

# The Trademark

Issue 5 2023

GLOBAL REACH, LOCAL KNOWLEDGE

[www.trademarklawyermagazine.com](http://www.trademarklawyermagazine.com)

## Lawyer



## Accessible format audio-visual works in China: a copyright debate

Zhenkun Fu, Senior Partner and Trademark & Litigation Attorney at Corner Stone & Partners, assesses the potential conflict of copyright arising from the adaptation of media for the disabled by a third party in light of a recent case.

**Twitter's rebrand: dos and don'ts**

Page 10

**An interview with PharmaCare**

Page 14

**Parallel import: Israel**

Page 22



*A Foundation to Your Success!*



# Editor's welcome



The driving force for inclusivity continues, and with it, more media outlets than ever are recreating, repurposing, and creating additional avenues to offer accessibility to consumers with alternative needs. Our cover story this issue raises the question of copyright in a repurposing context, questioning whether the recreation of content for audio and visually impaired consumers by a third party constitutes infringement.

Our guest interview this issue is with Sarah Scholtz, In-house Legal Counsel at PharmaCare Laboratories, in which she shares insights into the components

“  
The  
importance  
of creativity  
in trademark  
creation.  
”

she believes create a strong brand, the importance of creativity in trademark creation, and her most valued qualities in outside counsel.

Further, we have an analysis of the dos and don'ts when rebranding in light of Twitter's recent - and shocking - transformation to X; an overview of the Top 100 New Brands in 2023 from analytics experts Clarivate; a review of Israel's position on parallel imports, drawing on conclusions from the recent Schweppes case; an update on privacy rights in India with the passing of the Digital Personal Data Protection Act; a perspective study of trademarks in the modern era; and more!

Our *Women in IP Leadership* segment features Maria-Gemma Huijnen, Partner at Chiever, and Orietta Blanco, Managing Partner at MINIÑO. Please contact us if you would like to nominate an interviewee for 2024.

We are now preparing our 2024 Global IP Directory, contact us today to secure your feature.

Enjoy the issue!

*Faye Waterford*  
Faye Waterford, Editor

## Mission statement

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

## Sustainability pledge

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



## THE TRADEMARK LAWYER

Issue 5 2023

### Editor

Faye Waterford  
[faye@ctclegalmedia.com](mailto:faye@ctclegalmedia.com)

### Publishing Director

Chris Dooley  
[chris@ctclegalmedia.com](mailto:chris@ctclegalmedia.com)

### Advertising Enquiries

Katie Kerr (Publishing Executive)  
[katie@ctclegalmedia.com](mailto:katie@ctclegalmedia.com)

### Editorial Assistant

Ellen Peet  
[ellen@ctclegalmedia.com](mailto:ellen@ctclegalmedia.com)

### Subscription Enquiries

[subscriptions@ctclegalmedia.com](mailto:subscriptions@ctclegalmedia.com)

### Accounts Enquiries

[accounts@ctclegalmedia.com](mailto:accounts@ctclegalmedia.com)

### Published by:

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

### Design and Repro by:

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

### Printed by:

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

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

ISSN 2053-3829

CTC Legal Media



Issue 5 2023

# Contents

## 6 Meet the Editorial Board

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

## 7 Cover Story: Accessible format audio-visual works in China: a copyright debate

Zhenkun Fu, Senior Partner and Trademark & Litigation Attorney at Corner Stone & Partners, assesses the potential conflict of copyright arising from the adaption of media for the disabled by a third party in light of a recent case.

## 10 Twitter's recent rebrand: a guide to keeping your trademark rights alive

Nicole Berkowitz Riccio, Shareholder at Baker Donelson, analyzes Twitter's controversial rebrand to 'X' to assess strategy for protecting existing trademarks during and after a brand transition.

## 14 An interview with Samantha Scholtz, In-house Legal Counsel at PharmaCare Laboratories

Sarah sits down with The Trademark Lawyer to discuss her experience managing almost 30 brands for Australian-born health and wellness company PharmaCare, sharing insights into the components that create a strong brand, the importance of creativity in trademark creation, and her most valued qualities in outside counsel.

## 17 More than meets the eye: trademark functions in the modern era

Jan Wrede, Managing Director at Dennemeyer & Associates Dubai, provides an update on the uses and benefits of trademarks in light of recent evolutions in consumer perspectives and business strategies.

## 22 Parallel import and the Schweppes precedent – is it sparkling or sizzling?

Karen Elburg and Adar Bengom of Herzog Fox & Neeman examine two conflicting cases regarding parallel imports into Israel to assess the Supreme Court's position on related infringement.

## 26 Snus – the Swedish way to quit smoking?

Petter Rindforth, Managing Partner at Fenix Legal, details the evolution of Snus, oral tobacco, to evaluate the effects of time on trademarking products considering the Swedish Government's incentive as a smoking cessation product in the form of a tax reduction.

## 29 Women in IP Leadership:

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

**Featuring:**  
Maria-Gemma Huijnen, Partner at Chiever in The Netherlands, and Orietta Blanco, Managing Partner at MINIÑO.



## 35 Rankings: UK & Europe

10 of the best law firms from each of the top Europe jurisdictions, including Germany, Poland and the UK.

## 45 Social media influencers and intellectual property: dos and don'ts

Ricardo Costa Macedo, Adriana Magalhães and João Bertholo Meireles of Caiado Guerreiro detail the most common instances of intellectual property right use by influencers on social media to identify key considerations for both protection and the prevention of infringement.



49

## 49 Top 100 New Brands 2023: the changing dynamics in the modern brand landscape

Robert Reading, Head of IP Content Strategy at Clarivate, highlights key findings from the recently published Top 100 New Brands report to expose the growth in specific sectors and locations.

## 52 The right to privacy gets recognition in India!

Rachna Bakhru and Vanshika Oberoi of RNA, Technology and IP Attorneys detail the long-awaited and newly passed legislation for data protection in India, known as the Digital Personal Data Protection Act.

## 56 Trademarks in commercial concession agreements: law enforcement problems

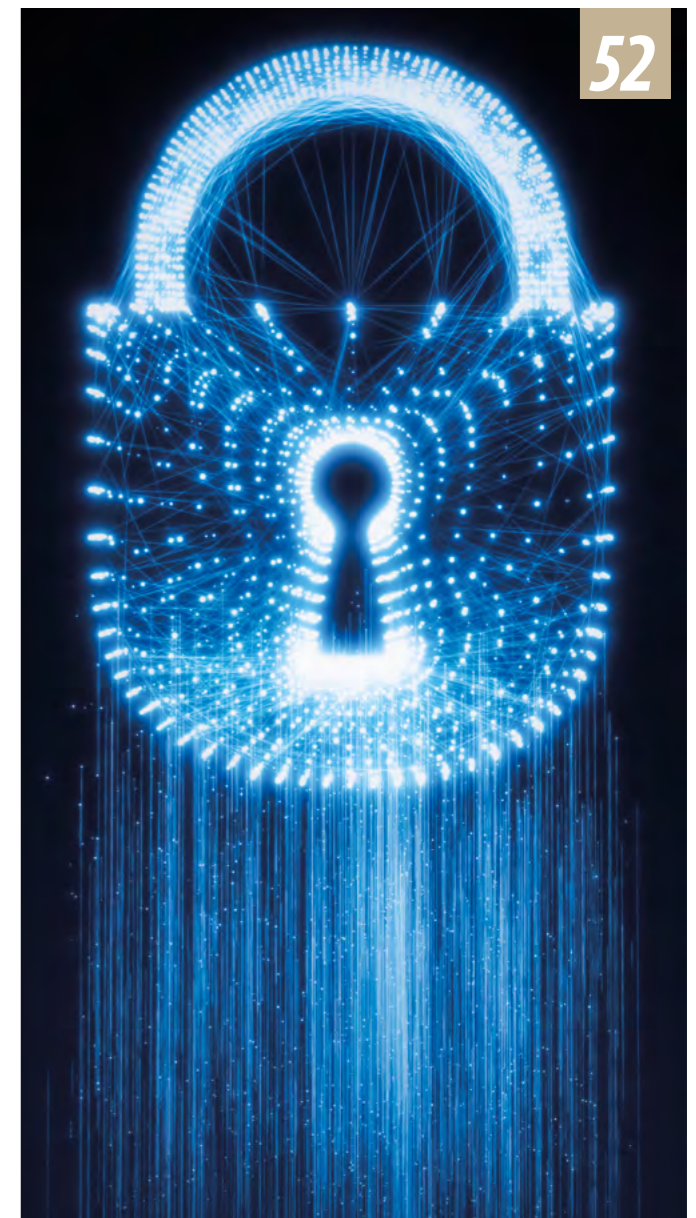
Sergey Zuykov, Managing Partner at Zuykov and partners, discusses topical issues regarding the role of trademarks as part of a set of exclusive rights granted by a copyright holder under a commercial concessions agreement.

## 60 Inspiring appreciation and respect for intellectual property

Alyssa J. Devine, Founder of Purple Fox Legal, reminds us of the core values rooted in intellectual property and the importance of encouraging consumers to favor strong brands and protected assets.

## 65 Directory of services

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



52



**Francesco Bonini - Studio Bonini. Italy**

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



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

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



**Catherine Hillaert-Prevost - Intellectual Property Advisor. Switzerland**

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



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

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



**Gang HU - Deputy General Manager, China Patent Agent (H.K.) Ltd. China**

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



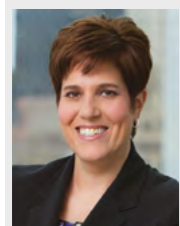
**Shelley Jones - Lawyer and Registered Trademark Agent. Canada**

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



**Stacey C. Kalamaras - Founder Trademarkabilities. US**

Stacey is founder and lead instructor of Trademarkabilities, a training academy for lawyers. Stacey is a seasoned trademark lawyer, having spent most of her career in Big Law representing many well-known brands in 150+ countries. She has prior business experience working in marketing and advertising. Since 2018, Stacey has educated more than 5000 lawyers on a variety of IP topics.



**Barbara Leitao-Johnson - Associate General Counsel, Intellectual Property, IABBB. Latin America/USA**

Barbara is a US based Brazilian Trademark Lawyer, having worked in several large Brazilian IP offices. With an LL.M. from George Washington University, DC, and after working at the IP protection areas of Facebook Reality Labs and Corsearch, she is currently taking the position of Associate General Counsel for IP at the International Association of Better Business Bureaus.



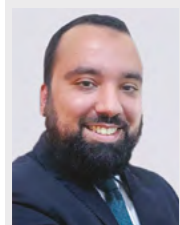
**Rachael Lodge Corrie - Partner, FOGA DALEY. Jamaica**

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



**Yasir Masood - IP Manager, Rouse & Co. Dubai**

An experienced German legal advisor specializing in IPRs, particularly trademarks, Yasir is dedicated to serving a diverse clientele in the UAE and MENA region. With an in-depth understanding of IP laws and procedures in the UAE, GCC, Europe, and US, his expertise encompasses filing, enforcement, and drafting. As an active member of INTA and AIJA, Yasir is committed to staying at the forefront of IP.



**Chris Mitchell - Member, Dickinson Wright. US**

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



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

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



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

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



**Charlotte Wilding - Partner, Keltie LLP. UK**

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



**Beata Wojtkowska - Partner, Kulikowska & Kulikowski. Poland**

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



# Accessible format audio-visual works in China: a copyright debate

**Zhenkun Fu, Senior Partner and Trademark & Litigation Attorney at Corner Stone & Partners, assesses the potential conflict of copyright arising from the adaptation of media for the disabled by a third party in light of a recent case.**

In recent years, many public welfare projects have produced movies in formats designed to be accessible to disabled persons. So, does an entity showing accessible-format movies on mobile APPs constitute copyright infringement?

Recently Jinshan District People's Court in Shanghai has concluded the first case of copyright infringement concerning "accessible format audio-visual works" in China.

"Accessible format audio-visual works" are published audio-visual works in formats designed to be accessible to disabled persons, specifically the visually impaired, auditorily impaired, orally impaired, and multiple impaired. At present, the audio-visual works accessible to the visually impaired provide live spoken commentaries and have audio tracks, and those accessible to the auditorily impaired use sign language and have dedicated subtitles.

**Summary of the case**

The plaintiff enjoys the webcast right to a number of movies. The defendant promotes mobile APPs for "accessible format movies and TV dramas" on APP markets to show these movies and TV dramas for free.

The plaintiff held that the defendant's providing the public with the service of showing the said movies on the Internet without the permission of the plaintiff infringed the plaintiff's webcast right to the movies concerned, and then brought the matter to Jinshan District People's Court to seek the defendant's stopping infringement and paying damages.

The defendant argued that the relevant law allows for providing people with print disabilities



Zhenkun Fu

with published works in an accessible format that can be perceived by them without the permission of the copyright holder or payment of remuneration to them. The defendant has upgraded the examination of membership of the mobile APP for "accessible format movies and TV dramas" so that a member must enter the number of their disability certificate to be verified before they can use the APP to enjoy the accessible format movies and TV dramas. Therefore, the plaintiff's right is not infringed and their legitimate interests are not prejudiced.

**Result of the trial**

At the trial, the court specified to both parties the reasonable limitation on the use of "accessible

**Résumé**

**Zhenkun Fu, Senior Partner and Trademark & Litigation Attorney**

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

**The court was inclined to hold the defendant's act did not constitute infringement.**



format audio-visual works". In China, the disability certificates are numbered on a unified basis nationwide with the penultimate digit denoting the class of disability, specifically, one for visual disability, two for auditory disability, three for oral disability, four for physical disability, five for intellectual disability, six for mental disability, and seven for multiple disabilities. Under the general understanding, those with the penultimate digits of their disability certificate numbers being one, two and three should be "print disabled". Those with multiple disabilities, the penultimate digit of whose disability certificate number is seven, are not further classified under the law in China, perhaps including the persons who are print disabled.

For the benefit of the disabled, the party who provides the disabled persons with "accessible format audio-visual works" should not be asked to conduct examinations beyond their power. The copyright party should be properly tolerant towards the other party in the present technical or legal circumstances.

The court was inclined to hold the defendant's act did not constitute infringement, but the defendant needed to act with due care and attention. Through the court's mediation, both parties reached agreement that the works concerned on the mobile APP for "accessible format movies and TV dramas" **need not be removed or deleted, the visually disabled with**

“**This revision has widened the scope of reasonable use of “accessible format audio-visual works”.**”

the ultimate digit of their disability certificate number being one, the auditorily disabled with the ultimate digit of their disability certificate number being two, the orally disabled with the ultimate digit of their disability certificate number being three, and the multiple disabled with the ultimate digit of their disability certificate number being seven are eligible to enroll, log in and use the APP for "accessible format movies and TV dramas" operated by the defendant, and the defendant must regularly screen the information about the members to eliminate the possibility of those other than the said persons using the APP for "accessible format movies and TV dramas" to view the accessible format audio-visual works.

#### Interpretation of the case

##### 1. The scope of use of "accessible format audio-visual works"

The new-revised Copyright Law of the People's Republic of China ("Copyright Law") entered into force on June 1, 2021. Article 24.12 of this law was changed from "printing published works in braille" to "providing the people with print disabilities with published works in an accessible format that can be perceived by them". Using works in the circumstances may be without the copyright holder's permission or payment of remuneration to them, but it shall not conflict with the normal exploitation of the works or unreasonably prejudice

the copyright holders' legitimate interests. This revision has widened the scope of reasonable use of "accessible format audio-visual works".

##### 2. Promotion and use of "accessible format audio-visual works"

The Copyright Law stipulates that "providing the people with print disabilities with published works in an accessible format that can be perceived by them" is a legal form of using the works. This provides effective legal support for the development of accessible format audio-visual works. However, **the development of accessible format audio-visual works should be based on respect for and protection of intellectual property rights.** Only by protecting the legitimate rights and interests of copyright holders by law can creativity be better stimulated, and more excellent works be produced to constantly meet the spiritual needs of the print disabled, thus achieving a win-win situation where both the protection of intellectual property rights and the protection of the rights and interests of the disabled are fully strengthened.

##### 3. International treaty and China's law concerning "accessible format audio-visual works"

On June 28, 2013, China ratified the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired, or Otherwise Print Disabled ("Marrakesh Treaty"), which entered into force in China on May 5, 2022. China is one of the countries that first ratified the treaty.

The newly revised Copyright Law entered into force on June 1, 2021. Article 24.12 of this law was changed from "printing published works in braille" to "providing the people with print disabilities with published works in an accessible format that can be perceived by them". Using works in the circumstances may be without the copyright holder's permission or payment of remuneration to them, but it shall not conflict with the normal exploitation of the works or unreasonably prejudice the copyright holders' legitimate interests. This revision has widened the scope of reasonable use of "accessible format audio-visual works".

On August 1, 2022, China National Copyright Administration issued The Tentative Provisions on Providing the People with Print Disabilities with Published Works in an Accessible Format. Article 7 of the Provisions encourages the publishing, movie, broadcasting, TV, and web-casting entities to synchronously make and provide accessible format copies of their copyrighted works, encourages the accessible format copy service entities to make accessible format copies and provide them for the people with print disabilities or for other accessible format



“**The newly revised Copyright Law entered into force on June 1, 2021.**”

copy service entities, and encourages the accessible format copy cross-border exchange entities to exchange accessible format copies with their counterparts in other Contracting Parties to Marrakesh Treaty.

#### Contact

##### Corner Stone & Partners

1905, Tower B, Tia Yuan Gang Centre,  
No.2 Dongsanhuan North Road,  
Chaoyang District,  
Beijing 100027, China  
**Tel:** +010 8446 4600  
law@cornerstoneip.com.cn  
www.cornerstoneip.com.cn/en/





# Twitter's recent rebrand: a guide to keeping your trademark rights alive

**Nicole Berkowitz Riccio, Shareholder at Baker Donelson, analyzes Twitter's controversial rebrand to 'X' to assess strategy for protecting existing trademarks during and after a brand transition.**

It has been hard to miss the headlines about Twitter's recent rebrand to "X," from the dozens of articles questioning why Twitter would ditch its name and well-known blue bird logo to the drama surrounding the large-flashing "X" sign installed at – and then removed from – Twitter's headquarters in San Francisco. But now the question arises: What happens to Twitter's trademarks? After all, trademark rights are based on use. If X Corp. is no longer using the old Twitter trademarks, can someone else come along and start a new company called "Twitter"? And does X Corp. have any ability to prevent this from happening?

These same questions come up every time a company rebrands, drops a product or service line, or decides to part ways with a legacy brand name. If the business stops using a particular trademark, it can be found to have "abandoned" the trademark. Once a trademark is abandoned, it enters the public domain and anyone can use and register the same or a similar trademark. In some instances, the new user of the mark might be a former employee of the original trademark owner who decides to start a new venture using the same or a similar name. Other times, it may be an unfamiliar newcomer who simply wants to utilize the goodwill associated with the now-abandoned mark.

For example, in 2015, a company called Innovative Technology launched the VICTROLA brand of record players and audio equipment. This company had no relation to the well-known Victrola record player brand that had been discontinued years earlier but saw an opportunity in taking advantage of the goodwill associated with this abandoned trademark. Despite a brief legal battle with Radio Corporation of America (the previous owner of the VICTROLA trademark), Innovative Technology apparently worked out a



Nicole Berkowitz Riccio

“**If X Corp. is no longer using the old Twitter trademarks, can someone else come along and start a new company called “Twitter”?**”



deal to continue using the mark.

These previously abandoned, newly revived trademarks are commonly referred to as "zombie trademarks" because they have been "brought back from the dead." This can be frustrating for the original trademark owner, who feels like the newcomer is taking advantage of their hard work in developing the brand. However, if the original trademark owner has truly abandoned the trademark, they may have limited legal options. Twitter's recent rebrand to "X" presents an important opportunity to revisit what it means to abandon a trademark and how companies can take steps to maintain their marks and the valuable goodwill they represent.

## When has a trademark been "abandoned"?

Whether a mark has been abandoned may be clear-cut in some instances, but in many cases, it requires a complex factual inquiry. Under 15 U.S.C. § 1127, a trademark is deemed "abandoned" if "its use has been discontinued with intent not to resume such use." The intent not to resume can be inferred from the circumstances, and nonuse for three consecutive years is *prima facie* evidence of abandonment.

The party raising the challenge that a mark has been abandoned for non-use has the burden of proof. The precise burden, however, varies depending on whether the matter is before the Trademark Trial and Appeal Board (TTAB) or a federal district court. While a majority of courts have required a challenger to prove abandonment by "clear and convincing evidence," *see, e.g., Pado, Inc. v. SG Trademark Holding Co. LLC*, 527 F. Supp. 3d 332, 341 (E.D.N.Y. 2021), the Federal Circuit has taken the minority view such that in proceedings before the TTAB, the challenger's

burden to prove abandonment is the "preponderance of the evidence" standard. *Cerveceria Centroamericana, S.A. v. Cerveceria India, Inc.*, 892 F.2d 1021, 13 U.S.P.Q.2d 1307 (Fed. Cir. 1989). As a result, it is easier to cancel or oppose a registration on the ground of abandonment before the TTAB than to assert abandonment in a federal court infringement suit.

Courts have found that "even limited use can be sufficient to avoid a finding that use of a mark has been 'discontinued.'" *Tiger Lily Ventures Ltd. v. Barclays Capital, Inc.*, 35 F.4th 1352, 1360 (Fed. Cir. 2022). With that said, courts have found that certain activities do not even qualify as the "limited use" necessary to avoid abandonment. For example, merely maintaining a website displaying the mark is likely insufficient to establish ongoing use in commerce, if that website is not a point-of-sale location. Further, repairing previously sold trademarked goods is generally considered "incidental use" not sufficient to preserve trademark rights. In addition, neither "challenging infringing uses" nor "sporadic licensing" constitute use sufficient to avoid abandonment. *See Stetson v. Howard D. Wolf & Assocs.*, 955 F.3d 847, 851 (2d Cir. 1992).

On the other hand, case law regarding the type of conduct that does not constitute abandonment provides a useful guide for businesses seeking to maintain their trademark rights. For example, in *Tiger Lily Ventures*, although Barclays allowed the registration for the LEHMAN BROTHERS trademarks to lapse, the Federal Circuit found that it had not abandoned the trademarks because Barclays had continuously used the mark in connection with managing the former Lehman Brothers' assets for the benefit of the creditors of Lehman Brothers in the context of the ongoing bankruptcy proceedings, and also in connection with offering legacy LEHMAN BROTHERS trademark research materials and that Lehman Brothers – under the license from Barclays – also continued to use the mark in its signage, web addresses, correspondence, or corporate filings. In another instance, the TTAB found that the CHICLETS trademark for chewing gum had not been abandoned when one member of the registrant's corporate family ceased use of the mark in the United States, but within sixteen months, another member of the same corporate family relaunched the gum brand. *Retrobrands USA LLC v. Intercontinental Great Brands LLC*, Cancellation No. 92066647 (TTAB May 29, 2020). Similarly, the TTAB found that AT&T had standing to challenge a newcomer's attempt to register the CINGULAR trademark because even though AT&T had largely phased out the CINGULAR brand, it still had a wholly-owned subsidiary named New Cingular Wireless PCS, LLC that used CINGULAR as part of its trade name and

“**Since Twitter announced its rebrand to “X,” it has made several changes and significantly reduced its use of the TWITTER trademarks.**”



conducted significant business under that trade name, such as entering into thousands of FCC wireless licenses, leases, and antenna structure applications. *AT&T Mobility LLC v. Dormitus Brands LLC*, Trademark Opp. No. 91218108 (TTAB Feb. 10, 2020).

Perhaps the gray area between use and nonuse of a trademark is best demonstrated by the matter of *Sprint Communications, Inc. v. Calabrese*, Case No. 18-60788 (S.D. Fla.). The Sprint case involved the question of whether Sprint had abandoned certain NEXTEL trademarks. At summary judgment, Sprint asserted that it still actively used the NEXTEL trademarks because the term "NEXTEL® inspired" could be seen in the fine print on the back of certain boxes and on certain user guides that it marketed to businesses and government agencies. Sprint also claimed that it used the NEXTEL mark at certain trade shows and during customer sales presentations. The court found the issue was too close to resolve on summary judgment and allowed the case to go to a jury. The jury found that Sprint had not abandoned its NEXTEL mark and awarded Sprint \$2 million in statutory damages, among other damages. The defendants' appeal is currently pending before the Eleventh Circuit.

## What does this mean for former Twitter, now "X"?

Since Twitter announced its rebrand to "X," it has made several changes and significantly reduced its use of the TWITTER trademarks. Its "About" page on Twitter.com shows a large "X" logo and discusses "X Corp.," virtually every reference to "Twitter" on Twitter.com has now been changed to "X," the mobile app now appears as "X" in the Apple and Google app stores, the bird logo has been replaced on its website and mobile app

## Résumés

### Nicole Berkowitz Riccio, Shareholder

A shareholder in Baker Donelson's Memphis and Fort Lauderdale offices, Nicole focuses her practice in the areas of patent, trademark, copyright, trade secret, and unfair competition litigation. She litigates intellectual property disputes before district courts throughout the United States, as well as before the Trademark Trial and Appeal Board of the United States Patent and Trademark Office and the United States Copyright Office. Nicole also advises clients on the identification, protection, and enforcement of intellectual property rights and has expansive experience in drafting and negotiating intellectual property license agreements, assignments, and non-disclosure agreements.

**Author email:** nriccio@bakerdonelson.com

**Karen Glover**, a former Baker Donelson associate, and current Assistant Professor at the University of Mississippi School of Law, contributed to this article.



with a new "X" logo, and of course, Twitter attempted to replace the sign at its headquarters with a large flashing "X".

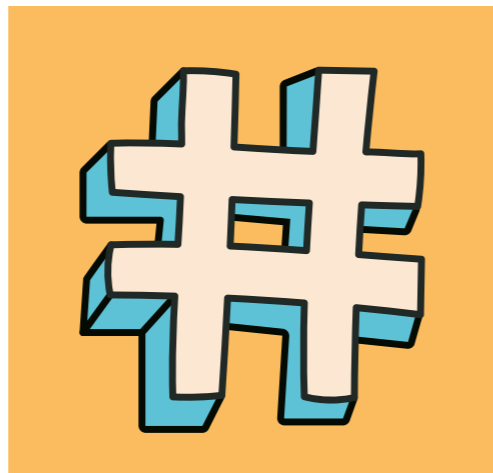
Currently, X Corp. is still using the website Twitter.com (X.com redirects users to Twitter.com), but other continuing uses of "Twitter" are harder to find. There are a handful of case studies referring to "Twitter" on X Corp.'s web pages relating to its advertising services. And there appears to be a hard-to-find, password-protected website selling Twitter-branded merchandise. However, given X Corp.'s limited use of the TWITTER trademarks, it is not surprising that a number of persons have already filed intent-to-use applications for the mark TWITTER in connection with a wide range of goods and services, eager to trade on the goodwill of the TWITTER mark in the event X Corp. fully abandons it.

If X Corp. intends to maintain its rights in its TWITTER trademarks and fend off these hungry newcomers, it must continue some minimum level of use to prevent the trademarks from abandonment. The same considerations relevant to X Corp. are critical for any company considering phasing out a trademark, whether due to a rebrand, a merger, or an acquisition that results in the elimination of a legacy brand, or a decision to drop a product or service line.

Given the fact-intensive nature of an abandonment analysis, it is difficult to draw a bright-line rule as to how much use is "enough" to prevent abandonment. The cases discussed above, however, provide some useful guiding principles for businesses to consider:

1. **"Token" use or "sporadic" use of a mark is likely insufficient.** There must be more than a few isolated sales under the mark, and simply displaying the mark on a bare-bones landing page is likely to be inadequate to demonstrate ongoing use. If the mark is displayed on a website and there is still a way to purchase goods or services on the website, that might be enough. It is a very close call whether X Corp.'s continued use of Twitter.com is sufficient, and if it transitions to exclusively using X.com, it will need to use the TWITTER trademarks in some other way to maintain rights.
2. **If you temporarily cease using a mark, but intend to reconvene use in the future, make a record of those plans.** A mark is only abandoned if there is no intent to resume use in the future. However, after-the-fact testimony that the business planned to resume use may be viewed as self-serving and may not defeat other proof of abandonment,

“ However, given X Corp.'s limited use of the TWITTER trademarks, it is not surprising that a number of persons have already filed intent-to-use applications for the mark TWITTER. ”



particularly if the period of nonuse is more than three years. Any business, including X Corp., with contemporaneous documentary evidence demonstrating its intent to resume the use of the trademark is more likely to overcome an abandonment challenge.

3. **Maintain your trademark registrations.** While a trademark registration will not save a business that has truly abandoned use of a mark, a certificate of registration is *prima facie* evidence of the registration and continued use of the mark. It also prevents and deters others from obtaining registrations for similar marks in connection with similar goods and services. Although there may be a business incentive to cut costs and allow a low-priority trademark registration to lapse, if the business is still using the trademark, it may be advantageous to maintain the registrations for it. X Corp. has already transferred the TWITTER trademarks into the name of its new company, which is a good first step. In order to maintain those registrations, it will need to submit evidence of continued use of the TWITTER trademarks when they are due for renewal.
4. **Uses on packaging, at trade shows, in catalogs, at other point-of-sale locations, or on documents associated with the goods or their sale, even if limited, is probably sufficient use to avoid abandonment.** In general, courts seem to be receptive to uses of the marks on shipping labels and packing slips and on packaging for goods. Likewise, using the mark at trade shows, in a catalog, or in some other manner

where there is a means for purchasing the goods or services, goes beyond mere advertising and evidences ongoing use. Certainly, the more prominent the use of the mark, the more likely a court is to find ongoing use and the more likely a business will be able to obtain an early favorable ruling. More limited use of the mark may ultimately suffice but may result in a close factual question incapable of resolution at summary judgment or earlier. X Corp. is still engaging in limited use of the TWITTER trademarks on its web page for advertising services and on an e-commerce site for merchandise. These uses, coupled with the ongoing use of Twitter.com, may be enough to avoid abandonment, at least for certain categories of goods and services.

5. **Continued use of a trademark on related items may avoid abandonment, even if a registrant discontinues use on a certain product or service.** Several courts to have considered the issue have found that an incumbent trademark owner has not ceased use

“ If you temporarily cease using a mark, but intend to reconvene use in the future, make a record of those plans. ”



and abandoned a mark where it has continued using the mark on different but related goods or services. The type of related use found sufficient includes an assortment of cookies instead of one particular type of cookie, a different mattress than that originally sold under the mark, or a budget-type paint instead of a premium-priced paint. In the case of X Corp., if it goes from selling Twitter-branded t-shirts and notepads to Twitter-branded sweatshirts and laptop bags, it very likely has continued use with respect to a wider range of promotional merchandise. Whether X Corp.'s use of the TWITTER trademarks in connection with its advertising and marketing services saves its trademarks in other categories, such as software and online social networking services, is a closer call.

### Contact

**Baker Donelson**  
www.bakerdonelson.com

**We don't just practice Mexican law. We help shape it.**

- ◆ TRADEMARKS
- ◆ PATENTS
- ◆ COPYRIGHTS
- ◆ LICENSING, TECH TRANSFER & FRANCHISING
- ◆ CORPORATE AND COMMERCIAL LAW
- ◆ LITIGATION
  - IP Litigation
  - Anti-Piracy | Anti-Counterfeiting
  - Alternative Dispute Resolution (ADR)
  - Mediation & Arbitration
- ◆ REGULATORY LAW
- ◆ IN HOUSE TRANSLATION DEPARTMENT

**OLIVARES**  
MEXICO

[www.olivares.mx](http://www.olivares.mx)

# An interview with Samantha Scholtz, In-house Legal Counsel at PharmaCare Laboratories

Sarah sits down with *The Trademark Lawyer* to discuss her experience managing almost 30 brands for Australian-born health and wellness company PharmaCare, sharing insights into the components that create a strong brand, the importance of creativity in trademark creation, and her most valued qualities in outside counsel.

## What inspired your career in IP and why did you decide to move to an in-house role?

My interest in IP sprung from experiencing firsthand its prevalence and influence in many areas that I have worked in. Setting up systems and processes that assist others, especially marketers, in understanding the importance of protecting and maintaining one's intellectual assets is vital to the success of any business and in future-proofing the products of its IP.

I moved in-house due to several factors but predominantly I was seeking the opportunity to get "my hands dirty" and gain a deeper understanding of the business' goals and objectives. In-house offers me the ability to help shape the company's IP strategy and ensure that it aligns with overall business objectives and governance. At PharmaCare, I meet with various internal departments, and we collaborate and deal with a diverse range of matters which keep me on my toes.

## Can you describe your role and responsibilities at PharmaCare?

PharmaCare is an Australian-born success story, and proud to be a 100% family-owned and operated business. PharmaCare has become an Australian leading health and wellness company with almost 30 brands in Australia and overseas and it operates in over 40 countries and serves thousands of retailers.



Given the size of PharmaCare and being the sole senior legal counsel, no two days are the same. I am responsible for an array of matters, from managing our extensive trademark portfolio (800 plus trademarks locally and internationally), providing advice to the Executive Management team on a wide range of matters, reviewing supply and distribution agreements, acquisitions, and employment matters and managing risk and governance across the company.

## What procedures do you have in place to manage such a vast portfolio of brands?

We manage our vast portfolio of brands by utilizing software and tools to streamline processes and centralize the asset collateral. It is important to always be on the front foot in terms of market scanning, benchmarking, and research to maintain a competitive edge, as well as being vigilant in monitoring for IP infringers and acting quickly to stop them. We also provide training and education to the internal teams and stakeholders about how best to protect our IP and the importance of innovation and how we can have a competitive advantage by utilizing and leveraging our existing brands.

## Why are individual brands so important in the health sector?

At PharmaCare, we understand the importance people place on their health and well-being,

and consequently the need to both establish and maintain trust and credibility. PharmaCare does this by mandating processes and procedures that ensure that we are committing to the highest quality and safety standards for all of our products. It is vitally important that our brands are distinct, sustainable, and reputable in an overcrowded and competitive environment. Acknowledging and acting on changes in customer purchasing practices both from a social procurement lens and discretionary spend is front of mind at PharmaCare to ensure that the brand represents value as well as quality and efficacy.

## And what do you believe makes a strong brand?

A strong brand in the highly regulated and important healthcare sector means that we need to maintain clear values, consumer focus, transparency, and quality while establishing emotional connections and differentiation in such a competitive landscape.

At PharmaCare, we try and ensure that each of our brands and products have a clear purpose, and that they do what we say they do, which in essence builds trust and credibility amongst our consumers. We also prioritize sustainability, quality, and safety in all aspects of our operations as we are committed to our consumers well-being.

## Do you think the increased use of 'health and wellbeing' as a slogan is affecting branding and trademarks in the pharmaceutical/complementary sector? How?

Yes, the increased use of "health and wellbeing" as a slogan is likely to have an impact on branding and trademarks in the complementary medicines sector. This trend reflects the growing emphasis on holistic health, preventative care, and overall well-being, and it presents both opportunities and challenges for health organizations, including PharmaCare.

The focus on "health and wellbeing" aligns with the evolving preferences of consumers who are seeking more comprehensive and holistic approaches to their health. At PharmaCare, we try and leverage this trend to position ourselves as trusted partners in overall wellness. When consumers look at our brands, we know that they are relatable and approachable as we are always committed to supporting a healthy lifestyle. We strive to engage with consumers and meet their needs in a way that proves that they can trust our brands, and that we are here to support their healthy lifestyle, not just for the short term but for each phase in their life.

However, given that the market has had an influx of products in recent years, and consumers

“

It is vitally important that our brands are distinct, sustainable, and reputable in an overcrowded and competitive environment.

”







have an array of products to choose from, it seems that the “health and wellbeing” slogan is becoming too common a phrase in the industry, and potentially losing some utility, and we are therefore always looking at trying to create unique and distinctive trademarks and differentiated positioning. This is a challenge, as developing new marks that stand out and getting the consumer to recall them, whilst ensuring they are not generic and descriptive, is no easy task, and can require large investment.

#### How does the global nature of PharmaCare affect your strategy for bringing brands to market?

Each country has its own nuances, regulatory frameworks, and consumer preferences. Our global strategy requires careful consideration of these factors to ensure consistency, relevance, risk mitigation, and effectiveness across various regions is maintained, whilst tailoring the offer to the individual market.

At PharmaCare, we consider cultural sensitivities and adapt our messaging according to that region. We ensure that the product positioning, tastes, and needs, resonates with local audiences while maintaining brand distinctiveness.

PharmaCare also works closely with its international distributors as each country has its own regulations. Our focus is ensuring that not only do we comply with the relevant regulatory body, but also always maintain consistent brand messaging and identity, both locally and internationally.

#### What would be your top considerations for creating a new trademark?

I always say to the business, think long term and think global. Just because it might work in Australia, doesn't mean it will work overseas. Secondly, I also try and encourage internal stakeholders to be unique and distinctive when trying to create a new trademark making sure that they utilize all their creativity and do lots of consumer engagement studies to ensure we are reflecting contemporary consumer requirements, mindsets, and sentiments.

#### What qualities do you value most in your outside counsel?

We have been using Clayton Utz for well over a decade. I work closely with Dean Gerakiteys and his team on all IP-related matters, and not only are they experts in all things IP but they provide valuable insights and guidance. Dean and his team also understand how PharmaCare operates, our needs and concerns, and they tailor their legal advice to PharmaCare's overall goals and strategic plan. We are a fast-paced organization and they are always readily

“ Each country has its own nuances, regulatory frameworks, and consumer preferences. ”

available and responsive to our needs, which has built trust and efficient working relationships.

#### What advice would you give to outside counsel who aspires to work in partnership with a global health and wellbeing brand?

Key points to remember:

- Familiarize yourself with the health and wellbeing industry, including its regulations, trends, and challenges. Be proactive in sharing thought leadership and offering training in this area and build relationships with all members of the business as this is where you will learn a lot about the brand and how the business operates.
- Align yourself with their values to effectively support their initiatives. Health and wellbeing brands often have a strong alignment to improve health outcomes and support customers on their wellbeing journey.
- If it is a global brand, ensure you understand and respect cultural differences and sensitivities that might impact legal matters.
- Given the sensitive nature of health information, ensure you're well-versed in data privacy regulations and emerging threats to guide them appropriately.
- Assist in protecting the brand's intellectual property, including trademarks, copyrights, and patents, to safeguard its unique identity and innovations.
- Finally, what I think is the most important is working collaboratively with all teams, as well as other partners, to ensure a cohesive and effective approach to legal matters and risk management.

#### What do you enjoy most in your role at PharmaCare?

It probably sounds cliché, but I love the variety of work and the people. I also get to work with a very large brand portfolio (almost 30 brands!), which is every IP lawyer's dream.

# More than meets the eye: trademark functions in the modern era

Jan Wrede, Managing Director at Dennemeyer & Associates Dubai, provides an update on the uses and benefits of trademarks in light of recent evolutions in consumer perspectives and business strategies.

Nothing in Intellectual Property (IP) law is one-dimensional, least of all the ubiquitous trademark. Just as the definition of these intangible assets has evolved to include holograms, motions, shapes, and scents, so has their role in modern business expanded upon their traditional function.

This signifies a paradigm shift of the trademark from a means “to distinguish goods from one undertaking from those of other undertakings” (Article 4, EU Trade Mark Regulation) to a public communication tool. However, this phenomenon is not merely isolated to the social sphere.



Jan Wrede

## Résumé

**Jan Wrede, Managing Director at Dennemeyer & Associates Dubai**

Admitted to the bar in Germany and Italy (-2022), Jan Wrede practiced IP law from 1996-2013 with two major Italian patent and law firms. In 2014, he opened the Dennemeyer & Associates Dubai Office, focusing on IP across the entire MENA region. He is a registered Arbitrator with DIAC (UAE), KCAC (Kuwait) and SCCA (Saudi Arabia). Between 1999-2008, Jan Wrede was a lecturer for the Master's in IP at ETH Zurich and is still a frequent speaker at conferences and universities.

#### Author email:

[jwrede@dennemeyer-law.com](mailto:jwrede@dennemeyer-law.com)

“ A trademark that has succeeded in establishing itself in the minds of the relevant public becomes a shorthand for the product or service to which it is attached. ”

having repercussions on the juridical protection of trademarks as well as their future filing patterns.

To some degree, this trend is the natural outcome of deepening reciprocity in seller-consumer dealings, but a growing appreciation of the strategic value of trademarks among owners is also at play. And this understanding can trace its origin to the influence of trademark attorneys, who have become more active in decision-making processes. Thus, it is incumbent upon IP counsels to continue to foster this responsive attitude so that their clients get the most out of established and emergent trademarking schemes.

### Gazing into the past

It is all too easy to assume trademark innovation to be a modern contrivance and overlook the history of development underlying commercial marks. That is to say, “ur-trademarks” were never a static concept prior to the codification of modern IP law. Take the various signatures and stamps applied by Mediterranean artisans for centuries in ancient Egypt, Greece, and Rome, which were as much for personal aggrandizement (and belittling rivals) as for ensuring quality production. While these examples may constitute a prototype for brand identity, they differ from trademarks as we recognize them today in that their use, as far as we can interpret, was primarily intended to redound upon the producer rather than engage the consumer.

Leaping forward, even the first written regulation governing the use of marks in commerce, England’s Statute concerning Bakers (Statutum de Pistoribus), circa 1266, was not completely analogous to current legal frameworks, being a combined trademark, certification, and traceability system. “Every baker shall have his seal and seal his bread, whereby it may be known whose bread it is and if he did not do this, he shall be grievously amerced.” The statute was a companion to the more famous Assize of Bread and Ale and served as a means to identify and punish tortious bakers who sold undersized or unacceptable goods.

Taking this deeper perspective on the development of trademarks, it is clear that this form of IP lends itself to new or modified applications, a fact savvy trademark holders are turning to their advantage in our current time.

### The traditional look of trademarks

When all is said and done, most consumers are only obliquely aware of what a trademark is in the letter of the law, if at all. This means a mark that satisfies regulatory concerns alone would have very limited market potential. Taking both the legal and promotional aspects of the

“  
A growing appreciation of the strategic value of trademarks among owners is also at play.”

”

modern trademark into consideration reveals a fourfold role:

- Identification: to distinguish the origin of a product from others
- Quality proposition: to guarantee the preservation of a product’s characteristics
- Marketing exposure: to advertise the product and those related to it
- Lifestyle promise: to communicate a brand image

Case law traditionally focuses on the identifying function (discussed under “likelihood of confusion”) and, if the mark is more famous, also on the marketing purpose (debated under “likelihood of association, diluting, tarnishing, and tailgating”). Less attention has been paid to those roles allied with product quality and lifestyle branding, but, as we shall see, that is beginning to change.

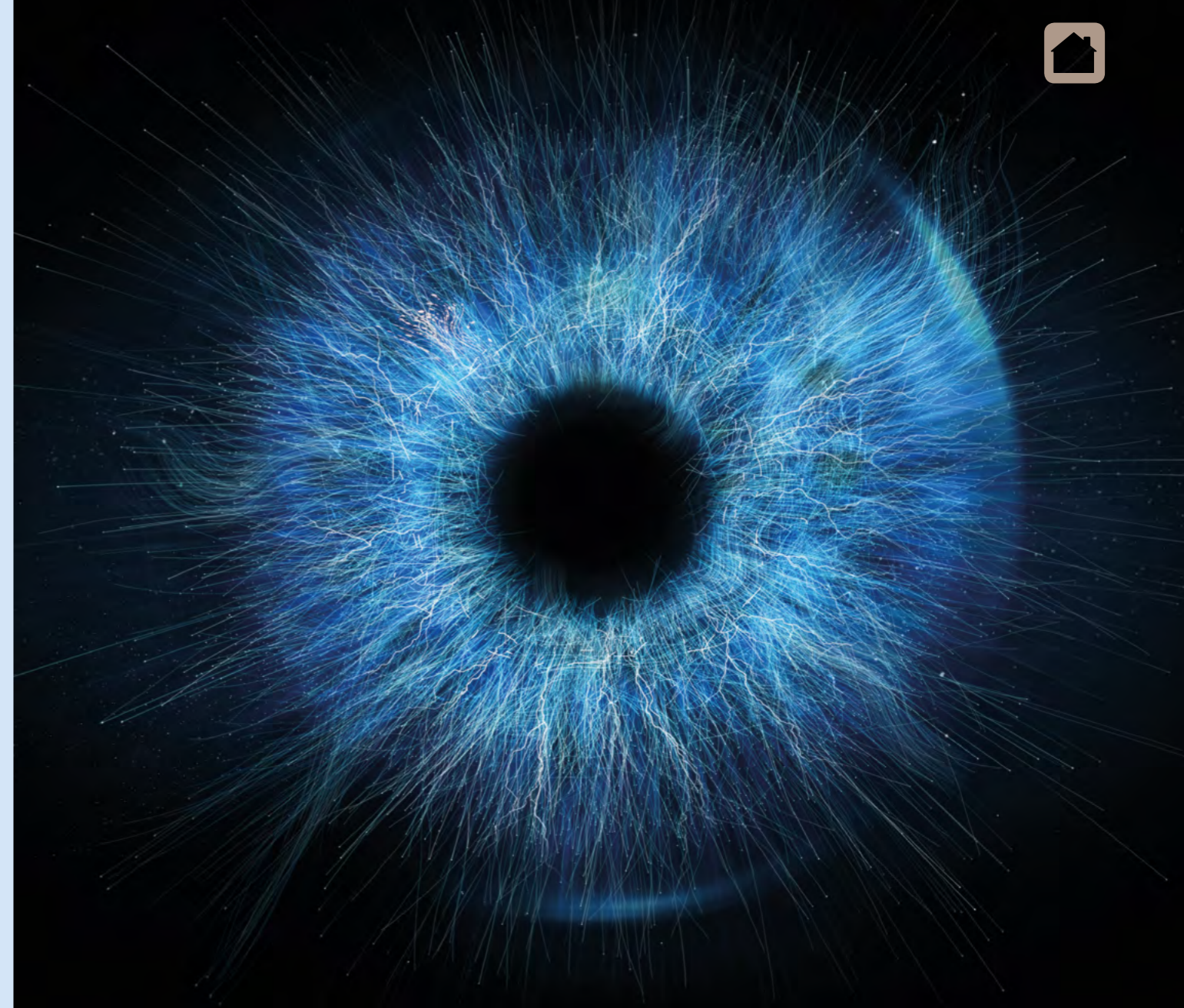
### Changing consumer perspectives

The relative weighting of trademark functions ascribed by conventional practice no longer matches 21st-century consumer perceptions. For the most part, the modern-day purchaser neither knows nor cares about the source-identifying purpose of a mark, with any changes in ownership being a non-issue. As an example, the BENTLEY trademark was originally owned by Bentley (1919), which was later bought by Rolls-Royce (1931), which was sold in part to Vickers (1980), who sold Rolls-Royce Motor Cars to Volkswagen (1998). Despite this turbulent history of nationalizations, mergers, and acquisitions, as far as a driver is concerned, a Bentley is a Bentley. To most customers, source identification is a legal fiction without any practicality.

With regard to fast-moving consumer goods (FMCG), the general public still wants assurances of quality but, ultimately, has little recourse when standards slip. Of the four roles, this leaves us with trademarks as containers of brand image and focal points of marketing efforts. Having exhausted the more legally advantaged features, we arrive at the modern trademark’s primary duty from the buyer’s point of view.

### Beauty is in the eye of the beholder

“To me, marketing’s about values,” mused Steve Jobs in his 1997 “Think Different” speech. “This is a very complicated world; it’s a very noisy world, and we’re not going to get a chance to get people to remember much about us. No company is. And so, we have to be really clear on what we want them to know about us.”



A trademark that has succeeded in establishing itself in the minds of the relevant public becomes a shorthand for the product or service to which it is attached. It operates as a synecdoche – an individual example that stands in for the entire category. Take drinking a Coke, googling a question, or, most recently, wondering whether ChatGPT has sent you an email instead of your colleague. Many more examples exist beyond soft drinks, search engines, and generative AIs, but the linguistic inclination is the same for all.

Even so, such built-in recognition for trademarks carries with it the danger of genericide, meaning owners must take visible and effectual measures to ensure the continued registerability of their IP. And yet, customers are as untroubled as they are oblivious to these woes and will use the most convenient language rather than the most accurate.

Of course, this should not be interpreted as apathy – quite the opposite. When a trademark acts as the preferred means of communicating ideas, it reinforces (largely) positive notions

“  
A mark that satisfies regulatory concerns alone would have very limited market potential.”

”

connected to a product or service. While it is perilously difficult to influence this process, once a brand image is distilled into a trademark, that mark is then transformed into an emotional locus and, therefore, a valuable promotional tool.

The result is a constant push-pull struggle to maintain both trademark exposure and exclusivity – though the integrity of registered rights should be prioritized if a choice has to be made. After all, it is easier for a brand to launch a new awareness campaign than to acquire distinctiveness or appeal a trademark revocation.

### Trademarks and business foresight

As mentioned at the outset, the changing trademark paradigm is not confined to consumer relations; businesses are able to employ trademarks in ways that are not immediately associated with sales.

For one, owners can use a trademark application or an international extension via the Madrid System to signal an intent to operate in a new territory. By the same token, a request to

connect additional Nice Classes to an existing mark implies entry into fresh markets. But what do these actions serve beyond their *prima facie* usefulness?

In a word, deterrence. Or, to put it more elaborately, deterrence and seizing the initiative from competitors by forcing them to react. Depending on local requirements for genuine/commercial use, a registrant may be able to stay on the books for up to five years before being obliged to prove the mark's presence in the market. This can give a retail plan ample time to catch up, provide R&D projects with extra breathing space or spur negotiations with potential partners and licensees in the region.

Naturally, this approach is precluded in the United States by the fact that the obligation to use a trademark is not postponed until after grant. Instead, following Section 15 of the US Code, a commercial strategy that started with a relatively low-key trademark deployment could be "ramped up" to full release after five years, when the mark's validity was as close to ironclad as can be hoped for in our industry. A similar course of action is available in the European Union thanks to Article 61's limitation in consequence of acquiescence (EU Trade Mark Regulation, as above) – provided the filings were made in good faith, of course.

There are many avenues by which trademarks can generate revenue for their owners outside of direct sales. We have already touched upon the theme of licensing, but as brands continue to widen their scope geographically, the royalties generated by these business partnerships can only grow as a percentage of total income. Given how tempting this prospect is, attorneys must redouble their efforts to ensure clients are well informed of the reputational and legal liabilities. When push comes to shove, trademark holders could find themselves shut out from their preferred litigative forum thanks to an impetuously signed licensing agreement.

Another riskier function of the modern trademark is as collateral for loans. Clients will likely know the hazards of taking this path, but circumstances may warrant or demand it. That said, attracting investment capital by showcasing a portfolio's strengths is a much safer bet overall – one need only reflect on the 17 Sustainable Development Goals from the United Nations to see why.

Those trademarks that indicate environmentally favorable goods and services have enhanced value both to their owners and the relevant public. Investors are cognizant of this fact, making it highly desirable to demonstrate accredited "green" assets within a portfolio. Though this kind of IP registration typically requires meeting a higher bar, those trademarks (and owners)

“  
Similar  
trademarks  
may coexist  
if the overall  
image they  
evoke is  
different.”

”

that prevail receive a fitting cachet.

#### A vision of the future

Trademarks perform the same legal functions as they traditionally have but are now inextricably linked with branding, marketing, and public relations. Consequently, the *raison d'être* of a trademark has shifted to communicate a message, meaning the yardstick of absolute grounds may not be so much its distinctiveness as its ability to speak, evoke, and recall. The level of descriptiveness could then, at least in theory, be set much lower than at present.

However, on an absolute level, trademarks cannot be merely descriptive or long-winded because the customer would no longer perceive them as indicating a single origin, even if the nature of that commercial entity remains of little concern. While on a relative level, future marks must still differ enough one from another phonetically, visually, and conceptually to be allowed to coexist.

At the courts, this convergent evolution could manifest in a rebalancing of which cases lead to disputation. On one pan of Justice's scales, otherwise similar trademarks may coexist if the overall image they evoke is different. On the other, signs previously judged dissimilar may become too close in this milieu if they convey the same appeal to lifestyle and fashion.

Until such a time, fora will continue to use established procedures in their decisions. In fact, in August of this year, the EUIPO Fifth Board of Appeal denied genuine use of Ferrari's TESTAROSSA mark for automobiles. The verdict was based on a straightforward application of the principle of origin since the cars were being sold only by unaffiliated dealers, not the trademark owner. Had the Board taken the perspective argued here that the storytelling function has its prerogative, use would have subsisted: Sports car enthusiasts and Miami Vice fans still reverently associate the brand with the legendary car maker from Maranello.

We shall have to wait and see how and how soon this new trademark tradition will come to pass.

#### Contact

**Dennemeyer & Associates Dubai**  
Al Mustaqbal Street, Business Bay,  
Regal Tower, Office 608, Dubai,  
United Arab Emirates  
P.O. Box 118156

**GOODRICH**  
RIQUELME  
ASOCIADOS



| MEXICO

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

Enrique A. Diaz      ediaz@goodrichriquelme.com      (5255) 5525 1422

Jaime Delgado      jdelgado@goodrichriquelme.com      (5255) 5207 5324

Juan Carlos Suarez      jcsuarez@goodrichriquelme.com      (5255) 5207 9261

Guillermo Sosa      gsosa@goodrichriquelme.com      (5255) 5207 7561

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

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



# Parallel import and the Schweppes precedent – is it sparkling or sizzling?

**Karen Elburg and Adar Bengom of Herzog Fox & Neeman examine two conflicting cases regarding parallel imports into Israel to assess the Supreme Court's position on related infringement.**

It is not often that the Israeli Supreme Court rules on IP-related matters, especially trademark matters. However, the issue of parallel imports has been thoroughly reviewed and discussed by the Supreme Court since as early as 1970 in the seminal case of *Geigy*<sup>1</sup> and as recently as 2022 in the case of *Schweppes*<sup>2</sup>.

The conundrum of parallel imports revolves around the tension between trademark rights and consumer protection – on the one hand, the Israeli Trademark Ordinance [New Version], 5732-1972 (the "Ordinance") grants trademark owners the exclusive right to use or authorize use of the trademark in Israel; permitting parallel imports, on the other hand, allows the sale of goods bearing a trademark registered in Israel, which were not authorized by the trademark owner. Since such goods are genuine goods in the sense that their production was authorized by the respective trademark owner, there is no consumer confusion.

In this straightforward case, the tension between trademark law and consumer protection is less apparent, as one of the basic tenets of trademark law is that infringement requires a likelihood of confusion<sup>3</sup> – and when the trademark owner



has authorized the production of the goods outside of Israel, the Israeli consumer is not misled as to the origin of the goods. This was the reasoning of the Supreme Court in *Geigy*, i.e., that the importation of goods manufactured by the same trademark owner outside of Israel does not constitute an infringement of the owner's marks registered in Israel, since there is no likelihood of confusion with goods of a *different* origin.

In 1990<sup>4</sup> the Supreme Court provided further color to this reasoning by noting that the trademark owner-manufacturer exhausts its rights after the first sale of its goods and is not entitled to control the downstream use or import of its products. By doing so the Supreme Court favored the "international exhaustion doctrine", as opposed to the "national exhaustion doctrine". In 2002, the doctrine was adopted (at least with respect to criminal liability) into the Ordinance by the addition of an exception to the criminal liability of an importer of trademark goods bearing a registered trademark without the authorization of their proprietor:

"60. (a) A person who commits any of the following acts, shall be liable to imprisonment for three years or to a fine of seven times the amount of the fine prescribed in Section 61(a) (4) of the 34 Penal Law, 5737-1977;... (2) Imports for trading, without authorization of the proprietor of the mark or his representative, goods or packaging thereof that have been marked with a trademark that is registered in the Register in respect of such goods or by imitation of such a mark, and the mark is liable to deceive another person; *provided that the provisions of this paragraph shall not apply in respect of goods that have been marked with authorization of whoever is the proprietor of the mark in the country in which the marking was done.*"

But what happens when the trademark owner is not the same as the one in the jurisdiction in which the goods were manufactured; or when the parallel importer advertises the imported goods while using the registered trademark?

These questions were raised by the Supreme Court in the cases of *Schweppes* and *Hilfiger*<sup>5</sup>. Since *Hilfiger* preceded *Schweppes*, we will begin with an overview of *Hilfiger*.

In *Hilfiger*, the appellants ran a parallel import retail store offering clothing of various well-known brands, such as TOMMY HILFIGER. They also operated an online website under the domain name [www.tommy4less.co.il](http://www.tommy4less.co.il), and for a limited time even named their store "Importer's Depot – Tommy Hilfiger". Not only had the appellants used the word mark TOMMY HILFIGER, but they had also used the red, white, and blue color scheme that characterizes many of the Tommy Hilfiger design marks.

The Tel-Aviv District Court issued injunctions prohibiting the appellants from using the registered trademarks of Tommy Hilfiger as part of the name of the store and the domain name. It also issued an injunction prohibiting the appellants from using the colors red, white, and blue on the premises of the store and online, and required them to indicate that they are parallel importers in conjunction with every use of Tommy Hilfiger's trademarks.

An appeal was lodged with the Supreme Court, which distinguished between the legality of selling parallel import goods in Israel (to which the simple answer was "yes, since the parallel import does not in and of itself constitute trademark infringement"), and that of marketing or advertising the parallel import goods by the parallel importer. In this respect, the Ordinance prescribes, in pertinent part, that "Infringement" means "the unauthorized use of a registered trademark in *advertising* goods that are the same as those in respect of which the mark is registered, or goods of the same nature".

The Supreme Court held that use of a registered trademark for marketing parallel imports goods constitutes an infringement, but can be exempt from liability if it is considered as "genuine use" pursuant to Section 47 of the Ordinance. The tests to determine whether or not certain marketing activities may be considered to be "genuine use" were established in the pivotal case of *Toto*, namely: (a) whether the product may not be easily identified without the use of the trademark, (b) whether the use of the trademark is beyond what is necessary in order to so identify the product, and (c) whether the use of the trademark does not imply an association between the trademark owner and the user.

The presiding judge in *Hilfiger* ruled that the first and second prongs are irrelevant to the



Karen Elburg



Adar Bengom

marketing of parallel import goods since "each use of the trademark for the purpose of marketing the products bearing such trademark is essential", and hence that only the third prong should be examined.

She further noted that the likelihood of association will be determined on a case-by-case basis, and much dependent on the nature of the goods. In this respect, if the goods include an element of service or if the consumers expect a continuous relationship with the importer (such as in the case of motor vehicles) the likelihood of association will be higher.

<sup>1</sup> C.A. 471/70 *J.R. Geigy, S.A v. Pazchem Ltd.* Some even say that the first case was back in 1957.

<sup>2</sup> C.A. 7934/20 *Jafora Tabori Ltd. v. Ben Shlush Import and Export Ltd.*

<sup>3</sup> Although there is one Supreme Court case that held that when the trademarks are identical, no likelihood of confusion is required (C.A. 8483/02 *Aloniel Ltd. et al. v. Ariel McDonald*). While this case followed the plain language of the Ordinance, it was and still is heavily criticized and its ruling was very narrowly construed.

<sup>4</sup> C.A. 371/89 *Leibovitz v. A & Y Eliahu Ltd.*

<sup>5</sup> C.A. 7629/12 *Elad Menachem Suissa v. Tommy Hilfiger Licensing LLC* (Nevo, 16 November 2014)

## Résumés

### Karen Elburg, Partner

Karen heads Herzog's IP Practice. Karen has extensive experience in the contentious and non-contentious aspects of intellectual property, including advising on strategic and day-to-day aspects of trademark portfolios and the trademark/domain-name interface, and managing worldwide trademark portfolios for her clients. Karen advises on the acquisition, disposal, protection, and exploitation of IP rights, as well as trademark clearance, all aspects of brand protection, and trademark & domain-name disputes. Her work focuses on transactional IP and on licensing, development, technology transfer, and other commercial agreements for clients ranging from start-ups to multi-national corporations, in a broad range of industries and fields.

**Author email:** [Elburgk@herzoglaw.co.il](mailto:Elburgk@herzoglaw.co.il)

### Adar Bengom (Ortal), Partner

Adar is a partner in Herzog's IP Practice, where she focuses primarily on intellectual property transactions, licensing, contentious matters, and client counseling. This includes leading intellectual property due diligence in various cross-border transactions such as mergers, asset acquisitions, and investments and drafting and negotiating all intellectual property documents relating thereto; drafting and negotiating complex license, research, development, and other commercial agreements in various fields including high-tech, pharma, e-commerce, IT, finance and online marketing; and providing contentious legal advice on copyrights, trademarks, breeders' rights, domain names, trade secrets, computer law, and other intellectual property-related topics.

**Author email:** [Bengoma@herzoglaw.co.il](mailto:Bengoma@herzoglaw.co.il)

Applying these principles to the case at hand, the Supreme Court held:

- (a) With respect to the name of the store, i.e. "Importer's Depot – Tommy Hilfiger" – it implies the existence of an association with the trademark owner since it entails initial interest confusion;
- (b) With respect to the use of the colors: the Supreme Court distinguished between use of the colors on the exterior vs. the interior of the store, but also noted that even use of the colors on the exterior of the store may not imply association when the name of the store does not include the trademark – and, most importantly, the trade dress (other than the colors) is different.
- (c) With respect to the use of the domain name: the Supreme Court ruled that since the domain name is "Tommy4less" it would not imply an association since Tommy Hilfiger invests substantial resources in branding its products as luxurious.
- (d) With respect to indicating that the appellants are parallel importers- the Supreme Court held that they should mention that they are not associated with Tommy Hilfiger on the home page and the "About" page of their website, as well as one conspicuous sign at the entrance to the store, but not in conjunction with every use.

*Hilfiger* became the leading precedent on the matter of parallel imports and trademark infringement. In *Schwepes*, the Supreme Court faced another conflict related to parallel import, but this time it was an "internal" trademark law conflict between the notion of territoriality and that of well-known marks, or marks with "international goodwill".

The facts of the case were as follows: Jafora Tabori is an Israeli producer of beverages, including under the SCHWEPES trademark. Jafora purchased the rights to the registered trademark SCHWEPES from Cadbury Schweppes PLC in 2006. The respondent, Ben Shlush, imported SCHWEPES-bearing beverages produced in Ukraine by a subsidiary of the Coca-Cola Company ("Coca-Cola"), which in turn had also purchased its rights in the registered trademark in Ukraine from Cadbury.

The Supreme Court ruled that the importation by Ben Shlush infringes Jafora's rights in the SCHWEPES trademark registered in Israel, since, *inter alia*, the appellant and Coca-Cola



“  
The  
Tel-Aviv  
District Court  
issued  
injunctions  
prohibiting  
the  
appellants  
from using  
the registered  
trademarks  
of Tommy  
Hilfiger as  
part of the  
name of  
the store and  
the domain  
name.”

## Contact

### Herzog Fox & Neeman

Herzog Tower,  
6 Yitzhak Sadeh  
Street, Tel Aviv  
6777506, Israel  
**Tel:** +972 3 692 2020  
**Fax:** +972 3 696 6464  
<https://herzoglaw.co.il/>



"do not belong to any global venture named "Schweppes" and "Cadbury never owned a global trademark for SCHWEPES". There is no doubt that this case involves unique circumstances, which raise the aforementioned internal conflict, but instead of confining the ruling to these unique circumstances, the Supreme Court's holding went beyond them and provided that parallel imports would be allowed only in one of three cases: (a) when there is no registered trademark in Israel "connected with the imported goods"; (b) when the imported goods bear a trademark registered in Israel, if the owner of that mark in the country of origin is the same as its owner in Israel; and (c) if the imported goods were originally purchased from the trademark owner in Israel, i.e. sent to another country from the factory in Israel and purchased in that country.

The ruling, and in particular the holding, was considered by many in Israeli's small trademark community (present company included) as going against previous Supreme Court rulings, including *Hilfiger*. It also raised concerns that it might cause a reduction in the number of parallel imports, since under the plainest interpretation it requires Customs to seize any goods imported from countries where the registered trademark owner is different (even if connected/affiliated) from the registered trademark owner in Israel. Thus, encouraged by the cheering crowd of Israeli trademark lawyers, Ben Shlush filed a further hearing request.

Although the request was denied, the President of the Supreme Court emphasized that the *Schwepes* ruling should be confined to its very specific and unique circumstances, in which "there was no affiliation or other commercial relationship between the local and foreign trademark owner". She further noted that although the *Schwepes* ruling might end up deterring competition, it did not merit a further hearing.

But were we (i.e. trademark lawyers) and the President of the Supreme Court right to be concerned? We often criticize court holdings and assume that they will have negative consequences, but in this case, we decided to follow through to see if our concerns have materialized.

Imagine our surprise when we were informed by the Israeli Customs Authority, which is best placed to inform us whether our dire predictions have come true, that there had actually been a decrease in the number of Customs seizures of goods suspected of infringement between July 2022 and December 2022. The relatively low number of seizures continued into the first half of 2023.

So it seems that the answer to our question whether *Schwepes* is sparkling, or sizzling - is that it is probably still, but we will certainly revisit it as time goes by.

**glp**® Your European  
IP Partner

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

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

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

Pushing  
forward  
the world's  
greatest  
innovators.

Patents  
Trademarks  
Designs  
IP Strategy

Online Brand Protection  
Legal Actions & Contracts



Via L. Manara 13  
20122 MILANO

Tel: +39 02 54120878  
Email: [glp.mi@glp.eu](mailto:glp.mi@glp.eu)

Viale Europa Unita 171  
33100 UDINE

Tel: +39 0432 506388  
Email: [glp@glp.eu](mailto:glp@glp.eu)

Via di Corticella 181/4  
40128 BOLOGNA

Tel: +39 051 328365  
Email: [glp.bo@glp.eu](mailto:glp.bo@glp.eu)

[glp.eu](http://glp.eu)

Other offices:  
PERUGIA · ZÜRICH  
SAN MARINO

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





# Snus – the Swedish way to quit smoking?

**Petter Rindforth, Managing Partner at Fenix Legal, details the evolution of Snus, oral tobacco, to evaluate the effects of time on trademarking products considering the Swedish Government's incentive as a smoking cessation product in the form of a tax reduction.**

**H**ave you met a Swedish tourist who seems to have a swollen upper lip? Then it is probably a person who snuffs - instead of smoking.

So, what is "snus"? The word is the Swedish version of the English word "snuff", referring to the nasal form of tobacco. However, in Sweden, snus is put under your upper lip. Or, as described by [www.snusdirect.com](http://www.snusdirect.com) in six steps: "1) Open the can of snus, 2) put your thumb and index finger in the can, 3) take a small quantity between the two fingers and form a wedge, 4) lift it out of the tin, 5) lift your upper lip on one side, 6) place the wedge inside, under the upper lip and the gum".

Although a tobacco product, "snus" is a special and independent word and has today no clear meaning in many countries outside Sweden and Scandinavia. It is exemplified when searching for "snus" by the TMclass tool, managed by EUIPO, where you can find the local language translation of a specific goods or service. In some countries "snus" is not translated at all, while in other countries, the local Patent Offices obviously have found it necessary to claim a further explanation. The most detailed version is Albanian: "snus (tobacco in powdered form, which is usually held in the mouth between the lips and gums) [Snus (duhani në formë pluhuri, i cili mbahet zakonisht në gojë midis buzëve dhe mishrave të dhëmbëve)]<sup>1</sup>.

Snus arrived in Sweden at the end of the 17th century and quickly became a must among both men and women of the aristocracy – based on the fact that Snus was well-known and popular among the French aristocracy. At that time, snus was only used in the nasal form, served in luxury small cans of gold.

In the first part of the 18th century, the Swedish tobacco industry had its breakout, when the Swedish king Fredrik I decreed that Swedes had to grow their own tobacco. At the end of the



Petter Rindforth

“**Ljunglöf's number one version quickly became so popular that ETTAN (Swedish for one) became a trademark in itself.**”

<sup>1</sup> <https://tmclass.tmdn.org/ec2/term/308142>

18th century, tobacco was being grown in around 70 Swedish cities, as well as becoming very popular among local farmers.

The traditional French snoring version saw its end by the French Revolution. The former upper-class users in Sweden switched to cigars, however, the production of snus in Sweden just changed the way to use it. Instead of snorting the product, the producers mixed it to a mush and left it to ferment in jars for several weeks. The new product was taken in portions and put under the upper lip. The Swedish snus had been born.

The oldest Swedish trademark for snus is "LJUNGLÖF'S ETTAN" ("Ljunglöf's One"). In 1822, Mr Jacob Fredrik Ljunglöf took over an old tobacco company, founded in 1694 with its plants in what is now a central part of Stockholm city. At that time, snus manufacturers used the numbers one, two, or three to indicate the quality of the product, but Ljunglöf's number one version quickly became so popular that ETTAN (Swedish for one) became a trademark in itself.

It is today nationally registered in Sweden as:  
No 335219 "LJUNGLÖFS ETTAN Original Anno 1822 No 1"  
No 400458 "ETTAN" with Swedish Match North Europe AB as the owner.

ETTAN is still the most popular snus trademark in Sweden, and accounts for approximately one-fifth of all snus sales, according to Swedish Match.

Other trademarks from this time, still alive and well-known in Sweden are:

- No. 137075 "GENERAL SNUS"
- No. 137074 "RÖDA LACKET"
- No. 366521 "GÖTEBORGS PRIMA FINT"

In 1914, the Swedish parliament decided to nationalize the entire tobacco industry. The reason



was that the Swedish Riksdag (parliament) needed to urgently find money for financing defense (as the First World War had started), as well as to finance a general insurance system. Around 65 competing tobacco companies, including 103 trademarks for snus, were turned into the state-owned monopoly AB Svenska Tobaksmonopolet. Three years later, the number of tobacco trademarks and available products dropped from around 400 to 17. However, the consumption did not drop – in 1919, the "record year" according to Swedish Match, 7,000 tons were sold, meaning a consumption of 1.2 kg per capita. Thereafter it became a bit less used as smoking cigarettes turned out to be more popular.

In the 1960s Sweden removed the import and sales monopoly on tobacco. AB Svenska Tobaksmonopolet merged with the match manufacturer Swedish Match and was listed on the stock market in 1996. Today, most of the Swedish snus trademarks are owned and registered by Swedish Match North Europe AB.

When the sales monopoly was gone, snus started to be more popular again. The main reason was the first reports indicating health risks with traditional cigarette smoking. In the 1970s, Swedish Match introduced the first portion-packed snus, which made it easier to use snus when you work, during a conference, when acting, or simply in a restaurant. The sales curve pointed upwards.

“**Around 65 competing tobacco companies, including 103 trademarks for snus, were turned into the state-owned monopoly.**”

The question remains: Is snus healthier (or at least less harmful) than cigarettes?

According to a report of November 15, 2022, from Folkhälsomyndigheten (the Public Health Agency of Sweden), 20% of men and 6% of women in Sweden stated that they snuffed daily. Only 6% are daily smokers, which is the lowest percentage within the European Union.

Snusforumet ([snusforumet.se](http://snusforumet.se)), an editorial platform about snus and Swedish tobacco and public health policy, owned by the Swedish Snuff Manufacturers' Association (an association of companies and organizations in Sweden that manufacture, market and sell snus) has listed on their website 12 "scientific articles" that support snus's potential for harm reduction and as a smoking cessation product.

According to Snusforumet, the research on snus and health shows that Sweden has fewer tobacco-related diseases than comparable countries and that snus is one of the tobacco products that is least harmful to people's health:

- Snus is about 90% less dangerous than cigarettes (but can still increase the risk of heart attack) (Le Houezec et al (2011)).
- Snus does not appear to cause cancer or respiratory diseases, but it can increase the risk of heart disease and be harmful to the fetus, even if the risk of this is significantly lower for snus users than for smokers.[...] Switching to snus instead of smoking has resulted in a significant

## Résumé

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



decrease in the proportion of men in Sweden who develop lung cancer. (Foulds et al (2003)).

- Sweden is an example of a country that, despite relatively high tobacco use, has succeeded in reducing tobacco-related diseases by reducing the use of cigarettes through a transition to snus (McNeill & Munafò (2012)).
- 53.6% of users who use snus daily state that the purpose of their snus use is to stop smoking (Lund and McNeill (2013)).

Even independent healthcare studies have come to the conclusion that snoring/snus is less harmful to health than smoking.

In an article published on February 9, 2023, Anna Gunnerbeck, a pediatrician at the Astrid Lindgren Children's Hospital and researcher at the Department of Medical Epidemiology and Biostatistics, Karolinska Institutet, Sweden, said that "taking snus or smoking while pregnant is associated with an increased risk". A comprehensive study concluded that taking snus while pregnant was associated with a 70% increase in the risk of infant death during the first year, regardless of cause, and a three-fold increase in the risk of sudden infant death. The risks associated with taking snus were comparable to moderate smoking (one to nine cigarettes a day). The highest risks were associated with smoking over 10 cigarettes a day. Although Dr Gunnerbeck's general recommendation was to not snore or smoke when pregnant, she also concluded that "Swedish snus is high in nicotine, but unlike cigarettes contains no combustive products and is thus considered, like vaping and other such nicotine products, to be much less harmful to the health".

The placing on the market of snus (identified as "oral tobacco" by the EU) has been banned in the EU – except for Sweden – since 1992, most recently by Directive 2014/40/EU. The validity



**As of today, there are 196 different trademarked products available for all citizens who are at least 18 years old.**



<sup>2</sup> [https://www.europarl.europa.eu/doceo/document/E-9-2023-001408-ASW\\_EN.html](https://www.europarl.europa.eu/doceo/document/E-9-2023-001408-ASW_EN.html)

of the ban has been confirmed by the Court of Justice of the EU which concluded that the relevant provisions are not in breach of the principle of proportionality.

Swedish Match has challenged the prohibition of snus before the European Court and lost (Judgement of 14 December 2004 (C-210/03), *Swedish Match*).

The European Commission stated on June 19, 2023, that "smokeless tobacco products such as oral or chewing tobacco contain nicotine, a toxic and highly addictive substance with well-established negative health impacts prolonging nicotine addiction. There are no safe levels of tobacco and/or nicotine consumption. In 2008, the Scientific Committee on Emerging and Newly Identified Health Risks provided scientific advice confirming the negative health effects of snus and other types of smokeless tobacco. This advice was reflected during the revision of the directive leading to the conclusion that these products should remain regulated and that the prohibition of oral tobacco should be maintained. The Commission is currently evaluating the EU legislative framework for tobacco control. Any scientific, technical and market developments will be carefully considered."<sup>2</sup>

It remains to be seen if the rest of European Union countries will change their mind and see snus not just as another harmful tobacco product, but as a possible way to cut down the use of traditional smoking tobacco products.

In the meantime, new snus trademarks are coming up constantly on the Swedish market. As of today, there are 196 different trademarked products available for all citizens who are at least 18 years old. One example is the Swedish trademark No 613154 *Après*, owned by *Après Nicotine AB*, and presented as: "Premium brand *Après* strives to develop unique and refined flavors in a timeless design. Innovation, aesthetics and quality are the values that guide us".

And in order to make it even more enticing to turn from cigarettes to snus, Swedish Prime Minister Ulf Kristensson announced on Instagram on September 6, 2023: "We are now reducing the tax on snus by 20%, which corresponds to a price reduction of SEK three per can. I myself don't snuff anymore, so I don't speak for myself. But anything we can do to reduce and avoid smoking is good."

## Contact

### Fenix Legal

Brahegatan 44, 11437 Stockholm, Sweden  
[info@fenixlegal.eu](mailto:info@fenixlegal.eu)  
[www.fenixlegal.eu](http://www.fenixlegal.eu)



# 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.



# Maria-Gemma Huijnen: Partner, Chiever in The Netherlands

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

**M**aria-Gemma specializes in the management and enforcement of large international trademark portfolios. She has experience in a variety of industries such as the fashion industry, food and beverages, as well as the entertainment industry. She is known for her dedicated approach, always seeking the most cost-efficient solutions and, where possible, settlements that both parties are happy with. She is co-owner of Chiever, a boutique trademark agency that advises on all trademark and design questions on a worldwide basis.

### What inspired your career?

Brands and trademarks have always been a part of my life. As a granddaughter of Dominique Claessens, who was a well-known brand specialist, artist, and pioneer in the design computer business, I have been surrounded by brands, logos, and packaging since I was a little girl. Being part of the family business, my father often came home with samples of new products and lookalike products to compare them. These were often hot topics at the dinner table. Renowned brands such as Heineken and La Paz were part of my childhood.

So being submerged by these inspiring designs, going through the supermarket with a critical eye, and always comparing products looking for similarities and differences, is why I decided I wanted to specialize in trademark law.

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

I had some wonderful mentors at the start of my career who really taught me the basics of our profession. I was extremely eager and hungry for more. I must admit that I felt lucky at times for being in the right place at the right time. But because of my determination and dedication, I was able to get where I am now. But believe



me, it hasn't been easy at all.

My advice to others is: never give up, believe in yourself, always see the positive side of things, and focus on your strengths. And make things easier for yourself. Get organized so you can focus on your goals.

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

Wanting to become a partner of a firm as a young woman was quite a challenge for me. It feels like you have to work 10 times harder in order to be able to prove yourself. But I did it, whilst having three children in the middle of my career.

I had the never-ending support from both my husband and my parents. Without them, their advice and insights, I am not sure whether I would have been as successful. It is so easy to doubt yourself, but the ones who know you best know what you are capable of and will push you further.

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

I remember that we were invited to participate for an RFP. At the time the partners of the firm weren't too eager to spend time on this due to other priorities. I convinced them that we should go for it, and I took the lead. The whole process was really inspiring and exciting. I felt so confident and convinced that we were the right firm for this client, that in the end, they decided to choose us. It really felt like a victory. This client is still very special to me and our firm.

Also, being listed as one of the 250 Women in IP in the world by IP Stars for four consecutive years has been an incredible and surreal honor. It should really be noted that those listings are only possible if you have an amazing and committed team supporting you with clients who aren't afraid to endorse you. I am still thankful for this every day.

“  
**My advice to others is: never give up, believe in yourself, always see the positive side of things, and focus on your strengths.**  
”





“Wanting to become a partner of a firm as a young woman was quite a challenge for me. It feels like you have to work 10 times harder in order to be able to prove yourself.”

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

I want to continue to work on Chiever's reputation and growth. We are often too modest, but our clients call us their "backbone", so we are surely doing something very right. Over the years I have seen so many companies struggling with their IP portfolios, so I know there is much room for improvement. The coming five years will be extra interesting with all the AI developments that will change our industry.

Further to that, I would like to grow in leadership and try to stimulate others in their careers. What we mostly don't realize is that others look at us women and learn. These are the people we work with, but also our friends and our children (and their friends!).

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

The big law firms really need to change their culture. Being inclusive and tolerant are key. Everyone has their own strengths and those should be put to use! Our clients are changing

and becoming more diverse, so we should be able to stay connected with our clients as well. I am really proud of how diverse we are as a company and how we all respect each other. Hopefully we can inspire others to do the same.

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

The most important is that women should continue to empower each other. Be kind and don't see each other as a threat. Give other women an opportunity if you are in that position and teach them. Be flexible and provide feedback so we can all learn.



# Orietta Blanco: Managing Partner, MINIÑO

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



Orietta Blanco is the Managing Partner of MINIÑO and founder of the firm's Intellectual Property (IP) Practice. Her practice encompasses all aspects of Intellectual Property Law in the Dominican Republic and the Caribbean. Orietta currently heads the privacy and data protection practice, and frequently advises local and foreign companies as regards privacy and data protection regulations and compliance. As part of her leadership functions at the firm, Orietta is responsible for the day-to-day and long-term strategic management of MINIÑO. She works closely with the firm's managers and advisors in the areas of human resources, technology, operations, marketing, and finance and is part of the leadership committee of the ESG group at the firm. Orietta has been the promoter and has been closely involved in the digital transformation of the firm and the implementation of software towards the standardization and optimization of processes. Throughout her career, Orietta has taken an active role in several committees and organizations related to Intellectual Property law. She is currently 1st vice-president of the Board of Directors of the Dominican Intellectual Property Association (ADOPI) (2022-2024) and was recently named vice-chair of the INTA Brands and Innovation Committee (2024-2025). Orietta's IP practice has been recognized for consecutive years by leading publications.

**What inspired your career?**

I started working in the IP field by chance. While at law school I worked as an intern at a full-service local firm that back then (1995) had one of the few IP practices in my country. This is a relatively young field in the Dominican Republic, and I had the opportunity to experience what practicing IP was in times when new laws, regulations, and international treaties were being adopted in our country. It was a fascinating and interesting time for the IP profession which

“  
My advice would be to find a good mentor, work hard, give yourself permission to make mistakes and take risks.”

made me immediately fall in love with it. By the time I had finished law school, I was completely sure I wanted to pursue a career in this field. After over 25 years of career, my passion for IP is still alive, and I do not see myself in a different role. What still inspires me to keep growing my career in this field is the dynamism of intellectual property and its role as an essential part of business and how it directly impacts the growth and evolution of society.

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

I have always considered my path as “a continued work in progress”.

My advice would be to find a good mentor, work hard, give yourself permission to make mistakes and take risks, have a learning mentality in everything you do, align your career path to your values, and enjoy the ride.

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

Like any other professional, I have faced many challenges and still face them. The mentality you have towards those challenges is what makes the difference. I try to pursue every challenge as a growth opportunity, and I make sure my inner voice sends the right message so I can keep strong and overcome them. Working hard, sticking to my values, and believing in myself are always strong foundations that help me with that inner voice.

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

The team I am part of and the professionals I've had the privilege to mentor or motivate along the way.

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

Constant learning and growth in my business are still part of my future career aspirations. I would like to combine those aspirations with impacting IP and society in my home country Dominican Republic, where there is still much to be done as regards educating the population in relation to the importance of IP as an essential part for the development and growth of our country. I would also like to impact by making IP legal advice accessible to entrepreneurs and creators to help them protect their IP assets and therefore their businesses and careers.

I plan to achieve those goals by aligning my individual career goals with my future career aspirations and by working hard every day taking steps (even if they are small) towards the achievement of those goals.

I have already taken some small steps in that direction; we recently launched a pro bono IP focused program specifically for entrepreneurs and creators and we are already handling over 10 matters. In addition to that, in my role as a member of the Board of the local IP Association (ADOPI), we work together to empower the community in the discussion and dissemination of ideas, public policies, and legal studies that provide guidance on the protection of intellectual property, as well as to work in the collection and dissemination of information and in the education and training regarding IP.

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

A unified standpoint involving all stakeholders in our industry, enabling us to collectively champion equality and diversity with the shared aspiration of eventually making these discussions unnecessary, transforming them from an issue into the accepted standard.

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

It is a responsibility for all women occupying leadership roles in the IP field (including myself) to use our roles to embrace gender equality and to support other women. Because the IP field has traditionally been a gender-equal area of law (in comparison with other areas), it is a good opportunity for us to be a role model and promote and support the empowerment of women in other sectors of law with more gender gaps.



The  
**Trademark**  
Lawyer

GLOBAL REACH, LOCAL KNOWLEDGE  
www.trademarklawyer magazine.com

# LAW FIRM RANKINGS 2023

## Europe and the UK

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





# The Trademark Lawyer

GLOBAL REACH, LOCAL KNOWLEDGE

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

## Austria

- ABP Anwälte Burger und Partner
- Binder Grösswang
- CMS Reich-Rohrwig Hainz
- DORDA
- Gassauer-Fleissner Rechtsanwälte GmbH
- GEISTWERT
- Salomonowitz Rechtsanwälte
- Schwarz Schönherr
- Wiltschek Plasser
- Wolf Theiss

## Belgium

- ALTIUS
- Bird & Bird
- Crowell & Moring
- Eubelius
- HOYNG ROKH MONEGIER
- NautaDutilh
- PETILLION
- Simont Braun
- Stibbe
- Van Innis & Delarue

## Bulgaria

- Bojinov & Bojinov
- BOYANOV & Co.
- Dimitrov, Petrov & Co. (DPC)
- Djingov, Gouginski, Kyutchukov & Velichkov (DGKV)
- Dr. Emil Benatov & Partners
- Gugushev & Partners Law Office
- Kambourov & Partners
- K TAHTADJIEV
- PETOŠEVIĆ
- Tsvetkova Bebov & Partners

## Cyprus

- AGP & Co
- Andreas Coucounis & Co LLC
- Christodoulos G. Vassiliades & Co. LLC
- Chrysostomides Advocates & Legal Consultants
- Elias Neocleous & Co LLC
- Haviaras & Philippou LLC
- IP Cyprus
- Koushos Korfiotis Papacharalambous (KKP LLC)
- Lellos P. Demetriades Law Office LLC
- Michael Kyprianou & Co LLC

## Czech Republic

- act Řanda Havel Legal
- Baker McKenzie
- Bird & Bird
- Čermák a spol
- CMS
- HAVEL & PARTNERS
- Havlík Švorčík and Partners
- Korejzová Legal
- Rott, Růžička & Guttman
- TRAPLOVÁ HAKR KUBÁT (THK Legal)

## Denmark

- AWA
- Bech-Bruun
- BUGGE VALENTIN
- Gorrissen Federspiel
- Horten
- LØJE IP
- Lundgrens
- NJORD Law Firm
- Patrade
- Plesner

## Estonia

- AAA Legal Services
- COBALT
- Ellex Raidla
- Eversheds Sutherland Ots & Co
- Hedman
- KÄOSAAR
- NJORD Law Firm
- Sorainen
- TGS Baltic
- TURVAJA OÜ

## Finland

- Backström & Co
- Borenius
- Castrén & Snellman
- Eversheds Sutherland
- Hannes Snellman
- Krogerus
- Merilampi
- Papula-Nevinpat
- Roschier
- Waselius & Wist

## France

- Baker Mckenzie
- BCTG Avocats
- Casalonga
- Deprez Guignot Associés
- DLA Piper
- DTMV
- Gide Loyrette Nouel
- Gilbey Legal
- Hogan Lovells
- Momentum Avocats

**Čermák a spol.** is a leading IP law firm in the Czech Republic and Slovakia, providing services in all areas of IP law, including patents, trademarks, utility models, industrial designs, unfair competition and others.

We have a qualified team of lawyers for both IP prosecution and litigation including litigation in court.

Our strengths is a unique combination of experienced and qualified patent attorneys and lawyers.

**ČERMÁK a spol.**  
advokátní a patentová kancelář  
law and patent office

<https://www.cermakaspol.com/>  
[info@apk.cz](mailto:info@apk.cz)


**M. Sc. Konstantin Tahtadjiev**  
Bulgarian & European Patent Attorney (EQE qualified)  
Bulgarian & European Trademark & Design Attorney

**TAHTADJIEV**  
INDUSTRIAL PROPERTY

PATENTS    UTILITY MODELS    TRADEMARKS    INDUSTRIAL DESIGNS

**Invent hard, IP it smart** We offer an individually tailored approach for getting the best possible protection for your business inventiveness and creativity in Bulgaria and Europe

[www.ktpatent.com](http://www.ktpatent.com)

## Excellence is in the details.


This is Preu Bohlig

Since 1959 we are one of the most renowned law firms in Germany in the fields of IP and pharmaceutical law.

We are ready to advise our clients before all divisions of the Unified Patent Court and provide excellent experience and in-depth knowledge re this new European court system.

We do not only solve cases – we achieve landmark decisions. With our offices in Munich, Berlin, Düsseldorf, Hamburg and Paris we coordinate international litigation and utilize our worldwide network.

[www.preubohlig.de](http://www.preubohlig.de)



## Germany

Bardehle Pagenberg  
Boehmert & Boehmert  
Gleiss Lutz  
Harmsen Utescher  
HARTE-BAVENDAMM  
Hogan Lovells  
KLAKA  
KLEINER Rechtsanwälte  
Lubberger Lehment  
Preu Bohlig

## Rankings: South America

in Issue 1 2024 of *The Trademark Lawyer*

To advertise contact [katie@ctclegalmedia.com](mailto:katie@ctclegalmedia.com)



## “One team to serve your needs”

**Kyriakides Georgopoulos Law Firm** sets the standards for others to follow. Over the years we have led the way in changing the face of legal services and in providing services that meet the needs of contemporary globalized businesses.

**KG Law Firm** is consistently ranked as a **top tier law firm** in the majority of prestigious international directories, such as IFLR1000, Chambers & Partners Global, Chambers & Partners Europe, Legal 500, with many of our lawyers receiving similar distinctions.

**Athens Office** 28, Dimitriou Soutsou Str. 115 21 Athens GR T+30210 817 1500  
**Thessaloniki Office** 17, Ethnikis Antistasseos Str. 551 34 Thessaloniki GR T+302310 441 552

[www.kglawfirm.gr](http://www.kglawfirm.gr)



KYRIAKIDES GEORGOPOULOS Law Firm




## Move your inventions forward. We take care of the rest.

[www.boehmert.com](http://www.boehmert.com)

**Industries**

- Chemistry
- Electrical Engineering
- Internet
- Creative Industries
- Physics
- Pharmaceuticals/ Life Sciences
- Mechanical Engineering
- Software / IT

**Legal Areas**

- Patents and Utility Models
- Unfair Competition
- Employee Inventions
- Domains
- Licensing
- Trade Marks
- Information Technology
- Data Protection
- Designs
- Patent Valuation
- Patent Litigation
- Product Piracy
- Copyright

**90+** Patent Attorneys & Attorneys at Law

**90+** Years of Competence & Client Confidence

**9** Locations in Germany and worldwide




## DR HELEN G. PAPACONSTANTINOU & PARTNERS LAW FIRM

Established 1920

2, Coumbari Str., Kolonaki, 10674 Athens, Greece  
T: +30 210 3626624 • F: +30 210 3626742  
E: [mail@hplaw.biz](mailto:mail@hplaw.biz) • W: [www.hplawfirm.com](http://www.hplawfirm.com)


- Patents
- Utility Models
- SPC's
- Plant Breeders' Rights
- Trademarks
- Designs
- Copyright
- Anti-Counterfeiting & Anti-Piracy
- Litigation
- Licensing
- Franchising

- Commercial and Corporate Services
- Internet
- E-Commerce and Domain Names
- Competition Law
- Advertising / Consumer Protection
- Foreign Jurisdictions
- Consultancy



## Greece

A & K Metaxopoulos & Partners  
Ballas, Pelecanos & Associates L.P.C.  
HP&P | Dr. Helen G. Papaconstantinou and Partners  
DRAKOPOULOS  
Kiortsis & Associates Law Offices  
KLC Law Firm  
Kyriakides Georgopoulos Law Firm  
Malamis & Associates  
Patrinos & Kilimiris  
Tsibanoulis & Partners



## Hungary

Baker McKenzie  
BÉRCZES FULAJTÁR Law Office  
Bird & Bird  
CMS  
DANUBIA  
Germus and Partners  
Gödölle, Kékes, Mészáros & Szabó  
Oppenheim  
SBGK  
Szecskay Attorneys at Law



**glp**® Your European IP Partner

Pushing forward the world's greatest innovators.

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

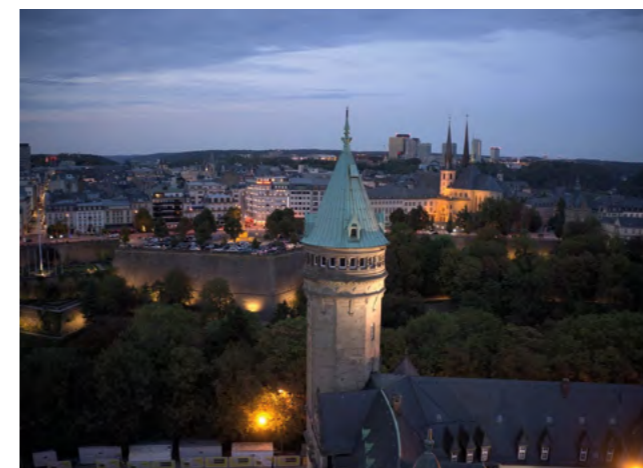
Via L. Manara 13 20122 MILANO +39 02 54120878 glp.mi@glp.eu  
V.le Europa Unita 171 33100 UDINE +39 0432 506388 glp@glp.eu  
Via di Corticella 181/4 40128 BOLOGNA +39 051 328365 glp.bo@glp.eu  
Other offices: PERUGIA - ZÜRICH SAN MARINO glp.eu

Italy

- ADVANT Nctm
- Bird & Bird
- BonelliErede
- (BCIP) Bresner Cammareri Intellectual Property
- GLP
- Hogan Lovells
- IP LAW GALLI
- Jacobacci & Partners
- Martini Manna & Partners
- Trevisan & Cuonzo

Luxembourg

- Arendt
- Bonn & Schmitt
- C Law
- Clifford Chance
- Decker & Braun
- Elvinger Hoss Prussen
- Lecomte & Partners
- LG Avocats
- NautaDutilh
- Patent 42



**PATENT 42**  
Patents - Trademarks - Designs

**YOUR IP ANSWER IN EUROPE**

Representation in Europe, Benelux, Luxembourg, France and Belgium

BP 297  
L-4003 Esch-sur-Alzette  
Luxembourg  
www.patent42.com  
info@patent42.com

Netherlands

- AC&R
- Brinkhof
- De Brauw Blackstone Westbroek
- DLA Piper
- Hoogenraad & Haak
- HOYNG ROKH MONEGIER
- Kennedy Van der Laan
- Leeway
- Ploum
- Visser Schaap & Kreijger

Poland

- Baker McKenzie
- JWP
- Kulikowska & Kulikowski
- LDS Łazewski Depo & Partners
- Patpol
- PolSERVICE
- Sottysiński Kawecki & Szlęzak
- Sulima Grabowska Sierzputowska
- Traple Konarski Podrecki & Wspólnicy
- Zaborski, Morysiński Adwokacka Spółka Partnerska

Portugal

- Abreu Advogados
- A.G. da Cunha Ferreira, Lda
- BMA
- Caiado Guerreiro
- Cuatrecasas
- CMS Portugal
- Garrigues
- Inventa
- PLMJ
- Simões, Garcia, Corte-Real & Associados

Trevisan & Cuonzo

A one-stop shop for every branding need.

Milan | Rome | Parma | Bari  
www.trevisancuonzo.com

**CAIADO GUERREIRO**  
INTERNATIONAL LAW FIRM

**INTELLECTUAL PROPERTY SERVICES**

talk to us at  
[caiadoguerreiro.com](http://caiadoguerreiro.com)

**Rankings: Asia**  
in Issue 3 2024 of  
*The Trademark Lawyer*  
To advertise contact  
[katie@ctclegalmedia.com](mailto:katie@ctclegalmedia.com)



## CABINET M. OPROIU

EUROPEAN PATENT AND TRADEMARK ATTORNEYS

Founded in March 1995, CABINET M. OPROIU is a professional partnership of industrial property attorneys, engineers, chemists, physicists and attorneys-at-law, all specialized in the field of industrial property rights, based in the city of Bucharest, Romania.

**Address:** Popa Savu Street No. 42, Ground Floor, P.O. Box 2-229, Bucharest, Romania  
**Tel:** +40 21 260 2833; +40 21 260 2834  
**Fax:** +40 21 260 2835; +40 21 260 2836  
**Email:** raluca@oproiu.ro  
**Website:** www.oproiu.ro

## Romania

CABINET M. OPROIU  
 Enpora  
 "MILCEV BURBEA"  
 Muşat & Asociații  
 Nestor Nestor Diculescu Kingston Petersen (NNDKP)  
 PETOŠEVIĆ  
 Ratza & ratza  
 SIMION & BACIU  
 Ţuca Zbârcea & Asociații  
 Zamfirescu Racoti Vasile & Partners

## Spain

Abril Abogados  
 Balder  
 Bird & Bird  
 ELZABURU  
 Gómez-Acebo & Pombo  
 GRAU & ANGULO  
 H&A  
 HOYNG ROKH MONEGIER  
 PONS IP  
 Uria Menéndez

## Switzerland

FMP Fuhrer Marbach & Partners  
 Homburger  
 IPrime  
 Lenz & Staehelin  
 MLL Meyerlustenberger Lachenal Froriep Ltd  
 Rentsch Partner  
 Schellenberg Wittmer  
 TIMES Attorneys  
 Troller Hitz Troller  
 Walder Wyss

## Turkiye

Deris  
 Destek Patent  
 Esin Attorney Partnership  
 Gün + Partners  
 Kenaroğlu Avukatlık Bürosu  
 Moroğlu Arseven  
 NSN Law Firm  
 OFO VENTURA  
 Stock Intellectual Property Services  
 Suluk Intellectual Property Law Firm

We Make Sure Your IP Is VIP

INTERNATIONAL EXPERTISE, EFFICIENT SOLUTIONS, RELIABLE RESULTS IN SPAIN, EUROPE AND LATIN AMERICA.

**BALDER**  
 www.balderip.com

## Rankings: America + Middle East & Africa

in Issue 4 2024 of *The Trademark Lawyer*

To advertise contact [katie@ctclegalmedia.com](mailto:katie@ctclegalmedia.com)

## Sweden

AWA  
 Delphi  
 Fenix Legal  
 Groth & Co  
 Gulliksson  
 Lindahl  
 MAQS  
 Synch  
 Vinge  
 Westerberg & Partners

Lindahl

**STAY AHEAD WITH CLEAR ADVICE**

Intellectual property and trademark law is complex. Lindahl's advice are straight-forward and to the point. Let us help you prepare for the future, by simplifying the complex and letting you focus on the business.

Read more on [lindahl.se](http://lindahl.se) or contact [Johan Norderyd](mailto:Johan.Norderyd@lindahl.se), our lead partner within IP law, at [johan.norderyd@lindahl.se](mailto:Johan.Norderyd@lindahl.se)

**fenixlegal**

INTERNATIONAL PATENT AND LAW FIRM

SWEDEN • SCANDINAVIA • EUROPE

European Patents • EU Trade Marks  
 Community Designs • Copyright  
 IP Due Diligence & Business Law • Internet Law  
 Domain Name Disputes & Social Network Law  
 Marketing Law • Mediation

Brahegatan 44, 11437 Stockholm, Sweden • [www.fenixlegal.eu](http://www.fenixlegal.eu) • [info@fenixlegal.eu](mailto:info@fenixlegal.eu)



## Is your next move protected?

From patent filing and trade mark registration, to litigation and commercial exploitation, our team of patent attorneys, trade mark attorneys, and lawyers provide an award winning full-service IP offering.

[www.marks-clerk.com](http://www.marks-clerk.com)

Marks & Clerk   
 marksandclerk   
 marksandclerk

### Ukraine

- Aequo
- Arzinger
- Baker McKenzie
- Doubinsky & Osharova
- Ilyashev & Partners
- Mamunya IP
- MIKHAILYUK, SOROKOLAT & PARTNERS
- Pakharenko & Partners
- Sayenko Kharenko
- Synergy IP Law Agency

### United Kingdom

- Appleyard Lees
- Bird & Bird
- Bristows
- CMS
- Fieldfisher
- HGF
- Marks & Clerk
- Mishcon de Reya
- Pinsent Masons
- Taylor Wessing

Global expertise from a European base



Austria France Germany Ireland Netherlands Switzerland United Kingdom

HGF offers a fully integrated IP solution, bringing together trade mark attorneys, patent attorneys and IP solicitors across 24 offices throughout Europe.



EUROPE'S LEADING PATENT LAW FIRMS 2019 – 2023

[hgf.com](http://hgf.com)

HGF Limited  
 @HGF\_IP

# Social media influencers and intellectual property: dos and don'ts

Ricardo Costa Macedo, Adriana Magalhães and João Bertholo Meireles of Caiado Guerreiro detail the most common instances of intellectual property right use by influencers on social media to identify key considerations for both protection and the prevention of infringement.



Ricardo Costa Macedo



João Bertholo Meireles



Adriana Magalhães

In today's world, social media platforms play a major role and impact our daily lives. With the technological advancements of the last decades, people are now more connected than ever, being able to interact with their friends across the world and even share content with other users in each platform.

Equally, most companies and businesses were eager to "catch the wave" and have begun using social media platforms to sell their products online, overlooking national borders and targeting consumers worldwide.

As a consequence of these technological developments, it was inevitable that new professions and career opportunities would arise and emerge in the digital realm. Accordingly, many people decided, or rather were declared to be, social media influencers.

For the purposes of this article, a social media influencer is someone who – being an active user of social media platforms with established credibility in a specific industry, due to, for example, their apparent knowledge of a specific matter – has the power to persuade and affect the purchasing decisions of consumers interested in such market sector.

Contrary to what some might initially believe, this definition of a social media influencer does not require a minimum number of followers or supporters.

Inevitably, companies and businesses quickly realized that social media influencers could serve as a bridge between the products they were trying to sell and their consumers. Actually, there tends to be an overlap between the target audience of those companies and businesses



(the group of people who are most likely to buy their product) and the influencers' followers on social media.

As such, the importance of social media influencers, when it comes to the marketing and advertising of someone's products, has grown exponentially, with the main source of income of these individuals stemming from the upload of content on social media platforms promoting said goods to their followers.

Indeed, nowadays, many companies and businesses would rather pay social media influencers to market and advertise their products than resort to more classic marketing techniques, like billboard advertising or TV advertising campaigns, amongst others.

This is due to the fact that many companies and businesses find that social media influencers can provide, most times, better results with the same resource expenditure.

## Résumés

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

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

Ricardo graduated in 1998, from the Faculty of Law of the Catholic University of Lisbon. He undertook postgraduate studies in Information Society Law at the Faculty of Law of the University of Lisbon in 2000 and in Commercial Law at the College of Law, London in 2003.

He is admitted to the Portuguese Bar Association and regularly publishes on matters relating to his fields of expertise.

### Adriana Magalhães, Associate Lawyer at Caiado Guerreiro

Adriana was admitted to the Portuguese Bar Association in 2022 and is a member of Caiado Guerreiro's Intellectual Property group.

She has been focusing her practice on a wide range of intellectual property matters, including trademarks, patents, designs, and copyright, both in contentious and non-contentious issues, in various business sectors.

Adriana completed her Law Degree and a Postgraduate Diploma in Intellectual Law at the University of Lisbon Law School, in 2019, as well as her Master's Degree in Civil Law at the same University, in 2023.

### João Bertholo Meireles, Junior Lawyer at Caiado Guerreiro

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

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

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

To illustrate the importance of social media influencers, one may consider the following example: there is an individual who is considered to be an expert on fashion and designer clothes. They have built a reputation online due to their knowledge and expertise on the matter, posting content where they reveal the current trends or attempts to educate others on such subject matter.

Naturally, their followers on social media, who like, comment, and interact with the content posted online, will likely also be interested in fashion and designer clothes. Additionally, new followers, aiming to learn more about the topic, may also begin to interact on this social media influencer's profile.

This *status quo* provides an ideal setting for a clothing brand seeking to market and advertise its products online. Undoubtedly, reaching out to the abovementioned social media influencer can be considered a better approach than, for instance, doing a billboard advertisement.

While billboard advertising can be effective in many instances, there are several limitations to this method of advertising, namely the difficulty of targeting a specific market sector and the limited information it can convey.

As expected, the billboard will be seen by hundreds, if not thousands, of drivers each day. However, many of those drivers will likely have no interest in the product being offered to them.

Contrastingly, as explained above, the content posted by social media influencers can target, in a much better way, the audience who is interested in particular products and convey more detailed information around the topic, improving the chances of engagement.

This is extremely important for companies and businesses as they will reach their target audience with less amount of money being spent and their products will be seen by a more specific group of consumers who are more likely to buy them.

All of this has had an impact on the marketing and advertising strategies of companies and businesses, which seek, every day, to be as efficient as possible with their resource's allocation, doing extensive research of the marketplace to acquire sufficient knowledge to understand which business strategies work and which ones do not.

Now that the importance that social media influencers acquired on the marketing and advertising strategies of companies and businesses has been ascertained, one can now discuss why said individuals need to understand intellectual property.

In this regard, what can be understood by intellectual property rights, and what justifies their existence?



Intellectual property rights are, as the name suggests, property rights that grant their legal owner the exclusive use and exploitation of the subject matter encompassed in such right. To put it differently, intellectual property rights proscribe third parties from using and exploiting the subject matter included in their scope of protection, unless authorized by their holder.

However, contrarily to most property rights, the subject matter of intellectual property rights are intangible assets, namely ideas, innovations, and creations.

As to why intellectual property rights exist, one should consider that they encourage and reward innovative and creative work, stimulate investment in research and development (which is crucial to economic growth and prosperity), and allow the author or creator to benefit from the results of their work.

What type of intellectual rights should one typically consider in the context of social media influencers?

On this front, one should consider trademarks and copyright as these two intellectual property rights seem to be the ones more commonly present on social media platforms, and so should deserve the most attention. Naturally, there can be other relevant intellectual property rights, but these are the most obvious ones to consider here.

In respect of trademarks, using the definition presented by Paul Torremans, Professor of Intellectual Property Law, they represent any sign that is capable of being represented in the register in a manner that enables everyone to

determine the clear and precise subject matter of protection and distinguishing the goods and/or services of one undertaking from those of other undertakings.

In this regard, social media influencers can proceed to register their own brand or brands in order to begin promoting their goods and services.

A good way to start is by registering said influencer's name as a trademark or even their username in the social media platform.

Additionally, social media influencers have the possibility to apply for the registration of figurative marks, which allow for the inclusion of a graphic, logo, or even said influencer's appearance.

Another relevant intellectual property right for social media influencers is copyright, which seeks to protect literary and artistic works from, as the name implies, being copied or reproduced without the consent of the author.

Through copyright, the originality necessary to create the literary or artistic work is protected. Such works can involve books, films, photos, music, amongst others.

Therefore, almost every content posted online by social media influencers will, in some way, be protected under copyright, with such right arising automatically, meaning as soon as the work is created, and contrary to what occurs for trademarks which need to be registered before a trademark office.

For instance, when a social media influencer takes a photograph, they do not need to register it before a particular authority or office, with the legal ownership of that photograph arising automatically.

“ Social media influencers can proceed to register their own brand or brands in order to begin promoting their goods and services. ”



“  
Infringing  
others’  
intellectual  
property  
rights is  
easier than  
one would  
initially  
think.”

The same applies to videos created by influencers and, subsequently, uploaded on social media platforms and even, in some scenarios, choreographies, when such dances are considered to be a creative work.

Fundamentally, social media influencers should understand that the content they post online is protected under intellectual property law but can also result in the infringement of intellectual property rights of third parties.

Up to this point, it has been discussed how social media influencers should protect the original content that they upload and post online, preventing their photos, videos and music from being plagiarised, and how they can increase their income and remuneration by creating their own brand and beginning to sell their own goods and services.

However, it is crucial for said influencers to be aware of other ramifications of intellectual property law so that they can also focus on protecting the rights of others by avoiding infringing others intellectual property rights, which, in many instances, leads to legal action of a civil or criminal nature.

In fact, infringing others’ intellectual property rights is easier than one would initially think.

Social media influencers need to be aware of the brand names appearing in the content they post online and also product names, company logos, and even slogans.

The unauthorized use of any of the signs mentioned above by social media influencers will likely amount to a trademark infringement, with several remedies being available to the legal owner of the intellectual property right.

The same also applies to cases of accidental inclusion of brand names and logos, so precautionary measures to avoid infringement are highly recommended.

As regards copyright, one of the main points that social media influencers have to be conscious of is that music is protected. For that reason, if a social media influencer uploads a picture or video online together with a famous and trending song, despite having legal rights to said content (the photograph or video), they are likely infringing the copyright in the music.

Actually, this is a common mistake when it comes to social media users, which leads to many musicians taking action to remove their works from such platforms in order to prevent having their music illegally reproduced. This is done by resorting to the copyright report form of the social media platform in question and asking for the removal of the post or content uploaded in the social media influencer’s profile.

The same is applicable to orphan works, namely works whose owner is unknown at the time of the usage. Social media influencers

need to consider that, despite not being able to determine who created such work, music, or photo, the same is still protected and its usage will result in an infringement.

Nonetheless, not all uses of a work protected under copyright give rise to an infringement, meaning there are some defenses and exceptions available.

The first defense, which is the easiest to foresee, is to ask for consent or authorization from the owner of the copyright, in order to use their intangible asset.

Additionally, other defenses to copyright infringement include research and private study, reviews and criticisms, or even the use of quotation marks and mentioning the author of the work.

It is particularly relevant to highlight the possibility that social media influencers have for making reviews and criticisms, as their social media followers tend to be interested in the honest opinion that influencers have on particular products in the market sector they specialize in.

Last but not least, when social media influencers are collaborating with each other, it is key to understand who is the owner of the intellectual property rights arising thereof.

In these cases of collaborations, influencers should establish, prior to creation, who will become the owner of the photos or videos taken during the collaboration and who is entitled to use and share the content afterwards.

In conclusion, a responsible social media influencer that understands intellectual property: (i) is aware of the content they post online and makes sure it does not infringe others intellectual property rights, (ii) avoids using brand names and trademarks, unless authorized by the respective owners, (iii) distinguishes a genuine and proper review of a product from marketing and advertising, (iv) understands that each social media platform has different terms of use regarding intellectual property and (v) does not forget that music is protected under copyright law!

## Contact

**Caiado Guerreiro**

Rua Castilho, 39 – 15° 1250-068 Lisboa, Portugal

Tel: +351 213 717 000

law@caiadoguerreiro.com

www.caiadoguerreiro.com

# Top 100 New Brands 2023: the changing dynamics in the modern brand landscape

**Robert Reading, Head of IP Content Strategy at Clarivate, highlights key findings from the recently published Top 100 New Brands report to expose the growth in specific sectors and locations.**

Trademark data contains a wealth of information well beyond the brands that are being protected. When a brand is created it is shaped by the world around it. Visual elements, including colors and fonts, will reflect current tastes and trends. The verbal elements may be tailored to appeal to particular age groups or markets. When legal protection is sought – via a trademark application – the nationality of the owner, the country of filing, the Nice Class<sup>1</sup> and goods and services covered all take into account complex commercial needs and intentions.

Analyzing trademark data reveals insight into our current world and how it is changing. However, the task is not without challenges. Each year over 10 million new trademark applications are filed around the world, at over 240 trademark



Robert Reading

“  
Each year  
over 10  
million new  
trademark  
applications  
are filed  
around the  
world, at  
over 240  
trademark  
registers.”

registers. To identify and monitor trends, global data needs to be captured and updated for multiple years. Clarivate has been collecting and compiling trademark data for over 100 years. This data is fully cataloged and digitized, even for trademark registers that still work with paper, and the Clarivate trademark database now contains over 150 million individual records.<sup>2</sup>

However, even a global collection of curated trademark data is not sufficient for analysis. Special tools and methodology have been put in place to link records together so that a brand filed as separate, unconnected applications in multiple jurisdictions can be treated as a family of records, and variations in owner name and entity format can be harmonized. The methodology also applies scoring that takes into account market size (based on GDP), relative dominance within each Nice Class, and the breadth of commercial activity.

With this in place, Clarivate is able to review and score over 20 million trademark applications filed globally in 2021-2022, identify the 100 brands with the highest scores, and perform an analysis of these emerging 2023 brands to reveal trends and issues that show how our world is evolving and changing at record pace.

**Technology is dominating the modern brand landscape**

Technology plays an ever more important role in society as each year passes. The Top 100 New Brands 2023 list contains a significant number of

<sup>1</sup> The Nice Classification categorises every single product or service that can be bought or sold into one of 45 Classes (34 for products and 11 for services)

<sup>2</sup> Clarivate SAEGIS® trademark database as of 28/08/2023



technology brands. The companies with the largest number of entries this year were Apple, Huawei, and Yuga Labs with five each. Global brands were launched covering fitness and health apps, artificial intelligence, smart watches and other electronic devices, fintech, and software.

One specific category of global brand highlights the rapid pace of technical change: non-fungible tokens (NFTs). Yuga Labs launched a number of global NFT brands including BORED APE YACHT CLUB, but it appears that keeping the attention of consumers with new technology can be challenging. NFTs – together with the much-hyped online metaverse – had a relatively short period in the spotlight and they now feel like yesterday's news, replaced by generative AI as the current hot technology topic. The USPTO received over 2,500 trademark applications covering NFTs in the first three months of 2022; the first quarter of 2023 saw just over 1,000 NFT related applications filed. In Q3 2023 the number of applications has fallen again to just over 500.

In the medical space biotech brands are becoming as important as traditional pharmaceutical brands.

#### Global brands are expanding to the East

Geography is another key trend that has been evolving quickly in recent years. Global brands have traditionally been predominantly based in

“  
NFTs –  
together with  
the much-  
hyped online  
metaverse  
- had a  
relatively  
short period  
in the  
spotlight  
and they  
now feel like  
yesterday's  
news,  
replaced by  
generative AI.”

the West. Companies from the United States and Europe have dominated the luxury, fashion, entertainment, technology, and medical sectors. Global brands from the East have been emerging slowly, mainly in the electronics and automotive space and mostly from Japan and more recently South Korea. The Top 100 New Brands 2023 report shows that this is changing rapidly. 27 of the 100 new brands are from China, more than any other single country. The United States was second with 25 brands. Europe and the UK combined provided 32 entries, which is less than China, South Korea (5), and Japan (4) with a combined total of 36 entries. The global brand space is also becoming more “global”, with brands from Morocco (4), Turkey (1), UAE (1), and Australia (1) appearing in the Top 100 for the first time.

#### The automotive sector sees exponential growth

One area of analysis has shown stability over time – the industry sectors that provide global brands. The overall numbers for 2023 closely match the numbers from last year: the consumer goods and food sector had 23 entries in the Top 100; the software, media, finance, and fintech sector provided 18 entries; luxury, fashion, and sports had 15; electronics and computing equipment was fourth with 14. There was significant growth in the automotive sector, with 13 brands compared to just six in 2022 – the driver (no pun intended)

appears to be the shift from internal combustion to electric and hybrid power. Lamborghini, the Italian supercar manufacturer now part of the Audi/Volkswagen group, launched the REVUELTO just before marking their 60th anniversary – their first hybrid electric vehicle.

Consumers also have a significant impact on the types of new brands that we see. ECODESIGN by Decathlon, SUSTAINera from Stellantis and Panasonic GREEN IMPACT have been created in response to consumers increasingly seeking products and services with a lower environmental impact. ZEEKR, a new premium electric automotive brand owned by Geely Automobile Holdings from China, deliberately calls out a newly important young generation of consumers. Created from Gen Z and the word “geek”, the brand targets a generation born in the mid 1990s who have grown up with technology and online access as part of their lives and are now reaching the age when they can consider car ownership.

#### Global brands meeting the changing demands

One final trend that is becoming stronger with each passing year is that global brands are taking advantage of the Madrid International Trademark System managed by the World Intellectual Property Office (WIPO) in Geneva. The system has expanded considerably in the past decade and now allows brand owners to file a single application, with a single payment of fees, in one language, that covers up to 114 trademark registers/130 countries. From just over 10,000 applications in 2000, WIPO received nearly 70,000 applications in 2022.

Creating new brands has always been a challenge. The complexity is multiplied when a brand crosses borders, and is magnified further when launching worldwide. Trademark registers are becoming more crowded than ever and trends come and go at lightning speed. The Top 100 New Brands report shows that brand owners are meeting the challenge. Brand creation is alive and well and creating powerful new brands to meet the changing demands of consumers on a truly global scale.

#### Contact

Clarivate  
www.clarivate.com



“  
The global brand space is also  
becoming more “global”, with brands  
from Morocco (4), Turkey (1), UAE (1),  
and Australia (1) appearing in the  
Top 100 for the first time.”



# The right to privacy gets recognition in India!

**Rachna Bakhru and Vanshika Oberoi of RNA, Technology and IP Attorneys detail the long-awaited and newly passed legislation for data protection in India, known as the Digital Personal Data Protection Act.**

The wait is finally over, and India has a dedicated personal data protection law! Over several years, the draft of this crucial legislation underwent multiple iterations, signaling the Indian government's intent to establish robust data protection measures of international standards. The Digital Personal Data Protection Bill of 2023 was presented in Lok Sabha on August 3, 2023, by the Minister of Electronics & Information Technology and successfully passed the legislative process by obtaining Presidential assent on August 11, 2023. The name of the Act was changed from PDPA (Personal Data Protection Act) to Digital Personal Data Protection Act (hereinafter DPDP) since the new law focuses only on digital personal data and excludes non-digital personal data except when the data manually collected is stored or processed digitally.

## Date of implementation:

While the DPDP Act became a law on August 11, 2023, the government has yet to draft rules governing the Act and constitute a board to enforce the Act and adjudicate disputes. As per a press release, the Act will be effective from the date of enactment, and the rules will be released shortly. While no sunrise period is mentioned in the Act, it is anticipated that the companies will get one year to transition into the new law.

## Who are the Key Stakeholders for the implementation of the Act?

Since the DPDP Act uses different terminologies to address the stakeholders compared to the GDPR, the table to the right is for quick reference and familiarity.

Equivalent term in GDPR	DPDPA
<b>Data Controller</b>	<b>'Data Fiduciary'</b> referring to entities or organizations responsible for determining the purpose and means of processing personal data.
<b>Data Processor</b>	<b>Data Processor</b> , processes data on behalf of Data Fiduciary, ensuring security.
<b>Data Subject</b>	<b>'Data Principal'</b> refers to the individuals to whom personal data relates, emphasizing their ownership and control over their data.
Under GDPR, there is no single centralized Data Protection Board for the European Union.	<b>Data Protection Board of India (DPBI)</b> , is a regulatory body responsible for overseeing and enforcing data protection laws and regulations.
GDPR does not use the term 'Significant Data Fiduciary'.	DPDPA proposes a specific category of <b>'Significant Data Fiduciary'</b> , which refers to entities handling a large volume of personal data.
GDPR does not use the term 'Consent Manager'.	DPDPA introduces the formal role of <b>'Consent Manager'</b> to oversee and enhance the consent process, providing structured and regulated services for managing user consent effectively.

The above stakeholders will collectively contribute to establishing a comprehensive data protection ecosystem, ensuring that personal data is managed, processed, and protected in a manner that respects individuals' privacy rights and meets regulatory requirements.

## What constitutes personal data/information (PI)

As per data protection and privacy laws, personal data includes information allowing individual identification, like name, contact details, birthdate, identification numbers, biometric data, location data, online identifiers, and more. This broad definition covers various data types linked to specific individuals.

## What are the grounds for collecting and processing personal information (PI) in India?

1. Consent as the main ground: Consent is the primary and fundamental ground for processing personal information. This means individuals must provide explicit and informed consent before their data can be collected and processed. Consent should be freely given, specific, and revocable, ensuring individuals have control over their data.
2. Legitimate use: While consent is the main ground, the Act likely specifies cases where processing personal information without explicit consent is permissible. Such conditions may include legal obligations, protection of vital interests, performance of a contract, compliance with a legal requirement, or the pursuit of legitimate interests by the data fiduciary or a third party.
3. Exemptions: The Act may also outline exemptions where specific categories of personal information or processing activities are exempted from the consent requirement. These exemptions could be related to national security, law enforcement, or other compelling public interests. Thus, the government will have the control to access personal data at any time based on the above situations.

## What are the rights of data subjects/principals?

The DPDP significantly enhances individuals' rights concerning their data. Individuals have



Rachna Bakhru



Vanshika Oberoi

the right to access their data, allowing them to understand how their information is being processed. They can rectify inaccuracies, request the deletion of their data (the right to be forgotten), and port their data to other services. Additionally, the Act grants individuals the right to know who is processing their data and for what purposes, empowering them to exercise greater control over their personal information.

## What will change for the Data Fiduciaries/Controllers?

### Implications and compliance requirements

Before the enactment of the DPDP Act, there was limited remedy available for protecting personal data under the Information Technology Act 2000, mainly focussed on sensitive personal information like health and finance records. However, on the lines of the GDPR, India's DPDP Act imposes responsibilities on the Data Fiduciaries to protect the personal information handed over to them for a specific purpose. The DPDP is anchored in seven core principles outlined below and emphasizes that data must be processed only for its intended purpose, barring lawful exemptions.

## Résumés

### Rachna Bakhru, Partner

Rachna 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.

### Vanshika Oberoi, Trademark Associate, RNA Technology & IP Attorneys

After earning a law degree from Amity Law School, Noida, and passing the All India Bar Exam in 2018, Vanshika has handled an array of Trademark Portfolios and legal matters, representing the interests of corporate and individual clients on complex issues. Vanshika has authored and published a number of articles for leading publications and has also dealt with numerous commercial corporate matters, including, but not limited to drafting, client management, contract review, and vetting. Currently, she works for the Trademark Prosecution Team at RNA Technology and IP Attorneys.

**1. Consent and transparency:**

As discussed above, one of the fundamental pillars of the DPDPA is the requirement for explicit and informed consent. Organizations must obtain unambiguous consent from individuals before collecting or processing their data. This consent must be specific, indicating the purpose of data processing, and individuals have the right to withdraw their consent at any time. This means

individuals must clearly understand what they consent to without undue pressure or ambiguity. The duty is cast upon the Data Fiduciaries to provide consent notice in 22 regional languages of India so that the data subjects understand it well and are not compelled to consent.

Transparency obligations mandate that organizations communicate their data processing activities clearly, enabling individuals to understand how their data is used.

The Data Fiduciaries must integrate data protection into their processing activities and business practices from the design stage to the lifecycle.

**2. Data minimization and purpose limitation:**

The DPDPA promotes the principle of data minimization, encouraging organizations to collect only the data necessary for the intended purpose. Moreover, it enforces purpose limitation, ensuring that personal data is not processed beyond the purpose for which it was collected without obtaining additional consent. This restriction mitigates the risk of data misuse and aligns data processing activities with individuals' expectations.

**3. Data accuracy:**

The DPDPA will improve data accuracy significantly. Organizations must ensure that the personal data they collect is correct, complete, and current. The Act further imposes a duty on the Data subjects to provide accurate data.

**4. Data security and accountability:**

To protect personal data from breaches and unauthorized access, the DPDPA mandates organizations to implement robust security measures. Data controllers and processors will be held accountable for ensuring personal data's confidentiality, integrity, and availability.

Accountability measures, such as data protection impact assessments and regular audits, will become essential for organizations to demonstrate compliance with the Act's provisions.

**5. Accountability for data breaches:**

As per section 8(6) of the Act, in case of a personal data breach, the Data Fiduciary shall give the Board and each affected Data Principal intimation of such breach in the prescribed manner. The Act also prescribes hefty penalties in case of failure to report the data breach to the Board, extending to Rs. two crore (approx. US\$250,000).

**Cross-border data transfer**

Cross-border data transfers are subject to stringent conditions under the DPDPA. Organizations can transfer personal data to countries lacking adequate data protection laws only if appropriate safeguards, such as standard contractual clauses or binding corporate rules, are in place. This provision

ensures that individuals' data remains protected even when transferred internationally.

**Future**

The act is likely to impact several industries using technology for conducting their businesses. Most organizations collect, store, process, retain and transfer personal data and will need to develop a strong data privacy and protection program and a robust data security system. The companies will need to integrate data protection into their processing activities and business practices, from the design stage right through the lifecycle.

**Conclusion**

It is exciting that India finally has a *sui generis* law to protect personal data/information safety. The data protection law was the need of the hour to act as a foundation for good governance of the government's several initiatives, such as Digital India and the growth of artificial intelligence, given that AI systems often scrape large amounts of personal data in every industry.

However, since the Act seems to have been passed abruptly, there is uncertainty about its enforcement and the timelines for framing the rules. While the Data Fiduciaries are preparing to

“  
The Act also prescribes hefty penalties in case of failure to report the data breach to the Board.  
”

transition into the new compliance requirements, they need clarity on several issues, such as appointing the consent managers, who would be significant data fiduciaries, etc. There are also concerns that the government has extensive control over enforcing the Act and the power to access personal data at any time. If the government does not frame the rules supporting the Act and constitute the Data Protection Board, the law will remain on paper with no teeth.

**Contact****RNA, Technology and IP Attorneys**

401-402, 4th Floor, Suncity Success Tower,  
Sector – 65, Golf Course Extension Road,  
Gurgaon - 122 005,

National Capital Region (Haryana), India  
Offices: Delhi | Chennai

**Tel:** +91-124-4296999

info@rnaip.com

www.rnaip.com

# [FRESH PERSPECTIVE]

\* PROTECTION

\* ENFORCEMENT

\* TRANSACTIONS

\* CONSULTING

\* COMMERCIALISATION

\* DIGITAL

WWW.RNAIP.COM

GURUGRAM | CHENNAI





# Trademarks in commercial concession agreements: law enforcement problems

**Sergey Zuykov, Managing Partner at Zuykov and partners, discusses topical issues regarding the role of trademarks as part of a set of exclusive rights granted by a copyright holder under a commercial concessions agreement.**

In recent years, relations based on a commercial concession agreement have been widely demanded in the economic sphere of the consumer sector. Experts note that its contractual structure is the best means of expanding business for firms that ensure the implementation of high standards of entrepreneurial activity using this method. In addition, this business model allows you to create and develop a network business model in a much shorter time, including in different countries.

At the same time, questions remain regarding the legal regulation of the commercial concession agreement, which leads to disputes about the effectiveness of the normative provisions of national law and, as a result, litigation, for example, about the abuse of the right in the absence of registration of exclusive rights.

Among others, the issues of the role of a trademark as part of the complex of exclusive rights belonging to the copyright holder and the consequences associated with the lack of rights to the trademark at the time of the conclusion of the contract are topical.

According to the legal structure of the commercial concession agreement, established in Paragraph 1 of Art. 1027 of the Civil Code of the Russian Federation<sup>1</sup>, under an agreement, one party (right holder) provides the other party (user) the right to use a set of exclusive rights belonging to the right holder in the user's business activities, including the right to a trademark, service mark, as well as the rights to other objects of exclusive rights provided for by the agreement, in particular, to a commercial designation, a secret of production (know-how) for an agreed upon period of time in exchange for a fee.

From the concept of a commercial concession agreement, it follows that the list of objects, the right to use which can be granted under the



Sergey Zuykov

agreement, is open, and the parties independently determine its composition. However, an analysis of related norms and law enforcement practice shows that the discretion of the parties in this part is limited, in particular with regard to the means of individualization.

So, by virtue of a direct indication of the current law, it is impossible to grant the right to use a company name (Clause 2 of Article 1474 of the Civil Code of the Russian Federation) and a geographical indication (Clause 6 of Article 1519 of the Civil Code of the Russian Federation).

At the same time, the defects associated with granting the right to use a trademark entail the following risks and consequences:

- The fact that there is no right to a trademark in the composition of the set of exclusive rights transferred under an instrumentation agreement gives, in the event of a litigation, grounds for its re-qualification from a commercial concession agreement into a license agreement.<sup>2</sup> But, if the agreement contains information about the transfer of rights but it is impossible to identify the trademark itself (for example, by indication of registration data or other individualizing features), the contract will be recognized as not concluded due to inconsistency of the essential condition.<sup>3</sup>
- The absence of the right to a trademark as part of the instrumentation to be transferred under a commercial concession agreement entails the refusal of the authorized body to register the provision of the instrumentation, in connection with which the transfer of

rights under the agreement will not take place by virtue of Paragraph 2 of Art. 1028 of the Civil Code of the Russian Federation. Thus, according to the recommendations of Rospatent, under a commercial concession agreement the set of exclusive rights belonging to the right holder must include the right to a trademark without fail. At the same time, the procedure for checking the terms of the agreement for compliance with the terms of registration provides for checking information about registered trademarks (Clauses 3.4.1., 3.4.5 of the Recommendations on verification of agreements on the disposal of the exclusive right to the results of intellectual activity or means of individualization<sup>4</sup>).

In addition, granting the right to use a trademark as an appropriate means of individualizing goods (works, services) is one of the system-forming features of a commercial concession agreement, which is due, in particular, to its entrepreneurial nature. Therefore, unlike the consequences of the termination of the copyright holder's exclusive rights to other objects, the termination of the rights to a trademark is the basis for the termination of the commercial concession agreement as a whole if there is no replacement of the terminated right with a new similar right (Clause 3 of Article 1037 of the Civil Code of the Russian Federation). In this case, the agreement is also terminated in relation to other objects of exclusive rights without the possibility of automatic re-qualification of the commercial concession into license agreements.

It follows from the foregoing that granting the right to use a trademark is a basic (essential) condition of a commercial concession agreement, which must be taken into account when agreeing on its subject matter.

With regard to the consequences of the absence of the right holder of the rights to the trademark at the time of the conclusion of the contract, the practice is ambiguous.

It follows from the legal structure of a commercial concession agreement that it is not a real, but a consensual agreement, i.e., is considered concluded from the moment the parties reach an agreement on all its essential terms (Clause 1, Article 1027, Clause 1, Article 432 of the Civil Code of the Russian Federation).

At the same time, some courts<sup>5</sup> hold the position that it is impossible to conclude a commercial concession agreement in the absence of the right holder of the rights to the trademark. Proceed from the fact that by virtue of Paragraph 1 of Art. 1448 of the Civil Code of the Russian

## Résumé

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



**Questions remain regarding the legal regulation of the commercial concession agreement.**



Federation, the right to dispose of a trademark, including the right to grant third parties the right to use it, arises from the moment the copyright holder acquires the exclusive right to the trademark.

And the exclusive right to a trademark arises from the moment of state registration of a trademark and extends its effect also to the period from the moment of filing an application

<sup>4</sup> Recommendations on verification of agreements on the disposal of the exclusive right to the results of intellectual activity or means of individualization, approved. Order of Rospatent dated December 29, 2009, N 186 // SPS "ConsultantPlus".

<sup>5</sup> Resolution of the IP Court dated 06.02.2019 N C01-627 / 2016 in the case N A68-9982 / 2015 // SPS "ConsultantPlus".





to registration, according to which, as a rule, the priority of exclusive rights to this trademark is established (Paragraph 1 of Article 1232, Paragraph 1 Article 1484 and Paragraph 1 Article 1491 of the Civil Code of the Russian Federation).<sup>6</sup>

Thus, if at the conclusion of a commercial concession agreement, the right holder does not have the exclusive right to the trademark, the right holder does not have a real opportunity to fulfill the obligation under the contract to transfer the right to use as part of the set of exclusive rights, since before the registration of the trademark it is impossible to grant the right to use it.

Other courts,<sup>7</sup> on the contrary, believe that the law does not connect the moment of concluding a commercial concession agreement with the right holder having the whole complex of exclusive rights, including the right to a trademark. They are motivated by the fact that the commercial concession agreement is consensual, therefore, the presence or absence of the right holder of the right to a trademark at the time of the conclusion of the agreement does not affect the emergence of relevant obligations for the parties, since this relates to the scope of performance, and not to the time of conclusion of such an agreement.

In addition, the courts<sup>8</sup> note that when concluding a commercial concession agreement, users, acting with the degree of care and diligence required by the nature of the transaction, are not deprived of the opportunity to require the right holder to present documents of title to the trademark, as well as independently verify

information on the registration of the mark (filing an application) using the open registry of trademarks and service marks. On this basis, the courts reject arguments about the bad faith of right holders and misleading users when concluding a commercial concession agreement regarding the possibility of its execution.

It seems that this approach is quite consistent with the nature of the commercial concession agreement and the requirements for business entities when concluding it.

Thus, we believe that when concluding a commercial concession agreement, each of the parties must exercise care and discretion. In particular, pay attention to the presence in the contract of a condition on granting the right to use a trademark and its individualizing features as part of the set of exclusive rights, including information on registration or filing a corresponding application, and also check this information for compliance with the state register of trademarks.

<sup>6</sup> Resolution of the IP Court dated August 15, 2018 N C01-577 / 2018 in case N A71-16755 / 2017 // ConsultantPlus ATP.

<sup>7</sup> Decision of the Arbitration Court of the Krasnodar Territory dated 11/29/2021 in case N A32-32991/2021 // ATP "ConsultantPlus".

<sup>8</sup> Resolution of the IP Court dated 06/03/2022 N C01-703 / 2022 in case N A32-32991 / 2021. Decision of the Arbitration Court of the Udmurt Republic dated 02/09/2021 in case N A71-13539 / 2020 // ConsultantPlus ATP.

### Contact

**Zuykov and partners**  
Grokhol'sky lane, 28 Moscow, Russia, 129090  
**Tel:** +7 495 775 1637  
info@zuykov.com  
www.zuykov.com/en



## IP SERVICES IN RUSSIA, EURASIA, UAE AND CIS COUNTRIES

### IP LITIGATION



### PATENTS



### TRADEMARKS



### AGREEMENTS



### Russian Federation

Moscow, 129090, Grokhol'skiy per., d. 28, 2nd floor, Tel: + 7 (495) 775-16-37  
email: info@zuykov.com

### Belarus

Minsk, 220004, 23/1 Pobediteley Avenue  
Tel: +375 17 204-16-37  
email: bel@zuykov.com

### Kazakhstan

Almaty, 050042, 28/8 Ryskulbekov Str., Office 59  
Tel: +7 727 312 16 37  
email: kz@zuykov.com

### UAE

Dubai, Barsha Heights, Madison Residency, Office 611,  
Tel: +971-50-425-1637  
email: info@zuykov.ae



# Inspiring appreciation and respect for intellectual property

**Alyssa J. Devine, Founder of Purple Fox Legal, reminds us of the core values rooted in intellectual property and the importance of encouraging consumers to favor strong brands and protected assets.**

Intellectual property is the most valuable resource in the world.<sup>1</sup> Intangible assets comprise more than 90% of total assets on the balance sheets of S&P 500 companies.<sup>2</sup> But what does “intellectual property” mean and why should we inspire a greater appreciation for its worth and the protection it offers? This is the question intellectual property attorneys must answer for the courts, their clients, and society at large.

Intellectual property is all around us. Most people see, hear, and experience it both in the physical and digital worlds more times in a day than they realize. Intellectual property is important to both companies and individuals for three reasons: first, it enhances consumer protection; second, it incentivizes fair competition; third, it shapes culture and societal perceptions.

## 1. Protecting consumers

One of the functions trademarks serve is to ensure that unfair competition is minimized. Modern trademark law is based on a mixture of consumer protection and unfair competition principles. Trademarks are intended to serve as source indicators for a specific good or service. As much as they incite fair competitive practices, trademarks prevent consumers from being misled and decrease their search costs when contemplating purchases. To further these goals, the likelihood of confusion test came to fruition.<sup>3</sup> This test is the standard for trademark infringement and uses 13 factors to determine whether the

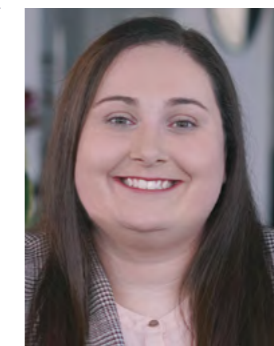
average consumer would be confused by two competing trademarks.

Trademark law also protects consumers through the principle of acquired distinctiveness. Word marks are measured using a scale of distinctiveness.<sup>4</sup> From weakest to strongest, the five categories of distinctiveness are generic, descriptive, suggestive, arbitrary, and fanciful. Generic marks cannot be protected at all due to the need to use words for their plain meaning. Descriptive word marks are ineligible for legal protection unless they acquire secondary meaning in the minds of consumers over time.<sup>5</sup> This means that the trademark needs to be used for several years before consumers can automatically recognize that trademark and distinguish it from other trademarks for similar goods and services.

Publicity rights are another type of intellectual property that protects consumers from being misled. The right of publicity is best defined as a state-based intellectual property doctrine that provides an individual's right to control the commercial use of any feature or indicia that “unequivocally identifies” them.<sup>6</sup> Publicity rights are often mistakenly associated exclusively with famous individuals because legal disputes involving this legal doctrine frequently involve celebrities, including those who are deceased.<sup>7</sup> However, this is not accurate as Meta, formerly known as Facebook, discovered in 2011.<sup>8</sup>

Facebook was created in 2004 and became one of the most popular user-generated content platforms.<sup>9</sup> Facebook CEO Mark Zuckerberg built the company by generating revenue through advertising to its users and argues that “[a] trusted referral is the Holy Grail of advertising.”<sup>10</sup> However, in 2011, Facebook’s “Sponsored Stories,” the Holy Grail of its advertising practices, went a step too far, resulting in a right of publicity class action lawsuit.

Facebook’s “Sponsored Stories” displayed a Facebook user’s “name, profile picture, and an assertion that the person ‘likes’ the advertiser, coupled with the advertiser’s logo” on another Facebook user’s page. Once a Facebook user “liked” a specific product or service, that action was shared with an average of 130 other Facebook users in the form of “Sponsored Stories,” which appeared alongside Facebook’s paid advertisements. This practice gave users the impression that their Facebook friends endorsed a product or service. Once this practice was discovered, a number of Facebook users filed suit alleging that Facebook unlawfully misappropriated their names, images, and likenesses in paid advertisements without obtaining their consent. The class action complaint demonstrated the plaintiffs’ tangible property interest in their publicity rights by citing Facebook COO Sheryl Sandberg who stated the value of a “Sponsored Story”



Alyssa J. Devine

## Résumé

**Alyssa J. Devine**, Founder and Managing Attorney of Purple Fox Legal, created a unique law firm brand as a reflection of her appreciation for entrepreneurship and passion for intellectual property. Uniquely positioned to assist her clients, Alyssa is not only a lawyer but has also earned an M.B.A. from Indiana University. Purple Fox Legal is based in Nashville, Tennessee, where Alyssa’s practice focuses on business, trademark, copyright, and right of publicity law.

advertisement was “at least twice and up to three times the value of a standard Facebook.com advertisement without a friend endorsement” and as well as data gathered by a well-respected marketing research firm. *Farley v. Facebook* is one of the first modern cases that acknowledges how technology enables third parties to unfairly profit from both famous and non-famous individuals’ publicity rights and shows why every individual should be cognizant of intellectual property rights.

<sup>1</sup> <https://ipo.org/wp-content/uploads/2013/04/ipmarketplace.pdf>.

<sup>2</sup> <https://anderson-review.ucla.edu/boom-of-intangible-assets-felt-across-industries-and-economy/>.

<sup>3</sup> *In re E.I. du Pont de Nemours & Co.*, 476 F.2d 1357 (C.C.P.A. 1973).

<sup>4</sup> *Abercrombie & Fitch Co. v. Hunting World, Inc.*, 537 F.2d 4 (2d Cir. 1976).

<sup>5</sup> Trademark Manual of Examining Procedure § 1216.06 (July 2022); J. Thomas McCarthy, 2 MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 15:1 (5th ed. 2021).

<sup>6</sup> Jonathan L. Faber & Wesley A. Zirkle, *Spreading its Wings and Coming of Age: With Indiana’s Law as a Model, the State-Based Right of Publicity is Ready to Move to the Federal Level*, 45 RES GESTAE 31, 38 n.42 (2001) (citing Ind. Code § 32-36-1-7 (2001) (defining “right of publicity” as the name, voice, signature, photograph, image, likeness, distinctive appearance, gestures, or mannerisms of an individual)); J. Thomas McCarthy & Roger E. Schechter, RIGHTS OF PUBLICITY AND PRIVACY § 2:3 (2d ed. 2020) (“[T]he right of publicity is not restricted to ‘celebrities.’”); J. Thomas McCarthy, MCCARTHY ON TRADEMARKS AND UNFAIR COMPETITION § 28:1 (5th ed. 2019) (“The right of publicity is the inherent right of every human being to control the commercial use of his or her identity”); *Farley v. Facebook, Inc.*, 830 F.Supp.2d 785 (N.D. Cal. 2011) (explaining how Facebook’s primary revenue streams from using unpaid Facebook members as unknowing spokespersons for various goods and services); *Motschenbacher v. R. J. Reynolds Tobacco Co.*, 498 F.2d 821, 825 n.11 (9th Cir. 1974) (stating “the appropriation of the identity of a relatively unknown person may result in economic injury or may itself create economic value in what was previously valueless.”); see also A Bill to Protect Ladies, H.R. 8151, 50th Cong. (1888) (introducing a federal bill “[t]o prohibit the use of likenesses, portraits, or representations of females for advertising purposes without consent in writing.”).

<sup>7</sup> J. Thomas McCarthy & Roger E. Schechter, RIGHTS OF PUBLICITY AND PRIVACY § 2:3 (2d ed. 2020) (“[T]he right of publicity is not restricted to ‘celebrities.’”); see generally Loren Cheri Shokes, *Life After Death: How to Protect Artists’ Post-Mortem Rights*, 9 HARV. J. SPORTS & ENT. L. 27 (2018).

<sup>8</sup> *Farley v. Facebook, Inc.*, 830 F.Supp.2d 785 (N.D. Cal. 2011) (explaining how Facebook’s primary revenue streams from using unpaid Facebook members as unknowing spokespersons for various goods and services).

<sup>9</sup> <https://www.usatoday.com/story/tech/2022/07/25/when-was-facebook-created/10040883002/>.

<sup>10</sup> *Farley v. Facebook, Inc.*, 830 F.Supp.2d 785, 799 (N.D. Cal. 2011).



## 2. Promoting fair competition

Trademark law also serves to minimize unfair competition without overburdening market entrants. For example, whether a website domain had acquired distinctiveness was recently reviewed by the US Supreme Court.<sup>11</sup> In this case, the US Patent and Trademark Office refused registration for "Booking.com" in relation to online travel reservation services and cited that generic trademarks were ineligible for federal trademark registration. However, disagreeing with the US Patent and Trademark Office's categorization of the domain name, the US Supreme Court found that the addition of ".com" to "Booking.com" positioned its classification on the distinctiveness spectrum to be descriptive, not generic. Additionally, evidence demonstrated that consumers easily distinguished "Booking.com" from other trademarks offering similar services. The US Supreme Court held that because "Booking.com" was descriptive and had acquired distinctiveness, the US Patent and Trademark Office should issue its registration. This case symbolizes the delicate balance between the purpose of trademark law and the rights of businesses and is a must-read for entrepreneurs.

Like trademarks, trade secrets incentivize fair business practices. Trade secrets are information that has quantifiable value due to not being known to competitors or the public and that is reasonably protected by the owner to maintain its secrecy. Misappropriating trade secrets may result in both civil and criminal liability.

The Coca-Cola formula is perhaps the most famous trade secret in the world, and this is for good reason. The Coca-Cola Company brand is worth over \$100 billion,<sup>12</sup> and the company makes significant investments to prevent infringement and misappropriation of its intellectual property. Unfortunately, Coca-Cola's confidential documents and unreleased products were stolen and almost sold to Pepsi for \$1.5 million by former Coca-Cola employees in 2006.<sup>13</sup> Once Pepsi executives received the offer, they promptly notified the FBI, which apprehended the former Coca-Cola employees. A district court judge sentenced former Coca-Cola employees to multiple years in prison and required them to pay \$40,000 restitution.

## 3. Shaping culture and society

People want more human interaction as technology evolves.<sup>14</sup> They want to purchase from brands that they connect with. They want experiences and stories.<sup>15</sup> This is why brands such as The Lumistella Company are incredibly popular.

The Founders of The Lumistella Company developed The Elf on the Shelf® to recreate their family tradition and childhood memories involving "a magical elf who visits families and

“  
Coca-Cola's confidential documents and unreleased products were stolen and almost sold to Pepsi for \$1.5 million by former Coca-Cola employees in 2006.”

shares their adventures with Santa each night.”<sup>17</sup> This desire transformed into a media franchise and became a Netflix animated series in 2020. While utilizing intellectual property to educate and connect with its target audience, The Elf on the Shelf® franchise speaks to the value of how storytelling and experiences shape our culture.

### Dispelling misconceptions

Despite its unquestionable importance, understanding intellectual property is often clouded by misconceptions that contribute to its underappreciation.

One such misconception is that if money is not generated by using others' intellectual property, then infringement cannot occur. This is patently false and has caused a plethora of problems for intellectual property owners seeking to enforce their rights.

Another common misconception is that intellectual property primarily benefits large corporations and excludes smaller players. This fallacy is perpetuated by large corporations' advanced understanding of and greater visibility in leveraging intellectual property, but individuals and small businesses can also benefit. The hurdle is in identifying the different types of intellectual property and prioritizing which ones to protect and utilize, given the finite resources of individuals and small businesses.

### Inspiring appreciation and respect

To foster a greater appreciation for intellectual property and demonstrate the consequences of failing to respect others' intellectual property, a multifaceted approach is necessary. Education, awareness, and ethics each play a crucial role in nurturing a culture that values and respects intellectual property.

Recognizing and celebrating innovators and creators with awards, grants, and public acknowledgments not only rewards those who contribute to society but also highlights the value of intellectual property. Encouraging individuals to consider the ethical implications of using or sharing copyrighted material without permission can help in fostering a culture of appreciation. Ethical behavior also extends to businesses by encouraging fair competition and protection of trade secrets.

As the most valuable resource in the world, intellectual property is instinctively intertwined with our professional and personal lives. Trademarks, trade secrets, publicity rights, and copyrights collectively symbolize the foundation of consumer protection, fair competition, and culture. These intangible assets protect the creations of the mind, incentivizing companies and individuals to invest in research, development, competition,

and creative endeavors. To ensure intellectual property's continued vitality, it is crucial for intellectual property attorneys to take the helm and begin a movement to inspire greater appreciation for the value of intellectual property.



“  
Education, awareness, and ethics each play a crucial role in nurturing a culture that values and respects intellectual property.”

- <sup>11</sup> *Patent and Trademark Office v. Booking.com B.V.*, 591 U.S. (June 30, 2020).
- <sup>12</sup> National Conference of Commissioners of Uniform State Laws, *Uniform Trade Secrets Act With 1985 Amendments* § 1(4) (1985), available at [https://higherlogicdownload.s3-external-1.amazonaws.com/UNIFORMLAWS/e58f19a0-6a5e-c90f-67c1-ac1f747ad47b\\_file.pdf?AWSAccessKeyId=AKIAVRDO71EREB57R7MT&Expires=1697654763&Signature=XU0rS1DIDtCxJLDAfLgOeooJWk4%3D](https://higherlogicdownload.s3-external-1.amazonaws.com/UNIFORMLAWS/e58f19a0-6a5e-c90f-67c1-ac1f747ad47b_file.pdf?AWSAccessKeyId=AKIAVRDO71EREB57R7MT&Expires=1697654763&Signature=XU0rS1DIDtCxJLDAfLgOeooJWk4%3D).
- <sup>13</sup> <https://www.marketingweek.com/coca-colarecovers-top-10-global-brand-status/>.
- <sup>14</sup> [https://www.theguardian.com/media/2006/jul/07/marketingandpr.drink?CMP=share\\_btn\\_link%27](https://www.theguardian.com/media/2006/jul/07/marketingandpr.drink?CMP=share_btn_link%27).
- <sup>15</sup> <https://www.mckinsey.com/capabilities/growth-marketing-and-sales/our-insights/the-great-consumer-shift-ten-charts-that-show-how-us-shopping-behavior-is-changing>.
- <sup>16</sup> <https://business.adobe.com/au/blog/perspectives/people-more-loyal-to-brands-that-care-about-them>.
- <sup>17</sup> <https://lumistella.com/about-us/>.

### Contact

**Purple Fox Legal**  
3820 Charlotte Ave, Suite 146-1  
Nashville, TN 37209  
[hello@purplefoxlegal.com](mailto:hello@purplefoxlegal.com)  
[www.purplefoxlegal.com](http://www.purplefoxlegal.com)

### Using Madrid Refusals to effectively expand your IP practice

Expand the reach of your practice beyond your home country by taking advantage of the global network of IP firms using Madrid.

Gain insight into Madrid refusals issued by your country's trademark office. Find out which representative firms have marks being refused. Discover the filers within your home country who have been refused abroad.

Be proactive and scout potential firms and clients from abroad, and prep for international meetings.

#### WEEKLY REPORTS MAY INCLUDE THE FOLLOWING:

- foreign refusals *into your home country*
- refusal from your home country *into other Madrid jurisdictions*
- which third-party marks have been cited (only certain jurisdictions)
- email address of foreign representatives
- WIPO record link

From the company that created the US-market 2(d) Citation Watch... now bringing you global data from foreign IP offices..

**towergateinformatics**

Powered by  
Trademarks  
**OnPoint®**

**Contact us:**  
[info@towergatesoftware.com](mailto:info@towergatesoftware.com) • Telephone: +1.866.523.8948





# Directory of Services

## ARGENTINA



### O'Conor & Power

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

**Address:** San Martín 663, 9th Floor, (C1004AAM) Buenos Aires, Argentina  
**Tel/Fax:** 005411 4311-2740  
005411 5368-7192/3

**Website:** [www.oconorpower.com.ar](http://www.oconorpower.com.ar)  
**E-mail:** [soc@oconorpower.com.ar](mailto:soc@oconorpower.com.ar)  
[ocp@oconorpower.com.ar](mailto:ocp@oconorpower.com.ar)  
[oconor@oconorpower.com.ar](mailto:oconor@oconorpower.com.ar)

## ARMENIA



### Vakhnina & Partners

The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers. Major areas of expertise of our patent team: Chemistry, Pharmaceuticals, Biotechnology, Biochemistry, Life Science etc.

We handle our clients' cases in Armenia, Russia, Kyrgyzstan, at Eurasian Patent Office, and cooperate with partners and associates in other Eurasian countries: Georgia, Belarus, Kazakhstan, Azerbaijan, Turkmenistan, Uzbekistan, Moldova, Tajikistan.

Our attorneys are members of INTA, FICPI, AIPPI, LESI, ECTA, PTMG.

**Address:** Yerevan, Republic of Armenia  
**Tel:** +374 91 066393  
**Email:** [Armenia@vakhnina.com](mailto:Armenia@vakhnina.com)  
**Website:** <http://about.vakhnina.com>  
**Contact:** Dr. Alexey Vakhnin, Partner

## BAHRAIN



### United Trademark & Patent Services

#### International Intellectual Property Attorneys

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

**Address:** United Trademark & Patent Services Office 21, Sabha Building No. 338 Road 1705, Block 317 Diplomatic Area, Manama, Bahrain

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [Bahrain@unitedtm.com](mailto:Bahrain@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Talal F.Khan & Mr Imad

## BANGLADESH



### Old Bailey Chambers

OLD BAILEY Chambers is a full-service intellectual property law firm in Bangladesh. OLD BAILEY also has expertise in technology, data protection and competition law practice.

The firm is widely acknowledged for its pioneering endeavours in the areas of intellectual property, technology, and competition law practice.

OLD BAILEY's international clientele includes number of Fortune 300 and 500 companies, and renowned brands. OLD BAILEY also represents number of local companies and brands that are market leaders in their respective fields, and number of net-worth individuals, socialites and several leading celebrities representing the local music, film and TV industries.

**Website:** <https://www.oldbaileybd.com/>  
**Email:** [mishbah@oldbaileybd.com](mailto:mishbah@oldbaileybd.com)  
**Tel:** +880172444888

## BOLIVIA



### Landivar & Landivar

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

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

## CARIBBEAN



### CARIBBEAN TRADEMARK SERVICES

Law Office of George C.J. Moore, P.A.

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

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

## COLOMBIA



### VERA ABOGADOS ASOCIADOS S.A.

VERA ABOGADOS was founded 50 years ago to attend to legal needs of the business sector in the area of IP. Today they provide their services to all fields of law. The law firm is a reference in the Andean community and they are part of international associations such as INTA, ASIPI, ABPI and ASPI.

They were ranked in 2022 by Leaders League as a highly recommended Colombian law firm and in addition, they are a member of PRAGMA, the International Network of Law Firms.

**Tel:** +57 60-1 3176650  
+57 60-1 3127928  
**Website:** [www.veraabogados.com](http://www.veraabogados.com)  
**Email:** [info@veraabogados.com](mailto:info@veraabogados.com)  
**Contact:** Carolina Vera Matiz, Natalia Vera Matiz

## CZECH REPUBLIC



### Cermak a spol.

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

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

## CZECH REPUBLIC



### Traplová Hakr Kubát Law and Patent Offices

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

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




# Directory of Services

**DJIBOUTI**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.  
**Address:** United Trademark & Patent Services  
 Djibouti Branch Djibouti,  
 Rue Pierre Pascal, Q. commercial Imm,  
 Ali Warki, Djibouti  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [Djibouti@unitedtm.com](mailto:Djibouti@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Imad & Faima Al Heyari

**DJIBOUTI**



**WDA International Law Firm**  
**Intellectual Property**  
 For over 25 years we have provided excellence in Intellectual Property protection to worldwide renowned companies including the most iconic pharmaceutical, beauty and clothing, beverages and motion pictures companies.  
 Our main practice is devoted to Intellectual Property which specializes in docketing maintenance of trademarks and patents and litigation attorneys of high profile IPR infringements, border protection and counterfeiting cases in Dominican Republic.  
**Tel:** 809-540-8001  
**Website:** [www.wdalaw.com](http://www.wdalaw.com)  
**Email:** [trademarks@wdalaw.com](mailto:trademarks@wdalaw.com)  
**Contacts:** LIC. Wendy Diaz  
 LIC. Frank Lazala  
**Whatsapp:** 829-743-8001

**DOMINICAN REPUBLIC**



**Guzmán Ariza, Attorneys at Law**  
 Guzman Ariza is the largest law and consulting firm in the Dominican Republic. Founded in 1927, we have extensive experience in protecting local and international clients' intellectual property rights, including trademarks, trade names, copyrights, and patents. We are your one-stop shop for all of your IP needs in the Dominican Republic.  
 Our services include: • Trademarks and trade names • Patents • Industrial design • Sanitary • Copyrights • IP management and IP audit • Litigation  
**Tel:** +1 809 255 0980  
**Fax:** +1 809 255 0940  
**Website:** [www.drlawyer.com](http://www.drlawyer.com)  
**Email:** [info@drlawyer.com](mailto:info@drlawyer.com)  
**Contact:** Fabio Guzmán Saladín, Partner  
[fabio@drlawyer.com](mailto:fabio@drlawyer.com)  
 Leandro Corral, Senior Counsel  
[lcorral@drlawyer.com](mailto:lcorral@drlawyer.com)

**KYRGYZSTAN**



**Vakhnina & Partners**  
 The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers.  
 We handle our clients' cases in Kyrgyzstan, Russia, Armenia, at Eurasian Patent Office, and cooperate with partners and associates in other Eurasian countries: Georgia, Belarus, Kazakhstan, Azerbaijan, Turkmenistan, Uzbekistan, Moldova, Tajikistan.  
 Our attorneys are members of INTA, FICPI, AIPPI, LESI, ECTA, PTMG.  
**Address:** Bishkek, Kyrgyz Republic  
**Tel:** +996-551-655-694  
**Email:** [ip@vakhnina.com](mailto:ip@vakhnina.com)  
**Website:** <https://www.vakhnina.com>  
**Contact:** Dr. Alexey VAKHNIN and Mr. Vlad PEROV

**LEBANON**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.  
**Address:** United Trademark & Patent Services  
 6th Floor, Burj Al Ghazal Building, Tabaris,  
 P. O. Box 11-7078, Beirut, Lebanon  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [lebanon@unitedtm.com](mailto:lebanon@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Hanadi

**LUXEMBOURG**



**Patent42**  
**Patents and Trademarks**  
 Patent 42 is a leading law firm offering a full range of services in the field of Intellectual Property rights. Our team of high-qualified patent and trademark attorneys are entitled to represent client's interests in Europe, Luxembourg, France and Belgium. Patent 42 provides concrete and careful solutions in the area of patents, trademarks and designs. We support clients in all stages of elaboration and implementation of an intellectual property strategy adapted to your needs at both national and international level.  
**Whatever your question is, we will find an answer for you.**  
**Address:** BP 297, L-4003 Esch-sur-Alzette, Luxembourg  
**Tel:** (+352) 28 79 33 36  
**Website:** [www.patent42.com](http://www.patent42.com)  
**Email:** [info@patent42.com](mailto:info@patent42.com)

**GUATEMALA**




**Ideas Trademarks Guatemala, S.A.**  
 Ideas is a firm specialized in the defense of intellectual property rights, offering advice on all kinds of issues related to them and in the management of portfolios of distinctive signs and patents, at competitive prices, in the Central American and Caribbean region. Ideas is focused on meeting the needs and solving the problems of its clients, setting clear expectations and obtaining creative solutions with minimal exposure and cost-effective. Proactivity has determined our constant growth and modernization, maintaining a high standard of quality and satisfaction in our professional services.  
**Tel:** +502 2460 3030  
**Website:** <https://www.ideasips.com/?lang=en>  
**Email:** [guatemala@ideasips.com](mailto:guatemala@ideasips.com)  
**Contact:** Gonzalo Menéndez, partner,  
[gmenendez@ideasips.com](mailto:gmenendez@ideasips.com)  
 Gustavo Noyola, partner,  
[noyola@ideasips.com](mailto:noyola@ideasips.com)

**GUATEMALA**




**Merida & Asociados**  
 The firm provides services throughout the range of different legal matters, specializing in the banking industry both nationally and internationally, business law, banking law, trademarks and patents, litigation, notary law, litigation and arbitration. We are a very well-known law firm for Intellectual Property in Guatemala. Our office serves clients from abroad, including clients from Europe and the United States, as well as Japan and other countries.  
**Address:** 20 calle 12-51 "A" zona 10,  
 Guatemala City, 01010, Guatemala  
 Armando Mérida, Section 019170,  
 P.O. Box 02-5339, Miami, Florida,  
 33102-5339, USA  
**Tel:** (502) 2366 7427  
**Website:** <http://www.meridayasociados.com.gt/en>  
**Email:** [corporativo@meridayasociados.com.gt](mailto:corporativo@meridayasociados.com.gt)  
**Contact:** Armando Merida

**INDIA**



**Chandrakant M Joshi**  
 Our law firm has been exclusively practicing Intellectual Property Rights matters since 1968. Today, Mr. Hiral Chandrakant Joshi heads the law firm as the senior most Attorney. It represents clientele spread over 35 countries. The law firm conducts search, undertakes registration, post-registration IP management strategies, IP valuation, infringement matters, domain name disputes and cyber law disputes of patents (including PCT applications), trademarks, industrial designs and copyrights.  
**Address:** Solitaire - II, 7th Floor, Link Road,  
 Malad (West), Mumbai - 400 064, India  
**Tel:** +91 22 28886856 / 57 / 58 / 64  
**Fax:** +91 22 28886859 / 65  
**Website:** [www.cmjoshi.com](http://www.cmjoshi.com)  
**Email:** [mail@cmjoshi.com](mailto:mail@cmjoshi.com) / [cmjoshi@cmjoshi.com](mailto:cmjoshi@cmjoshi.com) /  
[patents@cmjoshi.com](mailto:patents@cmjoshi.com) /  
[designs@cmjoshi.com](mailto:designs@cmjoshi.com) /  
[trademarks@cmjoshi.com](mailto:trademarks@cmjoshi.com)

**MACAU**



**IPSOL**  
 IPSOL is a key service line focused on the planning, registration and management of trademark, patent and other IP rights portfolios, offering solutions that enable to maximize the protection of your IP assets in Macau and worldwide.  
**Address:** Avenida da Praia Grande, 759,  
 5º andar, Macau  
**Tel:** (853) 2837 2623  
**Fax:** (853) 2837 2613  
**Website:** [www.ipsol.com.mo](http://www.ipsol.com.mo)  
**Email:** [ip@ipsol.com.mo](mailto:ip@ipsol.com.mo)  
**Contact:** Emalita Rocha

**MALAYSIA**



**Adastra IP**  
 Adastra IP is a full service IP firm with offices across the South East Asia, India and Australia with a full team of legal and technical specialists to handle drafting, responses and filings for Trademarks, Patents and Designs with emphasis on value and service for our clients. In addition, we have IP analytics and IP valuation capabilities aside from prosecution work to support our clients' IP needs.  
**Tel:** +60322842281  
**Website:** [www.adastraip.com](http://www.adastraip.com)  
**Email:** [info@adastraip.com](mailto:info@adastraip.com)  
**Contact:** Mohan K.  
 Managing Director

**MALAYSIA**



**MarQonsult IP**  
 MarQonsult® was established in February 2002 and is located in Petaling Jaya, nearby the MyIPO. MarQonsult® was founded by Clara C F Yip, who holds a double degree in law and economics from Auckland University, NZ. MarQonsult® is synonymous with effective delivery of services marked by its: quick response time; in-depth client counselling; affordability and adaptability; commercially viable IP strategies; result-oriented approach; and a high rate of success.  
**Tel:** +603 78820456  
**Fax:** +603 78820457  
**Website:** [www.marqonsult.com](http://www.marqonsult.com)  
**Email:** [clara@marqonsult.com](mailto:clara@marqonsult.com)  
**Contact:** Clara C F Yip (Ms)

To list your firm in this section, please email [katie@ctclegalmedia.com](mailto:katie@ctclegalmedia.com)

**INDIA**




**L.S. DAVAR & CO.**  
**PATENT AND TRADEMARK ATTORNEYS**  
 ESTD. 1932 NEW DELHI-KOLKATA-BENGALURU  
 COMMITTED TO PROTECTING INNOVATIONS  
 We are India's oldest Intellectual Property and Litigation Firm. Since 1932, we have been as a trusted IP partner of Global Large and Mid-size companies and foreign IP law firms. We have been widely acknowledged by Govt. of India. In the last 90 years, we have retained number one position in India in not only filing the Patents, Designs, Trademarks, Copyright, and Geographical Indications but also in getting the grants.  
**Tel:** 033- 2357 1015 / 1020  
**Fax:** 033 - 2357 1018  
**Website:** [www.lsdavar.com](http://www.lsdavar.com)  
**Email:** [mailinfo@lsdavar.in](mailto:mailinfo@lsdavar.in)  
**Contact:** Dr Joshita Davar Khemani  
 Mrs. Dahlia Chaudhuri


**JORDAN**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 United Trademark and Patent Services is a leading firm of lawyers and consultants specializing in Intellectual Property (IP) Rights and Issues. Our services include searching, filing, prosecution, registration, licensing, franchising, transfer of technology, arbitration, dispute resolution, enforcement & litigation, anti-counterfeiting, due diligence and counselling.  
**Address:** United Trademark & Patent Services  
 Suite 7, 2nd Floor, Chicago Building,  
 Al Abdali, P.O. Box 925852, Amman,  
 Jordan  
**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [jordan@unitedtm.com](mailto:jordan@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Mrs Fatima Al-Heyari

**MAURITIUS**



**Yusuf S Nazroo**  
 IP Agent/Consultant  
 Member of CITMA-INTA-APAA-AIPPI  
**Address:** 12 Frère Félix De Valois Street,  
 Port Louis, Mauritius  
**Tel:** +230 57 14 09 00  
**Fax:** +230 212 27 93  
**Website:** <http://yn-trademark.com>  
  
*Greetings from Mauritius the Rainbow Island*

**MOROCCO**



**Goodrich Riquelme Asociados**  
 Our staff of attorneys, engineers and computer specialists help adapt foreign patent specifications and claims to Mexican law, secure patent inventions and trademark registrations and maintain them by handling the necessary renewals. Our computer system, which is linked to the Mexican Patent and Trademark Department, permits us to provide our clients with a timely notice of their intellectual property matters. We also prepare and register license agreements.  
**Address:** Paseo de la Reforma 265, M2, Col. Y  
 Del. Cuauhtemoc, 06500 Mexico, D.F.  
**Tel:** (5255) 5533 0040  
**Fax:** (5255) 5207 3150  
**Website:** [www.goodrichriquelme.com](http://www.goodrichriquelme.com)  
**Email:** [mailcentral@goodrichriquelme.com](mailto:mailcentral@goodrichriquelme.com)  
**Contact:** Enrique Diaz  
**Email:** [ediaz@goodrichriquelme.com](mailto:ediaz@goodrichriquelme.com)

**MEXICO CITY**



**TOVAR & CRUZ IP-LAWYERS, S.C.**  
 We are a specialized legal firm providing intellectual property and business law services. Founded in 2009. The purpose is that our clients not only feel safe, besides satisfied since their business needs have been resolved, so, our professional success is also based on providing prompt response and high quality, personalized service. "Whatever you need in Mexico, we can legally find the most affordable way"  
**Tel:** 525528621761 & 525534516553  
**Website:** [www.tciplaw.mx](http://www.tciplaw.mx)  
**Email:** [ecruz@tciplaw.mx](mailto:ecruz@tciplaw.mx)  
[mtovar@tciplaw.mx](mailto:mtovar@tciplaw.mx)  
[contactus@tciplaw.mx](mailto:contactus@tciplaw.mx)  
**Contact:** Elsa Cruz, Martin Tovar



# Directory of Services

**MOROCCO**




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

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

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [morocco@unitedtm.com](mailto:morocco@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Yawar Irfan Khan

**OMAN**



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

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

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [oman@unitedtm.com](mailto:oman@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** S.Maqbool & T.F. Khan

**PAKISTAN**



**United Trademark & Patent Services**  
**International Intellectual Property Attorneys**  
 Specialising in Trademarks, Patents, Designs, Copyrights, Domain Name Registration, Litigation & Enforcement services.


**Address:** 85 The Mall Road, Lahore 54000, Pakistan

**Tel:** +92 42 36285588, +92 42 36285590, +92 42 36285581, +92 42 36285584

**Fax:** +92 42 36285585, +92 42 36285586, +92 42 36285587

**Website:** [www.utmps.com](http://www.utmps.com) & [www.unitedip.com](http://www.unitedip.com)  
**Email:** [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Yawar Irfan Khan, Hasan Irfan Khan

**SRI LANKA**



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

**Address:** No. 371, R A De Mel Mawatha, Colombo 3, Sri Lanka

**Tel:** 94 11-2336277  
**Website:** [www.juliusandcreasy.com](http://www.juliusandcreasy.com)  
**Email:** [anomi@juliusandcreasy.lk](mailto:anomi@juliusandcreasy.lk)  
**Contact:** Mrs Anomi Wanigasekera

**SRI LANKA**



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

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

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [srilanka@unitedtm.com](mailto:srilanka@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Krishni & M.F. Khan

**SWEDEN**



**fenixlegal**  
**INTERNATIONAL PATENT AND LAW FIRM**  
**Fenix Legal**  
 Fenix Legal, a cost-efficient, fast and professional Patent and Law firm, specialized in intellectual property in Europe, Sweden and Scandinavia. Our consultants are well known, experienced lawyers, European patent, trademark and design attorneys, business consultants, authorized mediators and branding experts. We offer all services in the IP field including trademarks, patents, designs, dispute resolution, mediation, copyright, domain names, IP Due Diligence and business agreements.

**Tel:** +46 8 463 50 16  
**Fax:** +46 8 463 10 10  
**Website:** [www.fenixlegal.eu](http://www.fenixlegal.eu)  
**Email:** [info@fenixlegal.eu](mailto:info@fenixlegal.eu)  
**Contacts:** Ms Maria Zamkova  
 Mr Petter Rindforth

**POLAND**



**LION & LION Kancelaria Patentowa Dariusz Mielcarski**  
 We offer:  
 - a full range of services related to patents, utility models, designs and trademarks in Poland as well as Community Designs and European Trademarks in the EU  
 - cooperation with patent agencies in all PCT countries  
 - preparation of patent applications from scratch for filing in the USA  
 - validations of EU patents in Poland,  
 - annuity payments

**Tel:** +48 663 802 804  
**Website:** [www.LIONandLION.eu](http://www.LIONandLION.eu)  
**Email:** [patent@lionandlion.eu](mailto:patent@lionandlion.eu)  
**Contact:** Dariusz Mielcarski,  
 Patent and Trademark Attorney


**POLAND**



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

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

**QATAR**



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

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

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [qatar@unitedtm.com](mailto:qatar@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Ahmed Tawfik & M.Y.I. Khan

**TAIWAN, ROC**



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

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

**TAIWAN, ROC**



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

**Tel:** +886-2-2517-5955  
**Fax:** +886-2-2517-8517  
**Website:** [www.lewisdavis.com.tw](http://www.lewisdavis.com.tw)  
**Email:** [wtoip@lewisdavis.com.tw](mailto:wtoip@lewisdavis.com.tw)  
[lewis@lewisdavis.com.tw](mailto:lewis@lewisdavis.com.tw)  
**Contact:** Lewis C. Y. HO  
 David M. C. HO

**TAIWAN**



**TOP TEAM INTERNATIONAL PATENT AND TRADEMARK OFFICE**  
 TOPTEAM's trademark practice supports all areas of brand protection for a trademark's full lifespan. We counsel clients on trademark selection, adoption and filing strategies - and the correct enforcement options - from the earliest stages. Our experience handling complex foreign and domestic trademark issues allows us to preemptively address potential risks and avoid unwanted problems during prosecution or post-registration proceedings.

**Tel:** +886.2.2655.1616  
**Fax:** +886.2.2655.2929  
**Website:** <https://www.top-team.com.tw>  
**Email:** [trademark@top-team.com.tw](mailto:trademark@top-team.com.tw)  
**Contact:** Lydia Wong, Principal Attorney at Law

**RUSSIA**



**Vakhnina and Partners**  
 The team at "Vakhnina & Partners" comprises of highly-qualified patent and trademark attorneys and lawyers. Major areas of expertise of our patent team: Chemistry, Pharmaceuticals, Biotechnology, Biochemistry, etc. We handle our clients' cases in Russia, Armenia, Kyrgyzstan, at Eurasian Patent Office, and cooperate with partners and associates in other Eurasian countries: Georgia, Belarus, Kazakhstan, Azerbaijan, Turkmenistan, Uzbekistan, Moldova, Tajikistan. Our attorneys are members of INTA, FICPI, AIPIPI, LESI, ECTA, PTMG.

**Address:** Moscow, Russia  
**Tel:** +7-495-946-7075  
**Website:** <https://www.vakhnina.com>  
**Email:** [ip@vakhnina.com](mailto:ip@vakhnina.com)  
**Contact:** Dr. Tatiana VAKHNINA  
 Dr. Alexey VAKHNIN

**SAUDI ARABIA**



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

**Address:** 30th Street, Olaya Opposite to Madarris Al Mustaqbil, P.O. Box 15185, Riyadh 11444, Kingdom of Saudi Arabia

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [saudia@unitedtm.com](mailto:saudia@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Dr.Hasan Al Mulla &  
 Justice R Farrukh Irfan Khan


**SLOVAKIA**



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

**Tel:** +421 915 976 275  
**Website:** [www.boldiz.com/en](http://www.boldiz.com/en)  
**Email:** [info@boldiz.com](mailto:info@boldiz.com)  
**Contact:** Dr. Ján Boldizsár


**TANZANIA**



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

**Website:** [www.bowmanslaw.com](http://www.bowmanslaw.com)  
**Email:** [francis.kamuzora@bowmanslaw.com](mailto:francis.kamuzora@bowmanslaw.com)  
**Contacts:** Francis Kamuzora  
 Audax Kameja

**TANZANIA**



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

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

**Website:** [www.utmps.com](http://www.utmps.com)  
**Email:** [tanzania@unitedtm.com](mailto:tanzania@unitedtm.com) &  
[unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
**Contact:** Mr Imad & Fatima Al Heyari

**TÜRKİYE**



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

**Address:** Spine Tower Saat Sokak No: 5 Kat:13  
 Maslak-Sarıyer / İstanbul - 34485  
 Türkiye

**Tel:** +90 212 329 00 00  
**Website:** [www.destekpatent.com](http://www.destekpatent.com)  
**Email:** [global@destekpatent.com](mailto:global@destekpatent.com)  
**Contact:** Simay Akbaş  
[simay.akbas@destekpatent.com](mailto:simay.akbas@destekpatent.com)

# Directory of Services

## UNITED ARAB EMIRATES



### Marks n Brands Intellectual Property

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

Tel: +971 56 936 7973  
Website: [www.marksnbrandsip.com](http://www.marksnbrandsip.com)  
Email: [info@marksnbrandsip.com](mailto:info@marksnbrandsip.com)  
Contact: Mahin Muhammed

## U.A.E.



### United Trademark & Patent Services International Intellectual Property Attorneys

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

Address: United Trademark & Patent Services Suite 401-402, Al Hawaii Tower, Sheikh Zayed Road, P.O. Box 72430, Dubai, United Arab Emirates  
Website: [www.utmps.com](http://www.utmps.com)  
Email: [uae@unitedtm.com](mailto:uae@unitedtm.com) & [unitedtrademark@unitedtm.com](mailto:unitedtrademark@unitedtm.com)  
Contact: M.F.I. Khan, SM. Ali & Maria Khan

## UKRAINE



### EIMar-IP Agency

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

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

## UKRAINE



### Pakharenko & Partners

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

Address: P.O.Box 78, 03150 Kyiv, Ukraine  
Visiting: Business Centre 'Olimpiysky', 72 Chervonoarmiyska Str., Kyiv 03150, Ukraine  
Tel: +380(44) 593 96 93  
Fax: +380(44) 451 40 48  
Website: [www.pakharenko.com](http://www.pakharenko.com)  
Email: [pakharenko@pakharenko.com.ua](mailto:pakharenko@pakharenko.com.ua)  
Contact: Antonina Pakharenko-Anderson  
Alexander Pakharenko

## VIETNAM



### ELITE LAW FIRM

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

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



## VIETNAM



### Pham & Associates

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

Tel: +84 24 3824 4852  
Fax: +84 24 3824 4853  
Website: [www.pham.com.vn](http://www.pham.com.vn)  
Email: [hanoi@pham.com.vn](mailto:hanoi@pham.com.vn)  
Contact: Pham Vu Khanh Toan, Managing Partner,  
General Director  
Tran Dung Tien, Senior IP Consultant

## VIETNAM



### Tri Viet & Associates

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

Tri Viet & Associates is a member of AIPPI, INTA, APAA, VBF, HBA, VIPA.  
Tel: +84-24-37913084  
Fax: +84-24-37913085  
Website: [www.trivietlaw.com.vn](http://www.trivietlaw.com.vn)  
Email: [info@trivietlaw.com.vn](mailto:info@trivietlaw.com.vn)  
Contact: Nguyen Duc Long (Mr.),  
Managing Partner,  
Reg. Patent & Trademark Attorney  
LinkedIn: <https://www.linkedin.com/in/longnguyen-tva>

## Subscribe now!

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

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

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

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



## World's Largest Association of IP Professionals

We offer exclusive benefits to our members around the world, including networking opportunities, Practice Guides and other resources, cutting-edge content, and professional development.

## Join us!

Become a member and benefit from our discount registration rate for our Annual Meeting and other events.



Learn more at [www.inta.org/joinus](http://www.inta.org/joinus)



IP ATTORNEYS  
SINCE 1932

**L. S. DAVAR & CO.**  
COMMITTED TO PROTECTING INNOVATIONS

## Our Legal Services:

Patents

Trademarks

Designs

Copyrights

Geographical Indications (GI)

Litigation & Dispute Resolution

Strategic IP Advisory

Media & Entertainment

Commercial Contracts

Corporate Transaction Advisory

Data Privacy & Security

Cyber Law & E-Security



*For more info.:*

E: [MAILINFO@LSDAVAR.IN](mailto:MAILINFO@LSDAVAR.IN)

T: +91 (0)33 2357 1010 | 1020

## OUR OFFICES:

NEW DELHI | KOLKATA | MUMBAI

BENGALURU | CHENNAI | HYDERABAD | GUWAHATI