the United States, CP13 offers guidance on how to examine bad faith in the cases of (1) misappropriating the rights of a third party or (2) as an abuse of the EU trademark system. CP13 presents factors for examining bodies to consider if a suspicion of bad faith is present. While acknowledging a bad faith assessment is performed on a case-by-case basis, CP13 provides examples of trademarks that violate principles of morality and guidance for when to consider additional context such as (1) the identification of goods and services or (2) the consumers most likely to encounter the trademark. CP14 advises trademark examination bodies to balance public policy and principles of morality with freedom of expression.

Alternatively, the United States no longer considers such a balance after recent precedent decisions. In 2017, the Supreme Court held that the disparagement clause of the Lanham Act was unconstitutional, violating the free speech clause of the First Amendment. In practice, this struck down the USPTO’s ability to refuse trademark applications that violate principles of morality. In light of CP14, a wide range of trademarks considered contrary to accepted principles of morality or public policy in the EU are registrable in the United States.

The inherent differences between the EU and the United States create variations in solutions for tackling the same issues. As policies continue to shift, it remains critical for brand owners and stake holders to monitor the successes and drawbacks of these altering approaches.

Résumé

Benjamin Cantor advises domestic and international clients in trademark clearance, prosecution, monitoring, and enforcement, and is very interested in the differences in European and US trademark laws. He is active with trademark industry associations INTA and ECTA. At the 2023 ECTA annual meeting, he is presenting an educational session on the differences in CP13 and CP14 in Europe and the US. Ben also has experience in copyright law, assisting and advising clients in obtaining and protecting copyrights.
High threshold for evidence of trans-border reputation in recent cases to prove trans-border reputation of trademarks in India

Manisha Singh and Ritika Agrawal of LexOrbis compare two recent cases that exemplify the high standards required for claimants to prove trans-border reputation in order to uphold their trademarks.

According to the principles of trans-border reputation, it exists when a trademark gains reputation across the border or beyond the territorial limits of the geographical region through promotions, commercial publicity, advertisements, and its market presence at large. Distribution of information about a product’s trademark through advertisements and publicity in media amounts to the use of a trademark even if the advertisement is not combined with the actual presence or use of the product in the market.

Trademarks having a trans-border reputation in India are well-protected under Indian law; however, a claimant needs to prove that their trademark has a trans-border reputation in India through documentary evidence. Courts in India have time and again laid down various tests to examine if a claimant’s mark has a trans-border reputation or not. In the recent cases of February 2023, the Delhi High Court has set high standards for the claimants to prove that their marks have a trans-border reputation in India and has laid down ten conditions on the evidence to uphold the same.

The Alphard case
In the recent case of Toyota Jidosha Kabushiki Kaisha vs. Tech Square Engineering Pvt Ltd decided on February 3, 2023, the Court rejected Toyota’s rectification application on the ground that its mark - a minivan, under the name Alphard in 2002, was not having any goodwill and reputation in India. Two important observations by the Court in the present order were its reliance on the strict test regarding the ‘territoriality principle’ and the difference between the application of the ‘spill-over effect’ of the trans-border reputation in passing off and rectification cases.

Firstly, the Court dismissed the evidence produced by the Petitioner, to hold that apart from establishing ALPHARD’s goodwill abroad, Toyota had not established ALPHARD’s goodwill in India. The Court noted that the petitioner failed to place on record any invoice to show that it had sold any car under the brand ‘ALPHARD’ in India. The trademark application filed on behalf of the petitioner in November 2017 was on a ‘proposed to be used basis’. Regarding the evidence of Toyota, the Court stated that the petitioner has not advertised its brand in India in any manner. Various documents placed on record by the Petitioner such as international brochures/annual reports, awards, worldwide trademark registration certificates/renewal certificates and promotional material, were considered to be for international usage of the aforesaid trademark.

The Court stated that, though these documents show that the trademark ‘ALPHARD’ has acquired goodwill and reputation in several other jurisdictions around the world, as per the ‘territoriality principle’, none of the aforesaid documents filed by Toyota showed that the brand ‘ALPHARD’ has acquired goodwill and reputation in India. The Court noted that the documents filed by the Petitioner relating to India were screenshots from third-party websites showing that it had listed a few cars under the brand ‘ALPHARD’ for sale in India, which is not enough to prove the goodwill of its mark in India. It was also pointed out by the Court that the aforesaid imports have not been made by the Petitioner but by the private parties.

The Court further pointed out that articles in various trade/automobile magazines and newspaper reports regarding the Petitioner concerning the launch of a vehicle under the brand ‘ALPHARD’ in India, were published after the trademark ‘ALPHARD’ had already been registered by the Respondent in India. The Court further noted that the vehicle under the brand ‘ALPHARD’ was never launched in India. The same model was launched in India in February 2020 under the brand ‘Vellfire’. Therefore, no reliance could be placed on these articles to show that the brand ‘ALPHARD’ has acquired goodwill and a reputation in India.

Secondly, the Court rejected Toyota’s claim of the trans-border reputation of ‘ALPHARD’ in the Indian market and its reliance placed on ‘MAC Personal Care’ and ‘Keller Williams Realty’ since these judgments were in the context of passing off and not rectification, indicating that to establish the spill-over effect of trans-border reputation in case of rectification application, the petitioner must satisfy a different standard of proof than the ones prescribed in passing off. However, no further explanation was given by the Court on this point.

The Court dismissed the petition basis that sufficient proof was not presented by Toyota to demonstrate the spill-over of the reputation of the mark in question in India.

The Bolt case
In the recent case of Bolt Technology OU vs. Ujjoy Technology Private Limited and Ors. decided on February 24, 2023, the Delhi High Court refused to grant an interim injunction in favor of Bolt Technology Private Limited’s trademark ‘Bolt’. The Court noted that articles in various trade/automobile magazines and newspaper reports regarding the Petitioner concerning the launch of a vehicle under the brand ‘ALPHARD’ in India, were published after the trademark ‘ALPHARD’ had already been registered by the Respondent in India. The Court further noted that the vehicle under the brand ‘ALPHARD’ was never launched in India. The same model was launched in India in February 2020 under the brand ‘Vellfire’. Therefore, no reliance could be placed on these articles to show that the brand ‘ALPHARD’ has acquired goodwill and a reputation in India.
the number of times Bolt’s App was accessed, and the Court noted that the Plaintiff admittedly has no trademark registration in India, though it has applied for registration of the trademark ‘Bolt Charge’ and device mark ‘Bolt’, which are pending with the Registrar of Trade Marks. It was found by the Court that since the Plaintiff is not engaged in providing EV charging services anywhere in the world and has merely installed EV charging stations in a handful of locations to charge its vehicles, no trans-border reputation in providing EV charging services could be credited to it that can be said to have spilled over into India.

Decision of the Court
The Court noted that the Plaintiff admittedly has no trademark registration in India, though it has applied for registration of the trademark ‘Bolt Charge’ and device mark ‘Bolt’, which are pending with the Registrar of Trade Marks. It was found by the Court that since the Plaintiff is not engaged in providing EV charging services anywhere in the world and has merely installed EV charging stations in a handful of locations to charge its vehicles, no trans-border reputation in providing EV charging services could be credited to it that can be said to have spilled over into India.

It was held by the Court that there is nothing whatsoever to indicate that the Plaintiff was, in the EV-charging market at all, even to date. The ‘market’, in which Bolt was using the trademark in question ‘Bolt’, was a market of taxi-hailing services, with associated activities like food and grocery delivery and the like. It was not admitted by the Court that the Plaintiff’s mark ‘Bolt’ was entitled to be regarded as a ‘well-known trademark’ under Section 100(2) (zg) of the Trade Marks Act, 1999. The Defendant also alleged that it is the largest player in India in the EV charging stations market and that the Plaintiff is not engaged in the business of EV charging stations/docks and thus, does not enjoy any goodwill or reputation for the same. It was argued by the Defendant that the use of the ‘Bolt’ mark by the Plaintiff for EV charging docks/stations in Tallinn (Estonia), Lithuania and Portugal, cannot be considered as trans-border/worldwide reputation having spilled over into India.

The Court stated that there is no justification, therefore, prima facie, for the Court to, by allowing the application of the petitioner, who has no market exposure whatsoever in India, and, prima facie, no spill-over or peril of its trans-border reputation into India, to jeopardize the market, or the repute, that the defendant has earned by use of the impugned mark, for providing EV charging services. The Court thus dismissed the plaintiff’s application seeking an interim injunction.

Conclusion
In both above-mentioned cases, the plea of a trans-border reputation of the Petitioner/Plaintiff was not allowed by the Court as the respective parties failed to produce sufficient evidence to show that they had a trans-border reputation associated with their marks with regards to the same goods and business as the Respondent/ Defendant in India. The key factor examined by the Court was whether the Petitioner/Plaintiff was able to show through its evidence or not that it had the intention to use its mark before the adoption of the same mark by the Respondent/Defendant in India. Another factor that came to light was the Court’s attempt to protect the use, interest, and rights of the Indian businesses that use their marks in a bona fide manner against the unsubstantiated claim of the multinational businesses. It can be safely concluded that these cases have set a high threshold for the need to produce evidence for claiming the trans-border reputation of a trademark in India.
TRADEMARK STABILITY IN RUSSIA

Has unstable become the new stable or is the IP in Russia firmly keeping its position?

Marina Karaldina of Patentica examines the failed attempts of copycats to assess the current stability of trademarks in Russia despite sanctions against the Russian Federation.

After the sanctions against the Russian Federation started to expand facing the counter sanctions as well as passing the President’s Decree of February 28, 2022 N 79 and the Government Decree N 430 – rounding the "unfriendly" states, the future for many sectors seemed vague, and IP had its various concerns. Unclear prospects created a tempting environment for the enterprising ones for trying to take advantage of the crisis.

In the spring of 2022, different Russian companies and individual entrepreneurs filed with the Russian PTO many applications for trademarks very similar or identical to famous foreign brands. Naturally, these filings alarmed the legitimate right holders especially due to uncertainty on how the rights of foreign companies would be treated by the PTO, which according to the law should conduct a search and cite relevant prior rights against the new filings. Some holders decided to act immediately by filing third-party observations, whereas consent from right holders is obviously off the table.

Other than trademark prosecution, foreign companies are truly worried about whether their registered trademarks are still enforceable in Russia. These concerns were mainly caused by a few erroneous decisions taken by courts in several Russian regions in the first half of 2022. which ruled against the right holders from "unfriendly states". The most notorious was a decision taken on 2 March 2022 in the Arbitration Court of the Kirov region of the Russian Federation, which refused to protect the interests of Peppa Pig copyright and trademark owner, Entertainment One. and was widely covered by mass media. This decision was successfully appealed at the Second Court of Appeal, recognizing the infringement of the rights of Entertainment One. Obviously, the initial ruling was caused by misreading and misinterpretation of the Presidential Decree and was simply a wrong decision on the ground.

Later on some Russian companies and individual entrepreneurs facing infringement charges tried to defend themselves by claiming that filing an infringement case by a holder from an "unfriendly state" should be treated as bad faith, however, judges overruled such defense statements. Among such decisions was the ruling of the Arbitration Court of the Novosibirskaya Oblast dated May 23, 2022. in case No. A45-1063/2022 that recognized infringement of rights to trademark LOL SURPRISE and works of art representing images of dolls belonging to MGA Entertainment Inc. by a domestic individual entrepreneur and awarded compensation to the right holder. In the Decision, the court made the following important conclusion: the Decree of the President of the Russian Federation of February 28, 2022 N 79, as well as the Government Decree N 430-1 do not provide for such enforcement measures that would allow the trademark violators an exemption from liability in relation to right holders from unfriendly countries.

In the same case the defendant claimed a release from liability on the grounds of the Decision of the Government of the Russian Federation of March 29, 2022 N 450 approving parallel import of goods labeled with trademarks owned by parties from unfriendly countries. Parallel import, introduced by the new provisions, changed the national exhaustion of rights to international with regard to certain types of goods and brands. This Decree allowed importing the original goods into the territory of the Russian Federation without the consent of the holder. If the goods had been introduced into the market by the holder abroad. The court in the above case pointed out that the disputed goods had been recognized as counterfeit (not original), because they were not produced and labeled by the trademark owner, which excluded the possibility of applying the legislation regulating parallel import.

Similar statements were made in a decision of the Arbitration Court of the Tambov Region dated July 26, 2022 in the case No. A64-9894/2021 on infringement of rights to trademark ROBICAR POLY and works of art portraying the cartoon characters of ROI VISUAL CO. LTD. The defendant did not provide the evidence confirming the legitimacy of using the trademark and works of art belonging to ROI VISUAL CO. LTD., whereas the court concluded that the registration of the plaintiff in an "unfriendly" state did not indicate bad faith of the plaintiff and, accordingly, did not give grounds to refuse protection of rights. Applicability of the parallel import provisions is also determined in the Ruling of the Court for Intellectual Property Rights dated April 27, 2022 N C04-557/2022 in the case N А40-8478/2022. The court also refused to apply the normative acts regulating parallel import to the case, because the goods under consideration were not original.

Court practices show that despite the suspension of direct import of certain goods to Russia and parallel import legalization, many foreign right holders continue to pay close attention to the Russian market. However, the future of trademark stability in Russia is still uncertain due to the sanctions and their consequences.

Marina Karaldina is a trademark attorney at Patentica. She has more than 15 years of experience in trademark prosecution in Russia and CIS. Her practice includes filing third-party observations, oppositions, and objections to examination decisions, as well as representing clients before the Chamber for Patent Disputes and the IP Court. She is a member of the Russian Association of Patent Attorneys and Saint Petersburg Association of Patent Attorneys.

Author email: marina.karaldina@patentica.com
Parallel import provisions are applicable only to original goods.

TRADEMARK STABILITY IN RUSSIA

attention to the situation in the market and monitor illegal use of their trademarks and sales of fake products. About 30 lawsuits involving well-known fashion house Dior Couture have been considered since February 2022 and decided in favor of the right holder awarding the Plaintiff damages of about 1.8 million rubles for illegal trademark use. Another well-known company Chanel has also participated in about 25 solved cases over the last year and has been awarded approximately 1 million rubles in compensation for infringement of its trademarks. Not only right holders themselves, but also administrative bodies initiate court actions against the illegal use of foreign IP. Over the last year courts in various regions of the Russian Federation have completed numerous administrative proceedings launched by executive bodies against parties importing or selling counterfeit goods featuring famous brands such as NIKE, GIVENCHY and many others, which in most cases ended with administrative fines to the infringers and destruction of the counterfeit. For example, different courts have considered over 20 court claims filed by police and customs against infringement of ADIDAS AG, which in most cases ended with administrative fines to the infringers and destruction of the counterfeit. For example, different courts have considered over 20 court claims filed by police and customs against infringement of ADIDAS AG. About 30 lawsuits involving well-known fashion house Dior Couture have been considered since February 2022 and decided in favor of the right holder awarding the Plaintiff damages of about 1.8 million rubles for illegal trademark use. Another well-known company Chanel has also participated in about 25 solved cases over the last year and has been awarded approximately 1 million rubles in compensation for infringement of its trademarks. Not only right holders themselves, but also administrative bodies initiate court actions against the illegal use of foreign IP.

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BORDER CONTROL MEASURES, EGYPT

The Business of Innovation

INTA’s 2023 Annual Meeting will focus on innovation. With two tracks, IP & Innovation and The Business of Brands, we will explore what the latest advances in technology could mean for brands in the future. Join us for networking opportunities, learn about cutting-edge ideas, and reconnect with colleagues from around the world.

Border control measures in Egypt and the dilemma of security payment

Nermien Al-Ali, Esq, Founder and Managing Partner of NAL Law Group, explains the changes to Egyptian law which bring into force some of the TRIPs agreement practices for imported and exported goods while highlighting some remaining flaws.

Global trade in counterfeited and pirated goods has reached a staggering 2.1 trillion dollars in 2022. Interpol identified global trade in counterfeits as cross-border organized crime, more profitable than drug trafficking, that has been shown to have links to terrorism. In an attempt to counteract this illicit cross-border trade, the Trade Related Aspects of Intellectual Property Rights treaty (“TRIPs”), part of the World Trade Organization GATT treaties, was signed between member countries in 1995 to provide the minimum requirements for border control measures. Under TRIPs, the intellectual property rights holder may apply to the Customs Authority.
for temporary suspension of release of suspect imported or exported goods, upon having reasonable grounds to suspect the goods are counterfeited or pirated. The rights holder shall have 10 working days from the date of suspension of release to obtain a judicial order (or an injunction) ordering the authorities to suspend release. The rights holder is not required under TRIPs to pay a security - a.k.a. bond - for the suspension of release to be effective. But due to the lobbying of some member countries of the TRIPs Agreement, and to assist rights holders with the suspension of release, the Egyptian Customs Authority allowed the rights holder to apply to provide a security on the conditions that such security is used for preventing abuse of the system and the protection of importers (where the goods are found to be genuine). In such cases, the security shall not unreasonably deter recourse to these procedures.

Though the TRIPs Agreement allowed the imposition of a security/bond on the rights holder, it did not totally exonerate the suspected importer of the same. In fact, the TRIPs Agreement provided that the Customs Authority of member countries must impose a security on the importer if the goods are to be released on the condition that if the goods are eventually found to be counterfeited or pirated by a court of law. In addition, the TRIPs Agreement provided that the Customs Authority should, on its own account, stop the release of any goods into market that it suspects are counterfeited or pirated. In such a case, the Customs Authority, and not the rights holder, would initiate the process by suspending the release of goods and notifying the rights holder to proceed with obtaining the appropriate judicial orders within the 10 working days. Such security shall be used in this case to compensate the suspected importer, if the goods are eventually found to be counterfeited or pirated by a court of law. In addition, the TRIPs Agreement provided that the Customs Authority should initiate the procedure to stop the release of suspect goods, and should obtain a security payment to cover the costs and expenses of keeping the goods for the 10 working days and possibly longer. Both grounds of justification fail to pass as appropriate or fair under the TRIPs Agreement standards, which made it clear that the bond should not be prohibitive to the rights holder and should be used for the purpose of preserving the market of genuine products. In addition, neither the law nor the practice thereof provides a clear mechanism for refunding the bond to the rights holder, once justice is served. The bond payment on the rights holder before 2021 (New Law) is initiated by the rights holder, then the rights holder shall pay the value of any goods taken from the Suspicion of Release for suspending the release of the goods without having to pay a security bond. But, for all other cases, the rights holder is faced with the imposition of an injunctive order without payment of a bond. In the case of Egypt, the laws of Egypt showed the rights holder is another aspect where the new Customs Law followed the Qatar Law model in that regard where the Port Authority should impose a security payment to be paid by the rights holder for the goods they are to be taken outside the port. Such a bond payment under the border control measures for the protection of intellectual property rights against counterfeiting and piracy shows Egypt’s commitment to enforcing the TRIPs Agreement and providing intellectual property rights and combating global illicit trade. Nonetheless, legal reform efforts need to address the requirement of payment of bond imposed on the rights holder, and the lack of reasonable mechanism for the authorities to recoup their associated expenses. With some changes in the laws and training on its application by the authorities, the new Customs Law should be at the forefront of border control measures with its 25 and more ports. Enactment of laws should not be done in a vacuum away from practical realities, that would burden and hamper their execution.
Olga Plyasunova, Head of the Trademark Department at Zuykov and partners, details examples of trademark registrations and their relevant resolutions for marks containing official symbols.

From time to time, objects that are part of the official symbols are included in trademarks - accidentally or intentionally - in order to attract the attention of consumers.

In accordance with Art. 1231.1 of the Civil Code of the Russian Federation, objects that include, reproduce or imitate official symbols, names and distinctive signs (or their recognizable parts) cannot be registered as a trademark, namely:

- state symbols and signs (flags, emblems, orders, banknotes, etc.);
- names of international and intergovernmental organizations (including abbreviations), their flags, emblems, other symbols and signs;
- official control, guarantee or hallmarks, seals, awards and other insignia.

The article is devoted to the topic of including official symbols (flags, names, insignia, etc.) in trademarks - in particular, the issues of proper consent to the registration of such marks and the nuances of proving the compliance of registration with Art. 1231.1 of the Civil Code of the Russian Federation.
1. For the registration of a trademark, the consent of the Heraldic Council under the President of the Russian Federation - the State King of Arms was required, since the designation contained the Russian flag.

2. In order to register a trademark including the designated pictorial element, it was necessary to provide the consent of the Central Bank of the Russian Federation.

3. The consent of the Green and Red Cross, respectively, was required for the registration of the designations and .

4. The registration of the designation “OLIMP LABS” was granted the consent of the International Olympic Committee (International Olympic Committee).

Cases in which the decision of Rospatent containing the assessment of the designation in accordance with Art. 1213 of the Civil Code of the Russian Federation are not numerous, but are of practical interest.

For example, in cases of 2022 N SIP-107/2021 and N SIP-1080/2021 trademarks ” ”, N 777671 and ” ” N 608247 were registered in the name of the LLC, but their registration was challenged under paragraph 2 of Art. 1483 of the Civil Code of the Russian Federation (registration of designations that relate to objects not subject to legal protection in accordance with Article 1213 of the Civil Code of the Russian Federation) - but Rospatent refused to satisfy the objections. This served as the basis for the applicant’s appeal to the Court for Intellectual Property Rights.

The main argument of the applicant was the following: the letter combination “RB” is used as an abbreviation for the name of the subject of the Russian Federation - the Republic of Bashkortostan, in connection with which the registration of the element “RB” of the disputed trademark contradicts paragraph 2 of Art. 1483 of the Civil Code of the Russian Federation. However, the IP Court of Rospatent considered that the letter combination “RB” could act as an abbreviation for various designations, including such as the Republic of Bulgaria, the Republic of Belarus, the Republic of Bashkortostan, the Republic of Burunia, etc. At the same time, the uncontroversial perception of the specified letter combination as “Republic of Bashkortostan” has not been proven, therefore, the grounds for concluding that the registration of the latter combination “RB” does not comply with the provisions of paragraph 2 Art. 1483 of the Civil Code of the Russian Federation are absent. Moreover, the applicant did not provide the consent of the applicant’s interest in challenging the granting of legal protection to the trademark on the basis of the norm under consideration. The IP Court pointed out that if signs, including official symbols, names and distinctive signs, are registered as a trademark, then the person interested in challenging the granting of legal protection to the trademark may be the relevant competent state body, body of an international and intergovernmental organization, while as the applicant did not have such a status.

Also interesting is the practice in which the Chamber for Patent Disputes evaluated the designation differently than Rospatent during the examination process, and recognized registration as possible, refuting the inconsistency of Art. 1213 of the Civil Code of the Russian Federation. For example, the designation “ ” was recognized by Rospatent as similar to the official emblem of APEC leng, Asia-Pacific Economic Cooperation, forums of the economy of the Asia-Pacific region for cooperation in the field of regional trade, facilitation and liberalization of capital investments, however, the falsified copyright holder objected, citing the lack of similarities. The Board of the Chamber noted that “APEC” and ” ” are protected designations, but the difference in sound in the initial part of the designations is a significant factor due to the small length of words; at the same time, the word element “Ipek” is fantasy and is not associated with the designation APEC in a semantic sense. The board also pointed out the difference in the overall visual impression.

As a result, the Board of the Chamber considered that the designation could not be considered as inconsistent with Art. 1213 of the Civil Code of the Russian Federation and canceled the decision of Rospatent.

In the case of the designation “ ” Rospatent also refused to register on the basis of paragraph 2 Art. 1483 of the Civil Code of the Russian Federation due to the fact that the pictorial element in the form of a red cross is confusingly similar to the official emblem of the International Committee of the Red Cross. In the objections, the applicant referred to his own request to amend the application materials by changing the color scheme of the applied for designation, in connection with which the legal protection of the designation is requested in black and white. According to the Applicant, these changes further reinforce the original differences between the declared designation and the official emblem of the Red Cross. The Board of the Chamber accepted these arguments and drew attention to the fact that the first and main element of the CRC is a red cross on a white background “ ”, however, the change in the declared designation was carried out in such a way that the new designation “ ” no longer contains a red cross, and the exclusion of this element from composition of the claimed designation eliminates the reasons for refusing registration.

Thus, it can be concluded that the reason under consideration for refusing registration or invalidating it is not the simplest and most unambiguous, like any reason requiring a comprehensive comparison of designations.

Résumé

Olga Plyasunova is a Trademark Attorney and Head of Trademark Department at Zuykov and partners. Olga has the status of Patent attorney of the Russian Federation (No 2958) and Eurasian patent attorney (No 63). Olga has been working with Zuykov and partners LLC since 2007. She specializes in Appellations of origin of goods, Trademarks and service marks, Industrial designs. Olga is a member of ECTA (2019). She has extensive experience in consideration of Trademarks and service marks, Industrial designs. Olga is a member attorney (No 63). Olga has been working with Zuykov and partners LLC since 2007. She specializes in Appellations of origin of goods, Trademarks and service marks, Industrial designs. Olga is a member of ECTA (2019). She has extensive experience in consideration of Trademarks and service marks, Industrial designs. Olga is a member attorney (No 63). Olga has been working with Zuykov and partners LLC since 2007. 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Such objects, their recognizable parts, or imitations may be included in a trademark as an unprotected element if there is the consent of the relevant competent state body.

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Burberry’s famous pattern denied by EUIPO for the metaverse

Diogo Antunes, Legal Manager and Patent Attorney at Inventa, reviews the recent trademark application refusal for the famous Burberry pattern that has raised questions about the EUIPO’s process for registering trademarks in the metaverse.

In recent years, the rise of non-fungible tokens (NFTs) has taken the world by storm, with individuals and companies alike attempting to capitalize on the new technology. One such company is Burberry, a British luxury fashion house, who attempted to register an EU trademark for their globally recognized pattern. However, the company’s application was met with a partial refusal by the European Union Intellectual Property Office (EUIPO), which was subsequently denied by EUIPO for the metaverse.

The refusal is based on the grounds that the trademark application lacks distinctiveness, as the check pattern used is not markedly different from other common patterns commonly used in the trade for the goods and services for which an objection has been raised. The examiner further stated that “the consumer’s perceptions for real-world goods can be applied to equivalent virtual goods as a key aspect of virtual goods is to emulate core concepts of real-world goods.”

This decision has raised questions about how trademarks for virtual goods should be analyzed and the extent to which they should be treated in the same way as trademarks for physical goods. EUIPO’s notice on NFTs states that virtual goods should be categorized as Class g goods, which include digital content or images. However, the term “virtual goods” on its own lacks clarity and precision, so it must be further specified by stating the content to which the virtual goods relate, such as “downloadable virtual goods, namely, virtual clothing.” The partial refusal of Burberry’s trademark application highlights the importance of ensuring that trademarks for virtual goods must be analyzed in the same way as trademarks for real-world goods.

Moreover, the value of NFTs lies in their uniqueness, rather than their design or branding. Furthermore, the importance of ensuring that trademarks for virtual goods should not necessarily be the same as for physical goods. Virtual goods have unique features that may not apply to physical goods, and their distinctiveness may depend on factors such as their rarity or uniqueness, rather than their design or branding. Therefore, the value of NFTs lies in their blockchain authentication, which makes them unique and valuable, and the trademark for the NFT could reflect that uniqueness.

The decision also raises questions about the broader legal implications of NFTs and virtual goods. As more companies and individuals begin to use NFTs to sell and authenticate digital art, collectibles, and other goods, there may be a need for new legal frameworks to regulate and protect these transactions. NFTs raise questions about ownership, copyright, and intellectual property, as well as the potential for fraud and theft. It is likely that regulators and legal experts will need to develop new rules and regulations to address these issues in the coming years.

In the meantime, companies that are interested in trademarking their virtual goods will need to consider the distinctiveness of their trademark and designs, and ensure that their trademarks are not simply replicating patterns that are commonly used in the trade.

To conclude, the recent partial refusal of Burberry’s NFT trademark application highlights the challenges and considerations that trademark applicants and examiners face in the emerging world of NFTs and virtual goods. The decision by EUIPO to refuse the trademark application indicates that virtual goods must be analyzed in the same way as trademarks for real-world goods when assessing their distinctiveness and potential for trademark protection. This means that NFT trademarks must be sufficiently distinct from other common patterns in the trade, just like any other physical product.

As more and more companies enter the world of NFTs and virtual commerce, it will become increasingly important for them to carefully consider the distinctiveness of their trademark and the potential for trademark protection in this new digital landscape. Additionally, trademark offices around the world will need to develop clear guidelines and standards for evaluating NFT trademarks to ensure that they are assessed fairly and consistently.

The refusal serves as a reminder that while NFTs and virtual goods offer exciting new opportunities for businesses and consumers, they also present unique legal and intellectual property challenges that require careful consideration and expert guidance.

Résumé

Diogo Antunes, Legal Manager and Patent Attorney at Inventa

Diogo works mainly on all Intellectual Property issues concerning Trademarks and Patents. Additionally, he provides support in cases of defense IP rights and litigation.
Technology is unlocking a new level of potential benefits for law firms across the world. Every profession benefits from the lightning-fast pace of technological development, and intellectual property management is no different. In recent years, IP management systems have matured into services that make it easier for attorneys and their colleagues to manage their tasks with ease, but what else does IP management technology have to offer to industry professionals?

Sam Thorley is Head of Platform for Equinox, a leading provider of intellectual property management software used by IP professionals across the world. He is currently working on the future of legal tech that can help IP professionals magnify their abilities to deliver incredible results for their clients. Sam’s aim is to make it as simple as possible to manage intellectual property.

In this article, Sam explores the future of IP management technology. He highlights the key areas of technological development that IP attorneys and their colleagues can expect to benefit from in the next few years.

Everything in one place
Intellectual property professionals rely on a wide variety of services to manage the lifecycle of their cases. There are hundreds of services built to help with individual elements of the profession: there are renewals providers, specialist search services, and financial services software, not to mention the standard administrative tools we all use. As these services add up, an IP professional can be quickly swamped by dozens of tabs and applications open at the same time. IP tech providers are working on a better way to balance these services.

An intellectual property management system (IPMS) already has the power to help professionals manage their tasks and meet deadlines more easily, but there is more it can offer. The future of IP management will see all of a professional’s services accessible from a single location. No longer will you have to switch between different tabs and programs or manually upload data from one place to the next: it will all communicate automatically. This will save everyone in your team hours of time and free up resources to focus on client relationships.

These integrations are increasingly accessible today and combine many of the tech services you already rely on, from software as common as Microsoft Office and email right through to specialist renewals providers.

The benefits of integration extend beyond those working on cases, however. Financial services applications can be connected to your system to make it easier to manage client billing, with...
The next goal for integrations is to have the full lifecycle of the IP management process manageable from a single system.

The next goal for integrations is to have the full lifecycle of the IP management process manageable from a single system. When artificial intelligence is adopted in the IP tech environment, it is quickly progressing towards integrations that encompass the entire lifecycle of intellectual property. IP management systems have already begun to incorporate renewal services into their systems, and at Equinox, we project that EP validation, translation orders, and links to business intelligence and search software are all strong candidates for integration.

Soon, with the increased use of artificial intelligence, the one-to-one tech support call is here to stay. At Equinox, our subscribers value the personal experience of having one of our support team guide the user to a solution or deliver training. Many other firms, we are set on maintaining this capability to ensure our support is as accessible as possible. However, we are also looking at ways to grant our subscribers more independent access.

Multi-media support documentation is the best way to give users the choice of how they can access help with their tech. People want to get their information in different ways; some like to read a document, whereas others like to watch a step-by-step video. At Equinox, we are building our Help Centre to encompass a variety of support media for independent, round-the-clock access. In conjunction with our friendly support team, the digital Help Centre ensures our subscribers can get the help they need anytime.

The next goal for integrations is to have the full lifecycle of the IP management process manageable from a single system.

THE TRADEMARK LAWYER
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THE FUTURE OF IP MANAGEMENT

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Trademark misuse in the digital environment

Xavier Hadad, Partner at Uhthoff, Gomez Vega & Uhthoff, evaluates the available general procedures for tackling trademark infringement on the Internet.

Nowadays it would be practically impossible to understand our lives without the "digital environment". What once seemed an alien world has now become a natural way of understanding and communicating, thus we could not visualize our modern world without the digital aspect.

How distant do the 1980s seem, when the first commercial applications of the Internet were born, and even the 1990s (30 years ago) when the first “social networks” were launched amidst a cloud of uncertainty? We have come to realize that our whole world is conditioned by the Internet and the digital environment.

As we have seen with each day passing since, the advance of the Internet and all that encompasses the so-called digital environment has grown by leaps and bounds. In contrast, legal professionals noticed how certain laws became obsolete and the legal industry struggled to find a feasible approach to work within the digital environment, not to mention considering local and international legislation.

The above has grown to a point that today there is a serious debate on whether the “right to access the Internet” (and hence the digital ecosystem) is a human right that every person is entitled to, as this would derive from the freedom of expression long ago recognized as a fundamental human right, considering these examples, it is evident that no matter how much the digital environment may change in the future, we are certain life as we envision it would not be conceivable without a digital environment.

In that context, the question we all have to ask ourselves is no longer whether current legislation protects users within the digital environment, instead, how do I protect myself in the digital environment? This is where lawyers specialized in Intellectual Property, amongst other concepts, start working to provide protection for intangible rights that are regulated by existing legislation.

Considering the overwhelming presence and importance of the Digital World in our life, as IP practitioners we encounter ever more consultations related to the use of trademarks or any intellectual property right in the digital environment, receiving inquiries from our clients such as:

- They are using my trademark on the Internet, what can I do?
- There is a social media profile showing my trademark without my consent, what can I do?
- If I am going to use a name only on the Internet or social networks, do I have to register it?

Considering the above we must clarify even though we could understand the digital environment as an independent entity and “alien” to the earthly world, we must realize since the last few decades and until these days the digital environment has become a primary tool for traders, entrepreneurs, and, in general, for anyone who wants to offer a product or service worldwide because with just a “post” or the press of a button you can reach millions of users. This new

Résumé

Xavier Hadad, Partner
A longtime Partner at Uhthoff with more than 20 years of experience in diverse areas of intellectual property with a strong focus on litigation and a proven leader in contentious matters. An expert IP advisor and counselor focused on patent and trademark litigation, domain name disputes, and anti-counterfeiting.

He began practicing law at Uhthoff, Gomez Vega & Uhthoff in 2003, and since then, he was invited to become a Partner in 2015. He is actively involved in relevant patent, trademark, and copyright cases. Xavier is an effective litigator with a unique attention to detail in matters related to both administrative appeals and judicial resources.

Author email: xhadad@uhthoff.com.mx

Domain name disputes

Let’s first talk about the mechanisms for the resolution of domain name disputes established by the World Intellectual Property Organization “WIPO”, better known as “Internet Domain Name Disputes”.

These alternative mechanisms allow individuals to avoid resorting to judicial proceedings and instead initiate a dispute resolution procedure to recover a domain name that uses a trademark in an identical or confusingly similar fashion to a previously registered trademark.
TRADEMARKS IN THE DIGITAL ENVIRONMENT

This mechanism, established by the World Intellectual Property Organization has its own legal framework called “Uniform Domain-Name Dispute Resolution Policy” and has governed domain name disputes since the beginning of this century.

Utilizing this procedure, we can provide answers for those clients who ask how to exercise an intellectual property right within the digital environment, and based upon this we can begin to develop a legal strategy to enforce our clients’ rights. This is available to any individual or company that detects the existence of an infringed domain name, for example.

Without getting too technical, this article aims to give a general overview of the possible actions and/or alternatives that exist to enforce intellectual property rights in the digital environment. The main assumptions we must prove are the following:

I. The conflicting domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights.

II. The owner of the conflicting domain name has no rights or legitimate interests with respect to the domain name.

III. The conflicting domain name has been registered and is being used in bad faith.

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<td>More than 10</td>
<td>To be decided in consultation with the WIPO Center</td>
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<table>
<thead>
<tr>
<th>Three panelists</th>
<th>Fee (USD)</th>
</tr>
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<tr>
<td>Number of domain names included in the complaint</td>
<td></td>
</tr>
<tr>
<td>1 to 5</td>
<td>$4,000 (Presiding Panelist: $1,600; Co-Panelist: $750; WIPO Center: $1,000)</td>
</tr>
<tr>
<td>6 to 10</td>
<td>$6,000 (Presiding Panelist: $1,750; Co-Panelist: $750; WIPO Center: $1,250)</td>
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https://www.wipo.int/amc/en/domains/fees/

It is important to note that these procedures are ultimately resolved by a panel of experts; this Panel may be composed of a single member or a group of three, which should be defined by the concerned parties in accordance with the provisions of the “Uniform Domain-Name Dispute Resolution Policy”.

Finally, it’s important to consider that if the concerned parties opt for this, it will be necessary to pay certain panelist fees as indicated in the table above.

Notice and takedown

As a result of new reforms to the Federal Copyright Law in Mexico and due to the “recent” initiation of the United States-Mexico-Canada Agreement (USMCA), we find the so-called “Notice and Takedown” procedure to be nothing more than the obligation of the Internet Provider Servicer to remove any work or content that violates Copyrights.

According to the Digital Millennium Copyright Act (DMCA), the notice and takedown process is a tool for copyright holders to get user-uploaded material that infringes their copyrights taken down off of websites and other internet sites.

Now, there are countless digital platforms and e-commerce platforms that establish their own “Trademark Protection Programs” which offer users the possibility to enforce their intellectual property rights. In general terms, this establishes the possibility of filing “complaints” or extra-judicial actions to remove content on digital platforms that violate intellectual property rights.

According to the information previously mentioned, this is one more option in our “digital” catalog of tools to enforce the rights of our clients against any possible violation of their rights in the digital environment.

Infringement claim and provisional measures

Finally, we have the traditional administrative procedure offered by different legislations in intellectual property matters. Considering particularly what is established in Mexican legislation, the holder of an intellectual property right has the right to exercise, through administrative procedures, myriad actions to combat a trademark infringement.

In this type of administrative action, we have various alternatives. Firstly, the holder of a trademark can file an infringement action requesting the competent authority either to apply provisional measures to the Internet site in question or to request the Internet provider suspend any content that violates intellectual property rights.

Even though the administrative actions mentioned above could merit a discussion several pages long, this article only intends to mention them as another alternative to defend against the abuse of a trademark or intellectual property right in the digital environment.

I would like to conclude this analysis by mentioning that if we, as specialists, felt overwhelmed by the sheer number of possible infringements through, by, or on social media networks such as Facebook, we must brace ourselves for the even more dynamic platforms that have come into existence such as TikTok. We have to think outside the box to offer viable solutions for our clients.

This issue does not end here due to the constant evolution and growth of the digital ecosystem; we will surely have to constantly evolve and create alternative mechanisms to resolve this type of controversy, a task that will not be easy for legislators or for the users of the system.

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We have to think outside the box to offer viable solutions for our clients.
Branding in cross-border trademark squatters

Alina Grechikhina and Alina Grechikhina of Goroddissky and Partners provide important tips for the protection of trademarks in Russia to fend off bad registration actions and cancellation actions.

When granted protection will enjoy protection on the whole territory of the aforementioned Eurasian states. Therefore, trademark holders have multiple options to obtain trademark protection before they enter the Russian market and it is highly advisable and vitally important to secure trademark rights through registration without delay. Sometimes trademark holders start trading activities without first obtaining proper protection of their trademarks, which may result in various undesirable outcomes. Using an unregistered designation involves risks such as filing of an identical or similar mark for registration by a third party and possible subsequent registration of such a trademark, which may end up with “infringement” of that third party’s trademark and it does not matter who was the first to enter the Russian market – the Russian law does not recognize prior use rights in respect of trademarks.

In particular, registration of the trademark in the name of the distributor without the consent of the true trademark owner may be noted. Such illegal actions of the distributor may be motivated by the need to preserve the right of a brand that is intended to be promoted on the local market in a situation where the true owner is not so active in protecting their trademark rights there.

Nevertheless, if a mark gets registered by the local distributor in its name without the true owner’s consent, the Russian trademark legislation foresees the possibility to combat such a situation. Pursuant to the Russian Civil Code a registered trademark may be invalidated in full within the whole term of validity, if its legal protection was not granted in the name of an agent or a representative of a person who is the owner of this exclusive right in one of the member states of the Paris Convention for the Protection of Industrial Property, in respect of identical or similar mark applied either under national or international trademark examination procedure for marks applied either under national or international registration.

In 2021 the Russian PTO considered invalidation action filed against trademark “TURQUA” TURQUA is a trademark of a Turkish company, Ata Silah San. A.S., which manufactures hunting weapons and is the leader on the weapons market in Turkey. Trademark TURQUA was registered in Russia for weapons of different types in the name of Rec Dış Ticaret Ltd. Şti. This company was a distributor of goods of Ata Silah San. A.S. and the latter contested registration of TURQUA claiming that it was carried out in violation of Article 6 septies of the Paris Convention. Ata Silah San. A.S. pointed out to the fact that they owned a series of trademarks with the element TURQUA in Turkey registered for nearly identical goods, the disputed trademark owner was entitled to introduce the goods of Ata Silah San. A.S. into civil circulation in Russia in accordance with the distributor agreement, however, Ata Silah San. A.S. had never granted their consent to the registration of the TURQUA mark in Russia. Rec Dış Ticaret Ltd. Şti. argued against the filed invalidation action stating, in particular, that at the time of filing the application the concluded distributor agreement had already expired and thus Rec Dış Ticaret Ltd. Şti. could not be regarded as an agent of Ata Silah San. A.S.

Upon consideration of the particulars of the case, the Russian PTO decided to invalidate the trademark in full, indicating in the decision that corresponding provisions of the law do not contain any clauses and restrictions regarding the period of time of the agency relationship and as such the argument in favor of expiration of the distributor agreement was found unpersuasive.

Another case heard by the Russian PTO in 2020 concerned trademark “TURQUA” TURQUA was registered in classes 29, 30 and 31. The invalidation action was initiated by a Croatian company Sardina d.o.o. holder of the trademark with the word elements ADRATIČ QUEEN enjoying protection in the European countries for food products in Classes 29, 30 and 31. The invalidation action was grounded on the facts that Hayat Retail Ltd. was once the distributor of goods under Class 29 of Sardina d.o.o., the Class 35 services covered by the contested mark were directly connected with promotion, sales and advertising of the goods, thus such a registration might interfere with business activities of Sardina d.o.o. on the Russian market. Additionally, Sardina d.o.o. filed an observation letter the so-called “informal opposition” against trademark in the stage of examination stage of trademark examination requesting to refuse the application while the mark remained pending.

Having in view the norms of consideration of the invalidation action the trademark registration was kept in force. The Russian PTO pointed out the fact that Article 6 septies could not be applied in the subject case as the true trademark holder allegedly granted its irrevocable consent to the registration of the disputed mark in the name of the applicant. The letter of consent contained in the application materials was allegedly executed by Sardina d.o.o. on a later date than the filed observation letter. Nonetheless, the genuine owner insisted that no consent letter was ever granted to registration of the contested mark. Despite this claim the Russian PTO had no other option except to accept the consent as it was beyond its competence to check authenticity of the document. In view of the foregoing, it should be noted that it is in the best interests of the genuine right holder to have the trademark timely registered in Russia in its name in order to avoid costly and time-consuming legal procedure for trademark invalidation.

Moreover, having registered trademark rights may give additional advantages in fighting against trademark squatters. Trying to catch the spirit of the shaky times, when foreign companies re-consider their business patterns in Russia resulting in termination or suspension of their commercial activities, some parties are attempting to get the famous brands or their imitations registered in their names. The number of such troublesome filings may potentially increase in the near future and it is necessary to pay attention to the Russian trademark legislation. Currently, a legal entity or an individual entrepreneur is entitled to file a trademark application. However, once
and widely used their trademark on the territory of a famous brand in relevant classes. However, and services even in the absence of registration designations in relation to a vast list of goods available, to bar registration of identical designations for renowned brands, which are widely known misleading grounds. This option may work best the observation letter.

In the first instance, the observation letter may draw the examiner’s attention to prior trademark rights registered in Russia for similar goods or services. Above all, the observation letter vests the brand owners with possibilities to point out other grounds for refusing registration of a designation, apart from existing prior trademark rights, including those that are not verified in the course of examination. Arguments in favor of non-compliance of the applied designation with the requirements of the law that are not checked at the time of examination may include reasoning on similarity of the applied designation to a company name or identity or similarity of the applied designation to the name of a person known in Russia on the filing date of the application the latter ground may be used by the fashion industry enterprises as many famous brands are named after the designers), similarity to the third party’s copyrighted objects etc. The documentary evidence on the duration and intensity of use of the company name in relation to certain goods and services, on protected intellectual property, the history of the brand, the length of use of the mark on the market, and the acquired reputation of the brand, etc. should support the arguments set forth in the observation letter.

The observation letter may also be based on misleading grounds. This option may work best for renowned brands, which are widely known with information about which being globally available, to bar registration of identical designations in relation to a vast list of goods and services even in the absence of registration of a famous brand in relevant classes. However, holders of non-global brands who have intensively and widely used their trademark on the territory of Russia may also successfully use the misleading ground, provided such use resulted in the conflicting mark becoming renowned in the eyes of Russian consumers as the brand of a particular owner and assuming the respective arguments can be supported by documentary evidence.

To sum up, Russian legislation provides various tools for defending both registered and unregistered trademark rights from trademark squatters. These instruments may be used at different stages either to prevent registration of bad faith filing or to invalidate the registered trademark. It should be noted though, that there is an important point for genuine trademark holders to remember when protecting their registered trademark rights. This point relates to use requirements adopted in Russia. It is the trademark holder’s right and obligation to use the mark. The failure to use the trademark within three consecutive years from the date of its registration may result in its early termination based on the decision of the IP court upon request of an interested third party. The risk of cancelation of the trademark due to its non-use increases significantly for those brand owners who decided to leave the Russian market. Thus, use requirements should be kept in mind by a trademark owner when filing an observation letter based on prior trademark rights, for example, because the applicant may attempt to overcome the bar to registration of its mark by way of cancelling the conflicted cited brand if it is already potentially vulnerable to cancelation for non-use.

All in all, the best way to secure a trademark from trademark squatters seems to be to obtain trademark registration in a timely manner, to use the registered mark in relation to goods and services for which protection was granted, and to keep an eye on new filings to reveal identical or confusingly similar designations by third parties and to take appropriate actions against their registration.
It’s time to register for the ECTA 41st Annual Conference: Explore the Magic of IP in Prague!

Another extraordinary ECTA Conference is coming up on 28 June-1 July 2023 in Prague, the City of Magic. You will have the opportunity to network with hundreds of IP colleagues worldwide, meet remarkable speakers, and catch up with ECTA friends. The programme includes instructive sessions on the latest case law and IP trends, tailored workshops for young practitioners, exciting gatherings in the hottest spots, and Saturday excursions as the cherry on top. Are you new to the ECTA Conference? Long-standing members will welcome you at the first-time attendee reception ‘ECTA at a Glance’.

Résumé
Carina Gommers, ECTA First Vice-President, ECTA Programme Committee Chair, BE
Carina Gommers is ECTA First Vice-President and partner at Wiggin LLP’s Brussels office. Her practice covers trademark portfolio management and litigation regarding intellectual property rights, including trademarks and designs. Carina has extensive experience regarding customs counterfeit seizures and also regularly advises on matters of advertising and unfair market practices. Since qualifying, she has worked on a number of high-profile cases, representing clients including Solvay, Philips, Supergroup, Pfizer, Procter & Gamble and Wolters Kluwer.

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On Wednesday, 28 June we kickstart with Committee meetings (for Committee members only), where impactful IP projects are worked on, updates on the latest case law are provided, and legislative and policy developments are discussed. ECTA Committees are the backbone of our Association and an invaluable opportunity to cooperate with numerous professionals and stay updated in your IP area of interest. If you wish to become more active in the ECTA Community, don’t miss out and meet Committee Leaders at the Committee Booth during the Conference!

On the same day, after the ECTA Supervisory Board’s exchange on more strategic aspects of our Association, you are all invited to attend the workshop on domain name and trademark abuse and enjoy the welcome reception at Palace Zofin on the scenic Sloyanisky (Slavíč) Island.

Thursday, 29 June, will be the first of two immersive educational and networking days on the most relevant topics on the European IP agenda. We will look closely at the latest IP news and trends and what are the current forces driving the world of IP. We will take a magic carpet ride through the online world, will be enlightened on what is contained in the long-awaited EU design reform package and will be given tricks and spells to tackle counterfeiting.

After heated discussions, newcomers are invited to raise a glass at ‘ECTA at a Glance’, a dedicated reception where long-standing members will bring them up to speed with ECTA activities and share their experience on how to get the most out of the Conference. The day will conclude with a gourmet taste of Czech cuisine and beers at Red Stag, located downtown Prague.

On Friday, 30 June, with parallel sessions we will double the morning’s educational offer and young practitioners are particularly invited to attend the session about the superpower of brands in sports. Experts will also take us through the alchemy of non-agri GIs, the works of applied arts, and geographical names as trademarks in light of the recent Iceland and Andorra cases. We will then cross the lines into dark magic in a comparative session with the US on trademark applications made in bad faith and trademarks contrary to public policy or to accepted principles of morality. To wrap up, the announcement by ECTA President of the ECTA Award 2022 winners, and an overview of the most influential EU cases.

The Conference will close with the much-awaited ECTA Gala Dinner, this time at the Trade Fair Palace, a gem of Czech Functionalist architecture praised by Le Corbusier.

Last but not least, ECTA friends can sign up for one of the typical ECTA Saturday excursions. This time you will have the chance to discover Prague Castle, UNESCO World Heritage site, or alternatively participate in a day trip outside of the city to the Gothic Castle of Karlštejn. Get ready for another extraordinary ECTA Conference! We look forward to seeing you all in Prague!

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