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GLOBAL REACH, LOCAL KNOWLEDGE

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Lawyer

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2023 in review: *The Trademark Lawyer* Editorial Board provide jurisdictional overviews that will influence IP in 2024 and beyond



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THE TRADEMARK LAWYER

Annual 2024

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Editor's welcome



Welcome to *The Trademark Lawyer Annual 2024*. This year has seen many key developments that will affect IP practice moving forward. To reflect, our 2023 Editorial Board have provided jurisdiction-specific reviews with their take on events. With comments from Argentina, China, India, Italy, Jamaica, Poland, Switzerland, the UAE, the UK, and the US, these reviews provide an overview of some of the important factors that will influence IP in 2024 and beyond.

In addition, this issue includes a guest interview with Olivier Billard, Head of IP at Exotec, discussing the importance of a robust strategy for protecting and enforcing IP in tech start-ups.

**We wish
you a very
happy and
healthy
2024!**

This issue also features an introduction to the American IDEAS Act; provides a guide for foreign filers of trademarks in the US; provides an update on the changing landscape in Mexico; advice for navigating position marks in Brazil; a review of geographic indication in China; an assessment of relative grounds objection in Japan; and much more!

Our *Women in IP Leadership* segment features Wei Wei Jeang, Co-Founder of Fulton Jeang LLP, and Catherine Wiseman, Head of Trademarks at Barker Brettell, discussing challenges, achievements and ideas for continuing the empowerment of women in the industry.

Also find a special feature on prioritizing wellbeing in the IP profession – a vital subject that, in our opinion, requires much-needed attention.

Thank you to all our contributors and readers for another fantastic year, we wish you a very happy and healthy 2024!

Enjoy the issue.

Faye Waterford

Faye Waterford, Editor

Mission statement

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

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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.



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Catherine Hillaert-Prevost - Expert IP Strategist, Consultant & Advisor. Switzerland

Catherine has 35+ years' expertise leading IP strategies & portfolios in 160+ jurisdictions, and worked as French INPI Examiner, IP Counsel at law firms, Senior IP Counsel at major international companies Rhône-Poulenc, Rhodia, Nestlé, prior to being Global Head of IP & Anti-counterfeiting at Stoli Group for 12+ years. She now advises on IP protection, litigation, enforcement.



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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.



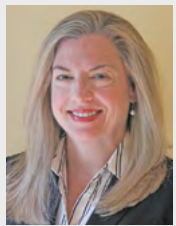
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Gang is a senior Chinese IP specialist and practitioner. He is good at solving difficult and complicated trademark litigation and non-litigation cases. Some of the influential cases he handled were widely reported on by media, and recent IP litigation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



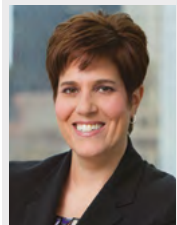
Shelley Jones – Lawyer and Registered Trademark Agent. Canada

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.



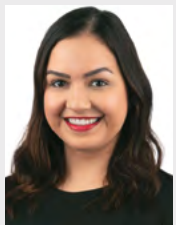
Stacey C. Kalamaras – Founder Trademarkabilities. US

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.



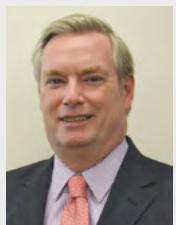
Chris Mitchell – Member, Dickinson Wright. US

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.



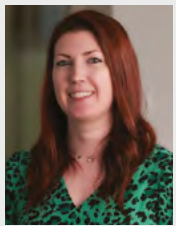
Peter Sloane - Partner & Co-Chair of the Trademark and Copyright Practice, Leason Ellis LLP. US

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.



2023 in Review

As we welcome a new year, we asked our Editorial Board to provide their take on 2023's key takeaways to inform of key developments that will influence IP practice in 2024 and beyond.

The following reviews include an overview of the confectionary cases heard before the Polish courts, a case analysis on shape marks in Switzerland, an introduction to the UKIPO's Tribunal Practice Notice 2/2023, highlights in US trademark law and practice, an explanation of how the approval of the Italian IP code will affect patents and trademarks, a reflection on CNIPA's revisions to trademark law in China, a summary of key developments and cases in India, a breakdown of the impact of the new Trade Marks (Amendment) Rules 2022 in Jamaica, the pressing requirement for Argentina to join the PCT, and a summary of the changes in UAE trademark law. Our Editorial Board members have delivered a summary of their take on 2023.

We would like to take this opportunity to thank our Editorial Board for their continued support and hard work throughout the year. Please visit page 6 to familiarize yourself with each member's profile.

If you would like to learn more about our Editorial Board or apply for 2025, please visit www.trademarklawyermagazine.com/editorial-board-applications/

A review from Argentina

Santiago O'Conor, O'Conor & Power

In the context of presidential elections and high inflation, intellectual and industrial property matters have kept on moving forward with substantial progress in different areas in 2023.

The trademark law amendments that took place between 2018 and 2019 in connection with the new opposition procedures, administrative nullity, and cancellation actions, as well as the implementation of the TMClass, began to effectively take place by Trademark Office decisions during the years 2022/23. The fast publication of trademark applications for opposition purposes from four-six months to 15 days is a great advance. However, TMO backlog delays still require improvement. Food warning labeling has also impacted companies and is a continuous topic. The urgent need for Argentina's accession to the PCT (Patent Cooperation Treaty) is a topic that is still being analyzed from an academic standpoint, and we trust that the new government that shall take over as of December 10, 2023, shall make all efforts for its approval so that our country joins the other Latin American countries which are already part of such an important innovation instrument. Last but not least, the impact of artificial intelligence, the metaverse, and blockchain has also been discussed at all levels, with Argentina being one of the leaders and players of hubs in this area in the region.



A review from China

Gang Hu, China Patent Agent H.K

The year 2023 is indeed an important and meaningful year for Chinese trademark practitioners.

In the field of trademark examination, CNIPA continued to take the lead in promoting a new round of consultation on the revision of China’s Trademark Law, and continued to refine and improve the existing guidelines for trademark examination and adjudication and published them to the public to enable applicants to have a clearer psychological expectation on the registration success rate of trademark applications. During the year, CNIPA carried out focused examination and notification of the guidelines to deal with trademark registration and hoarding in bad faith, especially for bad faith applications involving national interests, social public interests, and trademarks of hot spots of public concern, Internet buzzwords, and names of celebrities. One obvious consequence is that the trend of growth in trademark applications in China has been significantly curbed.

The most obvious substantive change has occurred in the judicial realm of trademarks, where we have seen a proliferation of high-dollar awards involving trademark infringement. Although the 2013 version of the Trademark Law introduced “punitive damages” and raised the statutory damages cap to RMB 5 million, judicial practice has been very conservative in terms of infringement damages. In 2023, we see that cases with awards of more than RMB 100 million are often reported, and the courts will also determine punitive damages of one-five times the amount of the infringement according to the degree of the infringer’s subjective fault, the severity of the infringement, and other factors. We believe that the following two reasons are behind this big change: first, the trademark right holder, under the guidance and support of litigation lawyers, is able to present strong arguments and evidence to prove the loss of the right holder, the infringer’s unlawful gain or the license fee. Secondly, the court pays more attention to the application of the documentary evidence filing order and the evidence obstruction system, and when the infringer has evidence obstruction or is negligent in the litigation, the court is more willing to synthesize the evidence of the whole case to determine the reasonable amount of compensation.

In 2023, China’s trademark examination and trademark judicial practice declared the market value orientation of the strictest protection of intellectual property rights.

A review from India

Misum Hossain, Lincoln Legal Chambers

2023 has been a fascinating year for trademarks in India. At INTA 2023, the Controller General of Patents, Designs & Trademarks underlined the continuing evolution of India’s IP landscape with emphasis on emergent technologies like blockchain, AI, metaverse, quantum computing, and biotechnology. A crucial part of nurturing IP growth is to maintain a stronghold in the protection of rights. Notable progress was made with the establishment of dedicated IP Benches in High Courts including Delhi and Madras. The High Courts of Calcutta and Gujarat also previously notified specific nomenclature for IP disputes. These special divisions are vital for speedier reliefs as the Intellectual Property Appellate Board had been abolished in 2021.

With regard to case laws, 2023 has seen some key developments.

The Delhi High Court, while examining Google’s AdWords, held that Google could not seek shelter with the intermediary “safe harbor” plea when trademarks were being used as keywords in its Ads program.

A crucial order was passed by the High Court at Calcutta in a matter involving trademark use in product review videos made on social media. The Court granted relief to leading FMCG company Dabur against a YouTuber who had uploaded a disparaging video. Going ahead, Courts will encounter cases where they will need to distinguish between genuine reviews and infringing content.

Famed “Slumdog Millionaire” actor Anil Kapoor sought protection from Delhi High Court for his personality – his name, photographs, manner of speaking, and gestures. The Court granted an *ex parte*, omnibus injunction restraining entities from using the actor’s name, likeness, AI-generated images, and GIFs for any commercial purpose. With alarming techs like deepfake, many more celebrities are likely to seek the refuge of law to protect personality rights.

2023 also witnessed global brands approaching Indian Courts to protect IP rights. French brand Louis Vuitton was awarded costs against an entity for selling counterfeit products. Casio won a design infringement case. Luxury brand Hermes received an important decision where the Court not only passed a favorable order but also recognized its “H” mark as a well-known trademark.

India has recently passed the Digital Personal Data Protection Act 2023 which signals its serious intent to protect privacy rights. India is investing heavily in its IP landscape by fostering growth, ensuring speedy reliefs, and creating a robust ecosystem for all forms of IP.

A review from Italy

Francesco Bonini, Studio Bonini

On 24 July 2023, the Italian Parliament approved amendments to the Italian IP Code.

Patents

A relevant change relates to inventions that are implemented and patented by universities and research centres. These institutions will have full ownership of patents; the professors or researchers who develop the invention at issue shall have the right to be mentioned as inventors. The inventors shall notify the possibility of patenting an invention to the institution that, in turn, shall file the patent within six months or notify the inventor that it has no interest in it. In lack of filing or interest, the inventor is allowed to file the patent in their name.

Another notable change affects the relationship between an Italian patent and the European Patent, which is extended on its basis. Once they are both granted, the Italian patent can still be valid and be kept in force.

Indeed, coexistence between national and European granted patents related to the same invention is now allowed.

Notably, the Italian patent does not drop, irrespective of the EP being invalidated or lapsed. This new provision brings a significant change: patent litigators, when enforcing, attacking, or defending a patent, should consider different strategies, when dealing with the Italian patent or the EP, and should act before the UPC or before an Italian IP court or both.

Trademarks

Interesting changes also affect trademarks, adding GI as an absolute ground for refusal and not just a ground for opposition.

The trademark opposition procedure, moreover, now provides for a suspension if a limitation request is filed within two months of the opposition notice. This provision would encourage a possible agreement between the parties at an early stage of the proceedings without a decision. Other provisions affect the recently introduced trademark cancellation: subdivision of cancellation notices is now prohibited.

If the applicant is aware of more than one ground (absolute or relative one) for cancellation, they shall claim all of them in one act. They shall not divide the action into separate notices.

More interestingly, the e-payment option has been enhanced: filing fees for patents, trademarks, designs, and records can now be made fully using the e-payment public platform.

A review from Jamaica

Rachael Lodge Corrie, Foga Daley

On September 30, 2023, the Trade Marks (Amendment) Rules, 2022, came into effect, bringing with it some sweeping changes to the Jamaican trademark landscape. The Rules provide procedural support for many of the changes introduced by the Trade Marks (Amendment) Act 2021, some of which are highlighted below:

- Implementation of the Madrid Protocol;
- Consequential Fee increases;
- Introduction of expedited examination and processing services;
- New filing requirements for non-traditional trademarks;
- Authorization of Agent (TM3) requirements.

Whereas previously Jamaican counsel could sign the Form on behalf of the Applicant, the IP Office now requires a scanned copy of the Form TM3, signed by either the Applicant or a legal representative duly authorized to sign.

An important consideration when filing in Jamaica is that the country has always been outspoken on the need to protect country names and preserve traditional knowledge and traditional cultural expressions. Whereas the Trade Marks Act has always included provisions for the protection of Jamaican national emblems, the 2021 amendment, expanded the scope of protection. Any Applicant that files a mark that makes reference to or suggests an affiliation with Jamaica, or any other country, in addition to a disclaimer requirement, may be required to provide a statement to the Registrar that the goods or services for which the trademark is applied for originate from said country.

Likewise, whereas previously, JIPO issued a practice direction on traditional knowledge and traditional cultural expressions, this has now been enshrined in law as an absolute ground of refusal. Section 11(4)(f)(iii) states that “A sign shall not be registered as a trademark if it is of such a nature as to misrepresent, or misappropriate, the traditional knowledge or traditional cultural expressions of indigenous or local communities”.

Notwithstanding these changes to the law, Jamaica still remains a top choice for stealth filings. Policy makers understand the importance of this strategy, and for this reason, applications filed through the national route will not be publicly accessible until formal publication, therefore, Applicants can continue to rely on Jamaica as a key jurisdiction as part of their global branding strategies.



A review from Poland

Beata Wojtkowska,
Kulikowska & Kulikowski

Several confectionery industry trademark cases were brought to the administrative courts in 2023 with significant findings.

The wordmark dispute over BISCOTTA between Unilever N.V. from the Netherlands and Aldi Einkauf GmbH&Co. oHG from Germany (II GSK 426/20) regarding the perception of foreign language marks by Polish consumers saw The Supreme Administrative Court (SAC) share the view of the Patent Office of the Republic of Poland (PPO), later accepted by the District Administrative Court (DAC), that there is a significant similarity between the disputed BISCOTTA trademark and the opposed BISCOTTO trademark, which, given the similarity of the goods, created a risk of confusion among the public. The fact that the term “Biscotti” means Italian cookies does not mean that it has been incorporated into the Polish language.


Another case concerned the invalidation of the word and figurative trademark MICHALKI, used to designate popular chocolate and nut candies (II GSK 654/20). The SAC confirmed the trademark had been applied for in bad faith because the owner knew that “MICHALKI” candies were manufactured using the same technology and recipe as other companies. Thus, the sign, without the additional element indicating origin, had no distinctive character and could only hold the association with the type of candies. The attempt to protect this mark was made to monopolize and prevent other confectioners from offering candies under the name “Michałki”.

The District Administrative Court in Warsaw dealt with a complaint against the decision of the PPO dismissing the motion for invalidation of the word and figurative mark LUXURY cream FUDGE Made in Poland, intended to designate sweets, including popular milk candies with the generic name ‘krówka’ - literally ‘little cow’ (VI SA/Wa 8298/22). The applicant claimed copyright over the packaging of the candy and an alleged application in bad faith. Neither PPO nor the DAC shared this assessment. The disputed trademark was not similar to the packaging submitted by the applicant with the unrealistic cow image. There was also no certainty that the owner was aware of the applicant’s earlier marks and the lack of similarity did not justify the allegation of a bad faith application. The cow image was found to be non-distinctive, and it was emphasized that it cannot be monopolized. The ruling is not yet final.

Karolina Szafarowicz co-authored this article.

A review from Switzerland

Catherine Hillaert-Prevost,
Expert IP Consultant & Advisor

The Federal Administrative Court (TAF), Court II, B-3904/2021, rendered a judgment on August 29, 2023, involving *Tetra Laval Holdings & Finance SA v. the Swiss Federal Institute of Intellectual Property (IPI)* concerning the 3D trademark No. 65026/2014 (Tetra-Pak). Tetra Laval sought to register this plain packaging shape as a 3D trademark in Switzerland back in December 2014, under class 16, covering products like paper, cardboard, and related materials used for liquid food and beverage containers and packaging. The trademark features a parallelepiped shape with characteristics, including trimmed edges, flat surfaces, and a cap, though it doesn’t claim specific colors. The products targeted in this registration are primarily aimed at industry professionals rather than end consumers.

After extensive examination proceedings, the IPI rejected the trademark in June 2021. The reasons included the *lack of distinctiveness and originality*. Further, the trademark didn’t gain recognition in the market or *qualify for “imposed mark”* protection under the Swiss Trademark Act. An appeal was filed by Tetra with the TAF in September 2021, focusing on the packaging’s distinctive nature *per se*, its widespread use since 2001, and evidence, on top of its recognition, by industry experts, and claiming a violation of the principle of equal treatment, and good faith.

The TAF concluded that *the shape does not significantly deviate from common packaging for liquid products, particularly those of a parallelepiped shape*. The features of the packaging are considered variations rather than distinct characteristics. The TAF also highlighted that the protection of a trademark should apply to a specific shape, not a broad concept of Tetra-Pak folded cardboard containers holding liquids. The TAF upheld the IPI’s decision.

As for the claim of a violation of the principle of equal treatment, the TAF found that Tetra’s previous Swiss trademark registration No. P-541405 was not relevant to the current dispute. Tetra’s appeal was rejected, and they were required to cover the costs of the procedure. The decision was open to appeal to the Federal Supreme Court through a civil law appeal within 30 days of notification.

A review from the UAE

Yasir Masood, Rouse

The UAE has seen several changes in law and practice.

Trademark renewals without power of attorney (PoA)
In a welcome step, the UAE Trade Mark Office (TMO) made a significant change in its trademark (TM) renewal process: it no longer requires a power of attorney (PoA) for renewals. The previous practice mandated a PoA, legalized by the UAE’s consulate in the trademark owner’s home country, which then had to be super legalized by the UAE Ministry of Foreign Affairs.

This new practice brings several benefits for TM owners:

1. Cost and administration: save time and money associated with a super legalized PoA.
2. Facilitating timely renewals: By removing the legalization procedures, TM owners can meet renewal deadlines without worrying about significant delays.
3. Simplified agent change: The previous process to change a local agent has been streamlined, no longer requiring the issuance of a new super legalized PoA.
4. Enhanced fairness for foreign TM owners: Local TM owners had an advantage as they could file renewals without a local agent or with just a notarized PoA. This change promotes fair competition.
5. Harmonized procedures: The new procedure aligns the UAE with major economies like the EU and the US.

It is hoped that the PoA requirement will eventually be removed for other procedures such as TM filings as well.

Clearing the recordal/amendment backlog
Another positive development is that the TMO is proactively accelerating the clearing of the backlog regarding applications for post-registration changes and amendments. This includes any changes in ownership, licenses, TM, and specification amendments as well as voluntary cancellations of marks. Already, the TMO has contacted all local agents to follow up on the status of their pending applications from before 2020.

International Trademark Association (INTA) Annual Meeting Dubai 2026
INTA’s announcement that its annual meeting in 2026 will take place in Dubai has generated excitement among the local IP community. It will be the first time that the event will be held in the Middle East, recognizing the progress made by the UAE and broader region in the field of IP, particularly the protection of trademarks.

Brand owners can be encouraged and optimistic about the protection of their rights in the UAE.

A review from the UK

Charlotte Wilding, Keltie LLP

On 25 January 2023, the UK IPO published “Tribunal Practice Notice 2/2023: Effective service in proceedings against trademarks and registered designs without a valid UK address for service”, which confirmed a change in practice regarding the service of documents in *inter partes* trademark invalidation, revocation, rectification, and opposition proceedings, and registered design invalidation proceedings. In particular, to those that do not hold a valid UK address for service (“UK AFS”).

Previously, the UK IPO would deliver notification of a contested right to non-UK addresses and this was sufficient to set the two month notice period for filing a defense. If a defense was not filed, the contested right was typically deemed abandoned.

Following the Appointed Person’s decision in *Tradeix Ltd v. New Holland Ventures Pty Ltd* (BL O/681/22), this practice was discontinued with immediate effect. This is because the UK IPO does not have power to serve outside of the UK. A number of cases were suspended following this case, whilst awaiting the UK IPO’s Tribunal Practice Notice. These have now become live again.

The UK IPO will now seek to obtain a UK AFS before any formal serving of documents. The rights holder is asked to confirm its intention to defend the proceedings and provide a valid UK AFS within one month from the date of the communication. If a response is not received, this may result in the contested right being deemed abandoned. If a response is received, and a valid AFS provided, the formal serving of documents will take place and the two-month defense period triggered.

Given that from 1 January 2024, all contentious proceedings relating to UK comparable rights that were created automatically when the UK left the EU will be required to have a valid UK AFS (at present, historical matters are not), it is vital that any UK trademark or design now has a valid UK AFS to ensure that rights are not inadvertently lost.



A review from the US

Stacey Kalamaras, Trademarkabilities

On October 18, 2023, nearly two years after the Trademark Trial and Appeal Board ruled in *Chutter*ⁱ that reckless disregard satisfied the requisite intent for fraud at the USPTO in trademark matters, the Court of Appeals for the Federal Circuit (CAFC) in a split decisionⁱⁱ reversed the TTAB, declining to reach a decision on fraud and remanding the case to the USPTO, holding that a Section 15 Declaration of Incontestability cannot be the subject of a cancellation proceeding because incontestability does not maintain a registration as required by statute.

The TTAB granted the Petition to Cancel in September 2021 on grounds of fraud, holding that Great Concepts acted with reckless disregard as to the truth of the statements in the declaration. In sending the case back to the TTAB, the court did not reach any conclusion with respect to whether Great Concepts and its attorney committed fraud; however, the court held that it was not proper for the USPTO to cancel Great Concepts’ registration, because the majority contends that the USPTO does not have the authority to cancel a registration for fraud in connection with seeking incontestability status. The court maintains that statutory construction (as supported by Bose) only gives the USPTO power to cancel registration for fraud in connection with procuring a trademark registration or maintaining or renewing a registration. It is the majority’s opinion that filing a Section 15 incontestability declaration is not necessary to maintain a registration, even if it is filed as a combined Section 8 and 15 declaration of continued use.

In Judge Reyna’s dissenting opinion, he would have affirmed the TTAB’s finding of fraud.

It should be noted, this decision is a narrow holding applying only to incontestability declarations. Trademark owners and counsel are reminded to review and sign all US trademark applications and declarations carefully as they are all signed under penalty of perjury. Any misstatements can have a significant impact on registrations, including cancellation or sanctions.

ⁱ *Chutter, Inc. v. Great Concepts, LLC*, 2021 USPQ2d 1001 (TTAB 2021); <https://ttabvue.uspto.gov/ttabvue/v?pno=91223018&pty=OPP&eno=61>

ⁱⁱ *Great Concepts, LLC v. Chutter, Inc.*, 2023 USPQ2d XXXX (Fed. Cir. 2023); <https://cafc.uscourts.gov/10-18-2023-22-1212-great-concepts-llc-v-chutter-inc-opinion-22-1212-opinion-10-18-2>

A review from the US

Peter Sloane, Leason Ellis

It’s 2023 and there are still many unresolved issues in US trademark law. Years can go by without the US Supreme Court weighing in on trademark law, so it was surprising to see the Court decide two cases in just the first half of the year.

In the first case, *Jack Daniel’s Properties, Inc. v. VIP Products LLC*, 599 US 140 (June 8, 2023), the seller of a dog toy brought an action seeking a declaratory judgment that its “Bad Spaniels Silly Squeaker” did not infringe or dilute whisky manufacturer’s “Jack Daniel’s” trademark. In deciding the case, the Ninth Circuit Court of Appeals had applied the so-called Rogers test, which requires dismissal of an infringement claim at the outset unless the complainant can show either (1) that the challenged use of a mark “has no artistic relevance to the underlying work” or (2) that it “explicitly misleads as to the source or the content of the work.” In vacating the judgment, the Supreme Court held that when an alleged infringer uses a trademark as a designation of source for the infringer’s own goods, as VIP had done, the Rogers test does not apply.

In the second case, *Abitron Austria GmbH v. Hetronic International, Inc.*, 600 US 412 (June 29, 2023), Hetronic, a US manufacturer of radio remote controls for construction equipment, brought an action for trademark infringement against foreign parties including Abitron. At trial, a jury awarded Hetronic approximately \$96 million in damages related to Abitron’s global use of Hetronic’s marks. The Tenth Circuit Court of Appeals affirmed the award and concluded that the US Trademark Act extended to all of Abitron’s foreign infringing conduct. The Supreme Court vacated the decision and held that the Trademark Act is not extraterritorial in nature, and that use of a mark in US commerce provides the dividing line between the Act’s permissible domestic application and impermissible foreign application.

When viewed together, the two cases show that US trademark law is still unsettled at times. Although this presents challenges for US practitioners seeking to provide clear advice to clients, it also makes the practice fresh and ever-interesting.

A review from the US

Chris Mitchell, Dickinson Wright

2023 has seen many interesting developments in trademark law and practice in the United States. Too many, indeed, to catalog in the short space permitted by this brief article. But here are some highlights:

On the practical side, the United States Patent and Trademark Office instituted the new three-month deadline for responding to office actions. Gone are the six-month reply deadlines. Now, applicants must either reply within three-months from the date of the office action or, by that same deadline, request a three-month extension and pay the applicable (and presently very modest) \$125 extension fee.

As to notable cases, 2023 saw the US Supreme Court issue decisions on the parody defense (*Jack Daniel’s Properties, Inc. v. VIP Products, LLC*, 599 US 140 (2023)) and the extraterritorial reach of the US federal trademark law, the Lanham Act (*Abitron Austria GmbH v. Hetronic International, Inc.*, 600 US 412 (2023)).

The decision in *Jack Daniel’s Properties, Inc.* sharply limited the availability of the parody defense, whereby an accused infringer could assert that their conduct is protected speech under the First Amendment of the US Constitution. Reversing the lower court’s decision, the Supreme Court held that while a claim of parody may be relevant to the trademark infringement analysis (e.g., does the parody make consumer confusion unlikely?), parody that serves a source-identifying function (i.e., acts as a trademark) neither mandates a threshold First Amendment inquiry nor automatically escapes claims of trademark dilution on the grounds of being “non-commercial use of a mark.”

While *Jack Daniel’s Properties, Inc.* concerned an admittedly niche area of trademark disputes, the decision in *Abitron Austria GmbH* had far more sweeping implications; namely, the extraterritorial reach of the Lanham Act. Hetronic prevailed at trial in securing a worldwide injunction against Abitron, as well as nearly \$90 million in damages from infringing sales outside of the US. That result was upheld on appeal. The Supreme Court, however, held that the Lanham Act does not apply to purely extraterritorial conduct; only domestic infringements are subject to claims. The announcement that the Supreme Court was hearing this case elicited more comment than the decision itself, since the court chose not to upset the generally understood principles of territoriality in trademark law (both in the US and around the world). That is just as well.





The American IDEA Act and the growing threat of IP theft

Angela Kalsi of Greensfelder introduces the American IP Defense and Enforcement Advancement Act which promises to protect US businesses against international IP theft

This past year has seen important developments concerning the issue of international intellectual property (IP) theft, and a promising new piece of legislation aims to support US companies – and particularly small businesses – from the harms that arise from IP misuse.

A growing problem

The Commission on the Theft of American Intellectual Property, an independent and bipartisan initiative that examines the scale, scope, and consequences of IP theft, estimated that IP misuse costs the US economy between \$225 and \$600 billion every year.¹ This has a



Angela Kalsi

significant impact on all Americans because IP-intensive industries are estimated to support more than 45 million US jobs.²

In spite of this, many businesses that are starting out do not consider protecting their intellectual property as one of their first priorities. Even those businesses that register their IP domestically often fail to consider protecting their IP internationally. However, a lack of IP protection can cause major problems for small businesses, and when confronted with IP theft – especially when it occurs overseas – many small businesses can feel hopeless at the seemingly insurmountable task of stopping the misuse.

A possible solution

The summer offered hope for these businesses in the form of a proposed piece of legislation, the American IP Defense and Enforcement Advancement Act, or the “American IDEA Act,” which promises to protect US businesses against international IP theft³. Introduced by Senators Tammy Baldwin (D-WI) and John Cornyn (R-TX) on July 27, 2023, the bill proposes to improve IP enforcement by strengthening existing laws, directing studies on how to best safeguard American IP, and funding legal aid programs to assist small businesses in protecting their IP.

One key element of the Act is a directive to target IP theft occurring in certain high-priority countries. Specifically, the Office of the Intellectual Property Coordinator (IPEC), a government position that coordinates federal efforts against counterfeiting and IP infringement, would be required to develop strategies for combatting IP theft in priority Watch List Countries. Watch List Countries are designated every year by the US Trade Representative (USTR) and identify the US trading

partners who present the most significant concerns as to insufficient IP protection and enforcement. The priority countries identified in the 2023 report were Argentina, Chile, China, India, Indonesia, Russia, and Venezuela.⁴

The USTR report notes that in many of the Watch List Countries, progress is being made at the governmental level, but widespread piracy and counterfeiting nevertheless persist due to inadequate IP enforcement and ineffective border control. It also includes countries in which IP misuse is state-sanctioned, which presents a different set of challenges. For instance, the report notes that in the last year, Russia has targeted IP rights belonging to companies from “unfriendly” countries whose governments have taken actions to hold Russia accountable for its invasion of Ukraine. This includes a decree that frees Russian entities from paying compensation for the use of inventions, utility models, and industrial designs belonging to rights holders coming from unfriendly nations, and another that restricts the ability of foreign rights holders to collect license payments for most types of IP⁵.

In addition to directing IPEC to focus on IP theft in Watch List Countries, the American IDEA Act would authorize two new Government Accountability Office (GAO) studies. The first would assess how the US can better protect the IP of American manufacturers in priority Watch List Countries. The second would study whether the US can use diplomatic channels to improve IP protection in Watch List Countries and better recover financial losses suffered by US businesses resulting from a denial of adequate IP protection.

However, US small businesses do not have to wait for IPEC’s strategic plan or for the results of the GAO studies to proactively combat IP theft in Watch List Countries. Companies can register their IP internationally, and not just in the countries where they operate, but in defensive locations as well. Businesses can also mitigate the reputational harm caused by counterfeit goods by recording their marks with US Customs and Border Control and other international customs agencies to stop the movement of counterfeit goods. Often,

¹ https://www.nbr.org/wp-content/uploads/pdfs/publications/IP_Commission_Report_Update.pdf

² https://www.nbr.org/wp-content/uploads/pdfs/publications/ip_commission_2021_recommendations_mar2021.pdf

³ <https://www.congress.gov/118/bills/s2566/BILLS-118s2566is.htm>

⁴ <https://ustr.gov/sites/default/files/2023-04/2023%20Special%20301%20Report.pdf>

⁵ *Id.*



“
The priority countries identified in the 2023 report were Argentina, Chile, China, India, Indonesia, Russia, and Venezuela.”

investigators can identify common shipping routes for counterfeit products, and businesses can use this intel to strategically register their marks and record them in countries where counterfeits can be intercepted early.

How to start

For US small businesses wondering where to start and how to learn about the basics of IP protection, the American IDEA Act would create a grant program specifically to fund legal aid programs to assist small businesses in protecting their IP. The grant would fund the development and delivery of training programs and materials for small businesses relating to the protection and enforcement of IP rights. It would also make funds available to any American Bar Association (ABA)-accredited law school, state bar association, or legal services organization that provides low-cost legal advice on the protection and enforcement of IP rights to small businesses that have an estimated annual revenue of not more than \$150,000.

Of course, US small businesses do not need to wait for these new legal aid programs to seek assistance in protecting their IP. Many law schools, legal aid programs, and other non-profit groups already

offer assistance to small businesses needing IP help. Additionally, the United States Patent and Trademark Office offers a wide array of resources and videos to educate users on the basics of patent, trademark, and copyright protection, as well as the enforcement of IP rights internationally⁶.

Don't snooze on your rights

While the American IDEA Act promises to take important steps to protect US small businesses from foreign IP theft, it is currently still under review by the Committee on the Judiciary. It will take time for the bill to make its way through Congress, and even if the bill passes, it will be more time before small businesses see the effects of its directives. In the meantime, it is important for all US companies – and in particular small businesses – to take steps today to be proactive about protecting their IP.

This is especially true following this summer's Supreme Court decision in *Abitron Austria GmbH et al. v. Hetronic International Inc.*⁷ In that case, the justices held that the provisions prohibiting trademark infringement under the Lanham Act

do not apply outside the US. The decision, written by Justice Alito, held that the provisions extend only to claims where the infringing use in commerce is domestic. The decision underscored the importance for businesses to obtain trademark registrations in all foreign countries in which they sell products or have operations.

Fortunately, certain international treaties can make the process easier for small businesses to tackle the enormous task of international trademark protection. For instance, the Paris Convention allows brand owners up to six months to seek international protection for their marks while maintaining a priority date relating back to the date of the US application. This benefit allows businesses to budget ahead and spread costs out while still securing the earliest possible priority date in foreign markets, a crucial advantage considering that most of the world follows a first-to-file trademark system. Additionally, the Madrid System offers small businesses a convenient and cost-effective way to register their trademarks worldwide by designating up to 130 countries in a single application.

For companies overwhelmed by the prospect

of policing their IP internationally, there are watch services that can monitor IP offices around the globe for potentially infringing rights, allowing businesses time to proactively oppose a filing before it makes it onto a foreign register. And for small businesses already experiencing the damaging effects of IP theft, engaging the services of an experienced international IP attorney can go a long way. In some cases, bad faith grounds can be relied upon to oppose or cancel infringing IP, even if the right holder has not registered its rights in that country. Litigation against infringing parties, and even criminal actions against counterfeit operations, can also be available. For online infringement, many e-commerce sites that are home to counterfeits have mechanisms in place to report those listings, and working with an attorney can make the whack-a-mole experience of takedown efforts more manageable.

Emerging issues

Finally, the issue of IP theft has found its way into President Biden's recent executive order concerning artificial intelligence (AI). *The Executive Order on the Safe, Secure, and Trustworthy Development and Use of Artificial Intelligence*, issued on October 30, 2023, is described by the Biden administration as “the most sweeping actions ever taken to protect Americans from the potential risks of AI systems.”⁸ On the topic of IP theft, the order promises resources to assist private sector businesses with mitigating the risks of AI-related IP theft. The order also includes directives to empower IPEC to better address issues of AI-related IP theft and to increase sharing between the Federal Bureau of Investigation, United States Customs and Border Protection, and other agencies. As the risks of IP theft evolve along with new technologies, so too must our efforts to combat them.

Final thoughts

From the cautionary decision in *Abitron Austria GmbH et al. v. Hetronic International Inc.* to the inclusion of AI-related IP theft in President Biden's recent executive order, the issue of IP theft has been front and center this year. The American IDEA Act calls attention to actions that can be taken to tackle this important issue and promises to be a meaningful step toward mitigating the harms of IP theft for small businesses.

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The American IDEA Act would create a grant program specifically to fund legal aid programs to assist small businesses in protecting their IP.”

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⁶ <https://www.uspto.gov/ip-policy/global-intellectual-property-academy/ip-elearning-modules>

⁷ https://www.supremecourt.gov/opinions/22pdf/21-1043_7648.pdf

⁸ <https://www.whitehouse.gov/briefing-room/statements-releases/2023/10/30/fact-sheet-president-biden-issues-executive-order-on-safe-secure-and-trustworthy-artificial-intelligence/>



An interview with Exotec's Head of Intellectual Property, Olivier Billard

Olivier sits down with *The Trademark Lawyer* to discuss the importance of robust strategies for protecting and enforcing IP in the tech start-up space, offer guidance into competitor analysis, and express the necessity of implementing NDAs.

Can you start by introducing yourself and your role at Exotec?

I have been Head of Intellectual Property at Exotec for two years now. It's an exciting role because I am situated in close connection with all of our functions, bridged between innovation and business. I began by working closely with R&D to build our IP portfolio as this is foundational to successfully reaching business goals. Building and protecting are key to our value proposition and to securing competitive advantages.

What strategies would you recommend tech companies or innovators implement to protect assets at the R&D stage?

Securing protection at the R&D stage is crucial. The first step is to ensure that everyone involved in the process signs a robust NDA to maintain confidentiality and prevent the unauthorized sharing of information.

Then, access to all R&D facilities and sensitive information must be limited. All employees and involved parties must be educated on the importance of confidentiality and the potential risk of information leaks. Conducting regular audits on these security measures can also assist in capturing IP for filing patents, trademarks, and copyrights to deter others from using, duplicating, or replicating innovations.

What should companies be looking at when carrying out competitor analysis?

Conducting competitor analysis provides a clear view of market share and position to understand the relative size and importance of the ecosystem.

Analysis allows for the examination of how our competitors are distributing their products.



Olivier Billard

“Building and protecting are key to our value proposition and to securing competitive advantages.”

For instance, are they leveraging online channel partnerships or using traditional retail outlets? How do they promote their products? Marketing and branding are incredibly important. Additionally, information can be derived from the examination of competitor IP portfolios.

Why is it important to be prepared “offensively” for an infringement suit and how should companies do this?

There is no room for improvisation when it comes to litigation.

Being proactive can deter potential infringers and strengthen the position of a company in the market. Being prepared offensively allows for strategic positioning in the industry. This includes identifying, at a very early stage, and advancing on potential threats.

Being prepared helps to minimize the financial impact of potential litigation. Quick resolution or a strong offensive stance can mitigate financial losses caused by infringement. Preparing for litigation in advance can be invaluable for negotiating and preparing to settle. Proactive steps empower you to control the situation. You can set the tone of negotiations and potentially avoid prolonged legal battles.

How do “offensive”, “defensive”, and “delegative” strategies differ in your opinion? And under which circumstances would you recommend each?

My ultimate guess is to say there are probably as many IP strategies in the world as there are companies! In my view, choosing between offensive, defensive, and delegative strategies depends on the value and criticality of the invention.



Delegative strategy can be considered when internal resources are lacking. Offensive strategy is used when there's a need to “aggressively” protect IP, monetize assets, gain a competitive edge, or challenge competitors' IP positions. Defensive strategy is employed when operating in a litigious industry, facing potential patent disputes, or aiming to build a defensive patent portfolio to prevent infringement claims.

The choice of strategy often depends on a company's industry, business objectives, risk tolerance, available resources, and the nature of its intellectual property portfolio. Many companies may combine elements of these strategies to create a comprehensive and balanced approach to IP management.

How and why are patent surveys commercially important?

They are the key driver and trigger for us to navigate Freedom to Operate (FTO). At a very early stage of innovation, we need to understand if we have a minefield or a blue ocean in front of us. This is the value of conducting regular patent surveys – encompassing a clear understanding of what there is in terms of technology, but also a clear evaluation in terms of strengths, breadth, and validity.

Secondly, this is a powerful tool for acquiring knowledge, for instance concerning an emerging technology, but also to better understand what the innovation strategy of a third party is.

Surveys also provide insight into possible license acquisitions; some technological bricks can be complementary to our IP and, since we cannot capture everything by ourselves, it can

“There is no room for improvisation when it comes to litigation.”

be clever to strengthen and broaden our market shares in terms of licensing. This can expand further into pure IP acquisition, buying a new interesting patent portfolio from another company, or mergers and acquisitions. Last but not least, it is very clear that IP is a source of inspiration for our R&D and innovation.

At what point should a company create an NDA? And how should they broach this with their employees?

At a very early stage and every time we move with a new company, partner, client, or customer, we need to clearly define the terms of confidentiality. People can be reluctant to sign NDAs because they're complex. We would be obliged to engage in complex discussions about the clauses concerning confidentiality, the duration, and what will or won't be considered confidential. NDAs are an efficient tool to make the situation and the discussion more comfortable. Signing can be a lengthy process, but spending the time and energy at the beginning of a project will then make the remainder of the process fluid.

But having an NDA signed is not enough. We need to explain that an NDA is not a mandate to put everything on the table. It must be understood that every time information is put on the table, the value and weight of such information should be considered. Regardless of the NDA, information should only be shared on a need-to-know basis. And ultimately, there is some information that we do not want to share – even under NDA. Beyond that, we need to have strong in-house proceedings to stop, rank, or flag the criticality of the information that we have. In simple terms, there

are three levels: information that is available to the general public; sensitive or confidential information – this is something that brings value to the company – that we consider ready to be shared because we can derive some value from the sharing of information; then information that we will never share.

Who within the company should be educated on IP? And how often do you feel this requires a refresh?

My personal view about that is to have different levels. I believe that, at some point, everyone at Exotec could be exposed to an IP issue. So, everybody at Exotec should, at least, have a basic understanding of IP, and a reflex for when confidentiality is concerned. Am I working under an NDA? What is the weight of information that I am currently sharing with my partners? Am I clear concerning the principle of the need-to-know basis?

“**Regardless of the NDA, information should only be shared on a need-to-know basis.**”

Then, we have the R&D teams – the contributors to IP in the sense that they are at the origin of our innovations! For them, we need to implement in-depth training for IP processes. They need to understand how a patent is drafted, what a claim is, and be familiar with all our IT tools in order, for instance, to declare an invention.

At which stage would you recommend start-ups seek outside counsel?

It makes sense to have outside counsel on board from the very beginning because they must understand who you are, what you are working on, and where you want to go in the future. From this global picture, they will be in a position to advise and provide opinions that make sense, which is completely different from a situation where legal counsel is coming in without an understanding of a company's mindset, products, and why there is an open patent dispute and litigation in the first place.

What qualities do you think are most important in outside counsel for start-ups in the tech space?

Ultimately, what do we want in a partner? For us, they need to be experienced in our tech industry and understand our technology and challenges.

A crucial aspect for us was for our outside counsel to share our entrepreneurial mindset. I've been working for almost 30 years in the field of IP, leading different positions like this one at Exotec but in larger groups. The difference with Exotec is the speed, the decision-making process, and the so-called entrepreneurial mindset.

In the same vein, accessibility, responsiveness, and a collaborative approach are vital. And making sure that our counsel can rely on robust networks and connections.

What three key takeaways would you like readers to take from this conversation?

IP is a collective game. From this point of view, having people on board is essential, not only from an in-house perspective but also encompassing outside skills and expertise, including outside counsel.

Ultimately, IP is business. My job is to advise the top management of Exotec in terms of risk probability, and impact, and ultimately to provide scenarios to mitigate risk.

Thirdly, having IP in the middle of everything. IP will continue to play a crucial role because our business is more and more competitive. We are still facing big legacy players with extensive patent portfolios. In the meantime, we also see newcomers entering the game, each with emerging patent portfolios, meaning that there are still some open places for new and innovative solutions. So, it is clear that IP will continue to play a key role.



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Changing landscapes relevant trademark criteria in Mexico

Hiromi Takata and Mauricio Galindo of Dumont introduce and evaluate the changes implemented in Mexican trademark law this year to provide practical advice for protecting IP in the evolving legal system.

During this year, the legal landscape of trademarks in Mexico has undergone a notable evolution, marked by the emergence of relevant criteria. These criteria, meticulously delineated by our higher courts, are poised to become the benchmark for normative interpretations, shaping perspectives and guidelines that will significantly influence legal practices and related procedures in the expansive domain of industrial property.

Our Mexican Constitution, among other provisions and principles, states that all men and women are equal before the law, without any discrimination on grounds of nationality, race, sex, religion, or any other personal or social condition or circumstance, so that all authorities must consider that individuals in the same situation must be treated equally.

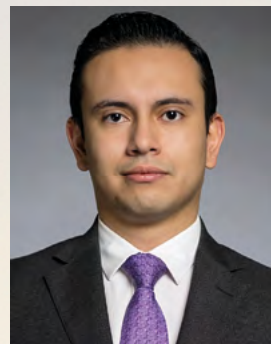
It also provides the principle of legal certainty, which requires that the law must be clear, unambiguous, and with foreseeable legal consequences or implications.

These principles and human rights, which are also contained in international treaties to which Mexico is a party, are closely linked to the authorities' duty of acting in accordance with their own precedents, which means that a criterion or decision held in a previous case, must be applied in similar cases in the future.

On August 18, 2023, the case decision number 2027029 was published in the weekly Federal Judicial Journal under the heading: "MARCAS. EL INSTITUTO MEXICANO DE LA PROPIEDAD INDUSTRIAL (IMPI) SE ENCUENTRA OBLIGADO A MOTIVAR Y FUNDAMENTAR LA APLICACIÓN O NO DEL MISMO CRITERIO EN CASOS SEMEJANTES, AL RESOLVER SOBRE SU REGISTRO (PRECEDENTES MARCARIOS)", which basically states that the



Hiromi Takata



Mauricio Galindo

Mexican Institute of Industrial Property is compelled to maintain a consistent criterion when solving cases of similar distinctive signs, since it is not exempt for complying with the human rights of equality and legal certainty.

The original case that determined this decision was the prosecution of trademark "FABRICADO EN MÉXICO" (and design) - translated into English, "*manufactured in Mexico*" - filed covering a wide list of goods in class 29 before the Mexican Patent and Trademark Office by a retail company, which is the leader of the hard discount model in Mexico with more than 1500 stores and more than 100 house marks.

During the Mexican Patent and Trademark Office's examination, an objection was raised due to the existence of earlier slogans "SI ESTA HECHO EN MÉXICO ESTA BIEN HECHO" and "LO MEJOR DE EUROPA HECHO EN MEXICO", as well as on considerations of descriptiveness, specifically, the examining attorney considered that the trademark of interest was descriptive of the intended goods. The applicant filed a response to the objection, which was not persuasive for IMPI and, therefore, a final rejection was issued on July 28, 2021.

This decision was appealed before the Intellectual Property Specialized Court (SEPI) of the Federal Administrative Court of Justice, which issued a judgment recognizing the validity of the challenged decision, by considering that the trademark of interest was descriptive for the goods in class 29 since the same was indicative of its place of origin, which is a prohibition set forth in section IV article 90 of the Federal Law for the Protection of Industrial Property.

Against this decision, an Amparo Appeal was submitted, which was settled by the Twentieth

Administrative Circuit Court determining essentially, the following points:

If the conclusion of the Mexican Institute of Industrial Property is that the trademark FABRICADO EN MÉXICO (and design) could not be registered since it describes the place of origin of the intended goods, it should have explained how trademarks also bearing names of specific cities, towns or places, such as HECHO EN MÉXICO -*made in Mexico*-, HECHO EN OAXACA -*made in Oaxaca*-, HECHO EN VERACRUZ -*made in Veracruz*-, HECHO EN LATINOAMÉRICA -*made in Latin America*-, HECHO EN LA UNAM -*made in the National Autonomous University of Mexico*-, HECHO EN CU -*made in the UNAM campus*-, HECHO EN JALISCO -*made in Jalisco*-, HECHO EN TLALPAN -*made in Tlalpan*- and HECHO EN FRESNILLO -*made in Fresnillo*-, as well as some other similar trademarks granted to TIENDAS TRES B, are not descriptive of origin and that the same do not fail to comply with the provisions of article 90 section IV of the Law of Industrial Property, or it should have provided sufficient legal reasons to justify why such criterion has been abandoned in this particular case, in use of its freedom of jurisdiction.

Also, while it is true that the examination of a trademark is conducted on a case-by-case basis, it is also true that such argument in this particular case departs from the principle of legal certainty and falls into arbitrariness, violating the principle of Law *ubi eadem est ratio eadem juris dispositio debet*, which means that where there is the same reason, there must be the same provision, since it was used as an excuse to not verify or elucidate what is visible at first glance. This is because the trademark of interest is indeed in a similar situation as the mentioned registrations, since all of them refer to the place where the products were manufactured.

In light of the above considerations, the Magistrates of the Circuit Court ordered the issuing of a new decision declaring the nullity of the challenged resolution, so that the Mexican Patent and Trademark Office analyze the alleged analogy of the situation between the trademark of interest and the granted trademark registrations, in order for said administrative authority to

Résumés

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She has also worked in a group of companies active in financial services, retail, media, telecommunications, and internet industries as an in-house lawyer.

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Mauricio Galindo joined Dumont in 2019 and is the Manager of the Intellectual Property Litigation department.

Leading the IP Litigation team, he handles complex litigation matters regarding trademarks, patents, copyrights, trade secrets, domain names, anti-counterfeiting, and unfair competition, including actions before the Mexican Patent and Trademark Office, appeals at the Federal Administrative Court, Federal Circuit, District Courts, and the Mexican Supreme Court.

His expertise extends to copyright protection, involving registration, agreement drafting, and infringement advice. Mauricio and his team are also responsible for handling trademark oppositions, in which Dumont has an outstanding success rate.

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determine whether or not the same legal criterion should operate.

Although this case decision is not binding and legal criteria regarding equality and respect for precedents already existed, it is positive that these principles are reiterated and concentrated in one precedent that persuades the Mexican Patent and Trademark Institute to maintain a consistent and coherent criterion when deciding on similar cases, based on the human rights of equality and legal certainty, which all authorities in Mexico within the scope of their competences, have the obligation to promote, respect, protect and guarantee according to article 1, third paragraph, of the Mexican Constitution.

Another focal point undertaken by our courts has been the rigorous examination of the MPTO and its obligation to substantiate and provide comprehensive reasoning for the assessment of the "uninterrupted use" requirement when declaring the cancellation of a trademark due to its similarity with a previously registered mark.

The term "uninterrupted use" is inherently vague, lacking a specified scope or an objective parameter to ascertain when the frequency of commercial operations involving a trademark qualifies as uninterrupted. In light of this indeterminacy, the competent authority tasked with making determinations regarding nullity actions must articulate and substantiate its assessment.

However, it's crucial to emphasize that the assessment of "uninterrupted use" is not arbitrary; it demands precision and specificity. Contextual considerations, encompassing both national and international commercial operations, are essential to ensure a correct application of the law. The evolving nature of commerce and the global marketplace needs a nuanced understanding of what constitutes uninterrupted use, and these legal criteria provide a framework for such determinations.

“The legal landscape of trademarks in Mexico has undergone a notable evolution.”

It is evident that the globalized nature of commerce and the increasing interconnectivity of markets underscore the importance of establishing precise criteria for uninterrupted use. With trademarks serving as crucial identifiers in a myriad of industries, from technology to consumer goods, the need for a clear understanding of the parameters defining uninterrupted use becomes paramount. This legal evolution not only addresses the intricacies of national trade but also acknowledges the interconnectedness of markets in the contemporary era.

Another noteworthy criterion elucidates that the decision issued in an opposition procedure possesses a definitive nature, making it subject to be challenged in a federal contentious administrative proceeding before the IP Specialized Court, informally known as a "nullity appeal". This criterion carries significant weight as it clarifies that the "response" to an opposition is an integral component of the trademark application procedure and should be considered as a formal decision.

The opposition proceedings occur within the same file as the trademark application, commencing with the application and concluding with a ruling. Consequently, the decision encompassing reasons and legal grounds for the granting or refusal of a trademark registration concludes the opposition procedure. This finality enables affected parties to challenge these decisions through nullity appeals, safeguarding the rights of all involved parties.

Delving deeper into the ramifications of this criterion, it becomes evident that it not only streamlines the trademark application process but also bolsters the transparency and accountability of the legal framework. By categorizing the resolution of opposition as a definitive aspect of the application procedure, the legal system ensures that all facets of the decision-making process are open to scrutiny and challenge. This fosters a

culture of legal accountability and contributes to the overall integrity of trademark registration processes.

Lastly, the courts addressed the absence of a specific deadline for initiating a non-use cancellation action in the Federal Law for the Protection of Industrial Property. This criterion establishes that such proceedings may be initiated at any time, provided the applicant can substantiate their legal interest.

It's essential to note that legal interest in enforcing the cancellation of a trademark registration doesn't solely derive from a subjective right; it extends to individuals with rights opposable to third parties. This includes those applying for a trademark registration or those with a registered trademark similar to one that could potentially lapse.

This criterion underscores the absence of a specific time limit in the law, granting interested parties the flexibility to file cancellation actions when they see fit, as long as they can substantiate their legal interest. This approach offers adaptability and fairness in situations where filing a non-use cancellation cannot be done before filing a response to a provisional refusal.

Expanding on the implications of this criterion, it becomes apparent that the absence of a rigid

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time limit serves as a safeguard for the rights of individuals and entities with legitimate concerns about the use of specific trademarks. In a dynamic business environment where market conditions and commercial strategies can evolve rapidly, the possibility to initiate non-use cancellation actions at any time provides a pragmatic and equitable mechanism for removing trademarks that are blocking industry players from key opportunities, thus fostering a more competitive and dynamic business environment that encourages innovation and ensures fair access to the market.

In summary, these legal criteria, borne out of the evolving landscape of trademark law in Mexico, are a step forward in our legislation to ensure a fair and robust framework. They aim to clarify regulatory gaps, providing a lifeline against potential infringement on the intellectual property rights of individuals and legal entities. As these criteria become ingrained in legal practice, they contribute to the evolution of a more just and equitable intellectual property landscape in Mexico. The comprehensive nature of these criteria not only addresses specific legal nuances but also reflects a broader commitment to fostering transparency, accountability, and adaptability within the legal framework governing trademarks in Mexico.



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The protection of geographic indication in China

Wenlong ZHU, Trademark Attorney at CCPIT Patent and Trademark Law Office, details the available protection for products and services with a specific regional origin in China.

Geographical indications are an important area of intellectual property protection, but they are still a relatively new concept for China. In 1985, China acceded to the Paris Convention and began to protect geographical indications in the form of international conventions. In the Measures for the Administration of Registration of Collective Marks and Certification Marks, which came into effect on December 30, 1994, China for the first time protected geographical indications in the form of certification marks. After China acceded to the WTO in 2001, it amended the Trademark Law according to its commitment and made a clear definition of geographical indications. So far, geographical indications have been established in the form of laws in China.

The geographic indication is a sign that indicates the region where the goods originate and the natural or human dimensions which primarily decide the specific quality, reputation, or other features of the goods. The TRIPs agreement places geographical indication alongside traditional intellectual property rights, such as copyright, patent, and trademark, as objects of intellectual property protection.

With a long history and profound cultural accumulation, China is rich in geographical indications resources. The Chinese government attaches great importance to the protection of geographic indication. Internationally, the *China-EU Agreement on Geographical Indications*, officially signed on September 14, 2020, is the first comprehensive, high-level bilateral agreement on geographical indications signed by China, which will be conducive to the promotion of bilateral trade in geographic indication products. Domestically, the PRC Civil Code and the PRC Trademark law



Wenlong ZHU

provide the protection of geographical indication with reference to the TRIPs agreement. In addition, many regulations in China stipulate the protection and management of geographic indication:

Regulation on the Implementation of the Trademark Law of the People's Republic of China (2014 Revision) stipulates that the geographic indications as mentioned in the Trademark Law may be registered upon application as certification marks or collective marks in accordance with the Trademark Law and this Regulation.

"Provisions on the Protection of Geographical Indication Products" issued in 2005 by the former State Administration of Quality Supervision, Inspection and Quarantine (dissolved) stipulates that the "geographical indication products", as mentioned in these Provisions, refer to those products which are named geographically according to their specific region of origin after being examined and approved, and whose quality, reputation, or other characteristics depend on the natural factors and humane factors of the area of production.

"Measures for the Administration of Geographical Indications of Agricultural Products (2019 Amendment)" issued by the Ministry of Agriculture and Rural Affairs stipulates that the term "geographical

Résumé

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indications of agricultural products" as mentioned in these Measures refers to special agricultural product indications which are named by territorial names and are meant to tell that the indicated agricultural products are from a specific area and that the quality and major characteristics of the products mainly lie in the natural and ecological environment as well as cultural and historical factors of the area.

Based on the above-mentioned applicable laws and regulations, it can be conceived that China's provisions on the protection of geographical indications are relatively fragmented and complicated, with a number of departments having the authority to manage them. Historically, there have been three main systems for the protection of geographical indications in China:

Firstly, the China National Intellectual Property Administration (CNIPA) is in charge of the registration and protection system of "collective marks" and "certification marks", which is based on the Trademark Law. "Collective mark" means a mark registered in the name of a group, an association, or any other organization for the members of the organization to use in commercial activities to indicate their memberships in the organization. "Certification mark" means a mark controlled by an organization with supervising power over certain kinds of goods or services but used by entities or individuals other than the organization on their goods or services to certify the origins, raw materials, manufacturing methods, quality, or other specific characteristics of the goods or services. PRC Trademark Law stipulates that the name of any administrative division at or above the county level or the name of any foreign place known by the public may not be used as a trademark, except that the place name has other meanings or is used as a part of a collective mark or certification mark. Once a geographical indication has been approved for registration as a collective mark or a certification mark, it can seek the protection of the exclusive right to use the registered trademark by administrative organs or judicial organs in accordance with the provisions of the Trademark Law.

The second is the registration and protection system for "geographical indication products", which is led by the former State Administration of Quality Supervision, Inspection & Quarantine and is based on the *Provisions on the Protection of Geographical Indications Products*. The geographical indication products include: (1) the products originating from the plantation and breeding of this region; (2) the products produced and processed from raw materials coming entirely from a region or partly from elsewhere according to the specific techniques of this region. An application for the protection of a geographical indication product shall be filed by

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is a sign that
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or other
features of
the goods.”

the applicant institution for the protection of geographical indication products as designated by the people's government at or above the county level, or shall be made by the association or enterprise accredited by the people's government, and the opinions of the relevant departments on the application shall be solicited. This system focuses on the monitoring of the quality of geographical indication products, with no specific provisions on the rights and obligations of applicants and users of geographical indications, and no mention of penalties for non-compliance.

The third is the registration and protection system for geographical indications of agricultural products, led by the Ministry of Agriculture and Rural Affairs and based on the *Measures for the Administration of Geographical Indications of Agricultural Products*. This system protects only primary agricultural products sourced from agriculture, namely, plants, animals, micro-organisms and the products thereof obtained in agricultural activities, and encourages registrants to supervise and guide the production and sale of geographical indications of agricultural products through a registration and management system. Applicants for the registration of geographical indications of agricultural products shall be excellent professional cooperative economic organizations of farmers and industrial associations determined by the local people's government at or above the county level in accordance with the following conditions: (1) having the capability for supervising and administering the geographical indications of agricultural products and the products thereof; (2) having the capability for providing guidance for the production, processing, and marketing of agricultural products with geographical indications; and (3) having the capability for bearing civil liabilities independently.

Among the above-mentioned protection systems, the first protection mode under the Trademark Law with a hierarchy higher than regulation undoubtedly provides stronger protection over geographical indications, which could be filed with the CNIPA for the registration as "collective marks" and "certification marks" and enjoy the protection of the exclusive right to use the registered trademark by administrative organs or judicial organs in accordance with the provisions of the Trademark Law. In practice, this is the main way in which the owner of a geographical indication protects the geographical indication in China. In addition, PRC trademark law also stipulates that "where a trademark contains a geographic indication of the goods but the goods do not originate from the region indicated thereon, thus misleading the public, the trademark shall not be registered and shall be prohibited from use; however, those that have been registered in good faith shall continue to be valid", which



provides *ex post facto* protection on a case-by-case basis for geographical indications not yet registered.

The current geographical indication protection systems still have many shortcomings. Just to name a few: one is that geographical indications are "place name + product name", and such expressions are descriptive expressions that may be refused registration because they do not have the distinctiveness required by trademark law. The other is that the overlap between the legal system and the management system is not only prone to lead to rights conflict but even lead to consumers not being able to identify authentic geographical indications products.

To unify and simplify the management of geographical indications in China, the State Council Institutional Reform Proposal in 2018 explicitly transferred to China National Intellectual Property Administration (CNIPA) the administrative duties relating to geographical indications of places of origin of the former General Administration of Quality Supervision, Inspection and Quarantine. The Ministry of Agriculture and Rural Affairs also ceased in March 2022 its registration work involving the acceptance, evaluation, publicity, and announcement of geographical indications of agricultural products. The reorganized CNIPA is in charge of the unified registration and management of geographical indications and has now basically achieved unified recognition and publication.

Guiding Opinions of the China National Intellectual Property Administration and the State Administration for Market Regulation on Further Strengthening

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the Protection of Geographical Indications in 2021 indicate as an important type of intellectual property, geographical indication effectively boosts economic development with regional features, vigorously supports rural revitalization, and plays a crucial role in promoting foreign trade and foreign affairs. It not only serves to protect and carry forward traditional cultural essence, but also provides valuable resources for enterprises to participate in market competition. Based on the guiding opinions, China has elevated the protection of geographical indications to a more urgent position. Notice by the China National Intellectual Property Administration of Issuing the "14th Five-Year" Plan for the Protection and Use of Geographical Indications in 2021 made a general, forward-looking plan for the protection of geographical indications in China, including improving the legal system for Gis, establishing a coordinated and orderly unified identification system for Gis and optimizing the working mechanism for GI review, etc. China's geographical indications system has ushered in a major reform, which will surely lead to a more standardized and strict protection system.

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Brand strategy and protection: trademark registration



Igor Simoes and Amanda Rojas of Simoes IP outline the importance of a solid trademark and marketing strategy for the creation and development of a strong brand to attract consumer respect and retention.

Information is key in the process of modern globalization. It is undeniable that technological advances, especially the internet, have transformed the way societies around the world live. Access to information and technologies has given people the opportunity not only to interact with different cultures but also to make new choices.

This world filled with options can be challenging for entrepreneurs trying to consolidate their businesses and trademarks. However, we should not be mistaken that those challenges are exclusive to new trademark owners. Stakeholders owning renowned brands must also plan strategies to understand consumers, align

the company's mission, and keep their own companies fresh and on the rise. The truth is that the branding process lives with the brand itself, and, for that reason, trademark management should be brought to the table in all cases.

However, addressing branding strategies without giving the proper attention to protection is a common mistake. Many businesspeople leave trademark applications in second place or are even unaware of the procedures to file their trademarks before the Brazilian Patent and Trademark Office (BRPTO) and International Offices. Such mistakes can easily disrupt the branding strategies of a company in countries like Brazil.

Branding and strategy for strengthening trademarks

Researchers point out how digital marketing earns more and more of the attention of stakeholders. In Brazil, for example, IAB Brasil, in partnership with Kantar Ibope Media, collected data highlighting that the investment in digital advertising reached R\$ 32.4 billion in 2022¹.

Moreover, according to Forrester's 2022 Marketing Investment Forecast, the expectation is that marketing investments will grow 30% by 2025².

The numbers confirm that entrepreneurs are aware of the importance of directing investments to marketing and maintaining a relevant digital presence. Moreover, the ease of finding information from all sources, the deep connection that new generations seek to establish with brands, and the need to capture public attention in an increasingly globalized market demands new branding plans and a lot of work to enhance brand equity.

Branding refers to the set of strategies used to consolidate the brand identity before the public and the market. It is a complex management process, which requires a lot of research. To start planning branding strategies, the company needs to establish what it seeks to communicate through its trademarks, as well as its mission, values, and target audience.

Designing a meaningful logo, building the trademark story, and establishing how the brand should make consumers feel is part of the branding process. By establishing such points and other supporting materials (a tagline, the images appearing in advertisements, and more), the company can consciously plan brand management, seeking to perpetuate a trademark image and message in consumers' minds.



Igor Simoes



Amanda Rojas

Many companies have been doing their brand management for years, creating identity bonds with their audiences. That is one of the keys to business longevity, and to influencing consumers' decisions. For example, some brands build their trademarks to pass positivity, hope, and an idea of unity. Others rely on more modern approaches, seeking to speak to younger generations.

In marketing and communication fields, professionals always point out strategies for strengthening the business through trademarks. The Tone of Voice is one of those strategies, and it refers to the way a trademark communicates

¹ Investimento em publicidade digital cresce 7% em 2022 e atinge R\$ 32.4 bilhões. IAB Brasil. São Paulo. 10/04/2023. Releases. Available (in Portuguese) at <https://iabbrasil.com.br/investimento-em-publicidade-digital-cresce-7-em-2022-e-atinge-r-324-bilhoes/#:~:text=abril%20de%202023-,Investimento%20em%20publicidade%20digital%20cresce%207%25%20em%202022%20e%20atinge,em%20publicidade%20digital%20no%20Brasil>.
² VERBLOW, Brandon et al. 2022 Marketing Investment Forecast, Global. Forrester, Cambridge, MA, 30/03/2022. Forecast Report. Available at <https://www.forrester.com/report/2022-marketing-investment-forecast-global/RES177171> (requires subscription)

Résumés

Igor Simoes, Managing Partner

With over 25 years of experience, Igor is the Managing Partner of Simoes Intellectual Property, having graduated in Chemical Engineering from Fluminense Federal University (UFF) and in Law from Candido Mendes University. He is also an Industrial Property Agent, registered before the Brazilian Patent and Trademark Office (BRPTO) since 2001.

Igor has knowledge in all areas of Intellectual Property, demonstrating extensive experience in litigation before Brazilian State and Federal Courts, as well as in all administrative petitions before the BRPTO. His practice also involves prior art searches, technical and legal consultancy in IP, focusing on patents, industrial designs, trademarks, copyrights, and software.

Amanda Rojas, Marketing and Institutional Relations Coordinator

Amanda holds a degree in Languages from Fluminense Federal University (UFF) and a postgraduate degree in Marketing and Branding. She has completed courses focused on Intellectual Property, in addition to an academic exchange in Italian Language and Culture at the University for Foreigners of Perugia, in Italy, and extension courses in Marketing.

Amanda has been working with Intellectual Property since 2015, focusing on the administrative field and communication with clients. She has been working with Marketing for three years, focusing on the legal area, specializing in social media, user experience, strategic negotiation, and brand strengthening.



(basically, its "personality"). Netflix (an online streaming service), for example, communicates casually and playfully through social media. Medium (an online tool for writers and readers of diverse topics), on the other hand, connects with young generations but communicates more formally than Netflix.

Knowing the company's purpose is also crucial for consolidating the brand. Moreover, law and communication should meet at the very first steps of the trademark, namely, when stakeholders create the brand name and its visual identity. The reason for the connection between such fields being so important is simple: protecting the company's trademark is protecting the company itself, preventing monetary losses, and securing the team's work.

Trademark search as a branding ally

Article 122 of the Brazilian Industrial Property Law (LPI 9.279/96) establishes that trademarks are any visually perceptive distinctive signs, when not prohibited under law. Legal prohibitions are present in Article 124 of the LPI and define the main requirements that trademarks must follow to be eligible for registration, namely: legality, distinctiveness, veracity, and availability.

According to the Brazilian Trademarks Manual, legality concerns the non-prohibition for reasons of public order or reasons of morality and good customs. Veracity prohibits misleading signs regarding the origin, provenance, nature, purpose, or usefulness of products or services.

Distinctiveness refers to the function of the trademark to distinguish a product or service, making it possible to individualize it from others of the same gender, nature, or kind. Finally, to be available, a trademark must not find obstacles in previous registrations or other distinctive signs protected under any circumstances, not just those protected by the LPI.

Availability is protected by items IV, V, IX, XII, XIII, XV, XVI, XVII, XIX, XX, XXII, and XXIII of article 124, and articles 125 and 126 of the Brazilian IP Law. Article 125 establishes special protection for highly renowned marks. Meanwhile, article 126 is aligned with Article 6 bis (1) of the Paris Convention which provides protection to well-known marks.

For a trademark to be aligned with the provisions of Brazilian IP legislation, a professional analysis and trademark search, before filing, are highly recommended. The search is essential for guiding trademark owners and preventing unnecessary expenses with possible appeals against rejections.

Furthermore, trademark search is important for market analysis and brand building. Through it, it is possible to identify terms, presentations,

“According to Forrester's 2022 Marketing Investment Forecast, the expectation is that marketing investments will grow 30% by 2025.”

and trends specific to a given scope of activity in a particular country, and that opens the opportunities to draw differentiation and competitiveness plans. In certain situations, this research points to the need to adapt the brand's presentation, and this directly impacts branding strategies.

The examination of trademark applications in Brazil is territorial. This means that the trademark registration is only obtained before the BRPTO. For that reason, many international trademarks require presentation and branding adaptation.

Around the world, there are several examples of brands that changed their names to commercialize products or services in a specific country. This is the case, for example, of the North American brand Burger King, which has existed since 1954, and was renamed "Hungry Jack's" in Australia, as there was already a previous registration for the trademark "Burger King" in the country.

It is natural that international franchises adapt their strategies according to local realities, and this already raises the need for different brand management strategies. However, changing the brand sign will likely imply a branding redirection. Trademark presentation is an essential communication factor, which must be aligned with the other brand positioning strategies. Given this, the professional trademark search should also be prioritized whenever the company wishes to protect its own mark.

Trademark registration in Brazil

According to data from BRPTO's 2022 Management Report, the filing of trademarks in Brazil has been growing year on year, when looking at the comparison of numbers from 2019 to 2022. Last year, application numbers reached almost 400,000, an increase of 3% compared to 2021.

Such an increase was possible not only because of BRPTO's efforts to eliminate the backlog in trademark examination but also because of projects for the dissemination of intellectual property in our country.

Furthermore, it is important to highlight that, in 2019, Brazil took a big step towards international cooperation related to trademark protection, as it became a signatory to the Madrid Protocol. One year after Brazil adhered to the Protocol, 109 international applications were filed before the BRPTO by Brazilian trademark owners. At the same time, 7,896 applications were filed by owners from different countries, indicating Brazil as the filing designation.

Further data from the Institute pointed out that from October 2019 to March 2023, 474 International Applications were filed by Brazilian applicants. Meanwhile, Brazil received 34,257 international trademark designations. The United States and the

European Union are the main filing destinations for Brazilian trademarks, and the main regions trying to protect brands in Brazil as well.

Moreover, in 2021, the BRPTO started accepting position marks. In practice, this represented a major progress for owners of non-traditional trademarks who, for years, had been trying to register position marks in Brazil by claiming other presentations (figurative or three-dimensional marks).

As trademark registration is important to branding, a recent case of position marks in Brazil showed the importance of branding for claiming trademark registration as well. This year, the BRPTO rejected Louboutin's application for protecting the red sole of its shoes as a position mark, based on Art. 122 and Art. 124, item VIII, of the Brazilian IP Law, and on the Brazilian Trademarks Manual.

Louboutin's legal representatives in Brazil promptly took the case to the judiciary sphere, and, recently, Judge Marcia Maria Nunes de Barros, from the 13th Federal Court of Rio de Janeiro, issued an injunction suspending the BRPTO's decision.

In this case, one of the many arguments the Judge used for suspending BRPTO's decision was that the red sole has been widely used for years as a visual identity by Christian Louboutin, and it is recognized by consumers of luxury articles and people interested in the fashion and accessories industries. The impossibility of affirming that the designer has been the first one applying the red sole in its shoes was also highlighted, however, according to the Judge, the consistent use of this signature through the years is undeniable.

Importance of trademark registration

Brazil adopts the attributive system for brand protection, which establishes that trademark exclusivity and property are only granted by means of registration.

The general rule established by LPI and the Brazilian Trademark Manual, states that the trademark registration priority relies on the first applicant. The exception to this rule is provided by §1 of Article 129 of the LPI, which states the following:

"Any person who in good faith at the date of priority or of the application was using an identical or similar mark for at least 6 (six) months in the country, to distinguish or certify a product or service that is identical, similar or akin, will have preferential right to registration."

Considering the rules established by Brazilian legislation, trademark registration before the BRPTO should also be included in the branding strategy. Many stakeholders and businesspeople have already found themselves in the situation

“To start planning branding strategies, the company needs to establish what it seeks to communicate through its trademark, as well as its mission, values, and target audience.”

of having to change their brand because of a late filing before the BRPTO.

Some cases of trademark rejection in Brazil also highlight the importance of looking out for brand protection. In 2021 and 2022, Brazilian singer, Ludmilla, faced the trademark rejection of her biggest musical project, called "Numanice".

Her legal team filed two composite applications for "Numanice," in class 41. However, the BRPTO rejected both applications based on the previous existence of the registration "NUMA NYCE", in the same class, covering similar services.

In this situation, Ludmilla would have to obtain a usage license from the owner of the registered brand or buy the trademark in case the owner wishes to sell it to the singer. In any case, the late registration of the brand put the





name of one of Brazil's most famous musical projects of recent years at risk.

The worst-case scenario, when a trademark is not registered, is for a company to be accused of being an infringer. Usually, companies receive a warning letter sent by the trademark owner and a reply is required. Whenever a company receives such a cease-and-desist letter, the first recommendation is to analyze whether the sender of the letter is in fact the owner of the trademark or a licensor in Brazil. In the affirmative, the second recommendation is to analyze whether the trademark application/registration may be challenged (either before the BRPTO or in court). The third recommendation is to prepare a reply to the warning letter. There are no provisions in the Brazilian rules demanding the company to reply to the warning letter. However, it is always recommended to do so; otherwise, the sender of the letter may use the lack of reply to request and obtain a preliminary injunction (in court) based on the infringement activity.

Conclusion

Branding strategies are set to strengthen the company, allowing a trademark to go beyond its name. This set of strategies is built with persuasion purposes, not only to commercialize

products or services but to make a mark memorable and credible.

However, it is essential that a trademark does not infringe third parties' rights to maintain its longevity and credibility. The loss of brand exclusivity in such a competitive market, which is constantly changing, can jeopardize the entire company. Therefore, it is essential that brand protection is prioritized from its inception, and that branding strategies include careful analysis into trademark legislation in each country.

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An insider's guide: top tips for international trademark attorneys when filing or designating US trademarks

Alice Denenberg of Gottlieb, Rackman & Reisman, P.C. details the intricacies for successfully filing in the US with analysis into trademark searches and goods or services specifications.

A stute trademark attorneys entrusted with the oversight of worldwide filings will, over time, familiarize themselves with the requirements, rules, and limitations of trademarks outside their own jurisdiction. For trademark attorneys advising their clients on foreign filing, either via direct filing or by designating an extension of a Madrid International Registration, knowing these rules can save time and costs and increase registrability, maintainability, and enforceability of their clients' trademarks.

This is especially true when pursuing trademark protection in the US, which has esoteric rules found in no other jurisdiction. On their end, US trademark practitioners find that certain frustrating issues arise frequently when assisting foreign counsel in securing US trademark protection. Foreign trademark practitioners that plan ahead to comply with the rules and limitations of US practice, can offer their clients a smoother and therefore less expensive path to US registration. This article covers common issues that can be addressed prior to seeking US trademark protection or when filing for maintenance.

The importance of trademark searches

US Patent and Trademark Office (USPTO) Examiners review applications for a range of substantive issues, including whether a pre-existing trademark application or registration is confusingly similar to the application under



Alice Denenberg

Résumé

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examination. Refusals may be based on trademarks whose owners have no interest in enforcement or may no longer be in operation. In the event of a refusal, the Applicant must convince the Examiner to allow the trademark to register.

Other substantive grounds to refuse US trademark registration include, but are not limited to, descriptiveness, failure to function as a source indicator (also known as 'non-distinctiveness'), or a mark that is deceptive/mis-descriptive. USPTO Examiners also review applications for non-substantive requirements including conformance of the identification of goods and services to those in the US Trademark ID Manual.

Conducting a trademark search prior to filing is especially important in US practice as Examiners can refuse registration based on a wide range of substantive reasons. Substantive refusals can be notoriously difficult and expensive to



overcome. Direct filings in the US are currently examined 9-12 months after filing, and Madrid extensions have up to 18 months to be examined, meaning it may take a while for an Applicant to learn that their trademark is unregistrable.

In consequence, all US trademark filings or extensions should be prefaced by a search and accompanying opinion conducted by experienced US trademark counsel. Searches are valuable because even if a search report concludes that a trademark is not available for registration, the results may nonetheless indicate a path to registration either by challenging an existing trademark, adding or subtracting words and/or design elements, rewording or narrowing the identification of goods and services, and/or indicating that a mark is diluted and therefore coexistence is possible.

Searches are also important because, unlike most countries, the US is a first to use jurisdiction, and generally¹ recognizes the first user rather than first filer of a trademark. This means that a brand owner with common law use can assert prior rights, even over those of a registered trademark. Furthermore, and most importantly, a search can help a brand owner avoid a costly lawsuit in U.S. federal court for trademark infringement.

The gold standard for searches is a comprehensive trademark search, which involves securing a report from a reputable search company along with an opinion from an experienced US trademark attorney. A comprehensive search includes results from the US Patent and Trademark Office along with common law results. Together, these results provide a picture of the risks of adopting, using, or filing for US trademark protection. However, at a minimum, the brand owner should

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secure a knockout search of the USPTO database to indicate if there are any clear barriers to registration.

Strategizing identification of goods and services

Unlike US nationals, foreign applicants seeking US trademark protection have additional bases for securing registration. For example, they may secure an extension of protection through a Madrid International Registration (known in the US as a 66A basis), or they may secure protection based on an existing foreign registration (known as a 44E basis). The benefit of these aforementioned filing bases is that they do not require use in US commerce to secure a US trademark registration. In contrast, US nationals must ultimately prove use in US commerce as a prerequisite to securing US trademark registration and their filing options are based on use in commerce (known as 1(a) basis) or intent to use (known as 1(b) basis).

Since foreign applicants are only required to have a *bona fide* intent to use in the US to secure trademark registration on a 66A or 44E basis, they often file for US protection with an extremely broad or verbose listing of goods and services. The language of the US application typically mirrors wording used in an underlying local application/registration, which in some cases lists everything in the class. While some attorneys may view this filing strategy as providing the best and broadest protection, filing for extensive and/or broadly-worded goods or services is guaranteed to trigger an office action. Office actions requiring significant and numerous changes to the identification of goods and/or

services can be as expensive and time-consuming as responding to substantive refusals, frustrating Applicants, attorneys, and Examiners alike. Also, over-inclusive or broad identifications can inadvertently trigger office actions for a likelihood of confusion, where a narrower identification would not have.

Another issue is that to maintain a US trademark registration – even one registered without requiring proof of use – the Registrant must provide proof of use in US commerce between the fifth and sixth year after registration (and every 10 years thereafter, from the date of registration). To maintain the trademark registration, the Registrant must allege via a declaration that every good and/or service listed in the declaration is in use in the US. The USPTO is now adopting heavier scrutiny of maintenance submissions and after renewal, a trademark registration may be subject to a random audit requesting confirmation that goods/services remaining in the registration are in use. If the Registrant cannot provide valid proof of use in response to an audit, the USPTO will levy additional fees. Failure to respond to an audit will result in the abandonment of the registration, notwithstanding the maintenance filing.

Another disadvantage of including or keeping goods and/or services not in use is that a trademark registration is vulnerable to challenge by an interested third party. A third party may challenge an entire class or even an entire registration based solely on non-use of or no *bona fide* intent to use select goods and/or services. Keeping a precise list of goods and/or services that correctly reflect actual use can minimize challenges to a trademark registration.

To avoid the above issues, goods and services not in use or with no intention to be used should be omitted from the identification at filing and deleted from the registration during maintenance.

Identification of goods and/or services does not match expected or actual use

Another common problem encountered by foreign nationals seeking US trademark protection is imprecise wording, where the identification of goods and/or services does not correctly reflect the actual goods and/or services provided. A frequent example is ‘telecommunications services’ in Class 38, when the intended goods are ‘downloadable mobile application’ in Class 9; or ‘downloadable software’ in Class 9, when the software is accessed online only and should be listed as an ‘online non-downloadable software/SaaS’ in Class 42.

When the identification of goods and/or services does not match the actual or intended use, the trademark registration may be difficult to enforce

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¹ The exception is that by filing an application for intent to use, where there is no use at filing, but the use is perfected on the Principal Register, the earlier filing date will become a ‘constructive date of first use.’

or maintain. Planning ahead can avoid a mismatch in the scope of protection. One strategy is to provide the US attorney with information prior to filing, such as links to the products or services (or those of a competitor) for an opinion on accurate wording for the identification.

Proof of use and specimens

Compliance with US proof of use requirements is another issue commonly faced by international trademark attorneys. US trademark law requires submission of specimens, generally images or PDF documents that support use of the mark in connection with the good and/or service. Securing acceptable specimens has become more challenging as previously acceptable specimens are now being rejected. Examiners are also far stricter with their review of specimens: US trademark law does not permit mockups or computer-generated images, and Examiners will reject specimens that appear to be doctored or suspicious. Acceptable use in commerce also requires adherence to other formalities. If an Examiner refuses a specimen, then the substitute must have been in use as of the date of the original submission. As such, it is best not to risk a specimen refusal and to confer with US counsel to carefully scrutinize all specimens before submission.

Use for the benefit of others

A lesser-known requirement unique to US practice is that goods should be “goods in trade” and services should be “services for the benefit of others.” Outside of the US there is generally no penalty for a trademark identification that has a broad and overly inclusive list of goods and services. However, goods that are not in trade and services that are not for the benefit of others are precluded from US trademark protection and arguably not enforceable. Including unenforceable goods and/or services in the trademark identification can trigger an office action during prosecution or leave a registration open to challenge by third parties.

Common examples of goods not in trade include letterhead, invoices, reports, product packaging, business forms, and business cards. These products often bear the trademark of their respective business, but are not a product provided by the business. For example, an architect whose trademark is on their business card does not equate to business cards as a ‘good in trade’ for an architect. Architects do not manufacture business cards in the course of providing architectural services. Similarly, a distiller of alcohol cannot claim protection for glass bottles in Class 21 that contain the alcohol, unless they happen to manufacture glass bottles for third parties.

The same requirement applies to services, which must also be for the benefit of third parties and not merely for internal purposes. Common services that are inappropriately listed in the identification include advertising/promotional/marketing (where the trademark owner is not a marketing agency), personnel and human resources (when these are internal functions of the business and are not provided to outside parties), software development and maintenance (when the brand owner solely develops and maintains its own software) and distributorship (when the brand owner only distributes its own products).

US law recognizes an exception to the rule for companies that give away promotional products as a part of their business. These products are usually items given away at trade shows such as writing instruments, toys, office paraphernalia, and t-shirts. In this case, despite the brand owner not being the source of the product, these goods are protectable according to US case law.

Applying for trademark protection for goods not in trade and/or services not for the benefit of others increases prosecution costs and leaves the trademark registration open to unnecessary third-party challenge. Goods not in trade and/or services not for the benefit of others should

“**Another common problem encountered by foreign nationals seeking US trademark protection is imprecise wording.**”

be excluded from the identification when filing or designating trademark protection in the US.

Attorneys engaging in the oversight and management of US trademarks should communicate with their US trademark attorney to ensure that the protection they are securing in the US generates minimal office actions, is maintainable and enforceable. Planning ahead can save significant time and money and leave clients with the knowledge and satisfaction that their US trademark portfolio is in good order.

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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.



Wei Wei Jeang: Co-Founder, Fulton Jeang

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

Over a 30+ year career, Wei Wei has proven to be a formidable force in Dallas business and US patent law. An award-winning patent attorney, she has represented Fortune 500 companies (e.g., Texas Instruments, EDS, Caterpillar, Research in Motion, Nokia, Nortel, Alcatel), startups, and engineers in protecting intellectual property that has driven billions of dollars in revenue. In August 2023, Wei Wei co-founded the law firm, Fulton Jeang PLLC, a full-service law firm that currently has an attorney roster of 22 diverse attorneys who were former BigLaw partners, in-house general counsels, and senior lawyers.

Wei Wei has served as the Chair, Council Member, and Webmaster of the Intellectual Property Law Section of the Dallas Bar Association, President and Webmaster of the Dallas Asian American Bar Association, State Bar of Texas Intellectual Property Section Diversity Task Force Chair.

Wei Wei has been consistently recognized as one of "The Best Lawyers in America," "Best Lawyers in Dallas," "Best Women Lawyers in Dallas," "Texas Super Lawyers," and "Lawyer of the Year." Wei Wei was also recognized as a finalist for the Lifetime Achievement Award by the Texas Minority Counsel Program in 2022. Further, Wei Wei was recognized by the Southwest Jewish Congress as an "Inspiring Woman of the Southwest."

In addition to her role at Fulton Jeang PLLC, Wei Wei is co-founder and chief legal officer of Redmon Jeang LLC which has a patented mobile lawyer technology solution that enables drivers to summon licensed lawyers for assistance during a traffic stop or accident. The goal of this mobile lawyer technology is to provide legal counsel and de-escalate potential tensions. The technology uses a mobile app and can be incorporated into vehicles as OEM equipment.





“Companies need to insist that their outside law firms hire women lawyers, utilize them on their projects, and promote them.”

What inspired your career?

The inspiration for my legal career down the path of patent law is my intense interest in innovations, technology, and creativity. My education is in computer engineering, and I knew that there would be innovations on a revolutionary scale in my lifetime, and I wanted to be a part of it.

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

My partner, Suzy Fulton, and I founded our firm, Fulton Jeang PLLC, earlier this year. Suzy and I met 25+ years ago when we were both actively involved with the local Asian American bar association in leadership roles. We were part of the small core group that brought the national Asian American bar association conference to Dallas for the first time, and organized and hosted the entire event. We have been through the trenches together and worked together to solve tough problems to strive for a common goal. Needless to say that our relationship extends beyond the professional level to almost family.

My advice to younger lawyers would be to get involved in missions and passions that are important to you, and those relationships that you make will nourish you for the rest of your life.

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

In my 30-year legal career, the challenges have been to adapt to different law firm environments, internal politics, and cultures. I don't have a good answer for how to overcome these challenges except to form my own firm where I am instrumental in cultivating and shaping our own firm culture and work environment.

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

I consider my greatest achievement and the pinnacle of my career to be the founding of our firm, Fulton Jeang PLLC. We are a Texas-based full-service law firm with 22 lawyers, the majority of whom were BigLaw partners, general counsels, and senior-level in-house lawyers. We have one of the most diverse groups of lawyers in terms of gender and ethnicity. We provide the right environment and support to enable our lawyers to serve their clients in an efficient, diligent, and cost-effective manner. Leveraging our innovative virtual law firm platform, talented lawyers can shape and advance their legal careers according to their own plans and preferences without geographical limitations or firm-imposed artificial constraints. We believe in empowering our lawyers by providing them with cutting-edge technology and a flexible work environment, allowing them to serve their clients

efficiently and effectively. Our lawyers have the opportunity to earn a substantial income, as a significant percentage of their billings goes directly into their pockets. FJ lawyers also have a built-in internal referral network that enables them to financially benefit from work origination.

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

I will be working hard to build upon the great foundation we have established for Fulton Jeang PLLC so that our lawyers are happy and their clients are happy. I am especially focused on using technology such as artificial intelligence tools that make us work better and more efficiently.

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

There is still a significant shortage of women in the patent area and in law firms in general. Women are still not at the executive level or making key decisions. They are often relegated to areas considered more in the realm of women's domain, such as human resources and hiring. The success of our firm, with two women at the helm, will be a beacon to show the rest of the legal world that women can make the tough decisions that will steer law firms to success.

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

The bottom line for all law firms is their client base. We need companies to recognize that unless they put their money where their mouth is and hire women lawyers internally and externally, women lawyers, especially women-owned law firms, will have a tough time succeeding in the legal field because of the inherent biases they battle every moment of every day. Companies need to insist that their outside law firms hire women lawyers, utilize them on their projects, and promote them. Companies need law firms to demonstrate that women lawyers are not merely used as window dressing on pitches but are actually given the opportunity to do important work.

Catherine Wiseman: Head of Trademarks, Barker Brettell

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

Catherine Wiseman is Head of Barker Brettell's trademark team and a senior member of the firm's management board. She has been named as one of the world's leading trademark professionals in the WTR 1000 for many years, ranked as one of IP Stars Top 250 Women in IP (2017 to 2023), and is classed as a Band 1 attorney in Chambers & Partners.

Drawing on a wealth of experience, Catherine advises clients on a wide range of trademark matters including global portfolio management and prosecution. She is excellent at negotiating and managing conflict matters, consistently getting positive outcomes.

What inspired your career?

I did a law degree and the post-graduate diploma of law, with the aim of being a solicitor. However, even with a 2:1 degree in law from the University of Birmingham, I struggled to get a training contract during the recession in the mid-1990s. I saw an advert in a graduate magazine for a trademark attorney, that requested an interest in law, marketing, and foreign languages. I applied and made it down to the last two candidates, one guy and me. I was interviewed by two partners of the firm, one male and one female. The female partner, Sarah Lait, wanted to recruit me; the male partner wanted the guy. She got her own way, as I was to train under her, and so my journey began with her as my mentor.

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

Having a great mentor in Sarah was invaluable: I'd suggest finding an equivalent mentor to help you move through your professional life. Sarah supported and backed me for partner in 2001/2, and continued to remain a great source of support all the way through my career, both professionally



“That’s not to say I haven’t encountered sexist behavior, but my support network at the firm and at home has empowered me to either defend myself or rebuff inappropriate remarks.”

and personally, until she took early retirement in 2019. Having her as a role model and supporter was crucial in my progression at the firm.

At home, Sarah’s husband was also a trailblazer: he gave up his career to be a stay-at-home dad. Today, a number of female partners at Barker Brettell – including me – have husbands who are doing the same to help support us and our careers.

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

I count myself incredibly lucky in not really facing any serious challenges in my career because of my gender. At Barker Brettell, I have not felt discriminated against and am now part of a partnership where seven out of the 11 partners are women.

That’s not to say I haven’t encountered sexist behavior, but my support network at the firm and at home has empowered me to either defend myself or rebuff inappropriate remarks. I have however heard of the challenges that other women have faced in IP, including being passed over for promotion and also sexual harassment.

It’s fair, however, to say that I have faced my own mental challenges; being mainly maternal guilt and envy, when it comes to my sons, who are now 16 and 18. I have always been a dedicated mum at the weekend and in the holidays, but I was rarely the one who was at home when they came in from school, so I do feel I have missed out on aspects of their childhood and at times I have resented that, especially in more stressful periods of my career, like the global recession in 2008/9. But equally, I content myself with the fact that my husband has been there for them, and between us we have made a wonderful home life for them. Not that many children these days have the luxury of having a parent at home.

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

I always knew I wanted to make partner, and so I guess that is my greatest achievement, together with watching how the firm’s trademark team has grown from the two partners and me in 1996, to the now 20 attorneys based in the UK and Sweden. We have a wonderful collegiate team that I am very proud of.

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

I’ve been a trademark attorney for 27 years now, partner for 22 years, and head of the trademark team for four years. I have participated in lots of different roles at a partnership level, such as looking after the finance and facilities team, and now looking after the business development team. So I feel pretty content with where my

career is at right now. I’m now trying to give a little bit back to the profession by sitting on our institute (CITMA) Council and contributing to committee work around representation rights, and more recently being a CITMA mentor for attorneys coming through the profession.

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

I think the IP community in the UK is working extremely hard at equality and diversity, with IP Inclusive forging ahead with its agenda and talks on different topics. I’d like to see continued and sustained focus on mental wellbeing, as I think this is going to be an even bigger issue for the workplace in the future. A generation of Covid kids will be coming into the workplace in the next few years, and I think this will present some extreme challenges. We need to be ready and able to support this generation.

I also notice a lot of women around me battling the menopause. I know it’s a topic that a lot of people don’t like talking about, but I think increasing awareness of the struggles and symptoms that women encounter is important, so that colleagues can be supportive and helpful. It does rely on women being open about the challenges they are facing.

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

I think that forming or joining women’s support or networking groups is an important part of the empowerment of women. I have joined a women’s network recently and it is fast becoming a forum where women can share their own experiences and challenges, and how they have overcome them. Whilst I count myself as one of the lucky ones, it has particularly opened my eyes to the challenges that women face in other countries. Hopefully as a group, we can work together to improve the situation in other countries by sharing ideas on how to make progress.



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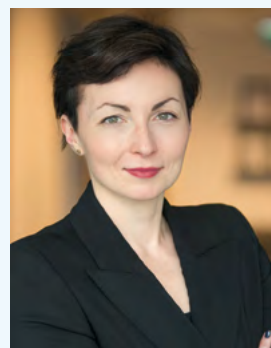
Anna Sokołowska-Ławniczak and Kaja Seń of Traple Konarski Podrecki and Partners review the increased requirement for strategically protecting trademarks in the pharmaceutical sector as a result of the increase in consumer awareness.

Minor differences between medicinal product brand names are becoming a major issue. It is especially true given the greater importance that consumers attach to the choice of these products compared, for instance, to foodstuffs. Mainly, because they have a greater impact on their health. This results in consumers looking more closely at brand names, which is a very good thing. It should be noted that the names of these products are often similar, due to the market practice of referencing illnesses, ailments or ingredients. For this reason, the similarity of trademarks for medical or pharmaceutical preparations is not always obvious at first glance and even minimal changes can affect the perception of a trademark. The significance of such differences in trademarks used for products of this kind has been confirmed in the newest Polish case law.

Minimum distinctiveness of trademarks for medicines

Does a word trademark used for medicine have to be an original name that bears no relation to its ingredients, and does it have to be different than the name used for the active substance? A company in the industry recently learned the answer when attempting to have the trademark "SYLIMAROL" invalidated. This trademark has been registered by Poznańskie Zakłady Zielarskie "Herbapol" S.A. in classes 5, 29, 30 and 31, for products such as food and dietetic substances for medical use, dietetic food for medical use, pharmaceuticals and veterinary products, medicinal herbs, healing broth, edible oils etc.

The company seeking invalidation argued that this mark alluded to the international generic



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name used for the active substance "silymarin" (pol. *sylimaryna*), which is recognized by the WHO as an INN (International Non-proprietary Name), and thus the element "sylimar-" used in the trademark described the use and ingredients of the product and indicate the generic name for the product it denoted. The ending of the word, "-ol", does not change this. Importantly, if the name of an active substance is recognized as an INN, it is not possible to register a trademark reflecting that name, as the name is intended to identify pharmaceutical substances or active pharmaceutical ingredients.

The proprietor of the disputed trademark contested the view that reference to the active substance *per se* means that the mark qualifies as a generic name. The proprietor also pointed to the practice, common in the pharmaceutical industry, of using marks that make inferences or allusions, while also stating that the mark did not prevent other companies from using the name of the active substance "sylimaryna" on the market (for example SYLIMARYNA MEDICEO, SYLIVERIN).

The Polish Patent Office pointed out that trademark distinctiveness is not determined by a certain level of linguistic or artistic creativity or imagination on the part of the proprietor. It is sufficient for the trademark to enable the relevant public to determine the origin of the goods or services for which the trademark is intended and distinguish them from goods of other origin. The mark does not have to be particularly unusual or original; it only has to have a minimum level of distinctiveness.

The Voivodship Administrative Court concurred, stating that the trademark in question was not the name of a substance but a made-up name

used to identify goods, and was clearly different to the name of the active substance. Moreover, the mark did not exist as a generic term in Polish or any other language. The fact that one of the ingredients of the product named *Sylimarol* is "sylimaryna" does not automatically mean that the brand is descriptive. The premise that the mark SYLIMAROL could be confused with the generic name of the substance is a flawed one, because in the case of generic names of active substances used in pharmaceutical production, the way in which letters are arranged - the layout and sequence, is fundamental and cannot go unnoticed by consumers.

The Supreme Administrative Court upheld the Voivodship Administrative Court's findings, stating that in the case of medicine or cosmetics, a name that combines the name of the main chemical ingredient of the medicine in question or the name of an illness for which the medicine is intended with certain prefixes or stereotypical endings is a fanciful name.

A low level of protection in practice?

The more descriptive a name is, the weaker its protection. This is particularly visible in assessments of the similarity of marks. One such assessment has been made in a recent dispute between manufacturers of flu relief products. In this case, both the Polish Patent Office and the Voivodship Administrative Court found that the earlier trademark TOTAL GRIP and the subsequently applied for trademark GRIPEX were not similar, even though they were intended for goods that were in part identical and in part similar, such as medicinal products, pharmaceuticals, and medicinal cosmetics.

These bodies found that as the marks were not similar phonetically or visually, and there was little conceptual similarity caused by the allusive element GRIP common to the two marks, referring to influenza (pol. grypa), this was unlikely to be misleading for consumers, even if the goods for which the two marks were intended were found to be partly identical and partly similar.

Due to the allusion made in the marks to the illness "grypa", these are rather low-quality trademarks, particularly in terms of class five. Meanwhile, if the proprietor holds a weak trademark, they can expect the protection obtained for the mark to be limited as well, and that other traders will be able to use the weak elements of the mark in their own, subsequent trademarks.

When to register a trademark for a medicinal product?

Trademark registration should take place in advance, but this does not guarantee that the chosen name can be used for medicinal products!

Résumés

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

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

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In Poland, a review of any name proposed for a medicinal product includes an examination of any aspects that may affect public health. Even if a name gets registered as a trademark in Poland, it still has to undergo a pharmacotherapy safety assessment and has to be found suitable for use as a name for a specific medicinal product. This and trademark registration are two entirely different procedures.

So why can prior application to the Polish Patent Office be important? While one company may be granted marketing authorization by the Polish Office for Registration of Medicinal Products, Medical Devices and Biocidal Products for a medicinal product under a certain name, a different company may register that name (assuming it's a fanciful one) or a similar name in Poland as a trademark. This may prevent the product bearing that name from being placed on the market. For this reason, when planning to launch medicine under a particular name, and before an application is filed for marketing authorization, or before an application is filed to change the name, a thorough trademark search in relevant registers seems necessary. Monitoring performed by a law firm might help in this regard.

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Japanese trademarks: how to respond to relative grounds objections

Kazutaka Otsuka of Asamura IP introduces the changes set to be implemented by June 2024 that will bring the “letter of consent” to the trademark practice in a bid to widen available protection to brands.

In cases where trademark applicants receive provisional refusal from JPO examiners based on prior trademarks, i.e., a relative grounds objection, the possible means to respond to such office actions in Japan is somewhat different to those in other jurisdictions. In this connection, the Japanese Trademark Act was amended in 2023 which includes the establishment of the additional means to respond to the relative grounds objection that is the “letter of consent” for trademark registration which is well-established and applicable in a few other jurisdictions like the USA, New Zealand, Singapore, etc. The amended Japanese Trademark Act will be implemented within a period not exceeding one year from the promulgation date, namely June 14, 2023. This article describes the possible means to respond to trademark relative grounds objections under the current regulation and practice and what will become available under the amended Japanese Trademark Act.

1. Outline of the trademark examination for relative grounds objection in Japan

JPO examiners conduct substantive *ex officio* examinations for trademark applications for both absolute grounds and relative grounds. If examiners discover prior trademark registration where the trademark and the designated goods/services are identical/similar to those of the trademark application under the examination, the examiner shall issue an official notice of provisional refusal to the applicant. It is possible to file a response to the provisional refusal within a period designated by the examiner.

(1) Similarity of trademarks

The similarity of trademarks shall be examined in terms of visual, phonetic, and semantic similarity



Kazutaka Otsuka

“The amended Japanese Trademark Act will be implemented within a period not exceeding one year from the promulgation date, namely June 14, 2023.”

between the trademark under examination and prior trademarks. It should be noted that if JPO examiners consider the trademarks confusingly similar in one of the aforementioned aspects, each trademark as a whole may also be considered similar, unless there is a significant difference in the other two aspects. For example, if the trademark under examination is considered phonetically similar to the prior trademark by the examiner and the provisional refusal is issued in connection with this, the applicant has to convince the examiner that there are significant differences in visual and semantic aspects of the trademarks to overcome the relative grounds objection.

If the relevant trademark consists of alphabetical characters, the phonetic similarity in relation to the prior trademark(s) is not necessarily examined based on the sound corresponding to

Résumé

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the pronunciation of native speakers of the non-Japanese language, but usually based on the sound recognized by the average consumers of the related goods/services fields in Japan. This applies to trademark examination of semantic similarity, too.

Reference examples of Appeal Board Decisions

- A. The trademark, namely "AMBERTEC" was considered confusingly similar to the prior trademark "AMPERTEC" due to the phonetic similarity of these trademarks. [Trademark Appeal No.2021-5917]
- B. The trademark "MONTAGNE" was considered confusingly similar to the prior trademark "MONTAIGNE" due to the visual and phonetic similarity of these trademarks. [Trademark Opposition No. 2017-900126]

(2) Similarity of goods/services

Similarity of goods/services is practically examined based on the sub-class system in Japan called similar group code. In cases where the goods/services designated for the trademark application under examination and those of the prior trademark registration are classified in the same similar group code, the goods/services shall be considered similar to each other in principle under examination. Specifically, if the goods/services to be compared are classified in similar group codes with at least one common similar group code, then the goods/services shall be considered similar in trademark examination in principle. In that case, it is difficult to convince the examiner that such goods/services are not similar.

Reference examples of Appeal Board Decisions

The following pair of goods were considered similar in the appeal board decisions.

Trademark Appeal No. 2015-8867
The following goods were considered as similar goods.
Class 14 "personal ornaments [jewelry]" (similar group code: 21A02 21B01)
Class 26 "insignias for wear, not of precious metal" (similar group code: 21A02)

Trademark Appeal No. 2021-17127
The following services were considered as similar services.
Class 41 "online game services" (similar group code: 41K01 41Z99)
Class 41 "providing amusement facilities" (similar group code: 41K01)

Trademark Appeal No. 2012-16957
The following goods and services were considered similar to each other.

The similarity of trademarks shall be examined in terms of visual, phonetic, and semantic similarity between the trademark under examination and prior trademarks.

Class 33 "sparkling wines" (similar group code: 28A02)
Class 35 "retail services or wholesale services for liquor" (similar group code: 28A01 28A02 28A03 28A04 35K03)

2. The possible means to respond to the relative grounds objections under the current regulation and practice

Trademark practitioners often consider the following means to respond to relative grounds objections, depending on cited trademarks, under the current regulation and practice.

- (1) Filing an argument against similarity of trademarks;
- (2) Filing an argument against similarity of goods/services usually limiting the relevant goods/services;
- (3) Filing an argument that cites the trademark owner as substantially recognized to be under control of the applicant (e.g., wholly owned subsidiary of the applicant) with supportive evidence thereof;
- (4) Requesting a cancellation trial against the cited trademark registration, e.g., for non-use of the registered trademark for more than three consecutive years;
- (5) Negotiating with the cited trademark owner for waiver or assignment (wholly or partially) of cited trademark registration;
- (6) Negotiating with the cited trademark owner for trademark coexistence by means of the so-called assignment and re-assignment strategy that is to temporarily assign the trademark application to the cited trademark owner and reassign the application from the cited trademark owner to the original applicant as soon as the relative grounds objection has been withdrawn by the examiner.

Merely filing a letter of consent issued by the cited trademark owner or trademark coexistence agreement between the parties concerned is not sufficient to overcome the relative grounds objection under the current trademark regulation and practice, and therefore, the above means (6) [assignment and re-assignment strategy] is substantially utilized as an alternative means of letter of consent in Japan.

3. The additional possible means becoming available under the amended Japanese Trademark Act

The Japanese Trademark Act was amended in 2023 to include the establishment of the additional

means to respond to the relative grounds objection that is a "letter of consent" for trademark registration as mentioned above. The amended Japanese Trademark Act will be implemented within a period not exceeding one year from the promulgation date, namely June 14, 2023.

The new provision regarding the letter of consent system will be stipulated in Article 4(4) of the amended Trademark Act. However, even with the consent of the cited trademark owner under the amended Trademark Act, if there is still a likelihood of confusion about the origin of goods/services between the objected trademark under examination and the cited trademark, the new trademark will not be granted registration.

Article 4(4) of the Trademark Act (to be newly stipulated in the amended Trademark Act):

"Article 4(1)(xi) [i.e. the section of the relative grounds objection] of the Trademark Law shall not apply to a trademark falling under Article 4(1)(xi) of this Act where the registrant of the trademark has obtained the consent of another person [i.e. cited trademark owner] under the said section to register the trademark and there is no likelihood of confusion between the goods or services in which the trademark is used and the goods or services pertaining to the business of the holder of trademark right, exclusive right to use or non-exclusive right to use of the registered trademark of the other person under the said item."

That is to say, the letter of consent system in Japan will be accepted conditionally. In the examination process, it is confirmed that there is no risk of source confusion, and after registration, the interests of consumers are protected by making it possible to request an indication to prevent confusion (Article 24-4(1)(i) of the amended Trademark Law) or request a trial for cancellation of unauthorized use (Article 52-2 of the amended Trademark Law). If a letter of consent is substantially taken into consideration to grant registration of the trademark, such information will be recorded on the Japanese database (called J-PlatPat, an official digital library for patents, utility models, designs, and trademarks) for easy reference to third parties. With respect to a trademark registered under the consent system, the act of using the registered trademark without an unfair purpose is not treated as unfair competition (Article 19 (1) (iii) of the Unfair Competition Prevention Act).

Although the examination guideline is still

The letter of consent system in Japan will be accepted conditionally.

under preparation, the conference materials of the formal working group of the trademark examination guidelines show that the documentation equivalent to the following might be required and the factors below might be taken into consideration to apply the above Article 4(4):

- 1. Written agreement covering both (i) a document to clarify that both parties have agreed to the contents of the agreement and (ii) a written opinion that is a reasonable explanation to clarify in what sense the agreement will reduce the likelihood of confusion.
- 2. A written statement confirming the specific use of both trademarks. Specifically, a written statement indicating the constituent elements of the trademark, method of use of the trademark, goods, etc. in which the trademark is used, method of sale and provision, season of sale/provision, geographical area of sale/provision.

The following items (1) to (8) are to be taken into consideration as a general rule, to determine whether there is a likelihood of confusion between the trademarks.

- (1) Degree of similarity between the applicant's trademark and the prior registered trademark;
- (2) The degree to which both trademarks are well-known;
- (3) Whether both trademarks consist of a coined word or have a distinctive feature in terms of composition;
- (4) Whether both trademarks are house marks;
- (5) Whether the enterprise has the potential to diversify its business;
- (6) Relevance between goods, between services, or between goods and services;
- (7) Commonality of consumers of the goods, etc.;
- (8) The use of both trademarks.

4. Practical thoughts

Considering that the letter of consent system in Japan will be accepted conditionally, it is conceivable to make oneself available to consider both the "letter of consent" and "assignment and re-assignment strategy" for trademark coexistence for a while after the implementation of the amended Trademark Act.

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Self-regulation in trademark matters: Trademark Coexistence Agreements and Letters of Consent

Ángel Ojeda, associate at Uhthoff, Gomez Vega & Uhthoff, S.C., details the available agreements for the protection and parallel use of similar trademarks without infringement in Mexico.

"The only way that the law has to protect and provide protection to each and every one of the social relationships that have legal interest is by recognizing the subjects of law their initiative so that they can regulate their own relationships, this is what is called the autonomy of private will".¹

"The principle of autonomy of will not only recognizes the individual as the principal subject of all public order and his freedom in the sphere of his personal sphere; in a stricter sense, it is understood as that power that is recognized to the individual



Ángel Ojeda

to establish the rules and norms that are to govern in that sphere of his private domain. This juridical power or power of autonomy is, therefore, an authentic normative power to which the legal system can grant full juridical efficacy, like that which juridical norms deriving from other sources can have".²

The previously mentioned quotations make mention of a principle of utmost importance for the free development of the personality of the subjects regulated by a national normative system. In other words, the principle of the autonomy of the will recognizes the power and faculty that human beings have to decide the acts that will generate direct legal consequences in its sphere of rights, whether these rights are of a personal nature, such as the proper name, or rights of an economic nature, such as the assets related to industrial property.

Now, and for the matter at hand, it is necessary to mention that the industrial property system in any country seeks, mainly, the protection of the following:

- a) Industrial property rights of individuals.
- b) The protection of potential consumers in a given territory.

The above-mentioned points are of utmost relevance for the development of this article since there are situations where both points may be adjacent and not properly adapted to specifically exist at the same time.

In this sense, and before starting with the specific object of this article, it is of utmost importance to point out that the most widely accepted understanding of the scope of intellectual property is divided into two aspects:

- a) Author rights and;
- b) Industrial property.

Likewise, industrial property protection can be divided into two areas:

- a) Rights over inventions (patents) and;
- b) Rights regarding distinctive signs.

For the purposes of a better understanding of this article, we will refer to the rights in distinctive signs as rights over trademarks.

Now, what can we understand as trademark rights?

On the previously mentioned point, it is necessary to begin by understanding what the main object is and the scope of protection of establishing such.

In this sense, I would like to start by explaining what can be considered as a trademark:

"What is a trademark? A trademark is a sign that makes it possible to differentiate the goods or services of one company from those of another. Trademarks are protected by intellectual property (IP) rights."³

"Trademark means a sign or a combination of signs that differentiates the goods or services of one company from those of others.

These signs can be words, letters, numbers, pictures, shapes and colors or a combination thereof. In addition, more and more countries are authorizing the registration of less traditional forms of trademarks, such as three-dimensional signs (like the Coca-Cola bottle or the Toblerone chocolate bar), sound signs (sounds like the lion's roar at the beginning of the movies produced by MGM), or olfactory signs (like the smell of a particular type of motor oil or embroidery thread). However, in a large number of countries limits have been set as to what can be registered as a trademark, namely, generally only signs that can be visually perceptible or can be represented by graphic means.

Trademarks are used for goods or in connection with the marketing of a goods or services"⁴

What happens if the owner or priority applicant states that it would not have any problem with the registration of a new trademark?



Moreover, and as the author of this article is an operator of the trademark protection system in Mexico, I would like to share what our special legislation on this matter defines as a trademark:

"FEDERAL LAW FOR THE PROTECTION OF INDUSTRIAL PROPERTY. Article 171.- A trademark is understood to be any sign perceptible by the senses and capable of being represented in a way that makes it possible to determine the clear and precise object of protection, which distinguishes products or services from others of the same kind or class in the market".

In accordance with the above, we can conclude that a trademark is comprised of the following three elements:

- a) A sign perceptible by the senses;
- b) A sign capable of being represented in such a way as to make it possible to determine the clear and precise object of protection;
- c) A sign that differentiates or distinguishes goods or services in the market.

Now then, how do these comments regarding trademark matters relate to what was mentioned at the beginning of this article, specifically the notion of the autonomy of the will for the regulation of legal acts?

As previously indicated, one of the objectives of the Industrial Property protection system is the protection of potential consumers in a local market. In this sense, one of the purposes of many national Industrial Property Offices, specifically in relation to trademark matters, is to avoid the granting of rights that represent: (i) a prejudice to holders or priority applicants of trademark applications (protection to the individual) and; (ii) the prevention of deception of potential consumers in a local market, as a consequence of the granting of registration of trademarks that are identical or confusingly similar to trademarks previously registered or applied for as a priority.

In this sense, and to reinforce the second point mentioned in the preceding paragraph, National Intellectual Property Offices seek to avoid the existence of trademarks that may create deception in potential consumers in the trademark system of a given territory, either by believing that the trademark has the same business origin (direct confusion) or by thinking that there is some kind of relationship between the interested parties, i.e.: the current owner and the third party applicant for a new trademark, when in reality there is none (indirect confusion).

Thus, and in order to exemplify the mentioned situation, if the author of this article files an

Résumé

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Ángel is an attorney graduated from the Universidad Central de Venezuela ("UCV"), student of the Specialization in Intellectual Property taught by the Universidad de los Andes ("ULA"), student of the Master's Degree in Industrial Property, Copyright and New Technologies of the Universidad Panamericana ("UP"), and accredited to practice the legal profession in Mexico through a resolution issued by the Secretary of Public Education.

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application for the registration of a trademark named PUMA or SUPER PUMA, for the protection and future commercialization of sports shoes, before the Mexican Institute of Industrial Property (IMPI), the office specialized in Industrial Property matters in Mexico, such office would deny this application *ex-officio* on the following grounds:

- 1) The trademark is identical (PUMA) or confusingly similar (SUPER PUMA) to the mark created by Rudolf Dassler;
- 2) That, as a consequence of the aforementioned identity or similarity, potential local consumers will be deceived.

Now, in relation to trademark owners and priority trademark applicants, we must ask ourselves, what would be the conduct to follow when observing an act such as the one mentioned in the preceding paragraph?

Mainly, most of the worldwide industrial property regulations establish the figure of trademark opposition, which, in simple words, is the action of the current owner of a trademark, or the priority applicant thereof, to assist the study carried out by a National Industrial Property Office, by means of the manifestation of request to the refusal of the registration of the new trademark. In summary, by means of the aforementioned manifestation, it is indicated to the National Industrial Property Office that the new trademark: (1) would represent a prejudice to the rights of the current owner or of the priority applicant and; (2) would also represent a prejudice for potential consumers, in view that the existence of the new trademark would result in the latter being confused and obtaining a good or service believing, erroneously, that it has a respective business origin.

However, and now entering into the main subject of this article, what happens if the owner or priority applicant states that it *would not have any problem* with the registration of a new trademark?

In this instance, we would enter into a Trademark Coexistence Agreement or issue Letters of Consent. The first mentioned are agreements through which a holder of trademark registration, or a priority applicant, agrees a number of guidelines with the applicant of a new trademark so that the two trademarks can coexist at the registration and commercial level; the second mentioned are composed of a manifestation of the holder of the trademark registration, or priority applicant, usually in writing, of not having any inconvenience in the granting of the new trademark and/or the use of the same in the commerce.

Hence, and continuing with the idea of the autonomy of the will of the parties, including the initiative to self-regulate relations, the acts would

“ **A holder of trademark registration, or a priority applicant, agrees a number of guidelines with the applicant of a new trademark so that the two trademarks can coexist at the registration and commercial level.** ”

be the embodiment of the decision of the parties to express to National Industrial Property Offices that there is no problem whatsoever with a new trademark application, which may be identical or confusingly similar, be granted.

The worldwide trend is to give greater validity to the referred acts, in view of the fact that the legitimate holder of the industrial property right expressly indicates that they do not consider, for various reasons, that the new right will affect the respective interests.

In this regard, and to exemplify the above, I would like to mention the Mexican experience and the current situation in the Andean Community.

Mexico did not consider, at a legal stage, these types of acts and the national office (IMPI) did not consider them as binding. Nevertheless, in 2018, a series of accepted reforms to the Industrial Property Law of 1991, a previously normative body in Mexico, entered into force and one of these reforms was the inclusion of the following paragraph in the article that regulates what could not be registrable as a trademark:

“INDUSTRIAL PROPERTY LAW. Article 90.- The following shall not be registrable as trademarks:

The provisions of sections XVIII, IXI and XX shall not be applicable with respect to confusingly similar trademarks of this article, when express written consent is exhibited, in accordance with the regulations of this Law.”

Section XVIII related to the identity and likeness of trademarks.

Likewise, and in relation to the current situation in Mexico, in the year 2020 a new specialized legislation on industrial property came into force, the Federal Law for the Protection of Industrial Property, which includes the following section:

“Article 173.- The following shall not be registrable as a trademark:

The provisions of sections XVIII, XIX and XX of this article shall not be applicable with respect to similar trademarks to a degree of confusion or identical, to similar products or services, when express and written consent is exhibited, in terms of the Regulations to this Law.”

In this sense, the trend in Mexico is to broaden the spectrum to validate private regulations established by individuals, since Coexistence

Agreements and Letters of Consent are now binding. Likewise, and as irrefutable proof of the new trend, the current situation includes the regulation for cases of identical trademarks as well; a situation that was not regulated in our previous body of law.

Regarding the Andean Community, of which Colombia, Ecuador, Peru, and Bolivia are members, we can observe in the Common Regime of Industrial Property, better known as Decision 486, which is the normative body that regulates the community in reference, the following:

“Article 159.- When in the Subregion there are registrations of an identical or similar trademark in the name of different owners to distinguish the same goods or services, the marketing of the goods or services identified with that trademark in the territory of the respective Member Country shall be prohibited, unless the owners of such trademarks enter into agreements permitting such marketing.

In the event of such agreements, the parties shall adopt the necessary provisions to avoid confusion of the public as to the origin of the goods or services in question, including those relating to the identification of the origin of the goods or services in question in prominent characters proportionate thereto for the due information of consumers. Such agreements shall be registered with the competent national offices and shall comply with the rules on commercial practices and the promotion of competition.”

It is observed that there is a regulation that addresses the issue of the voluntary decision of the parties for the scenario of the existence of identical or confusingly similar trademarks.

Now, what about the second scenario that National Offices must follow, specifically related to consumer protection in a local market?

As previously mentioned, part of the work of the specialized Industrial Property offices is to prevent consumers in a given market from being deceived as a consequence of the existence of trademarks identical or confusingly similar. In this sense, it is absolutely plausible that cases may occur where the two previously mentioned situations collided, in view that a trademark holder, or priority applicant, may indicate that there is no problem in the coexistence of two trademarks, but the National Industrial Property Office could consider that the possibility of deception of the consumer may occur.



“ **The legitimate holder of the industrial property right expressly indicates that they do not consider, for various reasons, that the new right will affect the respective interests.** ”

In the author's opinion, and without leaving aside the obligation to safeguard consumers, I consider that National Industrial Property Offices should determine that, under the current market parameters, where globalization and access to effective information allow knowing the specific conditions of a trademark and the respective product or service, the corresponding offices should grant the registration of new trademarks when the subject that has the prior right states that it has no problem with the granting of the new application.

It is perfectly understandable that National Industrial Property Offices maintain the position of safeguarding the consumer. However, and by performing the same exercise as the corresponding offices, when they put themselves in the consumer's shoes, we must understand that nowadays, due to the various information tools that exist, it is much more unlikely that consumers will be deceived.

Likewise, the National Industrial Property Offices, when carrying out the exercise of trying to think like consumers, must grant such consumers a certain degree of reasoning and intelligence, and must therefore determine that it will not necessarily incur deception when observing two respective trademarks. On this point, I would like to share the following criterion issued by the Third Chamber of the Court of First Instance of the European Union:

“It must be admitted that the average Austrian consumer will consider it normal and therefore expect that wines, on the one hand, and beers, Ale and Porter, on the other, come from different companies and that such beverages do not belong to the same family of alcoholic beverages. There is nothing to suggest that the Austrian public will not

be aware of and will not appreciate the characteristics which distinguish wine from beer as regards their composition and method of production. On the contrary, the Court of First Instance considers that those differences are perceived in such a way as to make it unlikely that the same undertaking would simultaneously manufacture and market the two types of beverages. Furthermore, the Court of First Instance points out that it is common ground that, in Austria, there is a tradition of production of both beer and wine by separate undertakings. Consequently, the average Austrian consumer expects beer, Ale and Porter, on the one hand, and wine, on the other, to come from different undertakings.”⁵

The aforementioned criterion was issued in relation to two trademarks, one to protect beer and the other to protect wine, which were considered to cause possible confusion at the first stage; however, and when performing a correct exercise in relation to potential consumers, the reality of the respective consumers was considered in order to perfectly establish that

“
**In
conclusion,
in the end,
the decision
must be
theirs.**”

such consumers could differentiate a trademark that commercializes wines and one that commercializes beers.

In this sense, and performing the same exercise of reasoning that National Industrial Property Offices performs to determine the behavior of consumers, it is perfectly conclusive that said offices can determine that the consumer will not be confused and that two trademarks, in which their owners have decided their coexistence, can perfectly coexist in a territory.

In conclusion, in the end, the decision must be theirs.

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⁵ ST T-175/06 June 18, 2008

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Navigating the turbulent waters of position mark registration in Brazil

Luzia Souza, Attorney at Law at Vaz e Dias Advogados & Associados, reviews the regulation, BTO's approach, problems, and possible solutions regarding position marks by drawing on case examples.

In the dynamic landscape of Industrial Property and trademark protection in Brazil, the advent of position marks registration under Regulation no. 37/2021, issued by the Brazilian Trademark Office (BTO) on September 13, 2021, has signaled a significant revolution in Brazilian IP Law. This type of protection, available 25 years after the enactment of Federal Law no. 9.279 of 1996 (IP Law), fills a gap in the local laws for non-traditional marks, expands the options for brand presentation, and protects companys' goodwill derived from such signs named as "position marks".

While this legal innovation promises to strengthen brand protection, it also unravels challenges for the BTO to address this new type of sign to identify products and services in the local market. This article points out the current requirements for the protection of position marks and highlights the existing problems related to this change, since over 350 applications so far encountered at the BTO only one has been granted. Further to that, registration for the renowned position marks related to the sole of the Louboutin shoes has been unexpectedly rejected, which has raised concerns to the examination rules of position marks. Therefore, this article invites readers to explore the require-



Luzia Souza

ments for the safeguarding of position marks and the existing obstacles, which may assist businessmen in redefining their defensive strategies when seeking such type of protection in Brazil.

Criteria for the Position Trademark Protection in Brazil

The BTO has taken significant steps to enhance the protection of position mark. Among them is the possibility to modify the presentation of applications submitted before October 2021 and converting them from, for example, 3D or figurative marks into position mark. This flexibility was granted for applications under review and compliant with the established standards for position marks. Interested parties had a 90-day window, starting from the effective date of Regulation No. 37/2021, to formally request alterations to their submissions.

This step by the agency evidenced the importance of the position mark as a new registration and proprietary rights duly recognized in the Brazilian market. Before September 2021 many market-leading companies commonly resorted to registering figurative marks to protect their position marks. This was because position marks were a non-traditional trademark not accepted as proprietary rights. A notable example involves the sports brand Adidas AG, which obtained registrations for figurative marks, not as a position mark, by adding three lateral stripes on its sportswear products, as seen in figure 1.

Therefore, before the introduction of position mark regulations, holders encountered challenges in obtaining registration for their signs as position marks, often resorting to costly judicial procedures due to the lack of a clear ownership title. The registration extension to position marks and the implementation of regulations simplified the recognition of this type of mark by the BTO,

Type	Registration No.	Mark	Owner	Class
F	811809960		ADIDAS AG (DE)	25/10.20
F	823362604		ADIDAS AG (DE)	Ncl(7) 25
F	823362612		ADIDAS AG (DE)	Ncl(7) 25
F	826054978		ADIDAS AG (DE)	Ncl(8) 25
F	830283099		ADIDAS AG (DE)	Ncl(9) 18
F	911067310		ADIDAS AG (DE)	Ncl(10) 25

Figure 1

introducing an administrative process that now provides a level of security that was previously unavailable.

The new protection was further incorporated into the BTO's Trademarks Manual through Regulation BTO/PR No. 08 of 2022. The requirements and procedures are outlined in Technical Note BTO/CPAPD No. 02/2021, currently governed by Regulation BTO/PR No. 08/22, which, in its article 84 stipulates the following:

"Article 84. The distinct ensemble capable of identifying products or services and distinguishing them from others that are identical, similar, or related will be registrable as a position mark, provided that:

- I. it is formed by the application of a sign in a singular and specific position on a given support; and
- II. the application of the sign in said position on the support can be dissociated from technical or functional effects.

Sole Paragraph. Failure to meet the provisions of the main text will result in the rejection of the request as a position mark."

The criteria for registering position marks can be summarized under Technical Note BTO/CPAPD No. 02/2021, as follows:

- A position mark is registerable if it can identify products or services and

“The BTO acknowledged this configuration as a position mark and granted the registration, deeming it distinctive in identifying the sneaker in the market since no similar marks were found in previous searches.”

distinguish them from others that are similar;

- To be registered as a position mark, the mark must consist of applying a sign in a singular and specific position on a particular support;
- The application of this sign in the support's position must not have a technical or functional effect;
- The position mark should be visually perceptible and can include elements such as words, letters, numbers, ideograms, holograms, symbols, drawings, images, figures, colors, patterns, and shapes, provided they are not prohibited by the law;
- Each element of the position mark (sign, support, and position) does not have separate protection unless there is another form of protection;
- The registration request must include a graphic representation that displays the support, the exact positioning, and the proportion of the applied sign;
- The sign should be indicated by continuous lines or filled areas, while the support should be represented by dotted or dashed lines;
- The regulation requires a textual description of the mark to define the desired protection;
- Distinctiveness is crucial in the examination of position marks. The application of the sign on the support must create a distinctive ensemble

Résumé

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and be recognized as a mark by the consuming public. The focus lies in the resulting ensemble of the sign on the support to which it is affixed, not solely in the distinctiveness of the sign itself;

Currently undergoing evaluation: position trademark applications

Until October 31, 2023, the BTO system recorded a total of 351 position marks. However, only one of these position marks has been granted so far by the BTO. This is the position mark registered in class 25 to identify sneakers, which occurred last May 30. This mark belongs to the local company TERRAS DE AVENTURA INDUSTRIA DE ARTIGOS ESPORTIVOS S.A. and it is featured in figure 2.



Figure 2: Position Mark – Registration No. 830621660

To obtain the registration of position mark, the local owner requested a change from the three-dimensional mark to a position mark, thereby removing the name element and the crown design on the sneaker, as originally filed. Therefore, the local owner presented a support object with sequence of three identical eyelets, in which the middle eyelet maintains the same distance from the one on its right and the one on its left. The trio of eyelets is intended for application on the upper part of a sneaker, specifically in the area between the toe and the tongue (covered by the laces) of the product, as detailed in figure 3.

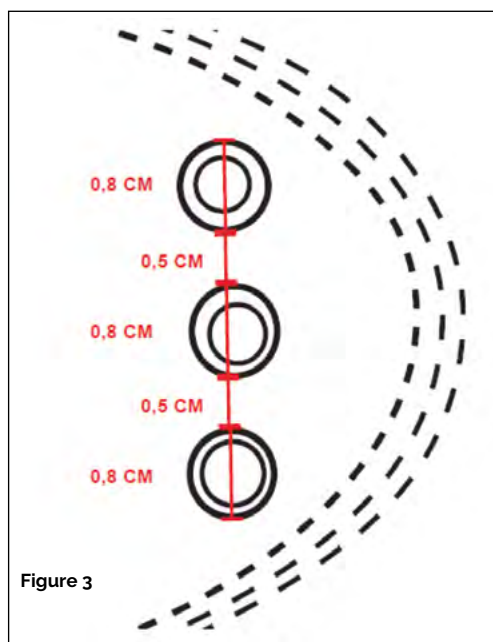


Figure 3

“It will not be registered as a position mark if the symbol is applied in a non-singular position.”

The BTO acknowledged this configuration as a position mark and granted the registration, deeming it distinctive in identifying the sneaker in the market since no similar marks were found in previous searches.

Further to that, there is no legal hindrance to use a previously registered mark as part of the distinctive set of a position mark. For instance, Grendene's "Ipanema", one of the most well-known and consumed Brazilian flip-flop nationally and internationally, mark is registered at the BTO as a composite mark. The mark owner – GRENDENE S/A. – also requested the protection as a position mark. The rejection of the registration as a position mark was due to the location's brand dilution by competitors, not by the existing composite mark registration. Thus, it is important to note that the prior registration of a mark does not automatically transfer distinctiveness to the new position mark, as distinctiveness must be evaluated based on the unique placement of the symbol on the support and the consumers' perception of this new set of marks.

In the application for a position mark, it is essential to precisely identify the specific position where the symbol is applied, and it cannot be formed by applying one or more signs in different positions. It will also not be registered as a position mark when the applicant fails to properly identify the proportion of the symbol in relation to its support, i.e., the applicant must provide accurate details about the size and scale of the symbol concerning its support.

Further, it will not be registered as a position mark if the symbol is applied in a non-singular position, meaning a location customarily used for displaying signs, considering the analysis of the requested product or service.

These rules aim to prevent the legal protection of a position mark from covering trade dress when the applicant attempts to register a symbol that spans more than one position or the entirety of the support, as illustrated in the examples of gas stations and aircraft indicated in items 18 and 19 of Technical Note BTO/CPAPD No. 02 of 2021, as shown in figure 4.

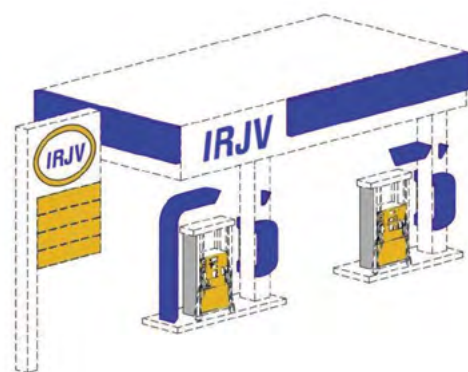


Figure 4: To identify the "commerce of fuel"

The first example involves the application of a company's visual identity in a commercial establishment, characterized by the application of various signs in more than one position on the support, making it impossible to identify the specific position where the signs are applied. (Figure 5)



Figure 5: To identify "airline service"

The second example entails applying the visual identity of an airline to an aircraft, involving the application of a symbol in a proportion that precludes the identification of a specific position.

In these cases, the BTO rejected the applications based on Article 122 of the IP Law combined with the sole paragraph of Article 84 of Regulation BTO/PR No. 8/2022.

As one may see, an adequate study of the rejected applications for position marks helps identify the best procedure to be adopted when seeking a position mark registration.

Even though rejected applications lead the way for best practice on seeking position mark protection, the BTO has drawn attention to the effective examination of such types of marks. Accordingly, the red sole of Christian Louboutin's high-heeled shoes, the renowned French luxury brand, was rejected. This application No. 901514225 was filed by CHRISTIAN LOUBOUTIN on March 13, 2009, in Class 25 (footwear) and was later adjusted to be considered a position mark. This request aimed to protect a specific coloration (Pantone Red) on the entire sole of a woman's high-heeled shoe, excluding the area corresponding to the heel, as shown in figure 6.



Figure 6

While reviewing the application as a position mark, the registration refusal (Official Gazette No. 2734 of May 30, 2023) was based on Articles 122 and 124, item VIII, of the Brazilian IP Law and the sole paragraph of Article 84 of the BTO's Regulation no. 8/2022. The decision highlighted

“The regulation of position marks in Brazil is of benefit to the luxury and fashion industries by safeguarding exclusive visual elements like shoe soles and clothing details, reinforcing the authenticity of creations.”

the fact that the protection focused on the isolated color (Pantone Red). Therefore, the sign would lack distinctiveness, falling within the legal prohibition of Article 124, VIII, of the IP Law, which prohibits the registration of color marks and their denominations that are not displayed or combined in a peculiar and distinctive manner.

The company licensing Louboutin's IP portfolio has filed a lawsuit at the Federal Court against the rejected BTO's decision and the court suit was submitted before the 13th Federal Court in the city of Rio de Janeiro under number No. 5082257-22.2023.4.02.5101/RJ. One of the plaintiff's requests was the preliminary injunction to suspend the BTO's decision, which was granted by Justice Marcia Maria Nunes de Barros on August 10, 2023. This indicates the willingness of the federal courts to conduct a comprehensive analysis of issues related to intellectual property and take into consideration the importance of protecting non-traditional marks and aligns with the growing trend of consumers considering these non-conventional marks as authentic sources of identification and origin.

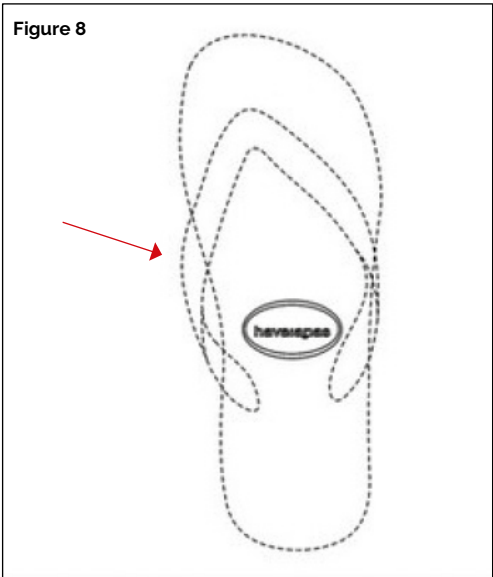


Figure 7





Indeed, it is widely recognized that the designer Christian Louboutin popularized throughout the world market of haute couture the use of the red color in high-heeled shoe soles, making it a distinctive part of his brand identity. While it might be impossible to assert that Louboutin was the pioneer in this practice, his consistency over the years and the association with glamour, luxury, and elegance have made his products desirable and recognizable to the consumer public. The



Further to that, the BTO's movement towards position marks aligns the Brazilian economy with international trends in recognizing non-traditional marks.



ability to distinguish his high-heeled shoe in the market is apparent through documented evidence and online research.

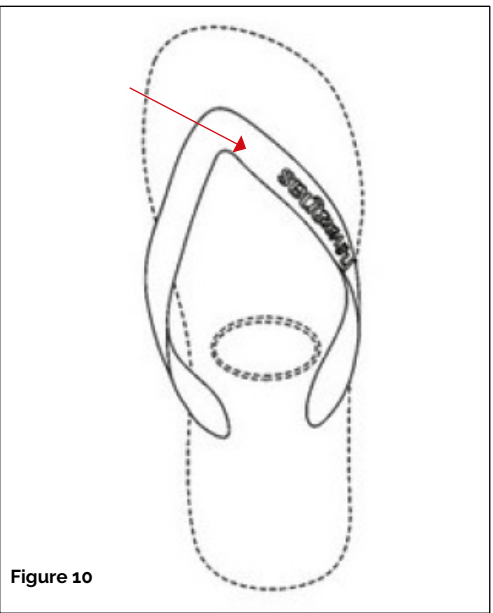
Another dismissed position mark request (Official Gazette no. 2749, dated September 12, 2023) worth mentioning as guidance refers to the famous flip-flop's mark "Ipanema" filed under no. 925160890 in the name of Grendene S.A. The BTO examiner concluded that the requirement for the mark's position on the support, as outlined in BTO/PR n° 8/2022 and item 5.13.2 of the Marks Manual, was not met. The BTO's examiners found that the position in which said signal is applied to the support has been commonly used by competitors. Examples of other flip-flops presenting brand signals on the rear part of their insoles were found – sometimes arranged in the same vertical manner depicted in the "Ipanema" mark request under examination (see Figure 7).

Another denied position mark application involves the famous 'Havaianas' flip-flops, owned by Alpargatas S.A. Both position mark requests filed under no. 906025281 and 906025397 were rejected by the BTO (Official Gazette no. 2733, dated May 23, 2023).

The first application no 906025281 concerning the 'Havaianas' mark in a horizontal elliptical frame applied to the flip-flop's central insole, as depicted in the figure 8, was dismissed due to the lack of uniqueness in the assessed position, according to market practices.

In this case, the BTO's examiners found that the position of the mark was conventional and commonplace, as the competition was using that position to display their distinct marks on the product, as demonstrated in figure 9.

From this rejected decision, the local company Alpargatas S.A. filed an administrative appeal alleging overly restrictive interpretation by the BTO and the distinctiveness of the "Havaianas" sign,



previously recognized several times by the BTO when granting trademark registrations for this sign in various forms. More recently, in an amendment to the appeal petition, Alpargatas S.A. sought the application of the "telle quelle" principle, from Article 6 quinquies of the Paris Convention, as it holds several registrations for this position mark granted abroad. The administrative appeal is still pending at the BTO.

Regarding application no 906025397, Alpargatas S.A. applied for the 'Havaianas' position mark in the word form positioned on one of the straps of the sandal or flip-flop, in figure 10.

The BTO's rejection was due to the lack of recognition of the position in which the sign was affixed on the support as singular, considering it to be a position commonly used by competitors in the market to identify their distinctive signs on the same product, as shown in figure 11.

From this decision, no administrative appeal was filed by Alpargatas S.A.

Changes and future perspectives
An aspect worthy of note - and of interest regarding the evaluation criteria adopted by BTO - is related to the fact that, in various other jurisdictions, such as in Europe and the United States, position marks require evidence of 'secondary meaning' for recognition.

This is crucial for the advancement of intellectual property in Brazil and its alignment with global standards.

Although this phenomenon is acknowledged in Brazilian case law and doctrine, it is not outlined in the local IP Law and therefore not applied by BTO in the assessment of trademark registration requests in general. Given that the BTO will not examine 'secondary meaning' in the context of position marks, it is possible that only a few position marks might be registered by the agency.

The regulation of position marks in Brazil is of benefit to the luxury and fashion industries by safeguarding exclusive visual elements like shoe soles and clothing details, reinforcing the authenticity of creations. Furthermore, it stimulates innovation, enabling the exploration of new designs and materials, fostering creativity and healthy competition in the fashion industry.

Conclusion and impacts of regulations
The regulation of position marks in Brazil stands as a notable advancement in the country's industrial property sphere. It provides enhanced legal protection for the holders of these marks, preventing misuse and market confusion, benefiting consumers. Furthermore, by distinguishing products in an increasingly competitive market, the regulation offers companies the opportunity to add value and authenticity to their creations.

This movement not only demonstrates BTO's willingness to adapt to global changes and meet industry professionals' demands but also means a significant step in modernizing the agency and keeping their services of quality to meet the market needs. Further to that, the BTO's movement towards position marks aligns the Brazilian economy with international trends in recognizing non-traditional marks. This is crucial for the advancement of intellectual property in Brazil and its alignment with global standards.

However, the BTO's decision on the red sole of Christian Louboutin's high-heeled shoes has been regarded as a setback and an alert to the effective protection granted by the BTO to position marks.

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The protection of olfactive marks in Mexico

Carlos Alberto Reyes of OLIVARES analyzes the application and grant process of scent marks to provide guidance on best practices for successful protection in Mexico.

Before the modifications to the Mexican Industrial Property Law (the IP Law) on May 18, 2018, the article 88 of this Law defined a mark as being a “visible sign” capable to distinguish products or services from others of the same type or category on the market. Thus, to be subject of protection as a mark, a sign had to be both distinctive and *visually perceptible*.

As we know, this definition of mark excludes from protection all non-visible signs, and the article following the mentioned above, article 89, confirm this by listing some visually perceptible signs as the ones that could constitute marks and receive protection through a mark registration, *namely*, words and visible figures, three-dimensional shapes, trade names and company or business names, and the proper name of a natural person.

The modifications of the Mexican Industrial Property Law of May 18, 2018, in force since August 10, 2018, modified this mark’s definition in article 88, determining that a mark is a distinctive sign capable to be perceived by the senses and susceptible to be represented “*in a way that shall clearly determine the object of the protection*”, which opened the way, for the first time in Mexico, to obtain protection as mark for signs that may be perceived by senses other than the sight (the so-called non-visible signs).

In agreement with this new definition of mark, the article 89 of the IP Law was also modified to list some non-visible signs that could now constitute marks, and expressly included “sounds” and “odors”. It is important to mention that this regulation was identical in our 2020’s Industrial Property Law, the so-called Federal Law for the Industrial Property Protection (hereinafter the Federal IP Law), in its articles 171 and 172.

However, no provision in the Federal IP Law, nor any later regulation, stated how to clearly define – namely, with precision and clarity – the subject matter of protection in a mark application for an olfactive mark. However, this is a crucial matter in a marks protection: how to clearly



Carlos Alberto Reyes

“**But defining an odor is not an easy matter.**”

determine and delimit the scope of protection requested for these marks and, what is the scope of protection when the mark registration is granted.

This is very important because it allows any person consulting the marks Registry to clearly notice the granted mark’s scope of protection, in other words, what is exactly granted registration, and, at the same time, to know the very limits of the granted exclusive rights of use. On the other side, the clear definition of the right granted should allow any examiner or officer of the Industrial Property Office (the IP Office) to determine – as objectively as possible – the existence or not of likelihood of confusion with other olfactive marks and, when there might be infringement by thirds of the granted mark.

But defining an odor is not an easy matter, for example, in wine tasting, when smelling the same wine at the same time, some persons will identify berries and cannel while others will be sure of smelling citric fruit, marmalade, and odor cloves. We all know from our own experience that something that is perceived by smell can be identified or defined very differently and in as many ways as persons are smelling the same odor at the same time. Also, the smell of some simple natural products, for example, fruits, coffee, spices, can significantly vary not only depending on the time of production but also depending on the place they were produced or the way they were processed.

How could you then clearly define the object of the protection granted for an olfactive mark for registration purposes, and, after being registered, how could a third access the mark Registry and be sure of what was exactly the subject matter of protection through such mark registration. Additionally, how could an examiner of the IP Office objectively determine the existence of a likelihood of confusion or infringement? Or how could we feasibly argue against such likelihood of confusion or infringement presumption from an examiner of the IP Office?

In this regard, the possible proposed solutions for this problem are varied, and some of them have been discarded because a reliable solution for this problem of clearly defining the object of the protection in the case of olfactive marks has not been found. Moreover, we need to take into account that our Federal IP Law **clearly requires**, in its article 171, any sign perceptible by the senses be “**capable of being represented in such a way as to enable to determine the clear and specific subject-matter of the protection**” to qualify as a mark.

The first proposed solution we can mention is to deposit the chemical formula of the olfactive mark, but this is not a feasible solution as chemical formulas cannot be available other than for a specialist in chemistry and neither a third nor an IP Office mark examiner would be able to determine the specific subject-matter of the protection granted for an olfactive mark – when consulting the marks’ Registry – unless being also able to “read” a chemical formula, which is very unlikely.

The second proposed solution is to deposit a sample of the odor, but this is not a feasible solution either as the smells are not stable and durable and, as mentioned before, are also subject to interpretation. Finally, the third solution is to describe the mark in words, which is the one that has been adopted by the Mexican IP Office. In this regard, describing a smell in words can be quite easy, but, in my personal advice, it can

Résumé

Carlos Reyes joined OLIVARES in October 2008 and has more than 30 years of experience in Intellectual Property prosecution and IP litigation. His practice is now mainly focused on the areas of counseling and trademark registration. In summary, he provides counseling regarding trademark registrability bringing his experience on trademark prosecution and litigation, answering objections related to absolute and relative grounds of refusal, and preparing and filing trademark oppositions before the Mexican PTO (IMPI).

As Senior Attorney in the OLIVARES trademark team, he has helped to secure trademark protection in Mexico for several important trademarks, in particular relating to trademark distinctiveness and likelihood of confusion.

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How could an examiner of the IP Office objectively determine the existence of a likelihood of confusion or infringement?

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hardly represent the mark “in such a way as to enable to determine the clear and specific subject-matter of the protection”.

Thus, since the very beginning, when the modifications to the Industrial Property Law came in to force on August 10, 2018, the formal requirement for an olfactive mark application is then to include a description in words of the applied-for mark. Also, to this date, the Registry shows 125 olfactive mark applications, of which only 11 have been granted registration (four of them after a Court of Appeal ordered the Mexican IP Office to register the marks after a refusal was issued). In brief, the IP Office has constantly refused registration to olfactive mark applications mainly based on the following causes of refusal:

- When according to commercial practices the odor has become a usual or generic element of the products or services and, consequently, the odor cannot accomplish any distinctive function or be identified as from a particular origin by the consumer. Under these arguments, the IP Office has refused registration to those olfactive mark applications for odors that are commonly used in relation to the purported products or services. For example, an olfactive mark application for the odor of canella in relation to class 35 retail services was refused on the basis that it is usual and expected for odors to be added in commercial establishments to improve the shopping experience, persuading the consumers to stay longer and improve the sales.
- When the odor is considered descriptive of the purported products or services and, thus, the olfactive mark cannot accomplish any distinctive function. The cited refusal cause relates the signs that, when considered as a whole, are held to be descriptive of the goods or services they intend to distinguish. Under this provision, the Mexican IP Office has refused olfactive mark applications when the odor is considered an inherent attribute or natural characteristic of the products or services. In particular, the IP Office has constantly refused mark registration under this cause for fruit odors in relation to class 32 beverages, floral or fruit odors for class 03 fabric softeners, disinfecting, and cleaning products, mint or chocolate odors for class 28 toys and pet toys, fruit, and

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species odor in relation to class 05 electrolytes, to cite some examples. In all these cases, the IP Office estimates that certain odors are not registrable as olfactive marks when the purported products naturally have them or when the consumers expect them to have odors. Thus, when having an odor is not held to be identified in relation to a particular source because the odor is natural or inherent to the product, as in the case of fruit juices or beverages, or, as in the case of fabric softeners, or cleaning or disinfecting products, when the products are normally added odors.

- In some refusal decisions, the Mexican IP Office has also argued that the applied-for olfactive marks were considered confusingly similar to another olfactive mark, that was estimated as a well-known mark. These decisions concerned the odor of chewing gum applied to children's shoes and shows the limits of the protection granted to olfactive marks derived from a description in words. That is because, how could we define what a bubblegum odor is? Taking-into-account that bubblegum can have quite varied and different odors, depending on the flavor they have, or even for the same flavor, depending on the producer.

In respect thereof, we may consider that a mark described as the “odor of bubblegum applied to children's shoes” allows any person to “determine the clear and specific subject-matter of the protection”, but the commented decisions from the IP Office seem to contradict this conclusion.

Indeed, while it is not disputed that nobody thought in applying a “kind of bubblegum odor” to children's shoes, and that this new idea and the olfactive undisputed distinctive mark that derived from it – that we could even accept as highly distinctive or well known – we cannot be in agreement on the widest scope of protection that has been granted to it by the Mexican IP Office, the same that we consider derives from the limits of granting olfactive marks protection from a description of these marks in words.

That said, in the commented decisions, the IP Office has refused other olfactive mark applications for “children's shoes” described as “the odor of strawberry”, “the odor of mint”, “the odor of lemon”, “the odor of vanilla” or “the odor of chocolate”, on the basis of a presumed existence of a likelihood of confusion with said well-known

mark described as the “odor of bubblegum applied to children's shoes”, which led us to believe that for the IP Office any fruit or species or sweet food odor would be then considered as confusingly similar to such “bubblegum” olfactive mark.

In conclusion, while describing an olfactive mark in words can be considered a suitable and feasible solution for granting protection to these marks, it is very doubtful that a word description could determine clearly and specifically the subject matter of the protection granted, as demonstrated by the children's shoes bubblegum odor mark decisions.

On the other side, the owner of the well-known bubblegum odor mark felt the need to register the mark and to include a very specific description and later filed a mark application describing it as an “olfactive mark applied to footwear with a bubblegum scent of fruity and floral aromas, with accents of red fruits (raspberry, strawberry and cherry) and flashes of citrus fruits (bergamot, orange, pineapple and mango), some sweet notes of jasmine and violet and a subtle blend of vanilla, musk and

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doubtful that
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protection
granted.”

cinnamon”, which in my advice proves that it considered itself that “odor of bubblegum applied to children's shoes” was not sufficient to determine the clear and specific subject-matter of the protection.

Candidly speaking, we might consider requiring applicants of olfactive marks to combine a word description with samples and a chemical formula of the mark. The samples and chemical formula could be consulted if a more accurate definition of the scope of protection granted to the mark is required, when determining the likelihood of confusion or even in litigation matters.

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Prioritizing wellbeing in the IP profession

As we enter into a new year, Diane Silve, Director & Senior Trademark Counsel at Mondelez International, reminds us of the importance of creating and maintaining a repertoire of habits to ensure we are caring for our mental and physical wellbeing in a high-pressure profession.

When was the last time you checked in with yourself and answered, honestly, the question “How do I feel today?”

Wellbeing is not a “nice to have” topic, and the IP community needs to continue talking and caring about it. According to a 2020-21 study about wellbeing in the legal profession, released a couple of years back by the UK legal mental health charity LawCare, “the majority of participants (69%) had experienced mental ill-health in the 12 months before completing the survey,” and, “legal professionals are at a high risk of burnout”. IP professionals often manage a strong volume of complex matters with tight deadlines, for demanding (and stressed) clients, in competitive environments. IP professionals are also often high achiever individuals and, as such, are the most self-critical judges with strong self-expectations. All these elements combined, or not, with a busy personal life can impact wellbeing.

“Wellbeing” is defined as “(...) the state of being healthy, happy, or prosperous; physical, psychological, or moral welfare” (Oxford English Dictionary). Wellbeing is often understood as being formed by different pillars: mental wellbeing, physical wellbeing, financial and social wellbeing – we will not talk here about financial wellbeing. There are several cornerstones that IP professionals can use to build and then strengthen their wellbeing:



Diane Silve

Being physically active

Staying active is a fantastic way for IP professionals to boost their physical health and fitness. But physical activity also reduces symptoms of depression and anxiety (notably due to the chemical changes caused in the brain helping to positively change the mood), enhances thinking, learning, and judgment skills, raises self-esteem, and generally improves overall wellbeing. According to the World Health Organization, one in four adults fail to meet the global recommended levels of physical activity. The UK National Health System (NHS) recommends that adults should try to be active every day and aim to do at least 150 minutes of physical activity over the week. Not everyone has the time to train for 30 minutes every day, but there are ways to integrate physical activities into a busy schedule by making them part of everyday life, e.g., walking or cycling to work, or stopping one bus stop early and walking the remaining part.

Eating and drinking

Beyond any weight considerations, building a healthy and balanced diet² will significantly improve our physical and mental wellbeing. According to the UK Charity Mind, “some studies suggest that what we eat and drink can affect how we feel”. Though, when we are under stress, one of the first things that may slip is our diet along with the urge to find refuge in comfort food. And even when we manage pressure well, it is not always easy to know what to eat or drink as there is a lot of contradictory information out there and healthier foods can be more expensive. Our diet eventually can impact the way we work as IP professionals. For instance, a low or high blood sugar level can have repercussions on our energy, not drinking enough water can reduce our concentration or ability to think clearly, eating sufficient proteins will help our brain produce neurotransmitters that are

necessary to regulate our thoughts and feelings, eating vegetables and fruits will bring nutrients to our body, too high levels of alcohol intake may disrupt chemicals in the brain and caffeine can stimulate but, for some, it can increase anxiety. Some food for thought...

Sleeping well

The aforementioned LawCare study:

“Suggests that many legal professionals are getting less than the recommended amount of sleep (seven-nine hours a night) with just over a third of participants (35%) estimating they had slept between six to seven hours a night over the two weeks before completing the survey, a quarter (25%) averaging five to six hours, and over one in 10 (12%) indicating they had less than five hours a night”.

While the needs of everyone are different, getting enough sleep is generally important for one's wellbeing. A good night's sleep will notably help with managing stress, reducing anxiety, improving mood, along with increasing focus at work, and improving our relations with people.

Being mindful

Mindfulness practices can improve our wellbeing significantly. Various free and accessible mindfulness techniques such as Yoga, breathing exercises, and meditation³ can help individuals cope with difficult thoughts, feel calmer in stressful situations, and/or increase their concentration. Being more mindful can help IP professionals to be more present and engaged in the moment, boost their attention, and manage their stress. While the idea of sitting and meditating for 30 minutes may sound daunting for some, mindfulness can also be about noticing simple things that are part of our daily lives, like a smell, taste, a thought, and the air on our face, or focusing on a specific action such as the action of brushing our teeth or the steps we take when we walk.

Taking some time for yourself and your hobbies

When we can, taking the time to do what makes us feel happy and fulfilled is an important piece of our wellbeing. Hobbies, from knitting, singing, and gardening, to running or playing music, can help reduce the pressure on IP professionals after a stressful day of non-

“IP professionals are also often high achiever individuals and as such, the most critical judges with strong self-expectations.”

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stop meetings, or as a breakaway from work, and give a positive kick to boost their mood and self-esteem at the same time. Hobbies, especially if creative, can help improve the cognitive functions of the brain and train memory by learning or practicing new skills. Such activities can also provide connection with new and/or like-minded people.

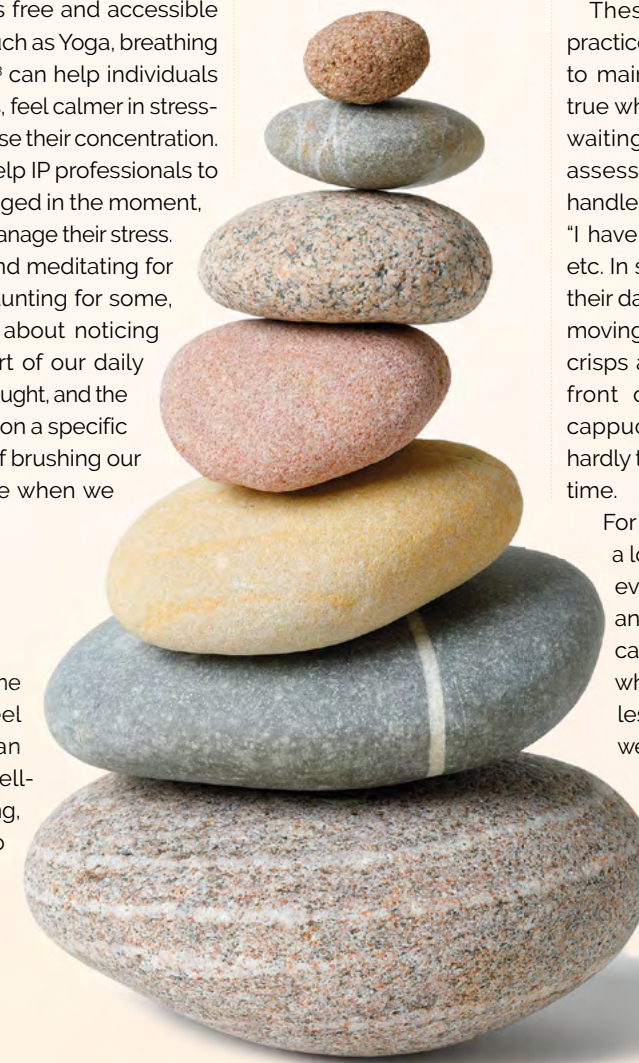
Connecting with others

Having meaningful relationships (within a community, family, at work) helps individuals to obtain a sense of belonging and self-worth. Knowing that there is a network of people on which they can rely or with which to share experiences is an important element of the emotional support that IP professionals, like anyone, need. Whenever possible, finding supportive colleagues with whom to chat with about a complex clearance assessment or getting some genuine feedback on the next big presentation to a client may be so helpful. One may also build a strong network of previous colleagues, mentors, or university friends to whom they can reach out to. These connections are important on a personal and professional level. Indeed, discussing helps to see a matter through different lenses, especially when working in an area of law, such as trademarks, that can be subjective.

These are simple, non-ground-breaking practices but are, unfortunately, not always easy to maintain in the long run. This is especially true when individuals are under pressure: “I am waiting for counsel to call to discuss a risk assessment,” “I have so many deadlines to handle,” “I need to finalize this injunction request,” “I have 560 pages of use evidence to review,” etc. In such cases, IP professionals may well go their day sitting the whole time at their desk, not moving except to go to the cafeteria to buy the crisps and soda which will be eaten quickly in front of their screen, or to get their fifth cappuccino of the day, and while doing so, hardly talking to others because they don't have time.

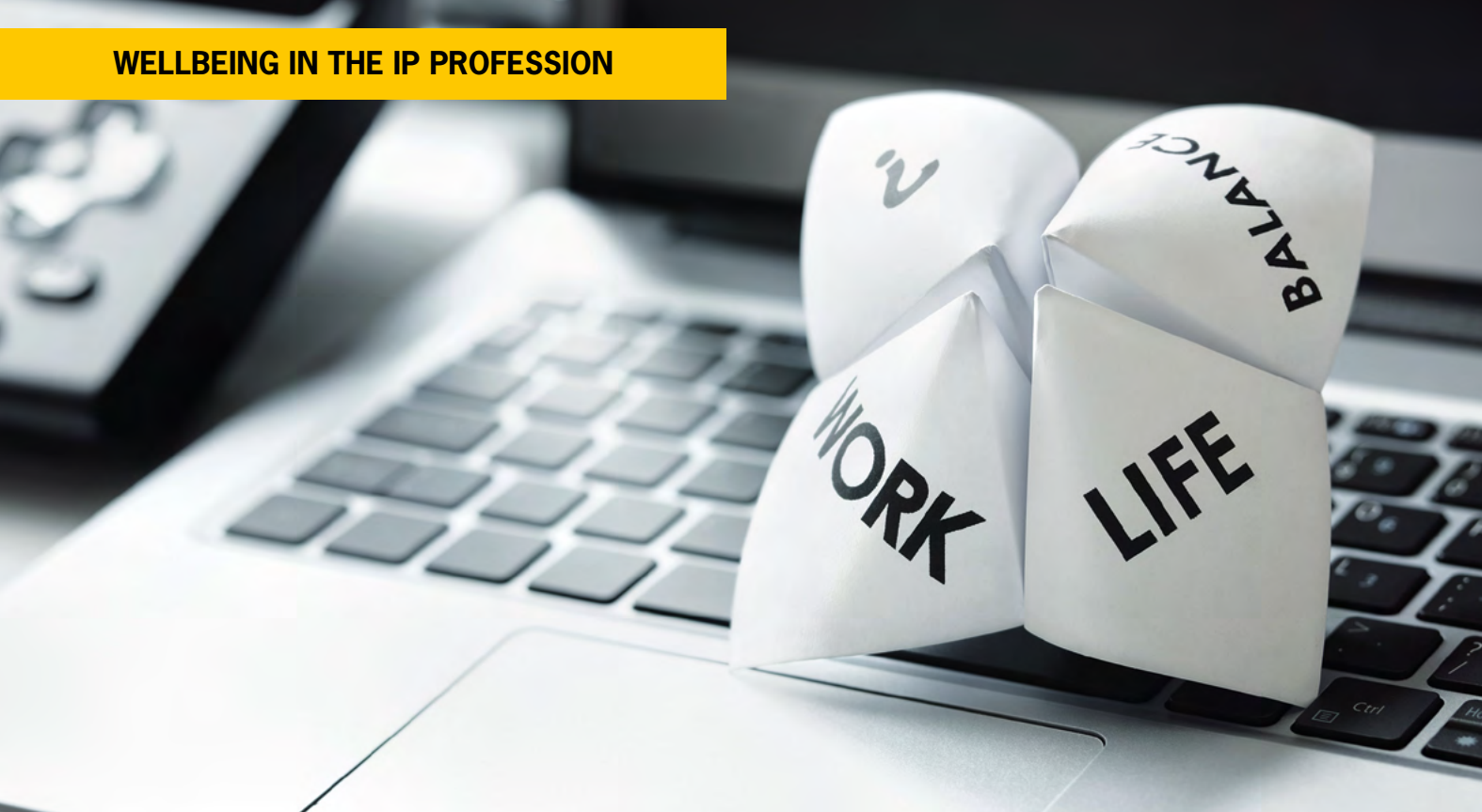
For many, such periods of stress can last for a long time, if not permanently. This makes it even more difficult to maintain a healthy and balanced way of being. For some, this can become another type of vicious circle, when the more stressed they become, the less they prioritize their wellbeing, the less well they are, and the more guilty they may feel for not keeping up with healthy eating, sleeping, and other practices.

So what? Is there a way for us, IP professionals, to break the circle and to be well, or better, physically and/or mentally despite the stress and the tensions we may be going through?



Résumé

Diane Silve is Director & Senior Trademark Counsel at Mondelez International. She has more than 20 years' experience as an IP lawyer. She has worked both in-house and in IP firm for various industries and in different countries. Diane is also a registered Yoga teacher and is undertaking qualifying courses in personal performance coaching and naturopathy. Diane is passionate about wellbeing and generally wants to understand and promote how IP professionals could take more care of themselves.



There are no right or wrong wellbeing practices, nor any good or bad ways to apply them. What may work for one may not for another: some may need to bake, others to meditate, journal, or cycle. In any case, what is important is to identify what our **coping strategies** are which help us to feel better and on which to then rely when things are getting more difficult.

Sometimes we are so buried under work matters and/or a demanding private life that we may not even notice that we may be dropping our wellbeing ball. As such, installing a regular self-wellbeing check-up with simple questions to answer may be very useful:

- How do I feel, mentally and physically – on a scale from one to 10?
- Do I sleep well these days?
- How is my stress level?
- Is there anything I can do to improve how I feel?

Mental Health First Aid England proposes such a simple tool⁴ that uses notably the notion of a “stress container” and helps us to question how full it is and how we can use our coping strategies to reduce stressors and prevent overflow.

Trying to fit in, at all costs, time (and energy) for a walk and for cooking nutritious food may quickly become exhausting. In such cases, we may need to recognize and accept the situation as it is. For example, we may recognize that we are doing our best but that there is just so much going on and that most of our energy is focused

“**A good night’s sleep will notably help with managing stress, reducing anxiety, improving mood, along with increasing focus at work, and improving our relations with people.**”

⁴ Weekly Wellbeing Checkup.pdf (mhfaengland.org)

on this big litigation matter we are working on and taking care of our family but accepting that we may be too tired to go to our HIIT or pottery class without labeling ourselves as lazy. It is vital to be kind to ourselves as we would be kind to others in the same context and try to release this extra pressure we may put on our shoulders. We need to remember that a five-minute meditation or stretching exercise or 10-minute gardening session is better for our wellbeing than nothing at all instead of waiting for our energy to return. One may also use the ‘just two minutes’ principle: just a two-minute breathing practice, exercise, or break in the garden is a step towards maintaining that wellbeing balance. Starting small is the best way to grow a practice. And most importantly, celebrating all the little victories.

To be fully transparent, while writing this article, I questioned whether I myself could legitimately write about wellbeing, despite my passion for the topic. Like all fellow IP professionals, I have experienced high levels of stress and times during which most, if not all, of my wellbeing strategies vanished quickly before I realized I was feeling unwell. Luckily, I could notice where I was heading, and also count on lovely colleagues to check on me. Wellbeing is as much an individual responsibility as a collective one, especially in the work environment.

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