Unauthorized use of trademarks in Russia – is there anything that can be done?

Riikka Palmos, Senior Partner and Director of the Trademark Department at Papula-Nevinpat, provides an update on trademark use and registration in Russia’s changing IP landscape.
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Unauthorized use of trademarks in Russia - is there anything that can be done?

Riikka Palmos, Senior Partner and Director of the Trademark Department at Papula-Nevinpat, provides an update on trademark use and registration in Russia’s changing IP landscape.

The Russian invasion of Ukraine in February 2022 brought about notable changes in the IP landscape for foreign trademark holders and local entities in Russia. While the protection, maintenance, and enforcement of IP rights remain unaffected by sanctions, the situation has had an impact on the exercise of exclusive IP rights under specific circumstances.

From a legislative standpoint, the developments are not considered alarming. Nonetheless, new regulations and laws have been introduced that grant the state to restrict exclusive IP rights. Both the Patent Office and the courts are not considered alarming. Nonetheless, new regulations and laws have been introduced that grant the state to restrict exclusive IP rights. The changes are primarily to protect the safety, health, or well-being of citizens. In practice, these measures ensure the availability of food, medicines, and other vital commodities. Despite rumors of nationalization or expropriation of IP rights, there have been no significant restrictions or sanctions imposed.

Unauthorized use of trademarks

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Remedies available

In clear trademark infringement cases, all legal remedies, such as sending a warning letter and filing an infringement action, are available. In many instances, sending the warning letter has led to peaceful negotiations and ultimately to an amicable resolution of the dispute. However, not everyone is fortunate, and some infringement claims end up being evaluated by the court.

In each infringement case where the claimant has exited the Russian market, the local defendants commonly make three claims:

1. The lack of the claimant’s interest in defending their rights due to their exit from the market.
2. The claimant’s unfriendly country status towards Russia; and
3. That the infringement claim goes against the national interest of Russia.

Fortunately, these arguments have not been considered by the courts, and the cases have been decided based on factual circumstances and according to the law, generally favoring the rights holders.

Filing an infringement action is not entirely risk-free, especially in situations where the trademark holder has not used its trademark in Russia for the last three years. In such cases, there is a risk of a non-use cancellation action being filed as a counterclaim to the infringement action, which could result in the loss of existing rights.

Misleading marketing, unfair conduct

There are also other means of misusing foreign trademarks. Some local operators attempt to capitalize on the strong brands of foreign right holders by creating associations between their own brands and those of foreign companies. These operators often use similar advertising, product placement, and misleading references to the international nature of their brand. However, the trademarks they use are usually different from those of the foreign companies. Consequently, in such circumstances, local operators are not directly infringing on any prior trademark rights. Instead, this misleading marketing and unfair conduct fall under the competence of the Anti-Monopoly Committee, which is the competition authority in the country.

To bring such cases under consideration by the Anti-Monopoly Committee, the actions should be regarded as competitive, meaning that both parties must be present in the market in a competitive situation. For companies that have exited Russia, this significantly limits the measures and possibilities for intervention against such actions.

Bad faith trademark applications

In addition to the unauthorized use of foreign trademarks, the Russian Patent Office (Rospatent) has received hundreds of trademark applications filed by local businesses for trademarks owned by foreign trademark holders, or for trademarks confusingly similar to existing ones. Mainly, trademarks of companies that exited in Russia were targeted for registration last year. These bad faith applications caused a significant amount of uncertainty and concern among the rights holders about securing their trademark rights.

Surprisingly, Rospatent reacted very quickly and according to the law, they are obliged to publish all applications filed with them, but this does not necessarily mean that the applications will be eventually registered. Rospatent further confirmed that all applications are thoroughly and legally examined, and prior right will prevent the registration of identical or confusingly similar trademarks for similar goods and services. It is a relief to notice that Rospatent has kept its word, and all pending bad faith applications have either been refused, or the applicants have not proceeded with the applications, leading to unpaid official filing fees.

Résumé

Riikka Palmos, Senior Partner and Director of Trademarks

Riikka Palmos has been a trademark lawyer at Papula-Nevinpat since 1995. She is also a senior partner in the company and the director of our Trademark Department and the head of Papula-Nevinpat’s Legal Team in Russia. Riikka has 25 years of experience in trademark processes, licensing and assignment of trademarks, protection of well-known trademarks, registration of domain names, registration processes as well as infringement and litigation issues in the Russian Patent Office and Courts. Riikka also has experience in Finnish and EU trademark processes.

Riikka’s expert articles have been published in a number of major IP publications. Riikka is also a popular speaker at Finnish and international conferences and seminars.
Belarusian SWED HOUSE opened its first store in Moscow in April 2023, selling furniture and interior items. At first glance, SWED HOUSE appears to be a near- replica of Ikea, the world’s largest furniture retailer, with the same colors, product range, and even product names. The most surprising fact is that, in addition to the similar colors and product range, SWED HOUSE actually sells original IKEA products and has admitted to doing so.

Although Ikea closed its stores and exited the Russian market in 2022, it still holds the right to the IKEA trademark in Russia. Naturally, Ikea is not pleased with the unauthorized use of their trademarks, similar marketing actions, and misleading associations to consumers. Ikea is not the only company that has suffered from parallel import, such as importers, prices, volume, territory, etc. Previously, parallel import had been prohibited in Russia.

The allowance for parallel import is intended as a temporary measure, valid until 2023 (for pharmaceuticals, until the end of 2024). Parallel import ensures the shipment of goods to Russia, especially in a situation where many companies have left the country or scaled down their business operations. It is important to note that parallel import is allowed only for specific goods, as listed and regularly updated by the Ministry of Industry and Trade.

The list includes categories of goods, brands and company names for which parallel import is permitted. It also contains exceptions of goods and brands for which parallel import is not allowed. As a result, interpreting the list can be quite challenging. The list is regularly updated, with new goods and brands being added and excluded periodically. Currently, the list covers various types of goods, including alcoholic beverages, automotive spare parts, cars, cosmetics, chemical industry products, toys, electronics, etc., with many goods belonging to companies that have left Russia. In practice, monitoring the import of their goods to Russia becomes difficult for rights holders. It is crucial to understand that the companies included in the parallel import list are unable to prohibit the import of their goods to Russia, even if they wish to do so.

The SWED HOUSE case
An illustrative example of permissible parallel import and counterfeiting is the case SWED HOUSE.

In April 2023, EFAC ICCUG restaurant was opened in Moscow by a local restauranteur Mr. Anton Plynsky. Mr. Plynsky has also filed the following trademark applications for restaurant services at the Rospatent:

Trademark applications are currently pending Guccio Gucci S.p.A. is the owner of prior fashion trademarks in Russia, including international trademark 457963 GUCCI device, which also covers restaurant services, bars, etc. Considering the prior trademark rights of Guccio Gucci S.p.A., Mr. Plynsky’s actions should be viewed as trademark infringement of the prior trademark rights of GUCCI and GG, as well as misleading and unfair actions.

In this matter, Guccio Gucci S.p.A. has sent a warning letter to Mr. Plynsky, but no further actions have been initiated yet. Mr. Plynsky denies the infringement and refers to the different fields of business (restaurant vs. fashion) as well as different trademarks EFAC ICCUG – GUCCI.

The situation is challenging for Guccio Gucci S.p.A. The international registration of Guccio Gucci S.p.A’s trademark 457963 GUCCI, including restaurant services, was registered in 1980 but has not been recently sufficiently used for restaurant services in Russia. As a result, the trademark is subject to cancellation on grounds of non-use, which raises concerns about the potential loss of trademark rights for Guccio Gucci S.p.A. Taking action through the Anti-Monopoly Committee is not possible as there are no required competition circumstances between the parties, given that Guccio Gucci S.p.A. is no longer present in the Russian market. Guccio Gucci S.p.A. is likely awaiting the outcome of the pending applications of Mr. Plynsky. The decision of the Rospatent will significantly determine further measures and their success in this matter. If the Rospatent refuses the applications, it is expected that Guccio Gucci S.p.A. will immediately initiate infringement actions against EFAC ICCUG restaurants and will likely be successful. However, if the applications are accepted, Guccio Gucci S.p.A. will need to go through the appeal instances to try to get the applications refused in order to successfully stop Plynsky’s restaurant business.

What does the future look like? Uncertainty and exceptional circumstances undoubtedly cause concern. The situation of companies that have exited the market is under the microscope, with derogations and illegal measures primarily targeting these companies. Defending one’s rights after withdrawal from the market can be complicated, especially as time passes and the rights are not used as stipulated by legislation. It is expected that cancellation actions due to the non-use of trademarks will become more common. Bad faith actions and the introduction of new sanctions and countermeasures can rapidly change the situation. Protecting and maintaining exclusive rights is crucial to prevent the exploitation and loss of rights, as recovering lost rights is nearly impossible. It is also advisable to monitor the IP situation and the market, as several local businesses and individuals are increasingly trying to take advantage of the current circumstances. The good news is that, at the moment, it seems unlikely that Russia is planning to dismantle the IP system, as new companies entering the market also require a functioning system of protection.

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Trademark review suspension changes in China

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**Background of issuance of the trademark review suspension**

In trademark practice in China, we often encounter situations where applicants hope to request suspension of reviews or invalidations while waiting for the outcome of parallel procedures to determine the legal status of cited trademarks, and filing several rounds of backup applications to obtain a higher chance for registration.

In solution and to save judicial resources, the Beijing Intellectual Property Court issued, on June 23, 2023, the “pre-registration” regulation for administrative litigation cases on review of refusal, which stipulates that for those who apply for “pre-registration” solely due to the unstable status of the cited trademark, the “pre-registration” period is 12 months, calculated from the date of filing the “pre-registration” application, and no extension can be applied for. The “pre-registration” regulation has been officially implemented.

To coordinate with the above governance of litigation sources in judicial procedures, the China National Intellectual Property Administration (the CNIPA) recently issued the Regulation on Trademark Review and Adjudication, which has been followed by examiners since the end of June 2023. In the Regulation, the CNIPA stipulates the specific rules on suspension.

Under the “pre-registration” regulation for administrative litigations and CNIPA’s suspension regulation, with the appropriate suspension in the review stage plus the 12 months of “pre-registration” and a certain period of “pre-litigation mediation” in the litigation stage, the time for parties to wait for the results of “parallel cases” will greatly increase, and the related unnecessary cases will significantly reduce.

For the public’s better understanding of the Regulation, the CNIPA released an interpretation article of the “Regulations for suspension of review cases” on June 23, 2023. We summarize the interpretation and provide the following advice in practice.

1. **Specific situations on review suspension**

According to the Regulation, there are seven situations in which the CNIPA should grant the suspension request of the applicant, five of which can be commonly applied to review of refusal cases, review of non-approval of registration cases, and invalidation cases:

- **Situation 1**: The disputed trademark or cited trademark is in procedures of change of name or assignment, and there should be no conflict of rights after completion of those procedures.
- **Situation 2**: The validity period of the cited trademark lapses and is in a renewal procedure or grace period of renewal.
- **Situation 3**: The cited trademark is in a procedure of removal of registration or withdrawal of application.
- **Situation 4**: The cited mark is canceled, declared invalid, or lapses without renewal, and it is within one year as of the day of invalidation or cancellation when the case is examined.
- **Situation 5**: The legal status of the cited mark has been issued and to be effective, or a new official decision affecting the legal status of the cited mark is to be issued soon on an effective judgment.
- **Situation 6**: The prior rights involved must be based on the result of another case being examined by the people’s court or by the administrative organ.
- **Situation 7**: The status of the cited trademark rights involved must be based on the result of another case being examined by the people’s court or by the administrative organ, and the applicant explicitly requests to suspend the examination.

Besides, there are three situations in which the CNIPA may grant a suspension request of the applicant under the examiners’ discretion right:

- **Situation 8**: In a review of refusal cases, the cited trademark involved is pending in invalidation and the registrant of the cited mark has been determined as malicious according to Article 4, Paragraph 4 of Article 19, and Paragraph 1 of Article 44 of the Trademark Law in other cases.
- **Situation 9**: The outcome of similar cases or relevant cases should be used as reference. In such scenarios, the examiners have discretionary right to decide whether or not to wait for the outcomes to be determined or judged according to the needs of the specific case.
- **Situation 10**: Other situations wherein suspension is necessary.

2. **Effects which may be caused to enterprises**

After the suspension regulation is issued, the potential disadvantage for the enterprises may be that the number of trademarks pending in examination will significantly increase, which will delay the completion time of some cases. In trademark registration cases, if the prior trademark rights are eliminated through suspension procedures, the target trademark can maintain the earliest application time, blocking subsequent similar trademark applications. The applicant has an opportunity to eliminate the prior obstacle trademark at once, with a higher certainty. Although it takes more time, the suspension can be used to obtain a relatively certain outcome.

Résumé

Jiezhenn (Amy) Min joined Sanyou in 2002. She has practiced as a trademark attorney for more than 10 years. She has handled and supervised many trademark prosecution cases for many companies in China and abroad.

She has rich experience in strategy-planning on trademark management and protection, and trademark prosecution in China. She is active in sharing trademark practice issues and attended IP conferences, e.g., 2023 AIPPI China Youth IP Seminar as a speaker.


**Notes**

- **Situation 1-5**}
  - commonly applied to review of refusal, review of non-approval of registration, and invalidation

- **Situation 6**}
  - applied to review of non-approval of registration and invalidation

- **Situation 7**}
  - applied to review of refusal only

- **Situation 8-10**

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<th>Review suspension situations</th>
<th>should</th>
<th>may</th>
</tr>
</thead>
<tbody>
<tr>
<td>apply to</td>
<td>review of refusal</td>
<td>review of non-approval of registration, and invalidation</td>
</tr>
</tbody>
</table>
3. Hotspots and Sanyou’s advice on review suspension

3.1 When the applicant should file a suspension application?

Only in the review of refusal cases that meet situation 7, the applicant must submit a request to suspend the case proactively within the three-month supplementary filing period. The examiners shall suspend the case under the applicant’s explicit suspension request. A suspension application submitted after the deadline for the supplementary filing period may be accepted case by case, and the applicant may attempt to file the suspension application if the three-month supplementary filing period is missed.

When applying to situations 1–5 and 6, even if the applicant does not request suspension, the examiners shall suspend the case and resume the case after the cited trademark’s status is confirmed.

When applying to situations 8–10, it is recommended but not mandatory for the applicant to request suspension, the examiners may suspend the case at their discretion.

3.2 Till which procedure on the cited mark will the examiners suspend the review case?

When applying to situation 7 in which the cited mark is pending in review of refusal or in non-use cancellation or further appeal, if a suspension request is filed, the examiners will suspend the review till after the status of the cited mark is finally confirmed. However, when applying to situation 7 in which the cited mark was filed an opposition but was issued an approval decision and then an invalidation was filed, the examiners will resume the review, but not further suspend the review to wait for the invalidation decision since the invalidation is a different procedure.

3.3 How to resume the review under suspension request?

After the cited trademark is issued a cancellation/opposition/invalidation decision which is favorable to the review if the applicant wishes to obtain the trademark registration right sooner, it is recommended for the applicant to submit a copy of the favorable decision as a reminder to the examiners to follow the review and wait for the decision against the cited mark to take effect. The examiners will resume the review accordingly upon the decision against the cited mark which takes effect.

If no resuming application is filed, the examiners will resume the case by themselves which may take longer.

3.4 In a review of partial refusal against a multiple-class application, what does the applicant need to pay attention to?

It is suggested that the applicant file a division application to publish the approved part and to obtain registration on the approved part sooner.

3.5 Will the examiners suspend the review if the applied mark is deemed as dissimilar to the cited mark in a review of a refusal case?

No. In such a scenario, the examiners will examine the case by themselves considering comprehensive elements without suspension even though it is requested.

3.6 Will the examiners issue a notification to the applicant on whether the suspension is accepted or not?

Yes, if the cited trademark’s status is pending, it is recommended to file a backup application when filing a review of refusal with a suspension request. This is because the parallel procedures to remove cited marks may fail and result in the loss of the review of refusal in which suspension is requested. If this happens, the applicant may need to refile their mark and the application date will be late. In other cases, the examiners will examine the case at their discretion.

3.7 Is a backup application required when filing a review of refusal application with review suspension at the current stage?

Yes, if the cited trademark’s status is pending, it is recommended to file a backup application when filing a review of refusal with a suspension request. This is because the parallel procedures to remove cited marks may fail and result in the loss of the review of refusal in which suspension is requested. If this happens, the applicant may need to refile their mark and the application date will be late. In such a scenario, the examiners will examine the case by themselves considering comprehensive elements without suspension even though it is requested.

3.8 Any other tips?

Enterprises need to pay attention to malicious registrations or entities. If the prior obstacle is registered in bad faith, or if the enterprise’s mark is attacked by a malicious opposition or invalidation, the enterprise needs to initiate an opposition or invalidation against the adverse party’s cited mark as early as possible to secure the suspension of its own trademark to avoid losing trademark rights.

With the above newly issued and implemented CNIPA’s suspension regulation as well as “pre-registration” regulation for administrative litigations, we do hope administrative and judicial resources will be effectively optimized, the burden of administrative procedures and litigations for trademark rights authorization and confirmation on legitimate rights holders will be reduced, thus we can obtain high-quality development for trademark careers in China.

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There are three trademark teams of professional staff, consisting of more than 400 employees of whom more than 300 are professionals. Sanyou IP will provide 180 patent attorneys and lawyers to provide services.
In June, the US Supreme Court handed down the momentous decision that trademark lawyers, dog lovers, and even whiskey enthusiasts had been waiting for with bated breath: Jack Daniel’s v. VIP Products. The unanimous Court reversed the Ninth Circuit’s decision that immunized VIP Products from various trademark claims over “Bad Spaniels” – VIP’s squeaky dog toy that mimicked the Jack Daniel’s bottle in several respects. The Court rejected VIP Product’s First Amendment arguments under Rogers v. Grimaldi, and remanded for the lower courts to assess whether Jack Daniel’s can prove likelihood of confusion under the Lanham Act. At the trial several years ago, a consumer survey figured prominently in the trial court’s decision in favor of Jack Daniel’s – this evidence showed a “net” confusion rate of nearly 30%. That same survey evidence was discussed numerous times in the various briefs submitted to the Supreme Court. And, the survey was referenced nearly 30 times during the course of the oral argument. Despite

Michael Keyes, IP litigator at Dorsey & Whitney and consumer survey expert, reports on the use of consumer survey results in the long-awaited Jack Daniel’s v. VIP Products ruling, which gained specific reference in Justice Sotomayor’s concurring opinion.

The Jack Daniel’s consumer survey: is it a veto over mockery?

Legal Survey Questions and Answers

Some companies don’t find our toys as funny as we do... and they try to sue us to try and silence the humor. We’re using a legal survey right now... And what do we have? Surveys here are of course the primary method for getting焦点、在[1]the[1]industry--releasing[1]VIP[1]Products[1]data[1]to other products don’t[1]VIP[1]Products make and Amleading[1]Dog Toys. our product's not[1]with[1]the[1]registration[1]of[1]another company! Correct Answer: [1]it because this product is parodically and this have bottle ideas belongs to VIP Products. Many people believe the key dog toys parodies are odious or offensive to be sued, and this is not the fact. Our method VIP as an affiliation to the bottle to the product. Correct Answer: VIP Products is aañnaffiliated with any other company. What other company you believe that business of this product. Correct Answer: These are not affiliations with any other company. MOST IMPORTANT: Ask such question will we ask why it do you think? for everyone decide. “Because I want a sample!”

2. Id. at *3.
4. Id. at *17.
5. Id. at *47-48.
6. The Court credits that Dr. Ford’s survey establishes likelihood of confusion in this case. The survey followed the Ever-Ready format, considered the prevailing standard for trademark survey research in cases involving strong marks... Dr. Ford’s survey results that 20% of potential purchasers were likely confused is nearly double the threshold to show infringement. VIP Prods. LLC v. Jack Daniel’s Props., 291 F. Supp. 3d 891, 908 (D. Ariz. Aug. 14, 2023). The Ninth Circuit remanded the case to the trial court.

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To alleging claims for infringement and dilution, "no." 12

That some of the answers to the survey in this paper were mistaken belief among some survey respondents that all parodies require permission from the owner of the parodied mark. 13 She then observed that survey answers may reflect giving uncritical or undue weight to surveys. 14

She also noted that survey answers may reflect a mistaken belief among some survey respondents that all parodies require permission from the owner of the parodied mark. 15 She then expressed this concern: "Allowing such survey results to drive the infringement analysis would risk silencing a great many parodies. Well-heeled brands with the resources to commission surveys would be handed an effective veto over mockery." 16

Is this concern justified here? There are some pretty compelling arguments that the answer is "no." For starters, it should be noted that in addition to alleging claims for infringement and dilution, Jack Daniel’s Properties alleged a claim for unfair competition in violation of Section 43(a) of the Lanham Act. 17 Why does this matter? Because that statutory provision explicitly refers to "approval," as being the touchstone for potential liability. It states, in pertinent part, that liability can attach to a party—here, VIP Products—who uses a mark in a way that is likely to cause confusion, deception, or mistake "as to the origin, sponsorship, or approval of his or her goods, services, or commercial activities by another person." 18 Thus, confusion as to "approval" is potentially actionable under the Lanham Act—Congress baked that into the statutory scheme.

Next, the late Dr. Gerald Ford designed the survey at issue in this case that was presented at trial. 19 He used the classic "Ever-Ready" format. 20 While question no. 9 of his survey did ask respondents if they believed Bad Spaniels "is being made or put put with the authorization or approval of any other company or companies," that was not the only question put to respondents. Respondents were also asked:

- Who or what company do you believe makes or puts out this product? (question no. 7)
- What other product or products, if any, do you believe are made or put out by whoever makes or puts out this product? (question no. 8)
- Do you believe that whoever makes or puts out this product... has a business affiliation or business connection with any other company or companies? (question no. 10)

Thus, respondents were queried using a variety of questions to test whether there was potential confusion, deception, or mistake. Only one of those questions—question no. 9—specifically asked about "approval" or "authorization." 21 Moreover, a review of the actual survey data andverbatim responses in Dr. Ford’s report shows significant confusion as to "source," with limited "confusion" that the alleged parody needed Jack Daniel’s approval. Let’s drill into that a bit. The test cell consisted of 232 respondents. 22 Of those respondents answered "Jack Daniel’s" in response to at least one of the questions set forth in question nos. 7-10. 23 Thus, 29.4% of the respondents expressed some sort of confusion (162 + 21 + 29.4% 23 of those 231 respondents for 10.6%) answered "Jack Daniel’s" to only question no. 9—"the approval" or "authorization" question. 24 And, only one of those respondents articulated that Bad Spaniels would need permission to create a "spoof." 25 The remaining 22 respondents articulated verbatim responses focusing on the similar names, bottle shapes, or label designs—all hallmarks of "source identification." 26

But, for the sake of argument, let’s isolate the 23 respondents that answered "Jack Daniel’s" in response to question no. 9 (but to none of the other questions). We would do this to address Justice Sotomayor’s concern and, thus, assume that each of these 23 respondents must have: (1) perceived Bad Spaniels as a parody, and (2) mistakenly believed VIP Products had to obtain Jack Daniel’s Properties permission to create the parody. That still leaves 39 out of 211 respondents for 18.5% that expressed confusion in response to the other questions in Dr. Ford’s survey. And that’s an appreciable amount of confusion in the eyes of a number of courts. 27 Finally, it should be noted that VIP Products is currently marketing Bad Spaniels in an attempt to counteract a consumer survey so that it cannot act as a “veto.” The hang tag now sold with the product (as seen on page 17) now provides the “correct” answers to Dr. Ford’s survey questions. At the top, the hang tag states: "Legal Survey Questions and Answers Some companies don’t find our toys as funny as we do, and they like to do surveys to try and silence our humor."
After listing (and answering) question nos. 7 and 8 from the survey, the hang tag poses question no. 9 (along with VIP Product's answer):

"Is this product put out with the authorization of another company? Correct Answer: NO, because this product is a parody and this funny bottle idea belongs to VIP Products."

It's not clear whether this new hang tag will be of any moment on remand. But it appears clear that VIP Products is not going to simply let a "well-heeled" Jack Daniel's Properties try to use a consumer survey to "veto" its mockery.

In short, Justice Sotomayor's concurring opinion expressed concern that survey data could be used by companies in such a way as to give them "an effective veto over mockery." Is her concern justified here? The Lanham Act, Dr. Ford's survey structure, the underlying survey data suggest it is not.

Mike Keyes is a consumer survey expert and IP litigation partner at Dorsey & Whitney in Seattle. He would like to thank Dorsey summer associate and Columbia Law School Class of '25 J.D. Candidate, Michael Wu, for his valuable research assistance and editing of this article.

Résumé
Michael Keyes is an IP litigator at Dorsey in Seattle. In addition to his legal practice, Mike is a consumer survey expert with a Master's Degree in Survey Research and Data Analysis. He publishes and presents frequently on best practices to be followed when developing survey research for use in federal courts and the Trademark Trial and Appeal Board. You can stay current on key legal developments regarding survey research by subscribing to his LinkedIn newsletter, Lanham Act Surveys for Lawyers. Scan the QR code to subscribe.

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31 Jack Daniel's, 2023 U.S. LEXIS 2422 at *35.
Can you start by introducing yourself and your role at Clarivate?

François Neuville, Head of Brand IP at Clarivate

I’ve been working in the IP industry for 15 years, covering patents, trademarks, and IP litigation intelligence. I lead a dynamic solutions and services team at Clarivate™ that focuses on trademarks and litigation. I am also on a content strategy for the IP customer segment of Clarivate. Content is key and it’s the basis of any good product or solution.

Our brand offering at Clarivate is a combination of the products and services offered by Compumark™, Darts-ip™, and CPA Global, as well as our new tools originating from the combination of the knowledge, skills, and capabilities behind all three. This gives the team a great space to innovate and bring unique products and services to our customers.

Before taking on this role, I was Vice President of Litigation Products and Managing Director of Darts-ip at Clarivate, a role I held since January 2020, based in Belgium. At the time, our focus was to ensure that we leverage Darts-ip data in all of our existing Clarivate products to build unique solutions to our customers’ challenges.

Prior to Clarivate, I was Executive Director for Asia at Darts-ip, splitting my time between Thailand, Hong Kong, and India where I established and managed local offices while leading business development in the region.

How does Clarivate’s data assist with brand protection? Why is this so valuable?

The key differentiator is content – we hold the largest library of curated global trademark data. With the acquisition of Darts-ip, we added unique, and again highly curated, case law data to our collection. We make this data more valuable to our customers by making it easy to search using our unique indexing and categorizations and industry-leading technology such as Trademark Vision image search. With our image recognition capabilities, AI technology, and our peoples deep expertise we can quickly turn data into valuable information and actionable insights.

Our clients need to be able to navigate through an ever-growing amount of information and alerts on brand issues and infringements and they need to find and keep track of this information in an efficient manner.

With over 120 million active trademark registrations around the world and 12 million+ new applications filed annually, trademark professionals are facing the challenges of an exponential growth in data sets when creating and protecting brands. In order to make decisions and mitigate risk, it is crucial to have access to accurate and timely trademark data as well as additional information such as opposition success indicators, owner assessments, and litigation strategy.

How is Clarivate leveraging AI to improve brand protection? Why is this so valuable to your clients?

First, I would like to point out that AI technology is not a “new” for Clarivate. There are a range of different AI tools that can be used to solve problems and increase efficiency. For some tasks generative AI is not always the optimal solution. We have created a number of AI models over decades and incorporated them in our products and workflows, such as the neural networks for our watch system, and the image recognition technology for our do-it-yourself device search capabilities. Clarivate was using semantics technology and generative AI in our Naming Tool years before the current hype emerged.

For the latest predictive AI models which we are currently developing and rolling out, we are adding additional focus around critical data points such as verbal similarity, and case law. AI should not replace expert decision making, rather support it by providing better accuracy, focused result sets, and more visibility on critical connections.

- The predictive AI we are developing, which includes our Watch Opposition Strength Score, Verbal Similarity Score, Goods and Services Similarity Score, Goods and Services Case Law Prediction Score, and Product Case Law Prediction Score integrated into different Clarivate products such as the Brand Landscape Analyzer, is based on our unique trademark and case law data and the deep expertise of our own experts in data science and operational teams.

- So, for our customers it feels like we add our analysts’ and industry expertise as a bonus to the do-it-yourself experience. We are convinced that the combination of our expertise with the AI technology is what gives us the cutting edge in the current competitive market space.

How is Clarivate ensuring that the results generated by AI can be trusted?

Artificial intelligence can only ever be as good as the input data. At Clarivate we are well-placed to capitalize on this because we have billions of properties in-class data sets which are expertly curated and interconnected. These data feed our machine, deep learning, and large language models. This enriches our information and powers our insights, services, and workflow solutions.

In brand IP, we also have over 45 years of human trademark search analysts’ expertise as well as 15 years of litigation data analysis which always has been the gold standard in the industry and which we are now leveraging for predictive AI technology. Going forward we will continue to leverage the expertise of analysts to further reinforce the AI learning.

AI from our perspective isn’t replacing the legal expert’s decisions, it provides tools in the toolbox of our customers that emerge and visualize critical data points for consideration in their assessment of risk, but our customers are the ones in the driver’s seat. We are looking at AI as a sort of “navigation system” that guides you through piles of data points and shows you where the roadblocks and roadworks are, but you are driving to your destination.

Our main goal is to bring more value to customers through augmenting the answers generative AI models can provide using our own data. By using our own best-in-class data assets, we will also reduce the likelihood of LLM starting to “make up” or “hallucinate” answers, which is currently something open-source LLM models tend to do.

Clarivate has a long-standing history in responsibly investing in and developing innovative IP technology. Our commitment is to leverage AI responsibly to help our customers confidently think forward as they embrace future technologies, knowing they can rely on our unwavering partnership.

How can Clarivate assist brands in preventing damage from infringement?

According to our Trademark Ecosystem Report, nearly 90% of the brands we surveyed experienced some level of infringement in 2020, so it is not a matter of if, but when and where your brand will encounter infringement. We assist our customers through global trademark watch services based on timely, curated, and global data. Easy to use platforms provide alerts when potentially infringing trademark applications are filed.

With a new predictive opposition score, we also help customers to better understand the likelihood of success to oppose in jurisdictions they are maybe not so familiar with from a legal perspective, which again can save time and focus on fighting the right battles. The opposition score takes into account the working practices of the local courts. If verbal similarity between a pair of marks is judged differently by the EUIPO compared to the ITC (for example based on language or local practices), the opposition score for each jurisdiction is adjusted accordingly.

In our new generation Watch solution – Trademark Watch Analyzer – which we are currently developing – we are also building in more of that rich contextual data that will support quick and efficient risk assessment of newly filed critical trademarks.

How does Clarivate’s brand analytics aid in researching relevant results?

We are embedding analytics in our next gen products like Brand Landscape Analyzer and Trademark Watch Analyzer to make contextual data on owners, global coverage, and use of the mark more complete and more robust. By adding visualizations into our products, we want to make it easy to interpret result sets. Bringing more analytics into products is something we will be developing further in 2023.

We can also provide customized analytics reports. We have millions of curated trademark records and case law records which we can pull together in reports and solutions like Tableau and Business Intelligence to provide insights on understanding competitive landscapes, filing activities /strategies, understanding litigation activity, etc.
How does Clarivate trademark management enrich a portfolio and why is this important? Managing a trademark portfolio is often very time consuming and involves a significant number of tasks that are administrative by nature. Clarivate offers a range of products and services within the entire lifecycle of a trademark that address those tasks and help our customers to make portfolio decisions faster so that they can focus on other areas of expertise. Clarivate has one of the largest IP admin teams in the world with significant experience in providing trademark services on a global basis and at scale. This expertise combined with our technology and data is a big differentiator in the market and the reason why customers are entrusting us with their valuable portfolios.

What sets Clarivate apart from alternative IP service providers? We are in the unique position to assist our customers along the entire IP lifecycle, not only from a Brand perspective but also from a Patent perspective. We provide Intellectual Property searching and monitoring services as well as filing services. We also have teams that can help with portfolio maintenance services like records, data validations, etc. Through IP Management Software and integrations of other data in these systems, we also help our customers to support their IP workflows and protect their IP assets.

Clarivate builds on over 100 years of experience from our legacy companies and acquisitions to offer deep industry expertise, advanced technology, quality of data, and the broadest range of IP products and services in the market. We have always been pioneers when it comes to the processes and standards that are used across the IP services sector.

We continue to innovate in our technology space, making big steps developing and patenting technologies that bring value to our customers. For example, for Brand Landscape Analyzer we have eight patents pending or granted.

What is Clarivate currently working on that will continue to reinforce the brand protection services offered? We are focusing on a next generation of search and watch solutions combining our existing industry standard technologies with new advanced AI and other technology to create a focus on critical results and provide context and analytics through advanced visualizations. We want to support our customers’ workflows in a consistent way.

Traditionally, our customers would get a list of similar names to go through and look up in other sources’ extra context to assess commercial risk. We want to make sure that, as far as possible, this workflow can be done in just one platform and make it easier for our clients to find the signal within the noise so that they can make better, faster, and more confident decisions.

Can you tell us about the Brand Landscape Analyzer? How does it assist with legal and commercial risk assessments? The Brand Landscape Analyzer is a trademark research solution that uses AI predictive scoring, trained on our own expertise and content, to provide focus on the most critical marks. It also presents additional context to formulate risk assessments.

We check case law and other sources to give clarity on absolute grounds obstacles and provide verbally similar marks to give an overview on possible relative grounds issues to cover the overview of legal risks. We provide all the additional context on the litigiousness of an owner, geographic presence, in use, etc., to help customers in assessing commercial risks.

What do you believe to be the top three considerations for protecting brands efficiently? And how can Clarivate assist its clients with these elements? Clarivate provides accurate, searchable global data for protecting brands efficiently and we continually strive to raise the industry standards.

The first consideration is to have world-class trademark record data with additional important data points like case law. This provides customers with a breadth of knowledge of the global brandscape.

The second consideration would be having easily accessible data. Our customers have to weed through the exponentially growing data sets and to focus on the most critical marks. Our advanced technology can support these challenges and processes and make our customers more precise and fast in their risk assessment.

The third consideration for protecting brands efficiently is having a simple workflow. Our customers are looking for ways to work quickly and efficiently. From trademark searching and monitoring to filing and portfolio maintenance which includes data validation, records, etc. Clarivate is developing workflow simplifications to cover those needs. Having integrated our world-class data into our IP Management systems, we help our customers to support their IP workflows and protect their IP assets.

Leveraging more than a century of collective experience from our legacy companies and acquisitions, Clarivate combines profound industry expertise, cutting-edge technology, data of exceptional quality, and the most extensive array of intellectual property products and services available in the market.
Trademark infringement on social media

Ricardo Costa Macedo and Adriana Magalhães of Caiado Guerreiro assess criteria for what constitutes trademark infringement on social media with guidance for methods of protection.

As important intangible assets of companies, trademarks are exposed to a high risk of infringement on social media. They should therefore be protected, both through monitoring and immediate reaction to infringements in the digital environment.

In an increasingly globalized world, social media is considered a link between people and, in particular, a link between consumers and businesses. Currently being one of the main marketing and communication tools, the good name and economic value of trademarks depend heavily on their recognition and immediate reaction to infringements in the digital environment.

While it is true that social media allows businesses to reach a far greater number of consumers when compared to traditional forms of communication, it is also true that the risk of trademark infringement increases exponentially on such platforms.

A trademark serves to distinguish a company’s products or services from those of a competitor. It is important to recognize that trademarks are assets of their owner, which not only attract customers by virtue of the recognition of the trademark and the quality of the products or services that they mark, but also hold significant value in business transactions, which is why they can be assigned or licensed.

As an asset, a registered trademark also grants its owner several rights, including the exclusive use of the trademark in the marketplace. This exclusive right is intended to prevent confusion in the public’s mind as to the origin of such goods or services, encouraging healthy competition and avoiding unfair competition.

A trademark infringement can occur when an individual uses a trademark without the owner’s permission in a way that may cause consumer confusion or consumer deception. This is one of the main infringements of intellectual property rights seen on social media, especially when it comes to famous or well-known trademarks, where recognition of the quality of the trademark determines its economic value.

Not every use of a third party’s trademark on social media is an infringement. It is important to note that not every use of a trademark without the consent of its owner will constitute infringement of industrial property rights.

The most noticeable example of this idea is the possibility for a person to refer to a third-party trademark to comment, criticize, praise, parody, or evaluate the products or services that it marks, so long as it is not done disproportionately. This is part of an individual’s freedom of expression and is called “fair use.”

Another example is the possibility of identical trademarks coexisting in the market when they indicate distinct products or services and are not likely to mislead consumers as to their business origin.

For example, it is possible to register the trademark “XPTO” to indicate stickers, just as it is possible to register another trademark “XPTO” for rockets, because the public is unlikely to confuse the business origin of such products, even if they are marked with identical trademarks.

Trademark protection on social media

The first and best method of protecting a trademark on social media is to register it prior to its first/initial usage, in order to avoid conflicts with other trademarks that are being used or will be registered in the national market.

When a business is targeting a wider and more diverse audience on social media, it is also advisable to consider the countries of access or the residence of the relevant consumers and register the trademark in those territories, so as to be able to legally react to infringements that occur across borders.

The intention is to register the trademark in more than one country. There are three ways to achieve this: (i) by registering the trademark individually in each country where protection is sought; (ii) through a single trademark with effect in certain regions, such as the European Union, Benelux or certain African states; or (iii) through a single international application identifying the various territories where the trademark is to be protected.

Another example is the possibility of identical trademarks coexisting in the market if they indicate distinct products or services and are not likely to mislead consumers as to their business origin.

Trademark protection on social media

The date of commencement of use of the trademark; and

- The territory where it is registered and being used.

One issue that may arise with the use of a trademark on social media is the apparent lack of physical borders, as rights to a trademark are limited by the geographic territory where it is protected and being used by the owner.

Thus, if a trademark is registered only in Portugal, its owner may not be able to prevent people from using it to mark an identical business in another country.

Misuse of a trademark on social media

An infringement occurs when a competitor in the same business area uses another’s trademark or a similar trademark in the course of its business activities, without the consent of the trademark owner.

On social media, it is possible to identify this type of infringement, in particular with the use of hashtags in content publications, carousel posts, stores, reels, videos, comments, or photographs on a corporate page, or a page that has the inherent objective of making a profit, where a third-party’s trademark is placed or mentioned as if it were one’s own or in order to create an association in the public’s mind between the third-party’s trademark and the trademark of the person who is using it improperly, when in reality there is no type of partnership between the owner of the trademark and the infringer.

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Trademark Infringement on Social Media

As a means of protecting the trademark during the term of the registration, the trademark owner may use the symbol ® on their products.

Another protective measure that can be taken by a trademark owner is to regularly monitor the trademark’s presence on social media in order to identify possible infractions as soon as possible. Social media monitoring tools or specialized companies can be used for this purpose.

Tackling Trademark Infringement on Social Media

Once a trademark infringement has occurred, the trademark owner has a few options for action:

1. Attempt to resolve the matter amicably by notifying the infringer in writing of the trademark right infringement and requesting that they remove the trademark from their social media account;

2. Report the infringement to the social media team by filing out the online form on the platform for intellectual property infringement reports, attaching evidence of the rights invoked;

3. Take legal action, such as reporting the offense to the relevant authorities due to the abusive appropriation or misuse of the trademark, particularly where the third-party presents itself as the owner of the trademark in question; filing a lawsuit in court requesting that the infringer be required to remove the trademark from their account on the social media, while also requesting payment of compensation for damages; or filing a criminal complaint for illegal use of the trademark, particularly if it involves counterfeit or imitation of the trademark.

Conclusion

In conclusion, trademarks represent assets of their owner and social media is an environment susceptible to infringements that may jeopardize a trademark’s good name and associated economic value, with possible consequences at a global level. Thus, it is of utmost importance to protect these assets and react immediately to possible infringements. Fortunately, there are several courses of action available to trademark owners.

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We are celebrating 25 years of building a reputation of a trusted partner for IP professionals.

The Team behind WebTMS is excited about what the future holds in IP software development.

Get in touch with the Team behind WebTMS to find out more about what’s new.

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As a matter of introduction, the Mexican Institute of Industrial Property (IMPI) plays a crucial role in overseeing the transformation of international registrations into national or regional applications under the Madrid Protocol. This article explores the application criteria outlined by IMPI and the relevant amendments to the Federal Law for the Protection of Industrial Property, particularly focusing on the impact of these criteria on the validity of trademarks obtained through the transformation process. Additionally, we will examine the benefits and criticisms associated with this transformation process and the significance of the new substantive and formal examination in ensuring legal certainty.

Mariana Patiño of OLIVARES details the application criteria of the Mexican Institute of Industrial Property in relation to the validity of international registrations subject to transformation by virtue of the amendments to the Federal Law for the Protection of Industrial Property.
cancellation by the office of origin, the figure of transformation set forth in Article 9 quinquies of the Protocol establishes a process whereby enables trademark holders to convert an international registration into a series of national or regional applications, offering several advantages to the trademark holder. Titleholders have a three-month window to request, directly before the contracting offices where the international registration had effect, the transformation of the international registration into a series of national or regional applications. The resulting national or regional applications maintain the original filing date, thereby preserving the right of “preemption” and allowing the holders to enjoy recognition of priority if it was claimed earlier in the international registration. The three-month window to initiate the transformation process starts running after receiving WIPO’s notice of ceasing of effects or the so-called recordation of the cancellation of the international registration in the International Register.

Benefits and criticisms of the transformation process

The transformation process offers significant benefits, including the retention of the original filing date and the recognition of priority rights. This facilitates the protection of trademarks in multiple jurisdictions, simplifying the administrative burden for trademark holders. However, criticisms arise from the fact that each Contracting Party or Designated Office has the authority to establish specific criteria for transformation. Consequently, the uniformity and consistency of the process may be affected as the Protocol and the International Bureau is no longer directly involved. This can lead to fluctuating standards and requirements, making the process less predictable for trademark holders regaining protection in multiple jurisdictions.

Impact of the Federal Law for the protection of industrial property

The interim application of the Federal Law for the Protection of Industrial Property, which took effect on November 5, 2020, holds implications for the validity of trademarks obtained through the transformation process. The law provides that the term of validity of trademarks is established from the date of grant instead of from the filing date as our previous IP Law used to establish. This raises the question of which criteria will be applied to applications undergoing the transformation process.

According to the criterion of IMPI examiners, the effective date of transformed applications will align with the international filing date if the file assignation of the new national file number was agreed and issued before November 5, 2020. Regardless of whether the transformation request was filed before the aforementioned date. Consequently, if the national dossier number was assigned after November 5, 2020, the validity period of the transformed application will be 10 years from the date of granting the national registration. Therefore, the date of issuance of the official communication approving the transformation holds paramount importance in monitoring the declaration of obligation deadlines and maintenance renewal dates.

Now it is worth mentioning that every transformation petition is subject to a new substantive and formal examination with the aim of safeguarding the principles of legal certainty and maintaining the integrity of the trademark registration process.

Furthermore, while the requirement for a new substantive and formal examination aims to ensure the compliance of transformed applications with local laws and regulations, there have been instances where the process has faced challenges. As local agents, our responsibility is to closely observe whether the substantive examination is conducted in strict accordance with the law. Unfortunately, in practice, it has been observed that the Mexican Institute of Industrial Property (IMPI) may cite registrations with a date later than the filing date of the transformation application, which has benefitted from the right of “preemption.” This occurrence has raised concerns among trademark holders and local agents as it can hinder the transformation process and lead to additional investments in rectifying arbitrary citations. The citation of registrations with a later date than the filing date of the transformation application seems to contradict the very purpose of the “preemption” right, which is intended to maintain the original filing date of the international registration.

Such instances create uncertainty for trademark holders who, in good faith, initiated the transformation process expecting the preservation of their original filing date and granted rights. It can also introduce unnecessary delays and additional administrative burdens as trademark holders are compelled to address these arbitrary citations, diverting resources away from their core business activities.

To address these challenges and ensure a more streamlined and transformational process, it is imperative for IMPI to exercise due diligence in conducting the substantive examination. Local agents and trademark holders alike expect a fair and transparent evaluation of the transformed applications. This entails careful scrutiny of relevant trademarks already registered in the jurisdiction to avoid unwarranted citations and to uphold the right of “preemption” in their true spirit.

Enhancing communication and collaboration between trademark applicants, foreign counsel, local agents, and IMPI is a possible solution to the aforementioned issues. A transparent dialogue can help clarify any ambiguities regarding the transformation process and ensure that all parties involved are engaged with the same understanding. Additionally, seeking feedback from trademark holders and local agents on their experiences and challenges can help IMPI refine its examination practices standardize clear guidelines to minimize discrepancies and ensure an efficient transformation process, while safeguarding the principles of legal certainty and fairness.

Moreover, introducing mechanisms for trade-mark holders to challenge arbitrary citations through efficient and accessible appeals procedures can enhance the accountability and fairness of the examination process. This would not only allow for the rectification of erroneous citations but also reinforce the confidence of trademark holders in the transformation process.

Ultimately, the effective implementation of the transformation process and its examination criteria is vital to promote foreign investment and innovation. A smooth and predictable transformation process enhances Mexico’s attractiveness as a destination for international trademark protection, encouraging more businesses to re-visit protection in the country and stimulating economic growth. We would be delighted to assist you with your transformation application.

Résumé

Mariana Patiño, Attorney

Mariana joined OLIVARES in 2017 as an attorney of the Trademarks team in Mexico and abroad. Her practice is focused on Industrial Property matters, mainly consulting, registration and prosecution of distinctive signs. Her experience includes conducting availability searches, preparation, filing, follow-up of applications, and the handling of requirements and provisional refusals before the Mexican Institute of Industrial Property, drafting of license agreements, franchises, mergers, and transfer of rights, as well as negotiation of coexistence agreements and planning of strategies for the protection of intangible assets abroad.

Represents national and foreign clients in matters related to Intellectual Property rights across a range of industries, such as digital media, entertainment, hotel, and various consumer goods.

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It is worth mentioning that every transformation petition is subject to a new substantive and formal examination with the aim of safeguarding the principles of legal certainty and maintaining the integrity of the trademark registration process.
EU design law: strategic considerations for Registered Community Designs


Registered Community Designs (RCDs) are an excellent option for the protection of product designs as they offer many advantages for the applicant. They provide quick and EU-wide protection, whilst being cost-efficient and easy to handle for the applicant.

The volume of applications received by the European Union Intellectual Property Office (EUIPO) is constantly high. In 2022, the EUIPO received more than 100,000 RCD applications (including direct filings and filings through the WIPO Hague System). According to the recently published Consolidated Annual Activity Report 2022 of EUIPO, the unstable global situation only led to a slight decrease in RCD applications compared with 2021.

In day-to-day legal practice, however, the picture is often quite different. In many companies, there is a lack of sensitivity as to which new products could be protected as designs or Community designs, and why such protection is advisable. Save time, effort, and money by registering EU designs For applicants seeking design protection in the European Union, it is regularly recommended to apply for an RCD. These rights are administered by the EUIPO based in Alicante/Spain and are valid in all member states of the European Union.

Providing the applicant operates exclusively in one EU member state, an alternative option is seeking registration for a national design with the IP office of this EU member state covering a single country only. For example, German applicants can apply for a national design with the German Patent and Trademark Office (GPTO) in Munich. This right only provides protection throughout Germany and is somewhat less expensive than an RCD. However, as soon as a further country is to be covered, national designs generally have a financial disadvantage compared to RCDs.

Of course, natural or legal persons based outside the European Union, who do not have their domicile or principal place of business or a real and effective industrial or commercial establishment in the EU, can also apply for an RCD. They are generally obliged to appoint a representative within the EU for all proceedings before the Office, other than filing the application.

It is important to understand that there are two different options to pursue the RCD application: it can be filed directly with the EUIPO resp. the central industrial property office of an EU member state or, alternatively, be included in an international design application with the World Intellectual Property Office (WIPO) designating the European Union. Either way, the RCD provides uniform protection for all (currently) 27 EU member states.

Résumé

Dr. Verena Schladt, Attorney at Law

Verena Schladt joined the renowned IP firm KUHNEN & WACKER in 2017. Having studied law at the University of Regensburg and worked as a junior barrister at the Nuremberg Higher Regional Court, Verena Schladt joined the Bar Association in 2009 and obtained her PhD from the University of Regensburg in 2013.

As one of KUHNEN & WACKER’s certified IP Lawyers of the legal, trademark, and design department, she has filed a multitude of EU trademark and EU design applications and is deeply committed to obtaining and enforcing IP protection for K&W’s international and national clients. Her special fields cover trademark law, design law, competition law, copyrights, complaint proceedings, infringement proceedings, license and cooperation agreements, and product piracy. Before joining KUHNEN & WACKER she worked for an IP law firm in Munich.

Verena Schladt writes on IP-related matters and is a member of INTA and the German Association for the Protection of Intellectual Property. She is proficient in German and English.

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EU DESIGN LAW

A single application is sufficient, which can be filed in any official language of the European Union. The fees for the application are also payable solely to the EUIPO. If the applicant seeks protection not only for the product itself, but also for some variations, for example, different color combinations, or a certain product line, several designs can be combined in a multiple application. A multiple application contains two or more designs within the same application but each of the designs is examined and treated independently. As the costs for a multiple application are substantially lower (varying depending on the number of designs) than filing separate design applications for each product, this feature enables applicants to handle the designs more efficiently and to protect their products more cost-effectively. To file one view showing a part of the full product, with protection for this part only.

Take care of the graphic representation

In contrast to national design registrations in various countries, the scope of protection of an RCD is determined exclusively by the graphic representations filed with the application. Applicants should therefore present the graphic representation very carefully, as errors can easily occur. In the worst case, bad representations may lead to the invalidity of the design.

Above all, care must be taken to file a clear and complete graphic representation of the product. According to EU law, one up to a maximum of seven views of the product to be protected is required for the design application. Computer drawings or photographs are particularly suitable for this purpose. The views may be in plan, elevation, cross-sectional, in perspective, or exploded. This graphic representation should include all the features of the design so that the object of protection of the design can be determined clearly and unambiguously based on the views. In order to ensure legal certainty, although the application can contain further indications, such as descriptions, the graphic representation of the designs alone is decisive for the scope of protection of the design.

EU law allows applicants to protect a multitude of special types of designs, some of which are inadmissible in other jurisdictions. It is remarkable that one single figure of a design is sufficient, and, in some cases, a single illustration may provide broader protection than a complete representation of the product from all sides. Even if the overall impression of the designs to be compared is similar as regards the front view, the latter design can have individual character because it differs in the side and back view. However, if the front view of the prior design is protected as a single view, this argument cannot help the infringer.

Often, in addition to a perspective view, the applicant selects other views encompassing the front view, top view, side view, and others. All figures of an application must refer to the same product. The application will only be correct if all views are consistent. Besides the product, no other objects may be depicted in the background. Furthermore, no other elements may be added to explain the design, such as an indication of measurements or proportions.

The easiest and most efficient way to protect a portion or a part of a product is to file a separate design just for this specific part, either as a fully separate EU design or as part of a multiple design application. Under EU law it is advisable to simply file one view showing a part of the full product, with protection for this part only.

Various types of views are also permitted, including partial or sectional views, and exploded views. Exploded views are views where parts of a product are shown disassembled, to clarify how the parts fit together. All the product’s parts must be shown disassembled in a separate single view and combined with at least one view of the assembled product.

It is also possible to protect “moving designs”, i.e., a short sequence of views used to show a single animated design at different specific moments in time. In a clearly understandable progression, for example, animated icons or animated graphic user interfaces.

These various design types allow the applicant to choose the best option, depending on the characteristics of the product for which protection is sought.

International filing strategies

For design protection outside the EU, applying for an International Design at the International Bureau of the World Intellectual Property Organization (WIPO) should be considered. In addition to the EU, many other economically interesting countries, such as the USA, Switzerland, Norway, Great Britain, Japan, and China, can be covered by this protective right. Instead of filing individual applications with the respective national offices, a single application is sufficient for this purpose – similar to the RCDs.

Unlike the EUIPO, the application process for an International Design does not end with the completion of the formal examination by WIPO.

A further substantive examination may follow if this is required according to the regulations of the countries in question. The offices of all designated countries examine whether the application complies with the national requirements for registration, for example, whether the designs are not contrary to morality, whether descriptions are attached, and in some cases whether the designs are new. Therefore, when applying for an International Design, care should be taken to consider the specific provisions of the individual countries, especially with regard to the EUIPO’s special design types that are not automatically admissible according to national law.

Outlook: planned design law reform of the European Commission

As the design protection system in the EU is more than 20 years old, the existing EU design law is currently being revised with the aim to update the design protection to the challenges of the digital age and at the same time make it even more efficient for applicants.

The European Commission presented their suggestions for a revised Regulation on November 28, 2022. Amongst others, the definitions of the terms “design” and “product” shall be specified. The new definitions explicitly cover digital forms of expression, for example, movements or animations, as well as spatial arrangements of goods and other items (such as store interiors). Graphical user interfaces, and lines. In addition, the protection regarding software for 3D printing is extended. These and further planned expansions aim to close existing gaps of design protection in view of the technological achievements and to further simplify the registration process. Another update concerns the terminology. Due to harmonization reasons, the designation “Community design” is to be replaced by “EU design” in the future.

The intended changes mean an important step toward further optimization of the EU design law in favor of the applicant. But already today, the RCD offers quick and effective protection of one’s own product against possible competitors. Since, in principle, almost any new product can be suitable as a design application, entrepreneurs should keep this in mind as early as the product development stage.

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They provide quick and EU-wide protection, whilst being cost-efficient and easy to handle for the applicant.

Under EU law it is admissible to simply file one view showing a part of the full product, with protection for this part only.
Women in IP Leadership
Celebrating achievements and continuing the empowerment of women
This segment is dedicated to women working in the IP industry, providing a platform to share real accounts from rising women around the globe. In these interviews we will be discussing experiences, celebrating milestones and achievements, and putting forward ideas for advancing equality and diversity.

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

If you would like the opportunity to share your experiences with Women in IP Leadership, would like to nominate an individual to be involved, or would like to learn more about sponsorship, please contact our Editor.
I would encourage young lawyers starting out to embrace a general practice, covering all aspects of the law and doing a variety of work, no matter how menial it may seem - a bit like a Karate Kid initiation!

What would you consider to be your greatest achievement in your career so far? A high point that I hold dear would be the evolution of my career in IP, expanding from traditional forms of IP, and developing this practice to include other areas, particularly technology media and telecommunications (TMT). The TMT practice started around 1996, and the 1990s were an exciting time to embrace the tech world and integrate it with law, especially with the surge in work in light of the dot-com boom.

As a relatively young woman lawyer in a predominantly male industry, it wasn’t easy during the early years as I faced skepticism about my abilities. However, these challenges merely fueled my determination to persevere. Today, I am delighted to witness how the IP and tech practices (as well as the product law and privacy practices) have flourished from seeds planted from the IP practice, with each thriving as separate and independent practices.

Moreover, I’m proud to say that our IP department, and possibly our firm, is made up of more than 50% women. It is particularly gratifying to note that our TMT practice, despite tech traditionally being male-dominated, is composed of 80% women and highly regarded in the industry. This is a testament to the progress the team has made in promoting gender equality and I hope that our example will inspire other women and young lawyers to break barriers and make their own mark.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years? As an employer, I advocate for a change in mindset regarding recruitment and promotion. My firm is committed to equality but I do know of many establishments or businesses that are not as committed, especially if the client-base is dominated by a particular gender or if there are societal and cultural biases that are hard to dispel. Women face dual pressures from work and home. I may be generalizing, but as more women enter the workforce, patriarchal economic mores and norms can amplify these pressures, creating an unrealistic “superwoman” ideal of a woman’s role being that of a wife, mother, carer, educator, as well as professional. The “superwoman” label, while seemingly empowering, isn’t always positive. In fact, it creates unnecessary added pressure on women to perform and compete in being the best at every aspect of work, home and hearth. Instead of striving to achieve this unrealistic idea, we should encourage each other to be the best versions of ourselves, balancing our personal and professional lives in a way that healthy and sustainable. I am heartened to see a more understanding and balanced approach towards women in the workplace and I hope this trend continues to grow.

For those with family pressures, practising self-care and understanding that we all cannot be superwomen 100% of the time is a good start.

How do you think the empowerment of women can be continued and expanded in the IP sector? In this era, I’ve witnessed women in the IP sector and beyond making great strides toward independence, equality, and empowerment. While many may feel that bigotry and inequality are inevitable, I firmly believe in our capacity to effect change. Yes, the truth is that diversity can divide if not embraced, and issues of color and gender can result in differential treatment. The arguments for justice and fair play are known to most but whether it is practiced is a different matter altogether.

However, I wholeheartedly disagree that we cannot make a difference. If I practice what is just and right, I have already made a difference to at least a few people. By upholding these principles in our own actions, we can influence those around us. In my team, I will not tolerate gender discrimination, and I strongly believe neither does the firm I work in.
Women's Health

Minh Hoang Merchant: General Counsel & Secretary, Aspira Women’s Health

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

What inspired your career? When I was young, I wanted to follow in my parent’s footsteps but in college I quickly realized that I did not want to be a civil engineer. I looked at my skill set: I enjoy reading and writing and linear thinking, and that seemed most suited for pursuing the law.

I specifically pivoted inhouse into healthcare because of my personal experience with a deeply impactful health situation in my family. I had a front-row seat to view how healthcare – in America at least – was failing. If there was something I could do to help move the needle in patient care, then that’s where I wanted to focus my career. I became very mission-driven in my professional choices as I continued to move through the ranks.

What would you consider to be your greatest achievement in your career so far? So far, I am incredibly grateful to be where I am – I put myself on a path to be a public company general counsel of a healthcare organization where I am impacting the lives of patients in a really meaningful and significant way. I’m incredibly proud of that. I stand behind the products that we have in the ovarian cancer risk assessment space. Women who are on this ovarian cancer journey can benefit greatly from our tests and knowing that I have helped to significantly move the needle on their medical management is really meaningful and significant way. I’m incredibly proud of that. I stand behind the products that we have in the ovarian cancer risk assessment space. Women who are on this ovarian cancer journey can benefit greatly from our tests and knowing that I have helped to significantly move the needle on their medical management is.

What challenges have you faced? and how have you overcome them? I think it’s important to know what your strengths are and to know what gaps you have and how you can address them; you can address them organically by trying to gain experience in those areas, you can try to learn on the fly, or you can partner with people who have expertise. Or do a combination of these.

Being able to assess your toolkit and see what you need to learn to progress to the next role is really important and knowing that you can stretch into a role will help you move forward even when you don’t have 100% of that skill set yet.

How have you found the pathway to your current position? And can you offer advice from your experience? What’s incredibly interesting to me is there’s no linear pathway as far as I can tell from my own experiences and those of others who have shared their journey with me; mine was certainly more circuitous than I had ultimately planned it to be right out of law school. I went from law school into private practice, and I was there for almost nine years. I thought that I was going to be a partner but for a number of reasons I decided that that was not the path for me. But I was still really invested in anchoring my career in the law and so pivoted inhouse.

From private practice as a litigator, I transitioned into an inhouse litigation role. Then, in order to actualize my dream of becoming general counsel, I felt I had to gain a deeper bench and breadth in subject matter experience. At McKesson, I focused almost exclusively on litigation and government investigations – it was fantastic but I needed to “move out to move up.”

Thus, my next move was to embrace a healthcare regulatory role at a smaller organization where, due to size and resources, there was a forcing function to wear all of the hats – and I loved that breadth of experience! There, I really was able to develop those muscles in areas that I hadn’t had a chance to flex before.

My advice would be to move forward with intentionality. I did not want to rely on serendipity to get to the next step, and I encouraged others to move forward on a path with an intended outcome or a plan to effectuate, of course, a key to this is to be flexible and nimble, so that if you decide on a direction, you can be ready to pivot to a new direction or course correct as needed.

What changes would you like to see in the IP industry regarding equality and diversity in the next five years? It’s no secret that women make up a large population of the students at law schools. Then, for private practice, the statistics start to really decline, and the data points are extremely disappointing. If you look at the in-House side, you’ll similarly find there are not many women GCs or CLOs; and among those few, even fewer are minorities. We have to ask ourselves what the root cause of this decline is. What is prohibiting these women from rising to the leadership ranks? Is it that they don’t look like the people who are across the table from them? Or do they have other pressures that somehow others believe should hold them back? (Whether it’s family pressures or other responsibilities.) Is it because they are not putting themselves forward because of imposter syndrome? Or do they lack the right allies?

I think what we can try to do – women who are leaders and in particular those who are also ethnic minorities – is to help move people along with us. There are lots of organizations that are focused on that. A lot of mentoring opportunities are available to those people who are thinking of putting themselves on that track. But it’s still incredibly challenging and the numbers are dismal. I’ve benefited from having female CEOs in my current and previous role, which is very rare.
When you look at industries in terms of a pyramid structure with the C-Suite at the top, the numbers get even smaller in healthcare so the fact that both my past and present CEO have been women tells you a lot about what my experiences have been, which is, unfortunately, probably not reflective of other people’s experiences.

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

I think there are a number of ways to tackle this, and fortunately, there are many ways towards a solution. It may well come down to death by a thousand cuts: what is going to work? And it may well be a multitude of factors, including organizations that support women, giving them the right toolkits for success; key partnerships with mentors; the right network - professional network is invaluable to professional success - there’s a correlative relationship, so committing to building those relationships will rebound in benefits. We need to make sure that organizations help foster connectedness so that women have the right relationships and networks to advance.

In looking at the root cause for the lack of women in these key roles, I suggest we assess the point at which women drop off after law school, and what is it that we can do to challenge this model? Can we also look at empirical data from organizations that have a larger percentage of women and analyze their successes, or conversely their failures and, with a growth mindset, adapt and grow based on those learnings? Is it a concerted effort to reduce implicit bias for women who may choose to take family or maternity leave and come back at something less than full time?

I think that nowadays as women, and especially minority women, we are always faced with breaking all manner of ceilings - the glass ceiling, the bamboo ceiling, the ceilings are multitudinous in number! - and shining a light on that is really powerful but so too is having a positive role model that looks like you; they did it, so I can, too! Aspiring young lawyers and people in the middle of their careers currently look out into this field and may see no one who resembles them. So to those who have achieved great things, we should make sure to repeat: “I did it! You can do it, too! And, what can I do to help bring you along?”
Throughout the next few pages, you will view a comprehensive list of the 10 most well-respected law firms from North & Central America, the Middle East, and Africa, in alphabetical country and company order. Our focused list is derived from a multifaceted methodology, which uses months of industry research and feedback from our readers, clients, and esteemed connections around the world. All firms are ranked top 10 in their jurisdiction but are displayed alphabetically to avoid bias.

**The Caribbean**

- DunnCox
- Ferraiuoli
- Foga Daley
- Guzmán Ariza
- HSM IP
- J.D. Sellier + Co
- McConnell Valdés
- Miniño Abogados
- Thornton Smith
- WDA International Law Firm

**J.D. Sellier + Co.**

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The Intellectual Property Practice Group can trace its records to 1929, and its team of very experienced Attorneys offer in depth analysis of issues concerning any area of Intellectual Property Law. We work closely with our clients in ensuring the protection and enforcement of their IP rights in Trinidad and Tobago and throughout the Caribbean.

“None to compare in this hemisphere”

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- CIETMA - The Chartered Institute of Trademark Attorneys
- INTA - International Trademark Association
- IFCA - Intellectual Property Caribbean Association

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This page is a partial representation of the content. The full page includes more detailed information about each firm and their services.
### Costa Rica

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Jurisdictional Briefing, Poland: Is it easy for a brand to be eco in Poland and the EU?

Anna Sokolowska-Lawniczak, PhD and Kaja Seń of Traple Konarski Podrecki and Partners detail the changing protection available for “eco” trademarks resulting from the bid to prevent greenwashing.

It is gradually becoming more and more commonplace in corporate communication to describe products of a particular brand as environmentally friendly, ecological, sold in biodegradable packaging, or manufactured in a sustainable manner. Consumers also encounter slogans like climate-neutral, friendly to nature, and reducing CO₂ emissions on a daily basis. According to recent reports, consumers willingly pay as much as 5-10% more for products described as environmentally friendly. Consequently, it is no surprise that the number of applications to register “environmentally friendly” trademarks, i.e., trademarks comprising elements such as eco, bio, green, or organic, is on the rise.

Plans to restrict the use of ecological phrases

This trend could however change in the near future due to plans to introduce EU-wide restrictions on the use of wording of this kind. This is all because of a proposal for an EU legislative package to stop greenwashing, i.e., marketing misinformation about being green.

In Poland, a proposal has also been made for a regulation to be issued by the Minister of Climate and Environment to stop the use in commerce of the popular name for coal, olenogrzybek, and for fuel, elotom. The names used presently, which could be misleading for consumers, are to be changed to greszuch plus and met plus. The president of the Polish Competition and Consumer Protection Authority (CCPA) has also started looking at the problem of greenwashing. CCPA currently observes information appearing in corporate communication. Names placed on products and advertising slogans, as well as information about product manufacture, have come under scrutiny. This has led to ecological references being monitored and will probably curtail the freedom to use them enjoyed in the past.

Much could change in this regard in the coming months.

Severe penalties

Even at the moment, a business in Poland could face a severe fine for making unjustified references in marketing to ecological issues, sustainability, or preserving the environment (using ecological slogans in a manner misleading to consumers). Even if unintentional, conduct of this kind could be found to be a practice violating collective consumer interests. In such cases, the president of CCPA has the power to fine a company up to 10% of its turnover generated in the previous financial year.

Using modified (eco) trademarks

The question is whether those developments will have implications for trademark use and registration. Clearly, this will be the case. Some firms might not be able to continue using ecological phrases.

On the other hand, rebranding and registration of a new trademark will not always be required when an element of this kind is part of a registered trademark. In certain cases, it will be possible to use the existing trademark without the prohibited eco elements. If an ecological phrase is descriptive, such as eco or bio, and the other elements of a trademark are at least of an average degree of distinctiveness, then omitting an element that is not of distinctive character will not affect the distinctive character of the trademark as a whole. Therefore, the Polish Patent Office and the EUIPO will continue to classify the use of a trademark of this kind, without the eco element (not of distinctive character), as use of a trademark.

At the same time, firms need to bear in mind that applying for permission to register a trademark alone does not rule out the possibility that using ecological wording will be against the law. Firms will not be able to cite legitimate reasons for using wording of this kind, for example holding a trademark registered before the legislation in question took effect.

What if we hold a trademark and wish to insert ecological wording, for example on product packaging? If it is not distinctive or is of a low degree of distinctiveness, inserting an element of that kind will not affect the distinctive character of the trademark if it is at least of an average degree of distinctiveness, while at the same time, it does not matter whether the inserted elements are visually dominant.

Meanwhile, a registered trademark may be rendered distinctive by a combination of a non-distinctive element and an element that is of a low degree of distinctiveness, for example, the word EKO/ECO, in which one letter is designed in the shape of an animal. If merely combining these two elements meant that the trademark could be registered, then omitting one of them would affect the distinctive character of the trademark, and thus these situations must be assessed on a case-by-case basis.

Not every (eco) mark can be registered

If a firm has yet to register a trademark, it needs to be aware that when an application is filed to register a trademark in Poland, the Polish Patent Office examines whether there might be any factors rendering it impossible to grant protection. It is important that granting protection when marks do not give the goods and services concerned distinctive character in commerce, and are descriptive, i.e., comprised solely of elements used in commerce to provide information such as origin, quality, method of manufacture, or composition. A trademark that is made up solely of elements that inform the origin, ecological origin of cultivation will not be registered. BIG NATURAL, ORGANIC ACTIVATOR or ECO-WOOD are just some examples of trademarks about which the Polish Patent Office has denied registration.

The same problem could arise when seeking to register an advertising slogan when the only information conveyed is about the goods and services concerned and registration has been denied in Poland, for example, in the case of the slogans Green Go! applied for in class 32 for i.a. beverages, and QUALITY CREATED BY NATURE applied for in class 32 for fruit and vegetables. For this reason, it is also not possible to register officially recognized marks that are protected in Poland, such as the community eco production label. It also needs to be considered whether under the EU law it might be impossible to use a particular mark as an element of a trademark, as in the case of the EU Ecolabel logo. Thus, before applying to register a trademark, it is worth doing a search to determine whether the trademark is likely to be registered. The search ascertainment, for instance, whether the trademark comprises elements that are descriptive or prohibited.

Eco-elements cannot be monopolized

Although a trademark cannot consist solely of descriptive eco-elements, such elements may be included, provided that the trademark comprises other distinctive words or figurative elements. At the same time, proprietors of trademarks comprising descriptive eco-elements do not have an exclusive right to use them, and this means that they cannot prohibit other parties from using the same or similar eco-elements. This mainly applies to natural, eco, bio, green, organic, and similar phrases. Allowing a single firm to monopolize these phrases would be contrary to the principle of economic freedom.

Résumé

Anna Sokolowska-Lawniczak, PhD, Patent and Trademark Attorney, Partner

Anna leads the Industrial Property and Brand Management Team as a part of the Intellectual Property Practice. She advises on every aspect of intellectual property rights, from developing strategies to maintaining and enforcing intellectual property rights under Polish, European, and international procedures. Anna has extensive experience in litigation before the Polish Patent Office and the EUIPO, and in court disputes concerning intellectual property, combating unfair competition, and copyright law. She draws up legal opinions on the registrability of trademarks and other items of intellectual property, and the use of trademarks during trade and in advertising campaigns. She is a member of the Polish Chamber of Patent Attorneys, ECTA, APPI, and INTA. She received individual recommendations in law rankings such as IAM Patent 1000, WTR, and Legal 500 Europe.

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Kaja Seń, Trainee attorney-at-law, Associate

Kaja’s practice focus is copyright and industrial property law, specifically trademark disputes. Kaja also has extensive experience in personal rights protection, influencer marketing, and combating unfair competition. She has worked on cases before the European Union Intellectual Property Office (EUIPO), the Polish Patent Office, common courts, and the World Intellectual Property Organization (WIPO) regarding international trademark registrations.

Author email: kaja.sen@traple.pl
The Bollywood actor’s passing leaves his privacy, publicity, and personality rights extinct, untransferrable to his family members.

Rachna Bakhru and Daleep Kumar of RNA, Technology and IP Attorneys evaluate the current right to privacy laws in India when it comes to legacy and heritability.

Recently, the Delhi High Court in a case titled Krishna Kishore Singh v. Sakal & Sonagol Ors., concerning the protection of privacy and publicity rights of a Bollywood actor Sushant Singh Rajput (SSR), held that the ‘right to privacy, the right to publicity and the personality rights vested in SSR is not heritable. They die with the death of SSR. The said rights, therefore, did not survive for exposure by the Plaintiff.’ He debuted in Bollywood in 2009 and met an untimely end in June 2020. The circumstances in which SSR breathed his last mark him, and the dust has yet to settle.

While India does not have specific legislation exclusively addressing publicity rights or the right to privacy, the courts have acknowledged and safeguarded the right to publicity as an element of an individual’s right to privacy and personal dignity. In cases where individuals’ publicity rights have been infringed, the Indian judiciary has relied upon various legal provisions including the right to privacy, the right to reputation, and the law of passing off to provide relief to the affected parties.

In India, the right to privacy is considered a fundamental right under Article 21 of the Constitution’, which safeguards the right to life and personal liberty. This recognition was solidified in 2017 when the Supreme Court of India delivered a landmark judgment in the case of Justice K.S. Puttaswamy (Retd.) v. Union of India4. The Court affirmed that the right to privacy is an intrinsic part of the fundamental right to life and personal liberty.

Factual insights of the recent case claiming violation of privacy and publicity rights of deceased Sushant Singh Raghore – famous Bollywood personality

- The dispute arose when SSR’s father (the Plaintiff) became aware that the Defendants, encompassing the Movie’s producers, director, and writer, were developing a film titled Nyay: The Justice (‘the Movie’ or ‘film’) based on SSR’s life, without obtaining consent from any of his authorized representatives, including himself. As a result, Plaintiff brought a quo warranto action restraining the Defendants from making and releasing the Movie.

- The Court did not grant an interim injunction, noting that ‘on the aspect of irreparable loss, we may note that the suit is not premised as a tortious action for defamation. It is founded on the basis of breach of celebrity/publicity rights inhering to the Plaintiff. It is thus opined that if an interim order is granted, it would be difficult to compensate the Defendants if the Plaintiff ultimately does not succeed in the suit. Whereas, the Plaintiff can always re-apply at a later juncture for injunction, if there is a change in circumstances after the release of the said film, and has an adequate remedy of being compensated by award of damages, if the Plaintiff proves in trial that the celebrity/publicity rights were infringe and inured to him exclusively.’

- Aggrieved by this decision, the Plaintiff appealed to the Division Bench (two Judges benched of the High Court). Meanwhile, as the Movie was completed and released on the OTT platform, the Court did not examine the appeal on merits and observed that ‘given the fact that, the stage at which the impugned decision was rendered, the subject film had not been released, all the parties will be at liberty to advance their respective stands, before the learned Single Judge, because of the changed circumstances’.

- Because of the release of the Movie, the Plaintiff filed the amended Plaintiff along with a fresh interlocutory injunction application against the continued streaming of the Movie by the Defendants to protect the possible irreparable injury and damage to the Plaintiff, his son, and his family’s reputation, defamations, and politicization of the event of death of SSR. The said application was decided by way of the present order.

Plaintiff’s stand:

1. The right to publicity and celebrity rights are heritable. Celebrity rights continue to exist posthumously in the deceased’s legal representatives after his death.

2. The Movie has been made based on defamatory statements and news articles, which alleged that SSR was subject to various vices such as drug addiction, etc., without any verification and without obtaining any report from any official agency to the said effect. Additionally, the film alleges that SSR was mentally unwell, that he was anxious and depressed, and that he died by committing suicide. In so doing, the Defendants have violated the right to privacy of SSR and the Plaintiff, which inhere in them under Article 21 of the Constitution.

3. Any misuse of the Plaintiff’s name, image, or caricaturing would result in infringement of the personality rights vested in the Plaintiff. It would also amount to passing off. The Plaintiff is the lawful successor to the rights vested in SSR earlier.

The events that led to SSR’s death, and after his death, were very personal not only to SSR but also to Plaintiff, his family, and his friends. Streaming or broadcasting the said events without the consent of the Plaintiff was completely illegal.

5. The investigation into the circumstances that led to the death of SSR is still in progress, and the release of the Movie is likely to prejudice fair trial in the case. Article 21 of the Constitution of India states that every citizen has the right to a fair trial.

6. The Defendants exploited the news circulated in the public domain for commercial gain without even taking the trouble to verify the authenticity of the same. Also, the disclaimer accompanying the Movie is untrue.

7. Plaintiff accepted that in view of the law enunciated in Puthaswamy5, while the right to privacy could not be said to survive SSR, the right to publicity continues to do so.

Résumés

Rachna Bakhru, Partner

Rachna Bakhru is a Partner with RNA, Technology and IP Attorneys, an IP specialist law firm. She qualified as an Electronics graduate from Delhi University, followed by a diploma in Business Administration and a degree in Law. She is a registered Patent agent and a member of the Bar Council of India.

Rachna currently heads the Dispute Resolution team of the firm, dealing with IP enforcement and advisory. She has over 25 years of extensive experience in managing non-contentious and contentious IP matters, IT, and Technology issues. Her expertise includes risk assessment, IP clearance, regulatory issues, litigation, and alternate dispute resolution. She has worked on portfolios of large international companies and her industry expertise includes Pharmaceuticals and Information technology. She advises her clients on issues related to IP infringement, Information Technology, Trade secrets, data protection, and geographical indications.

Daleep Kumar, Associate Partner

Daleep is an Associate Partner at RNA, Technology and IP Attorneys with a demonstrated history of working in the law practice industry for over 15 years. He is skilled in IP Management and Strategy, Trademarks (clearance, protection, opposition, cancellation and enforcement), Copyrights, Domain Name and Company Name Disputes, and IP Crimes in Digital Space. He regularly appears and argues cases before various judicial forums, including the Trademarks Registry and the courts.

Daleep has been a guest speaker at various IP training workshops conducted for police officials, researchers, faculty members, students, etc. Daleep has also contributed various articles and write-ups on IP issues and practice for known publications viz., Lexology, WTR, Managing IP, INTA Bulletin, etc.
Defendants’ counter-claims:

1. Puttaswamy[3] case confirms that both the right to privacy and publicity are enshrined in Article 21 of the Constitution[4]. If the right to privacy does not survive a person’s death, neither would the right to publicity.

2. No right to privacy or publicity can be violated if, as in the present case, the Movie is based on facts that are in the public domain. The right to privacy can never extend to publicity

3. Having not objected to the publications available in the public domain, Plaintiff cannot complain that the Movie violates his right to privacy. Plaintiff cannot claim absolute rights over SSR’s persona, and everything that has to do with him.

4. Even if it were to be assumed that the Defendants had commercially exploited the persona of SSR, the Plaintiff would, at the start of the Movie, be entitled to damages, and not more.

5. The disclaimer, which prominently figures at the start of the Movie, should suffice to negate the Plaintiff’s plea of the Movie being a re-telling or invasion of SSR’s life and death.

6. On the information available in the public domain, the law does not require the movie maker to obtain prior consent from the Plaintiff. The subsequent investigation.

7. The rights to privacy, publicity, and protection against defamation are personal rights that do not survive the death of the person concerned and are not heritable.

Plaintiff’s rejoinder

The Plaintiff, in his rejoinder, countered that there is a distinction between ‘public record’ and ‘public domain’. That the Supreme Court, in Rajgopal[5], has protected publications, which published material forming part of public record, from the taint of defamation or of infraction of another’s personality rights.

The Judicial perspective:

The Court refused to injunct the Movie while

1. After seeing the film, it is evident that it is an overt re-enactment of SSR’s life and times, focusing primarily on the circumstances surrounding his death and the subsequent investigation.

2. The disclaimer inserted in the Movie cannot detract from the reality that it is a colluious retelling of the life and death of SSR.

3. After examining in detail the legal position in previous decisions, the Court held that:

(a) The rights ventilated in the Plaintiff, i.e., the rights to privacy, publicity, and personality vested in SSR, are not heritable. They died with the death of SSR and cannot be espoused by the Plaintiff.

(b) On celebrity rights claimed by the Plaintiff, the Court took the view that it does not appear permissible, in our constitutional scheme which guarantees equality to individuals, to countenance an extra bundle of rights that would be available for enjoyment only to celebrities.

(c) The information contained and shown in the Movie is entirely derived from items featured in the media and, therefore, constitutes publicly available information. In making a film on the basis thereof, it could not, therefore, be said that the Defendants had violated any right of SSR, much less of the Plaintiff, especially as the said information had not been questioned or challenged when it appeared in the media. Nor were the Defendants required to obtain the consent of the Plaintiff before making the Movie.

(d) The remedy with the Plaintiff, if any, would not be to seek an interdiction against further transmission or telecast of the film but to claim damages, as already claimed.

(e) Injuncting further dissemination of the Movie would infract the Defendants’ rights under Article 19 of the Constitution, which states that all citizens have a right to freedom of speech and expression.

The Plaintiff (now Appellant) has appealed against the above order before the Division Bench of the High Court. It will be interesting to see the outcome of the Appeal in this notable case.

Closing remarks:

Without specific legislation on privacy laws in India, the legal system relies on Article 21 of the Indian Constitution, which enshrines the fundamental right to life and personal liberty. The right to privacy has been read into this constitutional provision through judicial interpretation. Over time, India’s jurisprudence on privacy rights has evolved through court decisions. The landmark judgment of the Supreme Court in the Puttaswamy[3] case firmly established the right to privacy as a fundamental right protected under Article 21 of the Constitution.

The current case reiterates the right to privacy as a fundamental right in line with the Puttaswamy[3] judgment. However, it also emphasizes crucial distinctions between privacy and publicity rights. While privacy is safeguarded as an essential individual right, the courts clarify that this right is not heritable. As India’s legal landscape continues to evolve, the understanding and protection of privacy rights remain subjects of ongoing development through court interpretations and future cases. Without specific legislation, the courts play a vital role in shaping and defining the contours of privacy law in the country.

Contact

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The protection of trademarks and democracy are intrinsically linked, and the reasons for this interconnectedness are diverse but easily discernible. Aspects such as freedom of expression, fair competition, and consumer protection, which favor innovation, are predominantly found within democratic systems.

That said, it is important to acknowledge that authoritarian regimes also protect intellectual property rights (IP), including trademarks. If on one hand, trademark rights prosper in democracy because only a democratic state offers secure and effective means to combat violations of these rights, while also encouraging the development of innovation. On the other hand, there are numerous examples of authoritarian states, particularly in the African continent, that effectively...
TRADEMARKS IN NON-DEMOCRATIC CONTEXTS

The delay in enacting an IP law indicates that, for the “newly born” country, there are other priorities to consider.

The Trademark Lawyer

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TRADEMAR
TRADE DRESS AS A TRADEMARK

Shape trade dress as a trademark: current trends and challenges

Alina Grechikhina of Gorodissky & Partners examines recent cases of both the grant and refusal of three-dimensional trademarks to assess best practices for businesses to leverage the power of distinctiveness.

Nowadays, within the sector of general merchandise, offer surpasses the needs. Consumers have become more sophisticated: it is getting difficult for manufacturers to attract their attention, to astonish them, to make them choose one’s product. Apart from the excellent quality of the goods, the business has to invent the very same trade dress that will conquer consumers’ hearts and play into the hands of the producers.

If the created design of a trade dress is unique and authentic, it is reasonable to obtain its protection as an object of intellectual property rights. Russian legislation on intellectual property rights, Russian Civil Code, which regulates intellectual property rights, provides that words, devices, graphic marks, positional marks, marks consisting of industrial designs, such as, for example, holographic marks, positional marks, marks consisting of three-dimensional marks, are protected as trademarks, which would provide for its distinctiveness.

The Chamber of Patent Disputes and subsequently the IP Court upheld the initial decision of the Russian PTO pointing out the fact that all the features of the applied shape were functional, specifically, they provided comfort when holding the bottle in the hand, its stable position on a flat surface and its convenient use, storage, and transportation; the recesses encircling the body of the bottle with a smooth side surface was designed for a snug fit of the label to the body of the bottle. Further, the administrative body and the court dismissed the argument that the existing industrial design served as proof of the originality of the design and thus distinctiveness of the applied designation indicating that trademarks and industrial designs were different objects of intellectual property rights that had different legal regulation and scope of protection.

Another case deals with the three-dimensional shape Figure 2 applied for confectionery. The Russian PTO refused registration of the subject designation stating that the form of the ring with the faceted stone lacked distinctiveness as it represented the realistic image of the goods applied for; besides the shape was allegedly used by many manufacturers in the applicant’s field of business. The applicant appealed against the official refusal, but the Chamber of Patent Disputes kept the rejection in force indicating in its own decision that all-social standard marks, individual or collective, did not impart the designation with the uniqueness which would provide for its distinctiveness.

As such it is not only the functionality of the form that may lead to the rejection of a three-dimensional designation to be registered as a trademark, but also its common nature that is typical to products of the same kind and that does not impart the designation with the uniqueness which would provide for its distinctiveness.

It should be noted though that in the latter example for the three-dimensional shape of confectionery, the applicant further appealed the decision of the Chamber of Patent Disputes with the IP Court. As a result, the Court dismissed the decision of the administrative body and imposed the Russian PTO to register the applied designation in relation to the applied goods. It was indicated that in the judgment that a comparison of the applied designation to a variety of confectionery shapes presented on the market did not prove that the applied designation represented a standard form of the product: besides the materials of the case did not evidence that the shape applied for was functional for the
applied goods (confectionery). So, the estimation of the distinctiveness of a three-dimensional form applied to be registered as a trademark has a somewhat subjective character, and the opinion of the administrative body and the judicial one do not always coincide.

Actually, the approach of the Russian PTO in the evaluation of the distinctiveness of three-dimensional marks is not that obvious.

For instance, an invalidation action was initiated by an interested person against the trademark Figure 3. The claimant stated that the registration of the mark was made in violation of the provisions of the law as the shape of the bottle was merely functional and was made of simple geometrical figures. The trademark holder presented arguments in defense of the originality of the form and additionally submitted the results of the opinion poll, which evidenced that the consumers recognized the shape of the bottle to be original, untypical for alcoholic beverages, and known as a trademark of the holder. The Chamber of Patent Disputes of the Russian PTO indicated in its decision that the memorable original shape of the bottle directly affected its general external outlines. Those design features were the central element and main attention to the customers and created a new memorable image of the product, besides the Russian PTO did not find the shape to be functional. As a result, the registration of the disputed trademark was kept in force.

At the same time, the Russian PTO decided to grant protection to the designation of Figure 4 in respect of alcoholic beverages with a disclaimer of the shape of the bottle. The examiner opined that the form was functional and lacked distinctiveness. In the present case, the applicant filed the appeal against the office action which presented arguments in favor of the untypical shape of the bottle that resembled a stone, and submitted materials, including the results of the opinion poll, as proof of fame and awareness of the applied designation for such goods as “brandy.” Having considered the materials of the case, the Chamber of Patent Disputes came to the conclusion that the applied designation might be registered as a trademark without a disclaimer of the form of the bottle for specific goods (brandy) as it has acquired distinctiveness through its intensive use.

As it goes from the provided examples, the question of the distinctiveness of the shape of a three-dimensional mark is quite complicated and controversial. That being said, unless a three-dimensional designation represents an extraordinary design that is not typically used for such a product or a package, there is a risk that such a mark may face a lack of distinctiveness objection. What is more, even if the mark obtains protection, it may be challenged by an interested person within the whole term of validity on the basis of a lack of distinctiveness ground, which was the case with a three-dimensional mark featuring the shape of a golden-colored package designed for food products (Figure 5).

The mark was registered subject to a disclaimer of the design of the shape. Subsequently, the mark was invalidated by a third party based on a lack of distinctiveness. The invalidation action was based on the fact that the non-protected elements of the mark, namely the shape design and the golden color of the package occupied a dominant position in the mark and therefore the mark should be considered non-distinctive as a whole.

The brand owner did not agree with the invalidity decision issued by the Chamber of Patent Disputes of the Russian PTO and tried to appeal the decision with the IP Court. The latter, however, upheld the position of the Russian PTO and pointed out the fact that the proposed shape design mark was not entitled to protection as the dominating elements of the mark, namely the shape design and the golden color, lacked distinctive character whereas additional elements of the mark could not change the overall impression created by the mark when viewed as a whole. The court also claimed that the brand owner failed to submit evidence of acquired distinctiveness specific to the mark as applied. Thus, the invalidity decision remained in force.

Judging from the recent cases on three-dimensional marks, one can notice that there is no universal approach to determine the distinctiveness of three-dimensional marks. Each case is studied and analyzed separately and in a set of various factors. To estimate the chances of obtaining protection of a shape as a trademark, it is advisable to review the so-called analog range of forms having similar purposes in order to reveal common features of such shapes. If the range is vast, then even slight differences from the ordinary features should be considered as being sufficient to generate distinctiveness of the form. If chosen wisely, a shape may become a haunting three-dimensional mark that will contribute to business development and perfectly function as a means of individualization.

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In the recent case of Carlton Shoes Ltd & Anr v. VIP Industries Ltd decided on 17 July 2021 by the Delhi High Court covers several important concepts of the Trade Marks Laws related to the scope of registration, trans-border reputation, and passing off.

The disputes between the parties Carlton Shoes Ltd (‘Carlton’) and VIP Industries Ltd (‘VIP’), were triggered by a Cease and Desist notice dated October 10, 2019, sent by VIP to Carlton, alleging trademark infringement of its trademark ‘CARLTON’ and calling upon Carlton to stop using the mark in relation to class 18 goods. Carlton sent a detailed response on November 25, 2019, informing VIP of its statutory and prior rights in the mark “CARLTON” dating back to 1994 in respect of class 18 goods. Carlton thereafter filed a suit against VIP for infringement of its trademark and copyright as well as passing off/unfair competition. As a counterblast to Carlton’s suit, VIP filed a suit alleging infringement and passing off.

The Delhi High Court’s judgment disposed of the aforesaid two suits filed by each party for infringement and passing off.

The popularity of the Carlton brand is reflected by its consolidated sales/revenue figures under the trademarks internationally and in India for the years ranging from 1992 to 2019, which is more than GBP 25 million. In India alone, Carlton’s products have garnered tremendous sales and the sales figures for the year 2017-18 alone are INR 18.31 billion increasing from INR 16.58 billion in the year 1993-94.

Carlton contended that VIP’s adoption and use of trademark “CARLTON” in relation to similar products are tantamount to infringement of Carlton’s statutory rights vested in its registered and well-known trademarks/names/logos “CARLTON/CARLTON LONDON” and their formative as well as violation of common law rights. It is alleged by Carlton that VIP has miserably failed in establishing spillover and/or transborder reputation of the mark “CARLTON” in the name of its predecessor Carlton International PLC into the shores of India and it is a settled law that trademark law is territorial in nature.

Carlton has produced the following evidence to show the use of its mark “CARLTON/CARLTON LONDON” in India and to prove actual confusion caused to the customers due to VIP’s products under the mark “CARLTON”:

- a) Invoices of sales from the year 2003 from various shops in different malls in Punjab, Haryana and Rajasthan and also a list of 24 outlets across Delhi, Gurgaon, Noida, Chandigarh where some sales invoices pertain to the years 2003 to 2005.
- b) Certificate of Sales figures/revenues under the mark “CARLTON” in India for the years 1993-2018.
- c) Articles extensively figuring on various high-profile magazines and newspapers widely published and circulated in India such as Cosmopolitan, Femina, Fashion Bloom, Apparels, Society, Outlook, The Tribune, The Pioneer, HT City, Business Standard, The Hindu, etc.
- The earliest promotional material for bags dates back to March 2004.
- Presence on e-commerce platforms available in India like Myntra, Flipkart, Amazon, etc.
- d) VAT registrations from the year 1993 onwards.
- e) Master data of production under the “CARLTON” marks from the year 2003 onwards.
- f) Consumer complaints from the year 2016 onwards showing actual confusion amongst consumers mistaking VIP’s products for Carlton’s products.

VIP’s case
VIP’s predecessor-in-title Carlton International PLC was incorporated in London on November 12, 1976, under the name Ravuale Limited. In the year 1980, Ravvale Limited adopted the mark ‘DIPLOMAT CARLTON’ and the mark ‘CARLTON’ with a circular logo. Carlton was adopted in 1986 in relation to travel bags and luggage, strollers, suitcases, school bags, wallets etc. and related accessories in the UK. Ravvale Limited applied for registration of the mark ‘Carlton’ in the UK on December 23, 1980, in class 25, and on May 19, 1988, in class 18. Ravvale Limited changed its name to Carlton International PLC on December 4, 1989, and after expanding its business in over 50 countries across four continents in 1994, applied for registration of the trademark “CARLTON” on July 10, 1995, in class 18 for goods namely, briefcases, luggage bags, suitcases etc. in India under registration no. 627450.

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 work 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 counselor 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.

Shubhankar Sushil Sharma, Associate
Shubhankar Sushil Sharma is a graduate in Commerce and Law, specializing in the subject of Intellectual Property Rights from Mumbai University. He has also completed his post graduate diploma in Media laws from NALSAR, Hyderabad. He joined LexOrbis as an Associate and has over three years of experience in the fields of trademark, copyright, and designs.
The The Court found that the rival marks are phonetically, structurally, and visually similar and both VIP and Carlton have registrations for their respective trademarks in bags and allied goods under class 18.

Section 28 (3) of the Trade Marks Act, 1999 according to which two or more persons are registered proprietors of trademarks that are identical to or nearly resemble each other and in such an eventuality to use these trademarks shall not be deemed to have been acquired by one of those persons against each other, merely on account of registration, subject to a caveat that the trademarks are registered for similar goods. In this scenario, neither of the two can sue each other for infringement. Hence, this position was settled.

Regarding the claims of passing off and spillover of the trans-border reputation, the Court commented that the action for passing off is premised on the rights of a prior user generating goodwill. The essence of passing off being that nobody has a right to represent their goods as those of somebody and encroach on the prior user’s formidable goodwill and reputation. The Court pointed out that in order to succeed in the claim for passing off, both VIP and Carlton in their respective rights would have to establish their existence through their marks in India and their goodwill and reputation abroad alone would not suffice, applying the territoriality principle. Assessing the evidentiary documents filed by VIP, the Court opined that its documents shed no light on whether the purported promotion material was extensively and widely published and/or circulated in India and whether customers here had seen and read them such that the goodwill and reputation of VIP’s predecessor percolated and spilled into India, since universal or worldwide goodwill and reputation, without any evidence of territorial goodwill and reputation, is no longer the yardstick. Where Plaintiff’s business is carried on abroad, it is not enough to show that there are people in Defendant’s country who happen to be its customers when they are abroad. Thus, the Plaintiff must have customers within the country of the Defendant. The Court disregarded the fact that the claimant under the trademark “CARLTON”, noting that the territoriality principle has overridden the universality doctrine. In the Indian market, prima facie Carlton has made out a case of prior user and enviable exposure of bags under the mark “CARLTON”.

The Court, therefore, concluded that VIP had failed to establish spillover of trans-border reputation in India and/or prior user’s whilst Carlton is first in the Indian market and has shown formidable goodwill and reputation under the trademark “CARLTON” and its formative marks, consequently, the injunction was granted against VIP and VIP’s suit was dismissed.

Conclusion
This judgement is yet another example reaffirming the territoriality principle when it comes to proving the trans-border reputation of a claimant. The Court made it abundantly clear that universal or worldwide goodwill and reputation, without any evidence of territorial goodwill and reputation, is no longer the yardstick. Where Plaintiff’s business is carried on abroad, it is not enough to show that there are people in Defendant’s country who happen to be its customers when they are abroad. Thus, the Plaintiff must have customers within the country of the Defendant. The Court disregarded the fact that the claimant of trans-border reputation also has a parallel registration in India for the same trademark in the same class. In India, the recent trend on this point indicates that the threshold for proving trans-border reputation has indeed been set as very high.

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The dos and don’ts for trademark use in advertising in Russia

Anastasia Omelchenko of Zuykov and partners reviews use cases of marks in advertising that infringe on registered trademarks to conclude best practices when creating campaigns.

Advertising plays an important role in promoting goods and services. It is difficult to imagine an advertisement that would not use a designation that serves to individualize goods, work performed, or services provided. In other words, the attention of the consumer is increasingly focused on the trademark or service mark. In addition, the Information Letter of the Presidium of the Supreme Arbitration Court of the Russian Federation of December 25, 1998 No. 37 states that in order to maintain interest in the product, it is not necessary to
The use of a trademark in advertising can be granted by the copyright holder on the basis of a letter of consent.

The goods (suitcases, bags) with the images of stylized flowers were displayed, confusingly similar to the Figurative trademark of the plaintiff, without the consent of the trademark owner.

TRADEMARK USE IN ADVERTISING

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