

The Trademark

Issue 3 2023

GLOBAL REACH, LOCAL KNOWLEDGE

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Lawyer

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The Trademark Lawyer
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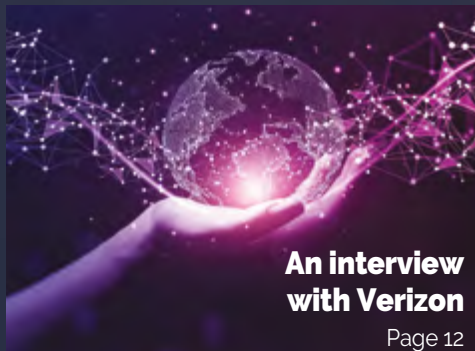
10

YEARS ANNIVERSARY



**Generative AI -
apocalypse or
opportunity?**

Page 8



**An interview
with Verizon**

Page 12

**Whose ARMOUR
is stronger?**

Page 44





THE TRADEMARK LAWYER

Issue 3 2023

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Editor's welcome



Welcome to our 10th anniversary edition of *The Trademark Lawyer* magazine. We would like to take the opportunity to thank our readers and clients for your continued support of the magazine throughout the years; we look forward to continuing these relationships for many more years to come!

This issue is packed full of hot topics including an assessment of whether generative AI is an opportunity or an apocalypse for IP as we know it; an

**An assessment
of whether
generative AI is
an opportunity or
an apocalypse for IP.**

analysis of AI's use of copyrighted works; a review of the recent UNDER ARMOUR case that saw conflict between two apparel brands; an update on trademark warehousing in China; an innovative solution for trademark lifecycles; and much more!

Our guest interviewee this issue is Patrick Flaherty, Senior Managing Associate General Counsel of IP Law & Policy Group at Verizon, in which he discussed

the value of branding for technological innovators and the importance of diverse counsel.

Our *Women in IP Leadership* segment features Maria Cecilia, Partner at CorralRosales, and Tomoe Takahashi, Partner at Hogan Lovells Japan. Contact us to find out how you can support the segment.

Don't forget to subscribe to our newsletter to stay up-to-date with the latest IP news.

Enjoy the issue!

Faye Waterford
Faye Waterford, Editor

Mission statement

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

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Contents

Issue 3 2023

6 Meet the Editorial Board

Meet our Editorial Board members who help determine the direction of this magazine.

8 Cover Story: Generative AI and intellectual property – apocalypse or opportunity?

Rhett Barney, Partner at Lee & Hayes, details the risks associated with a technological revolution while highlighting the available benefits that new technologies can offer in the plight to protect IP rights.

12 An interview with Patrick Flaherty: Senior Managing Associate General Counsel of IP Law & Policy Group, Verizon

Patrick sits down with *The Trademark Lawyer* to discuss his experiences at Verizon, the value of branding for technological innovators, and the importance of having diverse outside counsel.

15 Alternative endings to the trademark lifecycle

Gavin Hyde-Blake and Spencer Vold-Burgess, co-founders of RedCoin IP, introduce the new solution to monetize trademarks at the end of their lifecycle while offering a second lease of life to significant marks.

19 Trademark distinctiveness issues in registration application procedure

Jiuyang ZHOU of Beijing Sanyou Intellectual Property Agency Ltd. provides practical guidance to avoid registration refusal on the grounds of lack of distinctiveness, assessing name, design, and model.

22 Domain name dispute resolution: the Portuguese and international context

Ricardo Costa Macedo and João Bertholo Meireles of Caiado Guerreiro discuss the protection – or lack thereof – for domain names in relation to registered trademarks.

15



25

Women in IP Leadership:

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

Featuring: Maria Cecilia, Partner at CorralRosales, and Tomoe Takahashi, Partner at Hogan Lovells Japan.



31

Rankings: Asia Pacific

10 of the best law firms from each of the top Asia Pacific jurisdictions, including China, India and Japan.



42 Jurisdictional Briefing, US: Penguins, Groggu, and the color orange: the implications of artificial intelligence and its use of copyrighted materials

Michelle Ciotola, Partner at Cantor Colburn LLP, evaluates the ever-evolving debate surrounding AI-created works according to US Copyright Law from both a use and generation perspective.

44



44 Whose ARMOUR is stronger? A tussle between apparel moguls

Manisha Singh, Partner, and Anmol Bahuguna, Associate, of LexOrbis dissect the recent *Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd.* case to assess the claims of passing off and deceptive similarities with key takeaways for protecting fashion trademarks.

48 China's efforts to combat trademark warehousing

Nick Ji, Partner at Corner Stone & Partners, reviews the changes to Chinese trademark law in recent years to tackle the bad faith filings and trademark warehousing with an assessment of new trends.

50 An update on the Trademark Modernization Act

Raffi Zerounian and Justin Thiele of Hanson Bridgett review the TMA's non-use cancellation procedures and how expungement and reexamination petitions have fared followed by practical tips on how to prepare successful petitions.

55 Directory of services

An A to Z list of the international law firms who provide IP related services.

8





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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.



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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.



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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.



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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.



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



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Generative AI and intellectual property – apocalypse or opportunity?

Rhett Barney, Partner at Lee & Hayes, details the risks associated with a technological revolution while highlighting the available benefits that new technologies can offer in the plight to protect IP rights.

Commencing with the Constitution, Article I Section 8, Clause 8, known also as the “IP Clause”, intellectual property has always been fundamental to United States commerce and the United States’ economy. Abraham Lincoln stated that the patent system “added the fuel of interest to the fire of genius in the discovery and production of new and useful things.” Once those innovations and creative works are released into the marketplace, producers identify their creations with trademarks, thus making “effective competition possible in a complex, impersonal marketplace by providing a means through which the consumer can identify products which please him and reward the producer with continued patronage.”¹

As online and digital commerce expands and increases in complexity, and as tools and technology advance and become easier to access



Rhett Barney

¹ *Smith v. Chanel, Inc.* 402 F.2d 562, 566 (9th Cir. 1968).

Résumé

Rhett Barney, Partner

Rhett’s practice includes advising clients on worldwide trademark and copyright protection and enforcement strategies, the selection and clearance of trademarks, and the management of global portfolios. He works with clients to obtain domestic and foreign trademark registrations, handles trademark opposition and cancellation proceedings, and negotiates licenses and other intellectual property transactions.

and use, the opportunity to misappropriate and misuse intellectual property also increases. One area of significant advancement is in artificial intelligence like machine learning and generative AI. While it has always been possible for infringers to copy and confuse, with advances in AI an infringer can, within a matter of minutes, create a website, online store, or online marketplace, and begin selling infringing and counterfeit goods to unsuspecting or deal-hunting consumers. These fake products and websites are also improving in quality where even highly sophisticated consumers find themselves purchasing unauthorized and infringing products.

These advances, along with the growing anonymity of the internet post-GDRP leaves some companies and intellectual property practitioners scrambling to protect the rights in their care.

Recognizing that laws are slow to change and technological innovation like generative AI can render new laws outdated by the time they are enacted, a significant question arises – is generative AI an apocalypse for rights holders? Or could it be an opportunity?

Not unlike technological improvement scares in the past, such as advancements of 3D printing, it’s unlikely that many of the slippery-slope arguments and fear-based predictions about the death of intellectual property will come to fruition. Instead, rights holders should recognize that they too have access to the same tools and

resources as infringers. The same technology that makes it easier to infringe also makes it easier to find, catalogue, and take enforcement action against infringement.

Fear and fundamentals

So the fear is that these advancements in AI will result in new types of infringement and misappropriation. Will that happen? Absolutely. However, the fundamentals for how to address these issues are the same as they’ve always been. Provided that rights holders are willing to invest in new AI technologies the same way infringers are, with specific expertise and purpose, the task of using these fundamentals to attack and remove infringements will be no less onerous than they are today. It’s quite possible that AI technology will make it easier to identify infringements, and AI can be trained and tasked with removing the content.

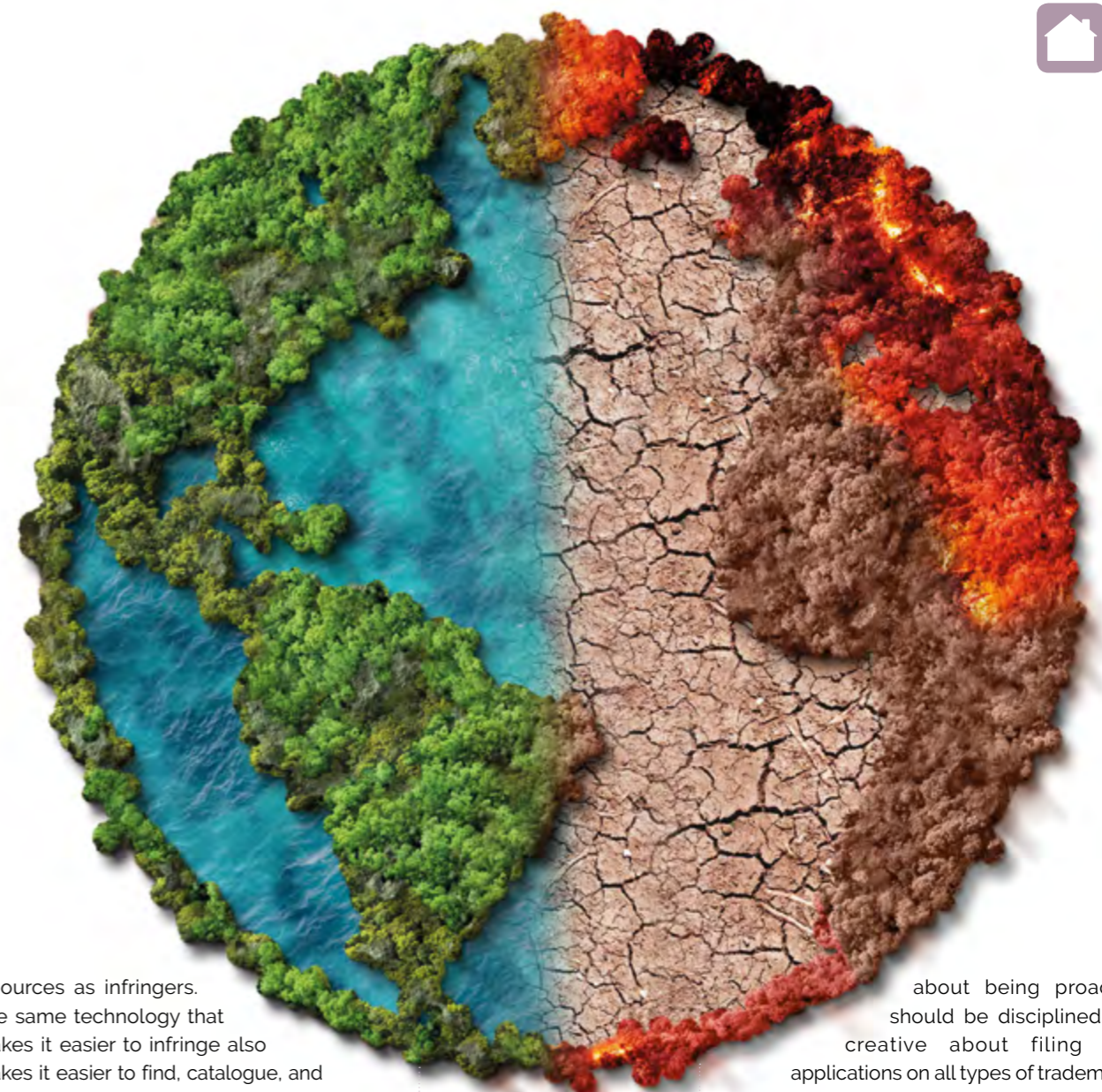
The foundation of every IP enforcement program is a collection of intellectual property registrations. Trademark registrations should be comprehensive and accurate, and each mark and variation thereof, should have its own registration. Common law rights are an important aspect of the US legal system, but they are very difficult to use for different kinds of enforcement, and many online platforms only work with federally registered trademarks. Therefore, rights holders anxious

about being proactive should be disciplined and creative about filing new applications on all types of trademarks.

Copyright registrations should be pursued in the same manner as trademarks, i.e., thoughtful registrations for each important piece of original content, updated regularly as needed, and consistently checked against new content. Not every creative work of a company should be registered, but any creative work that is important to a company’s brand or products should have a registration. Failure to seek registrations may severely limit a company’s ability to enforce its rights online and will hinder or completely prohibit the availability to recover certain statutory remedies.

While the focus of this article is on trademarks and copyrights, patents (both design and utility) should not be overlooked. In fact, there are significant overlaps between design patents, copyrights, and trademarks, and the rights of these three types of intellectual property complement each other well. For example, while copyright law has typically been the avenue for protecting graphical interfaces, such as web pages or program pages, a current trend of seeking protection on certain layout features is to seek both copyright and design patent protection.

When possible, overlapping different types of intellectual property is advised. Taking a holistic and overlapping approach to IP protection will



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With generative AI, a program can be created by the rights holder or a third-party service provider to track down infringing listings, catalog them, group them, and even submit the takedown notices.
 ”

not only provide a company with valuable assets that it can leverage for multiple purposes, but it will also provide flexibility and options when taking enforcement actions.

Types and examples of AI generated infringement

The types and manners in which infringements occur online are numerous: hidden metatags and metadata, use of trademarks in domain names (aka cybersquatting), linking and back-linking, file sharing and torrent sites, copycat and other infringing websites, e-commerce platforms selling counterfeit and infringing goods, and sales through social networking sites, etc. All these types of infringement have existed since before

AI became a concern, and there are already mechanisms in place to deal with them. Using AI to address infringements simply makes life easier for rights holders. For example, with copycat websites, defined as websites selling counterfeit or otherwise infringing products, where the website is identical to, or nearly indistinguishable from the authentic website. With AI, these sites can be flagged and grouped together with the speed and level of precision that was previously never possible. Subsequently, all the standard mechanisms for enforcement are still available — demand letters, webhost takedown requests, DMCA takedown notices, terms of service violation takedown notices, UDRP proceedings, and traditional litigation that typically results in an infringer that never responds and receives a default judgement. None of these actions require knowledge of the creator of the content to institute them, and all of them have a place in a robust enforcement program.

Another example to consider is infringement occurring on online marketplaces. An online marketplace is an e-commerce website where product or service information is provided by multiple third parties, and the transactions are processed by the marketplace operator. There are thousands of online marketplaces, the largest of which include eBay, Amazon, Etsy, Alibaba, Wishlist, Walmart.com, JD.com and Taobao. Possible tools for online marketplace enforcement are similar to those noted above and include sending a demand letter to the

party that posted the item (if you can find contact information) or sending a demand or takedown letter to eBay. However, nearly all online marketplaces have intellectual property takedown tools and policies. Sometimes these tools are built into the system and are automated, other times they are found in the form of a policy. Before sending demand letters to the online marketplaces, rights holders should research what options the platform provides. With generative AI, a program can be created by the rights holder or a third-party service provider to track down infringing listings, catalog them, group them, and even submit the takedown notices through these existing tools. So while some of these machine-learning enforcements are already happening at a basic level, as rights holders get more creative and sophisticated the tools and processes will get better and better. There is also a hope that these marketplaces will implement generative AI to learn from the takedown requests of rights holders that will then flag potential infringements within their own systems. While there is no legal requirement for marketplaces to do this, and their liability could increase by doing so, some may do it to demonstrate to rights holders that they are taking steps to stop and prevent the posting of infringing products.

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Educate your consumers

Though not a legal mechanism, rights holders should be very proactive in educating their customers about infringing and counterfeit goods. Consumers may not understand the health and safety risks associated with purchasing these goods, and they may not understand how detrimental some of these goods are to the health of the company that they are in some ways supporting. So, the importance of a strong education campaign can go a long way with consumers. The more educated consumers are, the less likely they will be to purchase infringing and counterfeit goods, so it is in everyone's interest to help develop these educational campaigns.

Conclusion

The economy is driven in large part by the intellectual property of companies and individuals. As technological advancements continue to create opportunities for free riders to profit from those properties, companies should invest in developing their own tools utilizing that same technology to protect their (hopefully) already robust intellectual property portfolio.

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An interview with Patrick Flaherty: Senior Managing Associate General Counsel of IP Law & Policy Group, Verizon

Patrick sits down with *The Trademark Lawyer* to discuss his experiences at Verizon, the value of branding for technological innovators, and the importance of having diverse outside counsel.

What inspired your career in law and how have you found the pathway to your current position?

My undergraduate degree at the University of Galway in Ireland was in Corporate Law and as part of that degree program I took a course in intellectual property. I became fascinated with how IP can create a corporate identity both in terms of a company's name or brand and what a company offers to consumers. When I completed my LL.B I skipped the law firm route and instead started working for Verizon in New York. There my job focused on patent licensing and litigation. Later I switched to working on trademarks, copyrights, and domain names, which has remained my focus ever since.

What motivated your switch from patent licensing and litigation to trademarks, copyrights and domain names? How did you have to adapt your skills to fit the change?

I switched when there was an opportunity to help another attorney with trademarks, copyrights, and domain names because of the high volume of work we had in the legal department. However, it meant having to move from New York to Virginia. The option to do the work remotely in New York didn't exist back then.

I had studied trademarks and copyrights at university in Ireland but I had to learn how US law worked. The domain names part was completely new to me. To learn all of these new areas of IP I just threw myself into the work and read everything that I could find on trademarks, copyrights, and domain names. Going back to law school also helped. I applied for an LL.M in IP at the George Washington University School of Law and completed the degree on a part-time



Patrick Flaherty

“A brand can represent the entire identity of a business, including its technology and innovation.”

basis over one and a half years. It made for very long days at times. I would work all day at our Virginia office and then jump on the metro to get to class at night on the GW campus in Washington, DC. I had always wanted to further my legal studies and do an LL.M so this all seemed worth doing and, more importantly, I enjoyed it.

What role does branding play in technology and innovation and why is it so important?

A brand can represent the entire identity of a business, including its technology and innovation. It's super important. Brands are all around us and even more so today with the use of social media. Consumers are constantly being exposed to brands. Branding is a vital part of business. It allows a business to differentiate itself from its competitors. Every brand wants to be recognizable to consumers and in the most positive way. There's a huge amount of competition in the world today with new technologies and innovations launching all of the time. Brands are also getting older younger. It no longer takes one hundred years to become as famous as, say, Coca-Cola or Levi's. I like seeing how brands are created and how they evolve and change over time. The Verizon brand was created in 2000 as a result of the merger between Bell Atlantic and GTE. The name derives from the words veritas and horizon. The logo remained the same for 15 years until 2015.

Our new brand identity is different but it still keeps the best elements of Verizon's heritage, represented by its colors and the "checkmark" design. The new brand is definitely cleaner, and the checkmark, the symbol for getting things done, continues to express the reliability of Verizon.

How, if at all, do you think the developments of Web3 will affect Verizon's IP strategy?

Not surprisingly, bad actors will always try to infringe on trademark rights in the metaverse and other developments of Web3 so we are monitoring for infringement and keeping a close eye on litigation, like the lawsuits filed by Hermes and Nike. We already own many trademark registrations in Classes 9, 35, and 41 so we don't see the need to file new trademark applications to protect goods and services in those classes.

Under what circumstances does Verizon use outside counsel and why?

My team and I try to do as much work as possible in-house but we still see a need to use outside counsel. In the US, we primarily use outside counsel to help us conduct trademark legal clearances based on the high volume of clearance requests with short deadlines we get from time to time. In situations like that, it's not possible to handle all of that work in-house. For international matters we use a blended approach of using US outside counsel and/or local foreign counsel. For example, we use US outside counsel to help us coordinate global trademark clearance, filing and prosecution matters, and sometimes foreign infringement matters. In certain countries where we have a lot of experience enforcing our trademarks and have a good understanding of the local law, we work directly with local foreign counsel. When it comes to domain name infringement, we have created in-house our own template Uniform Domain Name Dispute Resolution Policy (UDRP) complaints to file with WIPO using its UDRP complaint model. This has significantly reduced the cost of going the UDRP route to chase after cybersquatters. We ask for help from outside counsel in situations when we need to file a reply to any response from a respondent. Most respondents in a UDRP proceeding default, thankfully.

What attributes do you value most in outside counsel?

Diversity is important. Diversity of people provides us with diversity of thought. We look to work with skilled and strategic attorneys who can help us craft business-oriented solutions to our trickiest IP issues. It's important that outside counsel is responsive and personable, listens carefully to our problems, understands our concerns, and calibrates their recommendations and work product appropriately. Practical legal advice is what we need. When it comes to resolving disputes and enforcement matters, we want outside counsel to tirelessly defend our brands against bad actors. We look for a trusted advisor, someone who can work hand-in-hand with us

“Diversity of people provides us with diversity of thought. We look to work with skilled and strategic attorneys who can help us craft business-oriented solutions to our trickiest IP issues.”

to achieve our internal and external business goals.

How does Verizon optimize its watch and takedown services for brand protection?

We rely heavily on watch and takedown services for brand protection. You can't expect to find infringement, abuse, phishing, etc. without it. We review watch notices that we receive daily and weekly and take action quickly. We use takedown services that help with addressing phishing, malware, and brand abuse. Having a fast takedown time reduces the impact on a brand's reputation. We send demand letters from in-house. We ask US outside counsel to send demand letters. We ask foreign counsel to investigate infringement matters and send demand letters on our behalf. We draft and file UDRP complaints in-house. We instruct foreign counsel to file lawsuits, when necessary. We have a zero tolerance when it comes to misuse of our trademarks. We also regularly review the list of brands that we watch for to ensure the list is up to date. Sometimes we add brands as a result of an acquisition or remove them in the case of a divestiture. Verizon recently purchased Tracfone Wireless, Inc. and as part of the integration for that company we added all of its brands to our watch and takedown services.

What advice would you give to aspiring IP lawyers with a tech focus?

Know that change is a constant and embrace it. Getting to work on cutting-edge technology is very exciting, especially when you get to see it later being used by consumers. You will also continue to learn on the job by seeing how existing and new laws are applied to new technologies. There is nothing monotonous about my job. From clearances, to infringements, to agreements, you name it, every day is different.

What future digital development are you most looking forward to using and why?

Any future development that provides access to WHOIS or domain name registration data, whichever term you prefer. The lack of access to WHOIS data has dramatically impacted our ability to go after bad actors who take advantage of our trademark rights. As a result of the GDPR we are left having to complain to registrars and registries and use the UDRP more often. We recently won our largest ever UDRP decision at WIPO involving over 70 domain names. We currently have seven UDRP WIPO proceedings pending.



A Foundation to Your Success!

Alternative endings to the trademark lifecycle

Gavin Hyde-Blake and Spencer Vold-Burgess, co-founders of RedCoin IP, introduce the new solution to monetize trademarks at the end of their lifecycle while offering a second lease of life to significant marks.

The time comes in the life of all trademarks that they no longer have the same pull as they once did. Maybe the product has fallen out of fashion, maybe the name needs to drop as part of a rebrand or a company decides to drop a range of products and no longer needs the marks. What is the future for the now no-longer-needed marks? Or the other marks that may have been registered as part of a wider marketing campaign or as defensive marks to protect a core brand? Historically there has been a lack of options for positive action in this area, but a new platform now brings options for a proactive approach in the trademark lifecycle.

There is a great deal of study around trademarks, over their use, their protection, how commercial exploitation can maximize the brand to strengthen a company or increase a company's turnover, but there is one aspect of a trademark's lifecycle that is nearly always overlooked – and that is not doing sufficient service to an IP holder.

“Historically there has been a lack of options for positive action in this area, but a new platform now brings options for a proactive approach in the trademark lifecycle.”

Much thought has been put into the strategies on filing – on the use of defensive registrations, and filing overseas to get early priority dates (particularly in jurisdictions where the application process is paper-based). Creating a clear space around a trademark by filing defensive applications or acquiring similar marks are all tools in creating a strong legal instrument that can be the basis for a strong brand. Similarly, entire books and courses have been written about how to protect trademarks against dilution and genericization, against copying, against abuse – against every conceivable threat to it that IP professionals can think of. Similar levels of thought have gone into nearly all the stages of a trademark's lifecycle, except one: the end of life.

Too often the end of a trademark's lifecycle is an area where options – and potentialities – are overlooked, where the only choice given to a trademark holder at the end of their mark's lifecycle

is, 'do you wish to renew or let lapse?' This seems an inadequate situation for a mark that may have helped a company's development.

For some, selling the trademark was a considered step, but this can create problems with no mechanism or structure to facilitate the sale. Before now, trademarks were sold by owners reaching out to competitors (or those in related industries), to see if people would want to buy an old mark or portfolio from them. To buy a trademark previously, it was a seller-driven process, with a mark being identified and then approached – often by a third-party acquisition service such as that offered by Eccora – to acquire a mark. While these are positive and proactive steps by brand owners to facilitate the movement of marks, by lacking a more formal structure they are piecemeal and not always successful.

This old approach of constantly renewing or just letting them lapse has been overtaken by a positive and proactive approach that would be a winner for brand owners and IP professionals alike: RedCoin IP – an IP tech services company that has recently launched a dedicated platform, initially for buying and selling trademarks but with plans to extend to other IPR. A dedicated platform gives stability to the purpose and focus for buyers and sellers to congregate in the same forum, see the perceived values of marks, gain confidence that the platform is solid and reliable, and take part knowing that the process is fully integrated on the platform with secure transactional payments providing a simple, smooth and secure solution.

A dedicated platform ensures that the process of monetizing what would otherwise have been a dead asset can be done with confidence. For those looking to sell marks, a new approach brings with it a need for a new strategic focus on best practice. If an older core mark is no longer needed, but the company wishes to keep it out of the market for as long as possible, there is no need to sell that mark, but the related defensive marks they hold can now be listed for sale and capitalized on. That's new revenue coming back into the business that could be used for investing in new IP. By divesting the portfolio of marks that may be a cost and inconvenience, a company has the finances to strengthen its new core marks, which can lead to improved efficiency and profitability. The same is true for struggling

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Purchasing a trademark can provide instant recognition, brand loyalty, and an established customer base.

”



Gavin Hyde-Blake



Spencer Vold-Burgess

businesses or those going into administration – the value could be significant: recent distressed sales of Cath Kidson, whose intellectual property and domain names were acquired by Next for £8.5million, while Tesco acquired the IP of Paperchase for a reported six-figure sum. Neither of the purchases involved the acquisition of the shops, just the IP.

The valuation of a trademark is a difficult one. As an intangible asset it may be too specific or limited (either by the text or classification) to generate a big price tag, but you could get enough of a return to cover the initial filing costs and a profit left over. If a portfolio includes several such marks, the profit could be significant. As with a lot of intangibles (think domain names for a similar 'product' where the price is difficult to settle on), the 'value' is what a buyer will pay for it. Pushing out the sales listing onto social media (both those of RedCoin IP and the seller's own social media platforms) will get the listing in front of a wider audience, which increases the chances of it being seen by a potential purchaser.

For buyers of marks from the RedCoin platform, they are looking at an off-the-shelf registered trademark without having the potential stress of waiting for rejection or opposition and having additional prosecution costs or needing to apply for a new mark from scratch. It also helps to prevent competitors from using similar marks, which can dilute the brand value. Moreover, these pre-owned marks could potentially have vital prior rights too. Purchasing a trademark can provide instant recognition, brand loyalty, and an established customer base. The brand owner can start building on its new brand from the moment the transfer process goes through, rather than having to wait for the registration process to go through its steps, so it is a win-win for all!

Overall, buying and selling trademarks can be a valuable strategy for businesses looking to establish or expand their brands, or for those seeking to monetize or divest non-core assets. Having a tech solution in the form of a dedicated platform allows brand and IP owners to extend their existing trademark management tools for selling and buying trademarks into the digitized arena.

Résumés

Gavin Hyde-Blake and Spencer Vold-Burgess are the co-founders of RedCoin IP. They also run Eccora, a specialized IP research, investigation and acquisition company. They have been involved in IP since the 1990s.

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and lawyers

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Trademark distinctiveness issues in registration application procedure

Jiuyang ZHOU of Beijing Sanyou Intellectual Property Agency Ltd. provides practical guidance to avoid registration refusal on the grounds of lack of distinctiveness, assessing name, design, and model.

On your way to obtaining exclusive trademark right, in addition to avoiding conflicts with prior rights, the mark itself should possess distinctiveness to become a trademark, i.e., the capability to distinguish the source of goods or services, to enable consumers to recognize and remember.

Generally speaking, under Chinese practice, we usually follow three basic rules and a few special regulations to judge whether or not a trademark bears distinctiveness. Once your trademark is refused due to the basic rule(s) and regulation(s), we may also have solutions to help you out, provide assistance on overcoming refusal(s), and obtain trademark registration then.

Rule 1: a sign only bearing the generic name, design, or model of the goods

"AUCTION" in services "auction", "XXL" in goods "clothing", etc. are of these kinds of trademarks. But in real practice, there are some exceptions that successfully overcame the refusal of Rule 1, and obtained trademark registration. Such as DIAFORMIN in "Pharmaceutical preparations for the treatment of diabetes" in class 5, and THE iX3 in "Vehicles; motorcycles; bicycles, etc." in class 12.

In the refusal review application of DIAFORMIN, its applicant argued that the mark was not the generic name, the real generic name of this good is "phenformin". Besides, the applicant also argued that there was no clear dictionary meaning of the mark. Evidence like product introduction, registration information of the mark in Australia, screenshots of relevant definitions of Baiduexpedia, query results of the State Drug Administration, and extracts of relevant research reports were provided. Ultimately, the CNIPA supported the applicant's arguments that no evidence could



Jiuyang ZHOU

prove the mark was the generic name of its designated goods, then preliminarily approved the registration of the mark.

And in the refusal review application of THE iX3, the applicant claimed inherent distinctiveness and a strong link had been established between the mark and the applicant, the mark could distinguish origin of goods. In particular, the applicant provided evidence such as internet search results, trademark introduction on its official website, media reports of the THE iX3 cars to support that the trademark THE iX3 is one of the well-known automotive series brands of the applicant, with the meaning of "unique iX3", almost 20 years' development, and sales volume up to over 1.3 million globally. After examination, the CNIPA supported the applicant's arguments, it considered models referring to those specified in national or industry standards or established by convention. In this case, no evidence could prove the mark was the model of its designated goods, then it was preliminarily approved for registration.

Résumé

Jiuyang ZHOU joined Sanyou in 2016. 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 Madrid international trademark application.

She engaged in research for trademark Law and trademark practice in China and has published several articles and case analysis periodically in China, e.g. "On Perfecting the Application System of Trademark Division" published in the magazine *China Trademark*.

Rule 2: a sign only directly indicating the quality, main raw materials, functions, uses, weight, quantity, or other features of goods

"PURE" in goods "edible oil, vegetable oil", " in goods "fruit juice", "TRAVEL STEWARD" in services "downloadable smartphone software", etc. are of these kinds of trademarks. And in real practice, the refusal may be overcome in some cases, such as BIO-GIDESHape in "resorbable membranes for use in dental, maxillofacial and orthopedic surgery." in class 10, AIR LIQUIDE in "metal containers for compressed gas or liquid air, etc." in classes 6 & 7.

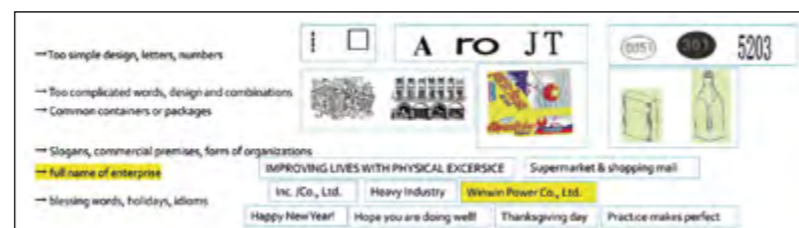
In the BIO-GIDESHape refusal review application and subsequent litigation procedures, the applicant kept arguing that the trademark had no fixed or specific meaning and had a high degree of distinctiveness. Besides, the definition from an online dictionary cannot be the determination basis. It provided evidence such as search results from various dictionaries like the English Chinese Medical Dictionary, Practical Stomatological Dictionary, General Medical Dictionary, and online dictionaries to show the mark is a phrase with originality rather than the material of its designated goods. And the online definitions of some hot words "iPhone", "ben-z", "buick", etc. could not be looked up in professional dictionaries. Therefore, in the second litigation, the court ruled the case in favor of the applicant and considered that online dictionaries may only be a reference rather than the basis for defining a foreign trademark's inherent meaning.

In the AIR-LIQUIDE refusal review application and subsequent litigation procedures, the applicant mainly argued that its metal containers were used for "Liquefied gas", not "air liquid". "Liquefied gas" is a common expression for a kind of gas, not "air liquid", not alone "air liquide". Besides, "LIQUIDE" is a French word, not an English word, Chinese consumers are not familiar with it. Moreover, long-term and extensive use to enhance distinctiveness was also claimed and quite a number of pieces of evidence were submitted, for example, the applicant's company introduction, prior trademark registrations for the mark in relevant goods, numerous charitable activities carried out, and numerous awards obtained by the applicant in China, media articles and reports of AIRLIQUIDE as a trademark and subsidiary name of the applicant, etc. In the end, in the second litigation, the court ruled the case in favor of the applicant and considered the inherent meaning of a foreign letter mark may affect its distinctiveness in its goods, but if public awareness of the meaning of the mark is relatively low, it may be considered distinctive. And over long-term use in mainland China, the trademark had established a strong

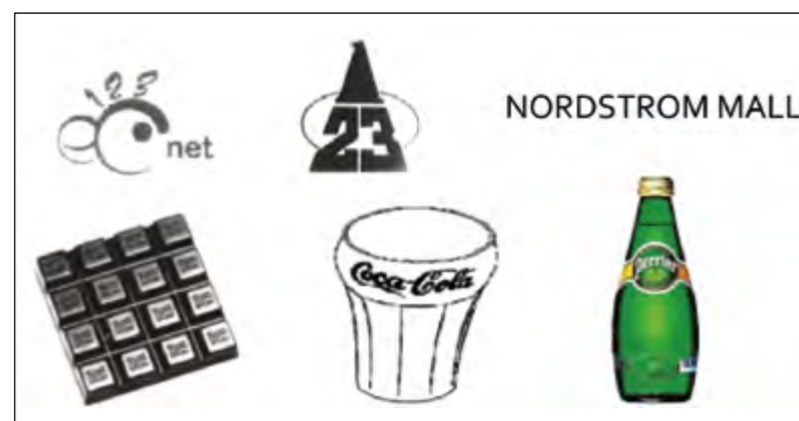
link with its applicant, then had the function of distinguishing the origin of goods.

Rule 3: other signs' lack of distinctiveness – miscellaneous provision

We have quite a number of examples of these kinds of trademarks, and what I may invite your attention to is that the full name of an enterprise may not be viewed as a distinctive trademark, and is likely to be refused.



Meanwhile, we also have exceptions as follows, such as number marks with special design, common packages combined with unique words and commercial premises with unique words, which could be approved for registration:



Rule 4: new types of trademarks being viewed as lacking distinctiveness

If a trademark consists of a word part and other element(s), while the word part does not have distinctiveness, the trademark as a whole should be deemed as lacking distinctive. A case in point is as below:



This mark is combined with the word part "1 VALVE 2 FRAMES 3 STEPS". Its device part is unique though, the trademark as a whole was judged as lacking distinctiveness in its designated services. In practice, if your trademark is of this kind, you may receive an Office Action or a direct Refusal Notification requiring the applicant to abandon the word part, otherwise, the trademark as a whole will be refused.

Solutions of defense when facing refusals due to lack of distinctiveness

To make a brief summary, when your trademark encounters refusal based on lack of distinctiveness, you may consider the following counterarguments, and relevant evidence is also necessary:

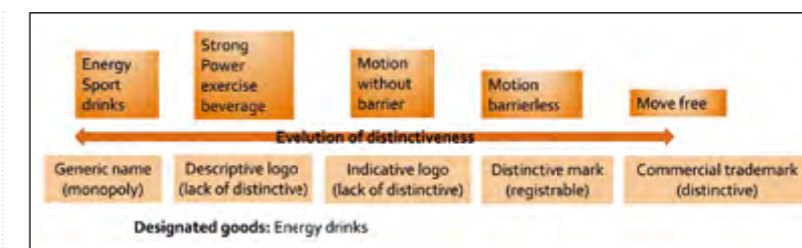
1. Emphasize the inherent distinctiveness (originality) of the trademark;
2. The trademark is composed of indicative words rather than descriptive words;
3. The inherent meaning of the applying mark is not known to the relevant public;
4. The meaning defined by an online dictionary cannot be a direct basis of the real meaning of the trademark;
5. Obtain distinctiveness through use and evidence collection may focus on:
 - (1) Timing/region (before the filing date, at least two-three years / mainland China);
 - (2) Media coverage and articles;
 - (3) Industry ranking (China, overseas, global);
 - (4) Sales documents (contracts, invoices, import and export documents);
 - (5) Special audit report regarding the trademark use;
 - (6) Documents (advertising placement contracts, invoices, promotional pages);
 - (7) Sales web pages and sales data on major online sales platforms;
 - (8) Others.

Suggestions for consideration

Lastly, I may provide some suggestions for trademark design procedure before taking it for filing.

1. Evolution of distinctiveness

Let's take the design of a trademark in "energy drinks" for example. At first, you may only think up the generic name of it "energy, sport drinks", then you may try to change to some similar words such as "strong, power, exercise", and these words, though descriptive, are better than the generic name. Then, you may put some imagination into trademark design to form



The court ruled the case in favor of the applicant and considered that online dictionaries may only be a reference rather than the basis for defining a foreign trademark's inherent meaning.

"motion without barrier" or "barrierless", which has become indicative rather than merely descriptive, but not particularly commercial. In the last stage, you may change the word "barrierless" to "free" so as to make the trademark as a whole perfect for both marketing purposes and registration purposes.

2. Using indicative words rather than descriptive words.

3. Use words or letter composition in two different languages which may not be familiar to Chinese consumers.

Overall, as a trademark attorney, I may understand the applicant's thoughts and ideas in filing non-distinctive trademarks, these marks, compared with coined words, have specific meanings, easy to remember, propagate, may give pleasant associations for consumers, and could be more acceptable to the market. However, in terms of obtaining exclusive rights, stability of the trademark right, and subsequent trademark enforcement, is required. As we mentioned above, non-distinctive trademarks may encounter refusal, and even if finally approved for registration the remedy procedures could take years. After the registration, this kind of trademark may also face cancellation or invalidation actions filed by any third parties due to lack of distinctiveness, and the trademark right may be unstable. Furthermore, the protection of the trademark right may have more limitations than expected. Therefore, it is advisable to use a coined trademark for registration.

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Domain name dispute resolution: the Portuguese and international context

Ricardo Costa Macedo and João Bertholo Meireles of Caiado Guerreiro discuss the protection – or lack thereof – for domain names in relation to registered trademarks.

Résumés

Ricardo Costa Macedo, Lawyer and Partner at Caiado Guerreiro, Head of the Intellectual Property and Life Sciences groups.

Mr. Macedo's practice covers a wide range of contentious and non-contentious patent, trademark, and other IP-related rights, such as trade secrets and unfair competition, in particular in the pharmaceutical, home care, food, and insurance sectors. Moreover, he has vast knowledge of regulatory matters in these sectors.

Mr. Macedo Graduated in 1998, from the Faculty of Law of the Catholic University of Lisbon. He undertook postgraduate studies in information society law at the Faculty of Law of the University of Lisbon in 2000 and in commercial law at the College of Law, London in 2003.

João Bertholo Meireles, Junior Lawyer at Caiado Guerreiro

Mr. Meireles has been collaborating with Caiado Guerreiro since 2022 and is a member of the Intellectual Property and Life Sciences groups.

Mr. Meireles graduated from the Faculty of Law of the Catholic University of Lisbon, in 2021. In 2022, he undertook postgraduate studies in Sports Law at Nottingham Trent University. His main areas of interest are Intellectual Property, Health Law, and Sports Law.

Currently, he is taking part in the Portuguese Bar Association internship in order to complete his admission and become a fully qualified lawyer.



Ricardo Costa Macedo



João Bertholo Meireles

Nowadays, domain names are becoming increasingly more important, being used to identify and distinguish economic operators online. However, due to the legal framework in force, domain names may be registered in an abusive manner, for instance, registrations purely speculative and prompted by bad faith.

The technical function of locating an "address" on the Internet has long been surpassed, as domain names are now regarded as genuine and proper signs capable of distinguishing the different economic activities, with businesses utilizing them to identify the goods and services they commercialize.

In Portugal, domain names are registered with .PT and are under the responsibility of the *Associação DNS.PT*, whose regime is based on the "first come, first served" rule, whereby the domain name is registered in favor of its first applicant.

Furthermore, contrary to what occurs in the context of trademarks, which may co-exist in the marketplace even though they are identical if they designate different goods or services, the domain name regime is governed by the unicity principle. In other words, domain names can only be registered once, with no repeated names existing within the same category and level of classification.

Having said that, looking at article 6 of the *Regras de Registo .PT* (the Portuguese registration rules), read in conjunction with its article 27, one can see that it is inadmissible to register a domain name that: (1) reproduces a mark, name, or designation that is widely and generally known, and (2) constitutes an abusive appropriation, carried out in bad faith, of a right or interest legally protected of a third party.

However, despite the abovementioned requirements, domain names may be registered in an abusive manner, for instance, registrations purely speculative and prompted by bad faith, since



the entities responsible for granting domain names usually only carry out a *post hoc* monitoring and not a preventive examination.

In such situations, the aggrieved party can resort, at its discretion, to legal action, filing a complaint before the Portuguese Intellectual Property Court, or resort voluntarily to an institutionalized arbitration center, such as ARBITRARE, which is also competent for settling disputes arising in Portugal.

The abovementioned Intellectual Property Court or the institutionalized arbitration center will customarily analyze, in each dispute, whether there is a legally protected right and whether there is an abusive appropriation, done in bad faith. Regarding the latter requirement, it is necessary to ascertain if, for example, the domain name was registered with the intention of selling it later on, obtaining unjustified and unfair profits, and/or if the registration was intended to disrupt the claimant's professional or commercial activities.

The final ruling typically either maintains the *status quo*, thereby agreeing with the registrant, or orders the removal or transfer of ownership of

the domain name, being in accordance with the initial request made by the claimant.

In this context, claims for civil damages may also be dealt with, arising from the misuse of the domain name.

At the international level, domain name disputes are often referred to arbitration, with the access to an arbitration tribunal being made either by means of an arbitration agreement, when, for example, the registrant undertook to submit all disputes arising from that registration to this type of alternative dispute resolution, or by means of a submission agreement, such as in cases where the parties, already in conflict over a given domain name, agreed to settle the dispute voluntarily by means of institutionalized arbitration.

Thus, disputes regarding the abusive usage of domain names, especially with .COM and .ORG, tend to be referred to the World Intellectual Property Organization (WIPO), which has an Arbitration and Mediation Center capable of providing, apparently, time- and cost-efficient solutions.

“**Claims for civil damages may also be dealt with, arising from the misuse of the domain name.**”

In these cases, the WIPO Arbitration and Mediation Center follows the guidelines and recommendations of the Uniform Domain Name Dispute Resolution Policy (UDRP). Similarly to what is stated in the *Regras de Registo .PT* (the Portuguese registration rules), it is stipulated, in paragraph 4(a) UDRP, that it is up to the Arbitral Tribunal to ascertain whether: (1) the respondent's domain name is identical or confusingly similar to a trademark or service mark in which the complainant has rights; (2) the respondent has a right or legitimate interest in relation to the disputed domain name; and, lastly, (3) the respondent registered the domain name and is using it in bad faith.

Concerning the finding of bad faith, this is probably the most difficult requirement to demonstrate. Consequently, most claimants, when they do not provide sufficient evidence of the registrant's intention, end up having their claim rejected, as they do not satisfy, on a balance of probabilities, such requirement, with malice or serious fault not being proved.

Moreover, it is insufficient to simply claim that the registrant is infringing a registered trademark. In this respect, it is important to mention the principle of speciality applicable to trademarks, which only protects their owners against the use of identical or similar signs in relation to identical or similar goods and services, covered by the trademark registration, existing a

“**Disputes regarding the abusive usage of domain names, especially with .COM and .ORG, tend to be referred to the World Intellectual Property Organization (WIPO).**”

likelihood of confusion between both signs in the mind of the average consumer.

From this perspective, an intellectual property right is not infringed whenever the domain name is being used in relation to goods or services other than those for which the trademark is registered, since its protection is limited to those specific goods and services.

That being said, some authors, namely Alexandre Dias Pereira, argue that the domain name regulation represents an exception to the principle of speciality, protecting trademark owners extensively also against goods and services other than the ones covered by the trademark registration.

Looking once more to Portugal, recent case law of the Portuguese Supreme Court of Justice extended the scope of applicability of unfair competition, stating that it confers protection against all practices targeting the same clientele, thus being suitable to prevent the abusive registration of a domain name.

Other instruments, such as the principle of good faith (*bona fide*) or abuse of rights, appear to be equally suitable to protect holders of intellectual property rights and may be available to claimants when asserting the existence of an abusive registration of a domain name.

In conclusion, in today's society domain names have acquired significant importance and are now considered to be true distinctive signs of commerce, with the capacity of identifying their holder and his or her goods and services.

Nevertheless, as its legal status has not yet been amended to reflect its nature as a distinctive sign, it is recommended that companies and entrepreneurs register them, for example, as trademarks, giving them additional protection.

As a matter of fact, companies and entrepreneurs are becoming increasingly aware of the importance of domain names, incorporating them into their portfolio of intellectual property rights.

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Women in IP Leadership

Celebrating achievements and continuing the empowerment of women





Maria Cecilia: Partner, CorralRosales

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.



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

Maria Cecilia is Partner at CorralRosales. She has a Juris Doctor degree from Pontificia Universidad Catolica del Ecuador, as well as several diplomas in various intellectual property topics. She has acted as an International IP Mediator and Arbitrator and has experience in the public sector, from her time as a judge of the Administrative Litigation Court.

Maria Cecilia received the Chambers Women in Law Award for Ecuador in 2018. She is the only Ecuadorian to have been recognized among the 250 most influential women in IP as selected by IP Stars. Maria Cecilia is a member of the EUIPO's Observatory International Panel of Experts. She is the first Ecuadorian both to sit on INTA's Board of Directors and to form part of the Programming Committee of the International Association for the Protection of Intellectual Property (AIPPI).

What inspired your career?

A curious fact is that I didn't want to be a lawyer, or at least it wasn't in my plans.

It all started when my aunt told me the news that I had been enrolled at the Law School. At first, I was shocked, as I had not planned it, but as time went by, I fell in love with my career and studied it with enthusiasm until the end.

At that time, intellectual property was not very developed in Ecuador and it was not a main focus at the university.

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

The road to my current position has never been easy. From something as simple as being a woman and studying for a university degree, to becoming the first and only Ecuadorian woman to be recognized by IP Stars among the 250 most influential women in the world or being a member of the Panel of International Experts of the EUIPO Observatory. Everything has involved



“
No matter how many obstacles life throws at us, the best we can do is take what life gives us and make the best of it.”

significant personal and family sacrifices to achieve it.

The best advice I can give anyone is that playing the victim will not get you anywhere. No matter how many obstacles life throws at us, the best we can do is take what life gives us and make the best of it.

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

Throughout my career, I have faced many challenges, most of them related to being a woman in a historically male-dominated environment. Still today, most law firms have a significant number of female associates or employees, but when we look at the partners, the number of women is low or none. This reality is consequence of a sad but true fact: being a woman and a lawyer means that, by default, our path will always have more obstacles than our male colleagues.

In my experience, the only way to deal with these and any other obstacles is to move forward. If I had spent time lamenting over all obstacles or taking criticism personally, I would never have achieved a quarter of what I have achieved in my professional and personal career.

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

Being the first Ecuadorian to have been part of INTA's Board of Directors, as well as the first Ecuadorian to be part of the Programming Committee of the International Association for the Protection of Intellectual Property (AIPPI) are some of the greatest achievements.

Some of the recognitions that have most fulfilled me have been receiving the Chambers - Women in Law Award Ecuador 2018. Likewise, being the only Ecuadorian recognized among the 250 most influential women in the world in intellectual property by IP Stars and having been appointed a member of the Panel of International Experts of the EUIPO Observatory.

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

At the moment, one of my greatest aspirations is to leave a legacy for future generations - especially women, and that they see themselves represented. I feel that I have achieved most I have set out to do and at this point in my personal life, I would like to leave a footprint that young people can use as a guide for each of them to pursue their dreams of success in the areas they desire. Leaving the door open for young women lawyers to reach high positions and make a difference is one of my goals, and what better way to do that than to teach by example and give them opportunities in my environment. The female lawyers who work

hand in hand with me know that I intend to empower them to be independent and successful on their own.

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

Undoubtedly greater female participation in positions of power. In most IP associations there are a high number of women members, however, when we look at the boards of directors, the gender inequality is striking. Changes are needed not only in the IP industry but in society, in general, with a greater representation of women in positions of power, but for this to happen, the necessary conditions of evaluation and equal opportunity must be given so that these are occupied by capable and competent women and not just to fill gender participation quotas.

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

The first thing is to create awareness of the need to empower women. Once we are aware of this need, opportunities will come our way, as more empowered women will result in women daring to do something new, different from what has been socially expected of them in the past, and this will lead to greater representation not only in decision-making positions within the IP world but also in the legal field in general. For this to happen, work has to be done on a large and small scale, both in the most influential organizations in the IP world, as well as in individual law firms. Equal access to opportunities is the key to achieve a better society.



Tomoe Takahashi: Partner, Hogan Lovells Japan

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

With extensive international experience, including qualifications in three different countries, Tomoe has lived and worked in Tokyo, the United Kingdom, Spain, and New Zealand, and regularly advises clients on complex multijurisdictional issues. Tomoe's practice largely focuses on multijurisdictional trademark enforcement and portfolio management. She also counsels on IP issues on a variety of commercial transactions spanning a broad range of industries including the automotive, consumer electronics, cosmetics, food and beverages, gaming, chemical, and energy industries. Tomoe's clients also seek her counsel on product compliance issues that may arise in the product life cycle for protection of their brand images, such as product safety regulations and labelling.

What inspired your career?

It was a bit of a coincidence; I could study one master's topic during my undergraduate degree, and I picked IP because it fitted well with my schedule. Then later on I was in a six-person study group for professional legal training and three out of the six other trainees were involved in IP, as was my teacher, which is very rare as there are not many people who specialize in IP in New Zealand, where I trained initially. At that time, there was an opening at one of the biggest IP law firms in New Zealand and Australia; I applied and got the job - the path fell into place and that started my career.



I was trained in domestic work in New Zealand and Australia but after two years I decided to come back to Japan, my home country, for family reasons and since then I've been mainly helping Japanese clients to expand into the overseas market. I didn't realize until I started this line of work that it was a perfect fit for me because I grew up overseas for much of my childhood, but I always thought that Japanese products and services were, for me, the best in the world; helping Japanese companies grow in other countries is something from which I take great enjoyment.

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

When I joined Hogan Lovells about 10 years ago, the team was very small with only one lawyer, one trademark attorney, a paralegal, and a few secretaries - maybe six or so in total. Now, after 10 years, there are more than 40 just doing trademarks. We grew quite quickly.

I believe the reason we have succeeded is by having a varied team of people with different qualifications and backgrounds. It's very rare, at least in Japan, to find foreign qualified personnel focusing mainly on trademarks, for example. Unfortunately, it's more common for lawyers to go to the practices such as M&A, finance, or litigation, likely because these practices are common in international law firms. But we manage to find those rare characters that are foreign qualified and specialize in trademarks (we have myself - I'm qualified in New Zealand, the UK and Ireland - UK and French trademark attorneys, and several US, AU and UK attorneys) as well as Japanese qualified patent attorneys with overseas experience. I think this mixture of qualifications and backgrounds has attracted the clients that helped us grow. Also, the firm has a system where junior lawyers can work in other overseas offices to gain experience. I have been given an opportunity to work in our London and Alicante offices for which I am really grateful.

Law firms are normally a pretty competitive environment I think, but we manage to retain friendliness and not have too competitive a

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I believe the reason we have succeeded is by having a varied team of people with different qualifications and backgrounds.”

structure with little hierarchy dominance. I am trying, though not always successful, to keep the team happy as this in turn makes the client happy as the team will work well together and can grow in strength. I spend a considerable amount of time doing HR-related work, and maybe it's not what some people think lawyers should be doing but I believe it's an important part of my role.

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

We realized that we have to be pretty efficient because trademark works generally have narrow profit margins, to be competitive. We invest time on, for example, making manuals/templates for newcomers to follow, developing the robotics, and consolidating the trademark portfolio management system of the firm's network to increase efficiency and accuracy of our data.

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

I prefer to think about it as many successes, including each time I get a new instruction – no one client or work is more important than the other but I'm always grateful for getting a new opportunity. I'm so grateful to the firm, the clients and the team for allowing me to stand where I am, and their continued assistance. I'm really grateful for my colleagues especially, not just my immediate team but the whole Hogan Lovells network as they are very helpful and have taught me many skills on the instructions we work together.

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

We are working on developing a practice that offers Total Brand Care to our clients, comprehensive brand-related services not just services relating to trademarks. We want to assist our clients to respond appropriately to all of the legal and business threats and opportunities that may arise over the life of a brand. We would like to be a one stop shop for protecting the clients' brands, by giving holistic advice on creating, commercializing and protecting their brands, including by giving advice on regulatory, product library, data privacy issues as well as antitrust and M&A. That's what makes us unique. As we're a full-service law firm, we can build a bigger practice together to support our clients even more. In an effort to achieve this, I asked to be seconded to a product library team for a while, and we try to send the juniors to other offices to gain experience in additional areas to trademarks.

We are also working on growing domestic services for overseas clients coming into Japan because, as a result of the economic climate,

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If you're doing a good job and you are kind to your team and work hard for your clients, hopefully the people around you will recognize that effort and take you where you should be regardless of your gender. This is what I would like to see.

”

we're definitely seeing more opportunities for foreign companies coming to Japan than ever before. I can already see much more foreign traffic coming to Japan these days so hopefully American, European, and Asian companies will begin to realize there are opportunities in Japan and they'll bring more inbound work, as we have a lot of senior Japanese lawyers and patent attorneys with overseas experience who will be ready to help them and be a great bridge between the different laws, practices, and culture.

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

In the trademark world, I think there are more women than in the other practices; for instance, our team has fewer than 10 men out of 40. For gender diversity, our team actually needs to recruit more men but for people who are already in the office, we are trying to be flexible regarding working hours to accommodate the needs of our team members. For example, those with young families can pick up their children at four and be with them until bedtime then pick up work again afterwards. We're also working to make our process more efficient so that our paralegals and administrative staff don't have to work overtime so they can have more of a work/life balance. There is a belief around the world that Japanese people tend to work till late at night all the time, but that's not the case in our office. Of course, some people will work longer hours to meet the client's expectations, particularly senior staff, but even then we are offering the flexibility to work around other life commitments to find more balance.

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

I'm really not an outspoken person but I was always told that you have to speak up more than men in order to be recognized in the world. Hopefully that's not the case for everyone; if you're doing a good job and you are kind to your team and work hard for your clients, hopefully the people around you will recognize that effort and take you where you should be regardless of your gender. This is what I would like to see, and now I am in a position to help others grow. I would like to be the one who recognizes such hidden talents and assesses people objectively for their work. I think this will be the key, together with keeping the flexible working arrangement as discussed above.



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LAW FIRM RANKINGS 2023

Asia Pacific

A comprehensive list of the 10 most well-respected law firms from the Asia Pacific region







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



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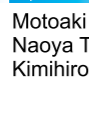
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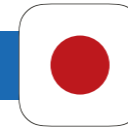
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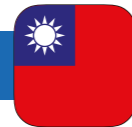


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Jurisdictional Briefing, US: Penguins, Grogu, and the color orange: the implications of artificial intelligence and its use of copyrighted materials

Michelle Ciotola, Partner at Cantor Colburn LLP, evaluates the ever-evolving debate surrounding AI-created works according to US Copyright Law from both a use and generation perspective.

Confession: I started this article by asking ChatGPT for an introductory paragraph. Using the prompt "An introduction to a legal article about how artificial intelligence ("AI") and ChatGPT use copyrighted material to generate works." Within seconds, ChatGPT provided the following introduction:

Artificial Intelligence (AI) has emerged as a transformative force, revolutionizing various industries, including the creative realm. With advancements in natural language processing, AI-powered systems like ChatGPT have gained remarkable proficiency in generating text, mimicking human-like conversations, and producing creative works. However, this development raises important questions regarding the utilization of copyrighted material by AI systems and the potential implications for copyright law.

Copyright law has traditionally protected original works of authorship, granting exclusive rights to creators while regulating the use and reproduction of their works. However, as AI systems such as ChatGPT learn from vast datasets, they inevitably encounter and incorporate copyrighted material, raising concerns about potential copyright infringement. This article aims to explore the intricate relationship between AI systems, copyright law, and the use of copyrighted material to generate new works.

I like that introduction. But I am a little intimidated by how quickly and comprehensively ChatGPT generated this reply to my prompt. The capabilities of AI are evolving quickly, and the quality of the works generated are frequently astounding. AI has created works of art, written works, and generated musical compositions. AI technology has successfully passed the bar exam and the medical boards. And without question, AI technology has written essays for students. The use of AI raises numerous legal questions, especially in copyright law. But the guidance trickling in is far outpaced by the rapid expansion of AI technology. For example, the US Copyright Office (USCO) recently issued a Statement of Policy on the examination and registration of works containing AI-generated material. It came as no surprise that AI-generated works were not subject to copyright protection since U. Copyright Law requires human authorship. But this leaves open the question of how the USCO will treat works that use but are not solely created by AI. Apart from ownership of AI-created works, what are the legal implications when AI uses copyrighted work to generate these works?

The AI technology often used in the creation of these works is known as "generative AI". Generative AI is a type of artificial intelligence system that can generate text, images, or other media in response to prompts entered by the user. The chatbot ChatGPT and the image-generator Dall-E, both developed by OpenAI, are examples of generative AI technology. Both ChatGPT and Dall-E use GPT-4 and GPT-3 respectively. GPT or Generative Pre-Trained Transformer is an

autoregressive language model which uses deep learning to create the outputs. Deep learning is a type of machine learning that uses artificial neural networks to mimic the human brain – deep learning algorithms learn from diverse, unstructured, and inter-connected data and is capable of improving performance. This raises copyright issues because the data deep learning learns from will likely include copyrighted materials.

The question becomes whether use of copyright material in AI deep learning may constitute infringement. Given the breadth and scope of data available, it would be impossible to obtain permissions from copyright holders. But the ability to use materials protected by copyright is instrumental to the success of deep learning. Does use of the data in the learning process constitute fair use? The doctrine of fair use permits the use of copyrighted works without permission from the owner of the copyright. It is a limitation to the rights afforded to a copyright owner. The doctrine is codified in the US Copyright Act under 17 U.S.C. §107:

Notwithstanding the provisions of sections 106 and 106A, the fair use of a copyrighted work, including such use by reproduction in copies or phono records or by any other means specified by that section, for purposes such as criticism, comment, news reporting, teaching (including multiple copies for classroom use), scholarship, or research, is not an infringement of copyright. In determining whether the use made of a work in any particular case is a fair use the factors to be considered shall include:

- (1) *the purpose and character of the use, including whether such use is of a commercial nature or is for nonprofit educational purposes;*
- (2) *the nature of the copyrighted work;*
- (3) *the amount and substantiality of the portion used in relation to the copyrighted work as a whole; and*
- (4) *the effect of the use upon the potential market for or value of the copyrighted work.*

The application of the fair use doctrine is fact and circumstance specific. Even if the use of copyrighted materials in machine learning is fair use, what happens when the prompts entered into generative AI technology results in an output that does infringe copyright? Is the user of the technology liable for copyright infringement depending on how that work is then used? Is the developer of the technology liable for infringement? Contributory infringement? The answers to these questions will depend on the specific technology at issue, safeguards put in place, and the manner in which the output is ultimately used by user, among other considerations.

Earlier this year for his seventh birthday, my son asked me for a painting of "penguins, Grogu,



Michelle Ciotola



Image generated by Dall-E from prompt "a painting of penguins and Grogu with orange"

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and the color orange." These are his absolute favorite things. The character Grogu, also known as "Baby Yoda," was from the television series The Mandalorian, is well-protected intellectual property and subject to copyright protection. Curious about how Dall-E would handle this prompt, I entered the following prompt into Dall-E: "a painting of penguins and Grogu with orange." The image generated contained penguins and orange, but no Grogu. Did AI understand the prompt "Grogu" but also identify it as subject to third-party intellectual property rights? Are there safeguards in place to guard against copyright infringement in certain circumstances?

Recently, TikTok user Ghostwriter977 posted (and subsequently deleted) a video in which they claim they used AI to create - specifically using AI to replace their voice with an AI generated voice to mimic the voices of rapper Drake and singer The Weeknd. Ghostwriter977 claims to have written the lyrics. This raises a new set of issues: if the lyrics were in fact written by Ghostwriter977 can this be a case of copyright infringement where the voices of third parties are used in the creation of the final work? While it is more likely the appropriate claim would be one directed to rights of publicity for use of the mimicked voices of Drake and The Weeknd, this is another example of the potential legal issues raised by use of generative AI.

While US Copyright Law continues to play catch-up to this very rapidly expanding technology, owners should be prepared to monitor and enforce their works, just as users of generative AI technology should carefully consider the technology used, the prompts entered, and the output created.

Résumé

Michelle Ciotola, Partner & Chair, Trademarks & Copyright Practice, Cantor Colburn

Michelle Ciotola counsels clients on protecting and enforcing their trademark, trade dress, copyright, and related IP rights, including unfair competition, Internet, advertising, and promotions law. She counsels clients in developing and exploiting their trademark and copyright portfolios, including clearance, prosecution, and identifying important overseas jurisdiction and filing or coordinating with local counsel overseas. Michelle develops strategies for the enforcement of her clients' IP rights. She also develops strategies for enforcement of her clients' intellectual property rights online, including handling Uniform Domain Name Dispute Resolution Policy proceedings. Michelle is a thought leader on AI and emerging technologies issues related to intellectual property, and has authored several articles related to these complex and evolving issues. Michelle attends and speaks at International Trademark Association (INTA), MARQUES, European Communities Trade Mark Association (ECTA), IPO, and the Asociacion InterAmericana de la Propiedad Intelectual (ASIFI).

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Whose ARMOUR is stronger? A tussle between apparel moguls

Manisha Singh, Partner, and Anmol Bahuguna, Associate, of LexOrbis dissect the recent *Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd.* case to assess the claims of passing off and deceptive similarities with key takeaways for protecting fashion trademarks.

The global fashion industry is one of the most competitive arenas, and the difference between the success and collapse of a brand is contingent upon how robustly the business protects its identity. Trademark infringement is a common dispute that plagues this industry, and courts in India rely upon an array of factors to determine the intellectual property rights of the disputing parties. In the recent case *Under Armour, Inc. v. Aditya Birla Fashion & Retail Ltd.* CS (COMM) 41/2023, I.As. 1349/2023 and 4142/2023, the Delhi High Court was presented with a dispute over the adoption of the marks STREET ARMOUR, STRT ARMOR and SA by the defendant, which were alleged to be similar to the plaintiff's registered UNDER ARMOUR, UNDER ARMR, and UA marks.

Facts of the case

The plaintiff, UNDER ARMOUR, Inc. (UA India), is a US-based company. The plaintiff officially entered the Indian market in 2017 by selling its goods through Amazon. In 2018, the plaintiff incorporated its Indian subsidiary, Under Armour India Trading Pvt. Ltd., and the first physical store of the plaintiff was opened in India in 2019. The mark UNDER ARMOUR stands registered in the plaintiff's favor in Classes 18 (leather and imitations of leather, and goods made of these



Manisha Singh



Anmol Bahuguna

materials, etc.), 25 (clothing, footwear, headgear), and 28 (games and playthings, gymnastic and sporting articles, etc.) since 24 February 2009 and the mark UA stands registered in the plaintiff's favor in the same classes since 12 January 2011.

One of the contentions made by the plaintiff was about reputation; in a Google search of the word 'ARMOUR', the plaintiff's site was one of the first results to show. However, the court stated that the appearance of any brand's website in Google search results does not establish the brand's reputation or goodwill in the market and held a Google-based search argument insufficient.

The plaintiff operates the interactive websites www.underarmour.com and www.ua.com. According to the plaintiff, the defendant's use of the word 'ARMOUR' in its mark, notably the style and letters, is confusingly similar to the plaintiff's ARMOUR mark.

The defendant argued that since the plaintiff has only relied upon the fact that 'ARMOUR' was the dominant part of its marks and not the complete trademark to support its claims, the court ought to consider the entire trademarks UNDER ARMOUR, UA, UNDR ARMR as well as 'ARMOUR' in the distinctive font used by the plaintiff. The objective of the court is to determine whether, when viewed as a whole, the defendant's marks infringe the plaintiff's

Résumés

Manisha Singh, Partner

Manisha is known to be one of the most reputed lawyers in the intellectual property domain, with a decorated career of over 25 years. She has served as a vital advisor to corporations and research organizations in handling intellectual property matters and developing strong IP portfolios. She is ceaselessly engaged in endeavors to strengthen India's IP protection and enforcement system to align it with international standards and works closely with industry associations and the government.

Manisha has served as the leading counsel for a client base in over 138 countries in their IP management and litigation matters. She is identified by her clients as a seasoned and reliable counsel for the prosecution and enforcement of all forms of IP rights, and planning and management of global patents, trademarks, and designs portfolios. She has also led numerous negotiation deals on behalf of her clients for both IP and non-IP litigation and dispute resolution.

Anmol Bahuguna, Associate

Anmol Bahuguna, an Associate at LexOrbis, is a Post Graduate of L.L.M (Corporate & Commercial Laws) from IMS Unison University, Dehradun and has pursued his Graduation in B.B.A L.L.B from Lovely Professional University, Punjab. He regularly undertakes drafting and advisory work related to IP/ trademark prosecution and contentious matters. Over the course of his internships with various Law firms, he has acquired various legal and technical skills across various legal fields such as Company Law, Data Privacy Law, Arbitration Law, Consumer Law, and Intellectual Property laws, which he applies to his work at the firm.

marks or if the defendant may be accused of trying to pass off its goods as those of the plaintiff, on which the court agrees and holds. The court also addressed the "dominant part" argument, concluding that the probability of confusion must be assessed by taking into account the totality of the composite marks as an indivisible whole rather than by cutting or segmenting.





Legal issues considered by the Delhi High Court

1. Whether the second element 'ARMOUR' is a dominant feature of the plaintiff's mark UNDER ARMOUR. Whether the plaintiff's marks, seen as whole marks, are, or are not, infringed by the defendants.
2. Whether the 'ARMOUR' part of the plaintiff's marks would be descriptive.

The court commented on the identification of a "dominant mark", which refers to a specific element within a composite mark that is given greater prominence compared to the other constituent elements. In other words, it is an element that stands out and is more noticeable than the other elements in the composite mark. In this present case, plaintiff's mark UNDER ARMOUR and the defendant's mark STREET ARMOR, there is no reason for the court to consider ARMOUR/ARMOR as the dominant part of both the marks respectively. The primary way to determine whether an element of a trademark is dominant is to test whether it makes a stronger impression on the customer's mind than the other elements when viewed by an average customer with imperfect memory. The court further observed that in the absence of any material or evidence to indicate that 'UNDER' or 'STREET' is less dominant in UNDER ARMOUR or STREET ARMOR respectively than 'ARMOUR' or 'ARMOR', thus the plaintiff's argument that 'ARMOUR' is the most dominant part of the UNDER ARMOUR mark is not valid.

While addressing the second issue, the court held that if a purchaser with average intelligence buys sportswear bearing the plaintiff's brand name UNDER ARMOUR or UNDR ARMOR, and later comes across sportswear bearing the defendant's brand name STREET ARMOUR or STRT ARMOR, the purchaser may think that they had purchased a similar piece of sportswear previously with a similar name and there is every possible chance that the purchaser may presume a connection between the defendant's mark and the plaintiff's earlier trademark which they came across earlier.

Keeping the abovementioned observations in mind, the court determined that under Section 29(2)(b) of the Trade Marks Act, 1999, the plaintiff's registered mark UNDER ARMOUR was violated since the use of the marks STREET ARMOUR and ARMOUR in connection with athletic equipment was likely to lead to confusion or association between the marks. Lastly, while determining whether there was trademark infringement, the court looked at the marks as a whole and did not consider 'ARMOUR' to be the plaintiff's mark's dominant component.



Credit: PRImageFactory

The primary way to determine whether an element of a trademark is dominant is to test whether it makes a stronger impression on the customer's mind than the other elements.

The defendant argued that the 'ARMOUR' part of the plaintiff's mark was descriptive and hence could not be protected. The court rejected this argument and held that 'ARMOUR' was not descriptive of the goods of either the plaintiff or the defendants. The court observed that sportswear is not armorial, and even if the clothing in question was protective, the mark could at best be suggestive, which can be registered, unlike descriptive marks. The court also noted that the plaintiff's use of the mark was not protective, and 'ARMOUR' was arbitrary when used for such apparel. The court further dismissed the defendant's argument that it had applied for registration of the STREET ARMOUR mark, contending that it was estopped from claiming that 'ARMOUR' was descriptive.

The defendant further argued that the word 'ARMOUR' was common to trade as the plaintiff was operating in a "crowded marketplace"; however, the court rejected this argument by stating that the Trade Marks Act does not recognize any such concept called "crowded marketplace". Even if 'ARMOUR' was common, it would only apply if the plaintiff claimed exclusivity over that part of the mark, which they were not doing. The court found the defendant's marks were deceptively similar to the plaintiff's marks, and the argument of whether 'ARMOUR' was common to the trade was insignificant.

It is important to note that the defendant contended that the plaintiff purposely suppressed material facts by not disclosing their response to the First Examination Report (FER) while obtaining registration for the mark UNDER ARMOUR. The defendants contended that in the response to FER, the plaintiff submitted that other marks

which had 'ARMOUR' as a part thereof were already registered, and the plaintiff's mark had to be seen as a whole, whereas in the present plaint, the plaintiff is being sought to claim exclusivity on the word 'ARMOUR' itself. The defendant contended that the stance taken by the plaintiff in this present case is different from the stance taken in the response to the FERs and the plaintiff is bound to disclose the replies filed to the FERs with the present plaint.

The court held that if the defendant's mark is cited in the FER as a similar mark to the plaintiff's proposed mark under Section 11(1)(b), then the plaintiff's response to the FER would be relevant as the plaintiff cannot take a different stance and oppose the same mark of the defendant in the infringement suit. Doing so would be considered inconsistent and unfair. Hence in the present case, this principle has no application as the defendant's mark was never put up as a similar mark in the FER while objecting to the application of the plaintiff for registration of the UNDER ARMOUR mark.

Lastly, the court observed that if any material fact which would have an impact on the outcome of the proceedings is suppressed, the suppression of fact could disentitle such party to seek relief and the plaintiff is not guilty of any such material

The probability of confusion must be assessed by taking into account the totality of the composite marks as an indivisible whole rather than by cutting or segmenting.

suppression of fact as would disentitle it to release in the present case.

Order of the Delhi High Court

The court made a ruling based on the facts and legal issue presented and held that defendant is restrained from dealing in or using the impugned marks STREET ARMOR, STRT ARMOR, ARMOR, ARMOR CO, STRT ARMOR LAB or any other trademarks/labels that are identical with and/or deceptively similar to the plaintiff's registered UNDER ARMOUR, UNDR ARMOR or UA word marks or device marks, or any other mark that is confusingly or deceptively similar to the said marks of the plaintiff, in respect of apparel or any other goods or services which may be regarded as similar or allied to the goods in respect of which the plaintiff uses its marks.

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China's efforts to combat trademark warehousing

Nick Ji, Partner at Corner Stone & Partners, reviews the changes to Chinese trademark law in recent years to tackle the bad faith filings and trademark warehousing with an assessment of new trends.

With public awareness of the importance of intellectual property rights growing in recent years, trademark applications in bad faith and the practice of trademark warehousing have significantly increased in China. According to official statistics released by the Trademark Office of China National Intellectual Property Administration (CNIPA), trademark applications numbered 3.52 million in 2016, 5.74 million in 2017, 7.37 million in 2018, 7.83 million in 2019, 9.34 million in 2020 and 9.45 million in 2021. This shows that trademark applications have increased significantly in the past few years, especially between 2017 and 2020. Quite apart from trademark applications resulting from economic development and business expansion, an appreciable proportion of trademark applications are filed in bad faith and with the intention of warehousing trademarks instead of actually using them.

China has been combatting the practice of trademark warehousing in recent years. For example, Article 4 of China's new trademark law, which came into effect in November 2019, added specific provisions against trademark warehousing.



Nick Ji

*Revised Article 4 - An applicant who needs to get trademark rights for their goods or services, should apply for a trademark application. **Bad faith applications without the purpose of use in commerce shall be rejected.***

This means that "trademark warehousing" is a clear violation of the revised Trademark Law Article 4. However, the revised language lacks details for determining "bad faith" or "not made for the purpose of using the trademark". Against this backdrop, the State Administration for Market Regulation (SAMR) issued a set of clarifying Provisions in October 2019 to shed light on the application of the amended Article 4:

When judging whether an application to register a trademark violates the provisions of Trademark Law Article 4, the trademark registration department may consider the following factors comprehensively:

- (1) *The number of trademark registration applications filed by the applicant, or by natural persons, legal persons, and other organizations connected to the applicant, the [Goods and Service] Classes specified for use, circumstances relating to trademark transactions, etc.;*
- (2) *The industry, operating conditions, etc., of the applicant;*
- (3) *Effective administrative decisions or rulings, or judicial decisions, have already determined that the applicant has previously engaged in bad faith*

trademark registration activities, or that it has engaged in acts infringing the exclusive rights of a third party's registered trademark;

- (4) *The applied-for trademark is identical with or similar to a third party's trademark that enjoys a certain degree of fame;*
- (5) *The applied-for trademark is identical with or similar to the name of a famous person, to an enterprise trade name, to an abbreviation of an enterprise name, or to other commercial identifiers;*
- (6) *Other factors that the examiner believes should be considered.*

Following these provisions, CNIPA and the courts have implemented a series of measures against the practice of trademark warehousing, whose examples are as follows:

- Having invalidated or rejected many trademark applications which featured obvious practices of trademark warehousing (for example, warehousing a large number of trademarks and selling them for profit);
- An applicant who applies for registration of more than 500 trademarks will be marked down as a possible suspect for trademark warehousing and their applications will be examined more critically;
- Prohibiting the transfer of the trademarks in the name of applicants who perform the practice of trademark warehousing.

New trends

In recent months, CNIPA has taken a new measure to prevent trademark warehousing. If an applicant



An applicant will be likely to pass the examination so long as they give sufficient explanation and produce the proof of their real intention of trademark use.

applies for registration of several dozen trademarks within a few months, a notification of examination will be sent to them to ask them to state the use of relevant trademarks or the intention of actually using them and to provide the necessary proof.

This new measure may undoubtedly serve to deter small or early trademark warehousemen, who warehouse trademarks on a modest scale for the time being, and effectively curb the act of warehousing trademarks on a small scale whose applications are filed by several applicants on a separate basis.

Inevitably, however, large companies which have the real intention of using their trademarks may also receive such notifications due to their large number of trademark applications. We advise that the applicant, when receiving the notification, respond positively to produce proof and give explanations. Proof to be produced includes:

- (1) *Business plan, road shows, presentations, meeting memos, email correspondences discussing the project, etc.;*
- (2) *Transaction documents regarding the intention of using the mark on the related goods/services, such as presale contracts, PR contracts, ordering packaging/promotional items;*
- (3) *Designing trademark logo / packaging (manuscript, copyright license/transfer, etc.);*
- (4) *Preparations made for manufacturing products bearing the mark, such as blueprints, ordering raw materials, setting up production lines, OEM contracts, etc.;*
- (5) *Any other materials proving the genuine intention of using the mark.*

In general, an applicant will be likely to pass the examination so long as they give sufficient explanation and produce the proof of their real intention of trademark use.

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Résumé

Nick Ji, Partner

Nick's broad-based experience spanning almost 20 years includes representation of consumer products, luxury goods, children's products, and media and entertainment industries. Nick's Electronics Engineering degree, along with his employment history with domestic and multinational IP firms, enables him to analyze intellectual property issues from multiple practice disciplines. His practice includes structured strategic intellectual property prosecution and enforcement.

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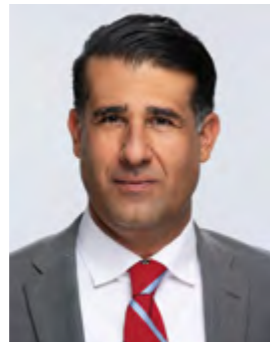
An update on the Trademark Modernization Act

Raffi Zerounian and Justin Thiele of Hanson Bridgett review the TMA's non-use cancellation procedures and how expungement and reexamination petitions have fared followed by practical tips on how to prepare successful petitions.

The Trademark Modernization Act (TMA) went into effect in December 2021 and, among other changes, created two important new United States Patent and Trademark Office (USPTO) procedures for challenging existing trademark registrations based on non-use: *ex parte* expungement and reexamination. Since the TMA went live, both the USPTO and practitioners have begun ramping up their familiarity with the relevant procedures, with hundreds of petitions filed so far. After almost a year and a half, a number of trends have emerged both in the actions taken by the USPTO Director and in the types and formats of petitions filed by practitioners. This article will provide further background on the TMA's non-use cancellation procedures and how expungement and reexamination petitions have fared followed by practical tips on how to prepare successful petitions.

Background on expungement and reexamination petitions

The two cancellation procedures for non-use under the TMA are in practice very similar. Expungement proceedings, available for registrations between three and 10 years old under any filing basis, allow for *ex parte* cancellation proceedings after either a petitioner or the Director makes out a *prima facie* showing that a registered mark has never been in use in US commerce for some or all of the goods or services in the registration. Reexamination proceedings are the same, but are based on a showing that a registration less than five years old originally



Raffi Zerounian



Justin Thiele

filed under 15 U.S.C. § 1051 was not in use in commerce on or before the relevant date.

Hundreds of reexamination and expungement petitions have been filed

The USPTO has released an online, real-time database of reexamination and expungement proceedings, which is searchable and sortable by proceeding type and disposition. As of June 19, 2023, the USPTO's public database of reexamination and expungement proceedings reflected the following statistics:

- 162 petitions for expungement have been received. Of these, 82 petition-initiated expungements have been instituted, the USPTO issued 36 notices of incomplete petitions ("30 day letters"), and 49 petitions were ultimately not instituted.
- 162 petitions for reexamination have been received. Of these, 79 petition-initiated reexaminations have been instituted, the USPTO issued 22 30-day letters, and 48 petitions were ultimately not instituted.
- The Director of the USPTO has instituted seven expungement proceedings and 136 reexamination proceedings under its statutory authority in the TMA.

These numbers reflect both proceedings in progress and those that have been terminated.

The Director of the USPTO is using its authority to institute proceedings without a petition

A few trends have been identifiable in Director-instituted proceedings. First, the Director has exercised authority to institute proceedings in conjunction with co-pending petitions. More than once, where a petitioner sought cancellation of only a limited scope of goods or services within a registration, the Director has used its discretion to both grant the petition and institute a parallel proceeding that is broader in scope. For example, Registration 5681148 was registered in connection with six discrete goods in Class 16: "Bookmarkers; Bookmarks; Novels; Series of fiction books; Series of fiction works, namely, novels and books; Story books." A private party petitioned for reexamination as to only four of these items, and the Director found a *prima facie* case for non-use as of the relevant date had been shown and instituted reexamination proceeding 2022-100064R. On the same day, the Director on its own initiative instituted parallel reexamination proceeding 2022-100102R for the remaining two (out of six) goods in the registration. In the latter proceeding, the Director expressly cited the evidence in the private petition and attached additional evidence of non-use gathered by the USPTO. Ultimately, the registration was canceled in full after a voluntary surrender by the registrant.

A practitioner considering filing a TMA petition may often be faced with a choice: whether to focus solely on knocking out goods and services specifically of interest to the client (such as those cited by the USPTO in an *ex parte* likelihood-of-confusion refusal) or to seek full cancellation. The Director's institution of parallel proceedings following petitions seeking to cancel less than all goods or services in the registration that appear to hint at total non-use may be an indication that the USPTO is not taking its role passively and is regularly seeking to clear away "dead wood" registrations in whole at once.

Second, the Director appears to have instituted proceedings *en masse* against groups of registrations owned by a single registrant where the USPTO has become aware of evidence of dubious use in commerce by that registrant. For example, on May 3, 2022, the USPTO received petition 2022-100091 for reexamination of Registration 6523829 for the mark WOLFOX owned by Best Tomorrow Store Inc., and ultimately declined to institute a proceeding on July 11, 2022 on the grounds that the petitioner had not submitted sufficient evidence of non-use as of the relevant date. Subsequently, however, on December 14, 2022, the Director initiated reexamination proceedings against 18 of Best Tomorrow Store's live registrations – including WOLFOX. In the

“Dubious or concocted specimens of use have been a major concern for the USPTO in recent years.”

notices of institution, the Director put forth evidence that the registrant's specimens of use appeared to be "e-commerce storefront[s] created solely for the purpose of submission as specimens of use in trademark applications and to reserve rights in the mark," containing allegedly digitally-altered product photographs and meaningless product descriptions. Ultimately, the registrant failed to respond to the non-final office actions and all 18 registrations were canceled in whole on March 21, 2023.

Registrations issued on the basis of dubious or concocted specimens of use have been a major concern for the USPTO in recent years. The TMA appears to have provided the Director with an effective tool to take action against such registrations when the USPTO learns of such improper specimens. Before the TMA, the USPTO's authority to cancel these types of registrations was largely limited to examination of 15 U.S.C. § 1058 and 15 U.S.C. § 1141K declarations of use, unless a private party happened to institute an *inter partes* cancellation proceeding before the Trademark Trial and Appeal Board (TTAB).

Practice tips for petitioners

The TMA cancellation procedures set out a fairly simple standard regarding non-use in commerce for registrations. However, drafting a petition that is likely to be granted can be complicated, time consuming, and requires attention to detail.

Learn and follow all formality requirements

One common ground for non-institution by the USPTO is the petitioner's failure to meet certain formality requirements. Petitioners should be sure to review and include in petitions all the formality elements required in the USPTO's rules,

Résumé

Raffi Zerounian, the Market Leader for Hanson Bridgett's Los Angeles Office, has a 360-degree trademark practice, handling all facets of counselling, clearance, prosecution, enforcement, litigation, and licensing. Raffi has pursued hundreds of trademark enforcement disputes and has been lead counsel in many trademark infringement actions in federal court.

Justin Thiele is an Associate in Hanson Bridgett's Litigation Practice Group. He focuses his practice on trademark litigation and prosecution as well as copyright and trade secrets litigation.



including basic facts like the basis for the petition (whether expungement or reexamination, which in practice should include the defined relevant date), the name and domicile address of the petitioner, and an index of the evidence attached to the petition, among other things. Fortunately, omissions of this type are usually not fatal to the petition; the USPTO may issue a notice of incomplete petition, commonly called a “30 day letter,” offering the petitioner the chance to rectify the formality issues without affecting the filing date of the petition. The USPTO issued over 50 30-day letters to date.

There is currently no official USPTO template or form for the format that a petition must take, beyond the formality requirements and suggested elements of a reasonable investigation provided in the USPTO’s rules, so practitioners should be thoughtful and thorough when drafting petitions. One of the most important of the formalities is the verified statement made under penalty of perjury by someone with firsthand knowledge of the petitioner’s investigation (usually but not always the petitioner’s attorney). Some practitioners may choose to include separate petition and declaration documents to satisfy the requirement for a verified statement; however, this is not a requirement. The Director has accepted numerous TMA petitions that combine all the necessary elements – the elements of reasonable investigation, the concise factual statement of the relevant basis for the petition, all formality requirements, and the itemized index of evidence – in a single document. Doing so may help a practitioner make the most efficient use of time in preparing a petition and simplify the documents the USPTO must review.

Conduct an appropriately comprehensive investigation

Another common ground for rejection of TMA petitions is the petitioner’s failure to establish a *prima facie* case for non-use as of the relevant date. Showing non-use is often a matter of negative proof – that is, providing sufficient evidence to show the USPTO that goods or services were not in use. A petitioner’s investigation need not be absolutely exhaustive, but should be “appropriately comprehensive” enough to satisfy the USPTO that the petitioner has conducted a “reasonable investigation,” as the TMA demands.

However, unlike the formality issues described above, a substantive failure of this nature cannot be cured – rather, an entirely new petition must be filed. Tactically, this might be fatal. Registrants receive automatic notice from the USPTO of all filed TMA petitions, which will naturally alert a registrant that a dispute exists as to its use in commerce of its mark. In an expungement proceeding, for example, in order to avoid

“**The TMA cancellation procedures set out a fairly simple standard regarding non-use in commerce for registrations.**”

cancellation a registrant must put forth evidence of use in commerce of the mark *before the filing date of the underlying petition*. Normally this prevents a registrant from manufacturing use only after it has received notice of a use challenge. But if the petitioner’s expungement petition is rejected on substantive grounds and the petitioner is compelled to re-file, the registrant will have received such notice of the challenge and may have an opportunity to commence use in commerce before the filing date of the revised petition, defeating the benefits of the expungement proceeding for the petitioner.

Although the TMA statute itself does not define “reasonable investigation,” practitioners should familiarize themselves with the guidance that the USPTO has provided, both through its rulemaking procedures and in the Trademark Manual of Examining Procedure (TMEP). For example, the USPTO has codified a list of common “sources for a reasonable investigation,” which includes things like websites believed to be controlled by the registrant, state and federal regulatory records, and records of relevant litigation, among other things. A TMA petition that expressly declares and provides evidence of the petitioner’s searches of each of these sources of evidence – which means attaching evidence that a particular search had no relevant results – will likely go a long way to establishing a *prima facie* case of non-use.

However, petitioners should not limit themselves only to the suggested elements of reasonable investigation in the USPTO’s rules, which are not limiting. There are a variety of other facts that may come to bear on a registrant’s genuine use in commerce, as defined in the Lanham Act. The Director has instituted a number of TMA proceedings on such grounds.

Scrutinize and spend time investigating specimens

Specimen issues are a common source of evidence of non-use. Even if the USPTO examination division in the course of prosecution accepted a specimen as complying with the USPTO’s specimen rules, this does not mean that a petitioner cannot identify irregularities or raise other issues about the specimens that were used to secure a registration. A careful review of specimens may identify obvious facial issues, such as visual clues that a photograph has been digitally altered to superimpose a mark on a good. Website specimens should be cross-referenced with archived copies of a website found on resources like the Internet Archive Wayback Machine to uncover cases of digital mock-ups. Reverse-image searching on the web may reveal that a single photograph of a particular product has been repurposed and re-used many times for many different marks.

Even if a specimen consists of nothing more than a photograph of a mark affixed to a physical good, the petitioner should specifically note whether that specimen contains any objective indication that the good was sold or transported in US commerce – such as if the good is photographed against a blank background or in a context that makes it evident that the photograph was not taken in the United States.

Research the registrant

Background information on a registrant can also provide facts tending to create an inference of non-use. For example, evidence that a registrant has filed an unusually large number of applications may be relevant, as can evidence that the registrant is domiciled outside the United States in contradiction of a domicile address provided to the USPTO.

Evidence that a registrant originally filed or declared use in bad faith may also establish a *prima facie* case. In February 2023, the *World Trademark Review* published an article discussing the online trafficking of trademarks, including US registrations, through websites such as “TrademarkSea.” Naturally, as indicators of source designed to protect against consumer confusion that must be transferred in connection with a business’s underlying goodwill, trademarks are generally not amenable to resale on the open market. Therefore, evidence that a mark in a particular registration has been advertised for sale or sold on an online registration marketplace may be very persuasive evidence tending to show that a particular mark was not in use in commerce in the ordinary course of trade.

“**Petitioners should be sure to review and include in petitions all the formality elements required in the USPTO’s rules, including basic facts like the basis for the petition.**”

Consider creative ways of establishing non-use

Practitioners should think expansively when considering sources of evidence for reasonable investigations of non-use in support of TMA petitions. For alcoholic beverages, for example, records of the federal Alcohol and Tobacco Tax and Trade Bureau’s (TTB) Certificates of Label Approval (COLA) can be a useful source of evidence on whether a label bearing a particular mark has ever been sold. In the same vein, commercial databases of import and export records for US ports may also be fruitful, especially in cases of foreign-domiciled registrants.

Broader strategy considerations may bear on the decision to file a TMA petition

Although TMA petition procedures are a very useful tool for clearing away “dead wood” registrations, they do have limitations. Under the statutory language of the TMA in the Lanham Act, the grounds for an expungement or reexamination petition are strictly limited to non-use of a mark in commerce, either before a relevant date or at any point in time. This means that a TMA petition cannot be brought on the grounds of abandonment, or on the basis that a post-registration affidavit of use under 15 U.S.C. § 1058 was insufficient or fraudulent.

Although *ex parte* in nature, a TMA petition does require a significant amount of effort on behalf of petitioners and practitioners in the pre-filing stage. Appropriately comprehensive, reasonable investigations and the compiling and indexing of evidence into a petition can take a significant

amount of time. A petition for cancellation before the TTAB, in comparison, may be completed with no more than reasonably-grounded factual allegations that comply with Fed. R. Civ. P. 8 and 12, perhaps using a practitioner's template and without the need to gather and produce all relevant evidence up front. In the event of respondent default, therefore, a TTAB proceeding can be resolved with less effort – but this must be balanced against the risk of contested and expensive *inter partes* proceeding should the registrant respond.

The *ex parte* nature of TMA proceedings means that petitioners' involvement is cut off upon institution. Once instituted, the USPTO will issue an office action to which the registrant must respond, and the USPTO alone will determine the sufficiency of the registrant's evidence of use in commerce, if any. The TTAB may review the Director's decision to cancel a registration in a TMA proceeding, but there appears to be no provision for the intervention of the petitioner in these appeals. Further, there is also no procedure for a petitioner to withdraw a reexamination or expungement proceeding once instituted – so in the event of a dispute and settlement negotiations between a petitioner and a registrant, the parties generally cannot contract in a settlement agreement to "dismiss" TMA proceedings.

“Although TMA petition procedures are a very useful tool for clearing away “dead wood” registrations, they do have limitations.”

Conclusion

Now that the USPTO has had about a year and a half to flesh out its rules on expungement and reexamination proceedings and has had occasion to review hundreds of these petitions, it is clear that the TMA's non-use cancellation procedures are powerful tools to help maintain the integrity of the trademark register. Moreover, practitioners can use reexamination petitions to cost-effectively and efficiently cancel certain types of fraudulent registrations and expungement petitions to remove registrations that were not necessarily fraudulently filed but never used in the US.

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