Michael K. Friedland, Partner at Friedland Cianfrani LLP, addresses trademark lessons from the expiration of the copyright on the world’s most famous mouse.
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THE TRADEMARK LAWYER
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Enjoy the issue.

Faye Waterford, Editor

On January 1, 2024, the copyright to two original Mickey Mouse films expired, rendering the films and all the characters within, to some extent, free to use. However, with Mickey Mouse being among the most famous characters in history, and a very well-renowned trademark for a number of categories, the character is arguably not under threat. So, how will Disney handle the expiration of this copyright? Our cover story this issue investigates.

Our guest interview this issue is with Dana Brown Northcott, the 2024 INTA president. As well as providing insight into her role as Vice President and Associate General Counsel of IP at Amazon, Dana discusses her excitement for the year ahead, the key evolving challenges faced by the IP community, and what to look out for at the INTA Annual Meeting in Spring.

Further, we delve into the evolution of ICANN, detailing the developments surrounding generic Top-Level Domains to provide advice and guidance for keeping IP protected in this evolving space followed by a timely review of a trademark squatter case that saw the attempted exploration of the BBC’s notorious ‘TOP GEAR’ mark by a Russian entrepreneur.

Our Women in IP Leadership segment features Dorota Rzazewska, Managing Partner at JWP.

There is still time to book for our INTA Special Edition, contact katie@ctclegalmedia.com to reserve your space today.

Issue 1 2024

Editor’s welcome
Meet the Editorial Board: Dana sat down with Michael K. Friedland, Partner at Friedland Cianfrani LLP, to discuss her experience as the President of the International Trademark Association (INTA). Friedland shared insights into the changes in the IP landscape, particularly in the areas of trademark protection and domain name disputes. He also highlighted the importance of diversity and inclusion in the profession.

Meet the Editorial Board: The editorial board members share their experiences and ideas for equality.

In celebration of their approaching 75th anniversary, Maddock & Bright express their dedication to the protection of innovation throughout the Mena region.

In an interview with the editor, Stacey Kolamaras, founder and head of the firm, discusses the developments of ICANN’s generic top-level domains and the impact on the trademark protection landscape.

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PROTECTING MICKEY MOUSE

What’s a Mouse to Do?

Michael K. Friedland, Partner at Friedland Cianfrani LLP, addresses trademark lessons from the expiration of the copyright on the world’s most famous mouse.

The copyrights on the two original Mickey Mouse cartoon films expired on January 1, 2024. As with any other copyrighted work, the expiration of the copyrights means that the works are now in the public domain. Thus, the original Mickey Mouse films, and all the characters in them, are, to some extent, free for all to use. The marketplace has quickly responded. In the month since the copyright expired, consumers can find unlicensed Mickey Mouse products all over the internet.

But Mickey is more than just a cartoon character; he’s also one of the world’s most famous trademarks. Thus, we bring a critical question into focus: is there anything that Disney can do to stop the proliferation of goods bearing Mickey Mouse and save Disney’s most valuable trademark? The lessons apply across the entertainment and copyright landscape.

Mickey as a trademark

Mickey made his debut in the cartoon Steamboat Willie in 1928. His life as a trademark began in 1930. The first Mickey Mouse dolls appeared in 1930. The first Mickey Mouse watches appeared in 1933. Since then, he’s been on books and clothing, food, toys, kitchen appliances, electronics, and more. Mickey has appeared on virtually every product imaginable.

The Lanham Act defines a trademark as “any word, name, symbol or device” that is used to identify and distinguish goods from those made or sold by others and indicate their source. 15 U.S.C. § 1127. Mickey undoubtedly qualifies.

Generations of consumers have become accustomed to seeing Mickey on everything from hats to handbags. When consumers see that iconic Mickey Mouse character on a product, they undoubtedly believe, after a lifetime of experience, that the product is made, sold, or authorized by Disney.

Now, however, unlicensed Mickey products are easy to find. Figure 1 & 2 are just a few examples. Because of Disney’s trademark rights in Mickey, enforcement of those rights against such third-party users should be an easy matter. But it’s not so easy, because Mickey Mouse is not only a trademark, he is also a copyrighted character.

If Disney had only used Mickey as a character in copyright-protected works (for example, books, artwork, and films), the analysis would be straightforward. The copyright expired, and the character would be on the open market. The world would be free to copy or create its own Mickey works, just as anyone is free to copy or make their own Sherlock Holmes or Tom Sawyer works. At the same time, if Disney had used Mickey only as a trademark, the analysis would be just as straightforward. Mickey would continue to be Disney’s to use exclusively.

With this background, we turn to the question: What are Disney’s options?

Do nothing

Disney could simply ignore the third-party uses, but this option has several severe negative consequences.

Disney would lose millions of dollars in sales and royalties. Consumers would have the option of buying Mickey products from unlicensed manufacturers instead of genuine Disney products. Disney could lose profits from the sales it would have made, perhaps billions of dollars’ worth, over time.

At the same time, manufacturers would have the option of making and selling Mickey-branded products without having to pay a license fee, causing Disney to lose royalties from those sales.

Reputational damages could follow. Disney would have no way to prevent flammables Mickey pajamas or lead-painted Mickey drinking cups from entering the market, and many consumers would mistakenly believe that the pajamas and cups were genuine Disney products. In addition, if the products carried a message inconsistent with Disney’s carefully cultivated image, Disney would suffer further reputational harm, as consumers could mistakenly believe that Disney endorsed the message.

The long-term consequence of the unauthorized use could be even more damaging. If unlicensed Mickey Mouse products continue to proliferate, Mickey would lose its secondary meaning. Consumers would become accustomed to seeing Mickey as a character who appears on products from a wide variety of companies, and consumers would no longer identify Disney as the source of Mickey Mouse products. Mickey could become no different than Santa Claus or the Easter Bunny.

Surgical enforcement

A second option would be for Disney to make a
tactical concession. Disney could ignore uses of Mickey that strictly resemble the Steamboat Willie version of Mickey Mouse. At the same time, Disney could continue to aggressively enforce its rights against uses of more modern versions of Mickey Mouse.

The limitations of that approach are made plain by review of the Steamboat Willie character, reproduced in Figure 3. The Steamboat Willie version of Mickey is immediately recognizable as Mickey Mouse. To developed fans, the differences between Steamboat Willie and his modern variants are immediately discernible. To more casual consumers, however, Steamboat Willie is just as much Mickey as any other version. Particularly where the Steamboat Willie Mickey is used in different poses or with different backgrounds, there is no reason to think ordinary consumers would readily distinguish between different versions of Mickey, another version of Mickey will fall into the public domain every few years. The Steamboat Willie version expired earlier this year. The next version expires in 2027, and the one after that in 2032. Thus, with each passing year, even if a campaign of surgically limited enforcement were successful for each iteration of Mickey, another version will periodically expire and lapse into the public domain. And because each newly expired version more closely resembles the current version, Mickey’s value as a trademark will continue to erode.

Damn the copyright, and full speed ahead

Disney’s most aggressive option is probably the most appealing. Disney could simply disregard the expiration of the copyright and sue third parties for trademark infringement as though the copyright limitation had never existed. Each regional federal appellate circuit has its own articulation of the test for trademark infringement. Application of any of the tests strongly favors Disney. For purposes of this discussion, the Ninth Circuit’s Sleekcraft factors are applied. See AMF Inc. v. Sleekcraft Boats, 559 F.2d 341, 348-49 (9th Cir. 1977). The relevant factors weigh:

- The similarity of the trademarks;
- The similarity of the goods;
- The similarity of the marketing channels;
- Evidence of actual confusion;
- The strength of the trademark;
- The defendant’s intent in selecting the trademark; and
- The degree of care exercised by consumers.

Every one of these factors would weigh heavily in favor of Disney. The Mickey images are the same or nearly the same, the goods are the same, the Mickey trademark is enormously strong. Disney could easily show actual confusion, either through consumer complaints or through a survey; the evidence would show that defendant chose to use Mickey knowing that consumers associate the character with Disney, and, because the goods are often impulse purchases, consumers tend not to exercise a high degree of care. Even though Disney could easily prove a likelihood of confusion using the Sleekcraft factors, there is still no guarantee that Disney would ultimately prevail. A defendant would likely raise the expiration of the copyright as the focus of its defense. The defendant would argue that the expiration of the copyright meant that the defendant could use the Mickey Mouse character, regardless of whether the character is also Disney’s trademark. That argument would be similar to one recently addressed by the Supreme Court in Jacd Daniel’s Properties, Inc. v VIP Products, LLC, 599 U.S. 149 (2023). There, the Supreme Court held that the First Amendment did not allow a company to sell a parody dog toy version of Jack Daniel’s whiskey bottle design. The defendant labeled its parody dog toy version “Bad Spaniel’s.” The Supreme Court held that the issue turned on whether the defendant was using “Bad Spaniel’s” as a trademark. There, the defendant admitted in earlier court proceedings that it believed the phrase “Bad Spaniel’s” was its trademark. Accordingly, the Supreme Court found that the First Amendment did not protect the defendant. In a dispute regarding Mickey Mouse, the inquiry would likely have the same focus. A court would need to determine whether the defendant’s particular use of Mickey constituted use as a trademark.

Although the determination would vary from product to product, and there is no guarantee that Disney would prevail in any particular case, the enormous potential loss entailed in allowing third parties to continue to use Mickey on products far outweighs the risk of doing nothing or pursuing a limited enforcement campaign. Doing nothing would deal a relatively quick death to Mickey as a trademark. A limited enforcement campaign would still allow Mickey to die as a trademark, albeit at a slower pace. Aggressive enforcement would at least give the world’s favorite mouse a chance.
Can you introduce yourself and your role in the IP industry?
My current role is Vice President and Associate General Counsel of IP at Amazon. I lead the team that supports all of Amazon’s brands globally, including trademarks, domain names, gTLDs, internet governance, copyright, content protection, and a lot of IP policy work. I’ve been at Amazon for 16.5 years, and, prior to that, I’ve held roles in law firms in Silicon Valley and London, as well as in-house.

Beyond Amazon, my most important (and exciting) role this year is to serve as INTA’s 2024 president. It’s a terrific organization of talented IP professionals who are deep in brand protection and with broad scope and global reach. INTA does so much for the IP community through talent development and policy advocacy, of which I am also a recipient. This is what truly makes this Association the premier global branding organization.

I have been a member of INTA for 23 years now, and am lucky to have served in a variety of roles, from committees to presidential task forces to the Board of Directors. I’m so appreciative of the organization – in addition to everything else, it makes my life more fun every day!

Did any particular cases or developments stand out for you in 2023?
There are a number of cases that come to mind but let me highlight two: one was in the US with international implications, and the other in the EU.

The first one was the Abitron case (Abitron Austria GmbH v. Hetronic International, Inc.) before the United States Supreme Court. The US Supreme Court has been hearing a lot of trademark cases lately, and it’s been exciting to watch our cases make it to the highest court for definitive review. As with many Supreme Court cases, INTA filed an amicus brief in 2022. The reason why this case is important here in the US – but also internationally – is that it limits the ability of trademark owners to obtain damages to only domestic infringing use in commerce in that country. This is also important because the US Senate is debating legislation around the decision soon.

INTA argued for a system that could function reciprocally, consistent with international treaty systems. Specifically, INTA’s position is that the Lanham Act may stop only foreign conduct that causes substantial injury in the US. The Lanham Act covers domestic consumer confusion, harm to brand owner reputation, mistakes about sponsorship, affiliation, and dilution. In the case of a foreign actor that is causing substantial injury in the US in any of these ways, there’s action available here, but otherwise, not. However, the Lanham Act cannot subject foreign companies to suit in the US for foreign conduct that has no likelihood of confusing consumers or other substantial impact in the US. The Lanham Act covers domestic consumer confusion, harm to brand owner reputation, mistakes about sponsorship, affiliation, and dilution. In the case of a foreign actor that is causing substantial injury in the US in any of these ways, there’s action available here, but otherwise, not. However, the Lanham Act cannot subject foreign companies to suit in the US for foreign conduct that has no likelihood of confusing consumers or other substantial impact in the US. The Lanham Act covers domestic consumer confusion, harm to brand owner reputation, mistakes about sponsorship, affiliation, and dilution.

Turning to the EU and the EUIPO v. Nowhere case: INTA filed a brief for this case last year which is still pending before the Court of Justice. It concerns the timing of grounds for EU trademark applications. INTA’s position, with regard to opposition or cancellation proceedings, is that where the relevant petitioner in the case relied upon a right that for no reason no longer exists when the decision is taken, then the petitioner no longer has an interest in the case, and the opposition or the cancellation should fail. The timing there is really important. In that case, the right relied upon was no longer valid at the time a decision was due to Brexit, but the outcome of the litigation might have an impact on any future cases that involve the “disappearance” of an earlier
right (cancellation, expiry, etc.), and this is why it is important to INTA.

The International Amicus Committee does such an impressive job of drafting all their briefs, then they explain it thoroughly to us on the Executive Committee so that we truly understand the issues.

What do you believe are the key evolving challenges in the IP community and how is INTA working to support these challenges? Have you made it through a day in the last six months where somebody hasn’t mentioned generative AI? No right? So, we should probably start there! One challenge would be AI and its implications on society, IP, and the IP profession itself. It’s certainly top of mind for everyone. INTA is hosting The Business of AI Conference in New York in March. It offers a great opportunity to explore exactly this. I love the March conferences. They are a great example of how INTA is a source of future-facing idea exchanges and best practices. I’d definitely be attending the conference with some of my team members. That’s where I’d start – AI – because it’s in the zeitgeist.

The second, the continuing iteration of IP rights. Global trade is increasingly complex, and technology is accelerating change. As a result, the needs of businesses and brand owners are changing. This will continue to be a key issue for INTA in the coming years because the law can’t keep up with the pace at which technology is evolving and developing. INTA’s advocacy team is engaging with all of the IP offices and the legislative bodies to talk about harmonization and how they can come together with best practices that work to the benefit of the consumers who rely on and trust brands.

Another issue that deserves mention is the increasingly complementary brand value and IP rights. Brand portfolios like Amazon’s are more and more complex, and as new products and services come on board, they require a variety of protections. As a result, INTA continues to advocate for a model that centers especially on complementary IP rights, as you can see with the new committee inaugurated this year on trade secrets. I am very excited to see what transpires in their first term.

Beyond that, INTA has ongoing focus on its policy priority issues such as counterfeit; brand redactions; internet transparency; and the expansion of the domain name system, as well as the evolution of the IP profession – and with this, evolving and growing expectations from both in-house and outside counsel.

Personally, I can speak from experience that brand owners have growing portfolios that demand (and expand) professional capacity necessitating a lot of substantive skills to expand across financial, marketing, and IT implications. I’m really pleased to see INTA stepping in to address this with the recently launched certification programs. One is the Finance for Non-Finance Legal Professionals – a game-changer for helping us develop our budgets. Then, an initiative focused on the broader lifecycle of the trademark, was launched at the end of 2023. And in this first quarter of 2024, INTA is launching the Trademark Administrator Certificate.

I think about this a lot, how we can lean into INTA immediately to help with training new hires, and the Trademark Administrator Certificate will be such a valuable starting point.

What aspect of being INTA president excites you the most? From the strategic mission of the organization. I’m also really excited to connect with the INTA members globally. I’m looking forward to participating in this year’s delegations where I’ll get to hear about what our members need and play a part in figuring out how INTA can best address those needs. INTA has a really important role to play with policymakers and regulators, as well. So I hope to advance some of the incredibly important conversations around INTA’s perspectives and priorities.

What are your main goals as president? My goals are centered around supporting all that makes INTA so very important and relevant to keep up with the fast-evolving professionals. Including INTA’s strategic mission, continued engagement with the membership, ensuring advocacy with policy-makers and regulators.

Another goal that is at the top of the list is my Presidential Task Force – I’ll give you a sneak peek! We are going to focus on brands and sustainability, communications, and the impact of customer trust on brand value. INTA’s strategic mission, continued engagement with the membership, ensuring advocacy with policymakers and regulators.

What advice would you give to young practitioners who are attending their first Annual Meeting? If you are coming to the Annual Meeting for the first time, you are a young practitioner, focus on building connections and building your network. Be sure to challenge yourself to explore new content areas that you know nothing about by attending as many educational sessions as you can get to, and also, no matter how early in your career you are, you have a lot to share, so share what you know with others.

If you could set a New Year’s resolution for the IP community, what would it be? What is your number one goal? For me, it’s the promotion and reinforcement of the value of INTA. As a whole, it is our organization and how it is we embrace technology and change. This will continue to be a key issue for INTA in the coming years because the law can’t keep up with the pace at which technology is evolving and developing. INTA’s advocacy team is engaging with all of the IP offices and the legislative bodies to talk about harmonization and how they can come together with best practices that work to the benefit of the consumers who rely on and trust brands.

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The evolution of ICANN: a new landscape for IP protection

Stuart Fuller, Director of TLD Services at Com Laude, details the developments of ICANN’s generic Top-Level Domain program to provide advice and guidance for keeping IP protected in this evolving space.

The history of the Internet continues to teach us that tomorrow’s growth is going to be fuelled by disruption to the norm. Some of today’s most ambitious, digitally focused, market-leading, and most valuable brands are organizations that have relatively short histories and have taken advantage of economic conditions to transform their business models. The global pandemic was a major tipping point for many brands to rethink and reimagine their strategies and business models, and also gave rise to new market entrants who could adapt quickly to the new ways of the world. The FinTech industry, which encompasses and facilitates the growth in ecommerce, is projected to become a $1.5 trillion industry by 2020 according to Boston Consulting Group.

As far back as 1999, organizations such as KPMG were focused on the opportunities that the Internet could deliver to organizations, noting in their research paper on “Electronic Commerce and Internet” that: “More companies than last year now see the Internet as a profitable way of making sales, compared to traditional methods. Unsurprisingly, perhaps, it is the more e-commerce mature businesses, like the retail/wholesale companies, which are particularly interested with the Internet as a selling tool.”

There are, of course, still obstacles to be overcome before the global digital revolution can really take off. These are more formidable barriers - security fears, particularly – than some e-commerce evangelists would like outsiders to believe. But when a massive 81% of respondents believe that electronic trading will revolutionize their dealings with customers and 32% say that the Internet has already increased total sales – it is clearly a revolution that is unstoppable. E-commerce companies that are lagging now only have a brief window before they fall irretrievably behind.

In 2012, the Internet Corporation for Assigned Names and Numbers (ICANN) launched the New gTLD (generic Top-Level Domain) program, representing the biggest and most significant expansion of the domain name system since its creation. The program marked a substantial departure from the limited availability of domain suffixes, such as .com, .net, and .org, allowing for a much broader range of Top-Level Domains to enhance competition and choice, promote innovation, and foster and support global internet diversity.

The liberalization of the domain name space was a chance for organizations to acquire their own slice of the internet in the form of a dotBrand Top-Level Domain, and to revolutionize how web users interacted with them and each other online. This limited opportunity saw over 500 global entities apply for their own dotBrand Top-Level Domain.

Rather than seeing a revolution in the domain name space it has been more of an evolution. Whilst there have been notable successes of some new gTLDs, we are yet to see a real step change for brands that applied for, and have launched, their own dotBrand TLDs.

The clamor for a second application round started almost immediately as the applicants were announced in June 2012. With over 20 years of experience in the domain name and brand protection industry, having previously held senior commercial positions at NetNames, CSC, CentralNic, and OpSec Security, Stuart Fuller played a big role in the first round of the new gTLD program in 2012, working with a number of global brands in creating dotBrand strategies and use case scenarios whilst he was at NetNames, and brings that expertise and experience to Com Laude.

Stuart is a published writer, both on subjects around domain names and intellectual property protection but also on football culture.
The ICANN evaluation process will look at the technical, operational, and financial capabilities of an applicant, but it is the feasibility and business case for a specific string that ultimately underpins the application.

The necessary steps in determining whether a specific string can be applied for should start as soon as possible. ICANN’s rules on who can apply and what they can apply for are complex so it is prudent to collaborate with a partner who not only understands the process and the criteria but also has experience of managing similar applications to determine whether an application will be successful. First and foremost, to operate a dotBrand exclusively for the organization’s use, the applicant must have a registered trademark matching the term.

Any prospective applicant that currently does not have a registered trademark has time to make a trademark application which would satisfy the necessary requirements to support their dotBrand, though they will need to demonstrate proof of use. There will be instances where there are conflicting, valid trademarks for a specific string. For instance, there are hundreds of registered trademarks for the term “Polo,” including those from global brands such as Nestle, Volkswagen, Ralph Lauren, and the United States Polo Association. Whilst all may have a valid claim to an application for a dotBrand TLD, there can only be one successful applicant.

Organizations will need to create a compelling internal business case before they will get the necessary sign-off to take an application forward. The feasibility work is the starting point for that internal justification and needs to consider the likelihood of applications being made by other parties for the same string. This is not an exact science, nor will it provide a fail-safe answer, but it will provide visibility on the risk of an application not being successful, and some context and understanding of who potential competitors could be for the dotBrand.

The feasibility assessment also needs to cover other aspects of the potential application string. History can teach a lot and so, it is important to look at whether similar strings were applied for in the previous round. This includes an analysis of any strings that may be considered confusingly similar (dotUnicorn and dotUnicom for instance), or any previous applications that were withdrawn, terminated, or have not yet been launched. Furthermore, some geographic strings are permitted but require additional approvals from local authorities.

There are unsurprisingly a number of terms that cannot be applied for, even if there is a trademark registered. There are key words or terms that are blocked by ICANN for technical stability purposes, geographic terms protected at the behest of national governments, and terms corresponding to intergovernmental organizations such as the Red Cross or the International Olympic Committee. The ICANN process allows for national governments to raise objections to any applications through their ICANN representative body, the Governmental Advisory Committee (GAC).

Typically, such objections will be based around a particular national sensitivity or a sensitivity shared by multiple governments, so again a look at what history has taught us can be insightful.

Once the feasibility of the term has been determined, the organization can start to think about the creation of a strategic business plan for the dotBrand application. This will include the formation of the team that will create, shape, and ultimately manage the application. Due to the complex nature of the ICANN environment and the processes involved, many applicants choose to work with a specialist organization that can navigate the entire process, from carrying out the initial feasibility assessment, to creating a successful TLD application.

The registrar will work with the organization to ensure all relevant areas of the business are involved in the project as well as developing uses for the dotBrand which will generate value for the business. This work will form the core components of the business plan for the organization - giving all relevant decision-makers and budget holders a clear vision for the application itself and how it will be an asset to the business on an ongoing basis.

It is unclear when the next application opportunity will take place post-2025, so the time is now for ambitious brands that want to join a very exclusive club of internet real estate owners. Preparation is the key to ensuring the necessary investment is aligned with the organization’s strategic long-term goals and there is no time like the present to start that process.
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.

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Dorota Rzążewska: Managing Partner, JWP

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

For 30 years, Dorota has been advising Polish and international companies on all aspects of IP law. Since 2007, she has been the Managing Partner at JWP Patent & Trademark Attorneys.

She combines extensive knowledge and experience as an attorney at law with the competences of a Polish and European patent and trademark attorney, successfully representing clients in contentious and court litigation proceedings resulting from infringement of exclusive rights, including complicated patent disputes.

What inspired your career?

I originally planned to pursue the career of a judge, as both my mother and grandfather had been in this profession. It seemed a natural choice to continue the family tradition. In Poland it is necessary to complete a three-year judicial training and pass a judge’s exam in order to become a judge. After passing the exam, I was offered a job at the court where my mother used to pass judgments. At this point, I felt the need to start building my own career and to follow my own professional path. I decided to complete an additional apprenticeship and train as a legal advisor, which allows you to represent entrepreneurs and individuals in legal matters both as a legal counsel and as an attorney.

One day I was approached by a patent attorney who was looking for a trainee to help him with a court case involving trademark infringement and committing acts of unfair competition. I took on and in the course of the case I saw how interesting and inspiring intellectual property law is.

The industrial property law currently in force in Poland comprises a number of open-ended concepts and definitions which, in relation to specific cases, might be interpreted in different ways. This is both a challenge and an inspiration to lawyers. It sparked my interest and prompted me to extend my knowledge on the subject. I decided to specialize in industrial property protection. In the next three years of my apprenticeship as a patent attorney I learned more about the field of industrial property protection. This was followed by the qualifying examination which allowed me to obtain the title of a professional patent attorney.

In 2004, the year when Poland joined the European Union, I also got my qualification as a European patent attorney.

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

My road to becoming professionally qualified as a patent attorney and entering the world of intellectual property protection may seem long,
Equality and diversity are the values that characterize the whole IP world, and they apply to exclusive right owners as well as to legal advisors or attorneys.

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

For me as a lawyer, the biggest challenge was to acquire the technical know-how necessary to pursue the career of a patent attorney. This profession is interdisciplinary by nature, combining both legal and technical aspects, and in order to practice it properly, it is necessary to study technical issues.

But in my case it has been consistent - I do believe in specializing and improving my knowledge and skills within the field of law I deal with on a daily basis.

I entered the world of patent attorneys as a qualified legal counsel, which gave me a slightly broader perspective on the rules of litigation and court proceedings before the Patent Office, administrative courts, and common courts.

Initially, I specialized in litigation and court cases, but with time, the know-how and experience gained allowed me to start providing advisory services in the fields of IP protection strategy and management of an exclusive rights portfolio.

All the knowledge and expertise I have gained in the course of my three apprenticeships as a judge, legal advisor, and patent attorney, have led to me being recognized as a person able to conduct litigation, whether it involves infringement of patent rights, trademarks, industrial designs, copyrights or cases related to protection against unfair competition.

My long-standing practice in this field also gives me the ability to provide advice and determine strategies for handling cases before courts. Of course, each case requires a strategy that takes into account its specific character and hard facts. It is necessary, however, to keep up to date with the changes in applicable legislation and follow the case law on an ongoing basis.

My work experience does not only include managing intellectual property cases. As well as managing partner of a law firm, I had to extend my knowledge and gain managerial expertise.

This sphere of my professional activity requires keeping abreast of market changes and constantly updating my know-how of management, psychology and soft skills. It is a challenge I face every day, as it involves not only actively developing my company and building its market position, but also - or perhaps above all else - working with people and building our team. This means bringing together professionals in the field of intellectual property and those skilled in providing professional advice and cooperation with the clients who are able to form strong relationships both with the clients and with colleagues.

What changes would you like to see in the IP industry over the next five years?

Equality and diversity are the values that characterize the whole IP world, and they apply to exclusive right owners as well as to legal advisors or attorneys.

Changes concerning the IP industry should follow our changing reality. As we are living in the digital age, soft skills in terms of communication and task delegation are all very useful, both as regards substantive work related to intellectual property protection and in management.

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

It is difficult to give a definite answer to this question, as my career has consisted of multiple stages. At the beginning, my greatest achievement was gaining the knowledge and experience necessary in the field of IP protection. Once I started my professional career, I might say the biggest achievement was setting up and keeping my own practice, steadily from the office of 15 people in 2006 to employing 120 members of staff in 2023.

JWP grew in number, we also expanded the catalog of services we provide, and I became the territorial outreach of our operations. As of today, JWP has offices in the four largest Polish cities and helps Polish companies protect their intellectual property in nearly 80 jurisdictions. My major success is also the establishment of the JWP Foundation and Law Firm which form the JWP Group, allowing us to provide comprehensive services on a global scale.

Pro bono undertakings are at the heart of my professional activities. The adopted strategy of my foundation is based on the sharing of know-how, development of a patent attorney, and those skilled in intellectual property protection in secondary schools, give lectures to students, doctoral students, entrepreneurs, and startup companies.

For the past eight years, I have also been actively involved in a professional association, I have been the President of the Polish Chamber of Patent and Trademark Attorneys for the secret term running, which makes me involved in pro bono activities related to building the position of the patent attorney community in Poland.

What changes concerning the IP industry should follow our changing reality?

In order to maintain parity, it is therefore necessary to open to gaining knowledge and expertise in the fast-paced world around us. It also implies the need for continuous professional improvement in order to be able to provide services in the sector of intellectual property protection. One must be open to gaining knowledge and expertise in the newly emerging branches of the economy.

The world of intellectual property is changing and expanding, and the need for more innovation is crucial, as is taking into account changes happening in the fast-paced world around us.
South America

A comprehensive list of the 10 most well-respected law firms from South America

GET READY TO SHINE BRIGHT IN ANTWERP

The event will take place at the Flanders Meeting and Convention Centre Antwerp, located next to one of the most beautiful train stations worldwide, with high-speed rail connections to Paris, London, Amsterdam, and Cologne, and only a 15-minute train trip to/from Brussels Airport.

The Conference venue is connected to the Antwerp Zoo, an award-winning science and research centre, managed according to the highest animal welfare standards. All profits from the Convention Centre are donated to the ZOO Foundation. Thus, the Conference will directly contribute to nature conservation, animal welfare, and ecological research. The other events will take place within walking distance of the Conference venue.

Antwerp, also known for its historic centre and its maritime port, has always been a major international trade hub which made the city flourish throughout the Golden Age in the 16th century. The historic shipping lines to the new world as from the 19th century helped it to develop into a unique, vibrant and diverse city. The Handelskantoor, the oldest purpose-built commodity exchange in the world, has been recently renovated to its old grandeur.

Like diamonds, IP has many facets. At the ECTA Annual Conference, we will discuss the most topical ones with a focus on sustainability – a key for a better future.

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GLOBAL REACH, LOCAL KNOWLEDGE

THE TRADEMARK LAWYER

LAW FIRM RANKINGS 2024

23CTC Legal Media
Throughout the next few pages, you will view a comprehensive list of the 10 most well-respected law firms from South America, in alphabetical country and company order. Our focused list is derived from a multifaceted methodology, which uses months of industry research and feedback from our readers, clients, and esteemed connections around the world. All firms are ranked top 10 in their jurisdiction but are displayed alphabetically to avoid bias.

**Argentina**

- Berton Moreno IP Law
- Estudio Chaloupka
- Lerman & Szlak
- Marval, O’Farrell, Mairal
- Mitran, Caballero & Ruiz Moreno
- Neotinger & Armando
- O’Conor & Power
- Ojam Bullrich Flanzbaum
- Palacio & Asociados
- Richelet & Richelet

**Brazil**

- BMA Advogados
- Daniel Law
- Dannemann Sienssen
- David do Nascimento
- Gruenbaum, Possinhas & Teixeira Intellectual Property
- Gusmão & Labrunie
- Kasznar Leonardos
- Montarry Pimenta, Machado & Vieira de Mello
- Murta Goysanes Advogados
- Vaz e Dias Advogados & Associados

**Bolivia**

- Bolet & Torrero
- Bufete Aguirre, Quintanilla, Soria & Nishizawa | BAQSN
- Cervieri Monsuarez
- C. R. & F. Rojas Abogados
- Escobar & Escobar
- Ferrere
- Landivar & Landivar
- Moreno Baldivieso
- SORVILL
- WA Menendez y Asociados SRL
### Chile
- Albagli Zaliasnik
- Alessandri
- Beuchat, Barros & Pfenniger | BBP
- Carey
- Covarrubias
- Johansson & Langlois
- Magiana Abogados
- Sargent & Krah
- Silva
- Villaseca Abogados

### Colombia
- Brigard Castro
- Castellanos & Co
- Cavelier Abogados
- Dentons Cardenas & Cardenas
- Gomez-Pinzon Abogados (GPA)
- Lloreda Camacho & Co
- Olarte Moure
- Philipp Pochecarrizoza Ferrero DU & Unia
- Posse Herrera Ruiz
- Vera Abogados Asociados

### Ecuador
- Aguirre | Noboa Law Firm
- Bustamante Fabara
- CorralRosales
- Falconi Puig Abogados
- Guerrero
- Lexvalor Abogados
- Perez Bustamante & Ponce | PBP
- Quevedo & Ponce
- Sur Legal Estudio Juridico
- Tobar ZVS

### Guayana
- Britton, Hamilton & Adams Law Firm
- Cameron & Shepherd
- Dentons
- Gunraj & Co.
- Hughes, Fields & Stoby
- Jamela A. Ali, Attorneys at Law
- London House Chambers
- McDoom & Company
- Satram & Satram
- Templar Chambers

### Paraguay
- Abente Stewart Abogados
- Barroso Modica Abogados
- Berkemeyer | BKM
- Cervieri Monsuarez
- Ferrere
- Mersan Abogados
- Olmedo Abogados
- Ponce Sosa Telechea Burt & Narvaja (“PSTBN”)
- Vouga Abogados
- Zacarias & Fernandez (ZAFER)
Peru

Patent and trademark prosecution and litigation. 49 years of professional practice in all areas of IP practice representing clients from several countries.

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Uruguay

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Antequera Parilli & Rodriguez
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Trademark squatter eliminated by the court after attempts to exploit the TOP GEAR mark

Vladimir Biriulin, Partner, Russian Patent Attorney, Head of Special Projects, of Gorodissky & Partners evaluates the recent case that almost saw the loss of the TOP GEAR mark for the BBC!

The BBC registered TOP GEAR in 2015 under No 538851 with priority of December 15, 2015 in Class 38. There was also another TOP GEAR trademark (No 339837 in Classes 38, 41, 42,43) registered by a Russian company in December 2007 with priority of October 25, 2005. That company was in the process of liquidation but immediately before that came into effect a Russian entrepreneur who is notorious for cybersquatting acquired the trademark in August of 2016. The entrepreneur dealt with immovable property only. On November 20, 2017 he filed a cancellation action at the Chamber of Patent Disputes (ICPP).

The appeal was that in the opinion of the BBC, the appeal against the registration of the BBC’s trademark had not been filed by an interested person as required by Article 1531 of the Russian Civil Code. Besides, the entrepreneur abused his right to initiate the cancellation of the BBC’s trademark. The IP court agreed that the instant instance of the IP court had made premature conclusions regarding the BBC’s arguments. The judgment was handed down by the 1st instance court without regard to all circumstances surrounding the case. The IP court put forward important considerations regarding the similarity of trademarks. The probability of confusion does not depend only on the degree of similarity of the designations in the eyes of the consumer but also on other factors, i.e., whether the trademark is used for specific goods, duration, and the scope of use of the trademark, whether the trademark is recognizable by consumers. If the trademark is not used, the consumers do not have associative links with that trademark or allegiance to its owner. Therefore there is no possibility of confusion of the compared trademarks in the eyes of the consumer.

Hence, since the cited trademark is not used, this should be viewed in such a way that there should be no confusion between the disputed and non-used trademark. The IP court did not issue a judgment but sent the case to the 1st instance court for reconsideration by a different panel of judges.

The court of 1st instance recognized that the previous panel of judges had not examined the behavior of the entrepreneur who sought to cancel the BBC’s trademark. If one of the parties behaves unfairly, the court may refuse protection of its claims. It was stated that the entrepreneur had registered his trademark No. 623091 for the only purpose of making the use of trademark No 538851 by the BBC difficult. This was confirmed by the proposal of the entrepreneur to sell his trademark No. 623091 to the BBC. It was stated during the hearing that the patent office when cancelled the BBC’s trademark was guided by Part IV of the Civil Code while the evaluation of the behavior of the appellant would go beyond its competence. In its judgment, the court obliged the patent office to reinstate the registration of trademark No. 538851.

One might think that this was the final outcome of the case. Not so. The entrepreneur filed a cassation appeal to the IP court but the appeal was dismissed.

This case was important in that it was included in the Review of Judicial Practice dated November 15, 2023, occasionally issued by the Supreme Court.

It is worth noting that the entrepreneur, whose name is Azamat Ibatullin, is a character well-known to many. He registered 742 trademarks in his name. There were 231 court cases initiated by Ibatullin and in many cases, his behavior was recognized as an abuse of right.

In one of the cases (Aрп-55727/2020) he sued a company allegedly infringing its rights for a trademark. In doing so he claimed compensation in the amount of 50,000 rubles and paid a court fee in the amount of 2,000 rubles. Later he raised his claim for compensation to 375,000,000 rubles but scrapped on payment of a larger court fee. The court dismissed his claims on the grounds of abuse of right by the plaintiff.

Ibatullin appealed the judgment at the appeal court without success and further at the IP court in its capacity as cassation instance. The IP-court found some flaw in the previous judgment and sent the case to the 1st instance commercial court without obliging the court to issue a specific judgment. During the hearing, Ibatullin argued that he had the right to 599,932,000 rubles of compensation (initially he claimed 50,000,000 rubles). He submitted evidence to the court according to which he had concluded a license agreement with another person. Furthermore, the case was dismissed. Ibatullin again appealed the judgment at the court of appeal. The case was bandied back and forth again through several court instances. Ibatullin reduced his demands to 10,000 rubles of compensation. And here, the judge made an unexpected and wise move: she called evidence from the patent office and obtained the mentioned license agreement. It transpired from the license agreement that the license was royalty-free. Thus the judge rightly concluded that the plaintiff evaluated the right of use of the trademark at “0” rubles which means that the trademark has no value for the plaintiff.

Finally, the judge issued a judgment on February 1, 2023 dismissing even that meager claim for 10,000 rubles.

Résumé

Vladimir Biriulin, Partner, Russian Patent Attorney, Head of Special Projects, Gorodissky & Partners

Vladimir graduated from the Moscow State Linguistic University as an interpreter (Spanish, English, and French) and from the Moscow University of Law as a lawyer. He started his legal career in 1973 at a major IP firm and furthered his studies at the Central Institute of Intellectual Property (Moscow). Vladimir joined Gorodissky & Partners in 1998, becoming partner in 2001.

Vladimir has considerable experience in counselling clients on Russian and foreign IP law, international IP treaties, conventions and agreements, technology transfer and licensing, infringement of IP rights, unfair competition, parallel import and copyright. He also advises clients on arbitration proceedings and licensing issues. He regularly represents clients in technically and legally complex infringement cases before the Russian courts, including the IP Court, covering a wide range of IP subjects.

Vladimir frequently speaks at conferences and seminars, both in Russia and abroad, as well as contributing articles to IP magazines in Russia and abroad.

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www.gorodissky.com
Safeguarding innovation: Maddock & Bright’s unwavering commitment to ethical excellence in IP law

As a managing partner at Maddock & Bright IP Law offices, overseeing operations in Egypt and several Mena region countries, Abdel Wahab Moustafa assures the development of Maddock & Bright IP Law Office (MBIO), the management of a team of patent, trademark, design attorneys, lawyers, and translators. M. Moustafa’s legal strategies, including administrative and court proceedings, undercover investigations, and border seizures, have enhanced MBIO's credibility. He is responsible for managing investigators focused on disrupting the production and distribution of counterfeit goods and prosecuting counterfeit purveyors, trademark and copyright enforcement, and anti-diversion strategies. He collaborated with the Japanese Patent Office on a project titled “Data Bank for Intellectual Property Information from Emerging Nations”, and authored articles on IP in Egypt and the Mena region. Notable works include Copyright Law in Egypt, Patent Enforcement in Morocco, Trade Secrets Protection in Egypt, and Fatal Pill. Mr. Moustafa’s multifaceted expertise, strategic leadership, and many contributions to international intellectual property initiatives underscore his pivotal role in shaping Maddock & Bright’s success in the dynamic landscape of legal practice.

Nada Ghazy Nasser is presently overseeing the Business Development Department and managing responsibilities within the Prosecution Department at Maddock & Bright. With an extensive academic background, she earned her PhD from Cairo University in the Department of English Language and Literature, showcasing her dedication to scholarly pursuits and academic excellence. Building upon this, she pursued her MA degree from the American University in Cairo in 2015. Her tenure at Maddock & Bright exemplifies her proficiency in business development, where she combines her academic ability with practical skills to fortify the firm’s standing in the realm of intellectual property rights. She actively engages in initiatives that promote education, language proficiency, and the advocacy of intellectual property rights within the broader community.

The essence of Maddock & Bright’s core values

At the heart of Maddock & Bright’s ethos lies a deep-rooted commitment to ethical practices. The firm recognizes the transformative power of intellectual property and understands the pivotal role it plays in shaping the world. In an industry where ethics can be challenged, Maddock & Bright places integrity at the forefront, ensuring that every legal solution provided aligns seamlessly with the highest standards of professional code of conduct, ethics, and clients’ privilege. Maddock & Bright’s dedication to its core values, including transparency, accountability, integrity, and client satisfaction, forms the core of its success. Maddock & Bright sees its role not just as protecting the interests of clients but as a safeguard to the very fabric of innovation that drives societal advancement.

Maddock & Bright’s core values are guiding principles that shape every facet of the firm’s operations. At the core is a profound commitment to integrity, which permeates through every interaction, decision, and strategy employed and implemented by the firm. This commitment to ethical conduct is not just an ideal but a fundamental pillar that upholds the trust bestowed upon Maddock & Bright and their clients.

Transparency forms the cornerstone of the firm’s approach, as Maddock & Bright believes that open communication is essential for fostering trust. Clients are kept informed at every step of the legal process, ensuring a collaborative relationship that goes beyond the traditional attorney-client dynamic. This dedication to transparency reflects Maddock & Bright’s belief that informed clients are empowered clients.

Accountability is another pillar that supports Maddock & Bright’s commitment to excellence. The firm takes responsibility for its actions, ensuring that clients receive not just legal solutions but a sense of security in knowing that their intellectual property concerns are handled with utmost care and diligence. In an industry often characterized by complexity, Maddock & Bright stands out for its straightforward, accountable, and client-centric approach.

Preserving global innovation: Maddock & Bright’s crucial role in safeguarding intellectual property

Maddock & Bright’s philosophy recognizes the global challenge of enforcement. The firm possesses strategic and tactical tools that enable the effective execution of court orders. The absence of vigorous Intellectual Property (IP) enforcement can have profound and far-reaching implications for global innovation, economic stability, and societal progress.

Offering tailored services designed to meet the specific demands of foreign companies and law firms entering the Middle East and North African Market, the firm delivers a meticulously customised and comprehensive array of services. Utilizing diverse expertise and a state-of-the-art technological capability, Maddock & Bright offers comprehensive legal assistance to foreign legitimate IP rights holders and foreign companies seeking protection and/or enforcement in the Mena region.

To celebrate their approaching 75th anniversary, Maddock & Bright express their dedication to the protection of innovation throughout the Mena region.
Maddock & Bright’s investigators deliver an extensive range of services and advice on brand protection, enforcement, and vital IP matters.

Our strategy:

1. Custom proceedings
2. White-collar crimes
3. Investigation and undercover operation
4. Trademark use and non-use investigation
5. Online monitoring and takedowns
6. Track and trace procedures
7. IP survey
8. Tests purchases (online & offline)
9. Company research
10. Surveillance
11. Factory/Warehouse findings
12. Raid support
13. Anti-counterfeiting program management
14. Police customs cooperation
15. Police customs training
16. Civil and criminal prosecution

Gray market investigation services:
Gray market pirated/counterfeit/infringed products are costing manufacturers millions of currency losses annually and it eventually may decrease the longevity of the original market. Maddock & Bright’s investigators deliver an extensive range of services and advice on brand protection, enforcement, and vital IP matters. The firm understands the value of brands and goes to great efforts to protect them.

Maddock & Bright’s services are customized and tailored to address the specific situations at hand, providing solutions to uncover the truth of the real scenario and safeguard brands from potential violations.

Protecting the world:
A distinguished mission
Countering counterfeiting through strategic investigation and undercover operation
Lack of IP protection contributes to an environment where counterfeit products and unauthorized use of intellectual property thrive. This not only erodes the market share of legitimate businesses but also hampers economic growth, creating economic disparities on a global scale. Counterfeiting and unauthorized use of intellectual property can flood the market with substandard or potentially harmful products. In this arena fraught with challenges, Maddock & Bright not only serves as a guardian of intellectual property but also as a shield for consumers. Our firm ensures that consumers are protected from the dangers posed by inferior or unsafe products.

It is important to note that there is a major global impact of counterfeiting, a menace that undermines the industries and economies of our world. The Anti-Counterfeiting Department at Maddock & Bright takes a formidable stance against this threat. By employing a combination of legal expertise and strategic foresight, the firm actively combats the proliferation of counterfeit goods, contributing to the creation of a safer and more authentic marketplace through a strategic anti-counterfeiting management program, an investigation management program, and an enforcement management program to support and assist Maddock & Bright’s litigation department in combating counterfeiting effectively.

How can your investigators support your litigators?
It is worth mentioning that working as a private investigator is not relaxing; the journey is not always easy because they often have to deal with several types of activities and carry out such investigations locally & internationally, which is a difficult task to perform for a lawyer and/or investigator if she or he are not well experienced and with very specific personal skills and/or a law enforcement background.

The Anti-Counterfeiting Department and Investigation & Undercover Operation

Parallel trade investigation services:
Maddock & Bright’s IP investigators understand the problem of parallel trade which is a growing issue in the field of violation of IP rights.

Department support the Litigation Department in their case-building through the following process subdivided into two steps: 1. academic and technical step (internal support) and 2. practical step (external support).

Academic & technical step (internal support)
Establish a concrete Internal Support Department:

- Database: to build a proactive, systematic, and collaborative process;
- Understand the finance, economy, and how business works;
- Know enough about intellectual property to perform necessary field work and gather evidence;
- Have a team with a law enforcement and/or governmental procedures background;
- Efficient team for non-field work;
- Acting as the bridge between the Legal, Marketing, Sales Departments, and/or Security Departments.

Practical step (external support)
- Identify who can do the undercover work;
- Support of local units is mandatory;
- Eyes and ears in the market;
- Support of our undercover operation by local units;
- Track & trace;
Maddock & Bright not only protects your ideas but fosters a legacy that redlines industries and inspires future generations of innovators.

Choosing Maddock & Bright: a collaborative partnership

In a world where progress relies on innovation, Maddock & Bright stands forth as a reliable partner. Beyond legal expertise, the firm’s distinct core values create a cooperative relationship with clients. The collaborative relationship ensures that the innovative spirit continues to thrive, safeguarded by a legal team that is not proficient but passionately dedicated to preserving the integrity of intellectual property. Maddock & Bright stands as a beacon of ethical excellence in the realm and field of intellectual property law. Through its unwavering commitment to transparency, accountability, and client satisfaction, the firm not only protects the interests of clients but actively contributes to safeguarding innovations on a global scale. In a world that needs guardians of intellectual property, Maddock & Bright emerges as a formidable stand, tall on a fortress of ethics, innovation, and legal ability. The firm uphold its guiding motto of “trust, consistency, and commitment is who we are” as a foundational belief. Maddock & Bright is committed to embodying justice in our daily lives, advocating not only for our clients but also for our communities, our fellow individuals, and the future generations of innovators.

Maddock & Bright not only protects your ideas but fosters a legacy that redlines industries and inspires future generations of innovators.
Directory of Services

TANZANIA

United Trademark & Patent Services
International Intellectual Property Attorneys

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

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Contact: M.F.I. Khan, SM. Ali & Maria Khan

TÜRKİYE

Destek Patent
Your IP Partner

Destek Patent was established in 1983 and has been a pioneer in the field of Intellectual Property Rights, providing consultancy services in trademark, patent and design registrations for almost 40 years.

Destek Patent provides its clients with excellence in IP consultancy through its 14 offices located in Türkiye, and via its associates in 19 countries. Besides its own offices, Destek Patent also provides IP services in 230 jurisdictions via its partners and associates.

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UNIFIED ARAB EMIRATES

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