



World Trademark Review Yearbook 2022/

2023


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A simple, easy-to-use digest of trademark regulations in key jurisdictions across the globe.

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Brands in Africa: the dos and the don'ts

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Africa is a vast continent and is often underestimated, both from a business but also from a brand protection perspective.

Africa's land mass exceeds that of India, China, the United States and Europe combined. It is also the second most populous continent, with over 1.3 billion people – or about 16.5% of the world's population. It has the world's largest free trade area. Business opportunities abound!

For brand owners, it makes sense to identify the business opportunity first and secure deals before thinking of brand protection. However, in an African context, it is prudent to secure protection of trademarks sooner rather than later. There are a host of reasons why brand protection should be top of mind when it comes to Africa. There are definite *dos* and *don'ts* in navigating the 54 countries, of which 52 have working trademark systems.

WHY AFRICA?

The continent has extensive natural resources, a young and increasingly educated workforce, more stability in terms of governance, and more prospects for economic growth than in the past. Africa is resource rich, with a third of the world's mineral resources and 10% of the planet's oil reserves, and contributes significantly to the gold and oil trades. Manufacturing services and tourism have been gaining traction. In Nigeria, the services sector now accounts for the bulk of its gross domestic product, with its Nollywood film industry surpassing that of Bollywood and is now second only to Hollywood. The continent has also been quick to adapt current technologies to supplement its weak infrastructure, using mobile technology to deliver novel financial platforms – such as M-Pesa – thus easing access to and stimulating trade.

A STRATEGY FOR AFRICA

A brand is a commercial asset and allows businesses to compete more efficiently, and protects businesses against infringement and unfair competition. Trademark squatters and counterfeiters have also discovered vast opportunities and often file applications for marks that are identical to, or incorporate elements of, internationally well-known brands. There are still jurisdictions where common law rights (user rights) or well-known marks are not recognised: the so-called first-to-file jurisdictions. Given the ever-growing reach of social media, brand owners should act quickly, lest they be blocked from trading in these markets. Unfortunately, brand owners often have to defend their rights without being able to rely on prior trademark registrations for their famous marks. This is not ideal and far costlier than creating a considered portfolio of trademark rights before the squatters and counterfeiters move in.

WHAT TO DO?

A strategy to protect and enforce any trademark portfolio will be informed by the commercial considerations of the business, followed by the legal merits of that strategy. An effective trademark strategy creates a clear picture of what rights need to be secured. This will put the business in a position to identify its objectives, and to measure successes and potential gaps. Protection and enforcement of trademark rights are interdependent and securing trademark registrations must form the foundation of any brand owner's enforcement strategy in Africa.

For most brand owners, the question is always where to start. This decision cannot be made without thoroughly considering the unique (and often challenging) African legal landscape. The laws are not uniform and brand owners will need expert guidance.

It is not only costly but also impractical to attempt to obtain trademark protection from east to west and north to south without first establishing the brand owner's business goals and identifying countries of interest, as well as strategically important jurisdictions. A trademark filing strategy will be informed by the business strategy for the next five to 10 years. The focus of the business strategy will often be only on the commercial priority of jurisdictions and this approach will not necessarily be successful in the African environment. The business focus should be influenced by the importance of securing and enforcing trademark rights in jurisdictions where trademark squatters and counterfeiters thrive. These considerations will have an impact on the overall priority of jurisdictions and even the ranking of trademarks.

A carefully tiered filing programme, which is typically rolled out over a period of five years in jurisdictions of importance (both from a business and trademark perspective) can offer effective protection. The strategy must always cover enforcement and anti-counterfeiting steps. Playing only a defensive game in Africa can cause substantial, unexpected costs and disappointment on the commercial side – a big *don't!*

DEFINITE DOS

There are a few important questions to ask in respect of brand owners' jurisdictions of interest.

- Can a trademark be protected in these jurisdictions and, if so, for goods and services?
- Is this a first-to-file jurisdiction or can the brand owner rely on user rights?
- How long does it take to get a trademark registered (the time periods can vary from a few months to several years)?
- What are the costs of obtaining and maintaining trademark registrations versus litigation costs to oppose or recover a mark, or both?
- What are the benefits of using regional filing systems including that of the Organisation Africaine de la Propriété Intellectuelle (OAPI) or the African Regional Intellectual Property Organization (ARIPO)?
- Has the country acceded to the Madrid Protocol and will using the Protocol compromise the rights of the brand owner (eg, where a country has not amended its domestic laws to give effect to international registrations)?
- Is the recordal of a licensee compulsory?

The next step in devising the strategy is to focus on proactive and reactive enforcement, including anti-counterfeiting measures, policing rights and an effective watch service in Africa.

After finalising the trademark strategy, the budgeting process will be much easier as a long-term plan will be in place. The filing programme can be rolled out in accordance with the budget. Such a strategy should, in time, result in fewer but more effective enforcement measures as the brand owner would have anticipated problems in specific jurisdictions.

LET'S TALK BASICS

There are two basic philosophical and legal approaches to trademark priority: first-to-file and first-to-use. Well-known marks should also be considered.

FIRST-TO-FILE JURISDICTIONS

The first-to-file rule is followed in most African territories. These jurisdictions must be prioritised in a trademark strategy.

The OAPI regional system (a centralised system covering 17 countries), follows the first-to-file rule. Trademarks can be opposed or a claim to ownership can be filed. The latter involves proving that the brand owner can claim ownership through use in the region or the mark being well known.

In Zambia, it is not possible to rely on earlier user rights in opposing a later application, following the DH Brothers High Court case. In many countries, competitors or counterfeiters use and often register the get-ups, or similar get-ups, but without the well-known house mark of brand owners. When user rights are not recognised, this can create a problem. Well-known animated characters also often feature in unauthorised label and logo marks. Depending on the jurisdiction, user or well-known rights may not be sufficient. Copyright cannot always be relied on in trademark oppositions and copyright must be pursued up to the appeal stage in the High Court in jurisdictions such as Morocco.

As most African countries and jurisdictions follow the first-to-file approach, it is critical to obtain registration as early as possible. Failure to do so can leave the business vulnerable to trademark squatting or counterfeits, or a current or former distributor could secure registration. Former distributors often have the chutzpah to register a well-known brand, threaten the new distributor with infringement and even use genuine packaging to sell their own products. If a brand owner wants to enter the market, or sell through another distributor, it will either first have to oppose or cancel the registration. Creative litigation solutions are possible, but absent registered rights, enforcement will inevitably be more complex and costly.

FIRST-TO-USE JURISDICTIONS

In countries where user rights are recognised (the first-to-use system), priority is given to those who are the first to use a trademark and can demonstrate evidence of that use if another party has applied to register that mark. The brand owner, however, must prove its earlier use. Detailed evidence must be compiled and a trademark application must be filed in any event. If there is no earlier use, proving that the mark is well known may be the only solution. This increases enforcement costs. The importance of securing registrations, even in first-to-use or jurisdictions where well-known marks are recognised, cannot be overstated. Enforcement will be much easier and results are certain.

Countries where a brand owner can rely on user rights include Botswana, Eswatini, the Gambia, Ghana, Kenya, Lesotho, Malawi, Namibia, Nigeria, Sierra Leone, South Africa, Tanzania, Uganda, Zimbabwe and Zanzibar.

WELL-KNOWN RIGHTS

Many African countries are signatories to the Paris Convention for the Protection of Industrial Property and well-known marks are recognised, although there are nuances when it comes to the extent of the recognition and proving such rights.

Typically, the brand owner must be able to establish that its trademark is well known in the country in issue. This will often require evidence of local use, promotion or, in some instances, spill-over advertising. Reliance on well-known rights alone can negatively impact the merits of taking enforcement action, particularly where there is insufficient evidence that the mark is well known locally.

Well-known rights are recognised, subject to nuances in each country, in Algeria, Botswana, Burundi, Cape Verde, the Democratic Republic of the Congo, Ethiopia, Djibouti, Egypt, the Gambia, Ghana, Kenya, Lesotho, Liberia, Libya, Malawi, Mauritius, Morocco, Mozambique, Nigeria, Rwanda, São Tomé and Príncipe, the Seychelles, South Africa, Sudan, Tanzania, Tunisia, Uganda, Zambia, Zanzibar and Zimbabwe, as well as the OAPI member states.

PRACTICAL EXAMPLES

Trademark squatting is an ongoing brand enforcement challenge. Companies or individuals seek registration of well-known trademarks often to circumvent anti-counterfeiting efforts.

In Nigeria, a major economy in Africa, local companies (with links to the manufacturers of counterfeit products abroad) apply to register well-known trademarks, but only prosecute those applications to the point of acceptance. That notice is then relied on by counterfeiters to convince customs officials that they own a trademark “registration”. The true brand owner’s application can be blocked by the earlier identical one, creating an impasse. Relief must be sought from the High Court, which involves costly, drawn-out litigation.

In countries such as Algeria, where user and well-known rights are not clearly enforceable absent registered rights, infringers open clone stores imitating obviously well-known brands, which closely resemble the original stores and outlets that have not yet been used or promoted locally by the brand owners. In Morocco, trademark squatting has become rife. Surprisingly, squatters defend oppositions even up to the appeal level.

THE SCOURGE OF COUNTERFEITS – WHAT TO DO?

Brand owners around the globe have embarked on business expansion plans to exploit the potential of their trademark rights, increase their market share and create an additional revenue stream in Africa. This trend has also created a fertile ground for the counterfeit goods trade, which is thriving in Africa.

There are challenges such as poor legislative framework, an unharmonised legislative landscape, unmonitored or porous borders, weak enforcement, limited resources and a lack of political will in some cases; however, these challenges are not insurmountable. It is possible to effectively address the counterfeit goods trade by partnering with a legal team familiar with the landscape and navigate around those challenges.

The most critical step in implementing an effective and sustainable anti-counterfeiting strategy is to record trademark rights with customs agencies. Formal customs recordal systems are possible in some, but not in the majority, of African countries, but informal recordals are possible in others. These recordals are a critical tool, and must be kept up to date and renewed. Kenya has recently amended its laws and is on the verge of implementing mandatory recordal with the Anti-Counterfeit Authority.

Brand owners are encouraged to conduct regular customs and police training (at local and regional levels) to create brand awareness and to demonstrate their commitment to the fight against the counterfeit goods trade.

It is equally important to conduct in-market investigations and regular surveys to understand the extent of the counterfeit goods problem and the flow of such goods, and to establish the identity of the retailers, (bulk) distributors and, importantly, manufacturers. The outcome of these investigations will ensure that an effective anti-counterfeiting strategy can be adopted, and brand owners must strategically and aggressively pursue criminal and civil remedies, especially against bulk importers, distributors, manufacturers and product completion centres. This approach will not only send a strong message to the market, but ensure that the problem is nipped in the bud.

Another important factor is the collaboration between local, regional and international enforcement agencies in several jurisdictions. This will enable law enforcement to impactfully tackle the practical challenges of transshipment and round-tripping of consignments between neighbouring countries, and assist with capacity building. The proper flow of information, an extensive network of investigators and the support of the World Customs Organization and Interpol have placed law enforcement in a position to identify new trends in the importation and movement of counterfeit goods across Africa.

Information is key to enable brand owners to formulate a cost-effective and sustainable enforcement strategy. As each country's intellectual property framework is different, a one size fits all approach is a **don't** and will not achieve meaningful results.

The **dos** for an anti-counterfeiting strategy include:


- border enforcement (formal and informal records);
- regular participation in law enforcement training;
- pursuing border detention cases against importers;
- conducting in-market surveys and intelligence-gathering exercises to understand the extent of the problem;
- pursuing in-market intelligence-driven search and seizure operations;
- exploring control delivery exercises, particularly for cross-border consignments of counterfeit goods;
- pursuing both civil and criminal proceedings, when warranted;
- supporting the police and prosecutors to achieve successful criminal convictions;
- exploring knock and talk exercises (where removal of counterfeit goods from the market is a priority) and voluntary surrenders, where appropriate; and
- conducting online investigations and dispatching cease and desist letters or submitting take-down notices on online platforms, or a combination thereof.

Many African countries have efficient regulatory authorities that are willing to participate in the fight against the counterfeit goods trade. They can assist with the removal of counterfeit goods in situations such as where packaging is in contravention of the labelling regulations, goods have been proven to be sub-standard or medicines are unregistered.

One unexpected side effect of the covid-19 pandemic in Africa was the migration of the sale of counterfeit goods onto online platforms, which has created significant challenges for law enforcement agencies. A hybrid of online and offline or traditional investigations has proven pivotal to infiltrate organised crime syndicates, which employ sophisticated strategies to circulate counterfeit goods online through websites, trading and social media platforms.

CONCLUSION

For brand owners, the African continent presents a huge, growing and dynamic market. With a focused and well-developed trademark strategy that involves securing registration for all key brands in relevant first-to-file jurisdictions and proactively policing and enforcement of rights in jurisdictions that are strategically important, successfully navigating the African continent from east to west and north to south is possible!

The logo for Adams & Adams, featuring the firm's name in a serif font with a thin blue underline.

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Sidestepping the Rogers two-step: clearing entertainment titles in a crowded social space

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Summary

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ADDITIONAL CONSIDERATIONS WHEN ROGERS MAY NOT APPLY

INTRODUCTION

A trademark practitioner seeking to clear an entertainment title for use in the United States will often find that the title has already been used, sometimes several times over – for example, an International Movie Database (IMDb) search for the title *Restless* displays 200 results. Beyond other entertainment titles, there are also considerations surrounding other similar marks for related goods and services. Add to that some uncertainty in recent case law and an overabundance of content on streaming services and social media – as well as more traditional television and film titles – and quite a challenge can arise. This chapter explores recent developments in US case law involving the balancing of First Amendment expression with Lanham Act trademark infringement claims in a media environment where new titles are proliferated daily through streaming platforms and social media.

For more than three decades, entertainment companies have relied on *Rogers v Grimaldi* to insulate themselves from Lanham Act claims when a mark or name is used in an entertainment title. In *Rogers*, Ginger Rogers sued the producers of a fictional film titled *Ginger and Fred* about aging Italian cabaret performers who imitated the famous dancing duo Ginger Rogers and Fred Astaire. The court in *Rogers* held that the Lanham Act did not apply to the use of celebrity names in a film title “unless [1] the title has no artistic relevance to the underlying work whatsoever, or, [2] if it has some artistic relevance, unless the title explicitly misleads as to the source or content of the work” (*Rogers*, paragraph 999).

Since then, courts expanded *Rogers* from celebrity names to all types of marks and applied the two-part balancing test to a variety of entertainment titles and content, including TV shows, books, paintings, songs and video games. In *Twentieth Century Fox Television v Empire Distribution, Inc* in 2017, the Ninth Circuit held that *Rogers* applied not only to the titles of expressive works, but also to consumer goods such as shirts and champagne glasses that bear the title of the artistic work.

In *Empire*, the music label Empire Distribution sued over the Fox TV series titled *Empire*, which portrayed a fictional hip hop music label named Empire Enterprises based in New York, and argued that *Rogers* did not apply to consumer goods branded with the series title. The court disagreed and said the “balance of First Amendment interests struck in *Rogers* . . . could be destabilised if the titles of expressive works were protected but could not be used to promote those works” (*Empire*, paragraph 1197). Thus, not only was the TV series held to not infringe Empire Distribution’s trademarks, but Fox’s promotional activities “auxiliary to the television show” also did not infringe.

IS THE EMPIRE OF ROGERS COMING TO AN END?

While the Ninth Circuit in *Empire* expanded the scope of *Rogers* beyond expressive works, US district courts in Colorado and Florida recently rejected the simplicity of the *Rogers* two-step balancing test. In *Stouffer v National Geographic Partners, LLC*, the court created and applied its own six-part test to dismiss infringement claims brought by the producers of the PBS TV series *Wild America* against National Geographic for its TV series titled *Untamed Americas, America the Wild, Surviving Wild America and America’s Wild Frontier*. The Colorado district court explained its rejection of *Rogers* by noting that other courts struggled “to assimilate unanticipated factual patterns into the *Rogers* test—factual patterns that raise legitimate concerns about whether *Rogers* tilts too far in favour of the junior user’s First Amendment interests” (*Stouffer*, paragraph 1140).

In *MGFB Properties Inc v ViacomCBS Inc*, the court found on summary judgment that the *MTV Floribama Shore* series did not infringe the FLORA-BAMA marks owned by a waterfront bar and entertainment venue located on the state line between Florida and Alabama. The court declined to apply *Rogers* to the title of a TV series, citing an exception for “misleading titles that are confusingly similar to other titles” because the plaintiff had licensed its FLORA-BAMA mark to Kenny Chesney for a song titled *Flora-Bama* and because artistic works were performed at the Flora-Bama venue (*MGFB Properties Inc*, footnote 6). Instead, the court applied the Eleventh Circuit’s seven-factor likelihood of confusion test after noting that “defendants would easily prevail on the Lanham Act claims” if the *Rogers* two-part test applied (*MGFB Properties Inc*, footnote 5).

MORE CONTENT, MORE TITLES, MORE RISK

While these recent decisions questioned the continued applicability of the *Rogers* two-part test to entertainment titles, the volume of entertainment content and titles is growing exponentially as streaming platforms, including social media, allow anyone with a digital recording device and access to the internet to become a creator. The most recent figures show that, as at June 2022, IMDb contained 11 million titles, while YouTube reports that more than 500 hours of content are uploaded to its platform every minute and Twitch’s press centre says that its platform has as many as eight million unique creators streaming each month. The Second Annual Stitcher Report, published on 7 July 2021, shows the continued growth of podcasts, with more than 400,000 podcasts published in 2020. These statistics illustrate an endless stream of new titles as well as common law rights in marks used in series titles and channel names.

Content providers may find it nearly impossible to select a title that is not at least somewhat like either an existing entertainment title (as in the case of the National Geographic series) or an existing mark (as in the case of the MTV series). Even the most generic terms incorporated into a title can run the risk of a trademark infringement suit. For example, UFO Magazine Inc recently sued the Showtime Network Inc over the use of “UFO” in the title of a docuseries about unidentified flying objects – UFOs. Therefore, trademark practitioners must help clients successfully navigate when a title may be used without trademark infringement or without using the title in a manner that is misleading as to the source of the content.

While courts’ approaches to balancing First Amendment rights with trademark rights may be somewhat inconsistent, the outcome of these cases still heavily favours First Amendment artistic expressions. That said, practitioners may want to consider additional factors beyond *Rogers* when advising entertainment companies on the risks associated with adopting a particular title. For example, the multi-factored analysis applied in the Colorado decision requires an examination of the artistic motives of the party accused of infringement, while the Florida court’s approach requires a full likelihood of confusion analysis.

ROSA PARKS AND HONEY BADGERS CARE ABOUT GRATUITOUS USES OF NAMES AND MARKS

The *Rogers* test was designed to avoid the multi-factored likelihood of confusion analysis and, when *Rogers* applies, Lanham Act claims are frequently (but not always) dismissed at summary judgment. When *Rogers* does not apply, either because a title has no artistic relevance to the underlying work or the title is explicitly misleading as to the source of the content, then courts still apply the likelihood of confusion factors to determine if the

entertainment title or content infringes an existing mark or otherwise violates the Lanham Act. When *Rogers* applies, courts are more likely to grant summary judgment.

Two examples where *Rogers* did not apply are the *Parks v LaFace Records* and *Gordon v Drape Creative Inc* cases. In *Parks*, the court reversed summary judgment for the defendant, record producer LaFace Records, for its use of “Rosa Parks” as the title of a rap song. The court held that civil rights icon Rosa Parks raised a genuine issue of material fact as to whether the use of her name as a song title and on an album cover was artistically relevant to the content of the song (ie, the first prong of the *Rogers* test) or “nothing more than a misleading advertisement for the sale of the song” (*Parks*, paragraph 458).

In *Gordon*, the court reversed summary judgment for the greeting card company Drape Creative for its use of comedian Christopher Gordon’s trademarks for his catchphrases “honey badger don’t care” and “honey badger don’t give a shit” used in popular YouTube videos. Gordon had registered HONEY BADGER DON’T CARE for a variety of merchandise, including greeting cards, and Drape Creative used slight variations of Gordon’s marks on its greeting cards. Gordon raised a genuine issue of material fact as to whether the use of a mark on a greeting card is explicitly misleading (ie, the second prong of the *Rogers* test).

PLAINTIFFS CAN’T FLY AWAY FROM OR HIDE FROM ROGERS AT THE PLEADING STAGE

The Colorado court in *Stouffer* referenced the *Parks* and *Gordon* decisions as examples for why *Rogers* should “not be adopted as is” because, even when *Rogers* applies, cases may still require discovery and summary judgment (*Stouffer*, paragraphs 1140–1141). However, other courts have applied *Rogers* to dismiss infringement claims brought against entertainment titles at the pleading stage (eg, under a Federal Rule 12(b)(6) motion to dismiss for failure to plead a viable claim).

For example, in *Reflex Media Inc v Pilgrim Studios Inc*, the plaintiff used *Love at First Flight* as the title of a web series that followed individuals travelling to a romantic getaway for a first date. The defendant adopted an identical title for its TV series featuring stories about travelling to go on dates. The court found that the complaint failed to allege that the defendant’s title was not artistically relevant to the work or that the title explicitly misled as to the source of the work. Thus, even in a situation where identical titles were used for conceptually similar content, a court found that *Rogers* required dismissal of the complaint.

Similarly, in *Hidden City v ABC Inc*, the plaintiff operated a journalism website titled ‘Hidden City Philadelphia’ that published news stories about Philadelphia, while the defendant produced a series of videos titled *Hidden Philadelphia* about visiting little-known places in Philadelphia. In dismissing the pleading, the court found that defendant’s title “easily meets the first element of the *Rogers* test” as a series about places in Philadelphia not commonly known to the public (*Hidden City*, footnote 4). On the second prong, the court listed several factors that warranted dismissal at the pleading state:

- the titles were not identical;
- the complaint did not allege that the plaintiff was affiliated with its videos; and
- the videos appeared on an ABC website with the ABC logo.

COLORADO COURT TAMES PLAINTIFF’S TRADEMARK CLAIMS

A deeper analysis of the *Stouffer* case suggests that, although it rejected *Rogers*, the application of its own test is relatively similar. In *Stouffer*, the plaintiffs were the producers

of the *Wild America* nature documentary series that ran on PBS from 1982 through 1996, with continued distribution through streaming platforms. They also own a registration for the WILD AMERICA mark for a TV series. After the plaintiffs denied National Geographic's request to use *Wild America* as title for a nature series 2010, it went forward with four successive series titled *Untamed Americas* (2012), *America the Wild* (2013), *Surviving Wild America* (2014) and *America's Wild Frontier* (2018) (*Stouffer*, paragraph 1139).

The *Stouffer* court criticised *Rogers* and *Empire* as tilting too far in favour of the junior user's First Amendment rights. Instead, the court used the following six-factor balancing test that examines the junior user's "artistic motives" in adopting the titles (*Stouffer*, paragraph 1140).

1. Do the senior and junior users use the mark to identify the same kind, or a similar kind, of goods or services?
2. To what extent has the junior user "added their own expressive content to the work beyond the mark itself"?
3. Does the timing of the junior user's use in any way suggest a motive to capitalise on the popularity of the senior user's mark?
4. In what way is the mark artistically related to the underlying work, service or product?
5. Has the junior user made any statement to the public or engaged in any conduct known to the public that suggests a non-artistic motive? This would include "explicitly misleading" statements but is not confined to that definition.
6. Has the junior user made any statement in private or engaged in any conduct in private that suggests a non-artistic motive?

Analysis of this test reveals that factors (4), (5) and (6) appear to apply *Rogers* by looking at artistic relevance and then exploring if the junior user has made any "explicitly misleading" statements publicly or privately that suggest a non-artistic motive. Therefore, despite announcing this new six-factor test, the court appeared to rely most heavily on artistic relevance when dismissing the complaint (*Stouffer*, paragraph 1145, internal citations omitted).

[T]he fact that National Geographic is using its titles to describe the content of the Accused Series weighs heavily in National Geographic's favour. The choice of a title for one's expressive creation is an expressive choice unto itself, including the choice of a descriptive title. Each of the Accused Series substantially focuses on America's wildlands. While the English language is notably quite expansive, the range of words to describe such programming is limited. Yet *Stouffer* would not allow even a synonym for "wild" (i.e., "Untamed Americas"). If trademarked words themselves and their synonyms are off-limits, then the artistic choice regarding a title becomes significantly constricted.

In sum, although the Colorado court believes that the focus should be on the junior user's motives, the application of the test appears to reach the same result as if the court had simply applied *Rogers*.

FIRST AMENDMENT DOMINATES THE FLORIDA COURT'S LIKELIHOOD OF CONFUSION ANALYSIS

Similar to *Stouffer*, while the *MGFB Properties Inc* court stated that *Rogers* did not apply to those facts, had the court applied *Rogers*, it would likely have come to the same conclusion. The *MGFB Properties Inc* decision adopted a rule that the *Rogers* test does not apply at all when “misleading titles are confusingly similar to other titles”, which is language that appears in a *Rogers* footnote (*MGFB Properties Inc*, footnote 3, quoting *Rogers*, paragraph 999, footnote 5). Moreover, the Florida district court seemed to struggle to even classify the MGFB’s use of its FLORA-BAMA mark as a title. Instead, the court appeared to rely upon the licensing of the mark for a song and that the entertainment events occur at the Flora-Bama bar. Nonetheless, the court held that *Rogers* did not apply but then analysed the trademark infringement claim with a shout-out to the First Amendment that tipped the balance in favour of the MTV series (*MGFB Properties Inc*, footnote 8).

The defendants have never depicted or even referred to the plaintiffs’ facility on the show. The graphic displays of the two marks are entirely dissimilar. Aside from their show’s title, the defendants have done nothing that comes close to trademark infringement.

This analysis looks suspiciously similar to the “explicitly misleading” language found in the second factor of the *Rogers* test.

ADDITIONAL CONSIDERATIONS WHEN ROGERS MAY NOT APPLY

Stouffer and *MGFB Properties Inc* suggest that a rote application of *Rogers* may be inadequate, at least in Colorado and Florida courts. Thus, a clearance opinion for an entertainment title should also consider the following.

- Motive of the junior user: it is important to explore why a client selected a particular title and identify an “artistic motive” for the selection to explain why a use is not gratuitous.
- Context of the use: the context of the use explores how consumers will encounter the title. For example, will the title ever be encountered apart from marks that identify the source, such as ABC in the *Hidden City* case or MTV in the *MGFB Properties Inc* case?
- Distribution channels: is there any overlap in the distribution channels for the junior and senior user’s content?
- Similarity of the content: distinguishing the junior user’s content from a senior user’s content is also important. Even if themes and concepts may be similar – as is often the case when titles are similar – there are often important differences.
- Consumer perception: will consumers perceive the use of a mark or a name in a title as describing the content or will they perceive the use as creating a connection to the senior user?



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Hungarian Curia puts trademark law into equilibrium

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Summary

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When the so-called Gömböc object (in colloquial language, this term refers to a short and chubby person) was developed in 2006 by two Hungarian scientists, Gábor Domokos and Péter Várkonyi, it had a significant effect on various fields from mathematics to pharmaceutical research.

The Gömböc is the first convex, homogeneous, mono-monostatic object. Although it was common knowledge among mathematicians – a Russian mathematician, Vladimir Igorevics Arnold, presented it in 1995 – that such an object was possible in theory, Domokos and Várkonyi were the first to produce a physical version of it.

The Gömböc has one unstable and one stable equilibrium. If placed on a horizontal surface in an arbitrary position, the Gömböc returns to the stable equilibrium point. The single unstable equilibrium point of the Gömböc is on the opposite side. It is possible to balance the body in this position, although the slightest disturbance makes it fall, similar to a pencil balanced on its tip.

It is easily understandable that Domokos and Várkonyi – who worked for decades on the Gömböc – wanted to afford the fullest IP protection to their product.

REGISTRATION

The applicants' first step was to obtain a registered Community design in 2007 for the whole European Union (000677091-0001). However, they wanted to expand the scope of their IP rights, and so they applied for a three-dimensional (3D) trademark at the Hungarian Intellectual Property Office (HIPO). The application was filed for:

- Class 14 – decorative objects;
- Class 21 – decorative objects made of glass and ceramics; and
- Class 28 – toys.

REFUSAL

The HIPO, in Decision No. M1500325/11, refused their application based on Section 2 of the Hungarian Trademark Act.

The section referred by the HIPO, and the subparagraphs therein, are in line with the EU Trademark Regulation. The relevant section of the Trademark Act states that the following cannot be registered:

Signs which consist exclusively of: [...] (ii) the shape, or another characteristic, of goods which is necessary to obtain a technical result; (iii) the shape, or another characteristic, which gives substantial value to the goods.

Regarding the first ground for refusal, the HIPO found that the Gömböc can only function as a toy because of its shape, as the shape allows it to turn to its stable balanced position. Therefore, the technical content determines the shape. All the essential elements of the sign at issue were designed to obtain that technical result. Therefore, the informed and reasonable consumer is going to consider the sign as a shape necessary to obtain the technical result, instead of a sign marking the origin of the product. The HIPO thought that the registration would unfairly limit competitors.

Regarding the second grounds for refusal, the HIPO refused the application because the 3D shape represented in the sign possessed a striking and attractive shape, which is an essential element in the marketing of the goods. Consumers purchase decorative objects because of the special design. In theory, it cannot be ruled out that 3D decorative objects can obtain trademark protection, but where it is the upfront style of such objects that determines their formal appearance, the value of the product resides in that shape. In both cases, the HIPO found that the function, shape and characteristic was well known to the public as there were webpages, various instances of press coverage and public events available prior to the filing date of the 3D trademark.

APPEALS

The applicants then filed a petition for revision at the Metropolitan Court (MC) asking the MC to alter the HIPO's decision because the HIPO failed to examine several attributes that were not visible in the 3D shape. The actual relation between function and shape should be considered, and not the perception of the consumers. The MC rejected the petition for revision, but gave different grounds for refusal. In the case of the toy in question, it stated that it is impossible to consider the public's perception of the link between the shape of the good and the technical result. The presence of such a link is an objective and a technical fact. As a decorative object, the MC held, in Decision No. 3 Pk 22,729/2016/7, that the substantial value of the Gömböc lies not merely in its aesthetic qualities, but in the underlying discovery – the "tangible mathematics" – embodied in the shape that gives it substantial value. Consumers would like to own the Gömböc not as a nicely designed object, but as a representation of such tangible mathematics.

The applicants appealed the decision, but the Metropolitan Court of Appeal (MCA) upheld the first instance court decision and agreed with the rejection of the application, but its reasoning also differed. The MCA stated that the single photograph attached to the application was not enough to determine the question of functionality and shape, and therefore confirmed only the second ground of rejection that the trademark application consist of a shape or other characteristic that gives the goods substantial value.

REVIEW

The applicants asked for the review of the decision from the Curia, Hungary's supreme court. The Curia considered that the HIPO and the first and second instance courts had different reasons and the relevant case law were also not clear, therefore the Curia requested a preliminary ruling before the Court of Justice of the European Union (CJEU).

The following questions were asked:

1. Must Article 3(1)(e)(ii) of Directive 2008/95, in the case of a sign consisting exclusively of the shape of the product, be interpreted as meaning that:
 1. it is, on the basis of the graphic representation contained in the register alone, that it may be determined whether the shape is necessary to obtain the technical result sought; or
 2. may the perception of the relevant public also be taken into account?

2. Must Article 3(1)(e)(iii) of Directive 2008/95 be interpreted as meaning that that ground for refusal is applicable to a sign that consists exclusively of the shape of the product where it is only by taking into account the perception or knowledge of the buyer as regards the product that is graphically represented that it is possible to establish that the shape gives substantial value to the product?
3. Must Article 3(1)(e)(iii) of Directive 2008/95 be interpreted as meaning that that ground for refusal is applicable to a sign, consisting exclusively of the shape of a product
 1. which, by virtue of its individual character, already enjoys the protection conferred on designs; or
 2. the aesthetic appearance of which gives the product a certain value?

In Judgment No. C-237/19 of 23 April 2020, the CJEU examined and answered the questions as follows.

QUESTION 1

In response to the first question, the CJEU stated that the correct application of the ground for refusal of the registration set out in Article 3(1)(e)(ii) of Directive (EU) 2008/95 required the referring court to carry out a two-step analysis: first, the competent authority must identify the essential characteristics of the 3D shape; and second, it must establish whether they perform a technical function of the product concerned.

The Curia's first question was aimed at the issue of whether it is enough to perform a simple virtual analysis of the sign or the applicable public's perception should also be examined. The CJEU adduced its earlier decisions, such as the red LEGO brick (Case No. C 48/09 P). This decision, in paragraph 52, stated that:

the presence of one or more minor arbitrary elements in a three-dimensional sign, all of whose essential characteristics are dictated by the technical solution to which that sign gives effect, does not alter the conclusion that the sign consists exclusively of the shape of goods which is necessary to obtain a technical result.

The same decision, in paragraph 45, also stated that:

the prohibition on registration as a trade mark of any sign consisting of the shape of goods which is necessary to obtain a technical result ensures that undertakings may not use trade mark law in order to perpetuate, indefinitely, exclusive rights relating to technical solutions.

The correct application of that ground for refusal requires that the authority deciding on the application for registration of the sign must:

- first, properly identify the essential characteristics of the 3D sign at issue; and
-

second, establish whether they perform a technical function of the product concerned.

During the first step, the competent authority can perform the assessment directly on the overall impression produced by the sign or examine, in turn, each of the components of the sign.

During every assessment and examination by the competent authorities, the perception of the relevant public and other necessary information can be used, but such information must originate from a reliable source.

QUESTION 2

The second question was in relation to Article 3(1)(e)(iii) of Directive (EU) 2008/95, which concerns shapes the characteristics of which influence the attractiveness of the product, such that it adds substantial value to the goods and a trademark in that shape would distort competition in the relevant market. Here, the technical functionality of the shape is irrelevant. The CJEU stated that:

the application of this ground for refusal is based therefore on an objective analysis, intended to demonstrate that the shape in question, on account of its characteristics, has such a great influence on the attractiveness of the product that restricting the benefit of the shape to a single undertaking would distort the conditions of competition on the market concerned.

In the cases of Class 14 and Class 21, the MC considered the fact that the tangible mathematical characteristic provides substantial value. The perception or knowledge of the relevant public can be referred to in a refusal decision but there must be an objective and reliable piece of evidence asserting that the consumer's decision to purchase the product in question is, to a large extent, determined by that characteristic.

QUESTION 3

The final question of the Curia concerned the interaction between Article 3(1)(e)(iii) of Directive (EU) 2008/95 and the protection afforded under European design law, as well as the application of Article 3(1)(e)(iii) where the relevant sign consists exclusively of the shape of a decorative item. The CJEU found that design law differs from trademark law and the existence of a design protection cannot automatically exclude a trademark protection, provided that the conditions for registration of that sign as a trademark are met. Regarding the second part, the competent authority should examine whether the sign at issue consists exclusively of the shape that gives substantial value to the goods.



Source: photograph of a Gömböc statue taken by Kicsinyul, distributed under a CC licence.

OBSERVATION

The applicants stated that the HIPO and the courts did not use evidence from objective origins, as the CJEU required in its decision. Therefore, the HIPO must perform a technical analysis to determine whether the sign consists of substantial elements that achieve the function of the goods. The considered consumers' knowledge (the shape is necessary to achieve the mechanical effect, the standing up) was false. For the Gömböc, the scientific breakthrough was to eliminate the more than one unstable equilibrium position and the standing up is a side effect. Regarding the question of whether the sign consists of a shape or other characteristic that gives the goods substantial value, the applicants stated that, in this case, the value of the Gömböc consists of elements that are not derivable from the shape, such as the history of its development and its developers.

DECISION

The Curia reasoned that it is obvious that the public can identify from the trademark application that it concerns the Gömböc, a mono-monostatic object of a particular shape, which is convex, homogeneous and always returns to its stable equilibrium. These features cannot be established from the trademark application, therefore other factors should be considered, such as the knowledge of the relevant public.

Regarding the technical function of the shape, objective sources were necessary to determine if the shape and material of the Gömböc were solely intended to ensure that the Gömböc always returns to its stable equilibrium. This does not have to be the opinions of experts as there are numerous other possibilities given by the HIPO, such as descriptions, publications, websites and promotional materials. It was clear from the case files that the characteristics of the Gömböc were designed to achieve the intended technical result.

The Gömböc can function as a toy due to the technical result achieved by the shape and therefore the shape is excluded from trademark protection under Class 28.

Regarding the issue of substantial value of the shape, the first step of the examination is similar to the one above. The sign applied for is the shape of the Gömböc and its essential

characteristics are known by the relevant public. However, it is not obvious for the Gömböc what gives it its essential value. There were differing opinions offered during the HIPO procedure and by the first and second instance court about the substantial value. The HIPO and second instance court saw it in the design, while the first instance court saw it in the tangible mathematics. The Curia had the same reasoning as the latter. According to the Curia, the public would purchase these objects based on the symbolic scientific value. Therefore, the unique shape of the Gömböc cannot be protected as a trademark for decorative objects in Classes 14 and 21.

CONCLUSION

The Curia, by following the CJEU's answers, set out that, to establish functionality, not only information from the trademark application itself can be taken into account but also information that is available before the filing date of the application, such as press coverage, websites and online shops from which a link between the form and function can be objectively deduced.

While it was clear from the CJEU's decision that the existence of a registered design per se does not exclude the shape from trademark registration, the Curia also made it clear that it is not the design of the product or the fact that shape as such is ornamental that renders substantial value to the product, but other objectively available information, such as the mathematical discovery that triggers consumers to purchase or hold the product.

The CJEU and Curia decisions firmly set the guidance that the functionality and substantial value exclusion clauses of European trademark laws are to be interpreted in such a way that objective and reliable information on the shape or the sign must be taken into account when determining the registrability of the trademark. In the present case, objective and reliable third party and own sources were available long before filing date of the trademark application. It is yet to be determined whether information or documents available to the public after the filing date may be taken into account. In our view, such documents that were made available after the priority date cannot be taken into account during the application's absolute grounds check. The same would apply in the case of an *ex tunc* invalidity action, as the relevant point in time of the assessment is the priority date of the contested trademark.

One thing seems to be clear: it is crucial to file applications for a registered design and a trademark for the same product or shape with the same priority (on the same day), while keeping all information concerning the product confidential until this time. It is yet to be seen if a shape such as the Gömböc can be registered and whether its registration may be cancelled based on other legal grounds, such as loss of distinctiveness due to its scientific value.

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LEGAL FRAMEWORK

No separate trademark laws exist in the Netherlands, Belgium and Luxembourg. Benelux trademark law is governed by the Benelux Convention on Intellectual Property, the current version of which entered into force on 1 March 2019. The first version of the Convention replaced the Benelux Trademark Law 1971, which was the first law providing uniform trademark protection in multiple EU member states. The Convention is in line with the EU Trademarks Directive (2015/2436, 16 December 2015), and thus is similar in material aspects and provides similar rights.

The Benelux is a member to all major international trademark treaties and agreements, including the Paris Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights, the Madrid Agreement and Protocol, the Nice Agreement and the Locarno Agreement.

The EU IP Enforcement Directive (2004/48), which provides specific remedies for IP rights infringement, has been implemented in the national laws of the Benelux countries.

UNREGISTERED MARKS

The Benelux Convention on Intellectual Property does not provide for protection of unregistered trademarks, the only exception being the protection of well-known marks as prescribed by the Paris Convention. When no registration exists, no trademark rights can be invoked. Timely registration is therefore of the essence.

REGISTERED MARKS

WHO CAN APPLY?

As a rule, anyone can apply for trademark protection in the Benelux. However, special requirements exist with respect to ownership of collective marks and certification marks. The representative's place of residence or registered office should be in the European Economic Area.

FORMAL REQUIREMENTS

No power of attorney is required for filing for trademark protection in the Benelux (or the European Union). The filing of a power of attorney, however, is required in the case of a request for withdrawal or limitation of a trademark. A priority claim must be substantiated but can be done by means of a scan or photocopy of the priority document.

WHAT CAN AND CANNOT BE PROTECTED?

The legal definition of a trademark in Benelux is quite broad. The requirement of graphical representation has also been abolished. Benelux legislation and practice regarding the admissibility of trademarks are largely in line with European practice. Despite changes in the law effective as of 1 June 2018 and 1 March 2019, non-traditional trademarks, especially three-dimensional trademarks, are generally difficult to obtain.

COSTS

The Benelux has a fee-per-class system. As at January 2022, the official fees were:

- €244 for an application in one class;

- €27 for the second class; and
- €81 for each additional class.

There are no official publication or registration fees. Renewals are calculated in a similar manner:

- €263 for the first class;
- €29 for the second class; and
- €87 for the third and subsequent classes.

Additional fees are due for expedited applications (registration being obtained in 48 hours) as well as collective and certification trademark applications.

PROCEDURES

EXAMINATION PROCEDURE

The Benelux Office for Intellectual Property (BOIP) maintains the Benelux Trademarks Register. The registration procedure is almost entirely done electronically and is fairly efficient.

An application is checked on formal grounds and subsequently on absolute grounds. No check on relative grounds is conducted. After publication, the two-months' opposition period commences. This term is not extendible.

In the absence of objections, the application will proceed to registration in approximately four months. If an office action or refusal is issued, the applicant is granted an initial term of one month to overcome such objections, which may be extended to a maximum of six months. If an expedited registration is requested (under payment of the above-mentioned additional fee), an accelerated check on formalities is conducted. If no objections arise, the mark is registered within two working days. With this type of application, the check on absolute grounds and publication takes place after registration, which implies that the registration may be cancelled eventually.

OPPOSITION

An opposition can be lodged on the basis of a prior identical or similar trademark application or registration for identical or similar goods. Opposition may also be filed on the basis of a mark with a reputation against a mark applied for dissimilar goods, provided that the younger mark takes unfair advantage of, or is detrimental to, the distinctive character or reputation of the earlier mark.

Also, and in line with Article *6bis* of the Paris Convention, an opposition may be filed based on a non-registered well-known mark. A more recent development is that the grounds for opposition have been extended to unauthorised filings by agents and protected designations of origin and geographical indications.

The opposition grounds do not need to be substantiated within the opposition form, thus it is possible merely to file a formal opposition. An opposition must be filed prior to the end of the two-month publication period (or the next working day if the term ends on a day that is not a working day).

Opposition fees are €1,045 – a relatively high amount, the effects of which are, however, mitigated by the rule that only 40% thereof needs to be paid at the time of filing the opposition. Only when a case is not settled within the reglementary cooling-off period is the remaining 60% of the fee payable.

The opposition procedure is similar to the opposition proceedings before the EUIPO. When the opposition is deemed admissible, the statutory two-month cooling-off period starts – the term of which can be extended with the consent of both parties for four month-long terms until an amicable settlement has been reached. When no extension is applied for, the opponent must file its arguments and further evidence within two months. Subsequently, the defendant or applicant is granted a two-month period to file counterarguments and request proof of use (where applicable). When both parties have filed arguments (and, where applicable, have exchanged proof of use and comments), the BOIP will issue a decision.

The language of the opposition proceedings is the language in which the application was filed (ie, Dutch, French or English). This standard language can be changed, but only with the consent of the trademark applicant. If the application was filed in English, however, the language of the proceedings may be chosen by the opponent.

If the opposition is awarded or rejected in full, the opposition fees of €1,045 must be borne by the losing party. The cost decision constitutes an enforceable judgment.

APPEAL

Appeals against decisions issued by the BOIP must be brought before the second chamber of the Benelux Court of Justice. The appeal deadline ends two months after the notification of the final BOIP decision.

REGISTRATION

Registrations are valid for 10 years from the application date. The use requirement commences five years from the date of registration.

REMOVAL FROM THE REGISTER

Any interested party, including the public prosecutor, may invoke the nullity of the registration and the registration may consequently be invalidated by the courts if the mark:

- is a sign that is not distinctive;
- is misleading; or
- has become the usual denomination for the goods or services involved.

In addition, nullity may be requested if the mark involved:

- was filed in bad faith;
- is contrary to public order or morals;
- conflicts with Article 6~~ter~~ of the Paris Convention;
- conflicts with a geographical indication or constitutes a so-called agent mark;
- is similar or identical to a prior trademark registered for similar or identical goods or services; or
-

is similar to a trademark with a reputation in the Benelux for dissimilar goods or services or is similar to a well-known trademark (in the sense of Article 6*bis* of the Paris Convention).

Finally, revocation may be requested if the mark has not been put to genuine use within five years of registration. Use by a licensee (and indeed any genuine use with prior authorisation from the mark owner) is sufficient to maintain rights in a Benelux mark.

Any interested person can apply for cancellation (on the basis of non-use) or invalidity (on the basis of a prior right) with the BOIP. The proceedings with the BOIP are generally swifter and less expensive compared to court proceedings. Moreover, the proceedings generally follow the same structure as Benelux opposition proceedings, and EU cancellation and nullity proceedings.

SEARCH OPTION

The BOIP does not carry out an examination on relative grounds during the registration procedure. The BOIP does provide a useful and comprehensive search tool (also available in English), which can be accessed at www.boip.int/en/trademarks-register. When this search tool does not suffice, the TMview trademark search engine is also useful (www.tmdn.org/tmview/welcome).

ENFORCEMENT

The enforcement of registered trademark rights in the Benelux is efficient. While there is no single specialised court for general trademark disputes, most district courts and courts of appeal have judges who focus on IP matters. Due to its exclusive jurisdiction for European trademark and design matters, the Hague District Court has highly specialised judges.

Most infringement actions will relate to the use of an identical or similar sign for identical or similar products or services. In addition, an action can be brought based on infringement of a well-known trademark.

Remedies sought can first consist of an injunction, after which a recall of infringing products can be demanded, as well as surrender or destruction of the infringing products. In addition, the infringer may be summoned to provide all relevant information enabling the plaintiff to calculate the damages caused by the infringement. This information may include the number of infringing products bought, sold and still in stock, along with the profits made. In addition, the infringer can be ordered to provide the contact details of the supplier of the infringing goods. In both summary and main proceedings, a claim may be brought for compensation of the legal costs incurred in ending the infringement. This works both ways; if the defendant prevails, they may also request compensation of their legal costs. It is not possible to claim punitive damages in the Benelux.

In the case of trademark infringement, a rights holder may bring a claim for the surrender of profits made by the infringer from the sale of the infringing products. A claim for compensation of damages can, however, be brought only in proceedings on the merits.

Interim relief is available. Under certain circumstances (particularly a threat of irreparable damage to the trademark owner), *ex parte* injunctions are also available. An application for an *ex parte* injunction is granted only if the plaintiff can make a prima facie case of infringement. Additional claims, such as a request for compensation of damages, cannot be granted in *ex parte* cases. As a rule, interim relief can be obtained provided that the infringement persists.

The trademark owner must proceed with initiating proceedings on the merit to prevent an interim relief decision from losing its effect.

The time limit for action against a registration filed in good faith is five years, as an effect of the rule of acquiescence. The holder of a prior trademark that has acquiesced for a period of five successive years in the use of a registered later trademark, while being aware of such use, will no longer be entitled to prohibit the use of the later trademark (Article 2.30 of the Benelux Convention on Intellectual Property). This rule does not apply when the younger mark was filed in bad faith.

The timeframe for the resolution of an enforcement action for registered and unregistered rights will depend on the type of remedy sought. *Ex parte* injunctions and interim relief can be obtained almost immediately, if the case is sufficiently urgent. As a rule, interim relief cases will be decided within approximately 14 days. Cases on the merits are commonly decided in six to 12 months.

Finally, although trademark infringement is mentioned in the Dutch Penal Code, public prosecutors do not show a great interest in pursuing common IP cases in the Netherlands. An exception may be IP infringement cases that are interconnected with large criminal cases.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Assignment is possible without the goodwill of the business but must be in writing. Recordal of assignments, licences and liens with the BOIP is efficient and straightforward. A scan or photocopy of the underlying document will usually suffice. For recordation of a licence, lien or limitation, an executed power of attorney of all parties concerned is required. Again, a scan or photocopy of the document will usually suffice. No notarisation or legalisation is required.

RELATED RIGHTS

In the case of service marks that also constitute the company name, it is likely that trade name rights apply. These rights are governed by the Dutch, Belgian and Luxembourg trade name laws.

Device marks, or combined word or device marks, may under circumstances also be protected under the copyright laws of the Benelux countries, as the scope of protection under such laws is not limited to artistic works and the threshold for copyright protection in the Benelux is considered to be fairly low. However, copyrights are dealt with on a national level.

Design rights are governed by the design chapters in the Benelux Convention on Intellectual Property, as well as European legislation. When it comes to unfair competition, various national laws against unfair competition come into play. In the Netherlands, for example, slavish imitation may be considered a form of tort. However, as a rule, a claim of unfair competition will require additional circumstances, and slavish imitation is, therefore, commonly claimed only in conjunction with a claim of infringement of other IP rights.

ONLINE ISSUES

On the basis of registered trademark rights, among other things, the trademark owner can object to unauthorised use in domain names, websites, hyperlinks, online ads and metatags. Benelux legislation provides no specific provisions regarding online IP matters.

The courts have exclusive jurisdiction over these proceedings (apart from dispute resolution policy options).

The '.nl' Dispute Regulation Policy (2008, amended in 2013) provides the legal framework for taking action against a conflicting '.nl' domain name. The WIPO Arbitration and Mediation Centre is the administrative body in this respect.

The centre may order the transfer of the domain name when the domain name is identical or confusingly similar to:

- a trademark or trade name protected under Dutch law in which the complainant has rights;
- a personal name registered in the General Municipal Register in the Netherlands, or the name of a Dutch public legal entity, association or foundation registered in the Netherlands under which the complainant undertakes public activities on a permanent basis;
- the registrant has no rights to or legitimate interests in the domain name; and
- the domain name has been registered or is being used in bad faith.

The WIPO arbitration system works very efficiently, and Dutch arbiters are considered to be experts in their field, so that UDRP proceedings will generally form a cost-effective solution for '.nl' domain name conflicts. In Belgium, the legal situation is very comparable. Next to court proceedings, it is possible to initiate ADR proceedings at the Belgian Center for Arbitration and Mediation (CEPANI). In the event of a dispute regarding a .lu domain name, legal proceedings would be necessary. The .lu registry's range of action is limited to enforcing court decisions.

No	No	Yes: all regular unconventional marks are eligible for registration.
No	Yes	Yes: two - month term from publication date.
Yes: five - year term from registration date.	Yes	Yes
Yes: however, preliminary measures are possible through all courts	Yes	Yes: no specific term.
No	No	Yes



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Brazil: Trademark procedures and strategies

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LEGAL FRAMEWORK

In Brazil, trademarks are governed by the Law on Industrial Property No. 9,279/1996 (the Industrial Property Law).

Brazil is a party to the following international treaties:

- the Paris Convention for the Protection of Industrial Property;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks; and
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

UNREGISTERED MARKS

As a general rule, the Industrial Property Law states that ownership of a mark is acquired through a granted registration, following which the rights holder has the right to exclusive use of the trademark throughout the national territory. However, the law also provides protection for owners of marks that have not yet been registered with the Brazilian Patent and Trademark Office (BPTO). An example is the right of prior use, which establishes that any person who, at the date of priority or filing date of the application, has been using in good faith an identical or similar mark for at least six months to distinguish or certify an identical or similar product or service has a preferential right to registration.

Another example is trademarks that are well known in their field of activity, as per Article 6*bis*-(1) of the Paris Convention. Well-known trademarks are given special protection regardless of whether they have been previously filed or registered in Brazil. The BPTO has powers to reject *ex officio* a trademark application that wholly or partially reproduces or imitates a well-known trademark.

On the other hand, in the event of the owner of a well-known mark filing an opposition or administrative nullity action based on its mark, it has 60 days from filing this in which to file an application to register its well-known mark in Brazil.

The law also establishes that signs that imitate or reproduce a third-party mark are not registrable as trademarks if the sign is intended to distinguish a product or service that is identical or similar to that covered by the existing mark and is likely to cause confusion or association with such mark. As a consequence, the law enables the owner of a mark that has not yet been filed or registered in Brazil to challenge third parties that attempt to register similar or identical trademarks. Similar to the aforementioned situation, the rights holder has 60 days in which to file an application for registration of its mark in Brazil, starting from the filing date of the opposition or administrative nullity action.

The amount of use necessary to establish unregistered rights is highly contingent on the circumstances of fact, the statute that is being raised and the market segment at issue.

REGISTERED MARKS

The Industrial Property Law states that a natural or legal person subject to either a public or private law regime may register a mark. Business entities that are subject to private law

regimes may apply to register a mark covering only activities that they effectively and lawfully carry out either directly or through companies that they control either directly or indirectly. Similarly, natural persons may apply to register only marks that cover their professional activities.

REQUIRED DOCUMENTS

A trademark application must include:

- a power of attorney, duly executed and signed by the applicant's authorised representative (it need not be notarised, legalised or apostilled) – if the power of attorney is not lodged at the time of filing, it can be submitted to the BPTO within 60 days of the filing date;
- in the case of a priority claim, a simple copy of the priority application comprising all goods or services to be filed in Brazil – if this is not lodged at the time of filing, it can be submitted to the BPTO within four months of the filing date; and
- in the case of composite or device marks, a clear sample of the mark so that copies can be made in accordance with BPTO filing requirements.

REGISTRATION REQUIREMENTS

The law establishes that any distinctive, visually perceptible sign may be registered as a trademark, provided that it fulfils the legal requirements.

The visual representation requirement excludes non-traditional trademarks (eg, olfactory, sound and gustatory marks) from the scope of protection. However, the protection of three-dimensional (3D) signs – which are considered non-traditional trademarks – has been admitted in Brazil since the enactment of the Industrial Property Law in 1997.

Article 124 of the law gives examples of unregistrable signs, including:

- signs of a generic, necessary, common, usual or merely descriptive character (when related to the product or service to be distinguished) or those commonly used to designate a characteristic of the product or service, except when the sign is presented in a sufficiently distinctive manner; and
- names, prizes or symbols of sporting, artistic, cultural, social, political, economic or technical, official or officially recognised events, as well as imitations likely to cause confusion, except when authorised by the competent authority or entity promoting the event.

PROCEDURES

EXAMINATION AND OPPOSITION

Once the application has been filed, it is published and interested parties can file an opposition within 60 days. If an opposition is filed, the applicant will be notified to respond within 60 days. After the term for opposition and counterarguments has expired, the examination is conducted and potential conflicts with senior trademarks are considered. During the examination period, office actions or requests may be issued and must be responded to within 60 days.

If an applicant fails to respond to an office requirement, the application will be shelved. However, if a response is filed, the examination will continue, even if the requirement has not been satisfied or if the applicant's response was to lodge a formal challenge to the office action or request.

In the absence of opposition, the examiner will consider the results of the availability search. If conflicts with prior registrations are found, the examiner will reject the application. If a possible conflicting registration that could be cited as grounds for rejection is under forfeiture or subject to court proceedings or orders, the examiner will stay the junior application pending a final decision on the respective case. The same applies to possible conflicting senior applications that are still under examination.

Once an examination has been concluded, a decision will be issued either allowing or rejecting the application. In the event of rejection, the applicant has 60 days to file an appeal to the BPTO president.

REGISTRATION

The trademark registration is effective for 10 years from grant and may be renewed for equal and successive periods. The renewal request must be made during the last year of the registration term and must be accompanied by proof of payment of the respective fee. If a renewal request has not been made by the end of the registration term, the registrant may make such a request within the following six months on payment of an additional fee.

REMOVAL FROM REGISTER

The registrant must initiate the use of its trademark within five years of grant, failing which the registration may, at the request of any person with a legitimate interest, be declared extinct. Moreover, if use of the mark has been interrupted for more than five consecutive years or if, within that time, the mark has been used in a modified form that implies alteration of its original distinctive character as found on the certificate of registration, the registration may, at the request of a third party, be deemed extinct.

Once the registration is published in the *Official Gazette*, a 180-day term commences in which any person with a legitimate interest may file an administrative nullity action. An administrative nullity action may also be commenced *ex officio* by the BPTO and the registrant will have 60 days to respond. Once the term for counterarguments has expired, even if no response has been presented, the issue will be decided by the BPTO's president. This decision brings the administrative stage to a close.

A registration may be subject to a declaration of administrative nullity if a third party can prove that it was granted in conflict with the law.

Any person with a legitimate interest or the BPTO may file a judicial nullity action against a registration or the administrative act that annulled a registration.

TIME FRAME

The BPTO is expected to issue a first decision regarding an unopposed application approximately nine months from the filing date of the application. A decision in connection with an opposed application is expected one year after the filing date of the application.

As for purely administrative proceedings (eg renewals, mergers and changes of name), a decision is expected within three to four months.

SEARCHES

The following trademark office searches are available:

- identical trademark search;
- similar trademark search;
- search per class; and
- search of device marks.

ENFORCEMENT

ADMINISTRATIVE PROCEEDINGS

The Industrial Property Law sets out two administrative mechanisms for a rights holder to enforce its rights: opposition and administrative nullity actions.

CIVIL AND CRIMINAL PROCEEDINGS

In addition, the rights holder can enforce its rights through criminal and civil proceedings, as provided for in Articles 189 and 190 (crimes against marks) and Articles 207 to 210 (civil measures) of the law.

For civil proceedings, the injured party may file a lawsuit seeking the cessation of the infringing act, coupled with a claim for damages. The lawsuit may also include an *ex parte* preliminary injunction request, with a view to the immediate cessation of the harmful conduct until a decision on the merits can be rendered, subject to the specific requirements of the Civil Procedure Code. To obtain a preliminary injunction, the plaintiff must demonstrate a *prima facie* good case (ie, that there is a likelihood of success on the merits of the case) and that delay in granting the relief sought would be likely to give rise to harm that is irreparable or extremely difficult to redress.

The plaintiff may also seek the imposition of a daily penalty for failure to abide by the preliminary injunction. If the interim relief sought is granted, the defendant will be restrained from practising the infringing act pending a final and definitive ruling on the substantive lawsuit. In some circumstances, a court will only grant interim injunctive relief if the petitioner posts a bond or a fiduciary guarantee to cover any losses incurred by the respondent.

A criminal action requires the filing of a criminal complaint. However, if the crime is committed against armorial bearings, crests or official public distinctions, a criminal action will be commenced by the Public Prosecution Service.

In terms of criminal proceedings, one very important provision is the possibility of filing a preliminary criminal search and seizure action, aimed at gathering evidence of acts of infringement before the infringer has a chance to destroy or hide it. Pursuing a preliminary criminal search and seizure action is normally more straightforward than undergoing the more complicated civil proceeding of early production of evidence. Given that it is possible to rely on evidence obtained under a search and seizure warrant in both civil and criminal proceedings, an application for preliminary criminal search and seizure is frequently a useful starting point for civil infringement proceedings, as well as for criminal proceedings per se.

JURISDICTION

Nullity actions against trademark registrations and against administrative acts upholding a rejection decision or annulment of a trademark registration are submitted to the Rio de Janeiro Federal Court (the BPTO is a party to all such actions and thus they must be filed in the federal courts).

The Rio de Janeiro Federal Court has four courts specialising in intellectual property at first instance. At appeal level, the Regional Federal Court of the Second Region, with jurisdiction over the states of Rio de Janeiro and Espirito Santo, has two specialist IP panels.

Infringement actions must be filed before state courts as the BPTO does not participate in such proceedings.

REMEDIES

Civil remedies include an order for immediate cessation of the infringing act (the plaintiff may request the imposition of a daily penalty for failure to comply with a preliminary injunction or with a first-instance decision) and compensation for unauthorised use of the trademark.

In a lawsuit seeking cessation of the infringing act and a damages award, the judge may grant an *ex parte* preliminary injunction to avoid irreparable loss or harm that would be difficult to repair. In such circumstances, the court may require a petitioner to post a bond or a fiduciary guarantee and may order the seizure of all merchandise, products, packaging, labels and other materials that bear the counterfeit or imitated mark.

Criminal remedies include preliminary criminal search and seizure measures, imprisonment and fines.

DAMAGES

The law applies three criteria when calculating damages:

- the benefits that would have been gained by the injured party had the infringement not occurred;
- the benefits obtained by the infringing party; and
- the remuneration that the infringing party would have paid to the rights holder for a licence to use the protected rights legally.

Since 2003, the Superior Court of Justice has held that proof of the infringement of a trademark right is sufficient in itself to give rise to a right to damages, independent of any evidence of actual harm caused to the injured party.

TIME LIMIT FOR ACTION AGAINST THIRD-PARTY REGISTRATION

Any person with a legitimate interest or the BPTO may file a judicial nullity action against a trademark registration filed in good faith. A judicial nullity action is statute barred following the expiry of five years from the date of publication of the granting decision.

As for a registration filed in bad faith, a nullity action can be filed at any time, according to Article 6*bis*(3) of the Paris Convention.

TIME FRAME FOR ENFORCEMENT ACTION

Once a civil trademark infringement action has been filed, the defendant is notified to respond within 15 days. The plaintiff may respond to the defendant's answer within 10 days.

There are usually two hearings at first instance:

- a conciliatory or preliminary hearing, in which the parties try to settle the case amicably; and
- an evidentiary hearing, in which the expert and technical assistants may be cross-examined if their findings disagree (the relevant questions having been filed and responded to in writing before the hearing) – depositions are taken from the parties and the listed witnesses are heard.

This second hearing occurs only in cases where there is a need for evidence to be produced.

At the close of the hearing, the judge may immediately make a final order (the final decision at first instance), or they may direct that the parties submit final briefs. In the latter case, the judge will issue the final order following the submission of the briefs and their consideration.

It is possible to file an appeal against this order to the State Court of Appeal, and an order of the State Court of Appeal may be challenged in a special appeal to the Superior Court of Justice or an extraordinary appeal to the Federal Supreme Court.

A final decision on infringement and nullity actions may take between one and two years at first instance. A final decision on second instance may take up to two years. Whether the lawsuit is based on registered or unregistered rights should not substantially affect the time frame of the case.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

ASSIGNMENT

Applications and registrations may be assigned on the condition that the legal requirements for requesting registration are met by the assignee. The assignment of a trademark application or registration covers only the trademark; no goodwill or other business assets need be assigned for an assignment to be valid.

A trademark assignment application must include:

- a power of attorney executed and signed by an authorised officer of the assignee (this need not be notarised, legalised or apostilled); and
- an assignment document to be executed and signed by the authorised officers of the assignor and assignee.

If the document is signed by the company's president, vice president, chief executive officer, chief financial officer, chief operating officer, or a director or secretary, notarisation is not needed. If, however, the signing officer has a different title, it is recommended to have the document notarised to avoid doubts about their powers to represent the company. This document must also include the signature and details of the identity of two witnesses (no notarisation is required for the witnesses' signatures).

The assignment of a trademark application or registration takes effect between the contracting parties from the moment it is executed and signed by the assignor and assignee. However, to be effective against third parties, the assignment must be registered at the BPTO. The assignment is effective against third parties from the date of publication in the *Official Gazette*.

LICENSING

A licence agreement takes effect between the contracting parties from the moment it is executed. However, a trademark licence agreement must be recorded with the BPTO to be effective against third parties. It will be effective against third parties from the date of publication in the *Official Gazette*.

Registration of the licence agreement with the BPTO is also important if royalties are agreed to.

The remittance of payments from trademark licences will be accepted only after grant of a respective trademark registration by the BPTO. Retroactive payments before the grant of the registration are not allowed.

Registration of the licence contract with the BPTO is not required to constitute proof of use of the licensed mark.

RELATED RIGHTS

Trademark rights may overlap with copyright and industrial design rights. A logo or a device trademark can also be protected by copyright, provided that it is an original work within the terms of the Copyright Law. The particular form (design) of a product or its finishing or packaging may be protected under the provisions covering 3D trademarks, industrial designs and copyright, provided that the requirements for each form of protection are met.

ONLINE ISSUES

Since October 2010, Brazil has had an administrative conflict management system, SACI-Adm, for domain names using the country-code top-level domain '.br'.

According to the SACI-Adm Regulations, a rights holder may oppose a domain name on the grounds that there is a previously filed or registered trademark before the BPTO, or that the opposing party owns a trademark that, although not filed or registered with the BPTO, is considered to be well known in its field of activity within the terms of the Industrial Property Law. The decision rendered in the SACI-Adm procedure will determine either cancellation of the domain name or its transfer to the rights holder.

The Brazilian courts have not yet specifically addressed the question of whether the use of a third party's trademark in keyword advertising constitutes trademark infringement. However, the judiciary has already issued rulings indicating that such use may constitute an act of unfair competition when it is likely to confuse or redirect consumers. In such a case, rights holders can invoke the regulations for protection against unfair competition.

Pursuant to Article 19 of the Civil Rights Framework for the Internet (Law No. 12,965/2014), hosts and other service providers are granted a safe harbour in regard to trademark and copyright infringement, as they may only be held civilly liable for damages arising from content generated by third parties if they fail to take the infringing content down after a specific court order, meaning that there is no red flag awareness provision applicable in this context. Moreover, according to Article 18 thereof, the internet service provider will not be civilly liable for damages arising from content generated by third parties.

No power of attorney required.	Yes	Yes: 3D and position marks.

Yes	Yes	Yes: 60 days from publication.
Yes: five years after grant if certain conditions are fulfilled.	Yes: an administrative nullity action or court action may be filed.	Yes: an administrative nullity action or court action may be filed.
Yes	No	Yes: an application for preliminary injunction may be included in the plaintiff's complaint.
Yes	No	Yes: SACI - Adm.

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Chile: Trademark procedures and strategies

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LEGAL FRAMEWORK

LOCAL LAW

Trademarks are governed in Chile by Law No. 19,039 (the Industrial Property Law), which has been in force since 30 September 1991. This law has been partially modified four times, with the last substantial amendments being introduced by Law No. 21,355, which entered into force on 9 May 2022.

In our opinion, the most substantial amendments as far as trademarks are concerned are:

- the elimination of the requirement of graphical representation to register trademarks, which allows the registration of non-traditional trademarks, such as gustatory marks;
- the addition of the option to register tri-dimensional trademarks; and
- the addition of the ability to sue for lapse of a trademark registration when it has not been used during five years or the use is suspended by said term.

In addition, on 4 April 2022, Chile officially became a member of the Madrid Protocol.

TREATIES

Chile is a member of the Paris Convention for the Protection of Industrial Property, the World Trade Organisation's Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement), the Trademarks Law Treaty and the Hague Convention Abolishing the Requirement of Legalisation for Foreign Public Documents (the Apostille Treaty). Free trade agreements containing IP chapters also apply, in particular those signed by Chile with the United States and the European Union.

Chile has approved the Madrid Protocol for International Registration of Trademarks, which has been in force since 4 July 2022. In addition, on 30 June 2022, Exempt Resolution No. 184 of the Ministry of Economics was published in the National Gazette, which contains instructions for the processing of international trademarks according to the Madrid System, also in force from 4 July 2022.

UNREGISTERED MARKS

Unregistered trademarks grant their holders only the right to oppose a trademark application by a third party or to apply for the invalidation of the trademark registration in the following cases:

- when the unregistered trademark has been actually and effectively used in Chile prior to the application for registration made by a third party for the same or similar trademark for identical or similar goods or services, in the same class or related classes, and coexistence may create confusion; and
- when the unregistered trademark is famous or notorious and is registered abroad but not in Chile, and this trademark is identical or similar to a trademark requested in Chile to distinguish the same products and services – a situation that may create confusion.

The latter claim must be supported by evidence of fame or notoriety among the relevant consumer public in Chile.

Moreover, the Chilean Institute of Industrial Property (INAPI) may reject an application on the basis of an unregistered prior mark, provided that the existence of the unregistered trademark is publicly known to the extent that its renown does not require evidence.

If the owner of a famous unregistered mark is successful in an opposition or cancellation action, it has 90 days from the date of the decision to apply for registration of the mark in its own name. Failure to do so entitles any third party to file an application for that mark, with priority being given to the party whose application for registration was rejected as a consequence of the opposition or invalidation action. The 90-day term applies to those that successfully oppose an application on the basis of previous use in Chile.

REGISTERED MARKS

OWNERSHIP

Any person or legal entity, whether domestic or foreign, may apply for and own a registered trademark.

The representative requires a power of attorney that must be signed by the legal representative of the applicant's firm, but it need not be notarised or legalised. It can be credited up to 30 days (for domestic applicants) or 60 days (for foreign applicants) after the application has been filed.

For power of attorney and other documents to be filed with other authorities or Chilean courts, the relevant Hague Convention eliminates the requirement to legalise public documents that originated abroad, replacing it with just one step of certification in the form of the Apostille Treaty, which is already in full force in Chile.

PROTECTED

Any sign capable of distinguishing products and services can be protected. Such signs can consist, among other things, of words, letters, numbers, drawings, colour combinations, olfactive marks and three-dimensional images. Phrases related to publicity or advertising may also be registered, provided that they are associated with a registered trademark. Sound trademarks are allowed if they are represented graphically and are accompanied by the filing of a sound recording. Trademarks that consist of letters or numbers must be represented by a characteristic drawing that gives distinctiveness to the letter or number. Geographical indications and appellations of origin, as well as certification and collective trademarks, are also protectable.

NOT PROTECTED

The following may not be registered as trademarks:

1. coats of arms, flags or any other symbols, names or initials of any state or international organisation, or state public service;
2. technical or scientific denominations in respect of the object for which they are destined, plant variety denominations, common international denominations recommended by the World Health Organisation and those indicative of therapeutic action;
3. the name, pen name or picture of any natural person, except if consent is given by that person, or their heirs if deceased (however, the name of a historical celebrity may be registered if at least 50 years have elapsed since their death and the registration does

- not affect the personality's honour, and names of persons cannot be registered when this constitutes an infringement of the signs described in points (5), (6) and (7) below);
4. reproductions or imitations of signs of official guarantee or control stamps adopted by a state without its authorisation, and reproductions or imitations of medals, diplomas or honours granted in national or foreign exhibitions whose registration is requested by someone other than the person who obtained them;
 5. expressions or signs used to indicate the kind, nature, origin, nationality source, destination, weight, value or quality of the products or services; those of general use in trade to name a certain kind of product or service; and those that exhibit no innovative feature or that describe the products or services to which they must be applied – however, signs that are not inherently distinctive may be registered if they have acquired distinctive character through their use in the country;
 6. signs that may induce error or deceit with regard to the source, quality or kind of product or service;
 7. signs that are identical to other marks, or that graphically or phonetically resemble other marks that have been registered abroad for the same products or services in a manner likely to create confusion, provided that the prior marks enjoy fame and notoriety;
 8. trademarks that are identical or similar to prior well-known Chilean-registered trademarks, requested for different classes, however related, if the registration could affect the interests of the owner of the well-known trademark;
 9. signs that are identical to, or that graphically or phonetically resemble in a confusing manner, other trademarks that are already registered or have validly been applied for earlier marks in the same class, or that have effectively been used in Chile prior to the application date – INAPI may allow coexistence agreements, provided that they do not affect the prior rights of third parties or cause consumer confusion;
 10. the colour of either products or containers, and colours themselves;
 11. protected geographical indications and appellations of origin; and
 12. signs that are contrary to public order, morality and good behaviour, and the principles of fair competition and business ethics comprised therein.

PROCEDURES

EXAMINATION

Each application is subjected to an examination to determine whether it meets the formal requirements, including whether the application specifies the goods or services of the Nice Classification for which registration is sought. INAPI notifies the applicant of any changes required. The applicant has 30 working days to file the necessary corrections. Failure to do so means that the application will be deemed abandoned. Where there are no formal objections or where these objections have been corrected in a timely manner, the application is accepted for further pursuit and published in the *Official Gazette* within 20 working days for opposition purposes.

After publication, the application is subject to substantive examination. Any objections must be filed within 30 working days of notification.

OPPOSITION

Any interested party may file an opposition within 30 working days of publication. The opponent may base its opposition on any of the grounds to reject an application provided by the law.

REGISTRATION

Applications that have passed the formal and substantive examinations and are unopposed, or that have overcome any objections or oppositions by a final decision, are accepted for registration. Mark owners have 60 working days from that date to complete the payment of the registration fees. The registration shall be for an initial period of 10 years, renewable indefinitely for consecutive periods of 10 years.

A granted registration can be divided during the prosecution of a cancellation action or during an appeal against a decision in a cancellation action.

REMOVAL FROM REGISTER

Any party can voluntarily withdraw a registration. When made through a representative, special powers are required.

Registration granted to signs deemed unprotectable by the Industrial Property Law may be cancelled on the basis that prohibitions for granting registration were ignored. Such actions must be filed within five years counted from the registration date.

However, there is no time limit for filing a cancellation action against a mark registered in bad faith. A cancellation action is heard at first instance by the head of INAPI and at second instance by the Industrial Property Court. In some circumstances, decisions of the Industrial Property Court may be appealed before the Supreme Court.

REVOCACTION

Revocation on the basis of non-use was incorporated in Chile by Law No. 21,355, which modified the Industrial Property Law when it came into force on 9 May 2022. This modification established a cancellation action for non-use.

For new trademarks with registration granted after 9 May 2022, registration will be cancelled if:

- the trademark has not been put to real and effective use in within the Chilean territory after five years from when registration was granted (by the owner, or by a third party with their consent) to distinguish one or more of the goods or services for which the registration was granted; or
- such use was uninterruptedly suspended for the same period.

For trademarks with registration granted before 9 May 2022, the five-year term begins after the first renewal that occurs after 9 May 2022. The modification that brought these rules into force also established a cancellation action for when a trademark has become generic.

TIMEFRAME

From the time of filing, it takes, normally:

- six to eight months for an unopposed application to proceed to registration;

- 18 months for an opposition procedure to reach a first-instance decision (and a further 24 months for an appellate decision to issue);
- 20 days for a renewal for being accepted;
- two weeks to record mergers and changes of name;
- two to three years for a cancellation action at first instance, six months to a year at second instance and about eight months if a further recourse is filed before the Supreme Court; and
- three months for renewals.

These terms are still presently and temporarily uncertain as a consequence of the covid-19 pandemic.

SEARCHES

Searches for identical trademarks (registered or applied for) are available online and free of charge at www.inapi.cl. Free searches for previously requested trademarks or registered identical trademarks that coincide in their first part to, or contain, the trademark searched for are also available online for all classes. Searches cover trade names and slogans, but only verbal descriptions of graphic marks. The databases cover the past 30 years.

ENFORCEMENT

COMPLEXITY

The enforcement of a trademark, by means of the Industrial Property Law, requires that the trademark be registered in Chile.

The actions available consist of border measures, criminal actions and civil actions.

BORDER MEASURES

Border measures are regulated by the TRIPS Agreement, internalised by Law No. 19,911 in 2003, and must be followed by actions in the relevant courts. When properly supported, border measures are usually effective.

CRIMINAL ACTIONS

Criminal actions are available before the ordinary criminal court with jurisdiction over the area where the offence was committed. These actions are open mainly when an unauthorised third party is using in bad faith a trademark that is identical or similar to another that is already registered for products or services that are identical or related to those protected. To be in a position to initiate criminal actions, it is necessary that the registered trademark bears in a visible form the words *Marca Registrada* (Registered Trademark), the initials MR or the symbol ®. The penalties consist of a fine and the confiscation of the products bearing the forged trademark. The court shall decide how to dispose of the tools and materials used to commit the infringement by ordering either their destruction or their distribution to charitable institutions. Finally, Law No. 21,355 incorporates new criminal sanctions in the Industrial Property Law for those who counterfeit a trademark, which include imprisonment.

CIVIL ACTIONS

Civil actions are prosecuted before the ordinary court that has jurisdiction over the defendant's address. Such actions are available against any kind of violation of a registered trademark. The object of civil actions is to put an end to the infringement, to obtain indemnification for damages and to adopt the necessary measures to prevent the infringement from continuing. Compensation for damages may be determined taking into account one of the following options in accordance with the trademark owner's choice:

- the profits that the owner failed to receive as a consequence of the infringement;
- the profits that the infringer would have received as a consequence of the violation;
- or
- the price of a licence, taking into account the value of the infringed rights and the contractual licences that may have already been granted.

If the mark owner so desires, compensation for damages may be calculated according to the general rules of the Civil Code, which are much more complex. Preliminary and precautionary measures are contemplated in the case of civil actions. In addition, in counterfeiting cases, the owner of the trademark that has been subject to counterfeiting may request that a compensation for damages caused could be substituted by a single fine that cannot exceed 2,000 monthly tax units per infringement. Such an option may be exercised in a claim for indemnity from damages.

Civil infringement actions to protect unregistered trademarks may be available under the Unfair Competition Law No. 20,169, but not under the Industrial Property Law.

TIMEFRAME

The competent criminal court may order the seizure of products bearing the infringing sign and of the elements directly used to imitate the registered trademark immediately after filing the complaint. The time to obtain this relief will depend on the court's criteria and on the quality of the evidence filed by the complainant.

According to the new Procedural Criminal Code, final decisions in criminal cases should take no longer than one year and a maximum of two. It is also possible to obtain an earlier settlement of the case by using the alternative reparatory agreements accepted by the court. Civil actions take approximately two years at first instance and a further two years at second instance. Terms are temporarily uncertain as a result of the covid-19 pandemic. While a decision is pending, it is possible to take preliminary or precautionary measures based on the merits of the case and the quality of the evidence rendered.

Criminal actions are much more common than civil ones. The Chilean courts are becoming more familiar with trademark cases, so the quality of the decisions is improving.

Unfair competition actions take around the same time as civil infringement actions.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Assignment of a trademark must be executed by means of a document signed by the parties involved. In the case of a change of name, the official documents must be certified by the proper local authorities. Licence agreements must be executed in the same way as assignment agreements.

The recording of assignments, changes of name and licences with INAPI is not compulsory. However, if these are not recorded, they will have no legal effect against third parties.

RELATED RIGHTS

While the law does not refer specifically to the cumulative protection of trademarks and copyright, a graphical or combination trademark can be protected under copyright law provided that it has artistic value.

ONLINE ISSUES

The Network Information Centre (NIC) Chile, the manager of the '.cl' domain, follows an alternative dispute resolution policy in relation to '.cl' domain names that is similar to the ICANN UDRP. Under NIC Chile's rules and policy, trademark owners may claim for:

- early revocation of the domain name based on prior application or registration or infringement of their trademark rights within 30 days of domain name registration; or
- late revocation of the domain name based on prior application or registration of a trademark or other arguments, after 30 days as from the domain name registration.

The regular Industrial Property Law provisions are applicable to online infringement: "Those who maliciously use, for commercial purposes, a trademark identical or similar to another registered for the same goods or services in respect of goods or services related to those protected by the registered trademark." To proceed with an action regarding online infringement, it is necessary to have a trademark recorded in Chile.

According to NIC Chile's rules, for any person who wants to take a '.cl' domain name, provisions are available to ensure that its registration does not contravene the rules regarding the exercise of freedom of expression and information, the principles of fair competition and business ethics.

NIC Chile's rules provide that one of the grounds that could be filed for a late revocation action against a domain name that is already recorded would be for the recorded domain name to be identical or deceptively similar to a name by which the complainant is known, or to a trademark or other expression in which the complainant claims to have prior rights.

NIC Chile has no public dispute resolution policy for the '.cl' ccTLD.

No: however, a non - legalised power of attorney will be required by the office approximately 40 days after filing the application.	Yes	Yes: sound trademarks.
Yes	Yes	Yes: 30 days.
No	No	Yes
	Yes	Yes: no specific term.

Yes, for registration, oppositions and cancellation cases. Infringement goes to ordinary courts.		
No, but necessary to enforce them in front of third parties.	Yes: implicit	Yes

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China: Trademark procedures and strategies

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China Patent Agent (HK) Ltd

Summary

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LEGAL FRAMEWORK

In China, the laws relevant to trademarks are:

- the Trademark Law (and its implementing regulations);
- the Anti-unfair Competition Law;
- the Copyright Law (and its implementing regulations);
- the Criminal Law;
- the Administrative Procedure Law;
- the Civil Procedure Law;
- the Measures for the Administration of Internet Domain Names;
- the Procedural Rules of the China Internet Network Information Centre (CNNIC) for Resolution of Domain Name Disputes;
- the Measures of the CNNIC for the Resolution of Domain Name Disputes;
- the Regulations on Customs Protection of IP Rights; and
- the Provisions for the Protection of Products of Geographical Indication.

The applicable international treaties include:

- the Paris Convention for the Protection of Industrial Property;
- the Agreement on Trade-Related Aspects of IP Rights;
- the Patent Cooperation Treaty;
- the International Patent Classification Agreement;
- the Singapore Treaty on the Law of Trademarks;
- the Madrid Agreement Concerning the International Registration of Marks;
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;
- the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks;
- the WIPO Performances and Phonograms Treaty;
- the WIPO Copyright Treaty;
- the Berne Convention for the Protection of Literary and Artistic Works;
- the Beijing Treaty on Audiovisual Performances;
- the Convention Concerning the Protection of the World Cultural and Natural Heritage; and
- the Supreme People's Court Rules on Punitive Damages in IP Cases.

UNREGISTERED MARKS

An interested party may prevent others from:

-

applying for registration or using a trademark on the same or similar goods if the trademark is a reproduction, imitation or translation of an unregistered well-known trademark in China and is likely to cause confusion (Articles 13.1 and 13.2 of the Trademark Law);

- applying for registration of a trademark on the same or similar goods if the trademark is known through business dealings or other special relationships (Article 15 of the Trademark Law);
- applying for registration of a trademark on the same or similar goods if the trademark is a reproduction or imitation of an unregistered trademark that has attained a certain reputation (Article 32 of the Trademark Law); and
- carrying out confusing behaviour that misleads others into believing that a commodity is supplied by another party or has specific connections with another party – for example, using an identifier such as a product name, packaging or decoration that is similar to that of another party's highly reputed commodity (Article 6 of the Anti-unfair Competition Law).

According to Articles 4 and 19.4 of the amended Trademark Law (effective as of 1 November 2019):

- any party may prevent others applying for trademarks that are filed in bad faith for a purpose other than use (Article 4); and
- the trademark agency cannot apply registrations for trademarks except for trademark agency services (Article 19.4).

Different legal provisions have different requirements for the extent of use to establish unregistered trademarks. Articles 13.1 and 13.2 of the Trademark Law set out the most demanding requirements on the popularity and extent of use of unregistered well-known trademarks. Article 6 of the Anti-unfair Competition Law also lays down demanding requirements on the popularity and extent of use of unregistered trademarks, with the confusing behaviour having to reach a level that can cause misunderstanding. Article 32 of the Trademark Law requires a lower extent of use of unregistered trademarks, wherein established contact with the relevant public is sufficient to support the rights of an unregistered trademark. Article 15 of the Trademark Law does not require evidence of trademark use, but evidence is required to prove that the trademark is known through special business dealings. Article 4 of the Trademark Law does not require evidence of trademark use, but evidence is required to prove that the trademark is filed in bad faith for a purpose other than use. Article 19.4 of the Trademark Law does not require evidence of trademark use, but must it must be proven that the designated goods or services do not belong to trademark agency services.

REGISTERED MARKS

Natural persons, legal persons or other organisations that require exclusive rights to trademarks for their goods or services during production and business activities can apply for and own a mark.

A power of attorney is required before filing, which does not need to be notarised or legalised.

Any mark that distinguishes the goods of a natural person, legal person or other organisation from those of other parties can be registered as a trademark, including:

- words;
- figures;
- letters;
- numbers;
- three-dimensional signs;
- colour combinations;
- sounds; and
- combinations of the above.

The following cannot be registered as trademarks in China:

- holograms;
- single colours;
- positions;
- motions;
- tactile marks;
- smells; and
- taste marks.

PROCEDURES

EXAMINATION PROCEDURE

It takes one to two months to receive the official filing receipt from the Trademark Office on acceptance of all the documents and designated goods. If the designated goods need to be amended, there is normally only one chance for amendments to be made. After the formal examination, the application will go into substantial examination. It takes another six to seven months to learn whether the application has been rejected or preliminarily approved.

OPPOSITION

Any interested party has the right to file an opposition against a trademark application during the three-month publication period. If the prior right does not concern an applied-for or registered trademark, the preliminary proof of the right must be filed.

REGISTRATION

If a trademark application is not opposed by a third party during the opposition period, it will mature into a registration. It normally takes one to two months to receive the certificate.

REMOVAL FROM REGISTER

A trademark can be revoked on the grounds of non-use for three years. Generally, the term starts from the date of registration, with the following exceptions:

- where the trademark has been approved for registration after an opposition procedure, the three years start from the date of publication of the registration in the *Trademark Gazette*;

- where the trademark is an international registered trademark under the Madrid Protocol, the three years start from the date of expiration of the time limit for rejection; and
- where the trademark is still under review for trademark rejection or opposition, the three years start from the effective date of the administrative decision.

When a trademark is registered over three years, it will be vulnerable to non-use cancellation. Other relevant time frames include the following:

- it takes 12 months to obtain approval for an unopposed registration;
- it takes 10 to 12 months from the filing of an opposition to receive a decision in an opposition procedure;
- it takes one to two months to obtain a renewal certificate;
- it takes four to six months to obtain a merger certificate; and
- it normally takes one to two months to obtain a replacement certificate due to a change of name.

Official Trademark Office searches are available from approximately two weeks from the date of filing, at the earliest. The following types of search are available:

- identical trademark search;
- similar trademark search;
- search per class;
- search of all classes;
- search includes trade names and slogans; and
- search of traditional graphic marks.

Searches of non-traditional graphic marks are not available. No official fee shall be charged.

ENFORCEMENT

According to Article 57 of the Trademark Law, rights holders may seek administrative or judicial remedies if they find any infringement of the exclusive right to their registered trademarks, including where another party:

- uses an identical trademark on the same type of goods without a licence;
- uses a similar trademark on the same kind of goods or uses an identical or similar trademark on similar goods, where such use is likely to cause confusion;
- sells goods that infringe the exclusive rights to the use of the trademark;
- counterfeits or manufactures without authorisation a representation of the trademark, or sells such representation;
- alters the trademark without the permission of the trademark registrant and sells goods bearing the altered trademark on the market; or
- intentionally facilitates others in committing infringements.

According to Article 60 of the Trademark Law, a dispute that arises from an act infringing the exclusive right to use a registered trademark prescribed in Article 57 of the Trademark Law will be settled by the interested parties through consultation. Where the parties are reluctant to resolve the matter through consultation or the consultation fails, the trademark registrant or an interested party may institute legal proceedings in court or request that the Administrative Department for Industry and Commerce address the dispute.

On determining that an infringement has been established, the Administrative Department for Industry and Commerce will:

- order the infringer to immediately stop the infringing act; and
- confiscate and destroy the infringing goods and instruments that are used to manufacture the infringing goods or counterfeit the representations of the registered trademark.

If the revenue derived from the infringement is 50,000 yuan or above, a fine of up to five times the illegal revenue may be imposed. If there is no revenue or the revenue is less than 50,000 yuan, a fine of up to 250,000 yuan may be imposed. Anyone who commits infringements on two or more occasions within five years or where the circumstances are serious will be subject to a heavier punishment.

If a party sells goods with no knowledge that such goods have infringed the exclusive right to use a registered trademark, can prove that the goods were obtained by legitimate means and can indicate the supplier thereof, the Administrative Department for Industry and Commerce will order that party to stop selling immediately.

Where there is a dispute over the amount of the damages for infringement, any interested party may ask the Administrative Department for Industry and Commerce for mediation or institution of legal proceedings in the court. Where no settlement is reached on mediation or the mediation agreement fails to be performed, the interested parties may institute legal proceedings in the court.

According to Article 213 of the Criminal Law, using an identical trademark on the same kind of goods without permission from the owner of the registered trademark will be penalised with:

- a fixed-term imprisonment or detention of up to three years and a fine, where the circumstances are serious; or
- a fixed-term imprisonment of between three and seven years and a fine, where the circumstances are particularly serious.

Punitive damages can be claimed in civil proceedings only. The amount of the damages is determined according to:

- the actual loss suffered by the rights holder as a result of the infringement;
- the benefit obtained by the infringer from the infringement; or
- a reasonable multiple of the royalty for the relevant trademark licence.

If the above three methods fail to determine the amount of the damages, the court may award damages of up to 5 million yuan (amended in the 2019 Trademark Law), based on

the circumstances of the infringement. Criminal proceedings are instituted by administrative authorities, not by trademark owners.

The statute of limitations for court action against trademark infringement is two years, calculated from the date that the interested party becomes aware – or should have become aware – of the infringement. If it is a one-off infringement, there is usually no problem with the two-year limit. However, if the infringement is continuous and the trademark owner has been – or should have been – aware of it for more than two years, the court will order the defendant to stop the infringement and the amount of the infringement damages will be calculated based on two years from the date that the lawsuit was filed with the court. Any infringement damage beyond two years will not be remedied.

Interim relief can be sought before the court before or after filing a lawsuit. In case of claiming prior to the lawsuit, the lawsuit should be filed within 15 days of the court taking measures to stop the infringement, otherwise the court will lift the measures.

There is no mandatory timeframe for the resolution of an enforcement action.

OWNERSHIP CHANGES AND RIGHT TRANSFERS

Currently, no legalisation is required for any documents regarding ownership changes or right transfers.

Any use by a licensee will be attributed to the trademark owner, unless exceptions are stated in the licence agreement.

RELATED RIGHTS

A copyright, a design patent right or a portrait right can be used to protect device marks that have artistic merit.

For example, a logo can be protected by trademark, copyright, design and civil laws. An enterprise name right or a natural person's name right can be used to protect word marks that contain an enterprise name or a natural person's name. For example, a famous person's name right can be protected by trademark law and civil law.

ONLINE ISSUES

Registered and unregistered marks are totally applicable to internet use.

The Trademark Law and the Anti-unfair Competition Law, as well as domain name-related regulations and relevant judicial interpretations, contain specific provisions protecting rights holders against unauthorised trademark use in domain names, on websites and in hyperlinks.

Further, the Trademark Law, the Anti-unfair Competition Law and the Advertising Law, as well as relevant judicial interpretations, contain specific provisions protecting rights holders against unauthorised use in online ads and metatags.

Relevant laws and regulations can be found in:

- the Interpretation of the Supreme People's Court concerning the Application of Laws in the Trial of Cases of Civil Disputes arising from Trademarks;
- the Trademark Law;

- the Anti-unfair Competition Law; and
- relevant judicial interpretations.

The UDRP regulates the ccTLD. The applicable regulations are the CNNIC Procedural Rules for the ccTLD Domain Dispute Resolution.

Yes	Yes	Yes: colour combinations and sounds.
Yes	Yes	Yes: three months.
Yes: after registration for more than three years.	Yes	Yes
Yes	Yes	Yes: no time limit.
Yes: for assignment. No: for licensing.	Yes	Yes



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El Salvador: Trademark procedures and strategies

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Summary

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LEGAL FRAMEWORK

NATIONAL LAW

The main regulations under the 2002 Trademarks Law (as amended in 2006) provide for the following:

- protection for well-known trademarks;
- protection for three-dimensional marks and trade dress;
- new trademark examination rules;
- coexistence agreements for similar marks;
- the registration of appellations of origin;
- the limitation of goods in a pending application or registered mark;
- co-ownership of a mark; and
- the extension and limits of trademark rights.

Only previously registered trademarks are subject to opposition on renewal. Marks are protected for 10 years and are renewable every 10 years. An additional advantage is the inclusion of clear and simple rules for calculating damages. The law has its own statute of limitations rules, which prevail over the Code of Commerce's general provisions.

Trademarks are protected through registration at the Registry of Intellectual Property (RIP). Priority can be claimed according to the Paris Convention for the Protection of Industrial Property. The 11th edition (2020) of the Nice Convention for the International Classification of Goods and Services applies. Recent practice has admitted protection for motion marks.

In February 2019, the Administrative Procedures Law became effective to unify procedures and recourses across the executive branch. The new law affects many procedures managed by the RIP, benefiting trademark holders providing certainty, shorter terms for government officials to resolve petitions filed, extensions of time to file documents and setting sanctions to government officials that do not observe the new terms, among other things.

INTERNATIONAL LAW

El Salvador is a signatory to the following international trademark treaties and agreements:

- the Paris Convention;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Dominican Republic–Central America Free Trade Agreement with the United States (DR-CAFTA) – to comply with the DR-CAFTA, El Salvador made a number of amendments to its trademark law, including:
 - extending protection to sound, smell and certification marks;
 - providing that certification marks cannot be seized, embargoed or subject to preliminary injunctions or judicial execution;

- should a certification mark not be renewed or be abandoned, or should the public entity owning it cease to exist, an identical mark cannot be registered or used by another party for 10 years;
 - making the recordal of licence agreements optional – coexistence agreements will be approved as signed by the parties; and
 - requiring that notices of publication in both the *Official Gazette* and major newspapers outline the list of goods and services covered;
- the Trademark Law Treaty, which implemented the following in El Salvador:
 - multi-class applications and registrations;
 - division of application or registration – an applicant can divide the application to defend an opposition, or voluntarily at any time, and continue the registration process in the other classes;
 - address and name changes – proof of such changes is no longer required in submitting a recordal application, unless the IP registrar has reason to doubt such changes; and
 - power of attorney – this need not be notarised or legalised, unless judicial actions are being pursued; and
 - the Association Agreement between the European Union and Central America, which focuses on protection for geographical indications and appellations of origin.

UNREGISTERED MARKS

PROTECTION

Rights in unregistered marks arise only where the relevant mark is sufficiently well known and this can be proved. Such marks may be enforced through an opposition process against identical or similar marks or through an unfair competition action filed before a civil and mercantile court. Criminal actions are available in cases involving criminal responsibility or cybercrimes affecting trademarks. Complaints are filed before the General Attorney's Office, which will investigate and file an action before a criminal court.

USE REQUIREMENTS

El Salvador is a first-to-file jurisdiction; therefore, no rights emerge from merely using a mark without filing an application. The Trademarks Law does not specify how much use is required to establish unregistered rights.

REGISTERED MARKS

OWNERSHIP

Any natural or legal person can apply for and acquire the right to own a mark in El Salvador. No conditions of nationality, domicile or establishment apply.

A representative needs a power of attorney to act before the RIP, which must be notarised and legalised by apostille or, alternatively, before the nearest consulate. In the absence of this, a bond can be rendered to support temporary representation while a power of attorney is rendered, at the latest before the mark is granted.

SCOPE OF PROTECTION

Not all trademarks or brand names are subject to registration. The Trademarks Law sets out grounds for refusal, both for intrinsic reasons (Article 8) and where the mark violates third-party rights (Article 9).

A mark is inadmissible for intrinsic reasons if it:

- consists of the usual form of the goods for which registration is sought, or their packaging, or a form that is necessary due to the nature of the goods or services;
- consists of a form that gives a functional or technical advantage to the goods or services for which registration is sought;
- consists of a common or usual name, term or designation of the goods or services in usual technical, scientific or commercial language;
- serves in trade to describe a characteristic of the goods or services;
- is a simple, isolated colour;
- totally or partially reproduces or imitates the name, code of arms, flag, emblem or abbreviation, official control symbol or warranty of any state or international organisation, without express authorisation;
- reproduces coins or bills of legal tender, securities or other mercantile documents, fiscal seals, stamps or other fiscal species;
- is a letter or digit separately considered, unless represented in special and distinguishing form;
- is contrary to morality or public order;
- includes elements that offend or ridicule people, ideas, religions or national symbols of any country or international organisation;
- includes medals, awards or diplomas received, unless the fact can be evidenced on filing the application;
- could mislead or cause confusion as to the geographical origin, nature, method of manufacture, qualities, aptitude for use or consumption, amount or some other characteristic of the goods or services; or
- consists of the name of a protected vegetal variety in El Salvador or abroad.

In addition, a mark is inadmissible if, after examination, the registrar determines that it violates third-party rights – for example, if it:

- is confusingly identical or similar to a third party's mark that is registered or pending for goods or services related to those protected by a registered or pending mark;
- is confusingly visually, phonetically, olfactorily or conceptually similar to a third party's mark that is registered or pending for goods or services;
- is confusingly identical or similar to a third party's trade name or emblem already used in El Salvador for similar commercial activities;
- constitutes a full or partial reproduction, imitation, translation or transcription of a third party's well-known mark, where its use may cause confusion or a risk of

association with the third-party mark or take unfair advantage of the notoriety of the well-known mark;

- affects a third party's personality rights or consists, fully or partially, of a third party's name, signature, title, pseudonym or image, unless the third party or its heirs expressly grant consent;
- is likely to cause confusion with a protected geographic indication or an appellation of origin for which protection has been applied before the examined application;
- infringes any third party's copyright or industrial property right, unless express consent is granted; or
- is registered to consolidate or commit unfair competitive practices.

PROCEDURES

EXAMINATION

An application will first be examined for compliance with the formal requirements and afterwards on novelty and to verify whether the mark falls under any of the prohibitions set out in Articles 8 and 9.

If the examining attorney states an observation that one or more formal requirements are not met, the applicant has 10 working days to respond, which may be extended once. If the examiner maintains no compliance of requirements, the applicant can file a reconsideration recourse within 10 working days of receiving notice. If the resolution is favourable, the application is admitted. However, if it is not favourable, the RIP will issue a resolution declaring the mark's dismissal – no further recourse is available and the resolution becomes final.

If the mark falls under any of the prohibitions, the RIP will issue an office action, comprising a preliminary rejection. The applicant has four months to respond. If it fails to do so within this time frame, the RIP will issue a resolution declaring the mark's abandonment. If the applicant responds but the RIP maintains the rejection, the applicant can file an appeal recourse within 15 working days after the notice has been served.

If the RIP's resolution is still adverse, the applicant can file a contentious administrative action in recently created courts with jurisdiction in such matters.

The Trademarks Law states that the examining attorney is entitled to declare the application abandoned if six months have elapsed from the date of service of any resolution without the applicant pursuing the next step of the registration process. Abandonment applies on the mere passage of time without action by the applicant.

The sole argument against abandonment is *force majeure*, which must be proven.

Once an application is admitted for registration, it will be published in the *Official Gazette* and in a major newspaper.

OPPOSITION

In the two months following publication in the *Official Gazette*, any party with a legitimate interest can file an opposition. The *Official Gazette* will apply a cumulative delay to publication of its printed version, which is the valid source for computing legal terms. There is an

electronic version of the *Official Gazette*, available online, which is limited to informative purposes.

No extensions for this action are allowed. The registrar will verify whether the opposition meets all legal requirements. If so, an admission resolution will be issued and served on the applicant, which has two months to respond. After this, the registrar will issue the final resolution within one month.

An opposition procedure takes between eight and 12 months.

REGISTRATION

The registration procedure takes between seven and nine months if the application complies with all legal requirements and no office actions or oppositions arise.

The following documents and information must be provided:

- the applicant's name, domicile and nationality or state of incorporation;
- 15 printed labels featuring the mark;
- a list of the goods or services, and international classes, for which registration is sought;
- any exclusivity claims of colours, fonts or words;
- any claim of priority under the Paris Convention; and
- a power of attorney and corresponding notarial certification duly legalised before the nearest Salvadoran consulate or by apostille.

One document per applicant is sufficient. If a power of attorney is granted in a language other than Spanish, it must be translated into Spanish by a translator appointed by a notary public prior to being used before any local authority.

REMOVAL FROM REGISTER

VOLUNTARY CANCELLATION

Any mark can be voluntarily cancelled by its owner through an administrative process before the RIP.

JUDICIAL CANCELLATION

Cancellation of a trademark can be based on two motives:

- if a mark was registered contravening Articles 8 or 9 of the Trademarks Law – an action based on Article 8 can also be initiated by the attorney general and one based on Article 9 must be filed within five years of the registration date; or
- for non-use, although this was abolished in 2002 but reintroduced in 2006 following the implementation of the DR-CAFTA to allow for full or partial cancellation of a mark that has not been used for five consecutive years (partial cancellation will affect only those goods or services for which the mark is not being used).

March 2011 marked the starting point for the filing of cancellation actions for non-use.

Where a mark is cancelled successfully, the prevailing party can take up rights in the mark starting from the filing date of its cancellation claim, but no later than three months following the court's decision.

A trademark is considered to be in use when it is used in relation to:

- goods or services in commerce;
- the import, export, storage or transport of goods bearing the trademark; or
- services originating in El Salvador that are used abroad.

Additionally, advertising the mark through any means is considered use, "even if the goods or services covered are not actually traded" in El Salvador, according to Article 41-D of the Trademark Law. This provision is useful for foreign rights holders, which can rely on advertising to help to prove use. Rights holders are advised to supplement advertising evidence with commercial invoices, accounting documents or auditors' certifications that show the amounts and regularity of the goods or services being used in commerce. Defences to non-use include circumstances beyond the power of the rights holder – such as import restrictions – or any other official requirements imposed on products or services covered by the mark.

No filing of proof of use is required on a regular basis.

Judicial cancellation actions must be filed with the civil and mercantile courts. Cases are orally argued by the parties, with the simplest decided in one hearing and the most complex in two. Evidence must be fully filed alongside the complaint and new evidence can be provided only if it refers to new facts. Cancellation procedures now take between six and 12 months. As part of the proceedings, the judge can issue a preliminary injunction ordering that the complaint be recorded at the RIP to prevent the registrant from transferring the disputed mark to a third party.

Once the court has issued its verdict, the RIP will cancel the mark accordingly.

INVALIDATION

Where a trademark has been incorrectly registered, the law only allows a judicial action to be brought against the registration. There is a five-year statute of limitations for judicial cancellation actions. However, if the registration was sought in bad faith, no such statute applies.

SEARCHES

Official searches are allowed for similar and identical marks, in one or all international classes. A search report includes similar or identical trade names and slogans. Design marks can be searched separately from word marks. The official fee is US\$20 per mark or design per international class. Searches of all marks that have been applied for or registered by a particular owner are also available and the official fee is US\$100 per owner.

ENFORCEMENT

COMPLEXITY

The Trademarks Law provides for:

- preliminary injunctions;

- permanent injunctions;
- civil actions;
- damages; and
- actions against unfair competition that affects trademark rights.

The Criminal Code also includes provisions on criminal offences. Accordingly, both civil and criminal remedies are available to deal with the infringement of registered marks.

Unregistered marks may be enforced if they are well known. All enforcement actions fall under the courts' exclusive jurisdiction.

While specialist IP courts do exist, the competent courts will be those with jurisdiction in civil and mercantile matters, as well as the criminal courts if the infringer has committed a felony.

Among other things, a rights holder can request a preliminary injunction ordering:

- immediate cessation of any infringing acts;
- the seizure of goods, packaging, labels and other materials bearing the infringing mark, and equipment and materials used to perpetrate the infringement – except for printing presses and accessories and other media, which are protected by the Constitution to guarantee freedom of speech;
- the suspension of imports or exports of infringing products or materials; and
- the provision of information by the alleged infringer about persons that participated in the production, sale or distribution of the infringing goods.

A judge can also issue a permanent injunction ordering:

- the transfer of infringing goods or materials and relevant equipment to the rights holder;
- any action necessary to prevent the continuation or repetition of the infringement, including the destruction of infringing goods and materials, and relevant equipment;
- payment of an indemnity for damage suffered; and
- publication of the final judicial resolution at the infringer's expense.

Preliminary injunctions may be granted against goods in transit and border seizures.

Permanent injunctions can include the destruction of goods seized at the border, as well as the destruction of materials used to manufacture the infringing goods. Infringers are not compensated for any losses in the procedure. The infringing goods can also be donated to charity, subject to the removal of all labels displaying the infringing mark.

Rules relating to damages have been substantially modified. According to DR-CAFTA-influenced provisions, the plaintiff can base its claim on one of the following:

- damages caused to the rights holder as a result of the infringement;
- benefits that the rights holder would have obtained if the infringement had not occurred – the court considers the value of the goods or services infringed based on the retail price or through other means that prove their value; or
- the price or royalty that the infringer would have paid if it had a licence.

The statute of limitations for civil actions is five years from the date of the last infringement. However, if it can be proven that the infringement was committed in bad faith, the statute of limitations does not apply and the infringer can be prosecuted at any time.

TIME FRAME

Preliminary injunctions may be requested to secure evidence, either before filing an infringement action or as part of it. The judge has the discretion to order the petitioner to post a bond as compensation for damage caused by a failed action. Preliminary injunctions can be requested either as a separate action or with the main enforcement action. They must be granted and executed within 48 hours of filing the action. If the suspension of imports or exports is requested, the plaintiff must file an infringement action within 10 working days (which may be extended once) – otherwise, the injunction will be lifted.

The Civil and Mercantile Process Code shortened the duration of a case from between five and six years under the former system to one year for first instance and appeal proceedings.

Criminal actions are usually more intimidating for the infringer and generally take between two and three months from filing the complaint to the conciliatory audience, following seizure of the infringing goods.

The statute of limitations for unfair competition actions is two years from the date on which the registrant learned of the act of unfair competition or five years from its last performance, whichever expires first.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

It is mandatory to register any changes to a rights holder's name or domicile, as well as all assignments, for each registration to ensure that the RIP's information is up to date. These changes can also be recorded against pending applications.

For an assignment, a document must be submitted to the RIP, fully executed in any language. Any foreign document must be notarised and legalised by apostille or alternatively before the nearest Salvadoran consulate, and must be locally translated into Spanish before being filed.

Although the recordal of licence agreements is no longer mandatory, it is desirable to create pre-existing evidence of use. Licence agreements are enforceable before third parties, including infringers and authorities, provided that they are duly legalised and translated into Spanish.

A licence is attributed to the rights holder when an express authorisation to use a mark is granted, with or without limitations, according to the owner's policy. Licence agreements can only be recorded against registered marks.

Recordal of these changes and rights transfers takes between one and two months.

RELATED RIGHTS

There are certain areas of overlap between trademark rights and other rights, such as copyright. This occurs mostly in judicial procedures where it is necessary to prove ownership of a right. In such cases, a copyright registration can strengthen the evidence of ownership. A design mark can be protected using copyright if it meets the criteria of artistic creativity and originality. A two- or three-dimensional form that can be used for manufacturing a product can also be protected as an industrial design for 10 years.

ONLINE ISSUES

The domain name regulations specifically authorise the registration entity SVNET to adopt dispute resolution procedures based on the UDRP for the ccTLD '.sv'.

The recent Law Against Cybercrimes forbids the trade of goods or services through unauthorised passing-off using information technology and considers such trade to be a felony. The crime is aggravated if the goods are medicines, food products or supplements, beverages or any other goods for human consumption.

No: power of attorney, but must be filed before a registration certificate is issued. Yes: notarisation and apostille are required.	Yes	Yes: sounds; smells; motion and certification marks.
Yes	Yes	Yes: two months.
Yes: but only with a final judicial resolution from a cancellation action for non-use.	No	Yes: but only with a final judicial resolution from a cancellation action.
No	No	Yes: in civil actions. Actions on merits must be filed within 10 days.
Yes: for assignments. No: for licensing.	Yes	Yes



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France: Trademark procedures and strategies

Alain Berthet, Bénédicte Devevey and Elisabeth Berthet

PROMARK

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LEGAL FRAMEWORK

NATIONAL

French trademarks are governed mainly by Law 1991-7, which implements the EU First Trademarks Directive (89/104/EEC) and is codified in the IP Code. The Code was amended several times, in particular by Law 2007-1544, which implements the EU IP Rights Enforcement Directive (2004/48/EC).

EU Directive 2015/2436 was incorporated into national law by a ruling of 13 November 2019 and most of its provisions entered into force on 11 December 2019.

INTERNATIONAL

France has ratified the following international conventions and treaties:

- the Paris Convention for the Protection of Industrial Property (20 March 1883);
- the Madrid Agreement (14 April 1891);
- the Madrid Protocol (27 June 1989);
- the Nice Agreement (15 June 1957);
- the Vienna Agreement (12 June 1973);
- the Trademark Law Treaty (27 October 1994);
- the World Trade Organization's Agreement on Trade-Related Aspects of Intellectual Property Rights (15 April 1994); and
- the Singapore Treaty on Trademarks (27 March 2006).

EU trademarks also cover France.

UNREGISTERED MARKS

French trademark law confers no exclusive right to the owner of an unregistered mark.

However, a well-known mark within the meaning of Article *6bis* of the Paris Convention may be protected under civil law under certain conditions and notably, against the use of an identical or similar sign for identical or similar goods or services for which the mark is well-known, provided that there is a likelihood of confusion

To enjoy such protection, the well-known mark must be recognised by a substantial proportion of the public in relation to the goods or services concerned.

French courts assess the well-known character of the mark, considering factors such as the seniority of the mark, the scope and the intensity of its use, and the promotional and advertising investments.

REGISTERED MARKS

OWNERSHIP

Any natural person or legal entity can apply for a French trademark before the French Institut National de la Propriété Industrielle (INPI). The application can be filed by the owner itself or its representative.

A representative is mandatory if the trademark has several applicants or if the applicant is not resident in France, an EU member state or the European Economic Area. If the representative is neither a lawyer nor a patent attorney, it must at least be established in the European Union or the European Economic Area and must have a power of attorney (neither notarised nor legalised).

SCOPE OF PROTECTION

A trademark can be registered if it is capable of distinguishing the goods or services of one undertaking from those of another.

French trademarks may consist of any signs capable of being represented that allow any person to clearly and precisely determine the scope of protection.

EXCLUDED SIGNS

A trademark that has no distinctive character, or that is descriptive or generic, may not be protected as a trademark.

The distinctive nature of the sign shall be assessed at the time of the application in relation to the goods or services for which registration is sought.

The following signs have no distinctive character:

- trademarks that consist exclusively of signs or indications that have become customary in the current language or in the bona fide and established practices of the trade;
- trademarks that designate a feature of the product or service (eg, quality, quantity and geographical origin); and
- trademarks that consist exclusively of the shape imposed by the nature or function of the product, or a shape that gives the product its substantial value.

Distinctive character may be acquired by use, except when the sign is of the kind described in the last bullet point above.

The following may not be adopted as a mark or an element of a mark:

- signs excluded by Article 6ter of the Paris Convention (eg, state emblems, official hallmarks and flags), as well as those of the Red Cross;
- geographical indications for wines or spirits that do not originate from that geographical area;
- signs that are contrary to public policy or whose use is prohibited by law; and
- signs that are liable to mislead the public, particularly as regards the nature, quality or geographical origin of the goods or services.

PRIOR RIGHTS

A sign may not be adopted as a trademark where it infringes prior rights, particularly:

- a registered earlier mark or a well-known prior mark within the meaning of Article 6bis of the Paris Convention;
-

a company name, or a trade name or signboard, known throughout the national territory, where there is a risk of confusion in the mind of the public;

- a domain name;
- a protected designation of origin;
- a copyright;
- rights deriving from a protected industrial design;
- personality rights of another person, particularly their surname or pseudonym;
- the name, image or repute of a local authority or public inter-municipality cooperation establishment; and
- the name of a public entity, provided that there is a likelihood of confusion.

SEARCH FOR PRIOR RIGHTS

Prior trademark searches usually concern either identical marks or company names, or similar marks. In most cases, both types of searches are necessary to secure a trademark application.

It is recommended to call on French trademark professionals to conduct such a search and analysis, as the ones simply proposed by INPI do not contain an in-depth analysis.

PROCEDURES

FILING

Applications for registration should be filed before INPI together with proof of payment of the filing fees. They should include:

- information on the applicant;
- a sample of the mark; and
- a list of the goods or services for which registration is sought, specifying the classes of the Nice Classification concerned.

Failure to provide the information above or proof of payment will result in the inadmissibility of the application.

If priority is claimed, the reference of such priority should be provided. In case of foreign priority, the applicant shall provide INPI with an official copy of the prior application (with a translation) and proof of the right to claim priority within three months of filing the application in France.

Only one mark may be applied for per filing.

If INPI considers an application admissible, it will be published in the *Trademark Gazette* within six weeks of the filing date (four weeks in practice).

EXAMINATION

INPI examines all applications to determine whether:

- the application and the attached documents satisfy the conditions set by law; and
- the sign may be registered as a mark, based on the criteria listed above.

However, INPI does not conduct any search for prior rights during the examination process.

If an application is considered unfit for registration, INPI will issue an objection (within four months from the filing date), with a deadline for the applicant either to amend the application or to reply to INPI's objection (one month for formal shortcomings and two months for substantive shortcomings).

In the absence of a response by the deadline or if INPI rejects the applicant's changes, a final refusal of registration will be issued. Such refusal may concern all or part of the application.

OPPOSITION

Within two months of publication of an application for a French trademark in the *Trademark Gazette* or, for an international registration, in the *WIPO Gazette*, an opposition may be filed, in person or through a representative, by:

- the owner of a prior registered mark or a prior application;
- the owner of a prior well-known mark;
- the owner of a company name, provided that there is a likelihood of confusion;
- the owner of a trade name or sign board, or a domain name known throughout the national territory, provided that there is a likelihood of confusion;
- any person who has authorisation to defend the rights on the protected designation of origin;
- a local authority or a public inter-municipality cooperation establishment;
- any legal person governed by public law on the basis of its name;
- the owner of the mark filed without authorisation in the name of its agent; and
- the exclusive licensee of such marks, unless otherwise stated in the licensing agreement.

The two-month deadline is not extendable.

A representative is mandatory in the same circumstances as for filing applications. The opponent must submit proof of ownership of the mark on which the opposition is based.

If the opposing mark was registered at least five years before the date of opposition, the applicant may request that the opponent provide evidence of use of its mark. The opponent shall then prove the use of its mark for all the goods or services on which the opposition is based or provide proper reasons for non-use.

Following the recent reform, INPI will now rule on the opposition after an adversarial proceeding that includes an investigation phase.

Formal opposition is available.

INPI should decide on the opposition within three months of the end of the investigation phase. In the absence of a decision within such timeframe, the opposition shall be deemed rejected. This period shall be suspended in the following cases:

- *ex officio* by INPI if the prior mark has not yet been registered;
- at the request of one party if there is a claim pending before the courts; or

- at the request of both parties.

INPI's opposition decisions are appealable before specialised courts of appeal, within one month of the notification of the decision if the appellant is French, and within three months if the appellant is not from France. The territorial jurisdiction of these appellate courts is determined by the domicile of the appellant; the Paris Court of Appeal has exclusive jurisdiction where foreign appellants are concerned.

WITHDRAWAL

The applicant may request, in writing, the complete or partial withdrawal of its application at any point in time until the technical preparation for registration begins.

REGISTRATION

Unless the application is rejected or withdrawn, the mark is registered in the National Trademarks Register for 10 years from the filing date. Registration of an unopposed application takes approximately four to five months from the application date, while registration of an opposed application takes about 10 to 11 months. INPI issues the registration documents about two to three weeks after the registration.

RENEWAL

Registered trademarks are renewable every 10 years, by declaration. At the renewal, the owner of the trademark shall not modify the sign nor extend the list of goods or services. However, the renewal may apply only for part of the goods or services stated in the initial registration. Proof of use is not required for renewal.

A renewal declaration should be submitted to INPI in the six months preceding the expiry of the registration. An application for renewal may also be filed within an additional six-month period, upon payment of additional fees. Renewal shall take effect on the day following the expiry date of the registration. INPI issues the renewal documents approximately two to three months after the renewal.

REMOVAL FROM REGISTER

CANCELLATION

The validity of a registered mark may be challenged through a cancellation action or in infringement litigation:

- on absolute grounds – namely, absence of distinctive character and descriptiveness, or unlawful signs; or
- on relative grounds – namely, earlier rights.

ACQUIESCENCE

If the owner of a trademark has acquiesced to the use of a later identical or similar mark for five successive years while being aware of such use and, if the later mark was applied for in good faith, the owner of the earlier right shall no longer be entitled to act against the use of the later mark in respect of the goods or services for which the later mark has been used.

REVOCATION FOR NON-USE

If, within a successive period of five years starting on the publication of registration, the mark has not been put to genuine use in connection with all or part of the goods or services for which it is registered, and there are no proper reasons for non-use, the rights of the mark owner shall be revoked. Such revocation can be invoked by any interested party or as a counterclaim in infringement proceedings.

In this respect, use of the mark in a modified form that does not alter its distinctive character is considered genuine use.

The owner of the mark for which revocation is requested bears the burden of proof of genuine use of its mark. Evidence of use shall be provided for all goods or services for which the trademark is registered. Failing that, the mark will be revoked for the goods or services for which genuine use was not proved.

If use of the mark started or resumed within three months of the request for revocation, after the owner of the mark has become aware of a request for revocation against its mark, such use shall be disregarded.

Revocation shall take effect retroactively as of the date of expiry of the five-year period mentioned above.

REVOCAION IF MARK BECOMES GENERIC

If a mark has become the common name in trade for a product or service for which it is registered, its owner's rights shall be revoked for such good or service.

REVOCAION OF A MISLEADING MARK

The registration of a mark shall also be revoked if the mark has become misleading, particularly as regards the nature, quality or geographical origin of a product or service.

SURRENDER

A registered mark may be surrendered at any time in respect of all or part of the goods or services for which the mark is registered.

New provisions entered into force on 1 April 2020, including the following:

- INPI has exclusive jurisdiction for revocation actions, whatever the grounds (eg, non-use or trademark becoming generic or misleading) as a main claim.
- INPI has exclusive jurisdiction for cancellation actions as a main claim that are grounded only on:
 - one or several absolute grounds; or
 - one or several relative grounds related to the infringement of:
 - an earlier distinctive sign;
 - a legal or trade name;
 - a shop sign;
 - a domain name;
 - a geographic indication;
 - the name of a public entity; or

- the name, image or reputation of a territorial collective or public inter-municipality cooperation establishment.

In the framework of revocation and cancellation actions before INPI, at the request of the successful party, INPI may order the losing party to pay a lump sum for the costs of the proceedings, according to a scale set by decree (€600 for the costs incurred under the written phase; €100 for the costs incurred under the oral phase; and €500 for representation fees).

French specialised IP courts remain competent for counterclaims and invalidation or revocation actions grounded on any other rights (eg, copyrights, design rights, or any related claim such as counterfeiting or contractual liability).

The decisions rendered by INPI could be the object of an appeal.

ENFORCEMENT

Anyone that uses a mark without the authorisation of its owner, by reproducing the mark or imitating it for identical or similar goods or services, shall be liable for trademark infringement.

To determine an infringing act, the court must assess:

- the identity or similarity of the conflicting signs based on visual, phonetic and intellectual criteria; and
- the identity or similarity of the goods or services concerned.

Civil infringement proceedings can be brought before specialised courts by either the owner of a mark or the exclusive licensee, if the licence is recorded in the Trademark Register. A licensee whose licence agreement has not been recorded can intervene in infringement proceedings only to claim remedy for damages that it has suffered.

An infringement action must be brought within five years of the infringement.

Such infringement may be proved by any means. To secure evidence of the infringement and to obtain any information related to it, the rights holder may obtain from a competent court an order to carry out a seizure at the premises of the alleged infringer.

Prior to an infringement action, the rights holder can also request an injunction to prevent an imminent infringement or any further infringement, by means of summary proceedings. Such proceedings may be *ex parte* if the circumstances require that such measures be issued without the defendant being heard.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

To be enforceable against third parties, the following information should be recorded in the Trademark Register:

- information relating to the owner and the mark, as well as acts affecting the existence or scope of the mark;
- acts affecting the ownership or enjoyment of the rights on the mark (eg, assignment agreement); and
- changes of name, legal form or address of the owner.

The recordation of a licence is not compulsory, but it is useful for evidentiary and opposability purposes and for the licensee to be able to act in infringement litigation or in opposition.

The applicant of such recordation will provide INPI with a copy or an abstract of the deed stating the change in ownership or use of the rights (not legalised, but translated into French).

RELATED RIGHTS

Trademarks and other IP rights can overlap. Thus, subject matter may be protected as a trademark, by copyright or as a design if it satisfies the requirements for such protection.

ONLINE ISSUES

Under French law, unauthorised use of a trademark on the Internet also constitutes trademark infringement. The rights holder may sue those that unlawfully use its mark on the ground of trademark infringement or unfair competition.

According to case law, the French courts have jurisdiction over infringements on websites that are intended for French consumers (depending on the language, the currency or the measurement units used on the website).

Law 2004-575, which implements the EU E-Commerce Directive (2000/31), establishes liability regimes applicable to internet access providers (IAPs), hosting service providers (HSPs) and website editors in case of an illegal act on the internet, including trademark infringements.

Article 6.1.2 of Law 2004-575 defines ‘HSP’ as the natural or legal person who, for the provision to the public through online public communication services, stores signals, writings, images, sounds or messages of any kind.

By virtue of Article 6, IAPs and HSPs have no general obligation to monitor the information that they transmit or store, or actively to seek illegal activities. They are liable only if they knew of the illegal act or if they did not act promptly to delete the illegal content or make the content inaccessible when they became aware of it.

As to domain names, the ‘.fr’ naming rules provide expressly that it is the responsibility of the person registering or using the domain name to ensure that it does not breach third parties’ rights.

A dispute resolution procedure called Syreli is available for disputes over ‘.fr’ domains, in addition to judicial actions. This system is managed by AFNIC, the registry of the ‘.fr’ top-level domain. Decisions are issued within two months of receipt of a complaint.

Yes: when representative is neither a lawyer nor a patent attorney.	No	Yes: 3D; aspects of packaging; colours; smells; sounds.
No	Yes	Yes: two months.
	Yes	Yes

Yes: five years' non - use from date of the registration's publication.		
Yes	No	Yes
Yes: to be enforceable against third parties.	Yes	Yes



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Germany: Trademark procedures and strategies

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COHAUSZ & FLORACK

Summary

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LEGAL FRAMEWORK

NATIONAL LAW

German trademarks, EU trademarks, and German trademarks based on international registrations, names and non-registered trade designations are enforceable in Germany.

German trademarks are governed by the Trademark Act, which implements the EU Trademark Directive (2015/2436).

EU trademarks are governed by the EU Trademark Regulation (2017/1001), the EU Trademark Delegated Regulation (2018/625) and the EU Trademark Implementing Regulation (2018/626).

International registrations that extend to Germany are governed by the Madrid Protocol, the Madrid Agreement and the Trademark Act.

Names and non-registered commercial designations are governed by the Civil Code and the Trademark Act.

INTERNATIONAL TREATIES

Germany has also acceded to several multilateral and bilateral international treaties, such as the Paris Convention for the Protection of Industrial Property, the Nice Agreement Concerning the International Classification of Goods and Services for the Purposes of the Registration of Marks, and the Agreement on Trade-Related Aspects of Intellectual Property Rights (see www.wipo.int/wipolex and www.dpma.de).

UNREGISTERED MARKS

Commercial designations are protected against newer identical or confusingly similar trade designations and trademarks once they are first used in Germany, but details of this protection can be complex (eg, the protection may be locally restricted and there may be coexistence in the case of natural persons with the same name).

Unregistered trademarks and other commercial designations (eg, business symbols) are protected against newer identical or confusingly similar trademarks and commercial designations only from the date on which they acquire a sufficient degree of public recognition in the specific German market. The required minimum threshold is determined on a case-by-case basis. If the sign is distinctive, a degree of recognition from between 20% and 25% of relevant consumers is sufficient to pass the threshold test. However, if the sign is descriptive or not distinctive for other reasons, it must also have acquired distinctiveness through use in Germany. Accordingly, the threshold for this is set at 50%. Unregistered trademarks used only outside Germany to the required substantial degree may be afforded protection in accordance with Article 6*bis* of the Paris Convention only if the mark is well known. This will usually require between 60% and 70% recognition. These requirements must be proved by opinion polls conducted in accordance with requirements established by precedent.

REGISTERED MARKS

Any natural or legal person may apply for and own a trademark.

While representation is not necessary before the German Patent and Trademark Office (DPMA) or the Federal Patent Court – which has jurisdiction over certain trademark matters (although not infringement cases) – applicants or owners with no domicile, seat or commercial establishment in Germany must appoint a German representative. German attorneys at law and German patent attorneys must be duly empowered, although no power of attorney need be submitted to the DPMA or the Patent Court. Other representatives must submit a power of attorney in writing (either in German or the original with a German translation). No notarisation is required. However, foreign applicants and owners may need to comply with their local formal requirements.

Registration may be applied for a mark that consists of any sign capable of being represented clearly and in a definitively determinable way – particularly words, numbers, graphical devices and three-dimensional shapes.

The represented sign must be capable of distinguishing the goods or services of one undertaking from those of other undertakings in a legal manner.

Signs are not eligible for registration if, among other things, they:

- are devoid of any distinctive character;
- are descriptive;
- are used by competitors to describe their goods and services;
- consist exclusively of the shape that results from the nature of the goods and, as such, are necessary to obtain a technical result or give substantial value to the goods;
- are contrary to public policy or accepted principles of morality;
- could potentially deceive the public – for example, in regard to the nature, quality or geographical origin of the goods or services;
- consist of legally protected signs and have not been authorised by the competent authorities; or
- have been applied for in bad faith.

However, the grounds mentioned under the first to third points above may be overcome by acquiring around 50% distinctiveness.

PROCEDURES

The DPMA will examine the trademark application with regard to formalities (eg, correct classification of the goods or services and full payment of the application fees) and absolute grounds for refusal. No *ex officio* search for older conflicting trademarks is carried out by the DPMA. Any deficiency will be raised by the DPMA in an official action granting the applicant at least one month in which to reply. These periods are extendable on request. This decision may in turn be appealed within one month of notification by either an administrative appeal to the DPMA or a direct full appeal to the Patent Court, depending on the status of the person at the DPMA who first issued the decision. A decision of a DPMA appeal division may be appealed to the Patent Court. Decisions of the court may, on rare occasions, be appealed to the Federal Court. Publication and registration of a trademark occur when the DPMA has issued the allowance (without any official action, this is likely to be completed between three and six months from the application, although can vary greatly). The trademark has effect with regard to third parties from the date on which it is recorded in the Trademark Register.

An opposition may be filed three months after a trademark registration is published, provided that the corresponding fees are also paid. The rights on which the opposition is based and its scope must be clearly indicated.

An additional fee must be paid for each right on the basis of which the newer mark is opposed. Generally, opposition proceedings are documentary proceedings with no oral hearing. A typical case will involve one or two rounds of short submissions. Currently, it can take at least one year for the first decision in opposition proceedings before the DPMA.

An opposition may be based on older German trademarks and EU trademarks, international trademarks in force in Germany and trade designations that are protected in Germany. It is also possible to base an opposition on older trademark applications.

An admissible opposition that is based on older rights will succeed if the newer mark or the goods and services claimed in its specification are identical or confusingly similar to the older right on which the opposition is based. This includes a danger of association with the older mark. Basically, the scope of protection afforded to older well-known, famous or notorious trademarks will be broader.

To support settlement negotiations between the parties to the proceedings, a period of at least two months will be granted by the DPMA at their joint request to reach an amicable settlement (ie, cooling off). This period may be extended by a further joint request.

The owner of the contested application may defend by requesting proof of use of the opposing trademark.

The DPMA requires proof of use rather than simply putting forward a plausible case. However, in place of full proof, affirmation in lieu of an oath is still permitted pursuant to Section 43(1) (second sentence) of the Trademark Act. The five-year period for which proof of use of the opposing trademark must be furnished will begin five years before the filing date or priority date of the challenged trademark.

The grace period for use will commence on the date when no further opposition is possible against the registration of a trademark:

- the date from which an opposition can no longer be lodged due to the expiration of the opposition period;
- the date on which the decision that concluded the opposition proceedings becomes final; or
- the date on which the opposition was withdrawn.

The beginning and end of the grace period for use will be entered in the Trademark Register (Section 25 (20a) of the Trademark Ordinance).

An opposition will also be rejected, if the younger opposed trademark was filed during the period during which the older trademark was not in genuine use, even if the older trademark was subsequently put to genuine use by the owner and the lack of use cured vis-à-vis other third parties.

An opposition can also be based on the grounds that the opposed trademark was registered in bad faith, particularly in the name of an agent or other representative of the (normally foreign) trademark owner.

If and to the extent that an opposition succeeds, the opposed trademark will be expunged from the register once the ruling is final and binding.

A trademark that is not put to genuine use within five years of expiration of the opposition period or the final decision in opposition proceedings is deemed invalid, as the case may be. However, provided that maintenance fees are paid, the mark will continue to exist on the public records, because no declaration or evidence of use is required. After the five-year grace period for commencing genuine use, any third party may file a request for revocation at any time. If the owner does not object to this within two months, the mark will be revoked. In case of an opposition, the third party is informed and may then proceed with revocation proceedings before the DPMA by paying another official fee within a month of notification or file a revocation action based on non-use with the German regional court that has special jurisdiction *ratio materiae*. If the owner can prove that it has commenced genuine use before the revocation request is filed, the trademark will not be revoked even if it had not been used for more than five years. However, use that commences less than three months before the cancellation request after the owner became aware of its potential filing will not be considered.

Any party may file a request for revocation, and the trademark may be cancelled, if:

- there are absolute grounds for refusing trademark protection (usually overlooked by the DPMA during examination), if:
 - the absolute ground of refusal still exists at the time that the decision on the application for cancellation is made; and
 - cancellation is requested within 10 years of the registration date;
- the trademark has become the common name in the trade for the goods or services in respect of which it is registered as a consequence of acts or the inactivity of the owner; or
- use made of the mark is liable to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

In respect to the enumerated number of statutory absolute grounds, a trademark may be cancelled *ex officio* by the DPMA if the procedure is commenced during the first two years after the registration date and the registration manifestly contravenes a finite number of provisions.

These grounds may apply only to some of the goods and services for which the trademark is registered, in which case the cancellation will concern only that part of the trademark.

As an alternative to opposition proceedings, especially after the expiry of the non-extendable three-month opposition period, the owner of older rights may file at any time a request for cancellation based on its older trademark or trade designation standing in force in Germany (ie, relative grounds). However, even if the relative grounds are proven to exist, the registration may not be cancelled if the owner of the older mark has knowingly tolerated the use of the newer mark for the goods or services in respect of which it is registered for a period of five consecutive years – unless the newer mark was obtained in bad faith or the owner of the older right has consented to registration and use of the younger mark. Further, cancellation is not possible if the older mark could have been cancelled on the date of publication of registration of the younger trademark.

Cancellation requests based on original or subsequent absolute grounds for refusal, lack of standing to own a trademark, lack of genuine use or because of the existence of earlier rights (only by the owner of such rights) may be filed with the DPMA.

An action for cancellation for revocation or because of the existence of earlier rights may also be commenced before the competent higher regional court.

The trademark may be renewed 10 years after the application filing for some or all of the goods and services for which it is registered by payment of the applicable maintenance fee. All renewals and deletions will be recorded in the register, which may be accessed online at register.dpma.de.

Any owner may relinquish its trademark completely, or with regard to certain goods or services, by filing a corresponding written request with the DPMA at any time.

ENFORCEMENT

Civil infringement proceedings may be based on a conflict with older rights. Typically, infringement claims will first be asserted against the infringer by sending a cease and desist letter that requests the infringer to henceforth cease and desist activity, and pay a contractual penalty in case of contravention. The necessity of requiring a contractual penalty to disperse the danger of repeated infringement is a unique feature of the German legal system. Unless the infringer gives such an undertaking, the action requesting an order to cease and desist will remain admissible.

The rights holder may seek an interlocutory injunction from the competent regional higher court (the competence of specific chambers is concentrated on the state level in a few courts in each state) if the matter is urgent, which is legally presumed. The petitioner must request injunctive relief soon after learning about the infringement (this period is not legally defined, although it is generally agreed to be within one month; some courts grant a period of up to two months, while longer periods are granted only under special circumstances). Unless the infringer acknowledges the court order as final and binding, the petitioner will have to institute normal infringement proceedings.

The following remedies are available in civil infringement proceedings:

- claims to cease and desist, which do not depend on the infringement being culpable;
- claims for actual damages, which may be demonstrated via three alternative methods:
 - licence analogy;
 - actual damages suffered by the rights holder; and
 - profits made by the infringer that are attributable to the infringement or unjust enrichment;
- claims for destruction and recall, or permanent removal from sale, unless this would be disproportionate – to secure the enforcement of such claims, under certain circumstances a sequestration can be ordered by interlocutory injunction;
- claims for information concerning the origin and sales channels of unlawfully marked goods or services (in special cases, these claims may also exist against certain third parties);

- claims that the infringer submit or allow access to banking, financial or commercial documents where these are required for the assertion of the compensation claim, unless this would be disproportionate – the court has the power to guarantee confidentiality protection;
- information claims, which under certain circumstances may be granted through an ex parte interlocutory injunction; and
- claims for the publication of the final judgment.

Reasonable attorneys' fees and court fees are awarded, depending on the extent to which a party prevails. Court and attorney fees are assessed on the basis of fee statutes that provide for lump sums and cap recoverable amounts.

Wilful trademark infringement is a crime and may be punished. The local public prosecutor's office is empowered by the Federal Act of Criminal Procedure to commence proceedings on its own initiative or upon receiving a complaint. The possibilities of the rights holder to influence the investigation, including the speed at which it is conducted, are limited.

The seizure and eventual destruction of imported counterfeit goods in Germany are possible under German and EU regulations, in regard to which detailed information is available from the German Customs Office at www.zoll.de.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

A change of ownership with regard to a German trademark takes place outside the register through the operation of law (eg, legal succession) or on the basis of an agreement (eg, assignment). While it is not mandatory to record such a change in the register, this is highly recommended to ensure that rights can be enforced without delay. The validity and the form of such a change of ownership depend on the applicable law. With regard to a registered trademark as such, there are no formal requirements. A German representative who is a German attorney at law or patent attorney may request the recordal of a change of ownership in the register without submitting a copy or original of the underlying legal instrument. In all other cases, documentary proof must be submitted.

Trademark licences are also granted outside of the register. A licensee may itself start infringement proceedings only with the consent of the licensor or owner of the licensed right. There is no statutory requirement to register a licence.

Commercial designations and names are regarded as being inextricably associated with the relevant business operation or company (eg, goodwill) and may not be transferred without the business operation as such or licensed to another company. The related legal issues are complex.

RELATED RIGHTS

A trademark that is an individual and sufficiently original creative work may also be protected by copyright. This not only applies to device marks, but on rare occasions may also include slogans that meet a high standard of originality.

Further, there may be a nexus between trademark infringement and the German Unfair Trade Practices Act. This legal area is mapped out by many precedents and is highly complex. Enforcement resembles trademark infringement matters to a certain extent, but claims differ substantially.

ONLINE ISSUES

The ccTLD '.de' is governed by DENIC eG. A dispute concerning a '.de' domain name may be registered with DENIC to prevent its transfer. Disputes must be resolved amicably or, if this is not possible, in court. A substantial body of trademark case law applies to cyberspace, just as it does to the offline world. For example, a domain name that is similar or identical to a registered trademark also requires use for identical or similar goods or services for a trademark-based claim to succeed. Cases of famous marks or bad-faith domain name registration may be different. Bearing this in mind, precedents have established that metatags can be infringing. Google Ads usage, on the other hand, will not normally constitute infringement unless the displayed advertisement contains something that is infringing.

No: if attorney at law or patent attorney admitted in Germany.	No	Yes: if representable in such a way that they can clearly and unambiguously determined.
Yes	Yes	Yes: three months from publication.
Yes: following five years' non - use from later of registration or end of opposition.	Yes	Yes
Yes	No	Yes: urgency required.
No	No special provisions; however, general provisions apply.	No

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Greece: Trademark procedures and strategies

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Dr Helen G Papaconstantinou and Partners Law Firm

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LEGAL FRAMEWORK

The most important pieces of legislation governing trademarks in Greece are:

- Law 4679/2020 on the Protection of Trademarks and the Incorporation of the Directive (EU) 2015/2436 and the Directive 2004/48/EC on the Enforcement of Intellectual Property Rights and other provisions (the Trademark Protection Law);
- Law 4796/2021, which provides the transfer of the responsibilities regarding trademarks from the Directorate of the General Secretariat for Trademarks of the Ministry of Development and Investments to the Hellenic Industrial Property Organisation (OBI);
- Law 146/1914 (the Unfair Competition Law), as amended and now in force;
- relevant EU legislation such as:
 - Directive (EU) 2015/2436;
 - the EU Trademark Regulation 2017/1001 governing substantive aspects of EU trademarks; and
 - secondary legislation such as the EU Delegated Regulation 2018/625 and the EU Implementing Regulation 2018/626 governing certain procedural aspects;
- Chapter C of Law 2943/2001, which establishes the Greek Community trademark courts;
- Law 213/1975 ratifying the Paris Convention for the Protection of Industrial Property (the Paris Convention);
- Law 2505/1997 ratifying the Nice Agreement on the Classification of Goods and Services;
- Law 2290/1995 ratifying the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- Law 2783/2000 ratifying the Madrid Protocol concerning the International Registration of Marks.

UNREGISTERED MARKS

PROTECTION

Unregistered signs are protected under Articles 13 to 15 of the Unfair Competition Law and may constitute relative grounds for refusal. In particular, protection is offered to signs that are deemed to have become a distinctive feature of the goods or services that they cover.

USE REQUIREMENTS

To obtain protection, an unregistered sign must have distinctive character and must have been used in commerce. No specific statutory conditions outline the extent and type of use that will satisfy these criteria; hence, courts rule on a case-by-case basis. The guiding principle is that use should be systematic, continuous and substantial.

REGISTERED MARKS

OWNERSHIP

Any individual or legal entity may file an application for the registration of trademarks, while cooperatives, associations and public entities may apply for the registration of collective trademarks.

POWER OF ATTORNEY

The trademark application must be signed by the applicant or its authorised attorney, whose appointment is optional. If a lawyer is appointed, a signed power of attorney is required, which remains valid for five years.

SCOPE OF PROTECTION

For a sign to constitute a trademark, apart from being able to distinguish the goods or services of one undertaking from those of another, it must be represented in a manner that enables the competent authorities and the public to determine the clear and precise subject matter of the protection offered to its owner.

Greek trademark law provides for two types of grounds for refusal or invalidation, as outlined below.

ABSOLUTE GROUNDS

The following signs cannot be protected as trademarks:

- signs that cannot constitute trademarks in accordance with Article 2, paragraph 1 of the Trademark Protection Law;
- signs that are devoid of distinctive character;
- signs that consist exclusively of signs or indications that serve in trade to designate characteristics of the relevant goods or services;
- signs that consist exclusively of signs or indications that have become customary to designate the relevant goods or services in the current language, or in the bona fide and established practices of the trade;
- signs that consist exclusively of a shape or another feature imposed by the nature of the goods, are needed to obtain a technical result or give substantial value to the goods;
- signs that are contrary to public policy or morality;
- signs that may deceive the public – for instance, as to the nature, quality or geographical origin of the relevant goods or services;
- signs that have not been authorised for use by the competent authorities and that are to be refused pursuant to Article 6~~ter~~ of the Paris Convention; and
- signs that include badges, emblems or coats of arms other than those covered by Article 6~~ter~~ of the Paris Convention, which are of public interest, unless the appropriate authorities have granted consent to the registration;
- signs excluded from registration under Greek law, EU law or international agreements in which the European Union or Greece is a party, conferring protection to designations of origin and geographical indications;
- signs excluded from registration under relevant legislation conferring protection to traditional terms for wine and to traditional specialities guaranteed;

- signs that consist of, or reproduce in their essential elements, the denomination of a previous registered plant variety, according to relevant legislation;
- signs of high symbolic value; and
- signs filed in bad faith.

RELATIVE GROUNDS

A sign may not be adopted as a trademark if it is:

- identical to an earlier trademark and both marks cover identical goods or services;
- identical or similar to an earlier trademark where there is identity or similarity of the goods or services covered and there exists a likelihood of confusion (including the likelihood of association) to consumers; and
- identical or similar to an earlier trademark that has acquired a reputation, irrespective of the similarity of goods or services covered, when the use of the later mark, without due cause, would take unfair advantage of or be detrimental to the distinctive character or repute of the earlier trademark.

In the context of the above, 'earlier trademarks' include:

- earlier registered national trademarks, EU trademarks, and trademarks registered internationally and effective in Greece;
- earlier applications for the trademarks stated above, subject to registration; and
- well-known marks within the meaning of Article 6*bis* of the Paris Convention.

A trademark application can also be opposed on relative grounds if it:

- conflicts with a prior distinctive sign, used in the course of trade, which gives the owner the right to prohibit the use of any later trademark;
- conflicts with an earlier right of personality or a prior right of intellectual or industrial property other than those regulated by trademark law; and
- is capable of causing confusion with a trademark that has been registered and used abroad at the time of filing the application, provided that it was made in bad faith by the applicant.

Further grounds for refusal or invalidation are provided in case of unauthorised trademark filing by an agent or representative, and of geographical indications and designations of origin under specified circumstances.

PROCEDURES

Law 4796/2021 provides for the transfer of the responsibilities regarding trademarks from the Directorate of the General Secretariat for Trademarks of the Ministry of Development and Investments to the OBI, which is supervised by the Ministry of Development and Investments.

According to the aforementioned law, the OBI is responsible for the awarding of national trademarks, the maintenance of the register of trademarks and the exercise of all responsibilities related to trademarks, in general.

The transfer of all responsibilities regarding trademarks to the OBI aims at creating a unified national policy for all industrial property rights, in harmonisation with the practice of other countries. A joint Ministerial Decision of the Ministry of Development and Investments as well as of the Ministry of Finance is expected to regulate all the necessary organisational, technical and practical details of the transfer.

Trademark applications are checked in terms of completeness, representation, specification of goods or services and other formalities by the trademark auditors. Specially designated employees (researchers) identify prior rights, the owners of which will receive notification of the publication of the later mark for the purpose of filing an opposition before the Administrative Trademark Committee.

EXAMINATION

The examiner only checks applications with respect to absolute grounds. If there are no such grounds for refusal, the application is published on the OBI's website for opposition purposes. If grounds for refusal exist, the applicant is notified and may revoke the application, limit the trademark to the extent that it becomes acceptable or submit its observations within 30 days as of the next day of notification. If the applicant fails to reply or comply within the set term, the application will be rejected. The examiner's decision to reject an application can be challenged before the Administrative Trademark Committee and the committee's decision is subject to further recourse before the first instance administrative court.

A smooth application from filing to registration, where no opposition is filed, usually takes six to eight months. Where an opposition is filed, the decision is expected to be issued within between 15 and 18 months of filing.

OPPOSITION

Third parties may oppose the registration of a trademark on both absolute and relative grounds. The term for filing an opposition is three months as of the next day of the publication of the decision on the OBI's website. If no opposition is filed, the trademark is registered.

Proof of use is provided as a defence during opposition proceedings. If the trademark on which the opposition is based has been registered for more than five years as at the filing date of the opposed application, the applicant can request that the opponent submit evidence of genuine use of the mark in respect of the relevant goods or services on which the opposition is based in the five years preceding the filing date of the application, or prove that there are proper reasons for non-use. Failure to meet these requirements will result in the rejection of the opposition for procedural reasons.

REGISTRATION

A trademark is registered when it is accepted by a decision of the examiner or the Trademark Committee (provided that no further legal remedies are sought) or by a final decision of the administrative courts. A registered mark is granted protection for 10 years as of the filing date and is indefinitely renewable every 10 years. If renewal is not effectuated within the specified period, the trademark may still be renewed up to six months later after payment of a fine.

Third parties' rights acquired during this six-month grace period, however, cannot be overturned.

REMOVAL FROM REGISTER

SURRENDER

The owner may surrender the trademark at any time for all or part of the goods or services for which it is registered. The surrender must be declared in writing, otherwise it does not have effect. If the mark is subject to a (registered) licence, its surrender will be entered in the register only if the owner proves that the licensee has been duly informed of the intention to surrender the mark.

REVOCACTION

A trademark can be revoked, either in whole or in part, if:

- it has not been put to genuine use by its owner for a continuous five-year period following registration in connection with the goods or services in respect of which it is registered, or if such use has been suspended for an uninterrupted five-year period;
- in consequence of acts or inactivity on the part of the rights holder, the trademark has become commonly used or the common name in the trade for the goods or services in respect of which it is registered; or
- by reason of the use made of a mark by the owner or with its consent in connection with the goods or services for which it has been registered, it is likely to mislead the public, particularly as to the nature, quality or geographical origin of those goods or services.

It is worth nothing that it is the trademark owner that bears the onus of proving genuine use of the challenged mark. Evidence of use must be provided for all goods and services covered by the mark in question and the registration will only be considered valid with respect to those goods or services for which use has been shown. The commencement or resumption of use within a period of three months preceding the filing of the claim for revocation shall be disregarded where preparations for the commencement or resumption occurred only after the proprietor became aware of the fact that the claim may be filed.

INVALIDITY

A trademark may be declared invalid if it should not have been registered in the first place because it was registered in breach of the provisions regarding absolute or relative grounds for refusal. The proof of use requirement also applies in invalidity proceedings.

A trademark will not be declared invalid, even if it was devoid of distinctive character, descriptive or generic at the time of its filing, if such grounds no longer exist at the time of filing a petition for the declaration of invalidity or of a related counterclaim because the trademark has since acquired distinctive character through use.

Decisions ordering the revocation of a mark or a declaration of invalidity take effect as soon as they become final.

While the Trademark Committee is competent for both opposition and invalidity or revocation cases, appeals relating to invalidity or revocation actions are heard by the civil courts. Civil courts are also empowered to deal with counterclaims for revocation or invalidity of both national and EU trademarks. Counterclaims for the temporary invalidity or revocation of the mark may also be filed in the context of preliminary injunctions, even though the related court decision cannot result in the permanent invalidation or revocation of the trademark.

ENFORCEMENT

A registered trademark confers exclusive rights on its owner, who is entitled to prevent all third parties from using in transactions without its consent any sign that:

- is identical to the trademark in question in relation to identical goods or services;
- is identical or similar to the trademark in relation to identical or similar goods or services, provided that a likelihood of confusion exists, including a likelihood of association; or
- is identical or similar to a trademark that has acquired reputation and the use of which would take unfair advantage of the reputation of the trademark without due cause or would cause detriment to the distinctive character or reputation of the famous trademark, irrespective of whether the sign will cover goods or services that are similar to those of the earlier trademark.

The owner of a prior trademark cannot oppose the use of a later mark if it has acquiesced to the use of the later mark for five successive years while being aware of such use, unless registration of the later trademark was obtained in bad faith.

The Trademark Protection Law introduced the right of the trademark owner to prohibit preparatory acts of infringement with respect to packaging or other means and sets out the parameters for the protection of trademark owners in transit cases, harmonising the treatment of national trademarks with that of EU trademarks.

REMEDIES IN CIVIL PROCEEDINGS

Special divisions have been established for EU trademark infringement cases in the first and second instance civil courts of Athens and Thessaloniki. These divisions also hear national trademark infringements when they are competent to do so *ratione loci*.

Greece has fully implemented the EU Enforcement of Intellectual Property Rights Directive 2004/48.

In cases of trademark infringement, action may be pursued before the civil courts.

MAIN INFRINGEMENT ACTIONS

In the context of a main infringement action, the rights holder may request:

- permanent cessation of the infringing activities;
- desisting from future infringing activity;
- removal of the infringing signs from the infringing goods, or the withdrawal, confiscation or destruction of the infringing goods themselves;
- imposition of penalties in cases of non-compliance – the new law has raised the penalty from €10,000 to €100,000 to act as a deterrent against recidivist infringers;
- moral and material damages; and
- publication of the judgment in the press or online, at the infringer's expense.

Remedies under the first three points above are also available against intermediaries.

The issuance of a first instance decision in main civil proceedings takes on average between 15 and 18 months.

INJUNCTIONS

A petition for an injunction requires that the situation be urgent and, consequently, it is recommended that rights holders act immediately on learning of the infringement. Preliminary measures may be also requested against intermediaries, while *ex parte* proceedings are also a possibility provided by law under exceptional, specified circumstances.

Trademark owners may also seek injunctive relief against intermediaries.

TEMPORARY RESTRAINING ORDERS

Temporary restraining orders may be requested only if a petition for injunction has also been filed simultaneously and are available only in cases of extreme urgency. As a rule, the judge invites the respondents to attend the hearing, although proceedings may also take place *ex parte*.

In infringement proceedings, the respondent may claim non-use as a defence, requesting that the plaintiff or owner of the trademark should prove that, during the five-year period preceding the date of bringing the action, the trademark had been put to genuine use in connection with the goods or services in respect of which it is registered or that there are proper reasons for non-use, provided of course that the trademark was not registered for less than five years as of the date of bringing the action.

The respondent may also raise said defence in preliminary injunctions.

DAMAGES

In the calculation of damages, the negative economic consequences suffered by the rights holder, including loss of profits as well as profits made by the infringer, are taken into account. Damages may also be calculated on the basis of hypothetical royalties.

Damages and moral damages may be claimed only in cases of wilful misconduct or gross negligence, a provision that may favour infringers and is inconsistent with the degrees of negligence required for copyright and patent infringement.

CUSTOMS PROCEDURES

The EU Customs Regulation 608/2013 is directly applicable in Greece and, as no national border law exists, the regulation sets out the domestic customs intervention procedure.

CRIMINAL PENALTIES

Criminal penalties are provided for various acts of trademark infringement, although criminal prosecution does not take place *ex officio* but following the filing of a related criminal complaint by the rights holder. Professional and commercial-scale infringement are considered as aggravating circumstances.

MEDIATION

Law 4640/2019 has put in place a compulsory initial mediation session before the hearing of a case in a legal dispute arising, among other things, from trademark infringement. That session, along with proof of the lawyer's compliance with the obligation to inform the client in writing about the option of mediation, have become a prerequisite for the admissibility of

a main infringement action. Voluntary mediation is also an option in Trademark Committee proceedings.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Ownership changes (eg, assignments and mergers) and various other changes (eg, changes of name, address and legal style of the rights holder) must be recorded in the trademark register in order to be enforceable against third parties.

Likewise, licence agreements must also be properly recorded in the register for the licensee to claim and enforce its rights against third parties and for the licensee’s use of the mark to benefit the trademark owner.

The signatures of the parties on both assignment deeds, merger contracts and licence agreements must be notarised and legalised with apostille. Evidence regarding the right of the signatories to represent the contracting parties is also required.

RELATED RIGHTS

There are clear areas of overlap between trademarks and other IP rights, as trademark protection may also be complemented by other related IP rights, provided that the protection criteria of such rights are met.

Shapes of products or their packaging, trade dress, logos and business names, as well as other unregistered rights, may under certain circumstances enjoy similar protection to that afforded to trademarks under the Unfair Competition Law. If certain conditions are met, these may all be regarded as non-registered marks and enjoy related rights of priority and protection.

ONLINE ISSUES

The regulation of telecoms in Greece is vested in the Hellenic Telecommunications and Post Commission. The main legal framework can be found in the Regulation on the Management and Assignment of Domain Names, which was most recently amended in March 2018. The regulation sets out the procedures for registering domain names in the country code top-level domain ‘.gr’ or ‘.ελ’ and the grounds for cancellation petitions, which may also include a request for the transfer of the contested domain name to the petitioner. Commission decisions can be appealed to the Athens Administrative Court of Appeal within 30 days of their official notification to the parties.

Yes: power of attorney required. No: requires no notarisation.	No	Yes: 3D; aspects of packaging; slogans; colour combination; sounds; position; holograms; motion; patterns; audio - visual marks.
Yes	Yes	Yes: three months from publication on Trademark Office website.

Yes: following five years' non - use from registration or suspension of use.	Yes	Yes
Yes	No	Yes: urgency required.
Yes	No: no special provisions, general provisions apply. Concept of cybersquatting applicable to bad faith.	Yes: Hellenic Telecommunications and Post Commission.



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LEGAL FRAMEWORK

The Trademarks Act 1999 and the Trademarks Rules 2017 are the relevant laws in India.

UNREGISTERED MARKS

Unregistered trademarks are protectable in India through passing-off actions in the applicable court. The owner of an unregistered mark does not possess a right to sue for infringement. However, such an owner gets common law benefits.

Continuous and extensive use of an unregistered trademark in respect of particular goods and services as well as a sufficient amount of reputation and goodwill gained by such a trademark in respect of those goods and services are required for establishing unregistered rights.

REGISTERED MARKS

A person who claims to be the owner of the trademark in relation to goods or services may apply for its registration. The following can file a trademark application:

- a natural person;
- a body corporate;
- a partnership firm;
- a trust;
- a society;
- a government department, authority or undertaking; and
- in the case of collective trademarks, a Hindu undivided family, an association of persons or joint owners.

At the time filing a trademark application or during taking over the representation of a trademark, a representative is required to file a signed power of attorney. The power of attorney does not need to be notarised or legalised.

A mark capable of being represented graphically and of distinguishing the goods or services of one person from those of others can be registered as a trademark. A device, label, brand, name, signature, letter, ticket, heading, word, numeral, shape of goods, packaging, and a combination of colour and sound marks can be registered.

Marks that cannot be registered as trademarks include:

- international non-proprietary names; and
- marks that:
 - lack distinctive character (non-distinctive marks);
 - have become customary in current language or common to trade, or both;
 - result from the shape of goods;
 - describe the goods or services, or their characteristics (descriptive marks);
 - are likely to deceive the public;

- contain scandalous or obscene matter;
- are prohibited under the Emblems and Names (Prevention of Improper Use) Act 1950;
- hurt the religious sentiments of any class or section of the public;
- are identical or similar to an earlier mark for the same goods or services;
- are identical or similar to well-known marks; and
- are protected by copyright law.

If a law of passing off is protecting an unregistered trademark, such a mark cannot be used or registered by other persons as trademarks.

PROCEDURES (FOR REGISTERED MARKS)

EXAMINATION

Once the application is filed and all filing formalities are found to be in order, the application is examined on absolute (distinctiveness, descriptiveness, etc) and relative (prior marks on register) grounds of refusal. Once examined, the Trademarks Registry can either issue an examination report based on procedural objections, such as filing a power of attorney or user affidavit, or based on substantive objections on relative and absolute grounds of refusal. If there are no objections, the application is accepted for publication in the *Trademarks Journal*. If objections are raised, a written response must be filed within one month of receipt of the examination report. However, even if, after reviewing the written response, the examiner continues to maintain the objections, a hearing is scheduled to hear oral arguments in support of the application. If the examiner is satisfied with the response, the mark is advertised in the *Trademarks Journal* and the mark is open to third-party opposition for a period of four months. If no opposition is filed by any third party within four months of the date of publication, the mark proceeds towards registration.

OPPOSITION

After the publication of a trademark in the official Trademarks Journal, any person can oppose a trademark by filing a notice of opposition through Form TM-O within four months of the date of publication. Upon receipt of such a notice from the Trademarks Registry, a counterstatement must be filed within the two-month statutory deadline. If the applicant fails to file its counterstatement within this two-month time frame, the application is deemed to have been abandoned. Within two months of service of the counterstatement on the opponent, the opponent is required to file evidence in support of the opposition or a reliance letter on the content of the opposition that is directly served on the applicant. Within two months of receipt of evidence in support of the opposition, the applicant is required to file evidence in support of the application or a reliance letter on the content of the counterstatement that is directly served on the opponent.

If the opponent or the applicant fails to file evidence by way of an affidavit or a reliance letter, the opposition or application is deemed to have been abandoned.

Within one month of receipt of evidence in support of an application, the opponent may file evidence in reply, if any. Upon completion of the evidence submission stage, a hearing is appointed by the Trademarks Registry to decide the matter on merit, allowing or dismissing the opposition.

REGISTRATION

If an application successfully passes the post-publication opposition period or the matter is decided in favour of the applicant during the opposition hearing, the mark is granted registration for period of 10 years. A registered mark can be renewed for recurring periods of 10 years by filing a renewal request within one year prior to the expiry of the registration.

REMOVAL FROM REGISTER

If any person is aggrieved by an entry of a trademark wrongly remaining in the Trademarks Registry, they may file a petition for cancellation of registration or rectification of the Trademarks Registry to remove the mark.

Any person aggrieved by wrongful entry on the Trademarks Register can present a cancellation or rectification petition on Form TM-O before the Trademarks Registry, depending on the relevant jurisdictional office. After the cancellation or rectification petition is filed with the Trademarks Registry, the Trademarks Registry serves the cancellation or rectification petition on the registered proprietor of a trademark, directing the latter to file a counterstatement. The registered proprietor is required to file its counterstatement within the two-month deadline (extendable by one month) from the service of the cancellation or rectification petition. Pursuant to the filing of the counterstatement, the Trademarks Registry serves a copy of the counterstatement on the petitioner within a period of one month. If the registered proprietor fails to file a counterstatement within three months, the petitioner shall proceed to file evidence in support of the cancellation or rectification petition. Within two months of receipt of the counterstatement, the petitioner is required to file evidence in support of cancellation or rectification, or a reliance letter on the content of the cancellation or rectification petition served on the registered proprietor. Within two months of receipt of evidence in support of cancellation or rectification, the registered proprietor is required to file evidence in support of registration or a reliance letter on the content of the counterstatement served on the petitioner. Within one month of receipt of evidence in support of registration, the petitioner may file evidence in reply, if any. Upon completion of the evidence submission stage, a hearing is appointed by the Trademarks Registry to decide the matter on merit.

A petition for cancellation or rectification of a registered trademark can be filed before the concerned high courts in India based on the jurisdictional office of the trademark registration. The five such courts are the High Courts of Delhi, Bombay, Calcutta, Madras and Gujarat.

A registered trademark becomes vulnerable to non-use cancellation if it has not been used for continuous period of five years and three months from the date on which registration was granted (ie, when the mark is actually entered on the register).

TIME FRAMES

UNOPPOSED REGISTRATIONS

In straightforward cases where the Trademarks Registry does not object to a trademark application on absolute or relative grounds of refusal and not opposed by third party, the mark is granted registration within approximately six to eight months.

If the Trademarks Registry objects to a trademark and, despite the filing of a written response, the application is kept pending for pre-acceptance hearings, it may take between six months and one and a half years for the mark to be listed for such hearings, depending on the

jurisdiction. Upon its acceptance and if it successfully passes the no-opposition publication stage, it may take approximately two years for the mark to be granted registration.

If the Trademarks Registry objects to a trademark on absolute or relative grounds of refusal, or both, and upon the filing of a written response, if the application is accepted for publication upon review of the written response and successfully passes the no-opposition publication stage, the mark is granted registration within approximately 10 to 12 months.

OPPOSITION PROCEDURES

The entire contested opposition proceeding, which runs from the filing of a notice of opposition until the final order is passed, is usually concluded within three to five years or more.

RENEWALS

A renewal request is recorded and updated with the Trademarks Registry within approximately seven to 21 days.

MERGERS

A merger request is recorded with the Trademarks Registry within approximately six to eight months.

CHANGES OF NAME

A request for a change of name is recorded and updated with the Trademarks Registry within approximately two to three months (without objections).

AVAILABILITY OF SEARCHES

Searches are available for records from the 1940s onwards. Identical and similar trademark searches are freely available on the Trademarks Registry's website, as are searches per class and searches of all classes (in individual classes). Searches that include trade names and slogans and traditional graphic marks are also freely available on the Trademarks Registry website. Searches of non-traditional graphic marks are not available.

ENFORCEMENT

Causes for action include infringement of registered trademark rights and passing-off claims based on common law rights. For details on administrative proceedings, please refer to the Procedures (for registered marks) section.

REMEDIES

Civil remedies are available in the form of interim and permanent injunction orders against defendants, punitive damages, and destruction of infringing goods. Criminal remedies are available in the form of seizure of infringing goods, imprisonment and penalties. Administrative remedies are available in the form of refusal of the infringing mark from registration, and a ban on import and export of infringing goods, which is governed by the Customs Authority.

JURISDICTION

Civil suits for trademark infringement or passing off shall be filed before a district court in the relevant jurisdiction to try the suit. Additionally, high courts with original jurisdiction – such

as the High Courts of Bombay, Calcutta, Delhi, Madras and Himachal Pradesh – can also entertain trademark disputes. An action for trademark infringement or passing off can be initiated by filing a plaint before the appropriate court wherein reliefs are sought. Opposition can be filed before the various jurisdictional offices of the Trademarks Registry. Custom recordal applications for registered trademarks can be made before the Customs Authority.

CIVIL PROCEEDINGS

The pretrial procedure in a civil suit comprises several stages that are preceded by the filing of the suit (plaint) before the appropriate court. However, the plaintiff is first required to institute pre-litigation mediation except in a case where urgent interim relief is being sought. The court could be the state's district court or its high court (based on original jurisdiction). The stages of a civil suit until trial are described below.

- Stage one: admission of suit and hearing on the ex parte injunction application. The filed suit is accompanied by an interim injunction application under Order 39, Rules 1 and 2, seeking ex parte interim relief. For the first hearing, the court reviews the grounds of injunction pleaded in the suit and interim injunction application. If the court decides that the plaintiff has made a suitable case for the grant of an interim injunction and the balance of convenience is in favour of the plaintiff, the court passes an ex parte injunction order and simultaneously issues a court summons to the defendant to appear in further hearings and to file its written statement within the stipulated time frame. If the court decides against passing an ex parte injunction order and deems it necessary that the defendant be present to defend its claims, the court issues a court summons to the defendant to appear in further hearings and to file its written statement within the stipulated time frame.
- Stage two: service of court summons on the defendant. To comply with Order 39, Rule 3, the plaintiff and court's registry are mandated to serve copies of the plaint and supporting exhibits alongside the court order to the defendant through postal and courier services as well as through electronic communication in the form of emails.
- Stage three: appearance of the defendant and filing its written statement. The defendant is allowed a period of a few weeks or months upon the service of court summons to file a written statement in its defence and appear in the second court hearing. The defendant, at this stage, generally also files a response to the plaintiff's interim injunction application under Order 39, Rules 1 and 2. In cases where an ex parte injunction order has been passed against the defendant, the defendant is at liberty to file an application seeking the vacation of the interim injunction order under Order 39, Rule 4.
- Stage four: filing of reply, rejoinder and replication by parties involved. Both sides have equal opportunity to file responses to the applications filed by the other side. For example, under Order 39, Rules 1 and 2, the plaintiff can file:
 - a replication to the written statement filed by the defendant;
 - a response or reply to the defendant's application seeking vacation of the interim injunction order; and
 - a rejoinder to its interim injunction application.

- Stage five: the court decides the plaintiff's application for the grant of an interim injunction based on contentions put forth by both sides.
- Stage six: admission or denial of documents filed by both sides.
- Stage seven: framing of issues by the court.
- Stage eight: the plaintiff files its evidence under affidavit and provides a list of witnesses. Thereafter, trial begins (ie, exhibiting documents filed by the plaintiff and cross-examination of its witnesses by the defendant). The next step involves the same procedure for the defendant.

Final arguments are followed by the court's final judgment.

CRIMINAL PROCEEDINGS

A complaint against an infringer can be filed by the holder of the trademark registration or its authorised person before the police or the magistrate. Under section 103 and 104 of the Trademarks Act 1999, acts such as applying false trademarks or trade descriptions (or both) to goods and services, or possession of any instrument for falsifying or falsely applying a trademark, are cognisable offences and the police can arrest an infringer without a warrant. These offences are punishable with imprisonment of between six months and three years or a fine, or both. The fine may be between 50,000 and 200,000 Indian rupees.

The procedure for filing a direct complaint before the police for infringement of trademark is provided under Section 115 of the Trademarks Act 1999. Under this section, any police officer not below the rank of deputy superintendent or equivalent, if satisfied that any of such offences has been committed, shall search and seize (without warrant) any goods, die, blocks, machines, plates or other instruments or things involved in committing the offence. However, the police must seek an opinion from the Trademarks Registry on the facts of the case before they can initiate any action against an infringer or counterfeiter.

No court inferior to that of metropolitan magistrate or judicial magistrate of the first class can try offences under Trademarks Act 1999. To initiate criminal proceedings against the infringer before the magistrate, the holder of the trademark may also file a criminal complaint under Section 156 of the Code of Criminal Procedure 1973.

SPECIALIST TRADEMARK OR IP COURTS

Subsequent to the abolition of the Intellectual Property Appellate Board in April 2021, the Intellectual Property Division was established in the High Court of Delhi to hear IP cases. The other high courts are also in the process of establishing special divisions to hear IP cases.

DAMAGES

The cost of litigation is recoverable from the defendant, and the Commercial Courts Act 2015 specifically provides the mechanisms for the payment of costs. However, recovery of costs depends upon several factors, including:

- merits of the case;
- quantum of loss;
- evidence submitted before the court;
- balance of convenience;

- dishonest intention of the defendant; and
- injury and monetary loss incurred by the plaintiff.

Interim relief is available and a civil suit for trademark infringement and passing off can be filed within three years of the date of the cause of action.

It generally takes anywhere between two and three years – sometimes more – for proceedings to reach trial from the commencement of a civil suit.

OWNERSHIP CHANGES AND RIGHT TRANSFERS

For filing assignment requests, the required documents are a signed power of attorney from the assignee, a notarised assignment deed signed by both assignor and assignee, and a notarised affidavit of no legal proceeding signed by the assignee. All documents that must be filed along with the assignment request are required to be notarised.

In India, Section 48(2) of the Trademarks Act 1999 envisages that the permitted use of a trademark by a registered user is deemed to be use by the proprietor of the trademark.

RELATED RIGHTS

There are overlaps between trademark rights and other rights. If the infringing mark has a device or logo that is similar to the artistic work of the plaintiff, the use thereof can be enjoined by claiming both trademark and copyright infringement.

For enforcement action involving trade dress, logo or packaging (ie, registered lettered trademark coupled with artistic elements under the Copyright Act 1957), the holder of the trademark can sue the infringer under both trademark and copyright infringement.

ONLINE ISSUES

The Trademarks Act 1999 recognises the use of the mark on the internet depending upon the facts and circumstances of the case. The act contains remedies against the misuse of marks on the internet. There are no specific provisions for domain names, websites, hyperlinks, online ads or metatags, but the Trademarks Act 1999 captures misuse of trademarks in such cases as infringements. Recourses are administrative.

The right holder can file a suit for infringement and passing off, and can also file a domain name complaint before the National Internet Exchange of India (NIXI) and WIPO.

The .IN Domain Name Dispute Resolution Policy (INDRP) and the .IN Registry created by the NIXI are responsible for regulating the ccTLD. Any dispute relating to .in and .co.in domains are resolved in accordance with the INDRP and the INDRP Rules of Procedure.

Yes: the representative is required to file a signed power of attorney, but notarisation and legalisation are not required.	Yes: an objection based on prior identical or similar marks for the same or similar descriptions of goods or services.	Combinations of colours; sounds; motions; and shapes of goods.

Yes: a bona fide prior user of an unregistered trademark can sue subsequent parties on the grounds of passing off.	Yes: protection granted to well - known marks is quite stringent.	Yes: opposition against published marks can be filed within four months of the date of publication.
Yes: continuous non - use for five years and three months from the registration date makes a mark vulnerable to cancellation.	Yes	Yes
Yes	Yes	Yes: within a week to a few months.
No: both registered and unregistered trademarks can be assigned, and the recordal of a licence is possible only for registered trademarks.	No	Yes



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Israel: Trademark procedures and strategies

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LEGAL FRAMEWORK

Relevant national laws include:

- the Trademarks Ordinance (new version – 5732/1972);
- the Trademarks Regulations 1940;
- the Trademarks Order (Protection of Industrial Property) 1934;
- the Merchandise Marks Ordinance 1929, as amended;
- the Merchandise Marks Regulations 1935;
- the Appellations of Origin (Geographical Indications) (Protection) Law (5725/1965);
- the Appellations of Origin (Procedure of Registration of Appellations of Origin Originating in a Foreign Country) Regulations (5727/1967);
- the Appellations of Origin (Procedure before Appeal Committee) Regulations (5727/1966);
- the Symbols Protection Act (5735/1974);
- the Trademark Regulations (Implementation of the Madrid Protocol) (5767/2007);
- the Unjust Enrichment Law (5739/1979);
- the Commercial Torts Law (5759/1999); and
- the Consumer Protection Law (5741/1981).

Israel has signed the following international treaties:

- the Paris Convention for the Protection of Industrial Property (1883), Stockholm (1967);
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Nice Agreement on the International Classification of Goods and Services (1957), Stockholm (1967);
- the Lisbon Agreement for the Protection of Appellations of Origin and their International Registration (1958), Stockholm (1973); and
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

UNREGISTERED MARKS

While the Trademark Ordinance predominantly provides protection for registered trademarks, it also protects unregistered well-known trademarks.

Unregistered marks that are not considered well known may be protected under:

- the Commercial Wrongs Law (5759/1999), incorporating the tort of passing off;
- the Consumer Protection Law (5741/1981), according to which a lawsuit may be initiated against a third party using the mark in a manner that deceives the consumer public; and
-

the Law of Unjust Enrichment (5741/1981), according to which unfair competition and unfair use of one's goodwill in a mark is prohibited.

According to Israeli law, there is no specific use requirement for establishing the mentioned rights. Each case is judged on its own merits, and the duration, extent, nature of use and nature of the mark are all taken into consideration to determine eligibility for protection.

Unregistered rights may also be protected under different laws, including the Unjust Enrichment Law, the Commercial Torts Law and the Consumer Protection Law.

REGISTERED MARKS

Any person or legal entity may obtain protection for a mark. No power of attorney is required before filing, but one must be submitted to the Israeli Trademark Office (ITO) at a later stage. No notarisation or legalisation is required.

SCOPE OF PROTECTION

Marks that are usually eligible for registration include those that are fanciful, arbitrary or distinctive, or that have acquired distinctiveness.

The following marks are not eligible for registration:

- a mark referring to a connection with the president of Israel or their household, or to presidential patronage, or a mark from which a connection or patronage might be inferred;
- flags and emblems of the state, its institutions, foreign states or international organisations, and any mark resembling any of these;
- public armorial bearings, official signs or seals used by any state and signs resembling any of these, and any sign from which it might be inferred that the owner enjoys the patronage of, or supplies goods or renders services to, a head of state or government, unless it can be proved that the rights holder is entitled to use it;
- a mark in which any of the following words appear: 'patent', 'patented', 'by royal letters patent', 'registered', 'registered design', 'copyright', "to counterfeit this is forgery" or words to that effect;
- a mark that is or may be injurious to public order or morality;
- a mark that is likely to deceive the public, contains a false indication of origin or encourages unfair trade competition;
- a mark containing a geographical indication in respect of goods originating in the geographical area indicated if the geographical indication may be misleading as to the real geographical area from which the goods originated;
- a mark containing a geographical indication that is literally correct, but that contains a false representation to the effect that the goods originated in a different area;
- a mark identical or similar to emblems of exclusively religious significance;
- a mark on which the representation of a person appears, unless the consent of that person has been obtained – in the case of representation of a deceased person, the consent of their successors is required unless reasonable grounds exist for not obtaining it;

- a mark identical to one belonging to a different owner that is already registered in respect of the same goods or description of goods, or so nearly resembling such a mark to a point of likelihood of confusion;
- a mark consisting of numerals, letters or words that are in common use in trade to distinguish or describe goods or classes of goods, or that bear direct reference to their character or quality, unless the mark has a distinctive character;
- a mark whose ordinary significance is geographical or a surname, unless represented in a special manner or unless having a distinctive character;
- a mark identifying wines or spirits that contains a geographical indication, if the wine or spirit did not originate in that geographical area;
- a mark identical or misleadingly similar to a well-known trademark, even if the mark is not registered with respect to goods for which the mark is well known or with respect to goods of the same description;
- a mark identical or similar to a well-known registered trademark, even with respect to unrelated goods or services, if the mark sought to be registered might indicate a connection between the goods with respect to which the mark is sought and the registered owner of the trademark, and the registered owner of the trademark might be harmed as a result of using the mark sought; and
- a mark identical to, resembling or containing the name or business name of another person or entity, if the mark is likely to deceive the public or to cause unfair competition.

PROCEDURES

FILING AND EXAMINATION PROCEEDINGS

Multi-class trademark applications are available in Israel. The mark is examined several months after filing. Proceedings may be accelerated under certain conditions.

The examination is conducted based on absolute as well as relative grounds.

A unique procedure in Israel relates to a refusal based on the existence of a corresponding pending application (*inter partes* proceedings). If such a refusal is issued, the parties may resolve the conflict by reaching a settlement approved by the registrar. Otherwise, the registrar will issue a decision based on three criteria:

- the applicants' good faith in choosing the trademark;
- the extent of use of the respective marks; and
- the filing dates of the applications.

According to local practice, and as Israel belongs to the common law countries where trademark rights may commonly be acquired by use, more emphasis is given to first use and to volume of use than to the date of filing.

A response to the examiner's objection must be filed within three months. If no response is submitted by the deadline or no extension of time is requested, the ITO will ultimately close the file. Extensions are available up to eight months from the date on which the response should have been filed, while the applicant is required to finalise the examination within two years of the first office action.

Once accepted, the mark will be published in the *Trademarks Gazette*.

OPPOSITION

Upon publication, third parties have three months to oppose the registration. If no opposition is filed, the mark will proceed to registration. The opposition period cannot be extended.

Once the opposition is filed, the applicant has two months to respond by filing a counterstatement. Two months thereafter, the opponent must file its evidence in support of the opposition. Subsequently, the applicant has two months to file its counterevidence and the opponent may then file evidence in response. The evidence is submitted in the form of affidavits. An oral hearing is then scheduled before the ITO (unless the parties reach a procedural agreement to waive cross-examinations). The parties then proceed to submit their oral or (usually) written summations and summations in reply. A decision will be issued thereafter. Such decision is final and binding, unless appealed to the relevant district court.

REGISTRATION

If no opposition is filed within the opposition period or if an opposition has been dismissed, the mark proceeds to registration.

RENEWAL

Registered trademarks are valid for 10 years from the application date.

REMOVAL FROM REGISTER

Any person may file an invalidation action for the removal or amendment of a trademark from the register on the grounds that it is not eligible for registration. Such application should be filed within five years of the registration date. However, if an application was filed in bad faith, there is no five-year limit.

A registered mark may become vulnerable to non-use cancellation action after three years following its registration date. A cancellation action against a registered mark may be initiated by any third party on the grounds that there was no good-faith intention to use the trademark in connection with the goods for which it was registered, and that there has been no good-faith use of the trademark during the three years preceding the application for cancellation.

Principally, cancellation and invalidation actions should be submitted to the registrar at first instance. The registrar's decision may then be appealed to the relevant district court at second instance. However, some actions may be submitted to the first instance court.

SEARCHES

Official trademark searches are conducted for any identical or confusingly similar marks, word marks and device marks for as many classes as requested.

ENFORCEMENT

CIVIL PROCEEDINGS

A request for interim remedies is one of the most valuable tools for the protection of trademarks. The plaintiff will be granted an interlocutory injunction if the court is convinced that the plaintiff has a good chance to win the suit and that the balance of convenience

leans in its favour. A plaintiff that superfluously delays action may not be granted interim remedies. There is no rule of thumb as to how much time must pass before it constitutes such delay, as this depends on the circumstances of each case. The main lawsuit, including the request for a permanent injunction, can be filed at any time within seven years of the date of infringement. However, in extreme circumstances, a superfluous delay might stop the plaintiff from bringing the claim to court.

If the plaintiff prevails, it is entitled to an injunction preventing the continuation of the infringements and, in some cases, destruction of the goods and a financial remedy.

ADMINISTRATIVE PROCEEDINGS

According to the Customs Ordinance, Customs is entitled to detain imported goods that are suspected of infringing trademarks.

It is possible, although not mandatory, for rights holders to file a complaint while recording their registered trademarks with Customs. It is highly recommended that such a complaint be filed if the rights holder is aware of specific shipments of infringing goods bound for Israel or if it wishes to bring certain trademarks to the attention of Customs.

Notwithstanding this, Customs is authorised to seize suspected goods (whether as a result of a complaint submitted by the rights holder or as a result of a random examination of shipments arriving in Israel). Once such goods are seized, Customs must send appropriate notice to the rights holder and the importer.

In most cases involving small shipments, Customs initiates a short procedure while agreeing to destroy the goods based on a written opinion submitted by the rights holder, in which it indicates the reasoning behind its belief that the goods are indeed infringing and provides that it will compensate the importer for any financial damage that may be inflicted as a result of the seizure, as well as joining Customs in any lawsuit initiated by the importer.

In other cases (mostly, when the shipment includes a high number of goods or expensive goods), Customs initiates a long procedure, under which the rights holder must file a lawsuit. As an initial step, the rights holder must submit a bank guarantee to Customs to compensate the importer for any financial damage that may be inflicted as a result of the seizure or the filing of a lawsuit.

Whether a long or short procedure is being instigated, on receiving the customs notification, the rights holder has three working days (with a possible further three-day extension) in which to respond. It may submit the required bank guarantee and relevant documents to complete the short procedure. Only after the bank guarantee has been submitted will Customs advise the rights holder of the importer's details and allow it to obtain a sample of the seized goods. As such, if the rights holder decides to proceed with the short procedure, it will not receive any details regarding the shipment.

Upon filing the bank guarantee, the rights holder can either settle the matter amicably with the importer or file a lawsuit against it within 10 working days of the notice date (an extension of 10 working days is available upon filing a reasoned request).

Should the rights holder choose to take no further action, the goods will be released.

CRIMINAL PROCEEDINGS

The knowing infringement of a trademark constitutes a criminal offence. In the past several years, the IP police units have been downsized and their action is now limited. However, the activity levels of local police stations that do not specialise in intellectual property have increased.

The police may act on the basis of information obtained by its own investigation or a complaint initiated by the trademark owner. The trademark owner (or its representative) is usually required to assist the police by giving a deposition and testify to the nature of the infringement. It is still possible for trademark owners to file private criminal complaints.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

ASSIGNMENT

A pending or registered trademark may be assigned with respect to all or some of the goods or services covered thereby. The assignment should be recorded with the ITO, inter alia, to avoid claims of non-use and to properly maintain any goodwill of the trademark. To record an assignment in Israel, a copy of the deed of assignment executed by the assignor is required, stating that to the best of its knowledge the recordal of the assignment will not cause confusion among the public (if such statement is not included in the assignment document, a separate document may be provided). In addition, an executed power of attorney on behalf of the assignee is required.

LICENCE

Recordal of a licence agreement in Israel is mandatory. Recordal of a licensee or registered user can take place only with respect to registered rights. If a licensee is not recorded as a registered user, the trademark registration may be cancelled for non-use. Further, not recording a licence may have other implications, inter alia, regarding the goodwill of the mark and its associated owners. A recorded licensee can take action against infringements in certain circumstances.

To record the registered user, the licence agreement should indicate:

- the relationship between the owner and the authorised person, including the extent of the owner's control over the authorised person's use;
- the goods in respect of which authorisation is sought;
- the conditions or limitations that are to apply to the use of the mark;
- the period of validity of the authorisation, if its registration is requested for a determinate period; and
- a statement that, to the best of the licensor's knowledge, the recordal of the licence will not cause confusion among the public (if the general agreement includes no statement to this effect, a separate statement may be provided).

In addition, a power of attorney signed by the licensee should be submitted. No notarisation or legalisation is required.

MERGER

A copy of the merger certificate is required. The certificate must reflect a public official or agency attesting to the merger. In addition, a power of attorney must also be filed.

CHANGE OF NAME

One of the following documents is required to record a name change with the ITO:

- a copy of the name change certificate, which attests to the change of name and is made by a public official or agency;
- a copy of the official publication of the change of name; or
- a copy of a notary confirmation indicating that the change of name was registered with the proper authorities in the owner's incorporating country.

CHANGE OF ADDRESS

One of the following documents is required to record a merger with the ITO:

- a copy of the merger certificate, which attests to the merger and is made by a public official or agency;
- a copy of the official publication of the merger; or
- a copy of a notary confirmation indicating that the merger was registered with the proper authorities in the owner's incorporating country.

As all documents are filed electronically, simple copies are sufficient. However, the ITO retains the right to request the original/certified documents, if necessary.

RELATED RIGHTS

Under specific conditions, a trademark logo that has artistic value or a slogan may be protected under copyright law. Three-dimensional (3D) marks may be protected under design law.

The issue of trademarks overlapping with other IP rights is a complex one that has barely been addressed by the Israeli courts. It appears that most cases will turn on their circumstances, but clear guidelines have yet to be established.

That said, the courts have addressed the registration of 3D trademarks and slogans as trademarks – ruling that, in certain cases, the shape of a product may be protected as a 3D trademark if it has acquired distinctiveness and is used as a trademark, and that a slogan filed for registration should be examined in the same manner as any other mark and should not be a priori considered inherently non-distinctive. These judgments were endorsed by the ITO.

ONLINE ISSUES

The Israel Internet Association (ISOC-IL) operates as the registry for domain names under the '.il' ccTLD.

The IL-DRP is an alternative dispute resolution procedure intended to resolve disputes regarding the allocation of domain names under the '.il' ccTLD. The IL-DRP is not intended to create or replace judicial precedent or jurisprudence.

Under the rules for allocation of domain names under '.il', the IL-DRP will review third-party challenges to an existing allocation of a domain name by ISOC-IL on a case-by-case basis. Disputes regarding the allocation of a domain name by a holder may be brought by a third party on the following grounds:

- the domain name is identical or confusingly similar to a trademark, trade name, registered company name or legal entity registration of the complainant;
- the complainant has rights in the name;
- the holder has no rights in the name; and
- the application for allocation of the domain name was made or the domain name was used in bad faith.

No: power of attorney is not required when filing and can be submitted at a later stage. No notarisation/legalisation required.	Yes	Yes: colours; 3D shapes; slogans; sounds.
Yes: but not as much protection as for registered rights and a heavier burden of proof.	Yes: specific protection for unregistered well - known trademarks, and increased protection for well - known and registered trademarks.	Yes: three months from publication in the official Trademarks Gazette.
Yes: at least three years after registration and pending non - use for three years before cancellation action.	Yes	Yes: usually within five years of the registration date.
No	No; but damages can be ordered without having to prove them.	Yes: no statutory time limit, but delay may be taken into account.
Yes	No	Yes: mainly through the Israel Internet Association.

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Japan: Trademark procedures and strategies

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Summary

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LEGAL FRAMEWORK

NATIONAL

The Trademark Act and its related regulations govern the registration and protection of trademarks in Japan. The Examination Guidelines for Trademarks also play an important role in the examination of trademark applications at the Japan Patent Office (JPO).

In addition, the Unfair Competition Prevention Act protects well-known trademarks – both registered and unregistered – as well as certain configurations of goods from unauthorised use.

INTERNATIONAL

The following international treaties apply in Japan:

- the Paris Convention for the Protection of Industrial Property;
- the Trademark Law Treaty;
- the Singapore Treaty on the Law of Trademarks;
- the Nice Agreement on the International Classification of Goods and Services (the Nice Classification);
- the Madrid Protocol; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (the TRIPS Agreement).

UNREGISTERED MARKS

TRADEMARK ACT

Under the Trademark Act, unregistered marks are protected only in certain circumstances, including through prior user's rights.

Even if an unregistered mark is identical or similar to another's registered mark, a prior user may continue to use the mark provided that:

- at the time of the subsequent trademark application, the unregistered mark is well known to consumers or dealers in Japan for goods or services relating to the prior user's business; and
- the prior user has no intention of engaging in unfair competition in its use of the unregistered mark.

The prior user:

- may not seek an injunction or compensatory damages against the infringer;
- may use its unregistered mark only within the specific region in which the mark was used at the time of the subsequent trademark application and only in relation to the goods or services for which it was used at the time; and
- may assign the mark only along with its business.

UNFAIR COMPETITION PREVENTION ACT

Unregistered marks that are well known or famous, as well as certain configurations of goods, are protected under the Unfair Competition Prevention Act.

The act provides that, where unfair competition causes damage to a person's business, that person may seek an injunction and, if the damages were caused negligently or intentionally, compensatory damages.

The definition of 'unfair competition' includes:

- use of another's mark that is well known to consumers or dealers as identifying its goods or business, thus causing confusion (or the likelihood of confusion) with that party's goods or business;
- use as one's own of another's mark that is famous to consumers or dealers as identifying its goods or business; or
- imitation of the configuration of another's goods (except when such a configuration is indispensable for ensuring the function of the goods themselves).

REGISTERED MARKS

OWNERSHIP

An individual or corporation that intends to use a trademark for goods or services related to its business may apply for trademark registration and own a trademark. Actual use is not a requirement for trademark registration. A power of attorney is unnecessary when applying for trademark registration.

SCOPE OF PROTECTION

PROTECTED

The Trademark Act provides that a trademark should be recognisable by human perception and shall consist of characters, figures, signs, three-dimensional (3D) shapes, colours or any combination thereof, or sounds, and be used for goods or services relating to the applicant's business. In April 2015, motion marks, hologram marks, colour marks per se, sound marks and position marks also became registrable as trademarks. In April 2020, the Regulation for Enforcement of the Trademark Act and related guidelines on how to describe a 3D trademark in an application were revised to protect the exterior and interior of stores, offices and facilities. However, if the trademark in the trademark application for the exterior and interior is not distinctive (ie, distinctive features or signs are not included in the trademark), the application will be rejected.

A trademark right is granted when a JPO examiner determines that the mark meets all registration requirements. It is an exclusive right to use the mark with respect to designated goods or services, which becomes effective throughout Japan upon registration of the trademark with the JPO. The Trademark Act follows the first-to-file principle.

NOT PROTECTED

Under the Trademark Act, a trademark application will be rejected unless the following substantive requirements are satisfied:

- the mark is sufficiently distinctive for consumers to distinguish the applicant's goods or services from those of others;

- the mark qualifies as registrable under the Trademark Act; and
- the application does not violate any treaties.

Some trademarks that lack distinctiveness – excluding generic terms – may still be registered if the applicant can prove that they have acquired distinctiveness for specific uses. Further, a well-known trademark consisting of a geographical name and a generic term for a product or service that is owned by an industrial business cooperative association, a commerce and industry association, a chamber of commerce and industry, or a specified non-profit corporation (including an equivalent foreign legal entity) may be registered, provided that it fulfils the other requirements.

Even if a mark is sufficiently distinctive, it will be rejected if it falls under one of the various bars set out in section 4 of the Trademark Act concerning the public interest or an individual interest.

Examples of public interest prohibitions include:

- trademarks that consist of a national flag, coat of arms or other insignia of Japan or any foreign nation, or the Red Cross or similar marks;
- trademarks offending public order or morality;
- trademarks that are misleading as to the quality of the goods or services;
- 3D trademarks comprising solely functional features that are essential to the use or purpose of the goods or their packaging; and
- trademarks that comprise foreign well-known trademarks and are used in bad faith.

Examples of individual interest prohibitions include:

- trademarks comprising the name or portrait of another person;
- trademarks that are identical or similar to another's well-known mark and used for identical or similar goods or services;
- trademarks that conflict with a prior registration;
- trademarks that cause confusion with respect to the source of the goods or services;
- trademarks for wines or spirits that indicate regional origin in a manner prohibited by the TRIPS Agreement or the JPO; and
- trademarks that are identical or similar to another's well-known trademark in Japan or abroad as identifying the relevant goods or services if the applicant uses such marks in bad faith.

MEASURES AGAINST NON-USE OF TRADEMARK

Where there is justifiable doubt as to whether the applicant is conducting, or is planning to conduct, business in connection with the designated goods or services, the examiner will preliminarily reject the mark and notify the applicant accordingly. This refusal may then be overturned if the applicant certifies the use or intended use of the trademark under the application where it has designated:

- a wide range of goods or services;

- two or more dissimilar retail services; or
- general retail services.

PROCEDURES

EXAMINATION

An applicant may file a trademark application with the JPO in person, by mail or online. The Japanese government, including the JPO, is currently pursuing further digitalisation of documents and procedures, and has abolished the requirements of signature and seals for majority of documents. The JPO Trial and Appeal Board is also pursuing further digitalisation and web-based online oral hearings are now possible.

Once formal registration requirements are satisfied, the examiner will examine whether the application meets the substantive requirements for registration.

If the examiner finds reasons to reject the application, they will notify the applicant accordingly within 18 months. The applicant may submit written arguments or amendments in response. The applicant has opportunities to request an extension of the specific time limit for filing the response – a one-month extension may be filed before the expiration of the time limit and an additional two-month extension may be filed even after the time limit has expired. There is no need to show reasonable grounds to obtain these extensions.

If the applicant does not reply to the JPO's notice, or if its written arguments or amendments fail to overturn the reasons for rejection, the JPO will issue a refusal decision.

The applicant may appeal the JPO's decision, which will become final and conclusive if no appeal is sought.

If an appeal is requested, the application will be scrutinised by a panel of trial examiners. If the panel issues an unfavourable ruling, the applicant may appeal to the IP High Court. If it fails to do so, the rejection decision becomes final.

REGISTRATION

If the examiner determines that there are no reasons to reject the application, or if such reasons are defeated, they will issue a decision of grant. In practice, it takes an average of 10 to 14 months from filing an application to a registration decision, if the JPO finds no reason to reject the application. In some cases, it is possible to reduce the examination period by applying for accelerated examination. In addition to accelerated examination, if all of the designated goods or services in a trademark application are selected from the goods or services published in the Examination Guidelines for Similar Goods and Services, the Regulation for Enforcement of the Trademark Act or the Nice Classification, the application will be automatically eligible for fast-track examination. Filing requests or payment of fees are unnecessary for fast-track examination.

A trademark right is established upon registration of such a right with payment of the registration fee.

The trademark registration will then be published in the *Trademark Gazette*.

The term of protection lasts for 10 years from the date of registration. The trademark right may be renewed every 10 years by filing a request for renewal within the six months prior to the expiry date.

OPPOSITION

Anyone may file an opposition to registration within two months of the trademark being published in the *Trademark Gazette*. Once an opposition is filed with the JPO, the panel of trial examiners will consider whether it has merit.

The grounds for opposition are similar to the reasons for rejection in the examination stage (ie, lack of distinctiveness and registrability).

If the JPO intends to accept the opposition and revoke the registration, it must provide notice of the reasons for this and give the rights holder an opportunity to contest such notice.

If the rights holder succeeds in its arguments against opposition, the trademark registration will be maintained; otherwise, it will be revoked. The opponent may take no action against a decision to maintain the registration. Thus, to contest a registration once maintained, the opponent must demand an invalidation trial with the JPO.

In case of a decision to revoke registration, the rights holder may appeal to the IP High Court. If it does not appeal, the decision becomes final and conclusive.

REMOVAL FROM REGISTER

Aside from successful opposition, a registered trademark may be removed from the Trademark Register for the reasons outlined below.

CANCELLATION/SURRENDER

A rights holder may voluntarily cancel its trademark right. The cancellation may apply to all or only some of the designated goods or services.

INVALIDATION

An interested party may request a trial with the JPO to invalidate a trademark registration on the basis of similar grounds to those available in an opposition to trademark registration. Additionally, invalidation may be sought based on facts that occurred after registration.

An invalidation trial may be commenced even after a registered trademark right has expired or has been relinquished. However, an invalidation trial based on grounds such as lack of distinctiveness or individual interest prohibitions may not be brought more than five years after the date of registration.

Once a decision to invalidate a registration has become final, in principle, the trademark right is retroactively deemed never to have existed.

REVOCAION

Anyone may request a trial with the JPO to revoke a registered trademark based on the following grounds.

- Non-use: if a registered trademark has not been used in Japan by a rights holder or its licensee for at least three consecutive years.
- Improper use: if a rights holder or its licensee uses a registered trademark in an improper manner.
- Similar trademarks owned by different persons: if similar registered trademarks come to belong to different persons as a result of the transfer of a registered trademark

right, and one person uses such a mark with the intention of committing an act of unfair competition and in a manner that may cause confusion with the other's goods or services.

Where a trademark owner's rights are registered in a country that either is a signatory to the Paris Convention or the Trademark Law Treaty, or is a member of the TRIPS Agreement, the rights holder may seek revocation of a Japanese trademark registration if its agent or representative files the trademark application without the owner's authorisation within five years of the unauthorised registration.

SEARCHES

The JPO provides a public database, the Japan Platform for Patent Information, in which trademarks can be searched in a variety of ways.

ENFORCEMENT

TRADEMARK ACT

The unauthorised use of a mark that is identical or similar to a registered trademark in relation to identical or similar goods or services constitutes infringement. The Trademark Act provides that certain preparatory activities shall be deemed to constitute infringement. These include:

- the possession of the designated goods, or goods similar to the designated goods or services, affixed with the registered trademark or a trademark similar thereto on the goods or their packaging for the purpose of assignment, delivery or export; and
- the manufacture, assignment, delivery or importation, as a business, of products to be used exclusively for the manufacturing of products indicating the registered trademark or a trademark similar thereto.

Where infringement occurs, the owner of the registered trademark (or its registered exclusive licensee) may enforce its rights by filing a trademark infringement suit in district court. Alternative dispute resolution before certain private entities, such as the Japan Intellectual Property Arbitration Centre, may also be considered.

Remedies for trademark infringement available under the Trademark Act are outlined below.

CIVIL REMEDIES

The plaintiff may seek an injunction against an infringing party (or a party that is highly likely to infringe) that acts with or without negligence or wilfulness. Together with an injunction, the plaintiff may seek an order for destruction of the infringing goods and removal of the facilities used to commit the infringement, as well as other measures necessary to prevent the infringement.

The plaintiff may also seek a preliminary injunction. To obtain this, the plaintiff must show irreparable harm due to the infringement. Courts sometimes require that a bond be posted.

In the case of negligent or intentional infringement, compensatory damages are also available. Under the Trademark Act, an infringer's negligence is presumed. To ease the burden of assessing damages, the Trademark Act provides the following optional measures for calculating damages:

- the owner's expected profit per item multiplied by the number of infringing items sold, to the extent of the owner's production or sale capability (for the portion beyond the owner's production or sale capability, it is also possible to claim damages for an amount equivalent to the deserved royalties);
- the actual profit made by the infringer; or
- an amount equivalent to the deserved royalties (when determining the amount of the deserved royalties, the court can take into consideration the amount that would likely be decided between the plaintiff and the defendant on the premise that an infringement of a valid trademark right has occurred).

Where the rights holder proves the amount using one of these measures, this will be presumed to be the damages incurred. However, the rights holder may seek actual damages exceeding this by proving the amount of such damages.

A plaintiff may additionally claim other damages, such as consequential damages (eg, intangible damage to brand reputation) and attorneys' fees, although the courts tend to affirm claims for attorneys' fees only to a limited extent. There are no punitive damages under the applicable Japanese laws.

The rights holder may seek an order for rehabilitation of brand reputation, including corrective advertising.

CRIMINAL PENALTIES

Intentional trademark infringements are subject to criminal penalties of up to 10 years' imprisonment or a fine of ¥10 million in certain cases, or both.

ADVISORY OPINIONS

Rights holders or parties who have shown their need to demand an advisory opinion (*hantei*) may request for administrative advice from the JPO regarding whether the subject article falls under the scope of the trademark right in question. The JPO will render an official *hantei* in a strictly neutral manner upon request. Although *hantei* has no binding legal effects and therefore will not be taken into account by courts, it can be used as one of the factors to amicably settle disputes between parties.

UNFAIR COMPETITION PREVENTION ACT

CIVIL REMEDIES

The owner of a well-known or famous mark (whether registered or unregistered) whose business has suffered (or is likely to suffer) damage from unfair competition may file suit in a district court to seek an injunction against an infringing party (or a party that is highly likely to infringe), regardless of whether that party is acting negligently or wilfully. The plaintiff may also seek an order for the destruction of the infringing goods and removal of the facilities used to commit the infringement, as well as other measures necessary to prevent the infringement.

In case of negligent or intentional infringement, the rights holder may claim compensatory damages. As with the Trademark Act, the Unfair Competition Prevention Act also provides optional measures for calculating the rights holder's damages. However, unlike under the Trademark Act, negligence is not presumed.

Pursuant to the Civil Code, the plaintiff may also seek:

- restitution for unjust enrichment for infringement, with or without negligence or wilfulness; and
- an order for rehabilitation of brand reputation, including corrective advertising in the case of negligent or intentional infringement.

CRIMINAL PENALTIES

The misappropriation of a well-known mark with the intent to commit an act of unfair competition is punishable by imprisonment or a fine, or both.

APPEALS

A party that is not satisfied with the district court's decision may appeal to the competent appellate court, whose decision may subsequently be appealed to the Supreme Court on limited grounds.

BORDER ENFORCEMENT

The Japan customs authority, Japan Customs, provides border enforcement for patent rights, utility model rights, design rights, trademark rights, copyright and neighbouring rights, plant breeder's rights, unfair competition relating to famous indication of goods, configuration of goods, and access or copy control of restricted material. Customs recordal of registered trademarks and other IP rights are possible. In 2021, with the aim of strengthening the effectiveness of border enforcement and customs seizures of counterfeit goods infringing upon trademark rights, the Trademark Act was amended so that the definition of 'import' is further clarified. Now, acts of overseas business operators sending counterfeit goods to Japan by methods such as mail will be considered part of the import process and import in the course of trade. By viewing the acts of overseas business operators as the import of counterfeit goods in the course of trade (infringing use of marks), Japan Customs may now seize counterfeit goods regardless of whether the individual importer (end customer) intends the goods for private use.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

ASSIGNMENT

A rights holder or applicant may assign its rights relating to the trademark or trademark application. The assignment documents need not be notarised or legalised.

ASSIGNMENT OF STATUS AS APPLICANT

The assignor or assignee must file a notice of change of ownership with the JPO. The assignment will take effect once this notice is filed.

ASSIGNMENT OF REGISTERED TRADEMARK

An application to register the transfer of a trademark right must be filed either by both the assignor and the assignee, or by the assignee alone if it has obtained such consent from the assignor.

The change in ownership will take effect once it is entered in the Trademark Register.

GENERAL SUCCESSION

If an applied-for or registered trademark transfers by merger, inheritance or other general succession, this will have immediate effect. However, the successor must notify the JPO by filing a notice of change of ownership of the application (before registration) or an application to register the transfer of the trademark right (after registration).

LICENSING

Exclusive licences (*senyo shiyoken*) must be registered to be effective. While registration is not compulsory for non-exclusive or exclusive licences other than *senyo shiyoken*, registration will allow the licensee to maintain its rights to the trademark in the event of any third party’s subsequent acquisition or exclusive licence for such a trademark right.

RELATED RIGHTS

Where a trademark – especially a 3D trademark – is a new technological invention or device, it may also be protected as a patent under the Patent Act or as a utility model under the Utility Model Act. If the trademark is a new, functional and ornamentally featured design, it may also be protected as a design under the Design Act. However, these rights are protected only if they are registered with the JPO.

Where the trademark is an original and creative expression as a result of intellectual or cultural activities, it will also be protected under the Copyright Act without any registration.

The Companies Act prohibits the bad-faith use of a trade name or company name that causes confusion with a different company’s name.

ONLINE ISSUES

The Trademark Act provides that the ‘use’ of marks includes use on the internet in the following manner:

- providing trademarked goods or services via the internet (eg, online distribution of trademarked products);
- providing services through a website displaying a trademark (eg, mobile banking services displaying trademarks on the monitor or screen); and
- providing information consisting of advertisements, price lists or other business documents relating to trademarked goods or services on or through the internet.

Protection under the Unfair Competition Prevention Act extends to an act of unfair competition on the internet.

With respect to cybersquatting, the Unfair Competition Prevention Act protects owners of registered and unregistered marks by providing that no one may obtain, keep or use in bad faith a domain name that is identical or similar to a trademark owned by a third party.

No	Yes	Yes: three - dimensional shapes; colours; sounds; motions; holograms; and positions.
	Yes	Yes: two months.

Yes: only for well - known marks and configurations.		
Yes: three years' non - use before filing of application for revocation.	No	Yes
Yes: optional jurisdiction.	No	Yes: in some cases.
Yes: assignment and exclusive licences only.	Yes	Yes: the JP Domain Name Dispute Resolution Policy.

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Mexico: Trademark procedures and strategies

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Basham, Ringe y Correa SC

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LEGAL FRAMEWORK

Registration and enforcement of trademark rights in Mexico is regulated by a framework of local laws, regulations, treaties and precedents on specific legal loopholes or procedural matters. Prosecution of applications, protection and maintenance of trademark registrations, as well as dispute procedures, are administered in accordance with the Mexican Federal Law for the Protection of Industrial Property (the IP Law), which entered into effect on 5 November 2020.

Mexico is a party to several treaties, which either directly regulate trademark matters or have been replicated in domestic laws:

- the Paris Convention for the Protection of Industrial Property;
- the Mexico–United States–Canada Agreement, which came into effect on 1 July 2020;
- the Nice Agreement Concerning the International Classification of Goods and Services;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks.

UNREGISTERED MARKS

RIGHTS

Mexican law and practice usually favour registered rights in terms of protection. However, certain provisions in the IP Law have created a hybrid system where rights over unregistered marks may arise.

When a party has applied for a trademark owned or previously used by another party, the rightful owner or senior user of an unregistered trademark may file an opposition, claiming bad faith and providing sufficient evidence regarding fame, rightful ownership or prior use of the trademark in Mexico or abroad. If successful, the opposition procedure could result in a provisional refusal.

The rightful owner or former user of an unregistered trademark may file a cancellation action against a registered trademark that is confusingly similar or identical to their own, claiming and providing evidence of:

- prior use;
- application or registration in bad faith; or
- that the trademark was applied for and registered without the consent of the rightful owner from another jurisdiction.

UNREGISTERED RIGHTS THROUGH USE

In terms of use as a means of establishing unregistered rights, the IP Law indicates that the party claiming to have used the trademark in the past must demonstrate use prior to the application date or the declared date of first use. According to the IP Law's description of 'trademark use', the rightful owner or prior user of a trademark should demonstrate on the

basis of satisfactory evidence that the goods covered by the trademark are made available in the amount or way that corresponds to the practice and customs in the market.

A party that has used a trademark in good faith prior to the filing rights over a registration, and is able to demonstrate it, will not be subject to the prohibitions inherent to the protection of a registration by a third party. This is an exception to an infringement action, which will not be successful against said good-faith user.

REGISTERED MARKS

OWNERSHIP

Any individual or company – national or foreign – may use trademarks on goods or services. There is no prohibition or limitation as to who may apply for or own a mark.

POWER OF ATTORNEY

A representative is not required to file a power of attorney when filing an application and will be considered as the registered representative throughout the prosecution. However, in an opposition procedure or a reply to a provisional refusal, and if the person replying is not registered as a representative, a power of attorney is required.

There is no need for notarisation or legalisation of a power of attorney used for trademark prosecution. In any case, an original power of attorney may be entered into a registry managed by the Mexican Institute of Industrial Property (IMPI) and a copy of the resulting certificate could be used instead.

PROTECTION – PROHIBITIONS FOR REGISTRATION

According to the IP Law, trademarks no longer need to be visible and may be registered if perceptible by any sense while capable of being represented in such a manner that the subject matter of protection is well defined. Accordingly, non-traditional marks (eg, sounds and scents) are now registrable, provided that they function as source identifiers. Likewise, descriptive or common use terms as well as three-dimensional common forms, isolated letters, digits and colours, and non-distinctive trade dress, are suitable for registration if secondary meaning is demonstrated.

The IP Law prohibits the registration of trademarks that go against public order or customs. However, the law provides no definition in this regard and it is therefore up to each appointed examiner to keep this in mind.

The IP Law sets forth specific hypotheses as prohibitions for registration. Some of the most common are:

- names commonly used for goods or services;
- words descriptive of the kind, quality, quantity, composition, value or origin of the goods or services;
- official flags, shields or emblems of any country, state or municipality, without authorisation;
- geographical indications, designations of origin, signs or names of places known for their fabrication of certain goods or the lending of certain services;

- names or pseudonyms of people who have acquired such a well-known status that the use of their name could create a false belief of association;
- titles of copyrighted works and any of their elements or characters;
- trademarks identical or confusingly similar to notorious or famous trademarks; and
- trademarks identical or confusingly similar to prior applications or registrations.

PROCEDURES

EXAMINATION

The IP Law does not foresee multi-class applications. It is not necessary to file a priority document at any time during prosecution.

An application is usually scheduled for examination three to six months after filing. Formal examination is conducted to determine whether an application meets formal requirements, including proper specification of goods or services. IMPI then conducts substance examination based on likelihood of confusion and inherent registrability. If there are no grounds for refusal, registration will be granted. A hassle-free, unopposed and fully compliant trademark application will take from four to six months to be granted registration. Electronic filings are encouraged to reduce the time of prosecution.

Any obstacle for registration will be raised and notified through an official communication. The applicant has a two-month period to respond, which can be extended for two additional months. Failure to respond to an office action will result in abandonment.

IMPI official actions and related writs are available through its online database. Once an application is granted registration, it will be published in the *Official Gazette*, which is accessible online.

The examiner's decision to reject an application can be challenged before the hierarchical superior of the issuing branch of IMPI within 15 business days, or before the Specialised Chamber in IP Matters of the Federal Court of Administrative Justice (SEPI) within 30 business days, from the date of notice.

OPPOSITION

An application will be published for opposition purposes in the *Official Gazette* within 10 business days following its filing. Any interested party may file an opposition within one month.

The opponent may rely on any grounds provided by law for the rejection of an application. A trademark may be opposed and effectively refused if proven to be confusingly similar to a prior registration or application, or if it is descriptive.

Unlike other jurisdictions, use is irrelevant in an opposition. However, if IMPI issues an office action citing the registration serving as basis in the opposition, the applicant will be entitled to seek a non-use cancellation. A separate legal action will be initiated for such purpose.

If an opposition is filed, this procedure will be notified along with by the examination office action. The applicant has a two-month period to respond the opposition and any other objection made ex officio by IMPI, which can be extended for a further two months. Failure to respond to an office action will result in abandonment.

Evidence in opposition procedures will be submitted alongside each initial writ. The parties will be granted a five-day term to file written arguments.

It takes approximately three to 18 months for the issuance of a final resolution (grant or denial).

REGISTRATION

Applications that have completed formal and substantive examinations are either denied or granted registration. The granting of registration is published in the *Official Gazette*.

Evidence of use is not needed before or during prosecution. Nevertheless, a declaration of use will be filed during the three months following the third anniversary of the registration. Failure to file said declaration will automatically result in the lapse of the registration.

Under the new IP Law, a trademark is registered for a 10-year term from the date of grant and can be renewed for further 10-year terms. Failure to renew the registration within the six-month period following the renewal date will result in the lapse of the registration. Declarations of use are required on renewal.

Partial cancellations are allowed in Mexico for registrations granted under the IP Law.

REMOVAL FROM REGISTER

The IP Law provides the following grounds for a cancellation action:

- an incorrectly granted trademark (no statute of limitations applicable);
- a registered trademark that is identical or confusingly similar to a mark previously used in Mexico or abroad or a previously granted or applied-for registration in connection with the same or similar goods or services (five-year statute of limitations following publication of the registration) – however, this ground will be rejected when an opposition has already been attempted and the arguments and evidence are the same as those submitted in the opposition and IMPI has already judged them on the merits;
- a trademark registration that was obtained in bad faith (no statute of limitations applicable);
- a registration that includes false information – the burden of proof relies on the owner of the mark (five-year statute of limitations); and
- a registration obtained by a party linked to the rightful owner of a trademark registered in a foreign country, without the owner's consent (no statute of limitations applicable).

The IP Law establishes the possibility to request the partial cancellation of a trademark or slogan, with retroactive effects reverting to its issuance.

Further, there are several grounds for the cancellation or lapse of a trademark registration:

- voluntary cancellation – when requested by a representative, special powers are required;
- lack of renewal or declaration of use – if the renewal or declaration of use are not filed in a timely manner;
- non-use cancellation action – an interested third party can pursue a cancellation action if a trademark is not in use after the third anniversary of its registration (the

registrant must prove use of the mark during the three-year period immediately preceding the initial writ); and

- cancellation of a generic mark – when the registrant caused or allowed a mark to become a generic name for the products or services that it covers.

It is now permissible to request the partial cancellation of a trademark for lack of use in respect to the products that are not used. The effects of the cancellation will arise from the moment that a final decision is issued.

TIME FRAME

It takes approximately two to four months to record renewals, licences, assignments and changes of name. It takes two to three years to obtain a ruling on a cancellation action at IMPI; one year at the SEPI; and six months to one year for constitutional appeals before the Circuit Courts of Appeals.

SEARCHES

Phonetic or design searches may be conducted for similar and identical marks, trade names and slogans per class and in all classes. Although these searches may be conducted by users, IMPI may also run its own searches on request.

Searches by owner or attorney-of-records are also available. There are no official fees associated with these searches and they are freely accessible through IMPI's online database.

It is not possible to conduct a specific search for non-traditional mark, although a list is available.

ENFORCEMENT

COMPLEXITY

Complexity in enforcement depends on the circumstances of each case. Some circumstances that might affect the complexity of enforcing trademark rights in Mexico include the amount of infringing goods and their location (eg, at Customs).

Trademark owners may opt for an administrative proceeding (infringement action) or a criminal action for enforcement. Administrative proceedings are governed by the IP Law, its regulations and the Administrative Procedures Law, and are ruled over by IMPI. In criminal proceedings, the infringing acts must meet the hypotheses listed as crimes by the IP Law (ie, counterfeiting). The Specialised Prosecutor's Office will initiate a criminal investigation to determine whether a criminal action is viable.

Causes for an infringement action include:

- claiming as registered an unregistered trademark;
- the unauthorised use of a sign confusingly similar to a registered trademark, for identical or similar goods or services;
- the unauthorised use of a registered trademark or a confusingly similar one, as part of a corporate name, or vice versa;

- carrying out acts that may lead consumers to wrongfully believe that there is a link between a manufacturer, trader or supplier and the rightful owner of a trademark;
- tarnishing the goods, services, activities or establishment of another individual or company; and
- the unauthorised use of the trade dress of a product or service that may induce a consumer to wrongfully believe there to be a link to the rightful trademark owner.

The legal hypotheses for infringement also include unfair competition acts linked to IP rights and may be claimed alongside other hypotheses.

Interim relief is available to trademark owners, who may request that:

- any infringing products, packaging, publicity, advertising or any such material be withdrawn from circulation;
- the sale and use of infringing goods be prohibited;
- infringing goods be seized and secured; and
- the lending of services cease or an establishment be closed.

The party requesting interim relief must guarantee possible damages to the defendant. The trademark owner must file an infringement action within 20 days following the imposition of the interim relief, at the risk of losing the guarantee to the defendant.

The remedies that a plaintiff may achieve through an infringing action include:

- a declaration of infringement;
- the imposition of a fine of up to 1 million Mexican pesos on the defendant;
- a halt to infringing actions or destruction of seized infringing goods, or both;
- closing of an establishment; and
- the prevention of future infringing actions.

These remedies may be achieved, ordered and executed through IMPI.

A plaintiff in a successful infringement action may also seek damages before IMPI. It is also possible to claim damages directly (without a prior infringement action) through a civil action before a federal civil court.

The IP Law expressly states that said damages must be at least equal to 40% of the legitimate value of the infringing goods or services.

TIME FRAME FOR RESOLUTION

An infringement action can take from two to three years before IMPI issues a ruling. The losing party may fight said ruling through a motion of review before the hierarchical superior of the issuing branch of IMPI or an administrative dispute before the SEPI, which can take six to 18 months to reach a decision. This decision may be appealed through a constitutional action before an appointed circuit court of appeals, which can take up to one year for a decision.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

The recordal of assignments, changes of name and licences with the IMPI is not compulsory. They are valid and binding among the parties even without recordal. Nevertheless, according to the IP Law, these agreements will be enforceable against third parties only if they are duly recorded with IMPI. The IP Law does not request a recorded licensee for the purpose of demonstrating the use of the mark by the owner.

Also, there are judicial precedents stating that use from an unrecorded licensee may benefit the owner if the latter proves to have control over such use. Nevertheless, it is highly recommended to record licence agreements with IMPI to avoid the objection of evidence by the plaintiff.

Either the original document or a certified copy by notary must be submitted to IMPI alongside a Spanish translation. If the document is executed and certified abroad, it must be duly apostilled or legalised. In case of a change of name, the official document must be certified by the proper local authority and then apostilled or legalised.

RELATED RIGHTS

There are certain areas of overlap between trademark rights and other IP rights. While the IP Law and the Copyright Law do not specifically refer to cumulative protection of trademarks and copyrights, a logo, device or a combined trademark can be protected under copyright law provided that it has artistic value and meets the threshold of artistic creativity and originality.

Also, a novelty two- or three-dimensional trademark design that depicts shapes, lines or colours, or includes patterns, is suitable to be protected by an industrial design, either for aesthetic or manufacturing purposes.

ONLINE ISSUES

The IP Law establishes the possibility to protect trademark owners from unauthorised use of their marks in domain names, but it is unclear whether this can be extended to websites, hyperlinks, online ads or metatags.

Private, platform-specific or alternative dispute resolution procedures are available for trademark owners. Mexican law allows for any of these procedures to be effective among individuals and legal entities, if no legal provision is transgressed. Takedown procedures are usually considered and provided by online platforms working for and with Mexican internet users, usually requiring the trademark owner to demonstrate ownership of the related trademark rights.

Concerning domain names, while the '.mx' registry, NIC-Mexico, provides a private dispute resolution procedure to trademark owners and internet users, domain name disputes are usually and effectively submitted to the WIPO Arbitration and Mediation Centre and ruled on by panellists in accordance with the '.mx' Domain Name Dispute Resolution Policy and Rules.

Infringement actions before IMPI may also be used by proxy against infringing actions that make use of internet resources. Interim relief has been used to block domain name registrations and specific content on third-party platforms and websites, with varying results.

No	Yes	Yes: 3D designs; shapes; sounds; olfactive; non - visible; position; motion;

		holograms; trade dress; trade names.
No: but it is possible to file cancellation actions based on prior use.	Yes: through estimation of notoriety or fame, or declaration of notoriety or fame.	Yes: one month.
Yes: three years from date of grant.	Yes	Yes
No: in first instance. Yes: in second instance.	Yes	Yes: no time limit.
Yes: for assignment. No: for licensing.	No: in national legislation; however, it is possible to take action through the digital risk protection service.	Yes



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Poland: Trademark procedures and strategies

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LEGAL FRAMEWORK

Poland's legal regime of national trademark rights is regulated mainly by the Industrial Property Law (30 June 2000). The provisions regarding trademark rights are harmonised with the EU Trademark Directive. Following 16 March 2019, when the last legislative action towards harmonisation was taken, all amendments required by EU Directive 2015/2436 (16 December 2015) have already been introduced. As a member of the European Union, Poland also protects EU trademarks based on EU Regulation 2017/1001 (14 June 2017). Trademarks can also be protected based on the Fair Trading Act (16 April 1993) and the Copyright and Related Rights Act (4 February 1994).

Among the applicable international treaties, the most important are:

- the Paris Convention for the Protection of Industrial Property (20 March 1883);
- the Agreement on Trade-Related Aspects of Intellectual Property Rights; and
- the Madrid Agreement Concerning the International Registration of Marks (14 April 1891).

UNREGISTERED MARKS

Unregistered marks benefit from the same protection as registered ones if they are commonly known within Poland. In such cases, the owner of the commonly known mark may request that an identical or similar trademark not be used in respect of identical or similar goods where the use could mislead the public as to the origin of the goods.

To some extent, unregistered marks may be protected under the Fair Trading Act. Similarly, provided that the mark complies with the requirement to be protected as a copyrighted work, the Copyright and Related Rights Act could be applied.

Polish law does not provide for the definition of a "commonly known" standard. Based on doctrine and jurisprudence, the mark must be recognised as a trademark by a significant part of the relevant customer base in Poland, however, the scope varies depending on the specific product and sector. The burden of proof of such common knowledge lies with the trademark owner.

REGISTERED MARKS

A trademark can be applied for and owned by a natural or legal person, or by organisational entities that are not legal persons but in which a statute vests legal capacity.

The application can be filed by the applicant or its professional representative. A natural person may be additionally represented by a joint proprietor of a right, its parents, siblings or a party's descendants, and persons related to the party on the grounds of adoption. Persons whose place of residence or registered office is not located within the territory of the European Union, a European Free Trade Association member state, a party to the Agreement on the European Economic Area or Switzerland must act through a patent agent, attorney or legal counsel.

If a trademark application is filed by a representative, a written power of attorney, signed by the persons authorised to represent the applicant, is required. The power of attorney should accompany the files when the first legal action is taken and must be filed along

with a document confirming the authorisation of the undersigned persons to represent the applicant.

Based on Polish law, a trademark may include any sign that is capable of distinguishing the goods of one undertaking from those of another and can be demonstrated in the trademark register in a way that the scope of granted protection can be clearly and accurately determined. The catalogue of signs which could be protected is open. The Industrial Property Law directly mentions words (including surnames), figures, letters, digits, colours, spatial objects (including the shape of a product or packaging) and sounds. Although not explicitly excluded, the official guidance issued by the Patent Office indicates that scents remain outside of this catalogue due to the lack of technology that would allow for their clear and accurate demonstration in the register.

The applicable regulations provide for two types of ground for refusal:

- absolute (examined by the Patent Office *ex officio*); and
- relative (being the basis for the opposition).

In both cases, the grounds for refusal are, in principal, synonymous with the provisions of Directive 2015/2436.

PROCEDURES

EXAMINATION

After receiving the application, the Patent Office verifies whether it complies with formal requirements. If it does not and it can be remedied, the Patent Office might call on the applicant to do so, otherwise the proceedings will be discontinued.

Within two months of the application date, the following information about the mark is published:

- the priority date;
- the date and number of the application;
- the list for goods or services for which protection is sought;
- the name of the applicant and its seat; and
- the country code.

After the publication of such information, third parties can submit comments regarding the existence of absolute grounds for refusal. The Patent Office simultaneously examines whether the trademark is eligible for registration and conducts an examination regarding the absolute grounds for refusal. If the Patent Office finds no grounds for refusal, the announcement of the trademark application is published in the Patent Office Bulletin. If there are absolute grounds for refusal, the decision refusing to grant the right of protection in respect of some or all the goods or services covered by the application will be published on becoming final. In the case of a partial refusal, after the decision becomes final, the announcement of the application will be published only in respect of the non-disputable goods or services. In either case, the Patent Office will be able to refuse to grant the right of protection only once it collects and considers the applicant's statement regarding the occurred grounds.

OPPOSITION

Within three months of the publication date in the Patent Office Bulletin, third parties may lodge an opposition against the trademark application based on relative grounds for refusal. In a limited scope, the opposition may be also based on absolute grounds for refusal – if the application considers the trademark to be excluded from registration under the national legislation, the EU law or an international agreement providing for the protection of geographical indication, designation of origin, a traditional term for wine or traditional speciality guaranteed.

The opposition should invoke relative earlier rights that may be affected by registration of the applied-for mark. Once the opposition is lodged, the Patent Office will notify the parties of the possibility of settling the matter amicably within two months of receiving the notification (with the possibility of an extension of up to six months). In the absence of an amicable settlement, the Patent Office will proceed with the examination of opposition. The party that disagrees with the decision can submit a request to re-examine the case or appeal to the administrative court once the decision is final.

REGISTRATION

If no opposition is lodged or any lodged opposition is dismissed, the trademark will be registered. It usually takes between seven and eight months from application to registration if no opposition has been submitted. In the case of opposition proceedings, the timeframe should be extended to between 12 and 14 months.

If opposition was lodged and deemed well founded, the Patent Office will refuse to register the trademark.

REMOVAL FROM REGISTER

The Industrial Property Law provides for the invalidation and lapse of trademark protection rights.

The right of protection for a trademark may be invalidated on request, either in whole or in part, if the conditions necessary to obtain that right have not been satisfied due to the existence of absolute grounds or – in a limited scope – relative grounds (existence of the earlier right) for refusal. Theoretically, the invalidation request could be filed at any time. However, in some instances, a request for invalidation is excluded. This includes situations where:

- the claim is based on the existence of the earlier trademark or infringement of the applicant's economic or moral rights, but the trademark in question was successively used for a period of five years without the applicant's objection – this does not apply if the trademark in question was obtained in bad faith;
- the trademark in question was granted despite the existence of certain absolute grounds for refusal (in principle, synonymous with the provisions of Article 4 (1b–1d) of Directive 2015/2436), but it acquired a distinctive character in the ordinary course of trade by the time that the invalidity request was submitted;
- the claim is based on the existence of the commonly known trademark, but the trademark in question was successively used for a five-year period without the applicant's objection – this does not apply if the trademark in question was obtained in bad faith; and

- the claim is based on the same earlier rights and same legal grounds as the opposition that was already finally dismissed.

The Industrial Property Law provides for additional regulations regarding the invalidity requests based on the existence of the earlier trademarks. These are, in principle, synonymous with the provisions of Article 46 of Directive 2015/2436.

Regarding the trademark's expiry, the Industrial Property Law provides that a trademark protection right may primarily lapse due to the expiry of the term for which it was granted or if the owner declares the surrender of the right before the Patent Office with the consent of persons who enjoy rights from the trademark (eg, a licensee).

The remaining grounds for expiry are generally related to the trademark owner's actions (eg, non-use) or consider the improper use of collective and guarantee marks. These are, in principle, synonymous with the provisions of Articles 19 to 21 and 35 of Directive 2015/2436, respectively.

The decision confirming the lapse of the protection rights is issued by the Patent Office, except for where the protection right has lapsed due to the expiry of the term for which it was granted.

Invalidation and declaration of the lapse of the said right are initiated on written request and, in principle, settled under contentious proceedings by the Dispute Adjudicating Panels of the Patent Office (following 1 July 2020 – alternatively before the common court, in the case of a counterclaim based on the invalidity or expiry of the protection right). The contentious proceedings have an adversarial character and rely on the parties' initiative to prove their rights and statements with the Patent Office acting as an arbitrator. The contentious proceedings are concluded with a decision. The Patent Office is bound by the scope of the motion and the legal basis indicated by the applicant.

The Industrial Property Law does not provide for statutory terms regarding trademark registrations, therefore the time frame depends on the circumstances of the case. Assuming a limited amount of required correspondence, unopposed registrations usually take between seven and eight months. A lodged opposition extends this time frame to 12 to 14 months, as it involves an examination of the opposition in the contentious proceedings.

Procedures regarding an already registered trademark customarily involve shorter time frames. A change of name requires between two and four months. The renewal procedure does not require a separate motion, just a timely payment with a clear indication of the renewed protection right. The Patent Office notifies the owner of the deadline six months prior. In the case of licence registration, the applicant might expect a decision within two months.

The official Patent Office search, E-Wyszukiwarka (E-Search), is available online in Polish, English and French and is free of charge: <https://ewyszukiwarka.pue.uprp.gov.pl/search/simple-search>. The search engine is based on a series of adjustable attributes:

- type of IP right;
- collection;
- content of abstract;

- representation (eg, Vienna classification, colour and description);
- list of goods (eg, Nice classes);
- basic information (eg, relevant dates, category of rights, name or title, application and exclusive rights number, years of protection paid, start of opposition period, decision type, mark feature, current status and English title);
- priority (eg, date and country of priority);
- additional information (eg, application information, exhibition details, expected fee and date of payment for the next protection period);
- publications (eg, publication details and documents cited in search report);
- people involved in the case (eg, opponents, applicants and representatives);
- oppositions (eg, date of filing and publication and opposition status); and
- claims (eg, conversion and transmission).

E-Search offers two types of searches, varying in how these attributes are used:

- a simple search, which compares the key word against all available attributes; and
- an advanced search, which allows for selecting the attributes to be compared against the key word and specifying whether the searched item should feature the defined attribute.

Although E-Search is significant progress over the previous search engine (Register Plus), it still does not offer the option of searching by graphic.

ENFORCEMENT

Enforcement of registered and unregistered rights is pursued through civil proceedings. The timeline customarily includes:

- the initial one to two-year period in the first instance court;
- the subsequent period of up to one year if the appeal is filed; and
- the period of a further year if the cassation is filed with the Supreme Court.

The burden of proof that infringement has occurred lies on the party seeking protection. Thus, the trademark owner must provide all necessary evidence, including evidence of trademark use.

The enforcement can be initiated in case of the threat of infringement. In such a case, the party seeking protection can request an order prohibiting the defendant from proceeding with acts that would infringe the trademark.

'Infringement' is the unlawful use in trade of a protected mark. Trademark infringement occurs where an identical mark, compared to the trademark registered with earlier priority, is used in respect of identical goods. Except for the double identity, the trademark is protected against public confusion. Reputable trademarks are also protected in the case of use of identical or similar marks for any goods. Instead of confusion, the owner must prove that such use may result in an unfair advantage or be detrimental to the distinctive character or repute of the earlier mark. Infringement also occurs where the trademark is used in an advertisement that constitutes an act of unfair competition under the Fair Trading Act, or

as a trade name or business name, unless its use does not interfere with the possibility of distinguishing the relevant products.

As of 1 July 2020, the claims of a party whose trademark rights have been infringed are pursued in a dedicated procedure for IP cases before the specialised departments of the common courts. Five departments were created in the regional courts of Warsaw, Gdańsk, Katowice, Lublin and Poznań to act as first instance courts, and two departments were created in the Courts of Appeal of Warsaw and Poznań to act as the second instance courts.

The owner may request the infringing party to cease the infringement, deliver the unlawfully earned benefits and, in the case of a faulty infringement, remedy the damage inflicted. Damages are available in the case of faulty infringement, which may be remedied either in general terms (calculated on the basis of the rights holder's demonstrated loss), or through the payment of cash to an amount corresponding to the licence fee or other relevant remuneration that would be due for pursuing the claim for the owner's consent to use the trademark. Punitive damages are not allowed. However, monetary compensation may be requested along with the delivery of the unlawfully earned benefits. The claims can also be pursued against the party who offers the labelled products that were obtained neither from the trademark owner nor the person authorised to use the trademark, as well as against the parties whose services were used in the course of the infringement.

Also, the owner may request the publication of the court judgment in its entirety or in part (or information about the judgment in the form specified by the court). The Industrial Property Law also provides for additional claims that are, in principle, synonymous with the provisions of Articles 10(4), 11, 12 and 18 of Directive 2015/2436.

Trademark infringement is also subject to penal provisions. According to applicable regulations, anyone who labels goods with a counterfeit national or EU trademark or a registered national or EU trademark to which they are not entitled, with an intention of putting the goods on the market, or markets the goods labelled with said marks, is liable to restriction of liberty or imprisonment of up to two years. Additionally, where a perpetrator commissioned the offence through their permanent source of income or committed the said offence in respect of high-value goods, they are liable to a term of imprisonment of between six months and five years.

Interim relief is available in the form of securing the claims for each party or participant to the infringement proceedings if said party substantiates its claim and legal interest in the security for a claim. The security may be awarded either before or during proceedings.

Further, the new IP procedure provides for a package of three types of discovery claims, which are a mixture of new and existing solutions. These serve to discover the circumstances surrounding the IP rights infringement (extraction purpose) and securing certain materials for the purposes of producing the evidence in the related infringement litigation (conservative purpose). Although similar, these measures differ in scope and applicability to accommodate a variety of IP cases.

- Securing the means of evidence – this can be applied against the defendant or any third party that might enable securing the means of evidence. It aims to physically preserve certain materials that will allow for producing evidence in any future IP litigation. The claimant is not required to explicitly indicate facts that are meant to be proven, as this measure is designed to gather facts about the scope of the infringement. The court's decision on granting this measure can be changed or

repealed if the reason for granting it has changed or ceased to exist. The court may do so upon the motion filed by the party that was obliged to disclose the concerned materials, as well as by the defendant.

- Disclosure or issuing the means of evidence – the aim is to extract the means of evidence that is at the defendant's disposal, particularly banking, financial or commercial documents. Compared to the first measure, this requires a greater level of specification from the claimant in terms of indicating what is actually requested and demonstrating that it is indeed in the possession of the defendant.
- Request for information – the most specific of the three measures, as the scope of information that may be requested is limited to data on the origin and distribution networks of goods or services, if obtaining them is necessary to pursue an IP-related claim. This can be applied against the defendant or any third party that may possess or have access to this information.

The new IP procedure also provides for two types of IP-specific claim. The first applies in infringement cases regarding trademarks (but also industrial designs) and provides the possibility for a counterclaim based on the invalidity or expiry of the relevant exclusive right. Such cases were previously only reviewed by the Polish Patent Office and this will remain the case as an alternative to the above-mentioned counterclaim in infringement cases. To avoid re-examining the same case, the new IP procedure provides for the conflict rules between the IP courts and the Polish Patent Office (including the obligatory suspension of the civil proceedings).

The second type of IP-specific case is a declaratory claim that aims to confirm that certain actions that have already been taken or will be taken by the claimant do not constitute infringement of the industrial property rights. This serves as a protection against investments that may turn out to be unprofitable if they cannot be executed due to existing IP rights. The declaratory claim must be preceded by communication between the claimant and the exclusive rights holder, in which the potentially infringing actions are discussed.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

The agreements regarding ownership changes and rights transfers should be made in writing under pain of nullity. If a change in the trademark registry is made based on these documents, originals should be submitted. If a copy is submitted instead of the original, it must be certified for compliance with the original by the applicant's representative, provided that said representative is a patent agent, attorney or legal counsel, or otherwise by a notary.

Use of the trademark by a licensee is attributable to the owner in terms of the required use necessary for non-expiry of the trademark. Upon the owner's consent the holder of an exclusive licence entered in the register may bring proceedings for infringement and ask for remedies to the same extent as the owner, unless otherwise stipulated in the licence agreement. However, such consent is not required if the owner was called on to take actions relating to the infringement and failed to do so within a given term. To obtain compensation for the loss, the licensee might join the infringement proceedings initiated by the owner.

RELATED RIGHTS

Trademark rights might overlap with regulations regarding copyright, design and unfair competition.

If a trademark is the work within the meaning of the Copyright Act and related rights, it may be protected as such. There is also the possibility of protecting the trademark as a design. However, the possibility of a design's protection depends on its novelty; therefore, if a trademark has previously been registered or used, design protection will be not available.

ONLINE ISSUES

There are no specific provisions protecting mark owners against unauthorised use in domain names, websites, hyperlinks, online advertisements or metatags. These can be protected under the general terms of the applicable IP law.

In the case of maintenance infringement of an internet domain name in the '.pl' domain, the resolution could be submitted to a specialised unit – the Court of Arbitration in Matters Concerning Internet Domain Names at the Polish Chamber of Information Technology and Telecommunications. Submissions for resolution are based on the arbitration clause between parties. The court rules are available online in English at https://www.piit.org.pl/_data/assets/pdf_file/0024/4668/Rules_of_the_Arbitration_Court_v2010.pdf.

Examination/registration		
Representative requires a power of attorney when filing? Legalised/notarised?	Examination for relative grounds for refusal based on earlier rights?	Registrable unconventional marks
Yes: certified for compliance by the professional representative; otherwise, notarised.	Yes	Yes: colours (but not per se); sounds; shapes.
Unregistered rights		Opposition
Protection for unregistered rights?	Specific/increased protection for well - known marks?	Opposition procedure available? Term from publication?
Yes	No	Yes: three months from publication.
Removal from register		
Can a registration be removed for non - use? Term and start date?	Are proceedings available to remove a mark that has become generic?	Are proceedings available to remove a mark that was incorrectly registered?
Yes: the continuous five - year period starting from the granting decision.	Yes	Yes
Enforcement		
Specialist IP/trademark court?	Punitive damages available?	Interim injunctions available? Time limit?
Yes: specialised departments of the common courts in Warsaw,	No	Yes: before or during proceedings.

Gdańsk, Lublin, Katowice and Poznań.		
Ownership changes	Online issues	
Is registration mandatory for assignment/licensing documents?	National anti - cybersquatting provisions?	National alternative dispute resolution policy (DRP) for local ccTLD available?
No: not mandatory for licensing but required in case of assignment to become effective with respect to third parties.	No	Yes

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Serbia: Trademark procedures and strategies

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Popović Popović & Partners

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LEGAL FRAMEWORK

NATIONAL

The following national laws govern trademarks in Serbia:

- the Law on Trademarks (*Official Gazette* RS, 6/2020);
- the Customs Law (*Official Gazette* RS, 95/2018, Part II – “Measures for the protection of intellectual property rights at the border”);
- the Law on Special Authorities for the Efficient Protection of IP rights (*Official Gazette* RS, 46/06 and 104/09); and
- the Law on Trade (*Official Gazette* RS, 52/2019).

INTERNATIONAL

Serbia is a signatory to the following international agreements relating to trademarks:

- the Paris Convention for the Protection of Industrial Property (1883);
- the Madrid Agreement on the International Registration of Trademarks (1891);
- the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks;
- the International Classification of Goods and Services (the Nice Agreement, 1957);
- the International Classification of the Figurative Elements of Marks (the Vienna Agreement, 1973);
- the Nairobi Treaty on the Protection of the Olympic Symbol (1981);
- the Trademark Law Treaty (1994);
- the Singapore Treaty on the Law of Trademarks (2006); and
- the Marrakesh Treaty to Facilitate Access to Published Works for Persons Who Are Blind, Visually Impaired or Otherwise Print Disabled.

UNREGISTERED MARKS

A trademark right is acquired by registration. Unregistered marks are not regulated by the Law on Trademarks, except for well-known and famous trademarks.

REGISTERED MARKS

All natural or legal persons involved in trade can apply for and own a mark. It is not necessary to prove such activity. Associations, funds and non-governmental and charity organisations may own trademarks.

Foreigners are represented by a local attorney or registered IP agent. Power of attorney can be filed belatedly and need not be notarised or legalised.

Any sign that is capable of distinguishing the relevant goods or services in the course of trade may be protected as a trademark, provided that it is capable of being presented in the Trademark Register in such a manner as to enable the competent authorities and public to clearly and precisely establish the subject of protection. A sign may comprise any sign,

especially words (including personal names) slogans, letters, numbers, drawings, colours, three-dimensional shapes, the shape of goods or its packaging, as well as a combination of such signs or sounds.

A sign cannot be protected as a trademark on absolute grounds if it:

- is contrary to public policy or morality;
- is descriptive;
- is not distinctive;
- consists exclusively of the shape or other characteristic that results from the nature of the goods or the shape or other characteristic of the goods that is necessary to obtain a technical result, or from the shape or other characteristic that gives substantial value to the goods;
- is generic;
- is deceptive to the public as to the nature, quality or geographical origin of the goods or services;
- contains official signs or hallmarks of quality control or warranty, or imitations thereof unless approved by the competent authority;
- does not fulfil conditions for registration in the meaning of Article 6*ter* of the Paris Convention unless approved by the competent authority;
- comprises a state coat of arms, flag or other emblem, or other official sign of Serbia, unless approved by the competent authority;
- represents or imitates a national or religious symbol;
- consists of or contains an indication of geographical origin valid in Serbia and that relates to the same or similar goods or services; and
- contains an earlier protected plant variety denomination or reproduces it in its significant elements and that relates to the plant variety of the same or similar plant species.

Generic, descriptive and non-distinctive signs may be protected as a trademark if the applicant proves that the serious use of such a sign has rendered that sign capable of being distinguished in the trade for the goods or services concerned.

A sign cannot be protected as a trademark on relative grounds if it:

- is identical to an earlier trademark registered for identical goods or services;
- is identical or similar to an earlier trademark of another person registered for identical or similar goods or services, if this may cause confusion among the public or a likelihood of association with the earlier trademark;
- is identical or similar to the same or similar goods or services of a third party's sign that is well known in Serbia within the meaning of Article 6*bis* of the Paris Convention;
- is, regardless of the goods or services concerned, identical or similar to an earlier trademark, if the use of such a mark would result in an unfair benefit from the reputation acquired by the famous trademark or in harm to its distinctive character or reputation; and

- infringes copyright or other IP rights by its appearance or content.

The likeness or name of a person can be protected as a trademark only with that person's consent. The likeness or name of a deceased person can be protected as a trademark only with the consent of their parents, spouse or children. The likeness or name of a historical person or other deceased famous person can be protected as a trademark only with the authorisation of the competent authority and the consent of such person's relatives up to the third degree of kinship.

To establish well-known and famous trademarks, it is necessary to prove genuine use of the mark that has rendered it capable of distinguishing the relevant goods or services in the course of trade. It is possible to enforce unregistered marks based on the unfair competition rules of the Law on Trade.

PROCEDURES

EXAMINATION

Legal protection of trademarks is acquired through administrative proceedings at the Serbian IP Office. The procedure is commenced by filing a trademark application, which is subject to both formal and substantive examination. The application is first formally examined. In substantive examination, the IP Office examines the application on absolute and relative grounds. During the examination procedure, any party may file a written opinion citing reasons for which the trademark application does not meet the grounds for registration. Such a party is not considered to be a party to the administrative proceedings.

If an application is not eligible for trademark registration, the applicant is invited to respond within a specified timeframe. If it fails to meet the examiner's request or if the examiner still deems the trademark to be unregistrable, the application will be refused either fully or for certain goods or services.

OPPOSITION

Upon examination proceedings, the IP Office publishes the application in the *Official Gazette*. An opposition may be filed within three months of the publication date. For international trademark applications based on the Madrid Protocol, the three-month term starts on the first day of the month that follows the month cited in the *WIPO Gazette* in which the international registration was published.

The opposition may be based only on relative grounds. It may also be raised by a company whose firm name or substantial part of its firm name (that has been inscribed in the respective register prior to the date of filing the trademark application) is identical or similar to the trademark application, unless the applicant of the trademark had the same or similar firm name at the time of filing the trademark application. An additional condition is that the goods or services that the company deals with in its course of business are identical or similar to those covered by the trademark application.

Finally, the opposition may be filed by the trademark owner against the application filed by the owner's representative without the owner's approval, unless for justified reasons.

On examining the opposition, the IP Office notifies the applicant about the opposition and the 60-day term within which to respond. If no response is filed, the application will be refused in the scope of the reasons cited in the opposition. If the response is submitted, the IP Office will

examine the file and decide on the opposition. A hearing with the IP Office may be scheduled. The parties may amicably resolve the issues and notify the IP Office of the settlement.

REGISTRATION

If the application meets the requirements for trademark registration, the applicant is invited to pay the prescribed fees. On payment, the IP Office will issue a trademark registration certificate and enter the trademark in the Trademark Register. The trademark is then published in the *Official Gazette*.

RENEWAL

Trademarks are granted for 10 years from the filing date and may be renewed an indefinite number of times. It may be renewed no earlier than six months before its expiry by filing a request on a prescribed form and paying the prescribed fee. Belated renewal is allowed within a six-month grace period with a prescribed penalty fee.

REMOVAL FROM REGISTER

REVOCATION

A trademark can be removed from the register if:

- it has not been in genuine use on the Serbian market for five years, without justified reason;
- it has become a generic term for the goods or services for which it was registered, due to acts or omissions of the rights holder or its successor;
- it has become misleading as to the geographical origin, type, quality or other characteristics of the goods or services as a result of the manner of its use by the rights holder or its successor;
- it has become contrary to public policy or morality; and
- a collective or certification mark has been used contrary to a general act.

These procedures are commenced by filing a written request, accompanied by prescribed particulars, annexes and their contents. A regular request is sent to the rights holder, which is entitled to respond within a certain timeframe. A hearing with the IP Office may be scheduled. After completion of the procedure, the IP Office will issue a decision either revoking the trademark (either fully or for certain goods or services) or refusing the revocation request. In case of revocation due to non-use, the revocation term of five years starts as on the day on which the trademark was entered in the Trademark Register or from the day of its last use, while the trademark ceases to be valid from the date of filing the request for termination. In other cases, the trademark ceases to be valid as of the day following the date on which the termination decision became legally valid and binding.

TERMINATION

A trademark will be terminated on expiry of the 10-year period for which the initial fee has been paid. A trademark may also be terminated:

- if the rights holder relinquishes its trademark rights, on the date following receipt of a statement of relinquishment;
-

if a certain right has been entered into the Trademark Register on behalf of a third party, the holder of the trademark may not relinquish its trademark rights without the written consent of the person on whose behalf the right has been entered;

- as a result of a court decision, on the date specified in the judgment; or
- if the rights holder ceases to exist (legal person) or dies (natural person), on the date of cessation or death, except where the trademark has been transferred to successors.

INVALIDATION

A trademark may be declared invalid if the requirements prescribed by the Trademark Law are not met. It may be declared invalid, either fully or for certain goods or services, at any time during the term of protection on the request of an interested party or the state prosecutor. For reasons based on relative grounds, invalidation may be requested only by the holder of the earlier right, unless the holder of the earlier right knew about the use of the latter mark for five consecutive years and did not object to it, and under the condition that the earlier mark was used within the five years preceding the date of filing the invalidation request.

The procedure for invalidation of a trademark is commenced by filing a written request with appropriate evidence and prescribed data. The rights holder may respond within a certain timeframe. A hearing may be scheduled. After completion of the procedure, the IP Office will issue a decision either invalidating the trademark (either fully or for certain goods or services) or refusing the request. An invalidated trademark is considered to have had no legal effect.

TIME FRAMES

The trademark application procedure takes six to 18 months, depending on whether objections have been raised. The procedure for recordal of changes in the Trademark Register takes approximately one month, as does the renewal procedure.

TRADEMARK SEARCHES

The following official trademark searches are available:

- identical trademarks;
- similar trademarks;
- per class;
- all classes;
- trade names and slogans; and
- traditional graphic marks.

Results from searches usually come through within two weeks. Official search fees are €18 to €30 for searches in up to three classes, plus an additional €2 fee for each additional class.

ENFORCEMENT

Trademark rights may be enforced through:

- trademark infringement action;
- unfair competition action;
- customs action (not available for unregistered rights);

- Market Trade Inspectorate action (not available for unregistered rights);
- criminal proceedings; or
- corporate offence.

Proceedings before the first-instance courts can take from several months to two years, depending on the complexity of the case. Proceedings resulting from customs or market inspection seizures have immediate effect but need to be justified through a ruling in favour of the rights holder in certain cases where the importer or distributor objects to the seizure.

TRADEMARK INFRINGEMENT

Trademark infringement proceedings are conducted before the Commercial Court or a higher court of general competence (when natural persons are involved) in Belgrade. There are no specialised IP courts; however, at first instance, IP infringement matters are dealt with by the district courts. The proceedings are conducted under the rules of general civil procedure. The proceedings are considered urgent and the trial starts a few weeks after the action is filed.

An infringement action may be commenced within three years of the rights holder becoming aware of the infringement and the identity of the infringer, but no later than five years from the date of first infringement or from the last act in the case of a continuous infringement.

The following can be sought:

- determination and cessation of the infringement;
- seizure, exclusion from commercial channels, destruction or alteration of the infringing goods or tools and equipment used in the infringement or to manufacture the infringing goods;
- compensation for damages, material and immaterial – the material damage cannot be lower than the fee for legal use of the right, while in cases of gross negligence, the compensation may be in the amount of the income that the infringer acquired from the infringement;
- legal costs and expenses;
- publication of the court decision; and
- disclosure of information about third parties involved in the infringement, origin and distribution channels of the infringing goods or services.

First-instance decisions can be appealed. An extraordinary legal remedy revision to the Supreme Court of Cassation is allowed against second-instance decisions in infringement matters.

Upon justified request, the court may order the securing of evidence, the seizure or removal from circulation of infringing products or an injunction forbidding the continuation of infringing activities. Where the marks are identical, the court is obliged to issue an injunction.

CONTESTING TRADEMARK REGISTRATION

If a trademark application was filed against the principle of good faith, or if a trademark registration was based on such application or in violation of legal or contractual obligations, anyone whose legal interest has been violated as a result may request the court to declare

such person as an applicant or the rights holder. In case of contesting a trademark consisting of a sign that is well known in Serbia within the meaning of Article *6bis* of the Paris Convention, such an action cannot be filed more than five years after the trademark was entered in the Trademark Register.

RELATED ADMINISTRATIVE PROCEEDINGS

Administrative proceedings can be related to court infringement proceedings where invalidation or revocation of the mark is considered an interlocutory question in litigation.

UNFAIR COMPETITION ACTION

Unfair competition actions are regulated by the Law on Trade, which prescribes activities deemed to constitute acts of unfair competition, including selling goods marked with labels, data or shapes which create justifiable confusion among consumers regarding origin, quality and other characteristics of the goods. In litigation, the determination of an act of unfair competition, forbiddance of further sale, removal of the goods from trade, compensation of damages and publication of the court decision may be claimed, with a possibility to request a preliminary injunction. The charge may be filed within the six-month term from the date of knowledge about the act of unfair competition, but not later than three years from the commitment of the act.

CUSTOMS SEIZURE

Customs seizures may be initiated through the prescribed procedure *ex officio* or at the rights holder's request. Customs supervision of trademarks is regulated by the Customs Law and regulations on border measures for the protection of IP rights. Such customs protection lasts for one year and may be renewed.

The rights holder may request the direct destruction of seized counterfeit goods within 10 working days, provided that the importer does not object to the seizure. After 20 working days, the infringement and destruction of the counterfeit goods has to be dealt with in court proceedings. Failing this, the customs authorities must release the goods for import.

MARKET INSPECTION SEIZURE

As with the customs action for seizure of imported counterfeit goods, it is possible to temporarily seize counterfeit goods found in trade. Within 15 days, the rights holder may:

- request destruction of the seized goods if the infringer does not object to the seizure;
or
- initiate court proceedings to protect its rights.

CRIMINAL PROCEEDINGS

Violation of rights in company names or other distinctive marks is a criminal act against commerce and will be pursued by the public prosecutor.

CORPORATE OFFENCE

The Law on Trademarks sets out fines for corporate trademark infringement offences committed by companies or other legal persons, as well as responsible natural persons within such companies or legal persons. The relevant proceedings are commenced by filing a criminal offence report, although the proceedings are pursued by the public prosecutor.

During the procedure, the rights holder may request compensation for damages, but the criminal court usually decides that damages should be claimed and determined in separate litigation.

COPYRIGHT INFRINGEMENT ACTION

Copyright infringement is dealt with in proceedings before the courts of general competence. Under certain conditions, copyright infringement can be considered a criminal act. Copyright can serve as a legal basis for customs seizures and market inspection seizures.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

ASSIGNMENT

An assignment agreement should be recorded in the Trademark Register to have effect against third parties. The request must be supported by proof of legal title, with any translation certified by a sworn court translator. The original assignment agreement or a certified copy must also be submitted. For certified copies, apostille or legalisation is required, unless there is an agreement between the respective country and Serbia upon which legalisation is not required (eg, the Western Balkan region, Austria, Bulgaria, Cyprus, France, Greece, Hungary, Italy and Romania, among others).

Short-form agreements are acceptable. Trademarks may be assigned with or without goodwill or compensation; the agreement must explicitly state the compensation amount, if any. It may also cover all or only some of the relevant goods or services. However, if the assigned goods or services are essentially similar to those for which the trademark remains registered in the name of the assignor, or if the assignment may create confusion in trade, the assignment may not be approved unless the assignee waives protection for the goods or services for which there is a likelihood of confusion.

LICENCE

A licence may be exclusive or non-exclusive and cover all or only some of the relevant goods or services. It may also be limited to a certain territory or time frame.

The application for recordal is filed on a prescribed form together with enclosed proof of legal title, with any translation certified by a sworn court translator (it may be partial). Short-form agreements are acceptable. The original licence agreement or a certified copy must be submitted. For certified copies, apostille or legalisation is required unless there is an agreement between the relevant country and Serbia, upon which legalisation is not required.

Use of the mark by the licensee is considered as use that defends against revocation for non-use. In general, trademark licensees may sue for trademark infringement, unless the licence provides otherwise.

Collective and certification trademarks cannot be licensed.

PLEDGE

Trademarks and rights relating to a trademark application may be the subject of a pledge on the basis of a pledge agreement, court decision, decision of the enforcement official or decision of another competent government body in respect of some or all of the relevant goods or services. The pledge may be recorded in the appropriate register of the competent authority on the request of the trademark owner, applicant or pledger.

RELATED RIGHTS

Company names are regulated by the Companies Act. As of 2020, the Law on Trademarks provides that opposition, under certain conditions, may be filed by a company whose firm name or substantial part of the firm name is identical or similar to the trademark application. Protection against third-party use of a company name may be grounded on the unfair competition rules contained in the Law on Trade. Violation of rights in a company name constitutes a criminal act under certain conditions.

Copyright and trademarks are often related. Certain signs may be subject to simultaneous copyright and trademark protection, in which case these rights have mutual effect. Under certain conditions, copyright can be used as supporting legal grounds in trademark infringement proceedings. A sign cannot be protected as a trademark if, by its appearance or content, it infringes copyright or industrial property rights. For example, if a word sign consists of the title of a book, that sign will not acquire trademark protection.

ONLINE ISSUES

The Law on Trademarks does not regulate online use of registered and unregistered trademarks. The national domains for Serbia are '.rs' and '.cpb'. They are registered with the authorised registrar of national domains.

Disputes relating to domain names are resolved before the Serbian Chamber of Commerce and its dispute resolution committee. By initiating proceedings before the committee, the plaintiff accepts the committee's authority. However, by accepting the committee's authority, the parties do not waive their right to resolve the dispute before the courts. The committee's decision can be contested before the courts in Belgrade (the Commercial Court for legal entities; otherwise, the Higher Court).

Yes: power of attorney. No: legalised/notarised.	Yes	Yes: 3D marks; sound.
No: except for famous or well - known trademarks.	Yes	Yes: three months.
Yes; five years from registration or from last use. The termination is declared as of the date of requesting revocation.	Yes	Yes
No	No	Yes
No: but it is advisable in order to bind third parties.	No	Yes



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Spain: Trademark procedures and strategies

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NATIONAL

Distinctive signs are principally governed by the Trademark Act (17/2001), which was partially modified by Royal Decree-Law 23/2018 to incorporate Directive (EU) 2015/2436. This is complemented by Royal Decree 687/2002, which was modified by Royal Decree 306/2019 to adapt to the Trademark Act as amended.

Royal Decree-Law 23/2018 mainly entered into force on 14 January 2019. The outstanding part will take effect on 14 January 2023.

Civil actions for trademark infringement are comprehensively covered in the Trademark Act, while criminal actions for infringement are defined in Book II, Title XIII, Chapter 11, Section 2 of the Criminal Code.

INTERNATIONAL

At an international level, the Trademark Act has adapted Spanish law to the general legal framework established within the international community. In particular, the following international treaties have been integrated into Spanish law:

- the Paris Convention for the Protection of Industrial Property;
- the Madrid System for the International Registration of Marks (the Madrid Agreement (1891) and the Madrid Protocol (1989));
- the Nice Agreement on the International Classification of Goods and Services for the Registration of Marks;
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks;
- the Trademark Law Treaty; and
- the Agreement on Trade-Related Aspects of Intellectual Property Rights.

UNREGISTERED MARKS

PROTECTION

The Trademark Act follows the principle that trademark rights come into existence upon valid registration under the Trademark Act. However, the owner of an unregistered well-known mark has the right to:

- file an opposition to an application for registration of a sign that is identical or confusingly similar to its own for identical or similar goods;
- file a civil action to invalidate an identical or similar trademark registered for identical or similar goods; and
- file a civil action against the unauthorised use of the unregistered mark for identical or similar goods.

USE REQUIREMENTS

The Trademark Act makes no reference to use of the unregistered mark in Spain as a prerequisite for claiming protection. Hence, in principle, the Trademark Act requires only that the unregistered mark be well known to be protected.

REGISTERED MARKS

OWNERSHIP

Any natural or legal person, including public law entities, can obtain a Spanish trademark or trade name.

A representative of the rights holder requires a power of attorney before filing. However, this need not be notarised or legalised.

The Trademark Act also sets out that if a person applies to register a trademark in breach of either third-party rights or a legal or contractual obligation, the aggrieved party may claim the ownership of the trademark before the Commercial Court, provided that the claim is brought before the registration date or within a period of five years from publication of the notice of registration or the time at which the trademark is first used in Spain.

SCOPE OF PROTECTION

Article 4 of the Trademark Act establishes the requirements for trademark registration. It provides that a trademark may be any sign that is capable both of distinguishing in the market the goods or services of one undertaking from those of others, and of being represented in a way that allows the authorities and the public to determine the clear and precise object. It also provides a list of signs that may constitute trademarks, which are:

- words, including personal names;
- figures, drawings, letters and colours;
- the shape of goods or their packaging; and
- sounds.

ABSOLUTE GROUNDS FOR REFUSAL

The following signs may not be registered as a trademark:

- signs that are not registrable because they do not fulfil the requirements set out in Article 4 of the Trademark Act;
- signs that lack distinctive character;
- signs that comprise exclusively signs or indications that serve in trade to designate the characteristics of the relevant goods or services;
- signs that consist exclusively of signs or indications that have become customary to designate the relevant goods or services in the current language, or in the bona fide and established practices of the trade;
- signs that consist exclusively of a shape or another feature that results from the nature of the goods themselves, is needed to obtain a technical result or gives substantial value to the goods;
- signs that are contrary to law, public policy or accepted principles of morality;
-

- signs that may deceive the public – for instance, as to the nature, quality or geographical origin of the relevant goods or services;
- signs excluded from registration under Spanish law, EU law or international agreements in which the European Union or Spain is a party, conferring protection to designations of origin and geographical indications;
 - signs excluded from registration under EU law or international agreements in which the European Union is a party, conferring protection to traditional terms for wine and to traditional specialities guaranteed;
 - signs that consist of, or reproduce in their essential elements, the denomination of a previous plant variety, registered in accordance with the legislation of the European Union or national law, or the international agreements in which the European Union or Spain is a party, that establish the protection of plant varieties and that refer to plant varieties of the same or closely related species;
 - signs that include or imitate the coats of arms, flags, decorations or other emblems of Spain, its autonomous communities, its towns, provinces or other local entities, unless the appropriate consent has been given;
 - signs that have not been authorised for use by the competent authorities and that are to be refused pursuant to Article 6^{ter} of the Paris Convention; and
 - signs that include badges, emblems or coats of arms other than those covered by Article 6^{ter} of the Paris Convention, which are of public interest, unless the appropriate authorities have granted consent to the registration.

RELATIVE GROUNDS FOR REFUSAL OR INVALIDATION IN CASE OF CONFLICT WITH IDENTICAL OR SIMILAR EARLIER RIGHTS

The following signs may not be registered as a trademark:

- signs that are identical to an earlier trademark, where registration is sought for identical goods or services; and
- signs that are identical or similar to an earlier trademark, where registration is sought for identical or similar goods or services and there is a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trademark.

EARLIER TRADEMARKS

An 'earlier trademark' is defined to include:

- Spanish registered trademarks, trademarks registered internationally and effective in Spain and EU trademarks, with a filing or priority date that precedes the trademark application;
- registered EU trademarks, which under the EU Trademark Regulation constitute a valid claim to seniority over Spanish registered trademarks or trademarks registered internationally and effective in Spain, even if they have been surrendered or have lapsed;
- trademark applications that fall under the above categories, subject to their final registration; and
-

unregistered trademarks that are well known in Spain on the filing or priority date, pursuant to Article *6bis* of the Paris Convention.

The Trademark Act also prohibits the registration of the following:

- signs that are identical to an earlier trade name designating activities that are identical to the goods or services for which registration is sought; and
- signs that are identical or similar to an earlier trade name, where registration is sought for goods or services identical or similar to the designated activities and there is a likelihood of confusion on the part of the public, including the likelihood of association with the earlier trade name.

The Trademark Act sets out relative grounds for refusal or invalidation in case of a conflict with identical or similar earlier registered trademarks and trade names that are well known in Spain or in the European Union. The protection afforded to such marks is extended beyond the principle of speciality: a trademark application will be refused even if the goods or services for which registration is sought are dissimilar to those for which an identical or similar well-known mark is registered. This reinforced protection applies if the use of the later mark might suggest a connection between the goods or services covered and the owner of the well-known mark, or in general where such use, without due cause, would take unfair advantage of, or be detrimental to, the distinctive or well-known character or reputation of the earlier mark.

Further grounds for refusal or invalidation are provided in case of other related early rights such as the name, surname, pseudonym or image of a person, copyright, unauthorised registration by an agent or representative, and company names, geographical indications and designations of origin in certain circumstances.

PROCEDURES

The trademark registration system is established in Articles 11 to 30 of the Trademark Act, and in the complementary regulation.

EXAMINATION

An application to register a trademark must be filed before the Spanish Patent and Trademark Office (SPTO) or another competent body.

Once an application is filed, the SPTO will examine it for compliance with the formal requirements. If the application is admissible, the SPTO will publish the application in the *Industrial Property Official Gazette* and will conduct an electronic search of earlier rights that may be incompatible with the application, based on relative grounds for refusal.

The SPTO will notify the owners of any potentially incompatible earlier rights that have been detected so that they may file an opposition if they consider it appropriate; however, the SPTO will not refuse an application *ex officio* due to the existence of an incompatible earlier right. Following publication, the SPTO will conduct an *ex officio* substantial examination of the application to determine whether:

- there are absolute grounds for refusal; or
- the application includes or comprises a name, surname, pseudonym or any other sign that identifies a person other than the applicant to the general public.

If no oppositions are filed and the ex officio examination raises no objections, the trademark will be registered and published in the *Industrial Property Official Gazette*.

If objections are raised in the substantial examination, the proceedings will be halted and the applicant will be notified accordingly. The applicant has one month from such notification to submit arguments in support of its application, or to withdraw, limit, amend or split the application. Regardless of whether the applicant responds, the SPTO will decide whether to grant or refuse registration, specifying the grounds for its decision.

If grounds for refusal exist only for some of the goods or services for which registration is sought, the refusal of registration will be limited to the goods or services at issue.

The grant or refusal of registration will then be published in the *Industrial Property Official Gazette*.

The applicant can contest the SPTO's decision through an administrative appeal procedure within one month of its publication. In such case, the SPTO will review its decision to determine whether the administrative acts granting or refusing registration were performed in accordance with the law.

OPPOSITION

Publication of the trademark application triggers a two-month period during which any party that believes its rights may be damaged can file an opposition to the registration based on absolute grounds for refusal and the holders of previous rights can file an opposition based on relative grounds for refusal.

The SPTO will notify the applicant of the opposition and give a one-month term to respond. The applicant can request proof of use from the owner of the earlier trademark in the course of the five years prior to the date of application or priority of the subsequent trademark. If, in a one-month term, the opponent does not provide any evidence or it is insufficient, the opposition will be dismissed.

The SPTO will then decide whether to grant or refuse registration and publish its decision in the *Industrial Property Official Gazette*. Again, the decision may be appealed through an administrative appeal procedure within one month of publication.

Any unsuccessful party in an administrative appeal process before the SPTO may lodge an appeal before the contentious administrative courts within two months of publication of the SPTO's administrative appeal decision in the *Industrial Property Official Gazette*.

However, of 14 January 2023, any final resolution of the SPTO (grant or refusal, among others) will be appealable before the Courts of Appeal of the specialised IP courts in the civil jurisdiction.

REMOVAL FROM REGISTER

A trademark may be removed from the register by the SPTO or the commercial courts.

A trademark may be cancelled by the SPTO if it is not duly renewed (renewals must be made every 10 years) or if it is surrendered by the owner (the owner may surrender the trademark for all or some of the goods or services for which it is registered; surrender will not be permitted where this may affect the rights of third parties – for example, where the rights are subject to licences, attachments or call options).

The Commercial Courts of Barcelona, Madrid, Valencia, Granada, Las Palmas, A Coruña and Bilbao are the specialised IP courts in the civil jurisdiction and can invalidate or cancel a Spanish trademark. However, as of 14 January 2023, the invalidation and cancellation of a trademark may be sought before the SPTO or the commercial courts only through a counterclaim in a civil infringement action.

CANCELLATION

A trademark will be cancelled by a commercial court if:

- it has not been put to genuine and effective use in the Spanish market in connection with the goods or services for which it is registered – if such use is not made from the date that the registration is final or ceases for an uninterrupted five-year period without legitimate reason, the trademark may be cancelled if a revocation application is filed before the commercial courts;
- the trademark has become a common name for the goods or services for which it is registered as a result of the owner's activity or inactivity; or
- the trademark becomes misleading as a consequence of its use in the market.

INVALIDATION

A registration can be invalidated due to the existence of relative or absolute grounds for refusal.

An invalidation action based on absolute grounds will not be time barred. However, regarding the relative grounds, if the owner of the earlier right has tolerated the use of the infringing mark for a period of five successive years, the right to bring an invalidation action will lapse, unless the infringing mark was registered in bad faith.

An owner of prior rights that wishes to act against a registration filed in good faith has five years from the date of publication of the notice of registration or the date on which the owner of prior rights becomes aware of the later trademark being used in Spain.

There is no time limit for action by an owner of prior rights against a registration filed in bad faith.

SEARCHES

The SPTO can perform official searches. These include searches for identical and similar word marks and trade name searches. Official searches for traditional graphic marks and non-traditional graphic marks are not available.

ENFORCEMENT

COMPLEXITY

Registered trademark rights may be enforced through the Commercial Courts of Barcelona, Madrid, Valencia, Granada, Las Palmas, A Coruña and Bilbao, and through any criminal court.

Among other things, the rights holder may seek the following civil remedies:

- cessation of the infringing acts;
- compensation for damages;

- delivery or destruction of the infringing goods at the infringer's expense;
- delivery or destruction of the means principally used to commit the infringement at the infringer's expense;
- transfer of ownership of the infringing goods and the means intended to commit the infringement; and
- publication of the judgment at the infringer's expense.

The compensation for damages is fixed, at the injured party's discretion, according to one of the following criteria:

- the negative economic consequences suffered by the injured party, including the profits that the rights holder would have obtained if the infringement had not occurred or the profits obtained by the infringer as a consequence of the infringement; or
- a lump sum amount that at least includes the amount that the infringer should have paid to the owner of the trademark for the granting of a licence.

Compensation for damages will also include moral damages, the expenses incurred by the rights holder during the investigations carried out to obtain reasonable evidence of the infringement.

In addition, the rights holder can request compensation for the damages caused to the prestige of the trademark – in particular, due to a faulty fabrication or inadequate presentation of the illicit goods.

The rights holder is also entitled to request interim measures to ensure the effectiveness of the judgment adopted in the main action.

Three criteria must be satisfied to obtain an interim injunction:

- *fumus boni iuris* (ie, a prima facie case);
- *periculum in mora* (ie, urgency); and
- the provision of a bond to guarantee potential damages to the defendant.

An interim injunction may be issued either *ex parte* or following a contradictory hearing.

The Trademark Act sets no time limits for the pursuit of interim relief. However, as one of the criteria to be satisfied to obtain an interim injunction is urgency, the rights holder should file the corresponding request as soon as possible after becoming aware of the infringing acts.

CIVIL ACTIONS FOR UNREGISTERED TRADEMARKS

The Trademark Act grants protection to unregistered trademarks that are well known in Spain. Therefore, since an unregistered well-known trademark is considered almost equivalent to an unknown registered trademark, there are no difficulties in enforcing such rights.

CRIMINAL ACTIONS FOR REGISTERED TRADEMARKS

Criminal proceedings can be commenced against those who intentionally manufacture, import, store or sell counterfeit goods. The legal penalties and remedies in criminal proceedings are:

- imprisonment of between one and four years for manufacturing, importing, offering, distributing, commercialising or storing wholesale counterfeit goods;
- imprisonment of between six months and three years for offering, distributing or commercialising retail sale counterfeit goods;
- imprisonment of between six months and two years for street vending and occasional sale of counterfeit goods (if certain requirements are met, imprisonment can be substituted by a fine);
- payment of damages (legal criteria established pursuant to Article 43 of the Trademark Act); and
- destruction of the infringing goods.

These penalties can be extended for up to six years if, among other reasons, the crime has a special economic significance, or it has been committed by a criminal organisation or association.

Only the owners of registered trademarks can seek protection under criminal law.

TIME FRAME

The time frame for civil actions for the protection of registered and unregistered trademarks is around one year at first instance and around two years for an appeal judgment.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

The Trademark Act does not require legalisation. Instead, the presentation of legalised documents is left to the applicant’s discretion.

RELATED RIGHTS

An object of copyright, a design protection or rights related to the name or image of a person may also be protected as a trademark, provided that it fulfils the legal requirements.

ONLINE ISSUES

The Trademark Act recognises that a registered rights holder has the exclusive right to use its trademark on interconnected communication networks and as a domain name.

Yes: power of attorney. No: does not require notarisatión..	Yes	Yes: 3D; sounds.
Yes	Yes	Yes: two months.
Yes: five years’ non - use from date of publication of registration or date of suspension of use.	Yes	Yes

Yes	No	Yes: interim injunctions are available. No: there is no time limit.
No	Yes	No: UDRP applies directly.

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Sweden: Trademark procedures and strategies

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LEGAL FRAMEWORK

Sweden's relevant trademark laws include:

- the Trademarks Act (2010:1877), last amended in 2021 through SFS 2021:561; and
- the Trademarks Regulation (2011:594)

There are also several supplementary acts dealing with more specific elements of trademark law, including:

- the Law on the Protection of International Humanitarian Symbols (1953:771);
- the Law on the Protection of National Municipal Coats of Arms and Other Official Designations (1970:498); and
- the Regulation on the Protection of National Coats of Arms and Other Official Designations (1976:100).

Sweden's trademark laws are based largely on international conventions and EU regulations and directives, including:

- the Paris Convention;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Madrid Protocol; and
- the Singapore Convention on Trademarks.

As an EU member state, Sweden is bound by:

- the EU Trademark Regulation (2017/1001); and
- the EU Trademarks Directive (2015/2436).

UNREGISTERED MARKS

Establishment through use of a mark will give the same protection as if the mark were registered. However, the bar is set high for demonstrating establishment through use.

To establish an unregistered right through use, the trademark owner must show that one-third of the relevant public has knowledge of the mark on the market. As the Swedish Patent and Trademark Office (PTO) and the Patent and Market Court accept market surveys as evidence of establishment on the market, such evidence is preferred. Other types of evidence may also be provided to prove establishment (eg, sales and marketing figures). However, given the lack of statutory provisions in the Trademarks Act, it is at the PTO's or the Patent and Market Court's discretion to decide on a case-by-case basis whether the one-third standard is satisfied.

REGISTERED MARKS

Any natural person or legal entity can apply for and own a mark.

Representatives do not require a power of attorney before filing a Swedish national trademark. However, a power of attorney is needed if changes to a registered trademark are necessary (eg, in the case of withdrawal of registration, any changes to the list of goods and

services or re-classification are to be filed or changes in ownership or in the case of recordal of a new representative).

Signs that have a certain level of distinctiveness (acquired or inherent) may be protected. Until 1 January 2019, there was a requirement in the Trademarks Act for a trademark to be able to be graphically represented. However, this requirement has since been removed, meaning that sound files, motion files and multimedia files may be filed as a trademark.

PROCEDURES

EXAMINATION

The PTO examines applications against both relative and absolute grounds for refusal. Generally, and if no opposition is made, it will take five to six months from filing until the trademark is registered. Applications submitted on or after 1 January 2019 will result in registrations that are valid for 10 years from the filing date of the application for registration. The trademark must be renewed every 10 years. Applications for renewal take approximately one month for the PTO to process. The latest renewal date (grace period) can be prolonged by six months and only if the holder pays a penalty fee.

The PTO offers searches and conducts them in the same way as an examiner would examine an application.

The cost is generally 2,400 Swedish kronor for a seven-day turnaround or 4,000 kronor for express delivery. Prices include search results of up to 5,000 hits. For more than 5,000 hits, the price varies.

OPPOSITION

The opposition period is three months from the date of publication of the trademark registration in the Official Journal. The opponent must submit a written objection. The parties always get the opportunity to comment on the adverse party's letters. It is possible for the owner of the opposed mark to demand that the opponent submits proof of use of the earlier trademark upon which the opposition is based. The PTO then decides whether to reject the opposition or revoke the registration, in whole or in part. The PTO's decision can be appealed to the Patent and Market Court following leave to appeal to the Patent and Market Court of Appeal. The opposition procedure may take up to two years, depending on the number of briefs and evidence filed by the parties at the PTO. However, after issuing the final office action, the PTO will normally examine the merits of the opposition within three months.

REGISTRATION

If no grounds for refusal are found, the PTO will issue a certificate of registration and, if no opposition is filed, the trademark will be granted protection three months after the registration was published in the Swedish *Trademark Gazette*. Once the trademark has been granted protection three months after the publication of a registration, opposition proceedings will no longer be possible.

REMOVAL FROM REGISTER

A trademark owner can surrender its trademark at any time by submitting an application to the PTO. If the application is signed by a representative, a power of attorney is required.

The Trademarks Act has no separate provisions for revocations and invalidations. A trademark can be cancelled, partly or entirely, on the basis that it was incorrectly registered or if the registered trademark was registered in violation of the Trademark Act provisions. It may also be cancelled if, due to the manner in which it has been used, the trademark has become a generic term for such goods or services. Additionally, the mark may be revoked if it is contrary to good practice or public order, or if it has become liable to mislead the public in terms of the nature, quality, geographical origin or other conditions related to the goods or services. In this context, it is not possible to revoke a trademark if the opposite trademarks are intervening rights, resulting in a situation where the right to a more recent registered mark under certain given conditions must be considered valid alongside an earlier trademark right.

A trademark may be cancelled if it has not been in genuine use within five years of the date of registration or within a period of five consecutive years.

ENFORCEMENT

In Sweden, enforcement of trademark rights, regardless of whether it is a registered or unregistered right, is a straightforward procedure at the Patent and Market Court. Trademark infringement actions may involve several causes of action, including:

- invalidity actions;
- infringement due to risk of confusion;
- counterfeiting;
- parallel imports; and
- repackaging.

Several remedies are available under the Trademarks Act and enforcement is exclusively requested at specialised judicial courts – the Patent and Market Court and the Patent and Market Court of Appeal. An administrative procedure for invalidity of trademarks and trade names is available but, if rejected by the defendant, it will be transferred to the Patent and Market Court. The remedies available are prohibitive injunctions risking penalties, as well as an injunction to produce information, damages, destruction of infringing goods and removal of infringing goods from the market. Generally, if awarded the claims, the claimant is also awarded coverage for all legal costs and fees.

The enforcement of trademark rights is carried out by filing a complaint with the Patent and Market Court. A complaint is generally filed stating the claims, legal grounds and evidence. The defendant is typically given three weeks to respond from the date that the complaint was served. The court allows for exchange of briefs until it declares that no more arguments, facts or evidence may be filed. Thereafter, there will be a preparatory oral hearing followed by a final hearing and the award will be rendered approximately four weeks later. The length of a proceeding varies significantly depending on the complexity of the case, the amount of evidence and the parties' procedural strategy.

The damages awarded are usually based on loss of profits, licence fees, damage to the goodwill of the mark and other pertinent circumstances. Punitive damages are not allowed in Sweden, although the court may consider circumstances other than strictly financial ones – for example, the severity of the infringement, the infringer's mindset (eg, whether it was premeditated) or the size of the parties involved.

Interim relief is available under the Trademarks Act. Interim seizures, prohibitive injunctions and search orders may be sought before and during the proceedings. Such reliefs may also be sought and awarded without first hearing from the defendant if there is a degree of urgency in the case. The requirements that must be proven so as to be awarded interim relief are:

- probable cause with regard to the claim of infringement;
- whether the trademark may be damaged due to the ongoing infringement; and
- whether the defendant will not discontinue use of the infringing trademark.

The claimant must provide an appropriate monetary security in case the defendant suffers any damage that the interim relief may cause during the proceeding. A further requirement is that the relief must be proportionate. There are no time limits in the statutory provisions that would bar the claimant from seeking relief, although a late claim or request may bar the claimants' requests for an *ex parte* decision and may even affect the outcome of the balance of interest if a major delay is solely due to the claimant.

An infringement case in the first instance court may take up to 18 months to be resolved, depending on the complexity of the case, case material, evidence and procedural strategies of the parties. On average, the Patent and Market Court will take 12 months to resolve the case from the filing of the complaint. For interim relief, the time frame varies depending on the claims. In counterfeit actions, the Patent and Market Court may take a couple of hours to decide, while in more complex infringement cases it may take up to three weeks before a decision is made.

Criminal proceedings for trademark infringement are also available in Sweden. However, for a public prosecutor to indict an infringer, there must be specific public interest. Typically, this would involve counterfeit cases with larger amounts of goods. If a public prosecutor decides not to indict a suspected infringer, the rights holder or its licensee may file suit through a civil court proceeding.

While enforcement actions for unregistered rights may have more complex evidentiary issues than actions for registered rights, the timeframe for the resolution is the same. On average, it will take one year for the Patent and Market Court to resolve enforcement action, while in more complex cases it may take up to 18 months. Obviously, the timeframe for interim relief is much shorter, spanning from merely a number of hours to up to three weeks from filing the request, depending on the type of claim made.

If an award is appealed to the Patent and Market Court of Appeal, the time frame is extended by between eight and 12 months if the appellate court grants a leave of appeal.

Regarding the procedure in invalidity cases through administrative procedures, the time frame for resolution is six weeks to three months, depending on when the defendant is served the administrative invalidity action. If the defendant rejects the claims of invalidity, the holder of the prior right will have one month to transfer the case to the Patent and Market Court for further processing and the time frame for judicial courts will apply.

If questions of non-use arise, use of a licensee is attributed to the trademark owner. If a licensee brings certain goods and services into the internal market under the mark, the exhaustion of exclusive rights will apply as though the licensor had brought them into the market. The same exhaustion rules apply to Sweden as in the European Union.

OWNERSHIP CHANGES AND RIGHT TRANSFERS

No documents require legalisation when filing for an ownership or rights transfer with the PTO.

To register mergers or changes of ownership, the registrant must provide proof of title and the procedure will normally take four months. Should the rights holder change its name, registration will take approximately two weeks.

Use of a licensee can be attributed to the trademark owner if the trademark is used as it is registered and for the goods or services covered by the registration.

RELATED RIGHTS

Copyright may be used to protect device marks that have artistic merits. In certain cases, a logo can be protected by both trademarks and designs. Trade names are given protection against similar or identical names being registered as trademarks if the goods and services overlap with the indicated line of business. Hence, the examination of the trademark application in relation to the relative grounds (ie, prior rights) is also made in relation to the trade names.

It is not possible to protect copyright by registration in Sweden.

ONLINE ISSUES

Both registered and unregistered rights (if they are established through use) are applicable to online use, as the definition of 'use' in the Trademarks Act does not exclude use online. However, there are no specific provisions for domain names as such or to specific online use.

There are no specific provisions that protect mark owners against unauthorised use on the internet – that is, on websites, commercial platforms, social media, metatags or hyperlinks. The legal provisions for national domain names – the Law on National Top-Level Domains for Sweden on the Internet (2006:24) – contains no provisions on use or intellectual property. Any natural person or legal entity may register a domain name without limitation or a priori regard to intellectual property. Use on such media will be examined through the general principles of use stated in the Trademarks Act.

A rights holder can file a complaint with a judicial court for trademark infringement for use of trademarks in domain names, websites, hyperlinks and metatags depending on the circumstances. The rights holder can also request the transfer or takedown of a domain name at a judicial court and may be part of an infringement suit.

There is an alternative dispute resolution (ADR) process for the ccTLD '.se' that is administered by WIPO (see <https://internetstiftelsen.se/en/dispute-resolution/>). The ADR is based on a contractual obligation for the domain holder to transfer or delete the domain name if a panel finds that the domain name infringes a holder's IP rights. The ADR through WIPO for the TLD '.se' may be processed and examined by either one or three panellists, depending on the parties' request. In any case, the claimant will have to pay upfront at least half of the ADR fee, which must be reimbursed by the losing party. The time frame for resolution varies depending on the number of panellists. If only one panellist is requested, the time frame is approximately two months, while for three panellists, the time frame is between three and four months.

No: power of attorney is not required for filing.	Yes	Yes: shape, sound, colour, 3D, hologram, position, ornament, movement and multimedia marks.
Yes	Yes	Yes: three months.
Yes: five years from date of registration or a five - year period.	Yes	Yes
Yes	No	Yes
No	No	Yes



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Turkey: Trademark procedures and strategies

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LEGAL FRAMEWORK

At the national level, trademarks are governed by Industrial Property Code No. 6769 (the IP Code), which entered into force on 10 January 2017.

Turkey is a signatory to several key treaties and conventions including the Paris Convention, the Agreement on Trade-Related Aspects of Intellectual Property Rights and the Madrid Protocol. As a member of WIPO since 1976, Turkey follows the Nice Classification system. Turkey is also a party to the Vienna Convention, the Convention Establishing the World Trade Organization and the Trademark Law Treaty.

UNREGISTERED MARKS

Unregistered trademarks can be protected in accordance with the provisions of Articles 6/3 and 6/4 of the IP Code as well as the provisions on unfair competition in Turkish Commercial Code No. 6102.

Article 6/3 of the IP Code regulates relative grounds for rejection of a trademark application upon opposition from a trademark owner based on an unregistered trademark or another sign used in the course of trade before the application or priority date. This provision can also be invoked as grounds to invalidate a registration.

In terms of enforcement, unregistered trademarks may be enforced within the context of unfair competition.

In establishing unregistered rights, evidence that proves continuous and extensive use of an unregistered trademark within the territory of Turkey is needed together with evidence indicating that the unregistered trademark acquired some level of distinctiveness or recognition, or both, in the relevant industry.

REGISTERED MARKS

According to Article 3 of the IP Code, the following can apply for and own a trademark before the Turkish Patent and Trademark Office (TÜRKPATENT):

- citizens of Turkey;
- natural or legal entities domiciled or engaged in industrial or commercial activities within Turkish borders;
- persons who have the right of application according to the provisions of the Paris Convention or the WTO; and
- persons who are the citizens of the states that provide protection of industrial property rights to the citizens of Turkey, according to the principle of reciprocity.

Natural or legal entities domiciled abroad must be represented by a chartered trademark agent to file a trademark application before TÜRKPATENT.

A power of attorney (POA) is not required to be submitted to TÜRKPATENT during the filing of a trademark application. However, a trademark agent should hold a POA in the name of their clients, and TÜRKPATENT has the discretion to request the submission of the original or a certified copy of the POA.

REGISTRABLE AND NON-REGISTRABLE SIGNS

According to Article 4 of the IP Code:

Trademarks may consist of any signs like words, including personal names, devices, colours, letters, numbers, sounds and the shape of goods or their packaging, provided that such signs are capable of distinguishing the goods or services of one undertaking from those of other undertakings and being represented on the register in a manner to determine the clear and precise subject matter of the protection afforded to its owner.

According to Article 5 of the IP Code, some marks cannot be registered as trademarks. This includes marks that:

- do not comply with the terms of Article 4;
- are non-distinctive;
- are descriptive;
- are identical or indistinguishably similar to a prior-dated trademark application or registration covering identical – or the same kind of – goods or services;
- are commonly used in trade, or used to distinguish members of a particular occupational, art or trade group;
- consist exclusively of the shape or another characteristic resulting from the nature of the goods themselves, or the shape or another characteristic of goods that is necessary to obtain a technical result or gives substantial value to the goods;
- are deceptive;
- are to be refused pursuant to Article 6ter(2) of the Paris Convention;
- are of public interest in terms of historical and cultural values, and include badges, emblems or escutcheons unless approved by the competent authority;
- contain religious values or symbols;
- are contrary to public policy or accepted principles of morality; and
- consist of or contain registered geographic indications.

A trademark that is found to be non-distinctive, descriptive and commonly used in trade may still be registered if the trademark was used before the application date and acquired distinctiveness for the claimed goods or services. Acquired distinctiveness of a trademark is examined by TÜRKPATENT only in cases of appeals filed by a trademark applicant against a decision of rejection on absolute grounds.

A trademark that is found to be indistinguishably similar to an earlier trademark may still be registered if the owner of the earlier mark provides a letter of consent (LOC). If the LOC is signed in a foreign country, it must be notarised and legalised. A LOC may be submitted either simultaneously with the filing of a trademark application or along with a response to a possible decision of rejection.

PROCEDURES

EX-OFFICIO EXAMINATION

Once a trademark application is filed – either directly with TÜRKPATENT or via WIPO under the Madrid Protocol – the application undergoes an examination on formal and absolute grounds.

TÜRKPATENT initially examines the application formally to check the accuracy and completeness of the information, documents and classification, and the official fees required for filing.

If no inaccuracy or deficiency is detected, TÜRKPATENT goes ahead with the examination on absolute grounds in accordance with Article 5 of the IP Code.

In the case of any office actions issued against the application, the applicant may respond or appeal within a non-extendable period of two months.

If the trademark application passes its examination on formal and absolute grounds, or if an applicant overturns a decision of rejection through an appeal, the application is published in the *Official Trademarks Bulletin* for an opposition period of two months.

In the case of a decision of partial acceptance, the application is published for the goods or services that are not subject to rejection. If the applicant manages to overturn the decision of partial rejection, the application is republished in the *Official Trademarks Bulletin* for another period of two months for the goods or services, upon which the decision of partial rejection is withdrawn.

The timeframe from the date of filing of a national application to registration is approximately eight to 10 months when there are no office actions or oppositions. The timeframe may be longer for international applications filed through WIPO.

OPPOSITION

Interested third parties may oppose an application on absolute or relative grounds within two months of the publication date of the application.

During the examination of the opposition, TÜRKPATENT requests the applicant's response, which must be filed within one month. If the applicant does not file a response, TÜRKPATENT still examines the opposition on the merits and issues a decision.

If the trademark, which is the ground for opposition, has been registered for at least five years as at the filing (or priority) date of the opposed application, TÜRKPATENT asks the opponent to submit evidence of genuine use of their trademark during the five-year period before the filing (or priority) date of opposed application upon the request of the applicant.

If the opponent fails to prove use or submits a justified reason for lack of use, and in the absence of other grounds that may result in acceptance of the opposition, the opposition is rejected. If it is proven that the trademark, which is the ground for opposition, has been used only for some of the goods or services covered by registration, then the opposition is examined considering those goods or services.

TÜRKPATENT may reject the application partially or entirely if it determines that the opposition has been justified.

Any party unsatisfied with the decision may file an administrative appeal within two months.

The Board of Re-examination and Re-evaluation (the Board) reviews the appeal and grants the parties a period of one month to submit their counterinterviews. In the absence

of countervails, the examination is conducted considering the existing documents and information.

Any party unsatisfied with the decision of the Board may file a civil lawsuit before the IP Court of Ankara within two months. The plaintiff must name TÜRKPATENT and the other party or parties to the opposition or appeal as co-defendants.

An opposition is usually decided within three to six months of filing, whereas an appeal filed before the Board is usually decided within four to eight months of filing.

REGISTRATION

If a trademark application faces no opposition or an opposition results in favour of the applicant, TÜRKPATENT sends the applicant or their trademark agent a notice of acceptance for payment of the official fees for registration.

If payment is made within two months, the application proceeds to registration and TÜRKPATENT sends the applicant or their trademark agent a trademark registration certificate.

MAINTENANCE

A trademark is registered for a protection period of 10 years as of the application date.

A registration may be renewed for further periods of 10 years. A renewal application can be filed up to six months prior to the expiration of the 10-year period or with payment of a fine within the grace period (i.e., within six months of the expiration of the 10-year period).

A declaration concerning use or intention of use of a trademark is not required by the IP Code either for registration or renewal.

INVALIDATION AND CANCELLATION ACTIONS

Trademark registrations may be subject to invalidation claims based on absolute and relative grounds for rejection under Articles 5 and 6 of the IP Code.

According to Article 9, a trademark owner is required to use its registered trademark. If a trademark has not been put to genuine use within a period of five years of the registration date by the trademark owner or if such use has been suspended during an uninterrupted period of five years, a trademark can be cancelled due to non-use unless there are justifiable reasons for non-use.

Non-use cancellation actions are currently being heard by IP civil courts, but TÜRKPATENT will be the authority to examine cancellation requests for non-use after 10 January 2024.

Other causes for cancellation of a trademark are if:

- a trademark has become generic for the goods or services for which it is registered;
- a trademark misleads the public regarding the nature, quality or geographic origin of the goods or services for which it is registered as a result of the use by the trademark owner itself or with the trademark owner's consent; and
- the continuous use of the collective mark or the guarantee mark is contrary to the technical specification and is not corrected within the prescribed period as regulated by Article 32 of the IP Code.

MERGER AND CHANGE OF NAME

Structural changes in trading companies, such as mergers or changes of names, can be recorded against the trademark applications or registrations of the subject companies, or both, before TÜRKPATENT.

The recordal of change of name takes up to one month as of the filing of the application with complete documents, whereas the recordal process takes up to two months for a recordal of merger.

OFFICIAL CLEARANCE SEARCHES

Official TÜRKPATENT searches are available for device marks or logos and word marks – including slogans – in addition to non-traditional marks.

These searches are carried out by TÜRKSMD, an affiliate of TÜRKPATENT. They reveal identical and similar marks in either all classes or selected classes as requested.

ENFORCEMENT

According to Article 29 of the IP Code, unauthorised use of a sign that is identical or similar to a registered trademark for identical or similar goods or services and is, therefore, liable to create a likelihood of confusion including association on the part of the public constitutes trademark infringement. Use of a sign – without due cause – that is identical with or similar to and would take unfair advantage of or damage the distinctive character or repute of a registered trademark due to its reputation in Turkey – irrespective of whether the goods or services are identical, similar or different – is also considered to be trademark infringement.

Second, the IP Code prohibits the use of an infringing trademark by a third party that is aware or should be aware that the trademark is counterfeited. The sale, distribution, putting on the market, possession for commercial purpose, importation and exportation of the products carrying that infringing trademark or offering to make a contract related to the infringing product is also prohibited by law.

Finally, the unauthorised broadening of the transfer of the rights given by the trademark owner through licensing to third parties also constitutes infringement.

On the other hand, the provisions of Turkish Commercial Code No. 6102 regarding the exercise of unfair competition prohibits:

- activities that cause confusion with the products, business or activities of another;
- use of any sign that is confusingly similar to a third party's product, trade or company name, or trademark; and
- the sale or the possession, or both, of goods likely to cause confusion for commercial purposes.

A trademark owner can file a lawsuit before an IP court against an infringer for trademark infringement or unfair competition, or both. A trademark owner can also file a penal complaint or civil action against the infringer.

CIVIL ACTIONS

The remedies based on trademark infringement and unfair competition in civil actions include:

- preliminary and permanent injunctions for prevention of use;
- seizure of infringing goods;
- removal of infringing trademark from infringing goods and, if necessary, destruction thereof;
- removal of infringing use from the internet;
- publication of the court decision in a newspaper; and
- material or moral damages, or both.

There is no minimum or maximum amount set by the law for either material or moral damages that can be claimed in a civil action. Material damages would be calculated by court experts and moral damages would be decided by the judge according to the specifications of the case. Material damages are actual damages caused by infringement as well as loss of profits.

An obligatory mediation process is required to claim damages in an infringement action.

CRIMINAL ACTIONS

Trademark infringement is a criminal offence under the IP Code. A complaint can be filed before the relevant public prosecutor by the registered trademark owner and, through an indictment from the public prosecutor, the Criminal Courts of Peace may issue a search and seizure order that would result in a police raid. If infringement is confirmed through search and seizure proceedings, a penal suit may be introduced by the relevant public prosecutor before the criminal court. Quick destruction is possible at the request of a public prosecutor if the goods are at risk of damage, if there is a risk of fundamental decrease in value or if the storage will cause high expenses, provided that the court's expert examination confirms that the goods are counterfeit.

Before a penal action is initiated, the parties are invited to a compulsory conciliation process. An infringer may be sentenced to a judicial fine or imprisonment, or both, at the end of the criminal proceedings. The term of imprisonment depends on the committed action and the maximum term is four years. Seized goods may be destroyed at the end of a penal action, but the complainant will not be granted damages.

INTERIM RELIEF

It is possible to obtain a preliminary injunction order from a civil court as a method of interim relief, which includes stopping the sale, manufacturing and distribution of counterfeit goods both before and after filing a lawsuit or during one. However, it is mandatory to file the main action as to the merits within two weeks of the request for the preliminary injunction. Otherwise, the preliminary injunction will ex officio be deemed to have been revoked.

For a preliminary injunction order to be enforced, the payment of an indemnity may be required.

NON-USE AS A DEFENCE

In an invalidation action based on a trademark registration that has been registered for at least five years, defendants may raise a non-use defence requesting the plaintiff to prove genuine use of the earlier trademark registration in the prior five years in Turkey.

In the case of an infringement action, if the plaintiff's trademark that is the basis of an infringement action has been registered for at least five years as at the filing date of the action, the defendant may raise a non-use defence and request the plaintiff to prove genuine use of its registered trademark in Turkey at the filing date of the action.

TIME LIMITS

An invalidation action can be filed within five years of the registration date of the disputed trademark. If a bad-faith claim is raised, no time limit is applied.

In terms of infringement, there are two time limits. First is the statute of limitations, which is two years as of becoming aware of a specific infringing act. In any case, such a civil action must be filed within 10 years of the date on which the infringing act occurred. If an action is also defined as a crime, the time limit applicable for that crime would be applied. If the infringement is ongoing, no time limit is applied.

The second time limit is loss of rights through remaining silent against continuing use. Although it is evaluated case by case, the average time applied by Turkish courts is five years in practice.

IP COURTS

Specialised IP courts are available in Turkey. As at 2022, there are eight IP civil courts and six IP criminal courts in Istanbul; five IP civil courts and one IP criminal court in Ankara; and one IP civil court and one IP criminal court in Izmir.

OWNERSHIP CHANGES AND RIGHT TRANSFERS

An industrial property right may be transferred, inherited, subject to licensing, pledged, shown as collateral, seized or made the subject of other legal transactions.

It is possible for an assignment to be affected either for all or some of the goods or services covered by a trademark application or registration.

A trademark may also be subject to licensing for all or some of the covered goods or services. A licence may be granted as exclusive or non-exclusive. Unless otherwise specified in the agreement, the licence shall be non-exclusive.

For recordal of assignment and licence before TÜRKPATENT, an assignment deed and licence agreement executed between the parties should be submitted. Each of the signatures on the assignment deed must be separately notarised for recordal of assignment, whereas no notarisation is required for recordal of licence. If the assignment deed or licence agreement is in a foreign language, a Turkish translation certified by a sworn translator is required.

It is not mandatory to record a trademark licence or assignment in Turkey. However, rights arising from these legal transactions cannot be asserted against bona fide third parties unless they are recorded before TÜRKPATENT.

In accordance with Article 9/3 of the IP Code, use of a trademark with the consent of its owner is considered to be genuine use. Accordingly, use of a trademark by a licensee inures to the benefit of the owner.

RELATED RIGHTS

There are regulations in Turkey enabling the overlap of IP rights. The IP Code regulates, in Article 58/3, that a design protected under the IP Code is also protected under the Law of Literary and Artistic Works if it meets the conditions in that law.

According to Article 6/6 of the IP Code, a trademark application shall be refused upon the opposition of the right holder if it consists of a person’s name, trade name, photography, copyright or any other intellectual property right of another. In this regard, there are precedents that the IP courts and TÜRKPATENT invalidate or reject trademark applications that include copyrighted works, such as book names, movie names, comics or cartoon characters, TV series, or logos.

Additionally, if a work of intellectual property meets the requirements for both copyright protection under the Law of Literary and Artistic Works and protection as a trademark or design under the IP Code, it benefits from cumulative protection.

In addition to the above, a product design may be protected by copyright law as a two- or three-dimensional mark, trade dress, design, unregistered design or work of applied art. Regardless of whether it is covered by copyright laws, a creative work can be registered as a trademark. Moreover, under trademark and unfair competition law, a geographical indication may be registered as such or may be protected as a collective or certification mark.

ONLINE ISSUES

The IP Code grants a trademark registration owner with the right to prevent use of a sign, which is identical or similar to a registered trademark as a domain name, router code, keyword or metatag, among other things, in such a manner that would create a commercial impression on the internet, provided that the user of the sign has no right or legal affiliation for the use. The law does not provide an exhaustive list of infringing use on the internet or on social media but provides examples.

Nic.tr, an authority affiliated with the Middle East Technical University (METU), used to manage .tr ccTLDs. Following amendments made to the legislation and regulations, METU transferred the management thereof to the Institute of Information Technologies and Communication. A new platform introduced by METU, called TRABIS, became fully operational on 14 September 2022 and started to provide uninterrupted service as an accredited registrar of the Institute of Information Technologies and Communication.

Much like the UDRP, .tr ccTLDs might be the subject of a dispute before the registrar in the new system. It is also possible to file an action for cancellation of a domain name before civil courts based on trademark infringement. A court may also rule for prevention of access to a website or removal of infringing content.

No: however, TÜRKPATENT may request submission of the original or a certified copy of a power of attorney.	Yes	Yes: 3D shapes; colours; sounds; motions; multimedia marks; positions; and patterns.
Yes	Yes	Yes: two months from the publication of the application.

Yes: cancellation after either a five - year term, which starts from the registration date, or any uninterrupted period of five years..	Yes	Yes
Yes	Yes	Yes: there is two - week time limit following the request for enforcement of the injunction order to file the main action.
No	Yes	Yes

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United Kingdom: Trademark procedures and strategies

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LEGAL FRAMEWORK

UK trademark law is governed by the Trademarks Act 1994 and a number of statutory instruments containing certain Brexit-related legislation.

The United Kingdom is a member of the WIPO and a signatory to the Protocol Relating to the Madrid Agreement Concerning the International Registration of Marks, meaning that the United Kingdom can be designated under an international registration.

The United Kingdom is also a signatory to numerous international treaties relating to trademarks, including:

- the Paris Convention for the Protection of Industrial Property;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights (TRIPs);
- the Nice Agreement Concerning the International Classification of Goods and Services; and
- the Vienna Agreement Establishing an International Classification of the Figurative Elements of Marks.

Unjustified threats provisions relating to trademarks and other forms of registered IP rights are prescribed under the Intellectual Property (Unjustified Threats) Act 2017. The provisions regarding trademarks are expressly covered by Sections 21 to 21F of the Trademarks Act.

UNREGISTERED MARKS

Unregistered trademarks can be protected through the common law tort of passing off.

In a typical claim for passing off, the claimant must establish the so-called classical trinity (*Reckitt & Colman Products Ltd v Borden Inc*), namely:

- goodwill in relation to the goods or services provided under the trademark;
- a misrepresentation by the defendant (whether intentional or innocent) that is likely to deceive the relevant public into believing that the defendant's goods or services originate from (or are associated with) the claimant (or vice versa); and
- damage, or a likelihood of damage, resulting from the defendant's actions.

Goodwill is assessed on a case-by-case basis and must be local to the United Kingdom. It is more than just mere reputation, although the trademark need not be well known and rights may be limited to a specific locality where there is no nationwide use.

The evidential burden on a claimant is generally higher in a claim for passing off than a claim for registered trademark infringement, although the two are often pursued together.

REGISTERED MARKS

Any natural or legal person can apply for a registered trademark in the United Kingdom. Applicants must declare that the mark is being used by them, or with their consent, or that there is a genuine bona fide intention to use the mark, for the specified goods or services.

Appointing a representative before the UK Intellectual Property Office (UKIPO) is not compulsory, and where one is appointed, no power of attorney is required. However, as of 1

January 2021, all new UK trademark applications (and oppositions) require a UK address for service.

The UK trademark register is publicly accessible online, free of charge.

To qualify for protection, a sign must be capable of:

- being represented in the register in a way that allows the “clear and precise subject matter of the protection afforded to the proprietor” (Trademarks Act 1994) to be determined; and
- distinguishing goods or services of one undertaking from those of other undertakings.

A trademark may, without limitation, consist of words (including personal names), designs, letters, numerals, colours, sounds, holograms, multimedia marks or the shape of goods or their packaging. Case law has also held that olfactory and taste marks are registrable in principle.

Up to six variants of a trademark may be covered under a single series application, provided that any variations do not affect the mark’s inherent distinctive character. Collective and certification marks can also be registered in the United Kingdom.

Signs cannot be registered in the United Kingdom if they:

- cannot be represented sufficiently clearly and precisely, or are incapable of distinguishing the goods or services of one undertaking from those of another;
- are devoid of distinctive character;
- consist exclusively of characteristics that describe the goods or services;
- have become generic or customary in the current language or genuine and established practices of the trade;
- consist exclusively of a shape or another characteristic that:
 - results from the nature of the goods themselves;
 - is necessary to obtain a technical result; or
 - gives substantial value to the goods;
- are contrary to public policy or accepted principles of morality;
- are deceptive;
- have been applied for in bad faith; and
- consist of or contain certain specially protected emblems, for example:
 - the royal arms or Olympic symbols (if applied for without authorisation); or
 - certain national flags (where use of the trademark would be misleading or grossly offensive).

These are referred to as absolute grounds for refusal.

COMPARABLE UK MARKS

The United Kingdom left the European Union on 31 January 2020, triggering a transition period that expired on 31 December 2020. As of 1 January 2021, the United Kingdom is no longer directly subject to EU rules and regulations, meaning that EU trademarks no longer have legal effect in the United Kingdom. All EU trademarks (including collective and certification marks) registered as at 31 December 2020 were automatically cloned on 1 January 2021 by the UKIPO to create comparable UK trademarks. A comparable UK mark has the same legal status as a mark registered under UK law, maintains the original EU trademark filing, priority or seniority dates, and is a fully independent UK trademark that can be challenged, assigned, licensed, enforced or renewed separately from the originating EU trademark. Under certain conditions, EU trademark holders may choose to opt out of obtaining a UK comparable mark.

For EU trademark applications pending as at 31 December 2020, rights holders had until 30 September 2021 to apply to register the same mark in respect of the same goods or services as a UK trademark. Such applications retained the earlier filing date of the pending EU trademark application and benefitted from any valid priority or seniority claims.

PROCEDURES

EXAMINATION

The UKIPO initially examines all trademark applications to ensure that they meet the formal filing requirements. It then undertakes a substantive examination to ensure that the specification of goods and services is sufficiently clear and correctly classified, and registration of the sign is not prohibited by any absolute grounds (other than bad faith). If objections are raised, applicants initially have two months to respond.

The UKIPO also undertakes a search for earlier conflicting UK marks. Where conflicting rights are identified, these are listed in the examination report and the applicant may amend the specification, withdraw the application or (once any other objections have been addressed) proceed with the application. If the application is published for any conflicting goods and services, the UKIPO will notify the holders of earlier UK rights. It is then for the earlier rights holders to decide whether to oppose.

OPPOSITION

Once any objections raised during examination have been resolved, applications are published for opposition purposes. The opposition period is initially two months from the date of publication. Potential opponents may file a notice of threatened opposition during that period to extend the opposition period by an additional month.

An opposition may be based on any absolute or relative grounds (or both), including where there exists:

- an earlier identical trademark for identical goods or services;
- a likelihood of confusion with an earlier (identical or similar) trademark covering identical or similar goods or services (including a likelihood of association);
- an earlier trademark with a reputation in the United Kingdom where use of the later mark without due cause would take unfair advantage of, or be detrimental to, the distinctive character or repute of the earlier trademark;
- an earlier unregistered trademark or other sign used in the course of trade;

- an earlier conflicting geographical indication or designation of origin; and
- earlier conflicting copyright, design rights or registered designs.

An 'earlier trademark' is defined as:

- an earlier UK trademark application or registration;
- an earlier international application or registration designating the United Kingdom; or
- an earlier trademark entitled to protection in the United Kingdom under the Paris Convention or the TRIPs Agreement.

Where an application is opposed, the applicant has two months to either file a defence or enter into a cooling-off period. If the applicant does not respond to the opposition, the application will be deemed abandoned in respect of the opposed goods or services.

To enter into a cooling-off period, both parties must consent. The cooling-off period initially lasts for seven months and may be extended by the parties for a further nine-month period. Either party may terminate a cooling-off period unilaterally without notice. If the dispute is unresolved at the end of the cooling-off periods, the applicant must file a defence to avoid the application becoming abandoned.

The opponent has two months from receipt of the notice of defence to file its submissions and evidence in support of the opposition. The applicant then has two months to file its own submissions and evidence, and the opponent has a further two months to reply. On completion of the evidence rounds, the hearing officer will make a decision based on the parties' written submissions and evidence or after a formal hearing (if requested by either party).

Where an opposition is based on an earlier trademark that has been registered for five years or more as at the filing date of the opposed application (or, where applicable, its priority date), the applicant may put the opponent to proof of use of the earlier mark. Where use cannot be established, the earlier mark in question will not be considered in the proceedings.

In respect of comparable UK trademarks, any use made of the originating EU mark in the European Union before 1 January 2021, whether inside or outside the United Kingdom, will count as use of the comparable UK mark. Similarly, where an originating EU mark enjoyed a reputation before 1 January 2021 in the European Union but not the United Kingdom, such reputation will also be considered for the purposes of the comparable UK mark.

Cost awards in proceedings are generally issued to the successful party and are calculated using a published scale of costs. Exceptionally, the UKIPO can award off-the-scale costs to address parties' unreasonable behaviour.

A standard opposition is likely to take in the region of 12 to 18 months to reach a decision (subject to appeal).

REGISTRATION

Absent any opposition, or once any opposition proceedings have been overcome, the application will proceed to registration. An application that encounters no objections or oppositions may be registered within four months of filing.

Once registered, a trademark is protected for 10 years from its filing date and may be renewed indefinitely provided the appropriate fee is paid every 10 years (subject to a standard six-month, and exceptional 12-month, grace renewal period).

Comparable UK trademarks retain the renewal date of their originating EU mark and are subject to standard UK renewal fees and procedure.

REMOVAL FROM REGISTER

INVALIDATION

A registration may be declared invalid at any time following registration based on absolute or relative grounds. Anyone can file an invalidation application based on absolute grounds, but only prior rights holders may file invalidation applications based on relative grounds.

If an earlier rights holder acquiesces in the use of a registered trademark for a continuous five-year period, it may lose the right to file an invalidation action, unless the later trademark was registered in bad faith.

Following a declaration of invalidity, the affected registration is deemed never to have been registered in respect of the affected goods or services.

REVOCAION

The grounds for revocation are:

- non-use – where a mark has not been put to genuine use in the United Kingdom within five years of registration or if such use has been suspended for an uninterrupted five-year period and there are no proper reasons for non-use;
- loss of distinctiveness – where a mark has become the common name in trade for the goods or services for which it is registered as a consequence of the acts or inactivity of the rights holder; and
- deceptiveness – where a mark is liable to mislead the public as to the nature, quality or geographical origin of the goods or services for which it is registered as a consequence of the acts or inactivity of the rights holder.

Following an order for revocation, the holder's rights are deemed to have ceased as of the date of the application for revocation or an earlier date if the grounds for revocation existed at that date.

For EU trademarks that were subject to ongoing cancellation proceedings on 31 December 2020 and are subsequently cancelled, the EU cancellation decision will be applied automatically to the UK comparable trademark except where the grounds for cancellation do not apply in the United Kingdom.

SURRENDER

A registration can be surrendered (partially or entirely) at any time. Surrender takes effect from the date of publication of the surrender in the UKIPO Trademarks Journal.

ENFORCEMENT

It is possible to bring an infringement or passing-off action in respect of unauthorised use of a registered or unregistered mark.

PRE-ACTION STEPS

Before bringing an infringement or passing-off claim, potential claimants are expected to make reasonable efforts to settle the dispute. Failure to do so may affect the available remedies (in particular, liability for costs).

It is common practice to send a cease and desist letter to the infringer prior to issuing proceedings, having due regard to unjustified threats legislation.

Unjustified threats legislation does not apply to acts of primary infringement such as applying a mark to goods or their packaging, importing such goods or supplying services under the mark.

For secondary acts (eg, selling infringing goods), a threat will be justified if the communication is necessary for the purpose of:

- giving notice that an IP right exists;
- discovering whether, or by whom, a right is being infringed;
- giving notice that a person has an interest in an IP right where that is relevant to any proceedings; or
- any other purpose that a court deems to be in the interests of justice.

A threat is also justified if it is shown that the act to which the threat relates was or would be infringing.

Unregistered trademark rights are not subject to unjustified threats legislation.

CIVIL PROCEEDINGS

Both infringement and passing-off actions can be brought in the High Court (Chancery Division), including the separate IP Enterprise Court (IPEC), as well as in a designated county court.

The remedies available depend on the court and route chosen. The IPEC is intended to manage lower value and less complex actions than the High Court and can therefore be cheaper and quicker for rights holders. Proceedings in the IPEC are subject to costs caps and caps on the amounts recoverable in damages.

Remedies available to a successful rights holder may include:

- an interim injunction (not available in the IPEC small-claims track);
- a permanent injunction;
- delivery up or destruction of infringing goods;
- removal of marks from infringing goods;
- an account of profits or damages;
- a declaration of validity and/or infringement; and/or
- payment of legal costs.

An interim injunction is a discretionary remedy and an applicant must show that it would suffer irreparable harm if an injunction were not granted until the end of a full trial. When

seeking an interim injunction, it is important that the rights holder acts immediately on learning of the infringement, as any delay may prejudice its position.

In respect of proceedings commenced after 31 December 2020, UK courts cannot sit as EU trademark courts and cannot grant pan-EU injunctions. Where a UK court was hearing a case as an EU trademark court on 31 December 2020, it will continue to do so. Actions and remedies taken or granted by the court in such cases continue to apply to EU rights, and the IPEC and the High Court may decide on infringement, revocation and invalidity, and to issue pan-EU injunctions.

Injunctions that are in force on 1 January 2021 that prohibit acts of infringement of an EU trademark in the United Kingdom give rise to an equivalent injunction that has effect in respect of the corresponding comparable mark, subject to any court order to the contrary. Any EU-wide injunction issued by a court of an EU member state on or after 1 January 2021 will not apply in the United Kingdom.

CRIMINAL PROCEEDINGS

The unauthorised use of a trademark can also constitute a criminal offence – for example, applying identical or highly similar signs to goods or their packaging, or selling, distributing or possessing such goods. To commit an offence, a person must act without the owner's authorisation, with a view to gain or with an intention to cause loss. The goods must be covered by the registered trademark and the trademark must be reputed in the United Kingdom, such that the use of the sign takes unfair advantage of, or is detrimental to, its distinctive character or repute.

It is a defence to criminal infringement proceedings for the defendant to establish that they believed on reasonable grounds that the use of the mark in the manner in which it was used, or was to be used, was not an infringement of the registered trademark.

A person guilty of an offence may receive a fine or be sentenced to up to six months' imprisonment on summary conviction (or both), and up to 10 years on conviction on indictment.

It is also a criminal offence to knowingly or recklessly misrepresent that a trademark is registered (eg, by using the ® symbol) if this is not the case. If desired, the ™ symbol may be used in respect of unregistered marks.

EXHAUSTION

The United Kingdom currently operates exhaustion for trademarks across the European Economic Area (EEA). Consequently, with some limited exceptions, if goods are placed on the market anywhere in the EEA with the consent of the rights holder, the rights holder is unable to assert their trademark rights to prevent the subsequent export of those goods into the United Kingdom. By contrast, goods placed on the United Kingdom market by, or with the consent of, the rights holder are not considered exhausted in the EEA and will require additional consent for export to the EEA.

OWNERSHIP CHANGES AND RIGHT TRANSFERS

A registered trademark is a property right that can be transferred, licensed, mortgaged and otherwise exploited like any other form of property. As well as a complete transfer, it is possible to partially assign or license a trademark in respect of certain goods or services for which the mark is registered, as well as for use in a particular manner, field or locality.

While such changes and transfers must be made in writing and signed on behalf of the assignor or licensor, the assignee's or licensee's signature is not required (although it is recommended to avoid disputes). If a trademark is jointly owned, all owners must consent to any assignment or licence.

For a licensee to assert its statutory rights and remedies in relation to infringement, the licence must be recorded at the UKIPO. Once recorded (subject to any express derogations contained in the licence itself), an exclusive licensee may call on the trademark owner to initiate infringement proceedings in respect of any infringing activity affecting the licensee's interests. If the owner refuses or fails to do so within two months, the licensee may bring proceedings in its own name.

A non-exclusive licensee may take infringement proceedings only with the consent of the owner (unless stated otherwise in the licence).

Failure to record an assignment or licence with the UKIPO within six months of its effective date can have adverse costs consequences for the new owner or licensee in any subsequent infringement proceedings.

Subject to any specific conditions that it may prescribe, a licence or security interest recorded against an EU trademark continues to have legal effect in the United Kingdom against the comparable UK mark. Any licence or security interest that refers to an EU trademark and authorises acts in the United Kingdom is treated as if it applies to the comparable UK mark.

RELATED RIGHTS

Copyright, registered designs and unregistered designs can complement (and overlap with) trademark rights, particularly in the field of figurative and three-dimensional trademarks. For example, copyright in artistic works arises automatically and subsists for 70 years from the end of the calendar year in which the author dies.

New product get-up and designs that possess individual character can also be protected in the United Kingdom. Unlike a trademark registration, a design registration does not have use requirements. A registered design is renewable every five years, up to a maximum of 25 years. Unregistered UK design rights protect designs for a period of 15 years from their creation date or for 10 years after the product is first sold, whichever is earlier. Designs that were protected in the United Kingdom before 1 January 2021 as unregistered community designs are protected as UK continuing unregistered designs for the remainder of their three-year term of protection. A new Supplementary Unregistered Design provides three years' protection in the United Kingdom for new designs first disclosed in the United Kingdom after 31 December 2020. Community Registered Designs in force as at 31 December 2020 have been cloned automatically into corresponding UK Registered Designs, except where publication has been deferred, in which case a new UK Registered Design application had to be filed by 30 September 2021 in order to secure equivalent protection in the United Kingdom.

COMPANY NAMES TRIBUNAL

The Company Names Tribunal adjudicates complaints involving company names registered for the primary purpose of preventing someone else with a legitimate interest from registering the names or demanding payment to release a name. It is a relatively straightforward and inexpensive process.

ONLINE ISSUES

The dispute resolution service for '.uk' domains is operated by Nominet, the '.uk' domain name registry.

Any legal or natural person can bring a claim. To succeed, the complainant must establish that the domain name complained of is an abusive registration – meaning that it was registered (or acquired) or is being used in a way that takes unfair advantage of, or is unfairly detrimental to, the complainant's rights.

If a complaint is defended, it automatically enters a voluntary mediation stage. A Nominet mediator will contact both parties and try to resolve the dispute. If mediation is unsuccessful, the complainant must pay a fee to receive a decision on the matter by a Nominet expert. Appeals are available to a panel of three experts.

If the complainant succeeds, the domain name registration may be cancelled, suspended or transferred to the complainant.

No	No: but the UKIPO conducts searches for prior conflicting marks and notifies UK trademark owners.	Yes: sound; colour; smell/olfactory; taste; movement/hologram; multimedia; 3D.
Yes	Yes	Yes: initially two months from publication, extendable by one month.
Yes: continuous period of five years' non - use at any time after registration.	Yes	Yes
Yes	No	Yes: should be applied for without delay.
No: but it is strongly recommended.	No: but common law remedies available.	Yes: operated by Nominet for all '.uk' domains.



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United States: Trademark procedures and strategies

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Summary

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LEGAL FRAMEWORK

Trademarks are governed by federal and state law. The Lanham Act is a federal statute that governs the registration and enforcement of trademarks used in interstate commerce, or foreign commerce that has a substantial effect on US commerce. Each state has a statute providing for registration and protection of trademarks used in that state. Both federal and state law protect unregistered rights in trademarks that are acquired through use (common law rights). Federal and state law trademark laws coexist, and courts generally interpret state trademark laws in a manner consistent with federal law.

The United States is a signatory to several international treaties relating to trademarks, including:

- the Paris Convention;
- the United States–Mexico–Canada Agreement;
- the General Agreement on Tariffs and Trade;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Madrid Protocol; and
- the Singapore Treaty on the Law of Trademarks.

UNREGISTERED MARKS

Trademark rights are generally acquired through use, not registration. The first to use an inherently distinctive mark in commerce acquires rights to the mark for the associated goods and services in the geographic market in which the mark was first used or has acquired recognition, with two exceptions:

- the first to file a federal intent-to-use application that later results in a registration obtains priority dating back to the date of filing the application; and
- for marks that are not inherently distinctive, the first to acquire secondary meaning in the mark acquires priority.

USE REQUIRED

To acquire rights in a mark, the applicant must make bona fide use of the mark in the ordinary course of trade, rather than token use to reserve a right in a mark. There is no bright line rule for determining the use to acquire trademark rights. The rule is flexible to account for differences in the kinds of transaction made across different industries and for different types of goods and services. Use sufficient to support a claim of rights can also be established through prior use as a trade name or other use analogous to trademark use, provided that such use created an association among consumers between the mark and the goods or services to be provided.

REGISTERED MARKS

Trademarks that are used in interstate commerce, or foreign commerce that affects commerce in the United States, are eligible for federal and state registration. However, these requirements have been construed very broadly, so almost any use of a mark in commerce can qualify for registration.

TYPES OF FEDERAL REGISTRATION

There are two types of federal trademark registration:

- registration on the Principal Register, for marks that are inherently distinctive or have acquired distinctiveness; and
- registration on the Supplemental Register, for marks that are not inherently distinctive but are capable of acquiring distinctiveness and otherwise meet the registration requirements.

BENEFITS OF FEDERAL REGISTRATION

Registration of a mark on the Principal Register:

- satisfies the burden of proof that:
 - the registrant owns the mark;
 - the mark is valid; and
 - the registrant owns the exclusive right to use the registered mark in commerce for the goods or services specified in the registration;
- serves as constructive notice of the registrant's ownership and use of the mark;
- achieves incontestable status after five years, provided that certain formalities are met;
- eliminates certain defences to claims of infringement and dilution;
- can be relied on to prevent importation of infringing goods;
- enables the registrant to file suit for infringement of the mark in federal court;
- may be cited against applications for registration of confusingly similar marks; and
- enables the registrant to use the ® designation.

Registration on the Supplemental Register provides only the last three benefits identified above.

APPLICANTS FOR FEDERAL REGISTRATION

To apply for a trademark registration, the applicant must be the owner of the mark (ie, the entity that applies the mark to goods or services that they offer or intend to offer, directly or through a licensee). Applicants may be natural persons, entities, nations, states or other government bodies.

POWER OF ATTORNEY

A power of attorney is not needed to file a trademark application unless the applicant or registrant is already represented by a qualified practitioner and a new practitioner wishes to take action regarding the application or registration. In that case, the new practitioner must file a new power of attorney or revocation of the previous power, signed by the individual applicant or registrant, or someone with legal authority to bind them (eg, a corporate officer).

PROTECTABLE AND UNPROTECTABLE MARKS

A trademark can be anything capable of distinguishing the source of goods and services from those of another, including words, symbols, slogans, three-dimensional (3D) shapes, colours, sounds, scents, motions and trade dress.

Marks must be inherently distinctive (eg, fanciful, arbitrary or suggestive terms) or have acquired secondary meaning (ie, descriptive terms that have acquired a special significance such that consumers associate the term with a single source).

The following cannot be federally registered:

- marks resembling a mark registered or previously used in the United States by another that are likely to cause confusion or mistake, or to deceive;
- generic, merely descriptive or deceptively misdescriptive terms;
- geographically descriptive or misdescriptive terms;
- marks that, taken as a whole, are functional;
- marks that are primarily merely surnames;
- any flag, coat of arms or other insignia of the United States, any state or municipality, or foreign nation;
- matter protected by statute or convention (eg, the Olympics); and
- the name, portrait or signature of any living individual or deceased US president, without consent.

Laws prohibiting registration of disparaging, immoral or scandalous matter have been held to be unconstitutional and are no longer a bar to federal registration.

PROCEDURES

FEDERAL REGISTRATION

The applicant must file an application with the USPTO based on:

- use of the mark in commerce;
- intent to use the mark in commerce;
- a registration of the mark in a foreign jurisdiction;
- an application for registration of the mark in a foreign jurisdiction within six months of such a filing; or
- an international registration.

The application must identify:

- the applicant and its address;
- the mark to be registered (including an image if the mark is a logo or design);
- the goods or services;
- one or more of the filing bases set forth above; and
- the dates of first use of the mark in commerce anywhere.

The applicant must provide a description of the mark (and, for use-based applications, a specimen) and pay the applicable fee. Foreign-domiciled trademark applicants must appoint an attorney who is licensed to practice law in the United States.

Once an application is filed with the USPTO, it will be assigned to an examiner for review, usually within a few months of filing. The examiner will determine whether the application complies with the formal requirements for applications, including:

- identification of the mark;
- use of the correct class or classes for the goods and services; and
- identification of the filing basis.

The examiner will check the application for substantive deficiencies, including whether the mark:

- is distinctive;
- does not conflict with any prior federal application or registration; and
- has been used in connection with the relevant goods and services.

The examiner will not determine whether the mark:

- conflicts with the rights of any owner of state or common law rights; or
- would constitute trademark infringement or dilution.

If the examiner identifies any basis for refusing registration, they will issue an office action identifying the basis for refusal. Currently, an applicant has six months to respond to an office action. However, under the Trademark Modernization Act of 2020 (TMA), effective December 2022, the timeline for responding to an office action will be three months from the date of the office action. The three-month deadline can be extended by three months for a fee. Thereafter, the applicant may file a petition to revive an application that was unintentionally abandoned within two months of the notice of abandonment. The examiner may issue additional office actions.

If the examiner does not identify any basis for refusing registration or determines that the applicant has overcome any deficiencies, they will approve the mark for publication.

If the examiner determines that the applicant has not overcome the deficiencies, they will issue a final refusal. The applicant has six months from the date of the final refusal to appeal to the TTAB or the USPTO. The applicant may also file a request for reconsideration with the examiner, although this does not toll the time for appeal. Accordingly, any request for reconsideration should be filed with the appeal.

OPPOSITION

Anyone who believes that they would be injured by federal registration of a mark may oppose the application within 30 days of the date of publication. The opposer may seek an initial 30-day extension (which will be granted for any reason) or a 90-day extension (which will be granted for good cause). An opposer who obtained an initial 30-day extension may seek an additional 60-day extension on showing good cause. An opposer that obtained a 90-day extension (in total) may seek an additional 60-day extension on consent of the applicant

or showing extraordinary circumstances. Total extensions cannot exceed 180 days from publication.

The opposition is commenced by filing a notice of opposition. Oppositions can be based on:

- prior conflicting trademark rights;
- descriptiveness;
- lack of distinctiveness;
- deceptive matter; and
- dilution.

The sole issue decided by the TTAB is whether the mark will be registered; it cannot grant an injunction prohibiting the applicant from using the mark or award damages, attorneys' fees or costs.

An opposition proceeding is similar to civil litigation in that the parties are entitled to broad discovery of information or documents relevant to the claims and defences in the case. Unlike with civil litigation, after discovery, the TTAB does not conduct a live trial. Rather, the 'trial' is conducted on paper and may be followed by a hearing. An opposition usually takes 2.7 years before the TTAB. However, using Accelerated Case Resolution, which prohibits extensions of deadlines, the proceeding usually takes 2.1 years.

The party losing the TTAB action may:

- seek reconsideration;
- appeal the decision to the Court of Appeals for the Federal Circuit; or
- seek review of the TTAB decision by a federal district court.

REGISTRATION

After publication, the USPTO will grant registration to an unopposed application for a mark that is based on use in commerce, a foreign registration or an extension of protection of an international registration to the United States. The time from filing to registration of a use-based application is approximately six to 10 months if no office actions are issued.

For unopposed applications based on the applicant's intent to use the mark in commerce, the USPTO will issue a notice of allowance approximately two months following publication. The applicant has six months from the date of notice to:

- submit a statement of use and specimen showing the mark in use in commerce; or
- request a six-month extension to file a statement of use.

Five extension requests may be filed. If the applicant submits all extension requests in a timely manner, the applicant will have three years from the notice of allowance to begin using the mark and file an acceptable statement of use. If the applicant does not file a statement of use or extension request within six months of the notice of allowance, the application will be abandoned.

MAINTENANCE

To maintain the registration, the registrant must file documents between the fifth and sixth anniversary of registration attesting the use of the mark in commerce or establishing excusable non-use. The registrant may also file a declaration of incontestability. The registration must be renewed every 10 years after registration. Failure to file maintenance documents will result in cancellation or expiration of the registration. There is a six-month grace period after the deadlines with payment of an additional fee. The USPTO may audit registrations by requiring trademark owners to submit proof of use for at least two additional goods or services per class.

CANCELLATION

The USPTO will automatically cancel registrations when maintenance documents have not been filed in a timely manner. Moreover, anyone who believes that they will be damaged by an existing registration may seek cancellation by filing a petition to cancel. A cancellation proceeding filed within five years of registration of the mark may be based on any ground that would have initially prevented registration. A cancellation proceeding filed after the fifth anniversary of registration is limited to certain grounds, such as abandonment, fraud or the mark becoming generic.

The TMA established two new types of *ex parte* proceedings for challenging a registration based on non-use of the mark by the registrant: expungement and re-examination proceedings.

In an expungement proceeding, the USPTO will cancel a registration or portion thereof if it finds that the registered mark has never been used in commerce on or in connection with some or all of the goods or services recited in the registration. Before 27 December 2023, an expungement proceeding may be filed for any registration that is at least three years old. Beginning on 27 December 2023, an expungement proceeding may only be filed between the third and 10th anniversary of registration.

In a re-examination proceeding, the USPTO will cancel a registration or portion thereof if the trademark was not in use in commerce on or in connection with some or all of the goods or services listed in the registration on or before:

- the filing date of a use-based application; or
- the later of the date that an amendment to allege use was filed or the date that the deadline to file a statement of use expired for an intent-to-use application.

The TMA also codified the letter of protest procedure. Third parties may file a letter of protest during prosecution or no later than 30 days after publication to submit evidence that a mark should not be registered. The TMA requires the USPTO to decide on the letter of protest within two months.

SEARCHES

The USPTO database can be searched online for free. Searches can include:

- identical and similar marks;
- applicants;
- owners;
- goods and services; and

- design elements.

The USPTO does not conduct searches on behalf of applicants prior to filing. The USPTO database includes live and dead federal trademark applications and registrations. It does not include state trademark registrations or common law uses. However, commercial providers provide more comprehensive searches.

ENFORCEMENT

Trademark enforcement in the United States can be expensive and time consuming. As a result, trademark owners often enforce their trademark rights through informal means, such as cease and desist letters and negotiated settlements. If a trademark owner cannot successfully enforce its rights through informal means, civil action is the primary method for enforcement.

CIVIL ACTION

A trademark owner can bring a civil action to enforce trademark rights in federal court or state court. There are no specialist trademark or IP courts. If the trademark owner files in state court, the defendant may remove the case to federal court under certain circumstances. The trademark owner can proceed with the action only in courts that can exercise personal jurisdiction over the defendant and where the venue is proper.

CAUSES OF ACTION AND DEFENCES

The most common causes of action in trademark cases in federal court are:

- trademark infringement (based on use of a mark in commerce that is likely to cause confusion with respect to a federally registered mark);
- unfair competition (based on use of a mark that is likely to cause confusion with respect to a registered or unregistered mark);
- trademark dilution (based on use of a mark that is likely to dilute the distinctiveness of a famous mark by blurring or tarnishment);
- trademark counterfeiting (based on use of a mark that is essentially the same as a federally registered mark on goods covered by the registration); and
- cybersquatting (based on registration, use or trafficking in a domain name containing the trademark of another with the bad-faith intent to profit therefrom).

The trademark owner may be able to assert state and common law causes of action. Affirmative defences include fair use, laches, estoppel and acquiescence.

INJUNCTIVE RELIEF

The court has the power to grant temporary, preliminary and permanent injunctions, based on principles of equity, preventing infringement of the mark. A court may also order seizure of counterfeit goods. In addition, the court has authority over the defendant's trademark registration, including the power to order cancellation. The TMA also provides that a trademark owner seeking injunctive relief is entitled to a rebuttable presumption of irreparable harm upon a finding of infringement or a likelihood of success on the merits.

MONETARY REMEDIES

A court may award damages for trademark infringement subject to principles of equity. A prevailing trademark owner is not automatically entitled to recovery of damages but can generally recover damages that it actually suffered from the infringement. The court may increase the award to up to three times the actual damages. The trademark owner may also obtain an award of the defendant's profits if the defendant's infringement was wilful. The court may increase or decrease an award of profits if it finds the award inadequate or excessive. In cases involving wilful infringement using a counterfeit mark, unless the court finds extenuating circumstances, it will enter judgment for the greater of three times the infringer's profits or the trademark owner's damages, together with reasonable attorneys' fees. Alternatively, the court may award statutory damages of up to \$2 million for wilful trademark counterfeiting. Punitive damages are unavailable under federal trademark law. The court may award reasonable attorneys' fees to the prevailing party in exceptional cases. In all cases, the prevailing party may recover certain costs.

OWNERSHIP CHANGES AND RIGHTS TRANSFERS

Trademarks may be assigned, licensed or pledged as security. For an assignment of a trademark to be valid, the trademark must be conveyed along with the goodwill it symbolises. The assignment of a mark that is the subject of a federal registration or application must be in writing. Intent-to-use applications to register cannot be assigned before the applicant files a verified statement of use, unless that part of the business connected with the mark is also transferred. The assignment of a federally registered or applied-for mark should be recorded with the USPTO within three months of the date of assignment. Otherwise, it is void against a subsequent purchaser giving value who has no notice of the prior assignment.

Trademarks may be licensed exclusively or non-exclusively. The licensor must exercise quality control over the licensee's use of the trademark. Licensing without quality control is a naked licence that can result in the loss of trademark rights. Merely including a quality control provision in a written licence agreement is insufficient; the licensor must make a bona fide effort to exercise quality control over the licensee. The licensee's use of a licensed mark inures to the benefit of the licensor.

A trademark may be pledged as security for a loan or other indebtedness. To perfect a security interest in a federally registered trademark, the security interest must be recorded with the USPTO. Different rules apply for perfecting a security interest in a state trademark registration or common law mark.

RELATED RIGHTS

In certain circumstances, overlapping rights may also protect a particular trademark. For example, state law rights of publicity protect the exclusive right to use one's name, voice, signature, likeness or persona for commercial purposes.

A trademark may qualify for protection under the Copyright Act if it contains sufficient original and copyrightable expression. The advantage of copyright protection is that liability is premised on copying and likelihood of confusion need not be proved. Because copyright protection does not extend to titles and short phrases, word marks do not typically qualify for copyright protection. However, logos, 3D marks, sound marks and audio-visual marks can qualify.

ONLINE ISSUES

The general laws prohibiting trademark infringement, unfair competition and dilution apply to the internet. Whether use of another’s mark online (eg, in sponsored advertisements) constitutes trademark infringement depends on whether the use creates a likelihood of confusion. Federal law prohibits cybersquatting, which is defined as the registration, use or trafficking in domain names containing the trademark of another with the bad-faith intent to profit therefrom.

No: unless replacing existing counsel.	Yes	Yes: 3D shapes; colours; sounds; motions; scents; flavours.
Yes	Yes	Yes: 30 days from publication. Extensions are available.
Yes: registrations are presumed abandoned after three years of non - use.	Yes	Yes
Yes: TTAB.	No	Yes: no specific time limit.
No: but if assignment is not recorded within three months, it is void against good - faith purchasers giving value.	Yes	Yes: usDRP and usTLD.

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Switzerland: Trademark procedures and strategies

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LEGAL FRAMEWORK

NATIONAL

The basic principles for trademark protection in Switzerland are contained in the Federal Act on the Protection of Trademarks and Indications of Source and the Trademark Protection Ordinance. The latest revisions to the act include revisions regarding 'Swissness', providing administrative trademark cancellation proceedings on the grounds of non-use and better protection for Swiss geographical indications, as well as establishing a register for geographical indications for non-agricultural products and a register for geographical marks. These revisions entered into force on 1 January 2017. The adoption of the Geneva Act of the Lisbon Agreement on Appellations of Origin and Geographical Indications, providing the registration of geographical indications and their relation to trademarks, entered into force on 1 December 2021.

INTERNATIONAL

Switzerland has signed most pertinent international agreements, including:

- the Paris Convention for the Protection of Industrial Property (the Paris Convention);
- the Madrid Agreement on the International Registration of Marks and the Madrid Protocol;
- the Agreement on Trade-Related Aspects of Intellectual Property Rights;
- the Nice Agreement on the International Classification of Goods and Services; and
- the Trademark Law Treaty.

UNREGISTERED MARKS

Generally, trademark rights are established through entry in the trademark register.

Well-known unregistered trademarks may enjoy protection under Article 6*bis* of the Paris Convention.

The use of unregistered signs may, in individual cases, be protected:

- by the Federal Act against Unfair Competition;
- as moral rights to a name;
- as foreign trade names under the Paris Convention;
- as geographical indications; and
- by the Federal Act on Copyright and Related Rights.

The Federal Act on the Protection of Trademarks and Indications of Source provides the right to continue using a sign to the same extent if a third party subsequently registers an identical or similar mark.

REGISTERED MARKS

Any natural or legal person can apply for trademark registration in Switzerland (restrictions apply to geographical and collective marks). Foreign applicants must indicate an address for service in Switzerland. There is no requirement of use or intent to use for filing an

application. However, trademarks that have been registered without any intention to use may be challenged. The current fee is Sfr550 for filing an application in up to three classes. Multi-class applications are available.

REGISTRABILITY

All signs that are capable of distinguishing the goods and services of one undertaking from those of another are registrable. Provided that they can be represented graphically, marks may be any kind of sign, including:

- words, letters and numerals;
- figurative representations;
- three-dimensional (3D) shapes;
- colours;
- sounds;
- motion marks;
- holograms;
- position marks;
- combinations of the above; or
- other non-traditional marks (eg, olfactory marks).

Multimedia marks are, contrary to the European Union and other jurisdictions, currently not yet registerable with the Federal Institute of Intellectual Property (IPI).

The Federal Administrative Court accepted olfactory marks in principle, but denied protection in a particular case due to a lack of graphical representability.

The Federal Act on the Protection of Trademarks and Indications of Source differentiates between individual, certification, collective and geographical marks.

Article 2 of the act excludes signs from registration that are:

- in the public domain, unless they have acquired secondary meaning;
- shapes constituting the nature of the goods or shapes of the goods or their packaging that are technically necessary;
- misleading; or
- contrary to public policy, morality or applicable law.

The relevant languages for examination are the official languages (French, German, Italian and Rhaeto-Romanic) and basic English, which is considered to be known by the average consumer.

PUBLIC DOMAIN

Signs that are in the public domain are signs that lack distinctiveness or must be kept free for trade. Signs that lack distinctiveness include:

- single numerals or single letters of the Latin alphabet;

- simple geometrical signs (eg, circles and rectangles);
- descriptive signs – including words, images, slogans or pictograms that describe the nature, quality, quantity, purpose, effect, content, get-up, addressee, geographical origin or other characteristics of the goods or services – for example: KEYTRADER in Class 36; MUFFIN KING in Class 30; NOBLEWOOD in Classes 2, 19 and 27; VIAGGIO in Class 12; COOL ACTION in Class 3; JAZZ in Class 9; GOLD BAND in Class 34; OKTOBERFEST-BIER in Class 32; VERY IMPORTANT PHARMACY in Classes 3, 5 and 44; and SIBIRICA in Classes 10, 20 and 24 (direct geographical indications are registrable if they are registered in the country of origin); and a red sole for women's shoes (position mark);
- general indications of quality or purely promotional signs (eg, SUPER, MASTER, MASTERPIECE, TOP, HYPE, PRIMO or ROYAL);
- common or banal signs (eg, ENTERPRISE or NETTO), references to a company form (eg, Ltd), ccTLDs and generic TLDs (eg, '.com' and '.ch'), telephone numbers (eg, 0800), plant variety denominations and international non-proprietary names; and
- shapes that are expected and common in the relevant sector – such forms can be registered as 3D marks when they are combined with distinctive two-dimensional elements that significantly affect the overall impression.

Based on the ruling of the Federal Supreme Court (BGer) 4A_518/2021 in proceedings between PUMA Se and FIFA, the IPI has changed its practice regarding event marks. In this ruling, the BGer found that the combinations QATAR 2022 and WORLD CUP 2022 initially lacked distinctive character under trademark law. The IPI will therefore comprehensively reject signs according to this pattern if they are filed as word marks. However, this only applies if the specific combination is perceived by the relevant public as an indication of an event, which presupposes that the place mentioned in the sign is known and that the year is in the near future.

Names of persons and characters may be registered, unless they are frequently cited to describe the goods or services or must be kept free for trade (eg, MOZART in Class 9 or RAPUNZEL in Classes 9, 14, 16, 20, 21, 28 and 41).

A trademark may consist of distinctive and non-distinctive elements and is registrable if one significant element is distinctive. Disclaimers are neither required nor permissible for non-distinctive elements.

Signs that must be kept free for trade are those which are indispensable to that trade (eg, abstract colours such as the colour blue for beverages, POST for postal and MARCHÉ for restaurant and food services).

Signs that initially lack distinctiveness and that are not absolutely indispensable for trade may acquire secondary meaning and be registered upon evidence of extensive use in Switzerland. The IPI typically requires proof of use over several years (usually 10 years) in all Swiss territories (French, Italian and German-speaking parts) as a trademark (eg, not as a company name) in relation to the designated goods and services, and to a significant extent. Documents or surveys are accepted as evidence.

SHAPE MARKS

Shape marks that are 3D signs additionally applied to goods (ie, the star on Mercedes-Benz cars) are examined by the IPI based on whether they are in the public domain. However, shape marks that represent the shape of the goods or their packaging cannot be registered if they are in the public domain, if their features correspond to the nature of the goods (eg, a ring) or if they are determined by technical necessities. Such shapes cannot acquire secondary meaning.

MISLEADING SIGNS

A trademark is misleading if it creates expectations that are not fulfilled by the goods or services marked (eg, CAFÉ for coffee substitutes). The most relevant cases in this field are geographical indications that mislead as to the origin of the designated goods or services. The IPI is strict when it comes to geographical indications and holds that a sign consisting of or containing a geographical term evokes the expectation that the designated goods originate in that location. This presumption is rebuttable if:

- the place is unknown;
- the sign has a clear and direct other or symbolic meaning;
- the place is obviously unsuitable for production or commerce of the goods claimed;
- the sign is a designation of type;
- the sign has acquired secondary meaning;
- the sign has degenerated into a denomination of a genus (eg, Hamburger for food products); or
- the overall impression does not evoke the expectation of any geographical origin (eg, the geographical term in the mark rather refers to the point of sale, the place of an event, the content, the owner of the mark or others, such as DEUTSCHER FUSSBALL-BUND in Class 29; and THE HARLEM GOSPEL SINGERS in Class 25).

Applications for marks that evoke a geographical origin may still be registered if the sign is distinctive (eg, AFRI-COLA for African beverages). As of 1 March 2022, the IPI no longer asks for a restriction on the list of goods and services to the goods and services of the applicable place of origin, provided that there is no legal or contractual obligation to restrict the list and assuming that correct use of the geographical indication is possible. A foreign indication should meet the statutory requirements of the country concerned, subject to misleading Swiss consumers. A Swiss indication is generally considered to be of Swiss origin if:

- products are grown and harvested in Switzerland (natural products);
- 80% of the raw material weight is of Swiss origin and the processing step that gives the product its essential characteristics is carried out in Switzerland (foodstuffs); or
- 60% of the manufacturing costs are accumulated in Switzerland and the processing step that gives the product its essential characteristics is carried out in Switzerland (industrial products).

PUBLIC POLICY

Signs against public policy or morality include racist, religiously hostile or sexually offensive signs or names of prominent individuals (without their consent) (eg, BUDDHA BAR in Classes 9 and 41; MADONNA in various classes; and MINDFUCK in Classes 21, 25, 35 and 41).

Signs against applicable law include those containing protected names, coats of arms and emblems (Swiss national legislation goes beyond Article 6^{ter} of the Paris Convention) and any other signs that are prohibited by law (eg, 'mild' for tobacco products).

GEOGRAPHICAL MARKS

The new law provides for a register for geographical indications for non-agricultural products and a register for geographical marks. It is possible to register geographical indications (both agricultural and non-agricultural), wine designations recognised by the cantons and indications of source that are the subject of a Federal Council ordinance (eg, for watches) as geographical marks. The applicant of a geographical mark must be a representative group and must file regulations governing the use of the mark. Anyone who fulfils the conditions is entitled to use the geographical mark. A geographical mark is not vulnerable in case of non-use; it cannot be licensed or transferred and no opposition based on a geographical mark can be filed.

MAINTENANCE

Declarations or evidence of use need not be submitted to the IPI to maintain a trademark registration. Trademarks that are not used for an uninterrupted five-year period (starting from the expiry of the opposition period for national marks, the declaration of grant of protection for international marks or a final decision in the case of a refusal or opposition) may be challenged on the grounds of non-use before the IPI or civil courts, unless proper reasons for non-use exist. Non-use may be invoked by the defendant in opposition proceedings and before civil courts. Since the introduction of the administrative non-use cancellation proceedings before the IPI in 2017, the IPI has decided more than 117 cases, which shows that these proceedings are an effective method of challenging trademarks in cases of non-use.

If use of the trademark is commenced or resumed after more than five years, the right to the trademark is restored with effect from the original priority date, unless non-use has been invoked prior to the commencement or resumption of use.

Generally, the trademark must be used as registered. However, minor variations are permissible to prove genuine use provided that the distinctive core of the mark is maintained. Omitting distinctive elements is generally more critical than adding such.

PROCEDURES

EXAMINATION

The IPI examines applications on absolute grounds only. Relative grounds may be raised by holders of earlier rights within opposition or civil proceedings. The timeframe from application to examination or registration is usually six days to six months. Accelerated examination can be requested for Sfr400. The IPI will then examine the application within four weeks. Swiss trademark applications (unlike international applications designating Switzerland) may be amended during the application process. However, in case of significant amendments, the application date will shift to the date on which the amendments were filed. IPI decisions can be appealed to the Federal Administrative Court and thereafter to the BGer.

OPPOSITION

Oppositions to a registration may be filed by the owners of:

- prior Swiss national trademark applications or registrations;
- prior international registrations designating Switzerland; and
- trademarks that are well known in Switzerland under Article 6*bis* of the Paris Convention.

The non-extendable three-month opposition period starts from the registration and publication date (for national registrations) or the first day of the month following publication in the *WIPO Gazette* (for international registrations). The official fee is Sfr800. Compensation awarded to the prevailing party is between Sfr1,200 and Sfr2,400. If use of the prior mark is not challenged, proceedings usually take one to two years. IPI opposition decisions can be appealed to the Federal Administrative Court, the decision of which is final.

REGISTRATION AND DURATION

The trademark is protected as of the application date for a 10-year period and can be renewed for further 10-year periods. The renewal fees are Sfr700, irrespective of the number of classes. A six-month grace period exists for late renewal (against an additional Sfr50 fee).

The use of the '®' symbol is not mandatory. Its use for a mark that is not registered may be considered an act of unfair competition.

REMOVAL FROM REGISTER

The IPI may not cancel registered trademarks *ex officio*. Third parties may particularly request removal based on absolute or relative grounds, abusive registration or non-use before civil courts. Cancellation proceedings based on non-use can also be initiated within a simplified administrative proceeding before the IPI. The requesting party must show *prima facie* evidence of non-use, while the owner of the mark must provide *prima facie* evidence of use. An in-use search provided by a service provider may be considered sufficient evidence before the IPI. The official fee for administrative proceedings is Sfr800. Party compensation is between Sfr1,200 and Sfr2,400, plus compensation of expenses for in-use searches, may be awarded to the prevailing party.

ENFORCEMENT

GROUND OF INFRINGEMENT AND PROCEEDINGS

The owner of an earlier mark may prohibit others from using an identical or similar mark for identical or similar goods and services if likelihood of confusion results. The scope of protection covers any use of the mark as a distinctive sign in the course of trade, including in import, export or transit (eg, as mark, company or domain name). The owner of an earlier mark may particularly introduce an opposition, civil action, criminal action or customs measures, or a combination thereof. Preliminary measures are available.

The Federal Act on the Protection of Trademarks and Indications of Source indicates no time limit for civil actions. Generally, after four to eight years, the civil courts may dismiss an action due to forfeiture. In case of bad faith, there is usually no forfeiture. Provisional injunctions should be brought before the court within approximately four months. Criminal complaints must be submitted within three months after the offender has become known. If the offender acts for commercial gain, they will be prosecuted *ex officio*.

As a general rule, the burden of proof lies with the party deriving rights from an alleged fact. This party bears the consequences of lack of evidence. The registered trademark owner enjoys a presumption that its rights are valid. In criminal proceedings, it is often difficult to present sufficient evidence of commercial use or wilful infringement, or both. In civil actions, the calculation of damages can likewise prove complex. Punitive damages are not available.

A key question is usually whether there is likelihood of confusion in the relevant trade circles. The main factors for likelihood of confusion are the similarity of signs, the similarity of goods and services, and the distinctiveness of the earlier mark. Weak or diluted trademarks or trademark elements (eg, CHIC for Class 3; ELLE for women's clothing; FM for broadcasting; or NEWCARE for care products) enjoy a narrower scope of protection, while well-known marks enjoy a broader scope.

Article 15 of the Federal Act on the Protection of Trademarks and Indications of Source allows a rights holder of a famous trademark to take action against use in relation to any goods or services if the distinctiveness of its trademark is jeopardised (dilution), or its reputation is exploited or affected.

Customs may suspend the import, export or transit of suspicious goods *sex officio* or on application. The applicant must then obtain preliminary measures. Simplified proceedings are available. For example, the consent of the declarant, holder or owner is deemed to be given if they do not expressly object to destruction.

DEFENCES AND REMEDIES

Defences may include:

- no likelihood of confusion or non-infringement;
- earlier mark is void or not enforceable due to non-use;
- prior rights or prior use and the right to continued use;
- private, non-commercial use (however, private import, export or transit can be stopped);
- fair (ie, descriptive, informative or decorative) use;
- exhaustion of rights; and
- forfeiture.

Remedies may include:

- securing evidence;
- declaratory judgment;
- injunction or prohibition;
- remedy of existing infringement;
- disclosure of information to the origin and quantity of goods;
- damages, redress or surrender of profits;
- publication of judgment;
- destruction of infringing goods; and
- criminal penalties (eg, imprisonment or fine).

SPECIALISED COURTS

No specialised trademark courts exist in Switzerland, but civil cases are judged by the higher cantonal or commercial courts. Decisions of these first-instance courts can be appealed to the BGer.

OWNERSHIP CHANGES AND RIGHT TRANSFERS

Swiss trademark applications and registrations may be totally or partially assigned (except geographical marks). The assignment must be in writing and usually includes goodwill. The recordal in the register is not constitutive, but a recorded assignment is effective towards third parties acting in good faith.

Licences may be recorded in the register, but such recordal is not mandatory (except for collective marks). The recordal may be in the interest of the licensee, since the licence becomes binding on any rights to the trademark subsequently acquired. Use by a licensee is attributed to the owner when a valid licence can be shown.

Security interests in trademarks are possible. While the recordal in the register is not constitutive, only recorded rights have effect against third parties acting in good faith.

RELATED RIGHTS

Trademark rights can overlap with other rights, particularly copyrights, designs, moral rights (eg, rights in one's own name), rights to a company name and rights under geographical indications and unfair competition laws.

The Federal Act on the Protection of Trademarks and Indications of Source protects owners against the use of confusingly similar marks in connection with similar goods or services as an identifier of commercial origin. Other types of use (eg, comparisons with a competitor's products, imitations of trade dress or denigration) may be pursued under the Unfair Competition Act, the Design Protection Act if there is a registered design or the Copyright Act if the mark qualifies as an artwork under the act. In practice, these acts are often invoked simultaneously.

ONLINE ISSUES

Generally, all laws apply in virtual life as they do in real life. The Federal Act on the Protection of Trademarks and Indications of Source, the Unfair Competition Act, and laws on the protection of moral rights and company names typically apply in online trademark issues. Although trademark infringement may be established only where a website involves similar goods or services, other laws may apply in case of an inactive site or a site offering dissimilar goods or services. Access providers are not liable under the pertinent IP laws.

The Unfair Competition Act may allow proceedings against unfair behaviour, including hindering and blocking, unnecessary imitation and exploitation of reputation or creation of a risk of confusion. In addition, several municipalities (Montana, Lucerne, Frick and St Moritz) have successfully challenged domain names that included their geographical names before the civil courts, based on the Unfair Competition Act and their right to a name.

Disputes over domain names may also be decided by a WIPO panel under the Rules of Procedure for Dispute Resolution Proceedings for '.ch' and '.li' domain names ('.li' being the TLD for Liechtenstein), which have been adopted by SWITCH (the '.ch' and '.li' registry). Under Paragraph 24(c) of the rules, the panellist will grant a cancellation request if the registration

or use of the domain name constitutes a clear infringement of a right in a distinctive sign that the claimant owns under the law of Switzerland or Liechtenstein. In 2021, 18 UDRP cases were decided, of which 16 were transferred to the complainant.



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