

The Trademark

Issue 2 2023

GLOBAL REACH, LOCAL KNOWLEDGE

www.trademarklawyermagazine.com

Lawyer

Welcome to Singapore!



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

**Jack Daniel's Props.
v. VIP Prods.**

Page 8



**An interview
with ÖURA**

Page 13



**A comparative
view: shape
and design**

Page 47





SANYOU IP GROUP

ESTABLISHED IN 1986

WWW.SANYOUIP.COM

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.

Professional Staff Structure

More than
400
employees

Over
300
professionals

Over
180
patent attorneys
and lawyers

A trademark
team of
30
members

OUR HEADQUARTER

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



THE TRADEMARK LAWYER

Issue 2 2023

Editor

Faye Waterford
faye@ctclegalmedia.com

Publishing Director

Chris Dooley
chris@ctclegalmedia.com

Advertising Enquiries

Katie Kerr (Publishing Executive)
katie@ctclegalmedia.com

Ranjana Suresh (Publishing Executive)
ranjana@ctclegalmedia.com

Editorial Assistant

Ellen Peet
ellen@ctclegalmedia.com

Subscription Enquiries

subscriptions@ctclegalmedia.com

Accounts Enquiries

accounts@ctclegalmedia.com

Published by:

CTC Legal Media Ltd,
23 Hedgers Way, Kingsnorth,
Ashford, Kent TN23 3GN
Tel: +44 (0)20 7112 8862
Fax: +44 (0)20 7084 0365

Design and Repro by:

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

Printed by:

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

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

ISSN 2053-3829

CTC Legal Media

Editor's welcome



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 ÖURA – an innovative

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

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!

Faye Waterford
Faye Waterford, Editor

Mission statement

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

Sustainability pledge

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



Contents

- 6 Meet the Editorial Board**
Meet our Editorial Board members who help determine the direction of this magazine.
- 8 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*.
- 13 An interview with Kristin Lamb, Associate General Counsel, VP of IP and Regulatory Compliance at OURA**
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 OURA's innovations.
- 19 Avoiding fraud attacks on US trademarks**
Britt Anderson, Partner at Perkins Coie, details strategies against fraud claims to US trademarks in defense and enforcement.
- 24 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.
- 29 German Federal Court of Justice on third-party information from Google**
Detlef von Ahsen, Partner at KUHNNEN & WACKER, discusses claims concerning the provision of information against infringers of property rights and platform operators.
- 32 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.
- 36 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.
- 41 Sponsored links: the Brazilian Courts as proficient venues under the perspective of trademark infringement**
Thiago Lombardi Campos da Costa of VAZ E DIAS ADVOGADOS & ASSOCIADO details the two cases that changed the approach to infringement through keywords in sponsored links.
- 47 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.
- 52 The Initiative of the CNIPA to regulate bad faith filings showing from the Draft Amendment to the PRC Trademark Law**
Li Xiaohong and Han Yajie of ZY Partners detail the proposals for the emphasize use requirement, the "Preclusion of Repeated Registration", and penalties for malicious trademark squatting, among others, that, if implemented, could combat bad faith filings.
- 56 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.
- 62 Hungarian IP enforcement proceedings are getting faster... but who is missing out?**
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.
- 67 Women in IP Leadership:**
An interview: inspirations, experiences, and ideas for equality.
Featuring: Simona Lavagnini, Founding Partner of LGV Avvocati, and Olga Plyasunova, Head of the Trademark Department at Zuykov and partners.
- 74 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.
- 76 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.
- 78 High threshold for evidence 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.
- 82 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.
- 87 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.
- 91 Registration issues of trademarks incorporating official symbols**
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.
- 94 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.
- 97 The future of IP management may be closer than you think**
Sam Thorley, Head of Platform for Equinox, explores the future of IP management technology, highlighting benefits that IP attorneys can expect in the near future.
- 100 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.
- 104 Brands in crosshairs of trademark squatters**
Alexey Kratiuk and Alina Grechikhina of Gorodissky and Partners provide important tips for the protection of trademarks in Russia to fend off bad faith registrations and cancellation actions.
- 108 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'.
- 111 Directory of services**
An A to Z list of the international law firms who provide IP related services.

Francesco Bonini - Studio Bonini. Italy

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



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

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



Catherine Hillaert-Prevost - Intellectual Property Advisor. Switzerland

With 35+ years' experience leading multinational companies' IP strategies in 160+ jurisdictions, Catherine has worked in private practice, In-House, and as Global Head of IP & Anticounterfeiting at STOLI Group.



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

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



Gang HU - General Director of Litigation Division, CCPIT Patent & Trademark Office. China

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



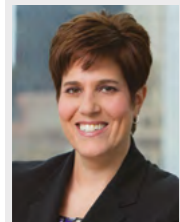
Shelley Jones - Lawyer and Registered Trademark Agent. Canada

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



Stacey C. Kalamaras - 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 150+ 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.



Barbara Leitao-Johnson - Brand Protection Manager, Corsearch. Latin America

Barbara is a US based Brazilian Trademark Lawyer, having worked in several large Brazilian IP offices. With an LL.M. from George Washington University, DC, and after working at AIPLA and Facebook Reality Labs, she is currently helping to coordinate the Latin American expansion at Corsearch. Her focus: Brand Protection Enforcement.



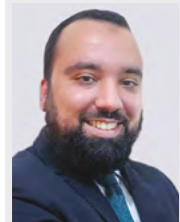
Rachael Lodge Corrie - Partner, FOGA DALEY. Jamaica

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



Yasir Masood - Trademark Lawyer, Dennemeyer & Associates. Dubai

After completing his law studies in Germany in 2013 and gaining initial experience in law firms in Germany and England, Yasir joined Dennemeyer & Associates' Dubai office in 2016. His areas of expertise are trademarks, copyrights, prosecution and enforcement, and IP portfolio management. He is a member of INTA's Middle East Global Advisory Council and a frequent speaker and author on IP.



Chris Mitchell - Member, Dickinson Wright. US

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



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

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



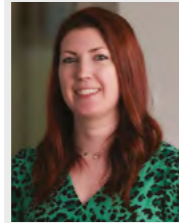
Peter Sloane - Partner & Co-Chair of the Trademark and Copyright Practice, Leason Ellis LLP. US

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



Charlotte Wilding - Partner, Wedlake Bell LLP. UK

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



Beata Wojtkowska - Partner, Kulikowska & Kulikowski. Poland

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



**GOODRICH
RIQUELME
ASOCIADOS**

MEXICO

- Industrial and Intellectual Property
- Litigation
- Licensing Enforcement
- Entertainment and Sport Law
- Copyrights

Enrique A. Diaz	ediaz@goodrichriquelme.com	(5255) 5525 1422
Jaime Delgado	jdeldgado@goodrichriquelme.com	(5255) 5207 5324
Juan Carlos Suarez	jcsuarez@goodrichriquelme.com	(5255) 5207 9261
Guillermo Sosa	gsosa@goodrichriquelme.com	(5255) 5207 7561

e-mail: mailcentral@goodrichriquelme.com
website: www.goodrichriquelme.com

Paseo de la Reforma 265, M2
Col. y Del. Cuauhtemoc, 06500 Mexico, D.F.
Tel. (5255) 5533 0040, Fax. (5255) 5207 3150



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 Props. 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 to balance First Amendment concerns and trademark law for expressive works.

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.



Max Vern



David P. Goldberg

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 it was about her or that she sponsored, endorsed, or was otherwise involved in the film. The Second Circuit supported 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 *Matal v. Tam*, 137 S. Ct. 1744 (US 2017) and *Iancu v. Brunetti*, 139 S. Ct. 2294 (US 2019), finding

the laws forbidding registration of trademarks 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



Figure 1. JACK DANIEL'S whiskey bottle



Figure 2. BAD SPANIELS dog toy

“ 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. ”

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 dilutory 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



Figure 3. Reverse side of BAD SPANIELS hang tag





Rogers v. Grimaldi. In particular, the Ninth Circuit found that the product, though not the Mona Lisa, was humorous and conveyed an irreverent 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.

On remand, the District Court granted VIP's Motion for Summary Judgment that Jack Daniel's would not be able to satisfy either prong of the *Rogers v. Grimaldi* test, which stipulates that a "trademark owner does not have an actionable Lanham Act claim unless the use of the trademark is 'either (1) not artistically relevant to the underlying work or (2) explicitly misleads consumers as to the source or content of the work.'" Accordingly, the District Court found that the BAD SPANIELS toy was entitled to First Amendment protection and not infringing. This Decision was affirmed *per curiam* by the Ninth Circuit.

Jack Daniels appealed to the US Supreme Court, which accepted certiorari on 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 heightened First Amendment protection from trademark-infringement claims?
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 matter of law a claim of dilution by tarnishment under the Trademark Dilution Revision Act?

On the surface of the matter, Jack Daniel's infringement and dilution claims appear to overreach. After all, there are significant differences between the real JACK DANIEL'S and pretend BAD SPANIELS trademarks and trade dress, the goods on which the real and pretend marks are used, the channels of trade in which they are sold, and so on. On the other hand, that does not mean that the potential problems in the Ninth Circuit's reasoning that a dog toy is an expressive work that Jack Daniel's raises lack merit.



“
The Ninth Circuit reversed the lower court's ruling on dilution and remanded the case for further proceedings on infringement.
 ”

Courts acknowledge the need to be especially careful when balancing artistic expression against trademark rights, which is why the *Rogers v. Grimaldi* test was developed by the Second Circuit and was widely adopted by other Circuit Courts in the 30 years since then. When such cases involve expressive works like books, movies, songs, and plays, the application of the test is largely uncontested. It is also fair to say that there are some non-expressive commercial products, like insecticide, where the application of the test may not be appropriate. That said, many other products, like t-shirts, fall somewhere in between.

There are a number of similar cases impatiently waiting in line for resolution, from the USPTO Trademark Trial and Appeal Board oppositions to District and Circuit Courts litigations. These include, for example, the much-touted 'MetaBirkins Lawsuit' by Hermès against the self-proclaimed artist Sonny Estival, a.k.a. Mason Rothschild. The latter is behind the transmutation of the famed Birkin Bags into non-fungible tokens (NFTs). This February, a jury in the Southern District of New York found that the MetaBirkins NFTs infringe the rights of Hermès in its iconic Birkin Bags and that the First Amendment protection would not extend to commercial use by Rothschild (whom Hermès labelled a "digital speculator"). This may well distinguish the case from *Rogers v. Grimaldi* rationale. Rothschild appears to have ignored the jury verdict and continued promoting the offending MetaBirkins, while he is preparing an appeal of the jury verdict, which will go to the Second Circuit, undoubtedly in the hope that the same forum that created the *Rogers v. Grimaldi* test would apply it favorably in his case as well.

Another recent example involves an opposition by Activision Publishing, Inc., a video game publisher and owner of CALL OF DUTY (the best-selling first-person shooter game series and most successful video game franchise created in the US), to the registration of the mark THE CALL OF BOOTY by Ass'd, LLC for beer, spirits and wine, as well as entertainment services in the nature of organizing social entertainment events, Renaissance fair events and social club services (obviously not an artistic venue, but a for-profit 'joint').

Against this background, where should humorous dog toys fall?

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" message conveyed by "juxtaposing the irreverent representation of the trademark with the idealized image created by the mark's owner." *L.L. Bean, Inc.*, 811 F.2d at 34 (affording First Amendment protection to a message "that business and product images need not always be taken too seriously"). Unlike the book in *Dr. Seuss Enterprises, L.P. v. Penguin Books USA, Inc.*, 109 F.3d 1394 (9th Cir. 1997)¹, which made "no effort to create a transformative work with 'new expression, meaning, or message,'" Bad Spaniels comments humorously on precisely those elements that Jack Daniel's seeks to enforce here. The fact that VIP chose to convey this humorous message through a dog toy is irrelevant.

In its brief, Jack Daniel's argues not only that this analysis is inadequate, but also that "*Rogers*' two-prong test does not align with the [Lanham] Act's likelihood-of-confusion standard," the "First Amendment concerns that animated *Rogers* are misplaced," and "*Rogers* creates, rather than avoids, constitutional issues." Allowing the Ninth Circuit's analysis to stand, Jack Daniel's argues, will allow the exception to swallow the rule. In other words, applying the *Rogers v. Grimaldi* test indiscriminately and letting profiteers hide under the 'artists' umbrella could undermine the principles of trademark law and lead to distortions in the marketplace, making it a very cold place for trademark owners.

Although Jack Daniel's fears are histrionic and its attempts to overturn *Rogers v. Grimaldi* (which is a helpful test when properly applied to expressive goods) misplaced, it does indeed seem that the Ninth Circuit's analysis here is anemic. Humor alone should not be sufficient to preclude a trademark owner's Lanham Act infringement claim since many trademarks convey messages while also functioning as source indicators, and some of those messages are humorous. When something other than a clearly expressive work like a book or a song is at stake, a detailed assessment of both a trademark owner's evidence of likelihood of confusion and an alleged infringer's evidence of a meritorious First Amendment defense are called for.

In cases like this, where parody is an issue, one would hope to find a fuller analysis by a court of factors such as whether there is a likelihood of confusion between the real and parodic marks, how clear it is that the parody

was not authorized by the trademark owner, whether the trademark owner sells competing products, whether parody is common in the relevant industry, why and how the parody targets the mark, survey 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.

In short, rather than abandoning the *Rogers v. Grimaldi* test altogether, as Jack Daniel's urges, a better outcome could be for the US Supreme Court to vacate and remand the Ninth Circuit decision with instructions to conduct a more comprehensive analysis of both Jack Daniel's trademark infringement claims and VIP's First Amendment defenses. If the Court delineates clear and contextually appropriate factors to be considered in determining whether possibly infringing goods should be subject to the *Rogers v. Grimaldi* test, so much the better.

Oral hearings were held on March 22, 2023, and despite the humorous nature of the case and the way it is being portrayed in social media, the Justices, although clearly not short on a sense of humor, are taking the legal questions that this case poses very seriously.

The Supreme Court's decision is expected by June 2023.

¹ <https://plus.lexis.com/document/midlinetitle/?pdmfid=1530671&clid=4a70d6b8-1aa5-46b0-9799-3b697c163ac8&docfullpath=%2Fshared%2Fdocument%2Fcas%2Furn%3Acontentitem%3A5YJH-D631-F8Dg-M106-00000-00&componentid=6393&prid=cbe0a17f-f9d5-477a-8fed-691a1c58915e&ecomp=ny79&earg=sr13>

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

Contact
Amster, Rothstein & Ebenstein LLP
 405 Lexington Avenue
 New York, NY 10174 US
Tel: +1 212 336 8000
Max Vern, Esq.: mvern@arelaw.com
David P. Goldberg, Esq.:
dgoldberg@arelaw.com
www.arelaw.com



Enforcing and defending patents, trademarks, copyrights, and other intellectual property in litigation and negotiations

Obtaining patents and registering trademarks and copyrights in the United States and around the world

Providing patentability, infringement and/or enforceability opinions and right-to-use analyses; and

Advising on transfers, licensees securitization and other transactions involving IP assets

Since 1953 and counting...
at the forefront of IP
in the City That Never Sleeps



An interview with Kristin Lamb, Associate General Counsel, VP of IP and Regulatory Compliance at ÒURA

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 ÒURA'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,



Kristin Lamb

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 ÒURA. 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 ÒURA, 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 ÒURA 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 ÒURA.

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 ÖURA and the technology that it offers?

ÖURA 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.

ÖURA'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. ÖURA has also partnered with several research institutions to further understand the relationship between sleep and health.

ÖURA has received several awards and accolades for its technology, including being named one of Time Magazine's Best Inventions

“ There is so much innovation happening among the different technical teams at ÖURA, and it is important to me that my team proactively identifies, harvests, and protects it. ”

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 ÖURA innovative in comparison to other health-tracking technologies available on the market?

Focus on Sleep: ÖURA 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. ÖURA'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 finger 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: ÖURA'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 and more regular 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 for the user.

Scientific research partnerships: ÖURA 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 ÖURA, and it is important to me that my team proactively identifies, harvests, and protects it. Rather than waiting for inventors to submit invention disclosures (though 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. We then 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 ÖURA 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. ”

unique opportunity for blue-sky inventing, without being confined by current commercial plans or resources, and often lead to very rich patentable ideas.

Last fall we hosted our first 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 cross-functional collaboration.

We are uniquely positioned at ÖURA, 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 ÖURA. 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 ÖURA encountered any difficulties while building its patent portfolio?

Our initial struggle was in identifying the innovation that was already happening at ÖURA. 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 that we could identify for them what might be protectable, and then personally shuttle those ideas through the invention disclosure submission, application drafting, and filing process. This helped to remove the barriers to participation in the patent process for the inventors, who are already working full schedules and might have previously viewed inventing as an "extra."

Under what circumstances do you use outside counsel at ÖURA?

Because my IP team at ÖURA 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



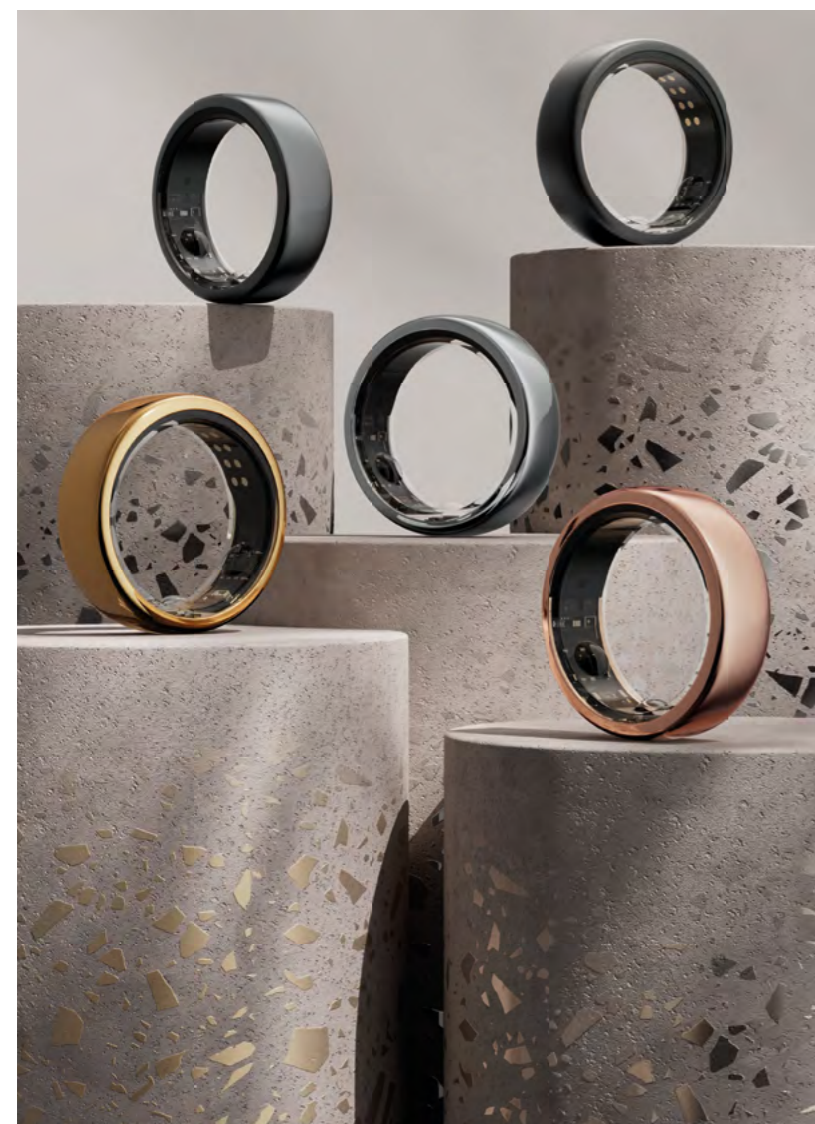
all aspects of copyright and trademark protection and enforcement.

What qualities are important to you when working with outside counsel?

Because my team is so small internally, I view my outside IP counsel teams as extensions of my own team. I give them broad visibility into my goals and strategies so that they can help me to carry them out, and I rely on them to have a strong understanding of those goals and strategies so that they can tailor their assistance accordingly. So this quality of working as a team and providing proactive support is very important to me.

I also highly value responsiveness and good communication. Sometimes I feel a bit like an air traffic controller at ÖURA, constantly responding to questions and issues, and coordinating help amongst various departments. So having teams of outside counsel who are responsive is critical in keeping all of my "planes" in the air, and being responsive internally to the different teams' needs.

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 ÖURA 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, ÖURA is at the forefront of smart ring innovation. And even more broadly, wearables have typically addressed activity monitoring with generic feedback, whereas ÖURA 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 ÖURA will be in five years' time?

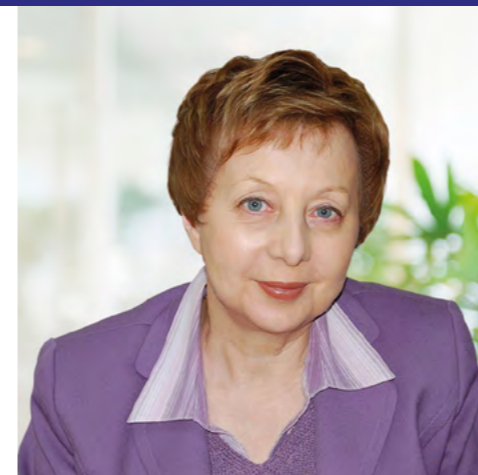
Our form factor and focus on accuracy allow us to gather continuous temperature trend, heart rate, and movement data, which together serve as the basis of innumerable health insights. We have only just started to scratch the surface of what can be tracked, measured, and translated into actionable insights based on these three data sets. While we focus primarily on sleep and activity now, I am excited to see all of the ways in which ÖURA 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 ÖURA will be a primary contributor to that shift.

VAKHNINA & Partners, Russia

Patents
Utility models
Designs
Trademarks



ip@vakhnina.ru
www.vakhnina.com
+7-495-231-4840



Dr. Tatiana Vakhnina

Founder, Doctor of Law, Honorary advocate of the Russian Federation.

Russian Patent and Trademark Attorney, Eurasian Patent Attorney

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



Dr. Alexey Vakhnin

M.D. PhD (Medicine, Biochemistry).

Russian Patent and Trademark Attorney, Eurasian Patent Attorney

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



Dr. Elena Utkina

PhD in Chemistry.

Russian Patent Attorney, Eurasian Patent Attorney

Specializes in Chemistry, Biochemistry, Pharmacology, Pharmaceuticals.

VAKHNINA & Partners

Eurasian and Russian Patent and Trademark Attorneys

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

Contact in Russia:
ip@vakhnina.ru

Contact in Armenia:
office@vakhnina.am



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

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

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

WWW.CARIBBEANTRADEMARKS.COM

TELEPHONE:
USA 1(561) 833-9000

FACSIMILE:
USA 1(561) 833-9990

EMAIL:
IP@caribbeantrademarks.com

ADDRESS:
2855 PGA Boulevard
Palm Beach Gardens, Florida 33410



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 1241. In *Bose*, the declarant in a post-registration affidavit falsely stated that



Britt Anderson

“ A successful fraud claim may result in cancellation of a registration critical to a subsequent infringement claim. ”

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. *Id.*

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.

Author email: BAnderson@perkinscoie.com



for counterfeiting violations does not apply unless there is a registered trademark covering the goods, 15 U.S.C. § 1117(b). In defense against certain trademark dilution claims, ownership of a valid registration is a complete bar to claims, 15 U.S.C. § 1125(c)(6).

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 from registration, unlike a cancellation claim for likelihood of confusion, causing raising questions and threatening rights many years after registrations have been secured.

Fraud claimants can cast a broad net

Despite the indispensable element of intent to deceive the USPTO, a wide variety of fraud evidence may be considered to show deceptive purpose – 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

“**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.**”

statements have been made.

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*, 155 F. Supp. 3d 585, 593 (2015).

The effects of a successful fraud claim may extend beyond the goods or services where a false statement has been made. TTAB cases hold that even if fraud is shown only as to one item in a long list of items within a class of goods, the remedy will be to hold the application or registration void as to the entire class. See, e.g., *Meckatzer Löwenbräu Benedikt Weib KG v. White Gold, LLC*, 95 USPQ2d 1185 (TTAB 2010) (motion to dismiss denied where fraud claim sufficiently pleaded). This remedy raises the stakes in fraud litigation, making an entire registration vulnerable if an applicant knew, or circumstantial evidence shows, that it could not truthfully state that it was using the mark with one portion of its trademark description at the time of the affidavit.

Litigants can also raise fraud claims based on other statements and information in U.S. trademark applications besides knowing lack of evidence of use. For example, in *Fuji Medical*

“**In defense against certain trademark dilution claims, ownership of a valid registration is a complete bar to claims.**”

Instruments Mfg. Co., Ltd. v. American Crocodile International Group, Inc., 2021 USPQ2d 831 (TTAB 2021), the TTAB canceled an incontestable registration because the registrant intended to deceive the USPTO when, as a distributor, it applied for the mark without authorization from the manufacturer and submitted a specimen that falsely represented that the distributor was the manufacturer of the relevant goods.

Chutter could broaden the bases for fraud claims

At issue for the Federal Circuit in *Chutter* is whether "reckless disregard" can amount to intent to deceive the USPTO. In *Chutter*, the operator of a small chain of restaurants in Atlanta called Dantanna's is seeking to overturn a TTAB ruling that canceled its trademark registration covering the restaurant's name. The cancellation for fraud against Dantanna's registration was brought by a restaurant called Dan Tana's in Los Angeles and based upon the signature in 2010 of a former lawyer for the trademark owner on a "declaration of continued use and incontestability," submitted to the USPTO, which asserted that "there is no proceeding involving said rights pending and not disposed of either in the [USPTO] or in a court and not finally disposed of." At the time of

HSM IP
Worldwide Services
Caribbean Specialists

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

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

Huw St. J. Moses, OBE
Managing Partner
+1 345 815 7400
hmoses@hsmoffice.com

68 Fort Street, George Town
PO Box 31726, KY1-1207
Grand Cayman, Cayman Islands
hsmoffice.com | info@hsmoffice.com

The **Patent Lawyer** Newsletter

GLOBAL REACH, LOCAL KNOWLEDGE
www.patentlawyormagazine.com

STAY UP TO DATE WITH THE LATEST IP NEWS

SIGN-UP TO OUR NEWSLETTER

the signature in 2010 by the attorney, Dantanna's right to use the name was the subject of litigation brought by the Los Angeles-based Dan Tana's. Dantanna's attorney would later testify he did not review the declaration closely enough to know that he was making a false statement. In the ensuing years, both Dantanna's and the attorney signing the declaration received notice of the mistake in the declaration but did not correct it. The TTAB concluded intent to deceive the USPTO had been shown because the attorney paid no attention to the document he was signing under oath and failed to take action to remedy the error once it was brought to his attention. *Chutter* thus represents an example of a fraud claim based upon false statements made to the USPTO long ago.

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 are in the best possible position to defend fraud claims, trademark owners should

“ It is imperative for trademark owners to take affirmative steps to minimize risk of fraud claims. ”

- (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.

Contact

Perkins Coie
 3150 Porter Drive Palo Alto, California
 94304-1212
 Tel: +1.650.838.4300
 www.perkinscoie.com

VELLANI & VELLANI
 Amalgamated with Amhurst Brown



PAKISTAN'S LEADING IP LAW FIRM

Vellani & Vellani is a premier full-service law practice established in 1937, with a particular focus on Intellectual Property. Our lawyers have a deep understanding of the issues faced by clients, and the expertise to provide advice that is practical, comprehensive, timely and helps meet the clients' aspirations.

Our Practice Areas

- Patents & Designs
- Trademarks
- Copyrights
- Licensing & Franchising

Oil & Gas | Anti-Trust | Real Estate | Environment
 Dispute Resolution | Banking & Project Finance
 Technology, Media & Telecommunications
 Not For Profit | Corporate & Commercial
 Mergers & Acquisitions, Restructuring

WWW.VELLANI.COM

khi@vellani.com +92 (21) 3580 1000
 isl@vellani.com +92 (51) 2855 890

KARACHI | ISLAMABAD

Twenty-two consecutive years as the number 1 in Peru



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

The Managing Intellectual Property magazine, the Latin Lawyer law directory, the Legal 500 law directory, 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.



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



The Canadian trademark ecosystem: what to consider for 2023

Micheline Dessureault, Caroline Guy and Simone Ndiaye of Therrien Couture Joli-Cœur 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 needed to know.¹ 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 2021 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 in jeopardy.

The French-speaking population is primarily found in the Province of Quebec. For the majority of people living in Quebec, day-to-day life is essentially lived in French. New-Brunswick and Ontario have over 75% of the remaining French-speaking Canadian population, and smaller populations reside in the remaining provinces and territories.

Without entering into a political debate, from the perspectives of marketing and cultural sensitivity, it is essential to acknowledge English-French bilingualism issues in Canada.

In addition to federal legislation, the government of Quebec has also adopted new legislation aimed at safeguarding French language and culture. To help people better understand the context, in North America, Quebec francophones are essentially surrounded by hundreds of



Micheline Dessureault



Caroline Guy



Simone Ndiaye

millions of English-speakers, which many fear will lead to the steady decline of the language and culture in a matter of a few decades, should measures not be implemented.

The situation is therefore quite different from the situation in Europe, for example, where different cultures and languages have been living next to one another for centuries, with nobody thinking that the Italian, Spanish or German cultures and languages are at risk of 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 visible from 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 upcoming regulations will contain more specific guidelines. Both the International Trademark Association (INTA) and the Intellectual Property Institute of Canada ("IPIIC") have been meeting with Quebec authorities to try to ensure that 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 ("CIPO")

CIPO still has a huge backlog of trademark applications awaiting examination. If the application was filed without using CIPO'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.

CIPO's preapproved list of goods and services is not exhaustive, although CIPO 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 CIPO will issue a

“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.”

Résumés

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

Caroline Guy is a Canadian attorney and a trademark agent at Therrien Couture Joli-Cœur 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 expungement proceedings. She is a member of the Intellectual Property Institute of Canada (IPIIC), and of the International Trademark Association (INTA), where she currently sits on the Harmonization of Trademark Law and Practice committee.
Email: caroline.guy@groupepetcj.ca

Simone Ndiaye is a Trademark Agent at Therrien Couture Joli-Cœur LLP, with over 15 years of experience. She graduated from France and immigrated to Canada in 2006. She has a DESS degree in Engineering and Valorization of Intangible Heritage of Companies (University of Marne-La-Vallée, France), a Master's degree in Documentation and Information Sciences (University of Paris X Nanterre, France) and a postgraduate Microprogram in Fundamentals of Technology Transfer (University of Sherbrooke, Canada). She is currently pursuing an MBA in Business management at the University of Sherbrooke, Canada. She is a member of INTA and the Intellectual Property Institute of Canada (IPIIC), which has spotlighted⁵ her during the 2022 Black history month as a BIPOC leader within the IP profession.
Email: simone.ndiaye@groupepetcj.ca



practice notice and if delays will be effectively reduced.

CIPO recently released its 2022-2028 Business Strategy Plan, in which one of the main priorities is to optimize turnaround time, which will be welcomed by trademark owners and the trademark industry. Hopefully, processing time will be reduced to regain competitiveness compared to other trademark offices around the world.

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 substantively 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.²

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."³

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.

¹ <https://edition.pagesuite-professional.co.uk/html5/reader/production/default.aspx?pubname=&edid=834362b7-b1e5-4ec1-97a6-c8f12f983c13&pnum=21>

² Extract of: "What we heard" report on the Canadian Intellectual Property Office fee adjustment consultations – August 2022 - <https://ised-isde.canada.ca/site/canadian-intellectual-property-office/en/publications/what-we-heard-report-canadian-intellectual-property-office-fee-adjustment-consultations>

³ Extract of: "What we heard" report on the Canadian Intellectual Property Office fee adjustment consultations – August 2022 - <https://ised-isde.canada.ca/site/canadian-intellectual-property-office/en/publications/what-we-heard-report-canadian-intellectual-property-office-fee-adjustment-consultations>

⁴ Source: *Milano Pizza Ltd v 6034799 Canada Inc.*, 2022 FC 425 - <https://decisions.fct-cf.gc.ca/fc-cf/decisions/en/item/521238/index.do>

“**CIPO has proposed increasing its fees by 25% in an effort to catch up with the near 30% increase in inflation since 2004.**”

Contact

Therrien Couture Joli-Cœur LLP
Montreal (Quebec) Canada
Tel: +1-514--871-2880
www.groupepcj.ca

A friendly approach to navigating the Canadian trademark and IP environment

Lawyers • Notaries • Trademark Agents

groupepcj.ca
tm-intl@groupepcj.ca

TCJ¹ Therrien
Couture
Jolicœur





German Federal Court of Justice on third-party information from Google

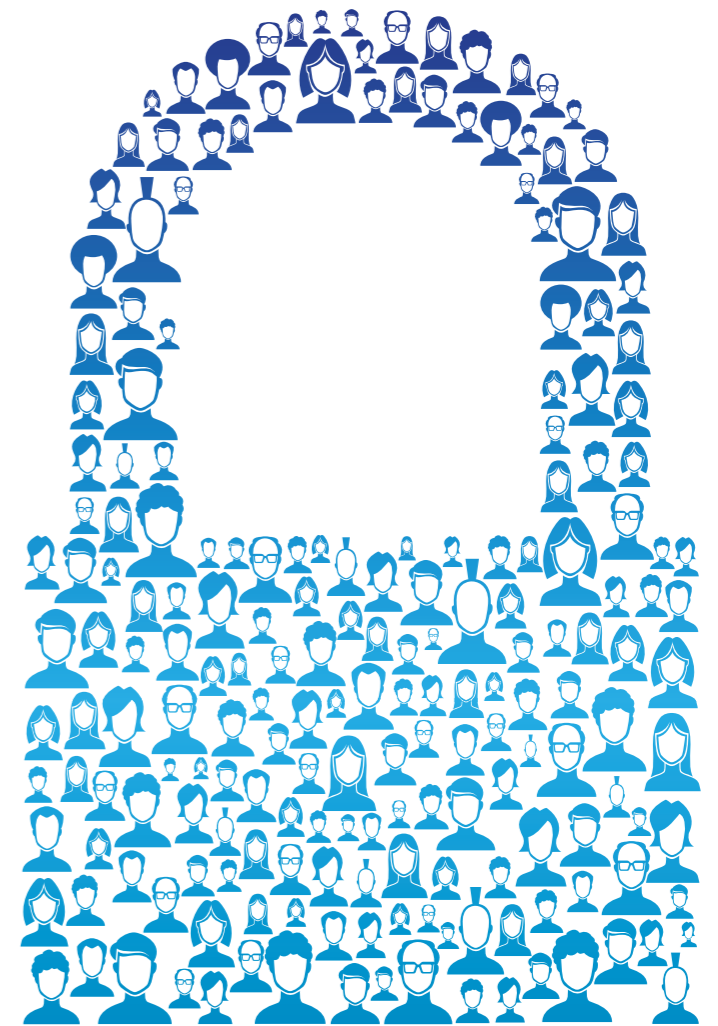
Detlef von Ahsen, Partner at KUHNER & WACKER, discusses claims concerning the provision of information against infringers of property rights and platform operators.

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



SUCCESS THROUGH DILIGENCE AND PRECISION!

K&W assists you in all matters of intellectual property, from applying for a patent for your invention to registering your trade mark. This is because our highly-specialized team of patent attorneys, attorneys at law, patent engineers and qualified staff profits from our more than 45 years of experience in the field of intellectual property and always hits the mark.



KUHNER & WACKER
Intellectual Property Law Firm PartG mbB

FREISING · MUNICH

Prinz-Ludwig-Straße 40A
85354 Freising / Germany
www.kuhnen-wacker.com
info@kuhnen-wacker.com

SEE YOU AT
INTA-Annual Meeting
16 – 20th May, 2023
in Singapore

Please contact us
via email
or LinkedIn
to arrange a meeting





Detlef von Ahsen

Résumé

Detlef von Ahsen

Dipl.-Ing., Patent Attorney, European Patent Attorney, European Trademark and Design Attorney, Partner, KUHNNEN & WACKER, Freising

could access the landing page of the buyer via a link. Following a take-down request by the complainant, Google immediately removed the advertisement. However, the right to information remained contested, so that the complainant took legal action against Google regarding the provision of information about the following:

- the name and the address of the buyer,
- the time from which the advert was visible on Google,
- the number of clicks made to view websites accessible via the advert, and
- the price the buyer paid to Google for this advert.

After Google provided the information on the name and the address of the buyer as requested under a) during the ongoing proceedings, the parties have concurrently declared this prayer for relief to be settled. However, the prayers under b) to d), as set out above, remained contested.

Ruling of the German Federal Court of Justice

While the complainant had been partially successful in the first-instance proceedings and the appeal proceedings, the German Federal

Court of Justice 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 and the channel of commerce of unlawfully identified goods or services. In cases of an obvious legal infringement, the claim according to section 19 para. 2 sentence 1 No. 3 of the Trade Mark Act may also be asserted against a person who, on a commercial scale, provided services used for infringing activities, as Google did in the present case. In this case, the German Federal Court of Justice was convinced of the obviousness of the legal infringement (undisputed by the parties of the judicial proceedings), so that the complainant is, in principle, entitled to claim the provision of information from Google. In conclusion, the German Federal Court of Justice nevertheless also finds that these claims are delimited to the scope defined in section 19 para. 3 of the Trade Mark Act, namely:

- according to section 19, para. 3 No. 1 of the Trade Mark Act, the name and address of the manufacturers, suppliers and other previous holders of the goods or services as well as of the intended wholesalers and retailers, and
- according to section 19, para. 3 No. 2 of the Trade Mark Act, the quantity of the goods manufactured, delivered, received or ordered as well as the prices paid for the goods or services concerned.

Regarding the individual pieces of information requested, the German Federal Court of Justice argued, in essence, as follows:

Information requested regarding the time from which the advert was visible on Google:

The court of appeal had assumed that placing an advert on the internet also opened up a channel of commerce, so that, in accordance with section 19 para. 1 of the Trade Mark Act, the provision of information regarding the channel of commerce would be owed. The court held that the claim concerning the provision of information was not limited to the mere notification of the fact that there had been a channel of commerce, but that it also included the time when the channel of commerce was opened. The German Federal Court

of Justice did not agree with this view. After carefully analyzing the history of section 19 of the Trade Mark Act, as well as the regulation of Art. 8(2) of the so-called Trade Mark Directive (Directive 2004/48/EG), which the aforementioned section is based on, it arrived at the conclusion that the claim concerning the provision of information is not described clearly. Therefore it was not possible to infer from section 19 para. 1 of the Trade Mark Act any obligations to provide information beyond the information set out in section 19 para. 3 of the Trade Mark Act. An analogical application of section 19 of the Trade Mark Act did not come into consideration either, because there were no unintended gaps in the regulation.

Information requested regarding the number of clicks

The wording of section 19, para. 3 No. 2 of the Trade Mark Act – as well as the German-language version of Art. 8(2)(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 services 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 arrives 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 incriminated 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.

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 be 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 serve 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 hereinabove. 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 against an operator of a platform where buyers may place an AdWords advert. Thus, the limits of the claim concerning the provision of information are further clarified.

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.

Contact

KUHNNEN & WACKER

Intellectual Property Law Firm
Prinz-Ludwig-Straße 40A, 85354,
Freising, Germany

Tel: +49 8161 608 - 0
info@kuhnen-wacker.com
www.kuhnen-wacker.com

“
The German Federal Court of Justice came to the conclusion that 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.”





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 under agreement is a common 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



Wei He

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, which contain the service of the location of catering of the food and beverages. The Trademark Office rejected the application on the grounds of "having direct reference to the content and characteristic of services", and Beijing Duck King did not apply for a review of refusal. However, Beijing Duck King has been continuing to use the "Duck King" trademark within the area of Beijing. On January 29, 2002, Shanghai Duck King applied for registration of

the word 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 the owned trademark.

Considerations for acceptance of trademark coexistence agreement

In practice, the court generally judged whether the coexistence agreement can be accepted by consideration of 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

“**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.**”

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.

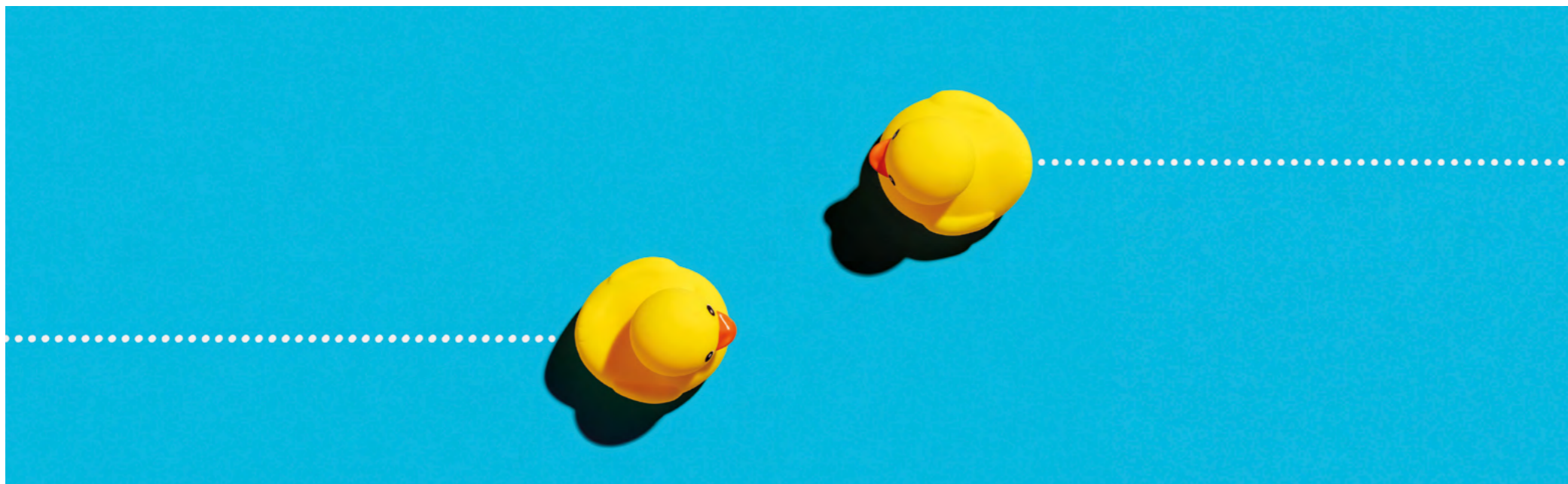
- **Conditions cannot be attached:** According to the practice of examination in China, the coexistence agreement should not contain the conditions. Turning to another case, a software company Jinda road's trademark "artin" was refused by citation of prior trademark "artina" owned by silver star company. The two parties reached a coexistence agreement but in the agreement, Jinda road company promises that it will not use the "artin" trademark alone, but will only use "artin" with another trademark "CMF". Jinda road company promises not to use the "Artin" trademark on other goods or services already covered by the registered trademark "artina" of silver star company. Such coexistence agree cannot be accepted because Silver Star Company agrees to register the contested trademark "Artin" on the condition that JINDA road company closely uses the trademark with "CMF".
- If the prior trademark owner is a Chinese company, the original notarized consent letter signed and stamped by the authorized person shall be provided.
- If the owner of the prior trademark is a Chinese person, the original notarized consent letter signed by the person shall be provided.

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 prosecution cases for many well-known companies in China and abroad. She has rich experience in strategy planning on trademark management and protection, trademark prosecution 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.



- 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.

In China, the used goods involved in the coexistence agreement are limited to the designated goods of the applied-for trademark, and in the refusal review procedure, the judgment 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: OCULUS, Designated goods: **virtual reality game software**

Cited trademark: "欧科路", the English letters "OCULUS" and devices, Designated goods: **computer; monitor (computer hardware); computer memory; computer keyboard; computer software, etc.**

Beijing High People's Court held that the two trademarks are distinguishable, although the English portions are the same. The "virtual reality game software" designated by the disputed trademark and the goods approved and used by the cited are similar, but not the same. And the business area of the two parties is different. The coexistence agreement was accepted finally.

Whether it damages the public interests and the market order: The determination of the validity of trademark coexistence agreements involving national health and public safety should be strictly controlled so as to avoid the possibility of confusion and misidentification.

Trademark case of "Wubigao" which is owned by a pharmaceutical company: Beijing High People's Court held that the appealed trademark was highly similar to the cited trademark, and the goods such as **pharmaceuticals** designated

“**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.**”

for the appealed trademark are similar to **tonics** and some other goods as approved for the cited trademark. Although the owner of the applied trademark submitted a trademark coexistence agreement signed by the owner of the cited trademark during the legal proceedings, the coexistence agreement can only be viewed as the preliminary evidence to exclude the likelihood of confusion. Besides, such factors as 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 "Aigefu" which is owned by a pharmaceutical company: Supreme People's Court held the designated goods of the applied-for trademark are chemicals such as pesticides and some others in Class 5, 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 5 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

The majority of coexistence agreements in the stage of trademark review and adjudication are used in the cases of review of refusal. Prior to 2021, we usually suggested our client obtain, if there is a chance, a coexistent agreement for similar marks in the refusal review application in

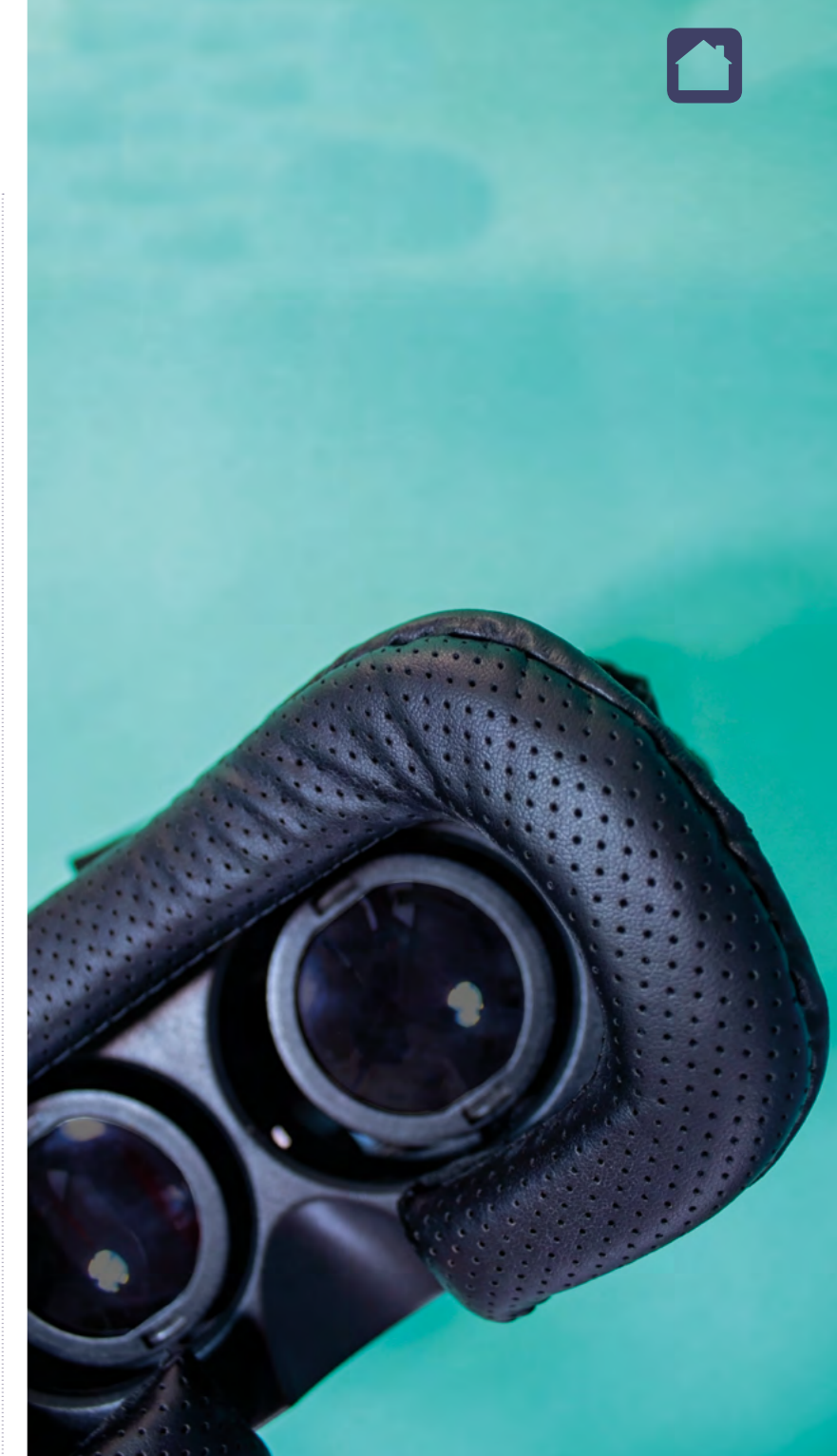
order to overcome the obstacle of the cited mark. But since 2021, the acceptance of the coexistent agreement has dramatically decreased. The reason is that CNIPA consider that trademark Law should protect the trademark right owner's interests and also protect the consumer's interests. CNIPA is taking the protection of consumer's interests as the fundamental purpose in the judgment 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 defectiveness 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 took the view that 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 lawsuit with the submission of a coexistence agreement, in the case that the agreement is assured 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-subsidiary companies and are not supposed to be held only by one party, joint ownership can be considered.



“**The rate of acceptance of coexistence agreements has decreased.**”

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

Contact

Beijing Sanyou Intellectual Property Agency Ltd.

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

Tel: +86-10-88091921,88091922

Fax: +86-10-88091920

sanyou@sanyouip.com

www.sanyouip.com



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 – dawns on collegiate sports, athletes have begun to receive compensation for these valuable, if 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 run-of-the-mill administrators or even 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 newer 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 in 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 Dončić**, the Dallas Mavericks star who stunned the sports world when he sued his own mother in 2022 for control of his trademarked name. Dončić filed a petition with the United States Patent and Trademark Office regarding canceling the “LUKA DONCIC 7” trademark, which is controlled by his mother and which she refused to give up.

In the collegiate world, **Paige Bueckers** is one of many standout athletes as the star of the longstanding powerhouse women’s basketball team at the University of Connecticut. Bueckers, who is sitting out the current season with an injury, is expected to come roaring back later this year. Meanwhile, she has been developing a brand not just around her own name but around the sobriquet she’s earned as a result of her scoring



LaKeisha C. Marsh



Kourtney A. Mulcahy

prowess—“Paige Buckets.” On July 13, 2021, she filed for a trademark on her nickname for use on athletic apparel. *The New Haven Register* quoted a sports technology company’s estimate that there might be more than \$300,000 worth 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, launched his own trademark and clothing line “J30 Apparel” in 2021. Bohannon also launched a website to sell t-shirts, socks, and other attire. 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 Bronco great, whose displays of Christian faith, both off and particularly on the field, were so widely seen that he earned himself a verb – “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 donating any proceeds to his own eponymous 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 highlight 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 did not 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

“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.”

is forced into one of three unappealing options: 1) pay the fraudster to transfer the ownership of the trademark application or to abandon the application; 2) take legal action; or 3) drop pursuing formal trademark protections altogether.

In the United States, athletes and others can file trademark applications on an “intent-to-use” basis. This means that the athlete does not have to offer the goods or services identified in the application at the time of the filing; they can seek protection for goods or services that are “intended” to be offered in the future. Given that the USPTO allows for up to five extensions to preserve the trademark application, the athlete will have at least three or four years before proof of use needs to be provided in order to support registration for the mark. Some likely subjects of protection include apparel, branded sports camps, and personal appearances by a sports celebrity.

In light of these real risks of having the “wrong” claimant to a trademark, athletes and their teams should carefully consider who the named owner of the trademark should be. As in Luka Dončić’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, and 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, a partner in the Intellectual Property and Trademark practices at Akerman, 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.

- PATENTS
EP VALIDATIONS
PCT NATIONAL APPLICATIONS
- TRADEMARKS
● MODELS
● COPYRIGHT
● DOMAIN NAMES
- SEARCHES
● PORTFOLIO SEARCHES
● COMPANY NAME SEARCHES
● LICENSING
● ASSIGNMENTS
- OPPOSITIONS
● LITIGATIONS
● CUSTOMS ACTIONS
● ANTICOUNTERFEITING
● RENEWALS
● ANNUITIES

Your Intellectual Property agent in Eastern Europe and Asia
European Patent and Trademark Attorneys
Domain name registrar (.si)

European countries

Slovenia | Croatia | Bosnia and Herzegovina | Serbia | Kosovo | Montenegro | North Macedonia | Albania | Bulgaria | Czech Republic | Cyprus | Greece | Hungary | Poland | Romania | Slovak Republic | Turkey | Estonia | Lithuania | Latvia

Eurasia

Russia | Armenia | Azerbaijan | Belarus | Georgia | Kazakhstan | Kyrgyzstan | Moldova | Tajikistan | Turkmenistan | Ukraine | Uzbekistan | Mongolia



Mark-Inventa Co., Ltd.
Glinška ulica 14, SI-1000 Ljubljana, Slovenia
P.O. BOX 2948, 1001 Ljubljana, Slovenia
p: +386 1 4266 503 and +386 1 5404 331
f: +386 1 2510 508 and +386 1 5243 118
e: office@mark-inventa.si
url: www.mark-inventa.com



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 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

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 properly formed

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 copyrighted 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.

“
The athlete will have at least three or four years before proof of use needs to be provided in order to support registration for the mark.
 ”

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.

Contact

LaKeisha C. Marsh
 lakeisha.marsh@akerman.com

Kourtney A. Mulcahy
 kourtney.mulcahy@akerman.com

Any Help?

We Are Here to guide you.
 Protecting your IP Rights across the Middle East

Patents & Trademark Commercialization

Licensing & Franchise

IP Due Diligence

Brand Valuation

Domain Names

IP Rights Counselling

VAKHNINA & Partners

Patents
Utility models

Designs
Trademarks

ip@vakhnina.ru
 www.vakhnina.com
 +7-495-231-4840

Dr. Tatiana Vakhnina
 Specializes in trademarks, and patents in mechanical and electrical engineering.

Dr. Alexey Vakhnin
 Specializes in Medicine, Biotechnology, Biochemistry, Pharmacology, Pharmaceuticals.

Dr. Elena Utkina
 Specializes in Chemistry, Biochemistry, Pharmacology, Pharmaceuticals.

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

Contact in Russia: ip@vakhnina.ru

Contact in Armenia: office@vakhnina.am

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

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.

Intellectual Property and Dispute Resolution are the firms' core strengths. Legal500 has recognized Sudath Perera as a leading lawyer in Sri Lanka and the firm has received Tier 1 rating for Intellectual Property and Dispute Resolution for a consecutive number of years.

TRADEMARKS ■ PATENTS ■ INDUSTRIAL DESIGNS

COPYRIGHT ■ LICENSING ■ TRADEMARK WATCH SERVICE

BRAND PROTECTION & INVESTIGATION ■ LITIGATION & ENFORCEMENT

CUSTOMS RECORDATION ■ DOMAIN NAMES ■ IP DUE DILLIGENCE



Sudath Perera

FOUNDER AND MANAGING PARTNER



Himani Perera

PARTNER – HEAD OF INTELLECTUAL PROPERTY



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

Thiago Lombardi Campos da Costa of VAZ E DIAS ADVOGADOS & ASSOCIADO details the two cases that changed the approach to infringement through keywords in sponsored links.

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 – UCC Committee - Policy Development Subcommittee¹, 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 (ab)use of sponsored links and fairness, as there may be instances of misleading advertisement (causing confusion or



Thiago Lombardi Campos da Costa

deception among consumers) and trademark infringement.

This topic has just recently made its way to the Brazilian Superior Court of Justice (STJ) and established a leading case on the use of a competitor's trademarked terms as a keyword for 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.

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”

Résumé

Thiago Lombardi Campos da Costa, Attorney-at-Law

Thiago specializes in litigation and has expertise in representing clients through court suits, probate, and *ex-parte* proceedings, advocating 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.

No.5, 9th Lane, Nawala Road, Nawala, Sri Lanka

+94 117 559 944

<https://www.sudathpereraassociates.com/>

ipd@sudathpereraassociates.com



“
There is no set of laws or regulations specifically addressing sponsored links.”

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 (CONAR) and the Brazilian Advertising Standards Council (CONARH), 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 plenary that refer to sponsored links; both of which, not coincidentally, were motivated by trademark infringement claims.

In the first one², 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.

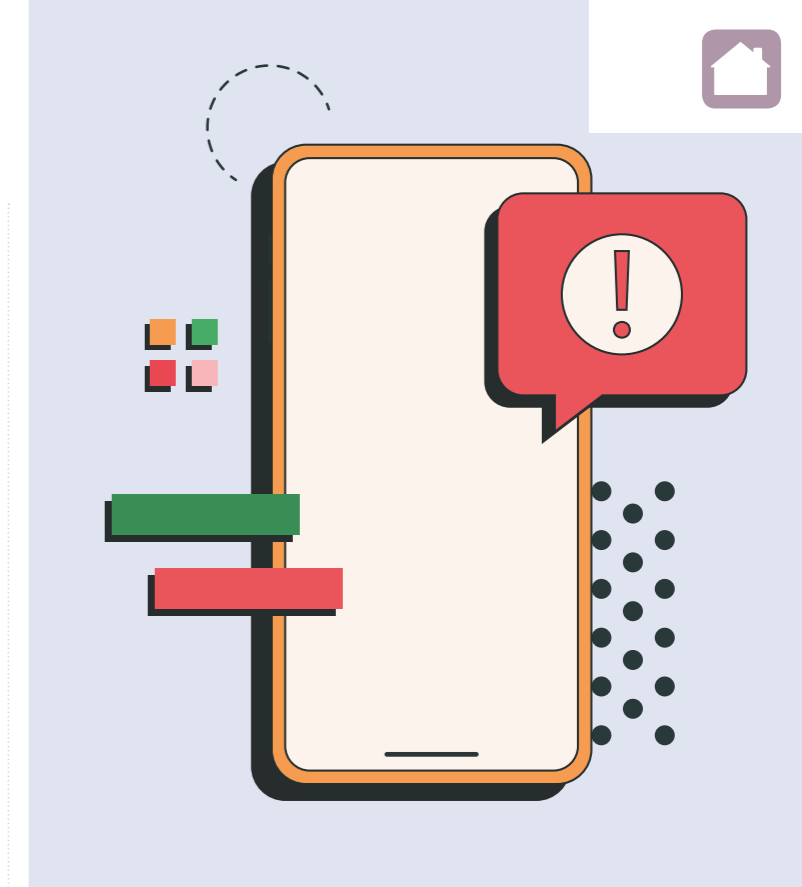
As for the second one³, records number REsp 1937989/SP ruled in August 2022 and published in the official gazette of November 7, 2022, the STJ's Fourth Appellate Chamber extensively examined the matter to establish, in a 16-page decision, that despite the constitutional right of free competition and the liceity 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

clientele, which characterizes an act of unfair competition” as provided in article 195, III 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 dissonant decisions, lacking uniformity and therefore jeopardizing trademark rights granted by the Brazilian Trademark Office (BTO). 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 one 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 2022⁴ – 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 only 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 2023⁵, 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 merit⁶. 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

“
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.”



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

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 victims the right to be awarded moral and material damages.

The amount of moral damages awarded varies. Mainly it will depend on the plaintiff’s representatives’ ability to influence the judge with factors, such as the involved parties and their financial capacity, the severity of unlawful conduct, and the duration of the legal violation.

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.

Contact

VAZ E DIAS ADVOGADOS & ASSOCIADOS

Rua da Assembleia 10 – Section 2422
Centro – Rio de Janeiro/RJ, Brazil

Tel: +55 21 3176-6530

Fax: +55 21 3176-6528

mail@vdav.com.br

http://www.vdav.com.br/

¹ In: [https://www.inta.org/wp-content/uploads/public-files/advocacy/committee-reports/](https://www.inta.org/wp-content/uploads/public-files/advocacy/committee-reports/Modern-or-Contemporary-Unfair-Competition-Practices-Final-Report.pdf)

Modern-or-Contemporary-Unfair-Competition-Practices-Final-Report.pdf

² Brazil’s Superior Court of Justice, case n.º REsp 1.606.781/RJ

³ Brazil’s Superior Court of Justice, case n.º REsp 1.937.989/SP

⁴ São Paulo’s State Court, Records no. 1130874-18.2021.8.26.0100

⁵ São Paulo’s State Court, Records no. 1128548-85.2021.8.26.0100

⁶ i.g. (1) São Paulo’s State Court - AC: 10005094920218260301 SP, Reporting Judge: Grava Brazil, Judged on: 08/11/2022, 2^a

Appellate Chamber Especialized in Business Law, Published on: 17/11/2022 | (2) São Paulo’s State Court - AC:

10639522920208260100 SP, Reporting Judge: Natan Zelinschi de Arruda, Judged on:

22/11/2022, 2^a Appellate Chamber Especialized in Business Law, Published on:

23/11/2022 | (3) São Paulo’s State Court - AC: 00207943820208260100 SP, Reporting Judge: Jane Franco Martins, Judged on:

23/11/2022, 2^a Appellate Chamber Especialized in Business Law, Published on:

08/12/2022 | (4) Santa Catarina’s State Court - APL: 03053207020188240005, Reporting Judge: Claudio Eduardo Regis de Figueiredo e Silva, Judged on: 23/02/2023, 5th

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.

Appellate Chamber Especialized in Business Law | (5) São Paulo’s State Court - AC: 10313383420218260100 SP, Reporting Judge: J. B. Franco de Godoi, Judged on: 02/03/2023, 1st Appellate Chamber Especialized in Business Law, Published on: 02/03/2023 | (6) São Paulo’s State Court - AC: 11281071220188260100 SP, Reporting Judge: Sérgio Shimura, Judged on: 14/12/2022, 2st Appellate Chamber Especialized in Business Law, Published on: 14/12/2022 | (7) Paraná’s State Court - APL: 00269477220208160001, Reporting Judge: Maria Aparecida Blanco de Lima, Judged on: 07/02/2023, 4th Appellate Civil Chamber, Published on: 09/02/2023.



GRUENBAUM,
POSSINHAS & TEIXEIRA

GPT is Global, Productive
and Technological

Our mission is to provide services in the areas of
**Intellectual Property with excellence and
competitiveness**

CONTACT US

+ 55 (21) 2533-6720

+ 55 (21) 2544-9339

central@gruenbaum.com.br

<https://gruenbaum.com.br>

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.

Attempting 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 signpost to third parties considering producing a product with a similar appearance, where the shape alone is protected an English court will

“**The US Supreme Court remains somewhat skeptical of over-extending trade dress protection.**”

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 & another*¹ 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*⁴, 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)

A Foundation to Your Success!



Résumés

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



Leigh Smith



Straat Tenney

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

With more than 25 years of experience in the sector, **Bart Lieben** from the Brussels office supports engagement with entrepreneurs seeking protection of intellectual property rights, including trademark, patent, and copyright, together with a focus on digitization, data protection on matters such as GDPR, and commercial and M&A activity. Bart has also been appointed before as an expert to the European Commission and the European Patent Office and an advisor to the United Nations' Economic and Social Commission for Western Asia.



Bart Lieben

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 intermingled 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 US 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 scheme⁵, children's outfits decorated with hearts, flowers, and fruits⁶, and tablet computers⁷. To be protectable, product design trade dress must be distinctive and nonfunctional.⁸ Product designs can never be inherently distinctive.⁹ The US Supreme Court remains somewhat skeptical of over-extending trade dress protection, noting in *Wal-Mart* that "product design almost invariably serves purposes other than source identification."¹⁰ 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."¹¹ 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

“

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.

”

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.¹² 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.

⁵ *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992).

⁶ *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 207 (2000).

⁷ *Apple, Inc. v. Samsung Elecs. Co.*, 920 F. Supp. 2d 1079 (N.D. Cal. 2013).

⁸ Lanham Act § 43(a)(1)(A), 15 U.S.C. § 1125(a)(1)(A); *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210 (2000) (citing *Two Pesos, Inc. v. Taco Cabana, Inc.*, 505 U.S. 763, 765 (1992)).

⁹ *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210 (2000).

¹⁰ *Wal-Mart Stores, Inc. v. Samara Brothers, Inc.*, 529 U.S. 205, 210 (2000).

¹¹ *Inwood Laboratories, Inc. v. Ives Laboratories, Inc.*, 456 U.S. 844, 851, n. 11 (1982).

¹² For trade marks, see Article 4 of Regulation (EU) 2017/1001 of the European Parliament and of the Council of 14 June 2017 on the European Union trade mark, OJ, L 154 of 16 June 2017, p. 1-99 and Article 3 of Directive (EU) 2015/2436 of the European Parliament and of the Council of 16 December 2015 to approximate the laws of the Member States relating to trade marks, OJ, L 336 of 23 December 2015, p. 1-26, as amended; for designs, see Council Regulation (EC) No 6/2002 of 12 December 2001 on Community Designs, OJ, L 3 of 5 January 2002, p.1, as amended, and Directive 98/71/EC of the European Parliament and of the Council of 13 October 1998 on the legal protection of designs, OJ, L 289 of 28 October 1998, p. 28-35.

Generally speaking, both the European Trade Mark Regulation and the European Trade Mark Directive contain provisions that aim to avoid that exclusive rights can be obtained for the same shape, but under different protection regimes. In particular in relation to designs, EU law excludes "signs which consist exclusively of the shape [...] (i) which results from the nature of the goods themselves, (ii) of goods which is necessary to obtain a technical result, and (iii) which gives substantial value to the goods".

Over the years, we have not only seen the courts and IP offices taking a seemingly more adverse approach towards shape marks: they also have been drawing clearer lines between the protection of shape marks on the one hand, and designs on the other hand, due to the different subject matter which is protected. Chances are therefore high that grant is refused if trademark protection for a design is applied for, based on the argument that the design only has an aesthetic function. IP owners may, however, overcome such a position if they can provide evidence that the design to be protected as a trademark has acquired distinctiveness through use on the market.¹³

Also, 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.



Locke Lord acted for NE10 Vodka in the case discussed above.

¹³ See, e.g., GC 10 June 2020, T-105/19, EU:T:2020:258.

¹⁴ Directive 2001/29/EC of the European Parliament and of the Council of 22 May 2001 on the harmonisation of certain aspects of copyright and related rights in the information society (OJ 2001, L 167 p. 10).

¹⁵ CJEU 12 September 2019, C-683/17, EU:C:2019:721, § 52.

Contact

Locke Lord
www.lockelord.com

“
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.
”

glp® Your European IP Partner

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

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

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

Pushing forward the world's greatest innovators.

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



Via L. Manara 13
20122 MILANO

Tel: +39 02 54120878
Email: glp.mi@glp.eu

Viale Europa Unita 171
33100 UDINE

Tel: +39 0432 506388
Email: glp@glp.eu

Via di Corticella 181/4
40128 BOLOGNA

Tel: +39 051 328365
Email: glp.bo@glp.eu

glp.eu

Other offices:
PERUGIA · ZÜRICH
SAN MARINO

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





The Initiative of the CNIPA to regulate bad faith filings showing from the Draft Amendment to the PRC Trademark Law

Li Xiaohong and Han Yajie of ZY Partners detail the proposals for the emphasize use requirement, the “Preclusion of Repeated Registration”, and penalties for malicious trademark squatting, among others, that, if implemented, could combat bad faith filings.

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

“

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.

”

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



Résumés

Li Xiaohong, Senior Partner, ZY Partners

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

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, copyright, unfair competition, domain names, and designs. She has expertise in advising on IP enforcement strategy and has in-depth knowledge of court procedures. She also leads a team providing trademark portfolio services to multinational clients in China, including trademark prosecution, opposition, cancellation, enforcement, opinion work, licensing, and other work.

Ms. Li has helped numerous clients to obtain well-known mark 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.

Author email: xiaohong.li@zypartners.com

Han Yajie, Senior Associate, ZY Partners

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 served many of the world's top 500 companies from 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.

Author email: yajie.han@zypartners.com

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 greatly burdened the trademark examination system and drained the right holders' resources to enforce their rights.

A rule called "Preclusion of Repeated Registration" is therefore added in 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 14.2), and some exceptions are also provided for repeated registration (Article 21), 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 (Article 44).

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 new 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 filing.

Article 22 of the Draft enumerates the circumstances constituting bad faith filing, including massive filings without intent to use, the trademark registration is deceptive or 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 18 of the

Draft), pre-emptive registration by agents or representatives (Article 19 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 introduces a new trademark assignment system in invalidation action. It is stipulated under Article 45 that the prior right holder may request the transfer of the squatted trademark under some circumstances, i.e., if the disputed trademark violates Article 18 (protection of well-known trademarks), Article 19 (pre-emptive registration by agents or representatives), or Article 23 (squat other's prior used mark with certain influence by illicit means). Article 46 also sets a restriction for such request, that is, if there are other reasons indicating the registered trademark should be invalidated (such as violation of the absolute grounds), or if the assignment of the trademark could lead to public confusion or other negative effects.

This system is quite friendly to the prior right holders. In addition to invalidating the disputed mark, the prior right holder can now choose to request the squatted 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 CYN 250,000, confiscation of illegal income and other punitive measures, and placed on the black list of the National Enterprise Credit Information Publicity System. Civil compensation is also added in Article 83, i.e., if the bad faith filing caused 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 CYN 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. Also, 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.



Contact

ZY Partners

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

Tel: +8610 5879-0066

Fax: +8610 5879-0088

www.zypartners.com



Li Xiaohong



Han Yajie

“
The Chinese government has been making efforts to crack down on bad faith filings and improve the protection of trademark rights, with remarkable results.
”



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 GI report released by World Intellectual Property Organisation 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 GI 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:

- (i) 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%.
- (ii) 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 13.57%, Design by 59.39% and Trademark by 3.85%.
- (iii) 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 11.5% 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, speedy resolution of the IP disputes has been a concern of the stakeholders considering the pendency of cases before the courts and opposition matters at the Trademarks Registry. The setting up of Commercial Courts in 2016 was the right step by the Indian government to streamline the procedure for adjudication of Commercial disputes that includes IP disputes. Commercial courts were established with the explicit intention of expediting proceedings to provide a speedy resolution for rights holders. Therefore, suits or claims with a value exceeding Rs 300,000 (approximately \$4,500) that fall in the subject matter defined in the Commercial Courts Act, 2015 can be filed before the designated commercial courts. A further amendment entails mandatory pre-institution mediation for suits that do not contemplate urgent interim relief.

Abolition of Intellectual Property Appellate Board (IPAB)

The Indian government took a bold step in the year 2021 by abolishing the Intellectual Property Appellate Board (IPAB) existing since the year 2003. This was a significant moment considering all pending matters before the IPAB were transferred to the State High Court. At the same time, concerns were raised on the abolition of IPAB whether this would actually cut down the delays or add to the overall pendency considering around 3000 cases were transferred from the IPAB to Delhi High Court and numerous cases were transferred to High Courts at Bombay, Madras, Kolkata and Gujarat.



Ranjan Narula



Abhishek Nangia

“
The increased IP awareness and meteoric rise in the country's GI rankings are reflected in the consistent growth in the filing of trademark, patent, design and copyright applications in India.
”

Résumés

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 1991 handling a wide range of IP, IT and Technology matters including IP management issues, strategic advice on IP clearance, acquisition, and enforcement. Ranjan has worked in-house and in private practice including a stint with international IP practice heading its India operations. In 2019, Ranjan was invited to join the INTA, Board of Directors.

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

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 ENISHI 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.



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:

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

The IPD Rules provide for

1. **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

“With the increasing workload and for speedier execution of the matters relating to Intellectual Property Rights, a separate IP division was most needed.”

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.

2. **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.
3. **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.
4. **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.
5. **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 tubbing. 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.
6. **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 same is required to be filed in a sealed cover along with an application supporting the claim for redaction.

7. **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. (CS(COMM) 211/2021)*, the Plaintiff, being the prior user and registered proprietor of the mark OMEZ, brought an action against the registered proprietor of the mark OMES 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 OMES 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.P.(C)-IPD 55/2021 & CM 37157/2019*, Allergan Inc. (Appellant) challenged suo motu order dated 15.05.2019 passed by Trademarks dismissing the oppositions 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



“It is interesting to note that consent of litigating parties is not required for appointing a Mediator or ENE.”

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-PAT) 5/2021*, the Appellant filed an appeal against the order passed by Assistant Controller of Patents & Designs, refusing 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

“**The technique involves recording experts’ evidence in each other’s presence and before the judge who asks the same questions.**”

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.

Contact

RNA, Technology and IP Attorneys
 401-402, 4th Floor, Suncity Success Tower,
 Sector – 65, Golf Course Extension Road,
 Gurgaon - 122 005,
 National Capital Region (Haryana), India
 Offices: Delhi | Chennai
Tel: +91-124-4296999
 info@rnaip.com
 www.rnaip.com



Enhance your business. Keep this card for the best IP service in Latin America.

[FRESH PERSPECTIVE]

* PROTECTION * ENFORCEMENT * TRANSACTIONS

* CONSULTING * COMMERCIALISATION * DIGITAL

WWW.RNAIP.COM
 GURUGRAM | CHENNAI

RNA
 Technology and IP Attorneys

Exclusivity in IP prosecution and litigation since 1904

- <https://colmenares.com.pe/>
- <https://www.linkedin.com/company/estudio-colmenares-asociados/>
- email@colmenares.com.pe
- [colmenares.asociados](https://www.instagram.com/colmenares.asociados)

COLMENARES & ASOCIADOS
 IP Since 1904
 Lima - Peru

Hungarian IP enforcement proceedings are getting faster... but who is missing out?

Miklós Sívári, 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.

Enforcement 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 Procedure¹.

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 on 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



Miklós Sívári

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

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 adjudging 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 lawsuits)², which also supports 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.

Looking at the 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 identically 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 ruling without hearing the opposite party, both on a request for provisional measures and on the subject of a request for ordering a preliminary taking of evidence: where any delay in consequence of hearing the opposite party is likely to cause irreparable harm, or if there is a demonstrable risk of evidence being destroyed, the court may decide *inaudita altera parte* on the right-holder's request for provisional measures and on the request for preliminary taking of evidence.

The court of second instance³ shall adjudge appeals against the Metropolitan Tribunal's ruling on provisional measures in priority proceedings, at the latest within 15 days following the date of filing the appeal.

Specifically in the Patent Law⁴, it is an option that – notwithstanding the basic concept of bifurcation (the Metropolitan Tribunal has exclusive jurisdiction and competency for patent infringement cases, while the actions for the declaration of invalidity are heard, at first instance, by the

Résumé

Dr. Miklós Sívári, Partner and Head of Trademark Department

Miklós is a European and Hungarian Patent Attorney and has been at Danubia Patent & Law Office since 1984, 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, HUNGARIKUM Trademark Committee, Union-ip, INTA and PTMG.

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

”

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 the Trademark 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 proceeding⁵.

It is a common provision in each of the Hungarian industrial property laws that invalidation proceedings – patent, utility model and design

¹ Act CXXX of 2016 - on the Code of Civil Procedure

² The Metropolitan Tribunal (Budapest) has exclusive jurisdiction to hear industrial property infringement actions (also functioning as a European Union trademark court of first instance)

³ 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)

⁴ Act XXXIII of 1995 on the Patent Protection of Inventions

⁵ See Article 60, European Union trade mark regulation



“
Very last-minute actions may result in incomplete oppositions or insufficient evidence, ultimately leading to the refusal of the opposition.
 ”

⁶ Act XI of 1997 on the Protection of Trademarks and Geographical Indications

invalidation actions, as well as trademark cancellation actions, both for revocation and for the declaration of invalidity – shall be handled by the Hungarian Intellectual Property Office in accelerated procedure at the request of either party if it is verified that an action for infringement of the IP right has been instituted, or a request for provisional measures has been lodged, provided that the infringement action and the proceeding on the provisional measures are pending at the filing date of the request for accelerated procedure.

As for the proceedings before the Hungarian Intellectual Property Office in general, a number of modifications of rules have been introduced through recent years, with the aim that proceedings be conducted within a reasonable time, and the Office practice has also changed in such direction. In cases where no deadline is prescribed by the respective law for responding to an office action, a minimum term shall be given to the party (two to four months in patent matters, 30 days in trademark matters) and this term may be extended on request, but an extension in excess of three months, or more than three extensions shall not be allowed except in justified cases.

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, that 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.

Contact

Danubia Patent & Law Office LLC

Bajcsy-Zsilinszky út 16, 1051 Budapest, Hungary

PO Box: 1368 Budapest 5, Pf. 198, Hungary

Tel: +36 1 411 8700

central@danubia.hu

www.danubia.com



Women in IP Leadership

Celebrating achievements and continuing
the empowerment of women





Simona Lavagnini: Founding Partner, LGV Avvocati

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

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.



Simona Lavagnini graduated with honors, holds a PhD and taught Copyright and Advertising Law for 10 years at the University of Pavia. Simona publishes regularly in legal magazines (Italian and English), and has recently edited a book dedicated to directive 790/2019 and its implementation in Italy. In 2023, Simona became president of AIPPI Italian Group, and is also a partner of INTA, Itech, Les and ALAI. After some professional experiences, in 2003 Simona became a founding partner of the law firm LGV Avvocati. She is currently a cassation lawyer and provides legal advice on intellectual property for national and international clientele, with a focus on trademarks, copyright, and new technologies.

What inspired your career?

A series of events that were as random as they were fortunate. When I had to choose which direction to take in my university career, I was very confused and chose law without any particular conviction, although my passion was literature and history, for fear of not finding a suitable career opportunity. After a few years of university, I - quite by chance - met a foreign colleague who had done an internship in the USA in a patent office, who praised intellectual property and told me that it was a fast-growing sector. By another chance, that very year my university had instituted, for the first time, the teaching of industrial law. I took it, and since it was a rather unknown and entirely optional subject, the course was attended by very few students. The professor noticed me and asked me to graduate with him, with a thesis on copyright law. It was an epiphany: I thought that by heading towards industrial property law I could deal with things I was passionate about, such as literature, but also fashion, and technology.



“ 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 fact that I have always been driven by a strong interest in the subjects I deal with, so that studying them does not weigh me down. I think my academic training has helped me in the profession, which pushes me to delve into issues with a systematic and interdisciplinary approach, and then use the results of my in-depth study in a very practical way, as a lawyer interested not in the solution in principle but in the concrete result for the client. For this reason, I think it is always good advice to build a solid preparation, combining study experience with practical/professional experience. Another important element of the pathway was international networking: thanks to some clients I was able to get in touch very early on with groups of lawyers from different jurisdictions, with whom on an annual basis we meet and brainstorm with each other, where everyone shares their results and draws inspiration from each other's suggestions. Through this experience, I have gained the conviction that the IP sector is particularly fertile for those who have creativity and can find out-of-the-box solutions. For this reason, 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.

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

The first barrier I faced was language knowledge. Coming from an Italian classical high school, I had studied a lot of Latin and ancient Greek, but little or no English or other languages, which are nevertheless crucial in IP. The first success was therefore to learn English very well, and then also German: I was helped - as often happened to me - by chance and luck, since I managed to win the first Erasmus scholarship set up at my university, to attend the University of Bristol in the UK, and then also some scholarships at the Max Planck Institut in Munich, Baviera, where I completed my PhD thesis. My activities at that time were hectic, because I had to simultaneously work, follow my PhD, and also do a lot of activities at the university (attending examinations, editing the journal of our university group, and more). I had to give up a lot of my private life for a number of years. Another problem I had to face was being able to be taken seriously. As a young woman, I felt that sometimes the others thought that I could not be as assertive and 'successful' as a colleague of the opposite sex. Sometimes I also doubted myself. I, therefore, had to work a lot on my self-esteem, to convince myself that this was pure prejudice, and that the first to over-come it was me,

in my own head. I don't know if this is a problem that young women still have: in this case, my advice is first to study and learn a lot, to reach a solid level of preparation, and then to work on one's self-esteem, to acquire the confidence that is necessary in our profession and that we must communicate to those who come into contact with us.

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

I am particularly proud of the leading cases that I have brought for some of my clients in the field of new technology. One important case related to the defense of the search engine Yahoo!. The case arrived at the Supreme Court in 2018 and represented the first-ever decision on search engine liability in Italy.

Another important set of actions are those connected with the enforcement of rights on sports events: we managed to obtain the first dynamic injunctions in our jurisdictions against illegal IPTV, with orders issued *ex parte* by the competent civil court and immediately executed by mere conduit (something in as little as two hours).

Finally, I have been recently managing a leading case concerning DNS providers' liability, again the first decision in our jurisdiction in relation to this very special type of provider.

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

I feel I have now fulfilled quite a few of the ambitions I had in my 20s. First of all, I founded my own law firm, which just this year turns 20 years old and is still considered a reference point in the legal landscape of intellectual property in Italy. I plan to continue to grow it, together with my colleagues, so that it can further establish itself in the market, as a boutique where the customer is treated with the utmost attention.

In recent years, I have also managed to fulfil my university aspirations, not only thanks to my PhD, but also because I taught the subject of Copyright and Advertising Law for 10 years at university.

I recently had the honor of being elected president of the Italian group of the AIPPI association (The International Association for the Protection of Intellectual Property), and for the next three years I will be in charge of managing the main training and educational commitments that the association pursues in favour of specialized consultants and lawyers.

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

When we talk about equality and diversity, we

are talking about something that goes far beyond the opposition between men and women, and even the issue of gender, to a broader concern for all diversity. I think we can learn a lot from young people, who already in many cases live in a world where diversity is accepted and considered equal, precisely because there is a new and more open notion of 'normality'. Over the next five years, I would like to see this same change of mentality take place in the intellectual property industry, which in my view could be fostered by the fact that in our sector there tends to be a more open mode of dialogue, as each professional often comes face to face with foreign colleagues, with cultures that are also very different, and therefore must be accustomed to seeing, understanding and accepting diversity.

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

With regard to equality between men and women, I think a real change of mentality should take place. It should first of all be men who change

their perspective and become more proportionately and equally involved in the family and childcare. Only when this privilege/responsibility is felt by men as much as by women will we have achieved the basis for creating a real competitive opportunity for women. The latter, for their part, must continue along the path of emancipation, cultivating the goal of becoming authoritative and assertive, and doing so in their own way, valuing their own diversity and wealth. In other words, there should be different ways for different people to exercise leadership. In the IP sector in particular, I would like to see more women 'in charge', especially in traditionally male roles. It still happens today to see meetings, or conferences, where there is an absolute prevalence of men; and indeed in many realities we see the creation of a pyramid, which at the base is very much attended by women and then gradually tapers off. For instance, there are many female intellectual property law graduates; and also many young female professionals. And yet, in the roles of heads of departments, or partners, you still see very few women because, for many, career development is hindered by so many factors, and sometimes even some prejudice. I think the effort is to remove the obstacles that still exist, to enable everyone to demonstrate their abilities and aspire to roles of responsibility, regardless of gender (or other such elements).

“ I think we can learn a lot from young people, who already in many cases live in a world where diversity is accepted and considered equal, precisely because there is a new and more open notion of 'normality'. ”



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 1258) 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, and industrial designs. Olga is fluent in English and is a member of ECTA (2019). She has extensive experience in the consideration of disputes, objections, and statements in the Chamber on patent disputes of trademarks. Olga regularly participates in conferences and seminars 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, real professionals in their field. This inspired me to devote my life



to the protection of intellectual rights, I realized that I was interested in this and I wanted to do it.

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 Russian Patent Office as an expert trainee in the expert 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 this 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 here for 15 years. I continued to develop my career and in 2008 became a patent attorney with the right to work in the field of trademarks and appellations of origin. In 2021, I expanded my qualifications and became a patent attorney for industrial designs. In 2022, I received the status of a Eurasian patent attorney, having received the right to work in the field of design not only in the Russian Federation, but also in the CIS countries (Kyrgyzstan, Azerbaijan, Armenia, Kazakhstan, Tajikistan, Belarus). In our company, I am the head of the trademark department. The department employs 10 people - four of them are patent attorneys, the rest are assistants. The Trademark Department provides clients 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. It 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 the progress 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 of young experts. 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

“

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.

”

with a full range of services for the registration of intellectual property, including the services of trademark registration in the UAE.

What are 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 clients, such as INTA, ECTA (I have been a member of ECTA since 2019). 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 patenting - 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 mechanisms 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.



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 2019, Marta became the head of the Litigation Department, incorporating other functions such as managing the secretariats 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.

Inditex claimed that the defendant's use of the well-known trademark "ZARA" linked to its service "Club Blinko" infringed their exclusive right and alleged that such behavior was a clear act of unfair competition, alleging that the counterparty was trying to take unfair advantage 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.

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 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, LM) IP 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 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:



Marta Gimeno



Alfonso Sabán

Contact

H&A
c/Cedaceros,1. 5ª
Planta 28014 Madrid
Tel: +34 915227420
info@herrero.es
www.hyaip.com

the use carried out by the defendant did not affect any of the functions of the trademark.

1. It did not affect the function indicating origin, since it is not reasonable to think that a reasonably well-informed and attentive consumer would consider that the promotion is a service provided by ZARA, or that it is a service provided by a company economically linked to ZARA.
2. Such use was not likely to affect the advertising function of the trademark, since it does not render INDITEX's possible advertising activity idle, nor does it oblige it to make additional advertising efforts as a consequence of such use.
3. It did not undermine the investment function of the trademark inasmuch as it did not constitute an essential obstacle for INDITEX to use its ZARA trademark to acquire or maintain a reputation that allows it to attract consumers and gain a loyal clientele.
4. It was not likely to affect the distinctiveness of this trademark.

Accordingly, the Judge dismissed the claim and, even though the judgement has been appealed twice (Provincial Court and Supreme Court), this resolution has finally become firm. Buongiorno Myalerts 3 – Inditex 0





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 (EUIPN) released its first drafts for public comment of Common Practice 13 'Trademark Applications Made in Bad Faith' ("CP13") and Common Practice 14 'Trade Marks 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



Benjamin Cantor

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 C13 and C14 in Europe and the US. Ben also has experience in copyright law, assisting and advising clients in obtaining and protecting copyrights.

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 analyzes 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.¹ 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 advises the mandatory factor in a bad faith filing is an Applicant's dishonest intention. Nonmandatory factors include the pattern of the applicant's behavior or actions, the honest commercial logic behind filing a contested mark, and the origin of a contested mark and its use, among other factors. Scenarios that may give rise to a bad faith consideration include parasitic behavior by an Applicant, defensive registrations filed to prevent competition, or re-filing.²

Rather than issuing a guidance document like CP13, the United States has taken on bad faith in trademarks by instituting new requirements for

filing and options for enforcement. First, the Post Registration Audit program, launched in 2017, began randomly selecting trademark registration maintenance filings for intensive audits to ensure trademarks are in use with each good or service claimed. Next, the US Patent and Trademark Office (USPTO) required foreign filers to obtain counsel based in the United States. This step required attorneys under the jurisdiction of the United States and state bars to represent foreign filings, adding a new element of accountability and enforcement. Finally, Congress passed the Trademark Modernization Act ("TMA"), effective in December 2021. The TMA added three new options for third parties to challenge nonuse of trademarks and prohibit bad faith actors from successfully abusing the trademark system.³ These options include expungement proceedings (applicable between three and 10 years after the date of registration), reexamination proceedings (applicable for registrations younger than five years old), and letters of protest (applicable when an application is still under examination).

The inherent discrepancies in the EU's first-to-file system compared to the United States' first-to-use system create a difference in approach to curtailing bad faith actors in the trademarks. CP14 illustrates more pronounced differences in approach between the respective jurisdictions when it comes to evaluating principles of morality in trademarks.

CP14 establishes general principles for assessing trademarks contrary to public policy or to accepted principles of morality. While acknowledging each assessment is carried out on a case-by-case

“
CP13 presents factors for examining bodies to consider if a suspicion of bad faith is present.
”

¹ Common Practice 13, *Trademark Applications Made in Bad Faith*, EUIPN, 1st draft (October 2022).

² Id.

³ Trademark Modernization Act 2020

⁴ Common Practice 14, *Trademarks Contrary to Public Policy or to Accepted Principles of Morality*, EUIPN, 1st draft (October 2022).

⁵ *Matal v Tam*, 137 S Ct 1744, 1765; 198 L Ed 2d 366 (2017).

basis, CP14 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.⁴ CP14 advises trademark examining 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 precedential 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.⁵ In practice, this struck down the USPTO's ability to refuse trademarks for immorality. In light of CP14, a wide range of trademarks considered contrary to accepted principles of morality or public policy in the EU are registerable 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.

Contact

Cantor Colburn LLP

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

Tel: +1 860-286-2929

www.cantorcolburn.com





High threshold for evidence 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 based its decision on the evidence provided to establish 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 it has failed to establish trans-border goodwill and reputation of the mark 'ALPHARD' in India.

Background of the case

The Petitioner, Toyota, claimed to have launched



Manisha Singh



Ritika Agrawal

its product – a minivan, under the name Alphard in 2002, stating that they have been using it in China, Russia, Indonesia, the Philippines and Japan. In India, Toyota applied to register the mark 'ALPHARD' on a "proposed to be used" basis, under Class 12 (vehicles; apparatus for locomotion by land, air, or water) in 2017. However, the same stood rejected by the Registry on the ground of its similarity with the Respondent Techsquare's mark 'ALPHARD'. On the other hand, Techsquare registered the mark 'ALPHARD' in 2015 under Class 9 (different scientific, nautical, life-saving apparatus, computer, and computer software etc.), Class 12 (for car covers, horns, visors, bumper horns, and other car-related accessories), and Class 27 (Carpets, rugs, mats and matting, linoleum, and other materials for covering existing floors; wall hangings). Techsquare has two more applications awaiting registration for the 'ALPHARD' word mark and device mark under Class 12 for land vehicles that were opposed by Toyota in 2017 (word mark) and 2018.

In a series of registrations, oppositions, and refusals, the dispute reached the Delhi High Court when Toyota sought the cancellation of Techsquare's mark by filing a rectification petition. However, it is interesting to note that Toyota does not use the ALPHARD mark in India, but instead sells the same vehicle under the name 'Vellfire'.

Decision of the Court

Tracing the footsteps of the *Toyota vs. Prius* judgment, the Court rejected Toyota's rectification application on the ground that it had failed to prove the goodwill and reputation of the ALPHARD

mark 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 transborder reputation in passing off and rectification cases.

Firstly, the Court dismissed all 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 private parties.

The Court further pointed out that articles in various trade/automobile magazines and newspaper reports regarding the Petitioner considering 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 transborder 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. Ujoy 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 OU in relation to the use of the trademark 'Bolt' for electric vehicle charging stations in India by Ujoy Technology Private Limited.

Background of the case

The Plaintiff, Bolt Technology OU, formerly known as Taxify OU, is an Estonian Company operating as a taxi aggregator. It also provides ride-hailing, food and grocery delivery, rental of cars, e-bikes and scooters and EV (electric vehicle) charging stations/docks.

It was Bolt's averment that Ujoy Technology's use of the trademark 'Bolt' in respect of EV charging stations in India was an act of passing off its products and services as those of Bolt's. Bolt further stated that it conceptualized and adopted the brand "BOLT" in 2018, and through continuous use, the mark 'Bolt' has amassed considerable goodwill and reputation, being exclusively associated with its products and services.

Bolt alleged that the international reputation and goodwill of its trademark 'Bolt' had spilled

over in India much before the adoption of the impugned mark by the Defendant. It relied on data gathered from the internet that indicated the number of times Bolt's App was accessed by drivers in Indian cities like Ahmedabad, Pune, Surat, Chennai, and Kolkata.

The Defendant, Ujoy Technology denied Bolt's claim that its mark 'Bolt' was entitled to be regarded as a 'well-known trademark' under Section 2(1) (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 observed 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 the Plaintiff has no business whatsoever in India and added that establishing the tort of passing off first requires the Plaintiff to establish its goodwill and reputation in India, or that its goodwill and reputation garnered abroad is so considerable that it has 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 in the EV-charging market, the plaintiff can claim to be 'first'.

It was further noted by the Court that since the Plaintiff has no commercial existence in India, no services of Bolt could be availed even if any person downloaded its App. The Court also highlighted that the limited downloading of the plaintiff's App by persons who may be travelling abroad to countries where the plaintiff's services are available cannot, *prima facie*, be regarded as any sign of spill-over of the plaintiff's

reputation into India, much less in the EV charging arena.

The Court admitted that the Defendant Ujoy Technology is the first in the Indian market to provide EV charging services. The Court stated that in examining these aspects, it must acutely be conscious of the cautionary note sounded in 'Milmet Oftho' and 'Toyota' cases - that the Court must not permit large multinational corporations that have no intention of coming to India, to throttle an Indian company by not permitting it to sell its product in 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 percolation 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

“ 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. ”

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 bonafide 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.

Contact

LexOrbis

709/ 710, Tolstoy House,
15-17, Tolstoy Marg, New Delhi- 110001
mail@lexorbis.com
www.lexorbis.com

Résumés

Manisha Singh is the Founder Partner of LexOrbis. Manisha is known and respected for her deep expertise in prosecution and enforcement of all forms of IP rights and for strategizing and managing global patents, trademarks, and designs portfolios of large global and domestic companies. Her keen interest in using and deploying the latest technology tools and processes has immensely helped the firm develop efficient IP service delivery models and provide best-in-the-class services. She is also known for her sharp litigation and negotiation skills for both IP and non-IP litigations and dispute resolution.

She is involved in a large number of intellectual property litigations with a focus on patent litigations covering all technical fields - particularly pharmaceuticals, telecommunications, and mechanics. She has been involved in and successfully resolved various trademarks, copyright, design infringement, and passing off cases in the shortest possible time and the most cost-efficient manner applying out-of-box strategies and thinking.

She is an active member of many associations like INTA, APAA, AIPLA, AIPPI, LES, FICPI, and is actively involved in their committee work. She is an active writer and regularly authors articles and commentaries for some of the top IP publications.

Ritika Agarwal is a qualified Advocate associated with LexOrbis, having started her career in August 2013. Since then, has been a part of trademark prosecution teams of prestigious IPR boutique firms. She has advised clients from diverse areas of business and understands the specific requirements of different industries when it comes to their brand and IP protection. Having worked extensively as a core team member dedicated to trademark prosecution, she has gained in-depth expertise in counselling, support, and strategy in trademark; search and watch including investigations, market surveys, negotiations for co-existence agreements, buy-outs; filing and prosecution of applications, oppositions, and cancellation actions; post-registration maintenance; assignment and licensing; representation before and liaison with the Trade Mark Registry.

LexOrbis INTELLECTUAL PROPERTY ATTORNEYS

Your most
trusted
IP Partner

- » **IBL:** 2019 Indian Law Firm Awards, IP Protection
- » **WTR 1000:** 2019 Indian Law Firm Awards, IP Protection
- » **Managing Intellectual Property:** 2019, Tier 3, Trademark Prosecution
- » **Legal Era:** 2019 IP Star women of the year, Manisha Singh
- » **GIPC:** 2019 Award for Excellence for invaluable services in the field of IP to Manisha Singh
- » **IAM Patent 1000, 2018:** Recommended Law Firm - Patent Prosecution
- » **India Business Law Journal, 2018:** Manisha Singh recognized as one of India's Top 100 Lawyers, The A-List
- » **Asia Law Profile 2018:** Rated as Notable Firm, Asia Pacific Region
- » **Asialaw 2018:** Manisha Singh recognized as Leading Lawyer for IP
- » **Managing Intellectual Property, 2018:** Rated as a Tier 3 Firm in Patent Prosecution
- » **World Intellectual Property Forum:** 2018, Ranked and Awarded amongst the Top 10 most Prestigious & Trusted IP Law firms of India, 2018
- » **World HRD Congress:** 2018, ET NOW, Stars of the Industry Award for Excellence

NEW DELHI • MUMBAI • BENGALURU

www.lexorbis.com / mail@lexorbis.com / T: +91 11 2371 6565 follow us on

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-r outlining 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, many showed a wait-and-see attitude. To the great relief, the fears have proved unfounded so far. In April 2022, the head of the Russian PTO announced trademark examination to be carried out in accordance with the law regardless of the applicant's country of origin. PTO's prosecution practice has proved the Office to be following this course.

For example, Sochi-based company Trade Technologies LLC filed 83 applications for famous brands including Apple, Boeing, Chanel, Lamborghini, etc. The company paid the official fees on most of the applications and they proceeded to examination. More than 50 have already faced Office Actions issued by examination with grounds against their registration, while the rest are still awaiting first examination results that are likely to be the same.

Another company that filed 30 applications for well-known trademarks such as Dior, Guerlain, Givenchy and others was Smart Beauty LLC



Marina Karaldina

“There have been no registration decisions among more than 100 applications copying famous brands.”



located in Moscow. The applicant however has never paid filing fees on most of them, which has already resulted in abandonment of more than half of the applications, and similar decisions are expected shortly on the rest of them. As for the remaining applications where the filing fees have been paid, some are in receipt of Office Actions and the others are likely to face objections shortly. Considering that the applicant did not pay the fees, apparently there was no intention for most of the applications to go to examination, the company most likely sought the publicity that these filings brought.

Thus, among over a hundred applications filed by these two companies, as of today there are no registration decisions issued by the PTO. Some applications go abandoned due to non-payment of the filing fees, whereas those that do proceed to examination receive objections from the examiners, which can hardly be overcome by argumentation, whereas consent from right holders is obviously off the table.

Other than trademark prosecution, foreign companies are truly worried about whether their rights 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 21, 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-r 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 Decree of the Government of the Russian Federation of March 29, 2022 N 506 allowing parallel import of goods labelled 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 ROBOCAR 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 C01-533/2022 in the case N A40-84838/2021. The court also refused to apply the normative acts regulating parallel import to the case, because the goods under consideration were not original.

Court practice shows that despite the suspension of direct import of certain goods to Russia and parallel import legitimization, many foreign right holders continue to pay close

Résumé

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.”

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 bringing the defendants to administrative responsibility, imposing fines and seizing fake goods.

These positive tendencies seem to encourage other companies to come to action. Since October 2022, Calvin Klein Trademark Trust alone has filed more than 50 lawsuits demanding infringement be stopped and compensation for selling the counterfeit goods be rewarded.

Prosecution of trademarks carried out by the Russian PTO in accordance with the law and court practice acknowledging the rights of foreign holders prove that marks copying famous brands do not get through, while the companies suspending their activity in the Russian market continue to enforce their rights. The future is unpredictable, but we have to work out the best solutions once the future becomes present.

Contact

PATENTICA
15 Malaya Morskaya Street, Office 5,
Saint Petersburg 190000, Russia
Tel: +78126002427
+78126002428
info@patentica.com
www.patentica.com

EXPANDING THE VALUE OF YOUR IDEAS



Patentica is an intellectual property law firm operating since 1997 and providing full range of high standard IP services

- ◆ Patents
- ◆ Utility Models
- ◆ Patent translations
- ◆ Trademarks
- ◆ Industrial Designs
- ◆ Litigation
- ◆ FTO searches and opinions
- ◆ Licensing & IP transactions
- ◆ Patent & Trademark Searches
- ◆ Computer programs



www.patentica.com info@patentica.com

SINCE 1997 SINCE 1997 SINCE 1997 SINCE 1997 SINCE 1997

INTELLECTUAL PROPERTY- THE AGE OF POWERFUL TECHADES

12TH EDITION

WIPF INDIA 2024

10 12

JANUARY

Powered by **L.S. DAVAR & CO.**

40+ COUNTRIES

200+ SPEAKERS

600+ PARTICIPANTS

www.worldipforum.com SHANGRI-LA, BENGALURU (INDIA)



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



Nermien Al-Ali

Résumé

Nermien Al-Ali, founder and managing partner, was recognized as the best IP lawyer in Egypt in 2018 Legal 500. With over 20 years of experience in intellectual property, corporate law, and due diligence in Egypt, and is a former research professor at the University of New Hampshire, Franklin Pierce Law School from 2000-2003. Author of Comprehensive Intellectual Capital Management, John Wiley & Sons, New York 2001, and Egyptian Pharmaceutical Industry After TRIPs, Fordham International Law Journal, 2002. Standing before Cassation and High Administrative Court.





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 until the goods are inspected and a determination is made by court on their status. 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, the provisions of the TRIPs Agreement allowed the Customs Authority to require an applicant to provide security on the conditions that such security is for preventing abuse of the system and the protection of importers (where the goods are found to be genuine), provided in all cases that such "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 provides that the Customs Authority of member countries must impose a security on the importer if the goods are to be released into the market, if the rights holder was unable to obtain an injunction stopping the release within the 10 working days. Such security shall be used in this case to compensate the rights holder, if the goods are eventually found to be counterfeit or pirated by a court of law. In addition, the TRIPs Agreement provided that the Customs Authority should, on its own accord, 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. In such a case, it is evident that no bond payment by the rights holder will be required. These standards of protection of intellectual property at the borders are the minimum requirements that member countries should provide to strike a balance between the interests of the rights holder and the interest of a potentially innocent importer, while at the same time not imposing a bond too high that it would discourage the rights holder from recourse to the procedures.

Member countries of the TRIPs Agreement, Egypt included, amended their local laws to provide for the minimum protection requirements set by TRIPs. In Egypt, the "border measures" provisions were first enacted in 2005, making Egypt one of the first countries in the Middle East to introduce border measures for the protection of intellectual

“**In Egypt, the “border measures” provisions were first enacted in 2005, making Egypt one of the first countries in the Middle East to introduce border measures for the protection of intellectual property rights.**”

property rights (Qatar in 2011, and Jordan in 2021 for example). The 2005 border measures under Law 770/2005 failed to impose any payment of bond against the importer as mandated by the TRIPs Agreement. In all other aspects of the process, Law 770/2005 mirrored the TRIPs Agreement process for suspending the release of suspect goods and opted to impose a bond on the rights holder, adding that such bond shall be "equal to the value of the whole consignment (shipment) according to the Customs Authority's valuation". In practice, this, in most cases, resulted in an arbitrary valuation of the goods based on 25% of the market value of the genuine products representing the goods and ignoring the value of the consignment listed by the importer, which usually is much less.

The Egyptian Customs Authority usually justifies this on two bases: first, that if the goods are genuine then this will be their market value, and they 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 to preserve the rights of importers 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 judicial orders are obtained. Therefore, many rights holders before 2021 resorted to court to obtain an injunction, or District Attorneys' temporary orders, to stop the release of suspect goods, to avoid payment of an arbitrary, and rather prohibitive, bond amount that the Customs Authority would impose. That is no longer possible after the amendments of the law.

The new Customs Law no. 207/2020 was passed in 2020, and its executive regulations were enacted in 2021 (new law). The New Law was celebrated by rights holders and their counsel as it introduced clearer procedures for suspending the release of suspect goods, and removed the Connections Point Unit from processing complaints, discounting many layers of red tape and hence administrative delays. Instead, the new law entrusted the implementation of border measures to the Intellectual Property Protection Unit of the Customs Evasion Department ("IP-CED"), a faster and more agile unit with clearer authority. In addition, the new law finally gave effect to Article 58 of the TRIPs Agreement and provided that the IP-CED can initiate the process of suspending the release of suspect goods on their own, subject to notifying the rights holder and the importer. The IP-CED (miraculously run by two officers) acts as a strong agent of change, raising awareness about the important

role of customs officers in detecting and reporting suspect counterfeit goods and providing a focal point of reference in border control matters. The IP-CED officers single-handedly manage to report numerous suspect counterfeit consignments across 25 different ports to rights holders, and assist rights holders with the suspension of release procedures.

Despite the changes made by the new law, it failed to give effect to a number of standards mandated by the TRIPs Agreement:

First - no bond payment is imposed on the importer in case the goods are released before the rights holder takes action, while imposing a prohibitive bond payment on the rights holder. Under the new law, if the application for suspension is initiated by the rights holder, then the rights holder must also present evidence that a bond as estimated by the Port in question, has been paid. This means that for matters initiated by the IP-CED, or those backed by an injunction to suspend the release of suspect goods, the rights holder has a chance of suspending the release of goods without having to pay a security bond. But, for all other cases, the rights holder is faced with the impossible situation - either pay an exaggerated bond amount or let presumably counterfeit goods be released into the market. This should have been addressed by imposing a bond payment on the importer, or by introducing more 'reasonable fees'. For example, both Qatari and Jordanian law provides that the rights holder shall pay the value of any goods taken from the suspect consignment for inspection or for presenting as evidence.

Second - the bond evaluation mechanism used by the Customs and Port Authority according to the new law is based on the arbitrary evaluation by the authorities, which practice is 25% of the market value of the 'equivalent' genuine products based on the quantity of the goods listed in the consignment. If the rights holder gets away with suspending the release of goods without payment of bonds as provided under the law, the rights holder is then faced with resistance and strong reluctance by the Customs Authority to suspend release and/or to allow inspection of the goods. In its defense, the Customs Authority argues their insistence on payment of a bond is based on their need to have funds to cover the cost of keeping the consignment at the port. This completely defeats the purpose of border control measures, and puts the burden of fighting global illicit trade on the rights holder alone. Instead, the new law should have either provided a more reasonable mechanism to evaluate the bond or provided for fees on the importer to cover warehousing costs, and on the rights holder to cover inspection costs.

Third - Inspection of suspect goods by the

“**Instead, the new law should have either provided a more reasonable mechanism to evaluate the bond or provided for fees on the importer to cover warehousing costs, and on the rights holder to cover inspection costs.**”

rights holder is another aspect where the new law fails to meet the minimum requirements of the TRIPs Agreement. TRIPs provides that the authorities should allow the rights holder to inspect the detained goods to determine if they are counterfeit, and if confirmed to be so, to provide the rights holder with information about the importer, consignment, quantity, etc. Though Article 12 of the new law allows inspection of the detained goods, no mechanism is provided to do so, and there is no obligation to provide the rights holder with any information, leaving it up to the Customs and Port authorities to allow it at will. In most cases, the authorities in Egypt are pro-importer and are reluctant to cooperate with the rights holder, requiring in some cases the intervention by police force to allow the rights holder's entry and inspection of goods. In some cases, this reluctance stems from a lack of human resources as port officers are assigned to other work. It would have been better if the new Customs Law followed the Qatari Law model in that regard: where the Port Authority requires inspection fees to be paid by the rights holder for the port officers to avail the samples for inspection, and to pay for such samples if they are to be taken outside the port.

In conclusion, the bond payment under the border control measures for the protection of intellectual property rights against counterfeiting and piracy shows Egypt's commitment to enforcing 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 law, and training on its application by the officers, Egypt could 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.

Contact

NAL Law Group

North Tower, Cairo Business Plaza, Inside,
N 90 st, Egypt

Tel: +202 23066102

+20110609311

nal@nal-law.com

www.nal-law.com



Registration issues of trademarks incorporating official symbols

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.

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.

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 Federation¹, 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.

¹ Civil Code of the Russian Federation (Part Four) dated December 18, 2006 N 230-FZ





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 flag².
2. In order to register a trademark , including the designation of the ruble, it was necessary to provide the consent of the Central Bank of the Russian Federation³.
3. The consent of the Green and Red Cross, respectively, was required for the registration of the designations and ⁴ and ⁵.
4. The registration of the designation "OLIMP LABS" was granted the consent of the International Olympic Committee (International Olympic Committee)⁶.

Cases in which the decision of Rospatent containing the assessment of the designation in accordance with Art. 1231.1 of the Civil Code of the Russian Federation, are not numerous, but are of practical interest.

For example, in cases of 2022 N SIP-1079/2021 and N SIP-1080/2021⁷, trademarks "PS" N 777957 and "PE" N 668247 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 1231.1 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 Art. 1483 of the Civil Code of the Russian Federation.

However, the IP Court, like 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 Buryatia, etc. At the same time, the unambiguous perception of the specified letter combination as "Republic of Bashkortostan" has not been proven, therefore, the grounds

for concluding that the registration of the letter 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 court noted the absence 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. 1231.1 of the Civil Code of the Russian Federation.

For example⁸, the designation "Ipek" was recognized by Rospatent as similar to the official emblem of APEC (eng. Asia-Pacific Economic Cooperation, forum 21 of the economy of the Asia-Pacific region for cooperation in the field of regional trade, facilitation and liberalization of capital investment), however, the failed copyright holder objected, citing the lack of similarities.

The Board of the Chamber noted that "APEC" and are indeed 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. 1231.1 of the Civil Code of the Russian Federation and

“
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.”

canceled the decision of Rospatent.

In the case of the designation "mceuticals" ⁹ 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, and the applicant did not provide the consent of the relevant competent authority.

In the objection, 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 emblem of the ICRC 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 "mceuticals" 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.

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, body of an international or intergovernmental organization.

It is interesting to follow in practice, the consent of which particular subjects Rospatent accepts as appropriate. Here are some examples:



Olga Plyasunova

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 1258) 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 disputes, objections, and statements in the Chamber on patent disputes of trademarks. Olga regularly participates in conferences and seminars on the protection of trademarks in Russia and abroad.

² Conclusion of the Chamber for Patent Disputes dated 11/18/2021 (Appendix to the decision of Rospatent dated 12/18/2021 on application N 2020727969)

³ Conclusion of the Chamber for Patent Disputes dated April 17, 2019 (Appendix to the decision of Rospatent dated May 16, 2019 on application No. 2017731803)

⁴ Conclusion of the Chamber for Patent Disputes dated March 16, 2020 (Appendix to the decision of Rospatent dated April 6, 2020 on application No. 2018732277)

⁵ Conclusion of the Chamber for Patent Disputes dated May 12, 2021 (Appendix to the decision of Rospatent dated May 28, 2021 on application No. 2019727793/33)

⁶ According to international registration No. 1478790, from the author's archive

⁷ Decisions of the Intellectual Property Rights Court dated May 26, 2022 in case No. SIP-1079/2021, dated March 28, 2022 in case No. SIP-1080/2021

⁸ Conclusion of the Chamber for Patent Disputes dated 08/29/2022 (Appendix to the decision of Rospatent dated 10/23/2022 on application N 2020738288)

⁹ Conclusion of the Chamber for Patent Disputes dated 06/30/2022 (Appendix to the decision of Rospatent dated 08/12/2022 on application N 2020741305)

Contact

Zuykov and partners

Grokholsky Lane, 28 Moscow, Russia, 129090

Tel: +7 495 775-16-37

info@zuykov.com

https://www.zuykov.com/en



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 a range of NFT-related products and services. However, the company's application was met with a partial refusal by the European Union Intellectual Property Office (EUIPO), which covers almost all of the goods and services listed in the application, with the exception of downloadable interactive characters, avatars, skins, video games, downloadable video game software, and certain services related to computer games.

BURBERRY filed its famous figurative application (Figure 1) on 02/02/2022 for the following classes:

"9 - Non-fungible tokens (NFTs) or other digital tokens based on blockchain technology; downloadable digital graphics; downloadable digital collectibles; downloadable clothing and accessories; downloadable interactive characters, avatars and skins; downloadable virtual goods; virtual bags, textile goods, clothing, headgear, footwear, eyewear all displayed or used online and/or in virtual environments; video games and downloadable video game software; downloadable digital materials, namely,



Diogo Antunes



Figure 1

audio-visual content, videos, films, multimedia files, and animation, all delivered via global computer networks and wireless networks."

"35 - Retail and wholesale services for clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; online retail services related to fashion, clothing and related accessories; Retail store services and/or online retail store services in relation to virtual merchandise namely clothing, footwear, headgear, bags, purses, wallets, umbrellas, watches, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and cosmetics, textile goods, pet accessories; presentation of goods on communication media, for retail purposes."

"41 - Providing online non-downloadable digital collectibles namely art, photographs, clothing and accessories, images, animation, and videos; providing on-line information about fashion shows, digital games and sustainability; entertainment services, namely providing on-line, non-downloadable virtual content featuring clothing, footwear, headgear, bags, purses, wallets, umbrellas, jewellery, eyewear and sunglasses, cases and covers holders for portable electronic devices, printed matter, homeware, toys, perfume, toiletries and

cosmetics, textile goods, pet accessories, for use online and/or in virtual environments; providing online video games; provision of online information in the field of computer games entertainment; entertainment services, namely, providing online electronic games, providing a website with non-downloadable computer games and video games, computer interface themes, enhancements, audio-visual content in the nature of music, films, videos, and other multimedia materials."

The refusal is based on the grounds that the trademark application lacks distinctiveness, as the check pattern used is not markedly different from other 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 NFT's classification stated that virtual goods should be categorized as Class 9 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 12th edition of the Nice Classification already incorporates the term "downloadable digital files authenticated by non-fungible tokens" in Class 9. EUIPO then requires that the type of digital item authenticated by the NFT must be specified within the classification.

The partial refusal of Burberry's trademark application shows that EUIPO is taking a cautious approach to trademarks for virtual goods, as they are still relatively new and there is little legal precedent for them. The decision also highlights the importance of ensuring that trademarks for virtual goods are distinctive and do not simply replicate patterns or designs that are commonly used in the trade.

However, it is possible to criticize the decision, arguing that the distinctiveness analysis for 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. Furthermore, the value of NFTs lies in their blockchain authentication, which makes them

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.

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 carefully 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 real-world products 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.

Contact

Inventa

Alameda dos Oceanos 41K-21,
Parque das Nações 1990-207 Lisbon,
Portugal

Tel: +351 213 150 970
info@inventa.com
www.inventa.com



Bufete Mejía & Asociados



TRADEMARKS



PATENTS



COPYRIGHT



LITIGATION



REGULATORY AFFAIRS



DOMAIN NAME

(504) 2550-7744
1 (914) 412-5719

1 y 2 Calle S. J., 20 Ave. "A", Bo. Rio de Piedras
P.O. Box 1744, San Pedro Sula, Honduras, C. A.
www.bufetemejia.com

bma@bufetemejia.com

The future of IP management may be closer than you think

Sam Thorley, Head of Platform for Equinox, explores the future of IP management technology, highlighting benefits that IP attorneys can expect in the near future.

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



Sam Thorley

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

Résumé

Sam Thorley, Head of Platform at Equinox

Since 2018, Sam has been one of the leading figures in tech development at Equinox. The UK-based company supplies a leading intellectual property management system (IPMS) to over 250 subscriber organisations across the world and has quickly grown to be a major competitor in the IP tech space.

Alongside Equinox's team of experts, Sam develops and refines the latest solutions for Equinox subscribers. He employs his years of experience and close connections with IP professionals to bring the next generation of tech software to the industry.

automated invoices based on the time attorneys spend on a case.

At Equinox, we have added more integrations to help our subscribers process their cases across multiple platforms with as little hassle as possible. We have purpose-built Microsoft Office, Outlook, and Gmail integrations allowing automated document templates and correspondence to be generated when needed. For the financial professional in your team, Equinox is linked to providers such as Xero and Sage to make accounting and invoicing simpler to manage, and we are connected to specialist systems like Billtrader that help IP professionals manage international payments.

While these integrations are already making a huge difference to users of IP management systems, there are yet more improvements on the horizon.

The next goal for integrations is to have the full lifecycle of the IP management process manageable from a single system. While your firm might rely on a dozen different tech services to process a case from application to renewal and beyond, the aim is to have all of these services accessible from one place. That way, you can log into an IPMS like Equinox and have every service automatically updated when you progress a task.

"The IP tech environment is quickly progressing towards integrations that encompass the full life cycle of intellectual property. IP management systems have already begun to incorporate renewals services into their systems, but at Questel we project that EP validation, translation orders, and links to business intelligence and search software are all strong candidates for integration.

Soon, with advanced developments from providers like Equinox, intellectual property professionals will enjoy a dramatically enhanced capability to simply manage client portfolios, be they trademarks, patents, or otherwise. It's an exciting time for IP tech, and we are already starting to see these tools come into action."

— Felix Coxwell, Program Manager at Questel.

If you can work more efficiently, you can deliver your services more effectively to your clients. Platforms like Equinox IPMS are already making a tangible difference to the IP professionals they support, and a system with all-encompassing tech integration is going to drive the success of its users even further.

Artificial intelligence

There is a great deal of excitement around artificial

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

”

intelligence. Following the success of Chat GPT, we have seen major tech companies like Google and Microsoft launch their own AI-powered services to compete. It is a promising route of technological development and offers compelling opportunities in the intellectual property space.

While artificial intelligence is starting to mature and become an accessible tool for many, there is still a way to go before we can start to see it applied to intellectual property management.

The core responsibility of artificial intelligence will be to take menial tasks away from the operator. With the huge volumes of data involved in the intellectual property profession, it is hoped that AI can offer ways to organize and process data that could greatly improve its accessibility.

Additionally, some processes may be taken away from the professional to give them more time to focus on value-adding tasks. At first, this will include simple tasks and classifications, but in time could grow to automate the complex, in-depth processes that eat away at resources in every IP firm.

While artificial intelligence seeks to automate many tasks taking up your time, this will only ever augment the wealth of skill and experience of those using the software. IP tech providers, like our team at Equinox, are exploring how best to apply these advances to benefit our subscribers. When artificial intelligence is adopted in the IP space, it will be a slow trajectory starting with little steps, but in five years' time it could have daily applications for many across our industry.

Accessing support

No matter how intelligent and sophisticated our tech becomes, we are always going to need tech support. Ensuring that users get the support they need as soon as possible is a major priority for tech companies, and finding smart, diverse solutions is of keen interest to all of us.

The one-to-one tech support call is here to stay. At Equinox, our subscribers highly value the personal experience of having one of our support team guide the user to a solution or deliver training. Like 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 access help with their tech. People want to get their information in different ways; some like to read a document while 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. This will be especially helpful if you have a minor question but do not have the time for a phone call; you can hop into the help centre and find the information in the format that works best for you.

The one-to-one support experience is not going anywhere, but independently accessed multi-media support documentation will become increasingly prevalent, promising to provide quicker, more accessible support in the way the user wants to access it.

Security and performance

Intellectual property firms and their clients need to be absolutely confident in the security of their data. While the ever-increasing connections between digital spaces offer opportunities to make our lives easier, the potential security threats are growing in kind. Every tech company from the small start-up to major international brand is taking security very seriously, and while the developments here are not as flashy as the likes of artificial intelligence, they remain paramount to the user's experience.

IP firms are trusted by clients to manage their data responsibly and securely. Ensuring that the software managing and storing that data is dependable is a huge concern for all parties.

As more and more firms embrace IP management software, providers are devoting huge resources to security. Even those tech providers with a reliable track record in security are making improvements; soon all major IP tech firms will offer a formalized, accredited security qualification. This allows the user of the system to have confidence in the software they depend on, but it is also a great selling point for the users themselves.

Increasingly, businesses and organizations that may need the services of an IP firm are pursuing their own security accreditation which may require all their tech services to attain a corresponding qualification. Adopting an IP management system that fulfills this security obligation will be a major priority for IP firms in the near future.

Up-time is another important consideration for IP professionals seeking new management tech, and providers are trying to ensure their users have access to their system for as much time as possible. When your IP management system is down, it disrupts your work, and back-end tech improvements should not be overlooked.

At Equinox, we are proud to have one of the most consistent, reliable up-time records in the industry. However, there is always further to go and we are working on the system to ensure that our subscribers can access their system as much as possible. We update our system regularly, almost once every two weeks, to deliver the

“
In conjunction with our friendly support team, the digital Help Centre ensures our subscribers can get the help they need anytime.”

”

most up-to-date development and security releases and ensure the system runs smoothly. We receive many questions about backing-up data from potential subscribers, and we are addressing this by bolstering and improving our backup functionality to ensure our subscribers can work confidently with Equinox.

A smooth running and dependable software system is another great selling point for our clients to take to their prospects. A combination of advanced and secure IP management functionality is key to winning new business, and in the next few years, we can expect those firms that fail to embrace IP tech to find themselves lagging behind their competitors.

Firms are already feeling the benefits of IP technology

Technology is proving an exciting prospect for the intellectual property professional.

The IP management lifecycle is becoming easier to manage for professionals across the industry. With the full process of managing a client's portfolio accessible from one location and many tasks alleviated using artificial intelligence, IP firms can become more efficient and continue to deliver the dependable services their clients rely on.

Those clients will also enjoy an improved experience thanks to the strong performance of IP management technology, and they can have confidence in the security of firms thanks to the growing trend for accreditation.

Overall, these upcoming developments will represent an attractive selling point for the firms that embrace technology. By adopting an IP management system, IP professionals will be able to deliver more to their clients and win more business.

Contact

Equinox

Tel: +44 (0) 113 274 7309

enquiries@equinox-ipms.com

www.equinox-ipms.com

equinox
A Questel Company



Trademark misuse in the digital environment

Xavier Hadad, Partner at Uthoff, Gomez Vega & Uthoff, 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 unknown 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



Xavier Hadad

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

way of understanding business inherently requires the protection of the intangible rights involved, such as trademarks, without leaving aside all the connotations in copyright that we find in the digital world that are a source of business and sadly open the door to a world of infringements and violations.

As in any business plan, and as we briefly commented, we face the challenge of fighting the violation of these rights through tools we have at our disposal within the administrative field.

One of the most common questions that appears on our desks and in our email inboxes is: "what do I do if my trademark is used on the Internet?"

It's at this moment, as an intellectual property lawyer, that the catalog of options that we have to enforce the violation of an intellectual property right in the digital environment must be present in our minds. Though, the ability to identify which option to utilize, and in which way so as to create the most effective and attractive solution, is above all else the most important aspect. We must have this ability whilst always keeping in mind the ultimate goal of allowing our clients to continue working and worrying about their business and not about litigation, since it can wear down any business and the financial resources necessary for efficient operations.

Considering the aforementioned, we can discuss some of the most common means of defense and actions that we have at our disposal to fight this "new" problem of enforcing laws and regulations within a digital environment. Here are some general procedures that are very effective upon implementation:



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.

Résumé

Xavier Hadad, Partner

A longtime Partner at Uthoff 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 Uthoff, Gomez Vega & Uthoff 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@uthoff.com.mx





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.

Single panelist

Number of domain names included in the complaint	Fee (USD)
1 to 5	\$1,500 [Panelist: \$1,000; WIPO Center: \$500].
6 to 10	\$2,000 [Panelist: \$1,300; WIPO Center: \$700].
More than 10	To be decided in consultation with the WIPO Center

Three panelists

Number of domain names included in the complaint	Fee (USD)
1 to 5	\$4,000 [Presiding Panelist: \$1,500; Co-Panelist: \$750; WIPO Center: \$1,000].
6 to 10	\$5,000 [Presiding Panelist: \$1,750; Co-Panelist: \$1,000; WIPO Center: \$1,250].
More than 10	To be decided in consultation with the WIPO Center

<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

“ We have to think outside the box to offer viable solutions for our clients. ”

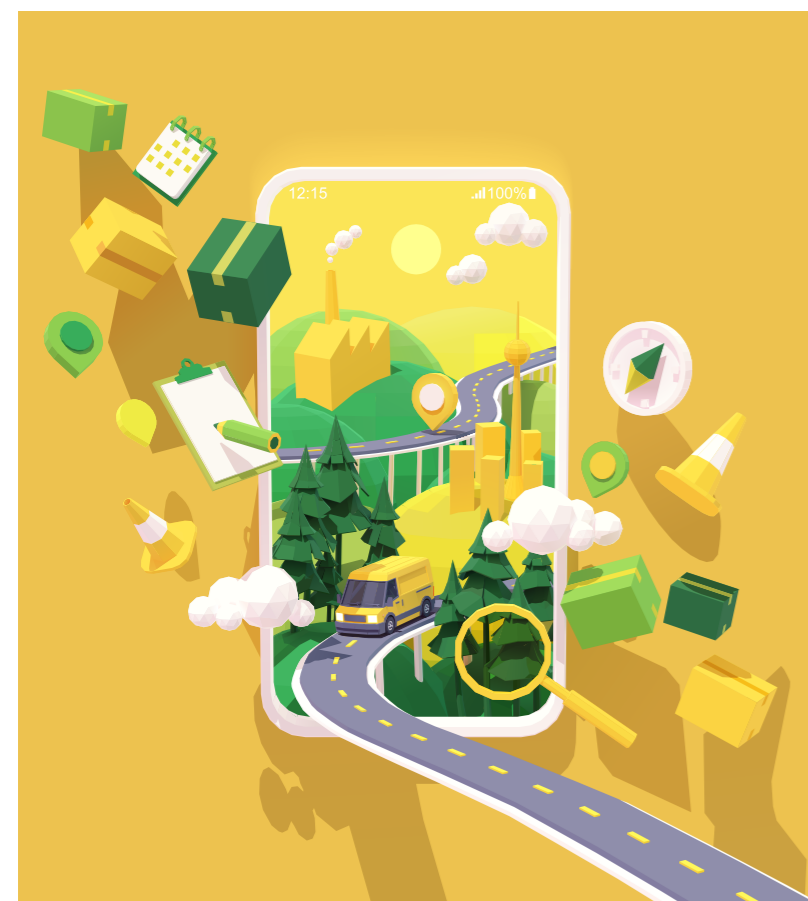
them as another alternative to defend against the abuse of a trademark or intellectual property right in the digital environment.

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.

Contact

Uhthoff, Gomez Vega & Uhthoff, S.C.
 Av. Paseo de la Reforma 509, 22nd floor.
 C.P 06500, Col. Cuauhtémoc, Mexico City, Mexico
 Tel + 52(55) 5533 5060
<https://en.uhthoff.com.mx/>



uhthoff
1905

THE LEADING
**INTELLECTUAL
 PROPERTY FIRM
 IN MEXICO**

Always at the forefront of **real solutions**, to the **legal needs** of our clients

uhthoff.com.mx





Brands in crosshairs of trademark squatters

Alexey Kratiuk and Alina Grechikhina of Gorodissky and Partners provide important tips for the protection of trademarks in Russia to fend off bad faith registrations and cancellation actions.

Brands, especially famous ones, have always been a *bonne bouche* for trademark squatters. It is hard to resist temptation to make a profit out of a well-known trademark and the reputation that stands behind it. Under present uneasy circumstances, the number of unscrupulous parties that try to make a living by squatting trademarks increases. Nonetheless, genuine trademark holders have various tools to protect their means of individualization, in particular trademarks.

In the first instance, it should be highlighted that Russia is a first-to-file country and the exclusive right to use a trademark results from its state registration. Trademark protection may be achieved through filing a national trademark application with the Russian PTO or an international registration designating Russia as a contracting party with World Intellectual Property Organisation (WIPO). There is no difference in trademark examination procedure for marks applied either under national or international trademark filing systems. The Russian PTO conducts examination both on absolute and relative grounds *ex-officio* within approximately six months from the application filing date in case of national applications or from the date from which the time limit to notify the refusal starts for international filings. Additionally, the Russian PTO provides service for expedited trademark examination for marks applied under the national filing system, which results in approximately three-month registration of a trademark, if there are no obstacles revealed.

There is yet another trademark protection system that is coming up soon. It is all about a brand new regional protection system for trademarks in the Eurasian territory. The system, when launched, should enable the brand owners to seek protection for their brands simultaneously in a number of Eurasian states such as Russia, Belarus, Kyrgyzstan, Armenia and Kazakhstan using a single application form, and the mark



Alexey Kratiuk



Alina Grechikhina

“**Russian law does not recognize prior use rights in respect of trademarks.**”

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 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 violation of the requirements of this Convention, specifically in violation of Article 6 septies.

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 Diş Ticaret Ltd. Şti. This company was a distributor of the goods produced by 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 Diş 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 Diş 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  registered for services in Class 35 owned by the Russian entity Hayat Retail Ltd. Invalidation action was initiated by a Croatian company Sardina d.o.o., holder of the trademark with the word the elements ADRIATIC 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  at the stage of trademark examination requesting to refuse the application while the mark remained pending.

However, as a result of consideration of the invalidation action the trademark registration

“**Moreover, having registered trademark rights may give additional advantages in fighting against trademark squatters.**”

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 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 the 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 view of the recent changes made to the Russian trademark legislation. Currently, a legal entity or an individual entrepreneur is entitled to file a trademark application. However, once

Résumés

Alexey Kratiuk, Partner, Russian Trademark & Design Attorney, Eurasian Design Attorney, Head of Trademark Department

Alexey is a well-known trademark specialist in Russia and worldwide. He has more than 20 years of experience in IP and counsels clients on issues relating to trademark strategies in different jurisdictions. Alexey deals with obtaining of rights for trademarks and appellations of origin of goods, trademark prosecution proceedings in Russia and other countries. He is intensively involved in invalidation/cancellation proceedings and enforcements of trademark rights using legal actions in both Administrative bodies and Courts in Russia.

Alina Grechikhina, Russian Trademark & Design Attorney, Eurasian Design Attorney

Alina specializes in trademarks and service marks, appellations of origin and geographical indications, non-traditional trademarks, collective trademarks, well-known trademarks, national, international and regional trademarks. Alina is intensively involved in opposition and cancellation proceedings representing clients across a wide range of industries including machine building, IT, games, consumer goods, food, chemical & pharma.

the amendments to the law come into effect, natural persons will have the possibility to apply for registration as well. This factor potentially may give rise to the number of applications filed in bad faith.

Naturally, the mere filing of an application does not guarantee its state registration. As previously mentioned the Russian PTO carries out examination both on absolute and relative grounds. Nevertheless, there is an opportunity for brand owners to take a proactive approach in defending their trademarks in the nature of filing observation letters during examination to try to avoid fairly costly and time-consuming post registration invalidity actions. An observation letter being a kind of informal opposition that may be filed in respect of pending applications is a very effective tool to prevent a third party's mark from being registered. The observation letter reflects the brand owner's concern in connection with the third party's filing.

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

“
These instruments may be used at different stages either to prevent registration of bad faith filing or to invalidate the registered trademark.
 ”

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 cancellation 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 cancellation 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.

Contact

Gorodissky and Partners

Tel: +7 495 9376116

pat@gorodissky.com

<https://www.gorodissky.com/>



Gorodissky & Partners

Practicing since 1959

PATENTS, TRADE MARKS, DESIGNS
 UTILITY MODELS, COPYRIGHTS
 LITIGATION, IP DUE DILIGENCE
 ANTI-COUNTERFEITING, MEDIA-
 TION, LICENSES, SEARCHES
 TRANSLATIONS

Moscow, St. Petersburg
 Kazan, Ekaterinburg
 N.Novgorod, Krasnodar
 Vladivostok, Samara
 Novosibirsk, Perm
 Sarov, Dubna, Ufa, Kiev



GORODISSKY

Head Office:

B. Spasskaya Str., 25, bldg. 3

Moscow 129090, Russia

Tel.: +7(495) 937 6116

Fax: +7(495) 937 6104/6123

E-mail: pat@gorodissky.ru

www.gorodissky.com



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.



Carina Gommers

ECTA

Caring for a balance of IP rights

The ECTA Annual Conference is one of the premier gatherings in the field of intellectual property, held for the first time in 1986, and now a must-attend event for up to 900 IP colleagues from around the world.

After the success of last year's memorable Conference in Copenhagen, we look forward to exploring the magic of IP in Prague, a city steeped in the alchemical arts, for the **41st ECTA Annual Conference**. You can count on the usual friendly atmosphere of the ECTA Family and on a distinctive programme in which I am sure everyone will find something of interest. Let me give you a sneak peek!

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 Slovyansk (Slavic) 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



We will then cross the lines into dark magic in a comparative session with the US on trademark applications made in bad faith.



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!

Contact

ECTA

Rue des Colonies 18/24, Box 8,
8th Floor, BE-1000, Brussels, Belgium

Tel: +32 2 513 52 85

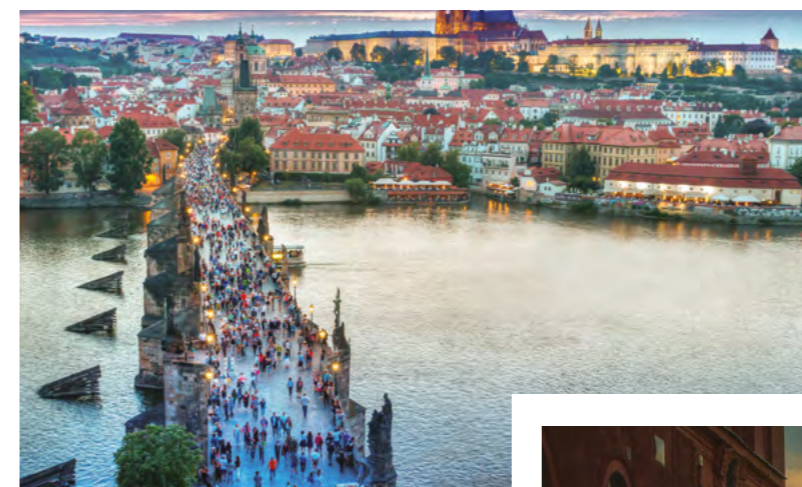
Fax: + 32 2 513 09 14

ecta@ecta.org

www.ecta.org

LinkedIn: ECTA (Official)

Twitter: @ECTABrussels





Directory of Services

ARGENTINA



O'Conor & Power

O'Conor & Power's trademark and patent practice group has wide experience in handling portfolios for international and domestic companies in Argentina and Latin America. Our services in the region include searches, filing and registration strategies, prosecution, opposition, renewals, settlement negotiations, litigation, enforcement and anti-counterfeiting procedures, recordal of assignments, licences, registration with the National Custom Administration, general counselling in IP matters, and counselling in IP matters in Argentina and the region.

Address: San Martín 663, 9th Floor, (C1004AAM) Buenos Aires, Argentina
Tel/Fax: 005411 4311-2740/005411 5368-7192/3
Website: www.oconorpower.com.ar
E-mail: soc@oconorpower.com.ar
ocp@oconorpower.com.ar
oconor@oconorpower.com.ar

ARMENIA



Yakhnina & Partners

The team at "Yakhnina & Partners" comprises of highly-qualified patent and trademark attorneys, lawyers and technical experts. We represent our clients' interests in Armenia, Russia, at Eurasian Patent Office, and cooperate with partners and associates in other Eurasian countries: Georgia, Belarus, Ukraine, Kazakhstan, Azerbaijan, Kyrgyzstan, Turkmenistan, Uzbekistan, Moldova, Tajikistan, as well as Baltic states. Our attorneys are member of INTA, FICPI, AIPPI, LESI, ECTA, PTMG.

Address: Yerevan, Republic of Armenia
Tel: +374 91 066393
Email: Armenia@vakhnina.com
Website: <http://about.vakhnina.com>
Contact: Dr. Alexey Vakhnina, Partner

BAHRAIN



United Trademark & Patent Services

International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services
Office 21, Sabha Building No. 338
Road 1705, Block 317 Diplomatic Area,
Manama, Bahrain
Website: www.utmps.com
Email: Bahrain@unitedtm.com &
unitedtrademark@unitedtm.com
Contact: Talal F.Khan & Mr Imad

BOLIVIA



Landivar & Landivar

Established by Gaston Landivar Iturricha in 1961, Landivar & Landivar is a pioneer firm in the field of Intellectual Property in Bolivia. Our international reputation was gained through a competent and complete legal service in our area of specialization. Our firm has grown into a Chain of Corporate Legal Services and Integral Counseling, with the objective of guiding national and international entrepreneurs and business-people towards the success of their activities.

Address: Arce Ave, Isabel La Catolica Square, N° 2519, Bldg. Torres del Poeta, B Tower, 9th floor, off. 902. La Paz, Bolivia, South America
Tel/Fax: +591-2-2430671 / +591 79503777
Website: www.landivar.com
Email: ip@landivar.com - info@landivar.com
Contact: Martha Landivar, Marcial Navia

CARIBBEAN



CARIBBEAN TRADEMARK SERVICES

Law Office of George C.J. Moore, P.A.
Caribbean Trademark Services, founded by George C.J. Moore in 1981, provides a single contact source of protecting trademarks and patents in the Caribbean. Covering 29 countries, including Belize, Bermuda, Costa Rica and Cuba; a bilingual staff provides IP services tailored to the diverse jurisdictions. Experienced staff members and volume transactions, services are efficient making our single contact, long established source for the Caribbean most cost effective.

Address: 2855 PGA Boulevard, Palm Beach Gardens, Florida 33410, USA
Tel: +1 561 833-9000
Fax: +1 561 833-9990
Contact: Michael Slavin
Website: www.CaribbeanTrademarks.com
Email: IP@CaribbeanTrademarks.com

COLOMBIA



VERA ABOGADOS ASOCIADOS S.A.

VERA ABOGADOS was founded 50 years ago to attend to legal needs of the business sector in the area of IP. Today they provide their services to all fields of law. The law firm is a reference in the Andean community and they are part of international associations such as INTA, ASIPI, ABPI and ASPI. They were ranked in 2022 by Leaders League as a highly recommended Colombian law firm and in addition, they are a member of PRAGMA, the International Network of Law Firms.

Tel: +57 60-1 3176650
+57 60-1 3127928
Website: www.veraabogados.com
Email: info@veraabogados.com
Contact: Carolina Vera Matiz, Natalia Vera Matiz

CZECH REPUBLIC



Cermak a spol

Čermák a spol. is a leading IP law firm in the Czech Republic and Slovakia, providing services in all areas of IP law, including patents, trademarks, utility models, industrial designs, unfair competition and others. We have a qualified team of lawyers for both IP prosecution and litigation including litigation in court. Our strengths is a unique combination of experienced and qualified patent attorneys and lawyers.

Address: Čermák a spol, Elišky Peškové 15
150 00 Praha 5, Czech Republic.
Website: www.cermakaspol.com
Email: intelprop@apk.cz
Contact: Dr. Karel Cermak - Managing Partner
Dr. Andrea Kus Povazanova - Partner

CZECH REPUBLIC



Traplová Hakr Kubát Law and Patent Offices

TRAPLOVÁ HAKR KUBÁT is a well based IP boutique with a long-term tradition in representing both the Czech and foreign clients in the patent, utility models, industrial designs, trademarks, copyright, unfair competition and anti-counterfeiting issues.

Address: P. O. Box 38, 170 04 Prague 74
Přístavní 24, 170 00 Prague 7
Tel: + 420 266 772 100
Fax: + 420 266 710 174
Website: www.thk.cz
Email: thk@thk.cz
Contact: Jana Traplová, Attorney at Law
Tomáš Pavlica, European Patent Attorney

CYPRUS



Christodoulos G. Vassiliades & Co LLC

The Firm employs over 200 professionals, comprising of qualified lawyers, legal and tax consultants, paralegals and accountants, all dedicated to the provision of services with professionalism, efficiency and integrity. We offer a fully integrated IP service, providing advice and professional support in relation to copyright, trademarks, patents, designs, domain names, as well as unfair competition and protection of other confidential information.

Address: 15, Agiou Pavlou Street, Ledra House,
Agios Andreas, Nicosia 1105, Cyprus
Tel/Fax: +357 22 55 66 77
Website: www.vasslaw.net
Email: maria.kyriacou@vasslaw.net
Contact: Maria H. Kyriacou



Directory of Services

Directory of Services

DJIBOUTI



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services
Djibouti Branch Djibouti, Rue Pierre Pascal
Q.commercial Imm, Ali Warki, Djibouti

Website: www.utmps.com
Email: Djibouti@unitedtm.com &
unitedtrademark@unitedtm.com
Contact: Imad & Faima Al Heyari

DOMINICAN REPUBLIC



WDA International Law Firm
Intellectual Property

For over 25 years we have provided excellence in Intellectual Property protection to worldwide renowned companies including the most iconic pharmaceutical, beauty and clothing, beverages and motion pictures companies.

Our main practice is devoted to Intellectual Property which specializes in docketing maintenance of trademarks and patents and litigation attorneys of high profile IPR infringements, border protection and counterfeiting cases in Dominican Republic.

Tel: 809-540-8001
Website: www.wdalaw.com
Email: trademarks@wdalaw.com
Contacts: LIC. Wendy Diaz
LIC. Frank Lazala
Whatsapp: 829-743-8001

DOMINICAN REPUBLIC




Guzmán Ariza, Attorneys at Law
ATTORNEYS AT LAW

Guzman Ariza is the largest law and consulting firm in the Dominican Republic. Founded in 1927, we have extensive experience in protecting local and international clients' intellectual property rights, including trademarks, trade names, copyrights, and patents. We are your one-stop shop for all of your IP needs in the Dominican Republic.

Our services include: • Trademarks and trade names
• Patents • Industrial design • Sanitary • Copyrights
• IP management and IP audit • Litigation

Tel: +1 809 255 0980
Fax: +1 809 255 0940
Website: www.drlawyer.com
Email: info@drlawyer.com
Contact: Fabio Guzmán Saladín, Partner
fabio@drlawyer.com
Leandro Corral, Senior Counsel
lcorral@drlawyer.com

JORDAN



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services
Suite 7, 2nd Floor, Chicago Building,
Al Abdali, P.O. Box 925852, Amman,
Jordan

Website: www.utmps.com
Email: jordan@unitedtm.com &
unitedtrademark@unitedtm.com
Contact: Mrs Fatima Al-Heyari

LEBANON



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services
6th Floor, Burj Al Ghazal Building, Tabaris,
P. O. Box 11-7078, Beirut, Lebanon

Website: www.utmps.com
Email: lebanon@unitedtm.com &
unitedtrademark@unitedtm.com
Contact: Hanadi

MACAU, CHINA



BN Intellectual Property Services

BN Intellectual Property Services has more than 15 years of experience and has offices in Macau, Portugal, Singapore and a support office in Mainland China. BNIP specializes in prosecution, licensing and protecting trademarks, patents and industrial designs rights in Macau.

We pride ourselves on our efficiency with the automation of more than 70% of our tasks and ability to recognize our clients concerns and practices. As a result, we handle our clients' needs quickly and effectively.

Tel: +853 2833 2828
Fax: +853 2833 3366
Website: www.bn-ip.com
Email: ip@bn-ip.com
Contact: Jenny Xiao

GUATEMALA



Ideas Trademarks Guatemala, S.A.

Ideas is a firm specialized in the defense of intellectual property rights, offering advice on all kinds of issues related to them and in the management of portfolios of distinctive signs and patents, at competitive prices, in the Central American and Caribbean region.

Ideas is focused on meeting the needs and solving the problems of its clients, setting clear expectations and obtaining creative solutions with minimal exposure and cost-effective. Proactivity has determined our constant growth and modernization, maintaining a high standard of quality and satisfaction in our professional services.

Tel: +502 2460 3030
Website: <https://www.ideasips.com/?lang=en>
Email: guatemala@ideasips.com
Contact: Gonzalo Menéndez, partner,
gmenendez@ideasips.com
Gustavo Noyola, partner,
noyola@ideasips.com

GUATEMALA



Merida & Asociados

The firm provides services throughout the range of different legal matters, specializing in the banking industry both nationally and internationally, business law, banking law, trademarks and patents, litigation, notary law, litigation and arbitration. We are a very well-known law firm for Intellectual Property in Guatemala. Our office serves clients from abroad, including clients from Europe and the United States, as well as Japan and other countries.

Address: 20 calle 12-51 "A" zona 10,
Guatemala City, 01010, Guatemala
Armando Mérida, Section 019170,
P.O. Box 02-5339, Miami, Florida,
33102-5339, USA
Tel: (502) 2366 7427
Website: <http://www.meridayasociados.com.gt/en>
Email: corporativo@meridayasociados.com.gt
Contact: Armando Merida

INDIA



Chandrakant M Joshi

Our law firm has been exclusively practicing Intellectual Property Rights matters since 1968. Today, Mr. Hiral Chandrakant Joshi heads the law firm as the senior most Attorney. It represents clientele spread over 35 countries. The law firm conducts search, undertakes registration, post-registration IP management strategies, IP valuation, infringement matters, domain name disputes and cyber law disputes of patents (including PCT applications), trademarks, industrial designs and copyrights.

Address: Solitaire - II, 7th Floor, Link Road,
Malad (West), Mumbai - 400 064, India
Tel: +91 22 28886856 / 57 / 58 / 64
Fax: +91 22 28886859 / 65
Website: www.cmjoshi.com
Email: mail@cmjoshi.com / cmjoshi@cmjoshi.com /
patents@cmjoshi.com / designs@cmjoshi.com /
trademarks@cmjoshi.com


MAURITIUS



Yusuf S Nazroo
IP Agent/Consultant
Member of CITMA-INTA-APAA-AIPPI

Address: 12 Frère Félix De Valois Street, Port Louis,
Mauritius

Tel: + 230 57 14 09 00
Fax: + 230 212 27 93
Website: <http://yn-trademark.com>



*Greetings from
Mauritius the
Rainbow Island*

MEXICO



Goodrich Riquelme Asociados

Our staff of attorneys, engineers and computer specialists help adapt foreign patent specifications and claims to Mexican law, secure patent inventions and trademark registrations and maintain them by handling the necessary renewals. Our computer system, which is linked to the Mexican Patent and Trademark Department, permits us to provide our clients with a timely notice of their intellectual property matters. We also prepare and register license agreements.

Address: Paseo de la Reforma 265, M2,
Col. Y Del. Cuauhtemoc, 06500 Mexico, D.F.

Tel: (5255) 5533 0040
Fax: (5255) 5207 3150
Website: www.goodrichriquelme.com
Email: maicentral@goodrichriquelme.com
Contact: Enrique Diaz
Email: ediaz@goodrichriquelme.com

MEXICO CITY



TOVAR & CRUZ IP-LAWYERS, S.C.

We are a specialized legal firm providing intellectual property and business law services. Founded in 2009. The purpose is that our clients not only feel safe, besides satisfied since their business needs have been resolved, so, our professional success is also based on providing prompt response and high quality, personalized service. "Whatever you need in Mexico, we can legally find the most affordable way"

Tel: 525528621761 & 525534516553
Website: www.tciplaw.mx
Email: ecruz@tciplaw.mx
mtovar@tciplaw.mx
contactus@tciplaw.mx
Contact: Elsa Cruz, Martin Tovar

INDIA




L.S. DAVAR & CO.
PATENT AND TRADEMARK ATTORNEYS

We are India's oldest Intellectual Property and Litigation Firm. Since 1932, we have been as a trusted IP partner of Global Large and Mid-size companies and foreign IP law firms. We have been widely acknowledged by Govt. of India. In the last 90 years, we have retained number one position in India in not only filing the Patents, Designs, Trademarks, Copyright, and Geographical Indications but also in getting the grants.

Tel: 033- 2357 1015 | 1020
Fax: 033 - 2357 1018
Website: www.lsdavar.com
Email: mailinfo@lsdavar.in
Contact: Dr Josphita Davar Khemani
Mrs. Dahlia Chaudhuri


INDIA



R. K. DEWAN & CO.
ADVOCATES, TRADEMARK & PATENT ATTORNEYS
INDIA
Established in 1942

**Maximum Leverage
Minimum Stress**

New Delhi Mumbai
Chennai Kolkata
Pune Bengaluru
Indore China



www.rkdewan.com
dewan@rkdewanmail.com

ISRAEL



Gold Patents and Financial Services (1992) Ltd.

Gold Patents and Financial Services (1992) Ltd. is an intellectual property solution provider firm that operates in Israel as well as worldwide. We specialize in providing evaluation and analyses of IP portfolios; prosecuting and drafting complex patent, design, and trademark applications; freedom-to-operate, due diligence, patentability, validity and infringement opinions. We provide high quality services and solutions that support our clients' business goals and deliver superior IP services in a timely and cost-effective manner.

Address: 15 Yohanan Hasandler St., Haifa 31251
Tel/Fax: +972-48110007/ +972-46892283
Website: www.gold-patent.co.il
Email: office@gold-patent.co.il
Contact: Marganit Goldraich

MOROCCO



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services
58, rue Ibn Battouta 1er étage,
no 4. Casa Blanca, Morocco

Website: www.utmps.com
Email: morocco@unitedtm.com &
unitedtrademark@unitedtm.com
Contact: Yawar Irfan Khan

NEPAL



Pioneer Law Associates Pvt. Ltd.

Pioneer Law was founded in 1982 and has been providing different IP services ranging from protection of IP to enforcement and IP litigation. Our IP department is headed by Ms. Anju Upreti Dhakal, an IP attorney with more than 23 years of experience. Through our understanding of the Nepalese markets, the institutional knowledge that we have acquired over the years and our solution-oriented approach, we provide best legal services to our clients. We are also members of APAA, INTA and AIPPI.

Address: Pioneer House, 246 Sahayog Marg,
Anamnagar, Kathmandu, Nepal
Tel/Fax: +977-01- 5705340, 5707102
Website: www.pioneerlaw.com
Email: anju@pioneerlaw.com
Contact: Ms. Anju Upreti Dhakal

NIGERIA



S. P. A. AJIBADE & CO.

S. P. A. Ajibade & Co., is a leading corporate and commercial law firm established in 1967. The firm provides cutting-edge services to both its local and multinational clients in the areas of Dispute Resolution, Corporate Finance & Capital Markets, Intellectual Property & Technology, Telecommunications, Real Estate & Succession, and Energy & Natural Resources.

Address: Suite 301, SPAACO House, 27A Macarthy Street, Onikan, Lagos, Nigeria.

Tel: +234 1 4605091; +234 1 8118903060
Fax: +234 1 4605092
Website: www.spajibade.com
Email: lagosoffice@spajibade.com
Contact: John Onyido - Partner and Head of the IP, Technology & Telecommunications Dept
Bolaji Gabari - Associate Partner, Abuja Office.



Directory of Services

Directory of Services

OMAN



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services Suite No. 702, 7th Floor, Commercial Centre, Ruwi Muscat, Sultanate of Oman, P. O. Box 3441, Postal Code 112 Ruwi, Sultanate of Oman

Website: www.utmps.com
Email: oman@unitedtm.com & unitedtrademark@unitedtm.com
Contact: S.Maqbool & T.F. Khan

PAKISTAN



United Trademark & Patent Services
International Intellectual Property Attorneys


United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: 85 The Mall Road, Lahore 54000, Pakistan

Tel: +92 42 36285588, +92 42 36285590, +92 42 36285581, +92 42 36285584
Fax: +92 42 36285585, +92 42 36285586, +92 42 36285587

Website: www.utmps.com & www.unitedip.com
Email: unitedtrademark@unitedtm.com
Contact: Yawar Irfan Khan, Hasan Irfan Khan

PERU



Arturo Díaz & Asociados
— ABOGADOS | ATTORNEYS AT LAW —

Arturo Diaz & Asociados
Arturo Díaz & Asociados, firm specialized in the protection of Intellectual Property Rights since 2007. The Experience has allowed us to know a series of legal instruments available to protect your ideas in matters of Industrial and Intellectual Property, but especially the protection, monitoring, evaluation of controversies and litigation, Investigation and Criminal Actions against counterfeiting and reproduction, and makes us capable today of preventing and combating, if applicable, with the effective protection of Intellectual Property.

Tel: 511 620 446 / 511 255 4752
Fax: 511 255 4752
Website: www.ardiazabogados.com
Email: info@ardiazabogados.com
Contact: Arturo O. Diaz – adiaz@ardiazabogados.com
Giovanna Yllanes – gylanes@ardiazabogados.com


SLOVAKIA



Boldiz Law Firm s.r.o.
Boldiz Law Firm is a boutique law firm which provides high quality services and solutions that support client's needs in national (Slovak) and European trademark & design law in a cost-efficient way. We are a full-service brand protection law firm, qualified to assist with all types of legal services related to trademarks and designs, such as registrations, oppositions, litigation, IP enforcement services and many others.

Tel: +421 915 976 275
Website: www.boldiz.com/en
Email: info@boldiz.com
Contact: Dr. Ján Boldizsár


SRI LANKA



Julius & Creasy
Julius and Creasy is one of the oldest civil law firms in Sri Lanka. Founded in 1879, the firm has established itself on rich tradition and the highest professional principles. Julius and Creasy's wealth of expertise and experience in a wide range of specialised fields of Law enables it to offer innovative legal and business solutions to a diverse, sophisticated and high-profile clientele. The Intellectual Property practice of the firm includes enforcement, management and transactional matters. The firm has acted for several Fortune 500 companies and is Sri Lanka correspondent of several firms in Europe, USA and Asia.

Address: No. 371, R A De Mel Mawatha, Colombo 3, Sri Lanka
Tel: 94 11-2336277
Website: www.juliusandcreasy.com
Email: anomi@juliusandcreasy.lk
Contact: Mrs Anomi Wanigasekera

SRI LANKA



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: U.T.P.S Lanka (Pvt) Ltd 105, Hunupitiya Lake Road, Colombo – 2, Sri Lanka

Website: www.utmps.com
Email: srilanka@unitedtm.com & unitedtrademark@unitedtm.com
Contact: Krishni & M.F. Khan

PHILIPPINES



OPTMARKS
Brand Protection & Intellectual Property Consultancy PH

Dynamic and innovative, OPTMARKS Brand Protection & IP Consultancy is the Philippines' emerging leader in intellectual property. Committed to fostering our clients' success, our firm delivers pinpointed and intuitive IP strategies as we partner with our clients in taking full control of their IP portfolios and provide them with efficient, technology-driven, and forward-looking IP solutions.

Tel: +63 (02) 79178198
Website: www.optmarks.com
Email: info@optmarks.com
Contact: Arjel P. de Guzman

POLAND



Sigeon IP, Grzelak & Partners
Grzelak & Partners

Sigeon IP, Grzelak & Partners are professionals specializing in the protection of intellectual property rights, as well as in broadly defined patent, trademark, design, legal, IP- related business, management and strategic consulting. Thanks to the close cooperation within one team of the Polish and European Patent & Trademark Attorneys, Attorneys-at-Law and business advisors, we offer the highest quality "one-stop-shop" service in Poland and Europe.

Tel: +48 22 40 50 401/301
Fax: +48 22 40 50 221
Website: www.sigeon.pl/en
Email: ip@sigeon.pl
Contacts: anna.grzelak@sigeon.pl (patents, management & international cooperation)
tomasz.gawrylczyk@sigeon.pl (trademarks, designs & legal)

QATAR



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services Ahmed Al-Misnad Building, Building No. 241, 2nd Floor, Office 9, Street No. 361, Zone No. 37, Mohammad Bin Thani Street, Bin Omran P.O.Box : 23896 Doha

Website: www.utmps.com
Email: qatar@unitedtm.com & unitedtrademark@unitedtm.com
Contact: Ahmed Tawfik & M.Y.I. Khan

TAIWAN, ROC



Deep & Far Attorneys-at-law
Deep & Far attorneys-at-law deal with all phases of laws with a focus on IPRs, and represent some international giants, e.g. InterDigital, MPS, Schott Glas, Toyo Ink, Motorola, Cypress. The patent attorneys and patent engineers in Deep & Far normally are generally graduated from the top five universities in this country. More information regarding this firm could be found from the website above-identified.

Address: 13 Fl., 27 Sec. 3, Chung San N. Rd., Taipei 104, Taiwan
Tel/Fax: 886-2-25856688/886-2-25989900
Website: www.deepfar.com.tw
Email: email@deepfar.com.tw
Contact: C.F. Tsai, Yu-Li Tsai

TAIWAN, ROC



Lewis & Davis
LEWIS & DAVIS offers all services in the IPRs field, including prosecutions, management and litigation of Trademarks, Patent, Designs and Copyright, and payment of Annuity and Renewal fee. Our firm assists both domestic and international clients in Taiwan, China, Hong Kong, Macau and Japan. Our experienced attorneys, lawyers, and specialists provide professional services of highest quality while maintaining costs at efficient level with rational charge.

Tel: +886-2-2517-5955
Fax: +886-2-2517-8517
Website: www.lewisdavis.com.tw
Email: wtoip@lewisdavis.com.tw
lewis@lewisdavis.com.tw
Contact: Lewis C. Y. HO
David M. C. HO

TANZANIA



Bowmans Tanzania Limited
THE VALUE OF KNOWING

Bowmans Tanzania Limited offers full IPR services in Tanzania and the rest of countries in the East Africa and ARIPO region member states. We have an experienced team of lawyers headed by Audax Kameja, a Senior Partner of 35+ years of experience, and Francis Kamuzora, with an experience of 15+ years. We have been a firm of choice, and have a track record in advising and representing some of the biggest and prestigious brand owners in IPR litigation and in other non-contentious transactions.

Website: www.bowmanslaw.com
Email: francis.kamuzora@bowmanslaw.com
Contacts: Francis Kamuzora
Audax Kameja

To list your firm in this section, please email katie@ctclegalmedia.com

RUSSIA




Yakhnina and Partners

The team of Yakhnina and Partners, one of the leading IP firms in Russia, comprises of highly-qualified patent and trademark attorneys, lawyers and technical experts. We represent our clients' interests in Russia and at Eurasian Patent Office, and also cooperate with partners and associates in other Eurasian countries as Georgia, Ukraine, Belarus, Kazakhstan, Armenia, Azerbaijan, Kyrgyzstan, Turkmenistan, Uzbekistan, Moldova, Tajikistan, as well as Baltic states. Member of INTA, FICPI, AIPPI, LESI, ECTA, PTMG

Address: Moscow, Russia
Tel: +7-495-946-7075, +7-495-231-4840
Fax: +7-495-231-4841
Website: www.yakhnina.ru
Email: ip@yakhnina.ru
Contact: Dr. Tatyana VAKHNINA
Dr. Alexey VAKHNIN

SAUDI ARABIA



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services 30th Street, Olaya Opposite to Madarris Al Mustaqbil, P.O. Box 15185, Riyadh 11444, Kingdom of Saudi Arabia

Website: www.utmps.com
Email: saudia@unitedtm.com & unitedtrademark@unitedtm.com
Contact: Dr.Hasan Al Mulla & Justice R Farrukh Irfan Khan

TANZANIA



United Trademark & Patent Services
International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services Shauri Mayo Area, Pugu Road, Dar-Es-Salaam, Tanzania

Website: www.utmps.com
Email: tanzania@unitedtm.com & unitedtrademark@unitedtm.com
Contact: Mr Imad & Fatima Al Heyari

TÜRKİYE



Destek Patent
Your IP Partner

Destek Patent was established in 1983 and has been a pioneer in the field of Intellectual Property Rights, providing consultancy services in trademark, patent and design registrations for almost 40 years. Destek Patent provides its clients with excellence in IP consultancy through its 16 offices located in Türkiye, Switzerland, Kazakhstan, UAE and the UK. Besides its own offices, Destek Patent also provides IP services in 200 jurisdictions via its partners and associates.

Address: Spine Tower Saat Sokak No: 5 Kat:13 Maslak-Sarıyer / İstanbul - 34485 Türkiye
Tel: +90 212 329 00 00
Website: www.destekpatent.com
Email: global@destekpatent.com
Contact: Simay Akbaş
simay.akbas@destekpatent.com

UNITED ARAB EMIRATES



Marks n Brands Intellectual Property

MnB IP is a specialized IP firm providing high quality services including the registration and maintenance of trademarks, industrial designs, patents and copyrights in the United Arab Emirates, Saudi Arabia, Oman, Bahrain, Kuwait and across the MENA (Middle East & North Africa) region for both the individual and corporate clients. We are committed to provide high quality professional services through personal attention to the clients' needs.

Tel: +971 56 936 7973
Website: www.marksnbrandsip.com
Email: info@marksnbrandsip.com
Contact: Mahin Muhammed

Directory of Services

U.A.E.



United Trademark & Patent Services International Intellectual Property Attorneys

United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.

Address: United Trademark & Patent Services
Suite 401-402, Al Hawaii Tower,
Sheikh Zayed Road, P.O. Box 72430,
Dubai, United Arab Emirates

Website: www.utmps.com
Email: uae@unitedtm.com &
unitedtrademark@unitedtm.com
Contact: M.F.I. Khan, S.M. Ali & Maria Khan

UGANDA



Sipi Law Associates

The firm provides world class IP services in Uganda and the ARIPO region, specialising in Trademark, patent and copyright protection. Hundreds of clients have recognised our quality of service quick turnaround time and competitive fees. The firm provides transactional advice for IP filings as well as counsel on how to commercialise and enforce rights in Uganda in mergers, acquisitions, franchises or distributorship arrangements.

SIPI Law Associates is a proud member of INTA and GALA.

Tel/Fax: 256-393272921 OR 256-752403763
Website: <https://sipilawuganda.com/>
Email: info@sipilawuganda.com
Contact: Paul Asiimwe and Dinnah Kyasimire

UKRAINE



EIMar-IP Agency

EIMar-IP Agency was founded in 2010 and specializes in the intellectual property rights protection in Ukraine. Providing of services by specialists with more than 15 years' experience, professional competence and education, competitive prices with client budget orientation allow us to provide our clients with the range of IP services including representation before the Trademark and Patent Office, the Board of Appeal and in court procedures.

Tel: +38 093 587 91 25
Website: <https://elmar-ip.com/>
Email: elmarip33@gmail.com &
clients@elmar-ip.com
Contact: Mrs. Elvira Volkova
Mrs. Julia Postelnik

UKRAINE



Pakharenko & Partners

Pakharenko & Partners provides full IP service coverage in Ukraine, CIS countries and Baltic states and has offices in Kyiv and London. We pride ourselves on an exclusive expertise and experience in the fields of IP law, anti-counterfeiting and anti-piracy, pharmaceutical law, competition law, advertising and media law, corporate law, litigation and dispute resolution.

Address: P.O.Box 78, 03150 Kyiv, Ukraine
Visiting: Business Centre 'Olimpiysky',
72 Chervonoarmijska Str., Kyiv 03150,
Ukraine

Tel: +380(44) 593 96 93
Fax: +380(44) 451 40 48
Website: www.pakharenko.com
Email: pakharenko@pakharenko.com.ua
Contact: Antonina Pakharenko-Anderson
Alexander Pakharenko

VIETNAM



ELITE LAW FIRM

ELITE LAW FIRM is very pleased to assist our esteemed clients in Registration of their Intellectual property rights Safely, Effectively and Handle IP Rights disputes Quickly So that Clients can Do Business Strongly and Successfully Develop.

Tel: (+84) 243 7373051
Hotline: (+84) 988 746527
Website: <https://lawfirmelite.com/>
Email: info@lawfirmelite.com
Contact: Nguyen Tran Tuyen (Mr.)
Patent & Trademark Attorney
tuyen@lawfirmelite.com
Hoang Thanh Hong (Ms.)
Manager of IP Division
honght@lawfirmelite.com



VIETNAM



Pham & Associates

Established in 1991, staffed by 110 professionals including 14 lawyers and 34 IP attorneys, Pham & Associates is a leading IP law firm in Vietnam. The firm has been being the biggest filers of patents, trademarks, industrial designs and GIs each year and renowned for appeals, oppositions, court actions, out-of-court agreements and handling IP infringements. The firm also advises clients in all aspects of copyright and other matters related to IP.

Tel: +84 24 3824 4852
Fax: +84 24 3824 4853
Website: www.pham.com.vn
Email: hanoi@pham.com.vn
Contact: Pham Vu Khanh Toan, Managing Partner,
General Director
Tran Dzung Tien, Senior IP Consultant

VIETNAM



Tri Viet & Associates

Tri Viet & Associates is a registered and fully licensed IP & LAW FIRM based in Hanoi, Vietnam. The firm provides a full range of IP services, strongly focuses on PATENT and PCT services, in a wide range of industries and modern technologies, in Vietnam, Laos, Cambodia, Myanmar, and other jurisdictions upon client's inquiries.

Tri Viet & Associates is a member of AIPPI, INTA, APAA, VBF, HBA, VIPA.

Tel: +84-24-37913084
Fax: +84-24-37913085
Website: www.trivietlaw.com.vn
Email: info@trivietlaw.com.vn
Contact: Nguyen Duc Long (Mr.), Managing Partner –
Reg. Patent & Trademark Attorney
LinkedIn: <https://www.linkedin.com/in/longnguyen-tva>

Subscribe now!

A subscription to *The Trademark Lawyer* magazine will ensure that you and your colleagues have detailed information on all the most important developments within the international trademark law industry.

The Trademark Lawyer magazine is dedicated only to the trademark industry and is written by trademark experts for trademark professionals worldwide.

A subscription includes a hard copy and an electronic copy which can also be read easily on your smartphone or tablet.

Tel: +44(0)20 7112 8862 Fax to: +44(0)20 7084 0365
E-mail: subscriptions@ctclegalmedia.com



O'CONOR & POWER
ARGENTINA

EFFECTIVE PROTECTION
OF IP RIGHTS
IN ARGENTINA
AND LatAm

CELEBRATING 10 YEARS
OF GOING AHEAD AND BEYOND



San Martín 663, 9th Floor
(1004) Buenos Aires | Argentina

ocp@oconorpower.com.ar
www.oconorpower.com.ar



Powerful IP management software



Looking for user-friendly software that makes IP management easy?

We have dedicated systems for law firms and corporates at every scale— from small start-ups to multi-office enterprise teams and everything in between.

Choose Equinox for secure, reliable software that boosts your efficiency.

Explore software

Learn more about
Equinox software:

equinox-ipms.com